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Paper No. 14
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **William B. Siegel**

Serial No. 75/539,620

Myron Amer of Myron Amer, P.C. for William B. Siegel

D. Beryl Gardner, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney)

Before Seeherman, Hairston and Wendel, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

William B. Siegel has appealed from the final refusal of the Trademark Examining Attorney to register CLEAR ADVANTAGE for tennis rackets.¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, on the ground that applicant's mark so resembles the mark ADVANTAGE, previously registered by the same entity for

¹ Application Serial No. 75/539,620, filed August 20, 1998, and asserting a bona fide intention to use the mark in commerce.

tennis rackets,² racquetball racquets,³ tennis balls,⁴ golf balls,⁵ golf clubs⁶ and soccer balls⁷ that, if used on applicant's identified tennis rackets, it is likely to cause confusion or mistake or to deceive.⁸

The appeal has been fully briefed; an oral hearing was not requested.

We affirm the refusals with respect to Registrations Nos. 956,094 for tennis rackets, 1,182,311 for racquetball racquets and 1,743,965 for tennis balls. We reverse the refusals with respect to Registrations Nos. 1,224,423 for golf balls, 1,738,474 for golf clubs and 2,112,471 for soccer balls.

² Registration No. 956,094, issued March 27, 1973; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

³ Registration No. 1,182,311, issued December 15, 1981; Section 8 affidavit accepted; Section 15 affidavit received.

⁴ Registration No. 1,743,965, issued December 29, 1992; Section 8 affidavit accepted; Section 15 affidavit received.

⁵ Registration No. 1,224,423, issued January 18, 1983; Section 8 affidavit accepted; Section 15 affidavit received.

⁶ Registration No. 1,738,474, issued December 8, 1992; Section 8 affidavit accepted; Section 15 affidavit received.

⁷ Registration No. 2,112,471, issued November 11, 1997.

⁸ In his reply brief applicant makes the statement that the Examining Attorney has "conceded by not responding to the registrant's non-entitlement to consideration beyond its single registration of ADVANTAGE for 'tennis rackets' of 0956094..." We interpret this language to be an assertion that the Examining Attorney did not address the refusals based on the other five cited registrations, and thereby must be deemed to have withdrawn those refusals. However, it is clear from a reading of the Examining Attorney's brief that she has maintained the refusals based on all six registrations, and we have accordingly considered all six registrations in our decision herein.

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Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's identified goods, tennis rackets, are legally identical to the registrant's identified tennis rackets in Registration No. 956,094. Therefore, the goods must be deemed to travel in the same channels of trade and be sold to the same classes of customers.

When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

The marks are CLEAR ADVANTAGE and ADVANTAGE. The similarities between the marks are obvious. Applicant has appropriated the registrant's mark, and has added the word CLEAR to it. As the Examining Attorney has pointed out in her brief, the addition of a term to a registered mark is generally not sufficient to avoid likelihood of confusion.

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See **Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.**, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER; **Lilly Pulitzer, Inc. v. Lilli Ann Corp.**, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN).

Applicant has stated that his tennis rackets are made of clear plastic, and has submitted a copy of his patent which confirms that fact.⁹ We do not accept applicant's argument that because of the descriptive nature of the word "clear," purchasers will focus on the CLEAR part of the mark, and therefore this portion should be given greater weight in our comparison of the marks. On the contrary, consumers who are familiar with the registrant's ADVANTAGE tennis rackets are likely to assume, upon seeing the mark CLEAR ADVANTAGE on tennis rackets made of clear plastic, that these rackets emanate from the registrant, and that CLEAR ADVANTAGE is a variation of the ADVANTAGE mark, chosen to indicate that these rackets are made of clear plastic.

We have considered applicant's arguments that the marks have different connotations, but are not persuaded thereby. Specifically, applicant points out that

"advantage" can mean (1) "any circumstance, opportunity, or means specifically favorable to success or a desired end" and (2) "the first point in tennis scored after deuce."¹⁰ Applicant agrees that the first meaning of ADVANTAGE would be applicable to both marks, but asserts that the second meaning would not be applicable to the mark CLEAR ADVANTAGE.

We need not engage in a discussion of whether or not the mark CLEAR ADVANTAGE would convey the tennis score meaning of "advantage" to tennis players because there is no dispute that one meaning of ADVANTAGE they would perceive is that of a means favorable to success, and this meaning of ADVANTAGE would apply to applicant's mark. Moreover, the word CLEAR in applicant's mark does not change this meaning, but merely emphasizes it (an undoubted means favorable to success). Thus, in at least one sense the connotations of the marks are the same.

