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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re School Apparel, Inc.

Serial No. 75916875

E. Lynn Perry of Townsend and Townsend and Crew LLP for
School Apparel, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

School Apparel, Inc. (applicant), a California
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark VIRTUAL
UNIFORMS ("UNIFORMS" disclaimed) for "clothing, namely,
school and career uniforms comprising jackets, sweaters,
pants, slacks, shorts, shirts, blouses, skirts, culottes,

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jumpers, shifts, vests and socks.”¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 2,366,597, issued July 11, 2000, for the mark VIRTUAL for “clothing, namely, jackets, shirts, pants, T-shirts, shorts and jeans.” Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.

We affirm.

The Examining Attorney argues that the only difference in the respective marks is the descriptive and disclaimed word “UNIFORMS” in applicant’s mark, and that the dominant part of applicant’s mark is the word “VIRTUAL.” It is the Examining Attorney’s position that this dominant word, which is the only word in registrant’s mark, is a strong and arbitrary word as applied to clothing and is entitled to a broad scope of protection. There is no evidence that the word “VIRTUAL” has a different meaning in the marks, and the differences in the marks are not sufficient to create different commercial impressions, according to the Examining Attorney.

With respect to the goods, the Examining Attorney maintains that registrant’s and applicant’s goods are

¹ Application Serial No. 75916875, filed February 11, 2000, based on applicant’s allegation of a bona fide intention to use the mark in commerce.

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clothing and that registrant's description of goods ("clothing, namely...") is without limitation and is therefore broad enough to encompass applicant's school and career uniforms. Furthermore, because there is no limitation in either description as to the channels of trade, both registrant's clothing items and applicant's school and career uniforms could be sold in clothing and department stores, according to the Examining Attorney. The Examining Attorney has also made of record several use-based third-party registrations which issued for, on the one hand, such items as T-shirts, shirts, jackets, shorts, pants and other items of apparel and, on the other, school uniforms. It is the Examining Attorney's position that this evidence shows that the same manufacturer may make the goods of both parties and sell them under the same mark. Both registrant's items of clothing and applicant's school and career uniforms could be sold to the same potential consumers through the same retail stores, the Examining Attorney argues.

Applicant, on the other hand, argues that the respective marks are substantially different in sound, appearance and connotation. In this regard, applicant argues that its mark, VIRTUAL UNIFORMS, suggests applicant's intent to sell its uniforms over the Internet,

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and that registrant's mark VIRTUAL does not suggest or connote uniforms or even clothing. Applicant also argues that "VIRTUAL" is a weak, "descriptive" term which would not be relied upon by consumers in distinguishing marks, and is therefore entitled to a limited scope of protection. In support of this argument, applicant submitted a list of third-party registrations with its appeal brief, to which the Examining Attorney objected in his brief.²

With respect to the goods, applicant argues that the goods are "not proximate or interchangeable and serve different purposes and markets." Brief, 6. It is also applicant's position that these goods are not likely to be sold in the same channels of trade by the same retailers

² Because this evidence should have been made of record before the appeal was filed, and because the Examining Attorney objected to the reference to these registrations, we have not considered them. See Trademark Rule 2.142(d).

Although applicant did not mention them in its brief, with its first response filed January 10, 2001, applicant listed other third-party applications and registrations which include the word "VIRTUAL," all by application serial number. These include, according to Office records, the registered marks VIRTUAL WEARALITY for T-shirts, caps and hats (Reg. No. 1,956,689, issued February 13, 1996, Section 8 accepted); VIRTUAL WARRIORS for T-shirts (Reg. No. 1,876,711, issued Jan. 31, 1995, now cancelled under Section 8); and VIRTUAL REALITY for mugs and various items of apparel (Reg. No. 1,889,092, issued April 11, 1995, now cancelled under Section 8). The Examining Attorney did not object to this listing, and we have considered the extant registered mark for whatever probative value it may possess on the issue of the weakness of the registered mark VIRTUAL for clothing. We note that third-party registrations are not evidence of what happens in the marketplace, and we cannot presume from their existence that the relevant public is aware of them.

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and, if so, are probably not sold in the same sections of those stores, and are not used by the same consumers. Further, applicant argues that school uniforms are generally purchased by parents of school-age children, while career uniforms are generally purchased by employers. The parents would purchase the school uniforms after some deliberation, applicant maintains.

Our determination under Section 2(d) of the Act is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on the likelihood-of-confusion issue. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations are the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that confusion is likely.

Turning first to the marks, it is well settled that marks must be considered in their entirety as to the similarities and dissimilarities of the marks. However, our primary reviewing Court has held that, in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another in creating a commercial impression. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

When the respective marks are compared in their entirety, the word "VIRTUAL" is clearly the dominant or more significant part of applicant's mark, the less significant feature being the generic and disclaimed word "UNIFORMS." The marks VIRTUAL and VIRTUAL UNIFORMS, except for the generic word, have obvious similarities in sound, appearance and commercial impression.

With respect to the goods, it is settled that they need not be identical or even competitive to support a

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finding of likelihood of confusion, it being sufficient instead that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978). See also *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)("[E]ven if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services"); and *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.").

The Examining Attorney has adequately demonstrated, by submitting copies of several third-party registrations, the relationship between registrant's items of apparel and

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applicant's school and career uniforms, which include items which are also listed in registrant's identification of goods--jackets, pants, shorts and shirts. In this regard, while use-based third-party registrations are not evidence that the different marks shown in the registrations are in use or that the public is familiar with them, such registrations may nevertheless have some probative value to the extent that they serve to suggest that the goods and services listed are of a kind which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988). The third-party registrations of record tend to show that the same manufacturer may make both certain items of wearing apparel, on the one hand, and school uniforms on the other.

While there is no specific evidence of record relating to the channels of trade or types of stores in which the respective goods may be sold, we agree with the Examining Attorney that applicant's and registrant's clothing may well be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that all of these goods come from the same source. Indeed, it is entirely conceivable that a purchaser, aware of

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registrant's VIRTUAL clothing, who then encounters applicant's VIRTUAL UNIFORMS school and career uniforms, either in the same store or in a different clothing store, or even through catalog or Internet shopping, may well believe that applicant's uniforms are a new line of registrant's clothing sold under the VIRTUAL mark, viewing the word "UNIFORMS" in the mark as merely the generic term for the goods.

Decision: The refusal of registration is affirmed.