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THIS DISPOSITION IS NOT
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THE TTAB

Paper No. 9
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Sporting Goods Corporation

Serial No. 75/905,719

Michael A. Painter of Isaacman Kaufman & Painter for
American Sporting Goods Corporation.

Radhika P. Raju, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney).

Before Hairston, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

American Sporting Goods Corporation sought to register
the following composite mark:



on the Principal Register for "clothing, namely,
skateboarding T-shirts, sweatshirts, fleece sweatshirts and
jackets, sweatpants, pants, water resistant and waterproof

pants, gloves, jackets, insulated pants and jackets, button-up and button-down pants and shirts, baseball caps, headbands, and footwear,"¹ in International Class 25.

This case is now before the Board on appeal from the final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has held that applicant's mark, as used in connection with skateboarding clothing, so resembles the trademark shown below:



registered for "men's and women's sportswear, men's and women's casual wear or club wear, men's and women's street wear, namely, t-shirts, sweatshirts, sweaters, shirts, jackets, hats, caps, scarves, trousers, pants, jeans, shorts, skirts, dresses; accessories for trousers or shorts, namely, belts, excluding footwear," in International Class

¹ Application Serial No. 75/905,719 was filed on January 28, 2000, based upon applicant's allegation of a *bona fide* intention to use the mark in interstate commerce.

25,² as to be likely to cause confusion, to cause mistake or to deceive.

Responsive to the refusal to register, applicant argues: that the word "Nice" is weak in the clothing field; that when properly considered in their entireties, these two composite marks are not confusingly similar; and, that there is no overlap between registrant's general clothing items and applicant's specialized skateboarding clothing.

On the other hand, the Trademark Examining Attorney argues: that applicant's mark is highly similar to registrant's mark; that the goods are identical, in part, and otherwise closely related; and that the correct presumption is that both registrant's and applicant's goods will move in the same channels of trade.

Both applicant and the Trademark Examining Attorney have fully briefed the case. However, applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth each factor that should be considered,

² Reg. No. 2,235,605, issued on March 30, 1999.

if relevant information is of record, in determining likelihood of confusion.

Turning first to the similarities/dissimilarities in the marks, we note the argument in favor of similarity made by the Trademark Examining Attorney, as follows:

...[A]pplicant's proposed mark and the registered mark create the same commercial impression since the dominant portion of both marks is the word NICE and since both marks have a similar arrangement of design and lettering.

(Examining Attorney's appeal brief, unnumbered p. 5).

We agree with the Trademark Examining Attorney that the shared term NICE is the dominant feature of both marks, that the term, when used without other words, appears to have the same suggestive connotation for both applicant's and registrant's clothing items, and nothing that applicant has submitted for the record demonstrates otherwise.³ As to the sound of the two marks, the word "Nice" is how consumers would call for the goods of registrant and of applicant. Consumers would likely not attempt to articulate the large

³ The printouts of the search results for registered marks in the clothing field containing the word "nice" were submitted along with applicant's appeal brief, and hence were untimely. The record must be complete prior to the time of the appeal. See, 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). The Trademark Examining Attorney correctly objected to this tardy submission of third-party registrations, and we have not considered them in reaching our decision. However, we hasten to add that even if we had considered them, it would not have changed our decision herein.

letter "N" in applicant's mark or the star designs in registrant's mark. Finally, as noted by the Trademark Examining Attorney, in spite of obvious visual differences in the two composites, both have design features in the top portion of the mark with the word NICE immediately beneath the respective design components.

Accordingly, when comparing these two marks by applying the traditional sight/sound/meaning trilogy, we find that both marks create similar overall commercial impressions.

Turning next to the relationship of the goods, applicant and the Trademark Examining Attorney have reached quite different conclusions on this factor as well. Applicant argues that there is neither overlap nor any relationship between clothing for general purposes and clothing used for skateboarding:

The amended list of Appellant's goods have no legal relationship to those identified in the '605 registration. In determining likelihood of confusion, goods will be deemed to be identical only if there is an overlap in the goods recited in the Certificate of Registration and the application. It is submitted there is no overlap in the goods identified in the application, as amended, and the cited registration...

... Where the goods, users and channels of trade employed to sell the respective goods are totally divergent, there is no relationship between the goods sufficient to refuse registration... .

(Applicant's appeal brief, pp. 7, 8).

By contrast, the Trademark Examining Attorney argues that the cited registration lists clothing items broadly and without limitation as to nature, type, channels of trade or classes of purchasers.

Despite the fact that applicant has amended its listing of clothing items (presumably intending to limit all the listed goods to "skateboarding" items), this clarification contains no restrictions as to channels of trade. Moreover, judging from the pictures of skateboarding pants, skateboarding shirts and skateboarding caps displayed on Web pages reproduced from a variety of third-parties' Web sites, these "specialized" items of clothing for skateboarders do not differ from pants, shirts and caps intended for teens and young adults involved generally in outdoor activities. The obvious similarity among all of these skateboarding items is the prominent display of the brand names targeted to skateboarders. On the other hand, as to material construction, basic design, etc., these items of clothing, seem from this record, to be identical to general activewear intended for non-skating teens and young adults. Finally, even if applicant is deemed to market skateboarding clothing exclusively, and registrant is considered to market general clothing not suitable for skateboarding, the same consumers

may be exposed to the marks in circumstances that may well lead them to conclude that variations of the same mark are being used for related clothing lines intended for slightly different uses.

As noted by the Trademark Examining Attorney, there are no limitations on channels of trade in the registration or in this application. Presumably, then, both applicant's and registrant's goods would be sold in skateboard shops, sporting goods stores, and even general department stores that market clothing items such as t-shirts, sweatshirts, jackets and pants to skateboarders and to others. Accordingly, we find that the goods are identical in part, and that the balance of the goods are closely related, and that the clothing items of registrant and of applicant will move in the same channels of trade to the same class of consumers.

Applicant points out that it already owns Registration No. 2,360,509⁴ for another special form mark, as shown below:

⁴ The assignment branch of the USPTO has recorded at reel 2070, Frame 0044 an assignment of this registration from the original registrant, Niceprod, Ltd., a New York corporation, to American/Niceprod, Inc., a Delaware corporation. However, while the latter seems to share the same address as applicant, American/Niceprod, Inc., appears to be a separate corporate entity from American Sporting Goods Corp. - the applicant herein. Nonetheless, for the sake of argument, we accept applicant's claim of ownership.



This mark is registered for and, according to applicant, is used in conjunction with an array of clothing items, shoes and accessories. In addition to the fact that the registration file for that mark is not before us, it is obvious that this is an entirely different mark.⁵ Each case before this Board must stand on the unique facts of its own record. Accordingly, this prior registration is not persuasive of a contrary result.

Finally, to the extent that there remains any doubt on the issue of likelihood of confusion, it is well established that such doubt must be resolved against the newcomer and in favor of the prior user and registrant. See In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal to register is affirmed.

⁵ We also note that inasmuch as this registration reflects a disclaimer of the words "Nice skate shoes," its existence on the federal trademark register is hardly a compelling factor in favor of registration herein. The disclaimer may well have influenced the Trademark Examining Attorney's decision to allow registration of this mark, despite the prior registration of the mark now cited against applicant.