Applicant has also asserted that because ADVANTAGE has a meaning with respect to scoring in tennis, the registrant's mark has a narrow scope of protection. We find, on this record, that the mark is only somewhat

⁹ The Examining Attorney withdrew her requirement for a disclaimer of the word CLEAR after reviewing applicant's argument that the mark was a double entendre.

¹⁰ Webster's College Dictionary.

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suggestive of tennis rackets or tennis products in general and further that, even if the mark were entitled to a more limited scope of protection than an entirely arbitrary mark, the protection extends to prevent the registration of the very similar mark CLEAR ADVANTAGE for identical goods.

Having found that applicant's mark should be refused registration based on Registration No. 956,094 for ADVANTAGE for tennis rackets, we will discuss only briefly the other cited registrations.

Registration No.1,743,965 is for tennis balls. Applicant's tennis rackets are related to tennis balls in that they are obviously complementary products which would be sold through the same channels of trade to the same class of purchasers. Our discussion of the similarity of the marks in connection with the ADVANTAGE registration for tennis rackets applies as well to the mark ADVANTAGE for tennis balls. Consumers who are familiar with ADVANTAGE for tennis balls are likely to assume that CLEAR ADVANTAGE tennis rackets emanate from the same source.

Applicant's mark CLEAR ADVANTAGE is also likely to cause confusion with Registration No. 1,182,311 for racquetball racquets. Tennis rackets and racquetball

racquets¹¹ are very similar products, the primary difference being that a racquetball racquet is somewhat smaller than a tennis racket. Consumers are likely to believe that the same company makes both products if they were sold under confusingly similar marks. And the marks CLEAR ADVANTAGE and ADVANTAGE are, for the reasons given above, confusingly similar.

In his brief applicant has raised the concern that the Examining Attorney's position is, in part, based on an erroneous finding that the registrant, Wilson Sporting Goods Co., has a proved house mark or family of trademarks in the mark ADVANTAGE. Whatever the Examining Attorney's views may be on this matter (and there is certainly no evidence in the record to support her point that the registrant is "a well known entity in the sporting goods industry," brief, p. 4), we confirm that our finding of likelihood of confusion is not based on any such premises. In fact, the concept of a family of marks can in no way be applicable, in that the cited registrations are all for only a single mark, ADVANTAGE.¹²

¹¹ "Racquet" is an alternative spelling for "racket".

¹² We would also point out that, even if a registrant owned a number of different marks which all contained a common element, a family of marks cannot be demonstrated simply by the fact of ownership alone. To prove a family, it must be shown that the marks are promoted together in such a way that the public would come to associate them with a single source.

Finally, we reverse the refusals of registration based on the cited registrations for golf balls, golf clubs and soccer balls. Although these products, and applicant's identified tennis rackets, are all sporting goods, the fact that a single term may be used to describe the goods is not sufficient to support a finding of likelihood of confusion. See **General Electric Company v. Graham Magnetics Incorporated**, 197 USPQ 690 (TTAB 1977); **Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.**, 188 USPQ 517 (TTAB 1975). The Examining Attorney has put no evidence in the record to demonstrate that tennis rackets on the one hand, and golf balls, golf clubs and soccer balls, on the other, are related goods. She has merely cited three cases for the proposition that "different products in the sporting goods field are related under Section 2(d)." Brief, p. 6. However, a review of those cases reveals the facts and/or records are different from the record herein. For example, in **In re New Archery Products Corp.**, 218 USPQ 670, 671 (TTAB 1983), the Board found that "fishing lures and arrowheads are closely related, both being sporting goods used in the closely related sports of fishing and hunting." The goods involved in that case were significantly different from the goods at issue herein, and the finding was based not just on the fact that the goods

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were sporting goods, but that they were used in closely related sports. Similarly, in **Trak Inc. v. Traq Inc.**, 212 USPQ 846 (TTAB 1981), the opinion is replete with references to the fact that there is substantial evidence in the record. For example, at page 851 is the statement, "Here, we conclude that a significant relationship has been demonstrated by the evidence."

Decision: The refusals with respect to Registrations Nos. 956,094; 1,182,311; and 1,743,965 are affirmed; the refusals with respect to Registrations Nos. 1,224,423; 1,738,474; and 2,112,471 are reversed.