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Mailed: 07 JUN 2002
Paper No. 12
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peter Kaveh

Serial No. 75/920,311

Gary F. Wang of Sheldon & Mak PC for Peter Kaveh.

George M. Lorenzo, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On February 4, 2000, Peter Kaveh (applicant) filed an application to register the mark SKY (in typed form) for goods ultimately identified as "men's and women's clothing, namely, shirts, pants, shorts, skirts, T-shirts, dresses, jackets, and sweaters" in International Class 25.¹ The application alleges a date of first use and a date of first use in commerce of November 15, 1997.

¹ Serial No. 75/920,311.

The examining attorney finally refused to register the mark under Section 2(d) of the Trademark Act because of a registration of the mark SKY SKI (in typed form) for "clothing, namely, jackets, hats, gloves, and swimwear" in International Class 25.² 15 U.S.C. § 1052(d). The examining attorney determined that there would be a likelihood of confusion when the marks SKY and SKY SKI are used on the identified goods.

After the examining attorney made the refusal final, this appeal followed. Both applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney's position is that "Here, the registrant disclaimed 'SKI' from its mark. As such, the identical word 'SKY' plays the largest role in creating the commercial impression of each mark; it is clearly the dominant portion." Examining Attorney's Br. at 3. The examining attorney also points out that both registrant's and applicant's identification of goods include the term "jackets" and thus the goods are "identical in part and closely related." Id. at 7. Furthermore, the examining

² Registration No. 2,286,592 issued on October 12, 1999. The registration contains a disclaimer of the word "ski." The registration also contains a second class of goods: "Sporting goods, namely, a sit-down hydrofoil device attached to a water ski for supporting a user while being towed by a power boat on water" in International Class 28.

attorney provided evidence to suggest that the goods of the type identified in the application and cited registration may emanate from the same source.

Applicant, on the other hand, finds the marks "are strikingly dissimilar as compared in their entireties" and "even the goods rendered under the marks at issue are strikingly dissimilar." Applicant's Br. at 5. Applicant emphasizes the importance of the word "ski" and argues that "it would appear unlikely that a consumer would envision that SKY SKI was in the business of selling men's and women's clothing unrelated to 'ski' as what the goods are sold under the pending mark." Id. at 7. "The description of the goods sold under the mark SKY SKI tells us that the products using the marks are related to water ski activities." Id. at 10. Although applicant concedes that "there is some overlap in these goods ... possible overlap must be given only minimal or no weight in the analysis for the likelihood of confusion." Id. at 10-11. Applicant concludes by arguing that the marks convey dramatically different commercial impressions and that "a finding of likelihood of confusion cannot be found."³

³ Applicant refers to several other registrations for marks containing the word "sky." The examining attorney has objected to the list of registrations in applicant's appeal brief. While normally it is not proper to include a list of registrations in an appeal brief, this list is identical to a list that applicant

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We affirm the refusal to register under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d).

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by discussing whether the involved goods are related. We must consider the goods as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of

included in its response dated February 22, 2001, to the examining attorney's first Office action. The examining attorney did not object to that list of registrations or advise applicant that a mere listing of registrations is not sufficient to make them of record, and that to do so copies of the registrations must be submitted. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"); See also In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994); In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). We, therefore, deem the examining attorney to have waived any objection to the list, and accept it for whatever probative value it may have.

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likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services [or goods] recited in applicant's application vis-à-vis the ... services [or goods] recited in [a] ... registration, rather than what the evidence shows the ... services [or goods] to be"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

In this case, both applicant's and registrant's goods include jackets, so we agree with the examining attorney that the goods are, at least in part, identical. In addition, we have no basis to find that the channels of

trade or the purchasers of applicant's and registrant's jackets would be different. Applicant argues that registrant's goods "are related to water ski activities," and are therefore sold in specialty sport stores. Applicant's Br. at 10-11. We will not read limitations into the identification of goods based on assumptions drawn from other goods in the cited registration. As discussed above, we are constrained to consider the issue of likelihood of confusion based on the goods identified in the application and registration. See Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of Squitco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The board, thus, improperly read limitations into the registration").

While the cited registration has a water ski-related item in International Class 28, this does not mandate that the clothing in International Class 25 is limited to water ski-related clothing or is sold in sports stores different from where applicant's goods can be sold. Just as the soft drink producer in Squirtco was not limited to balloons that were used as promotional items, nothing in registrant's identification of goods limits the goods to water ski-

related clothing or any particular type of jackets. Even if some of the clothing is "ski-related," it certainly does not mean that all the clothing must be related to water skiing. We also note that applicant's identification of goods does not exclude water ski-related jackets. Therefore, applicant's and registrant's goods are legally identical in part.

We now turn to the issue of the similarity of the marks. "If the services [or goods] are identical, 'the degree of similarity necessary to support a conclusion of likelihood of confusion declines.'" Dixie Restaurants, 41 USPQ2d at 1534, quoting, Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Here, since the goods are, at least in part, identical, it is clear that the marks do not have to be as similar. The only difference between the marks in this case is that the registrant's mark SKY SKI includes the additional word "ski," which registrant has disclaimed. We agree with the examining attorney that "sky" would be the dominant portion of both marks and that the additional word "ski" does not substantially change the commercial impressions of the marks. There is little difference between the mark SKY for jackets and SKY SKI for jackets. "[T]here is nothing improper in stating that, for rational

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reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Furthermore, the test is not whether the marks can be distinguished in a side-by-side comparison, Grandpa Pidgeon's of Missouri v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973), but whether they are sufficiently similar in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result. Here, the marks would be pronounced identically, but for the additional word, "ski" in registrant's mark. The overlapping word "sky" would have the same meaning and the marks would appear very similar. The presence or absence of the word "ski" would not significantly change the commercial impression of the marks. See Dixie Restaurants, 41 USPQ2d at 1534 (holding that THE DELTA CAFE and design was confusingly similar to DELTA; more weight given to common dominant word DELTA). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977)(CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products). Prospective customers who are familiar with registrant's

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SKY SKI jackets and other clothing items are likely to assume that applicant's SKY jackets and related clothing items originate from the same source.

Finally, we briefly mention the registrations that applicant has identified by registration number, mark, and International Class. This evidence has little probative value. Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1622 (TTAB 1989) ("Third-party registrations are of little weight in determining likelihood of confusion"). A list of marks, registration numbers, and classes, does not demonstrate that a mark is weak. The fact that there is more than one mark in an International Class of goods or services that includes the same word is hardly significant. This list certainly provides no justification to register the mark SKY when there is an existing registration for the mark SKY SKI for the same and related goods. Even if the mark in the registration is a weak mark, it is still entitled to protection from other confusingly similar marks used on the same and related goods. In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982).

Inasmuch as the goods are identical and the marks SKY SKI and SKY create similar commercial impressions, there is a likelihood of confusion.

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Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.