

**This Opinion
is Not Citable as
Precedent of the TTAB**

7/23/02

Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mark C. Andrews

Serial No. 75/781,752

Douglas J. McEvoy of Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C. for Mark C. Andrews.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Simms, Hohein and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Mark C. Andrews has filed an application to register
the mark shown below in International Class 25 for goods
identified as "wearing apparel, namely, T-shirts, pants,
shirts, hats, caps, coats, vests, socks and shoes."¹

¹ Serial No. 75/781,752, filed August 20, 1999, based on
applicant's allegation of a bona fide intention to use the mark
in commerce.



The application includes a disclaimer of OUTWEAR. The design element, which may not be particularly clear in the reproduction above, is an illustration of a pine tree.

The examining attorney has refused registration of applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of the prior registration, also in Class 25, of the mark NORTHERN APPAREL for goods identified as "men's, women's and children's clothing, namely, outerwear, coats, jackets, anoraks, suits, blazers, sport jackets."² The registration includes a disclaimer of APPAREL.

When the examining attorney made the refusal of registration final, applicant appealed. Both applicant and the examining attorney have filed briefs, but an oral argument was not requested. We affirm the refusal.

² Registration No. 2,403,327, issued November 14, 2000, based on an application filed December 8, 1998, and lists a date of first use and first use in commerce of September 30, 1996.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks, the overlap in the goods, i.e., both identifications list "coats," and the relatedness of the remaining items. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The NORTHERN APPAREL mark is registered in typed form. Thus, we must allow for the possibility that registrant could display its mark in any reasonable manner or form of lettering, including the typeface employed by applicant. See *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971); *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235 (TTAB 1992); and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). Applicant argues that the design element that is included in his mark "adds a very distinctive and unique flavor." Applicant likens the significance of the design element in his mark to the significance of the portrait of Ernest Hemingway included

in the mark at issue in *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997). We agree with the examining attorney, however, that the circumstances of that case are distinguishable. There the design was large and a prominent element of the mark; and the notoriety of Ernest Hemingway added significantly to the connotation of the mark. In contrast, the design element in applicant's mark is relatively small, less distinctive³ and, consequently, does not contribute as much to the overall commercial impression of the mark as did the portrait of Ernest Hemingway to the commercial impression of the SLOPPY JOE'S mark.

Given the relatively small size of the design element in applicant's mark, we consider this a case where it is appropriate to follow the general rule that words are normally accorded greater weight when assessing the significance of a mark, because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by them to request the goods and/or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori*

³ We add that, insofar as applicant's mark includes the term OUTWEAR and applicant admits, brief p. 5, that applicant's goods are "specifically directed to hunting and [a] hunting theme" the tree design would be viewed as tending to suggest that the goods are appropriate for use in the woods or forest.

Tokeiten v. Scuotto, 228 USPQ 461, 462 (TTAB 1985). See also: *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

Finally, we note that each mark includes the term NORTHERN and a second, disclaimed term. Disclaimed or descriptive terms, though they must be considered when comparing marks, typically are less significant. *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1003-04 (Fed. Cir. 2002).

The principle is well established that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In the case at hand, both marks derive the greatest share of their distinctiveness from the use of the term NORTHERN. Moreover, the connotations of the marks, considered in their entireties, are quite similar, insofar as the disclaimed terms do not change the connotation of

each mark as indicative of clothing from, or for use in, Northern climes. The minor design element in applicant's mark does not change this connotation and may indeed reinforce it.

In sum, the overall commercial impressions created by the marks are similar and consumers are not likely to differentiate the marks based on the different disclaimed words or applicant's inclusion of a small design element. Moreover, in reaching this conclusion, we are mindful that the test, when comparing marks, is not a side-by-side comparison, which consumers may not have the opportunity to make, see *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255, 259 (TTAB 1980), and that consumers' recollection of marks used on or in connection with general merchandise or services is somewhat fallible. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd.* (No. 92-1086 Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353, 355 (TTAB 1975).

Turning to the respective goods, we reiterate that the identifications of applicant's and registrant's goods include coats, so the goods are, in part, the same.⁴

⁴ When the goods of the parties are directly competitive, the degree of similarity in the marks necessary to conclude that

Moreover, the examining attorney has made of record numerous use-based third party registrations showing that the various other clothing items listed by applicant and registrant are products that may emanate from the same source under a single mark. The probative value of such evidence is settled. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999), *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993), *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Thus, applicant's argument that most of his clothing items are different from most of registrant's clothing items is not persuasive support for finding no likelihood of confusion. The items are of a general type and consumers would think that they had the same source or sponsorship if marketed under the same or similar marks.

Applicant, in regard to channels of trade for the involved goods, admits that the identifications "speak for themselves" but notes that his goods are directed to hunting and a hunting theme.⁵ Brief p. 5. We agree, to the

confusion among consumers is likely is not as great as when there are differences in the goods. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1773 (TTAB 1992).

⁵ In a response to an earlier Office action, applicant stated "reference is again made to the statements in the Declaration of Mr. Su which establish that the marks are applied to indeed

extent that the focus is on the identifications and not any restrictions that are not included therein. *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Interstate Brand Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1913 (TTAB 2000). Thus, for the purpose of our analysis, the goods must be deemed to include the listed items of apparel without restrictions as to types or channels of trade. Therefore, the involved goods are considered to be marketed to the same class of consumers through the same channels of trade.

Applicant argues that his mark is now in use and there have been no instances of actual confusion in approximately one year of continuous use. We have no evidence regarding the extent of use or sales by either applicant or registrant and discount the mere argument presented by applicant. See *Ranir, supra n.4*, 23 USPQ2d at 1774. Moreover, even if we presumed that the goods have been sold in the same outlets, so that there would have been an opportunity for confusion to arise, we have not heard from

different (wholesaler/retailer v. retail customer) channels of trade." There was, however, no reference in the earlier response, or earlier in the response from which we quote this statement, to any such declaration; and no such declaration is of record. We consider the statement to have been included in error.

registrant, whose experience may be different than applicant's.

There is one final point made by applicant that we now address. That is, applicant argues that his "development of commercial rights in its mark, while relatively minor at present, is believed to have conferred upon it some degree of rights to exclude others from use of its mark on similar goods, and in particular those in close geographic proximity." Brief pgs. 5-6. Insofar as applicant may be alluding to a claim that he has some concurrent use rights vis a vis registrant, that question is not now before us. We note, in any event, that a jurisdictional requirement for a concurrent use application is that an applicant would have to be able to claim use of its mark in commerce prior to the filing date of the application that matured into the cited registration. See TBMP § 1102.02(a)(2). Insofar as applicant's arguments suggest that he has only made use of his mark for approximately one year prior to briefing the appeal, such use having begun after the filing of his application, applicant does not appear able to meet this jurisdictional requirement for a concurrent use application.

In view of the similarity of the involved marks' commercial impressions, the overlap in the goods and

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relatedness of others, the presumptively similar channels of trade and classes of consumers, we find there to exist a likelihood of confusion or mistake by consumers.

Decision: The refusal of registration under Section 2(d) is affirmed.