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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HMS Motorsports LLC

Serial No. 78155921

Karl S. Sawyer, Jr., of Kennedy Covington Lobdell &
Hickman, LLP for HMS Motorsports LLC.

Susan Kastriner Lawrence, Trademark Examining Attorney, Law
Office 116 (Meryl L. Hershkowitz, Managing Attorney).

Before Quinn, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, seeks registration on the Principal
Register of the following mark:

The image shows the number '48' in a bold, stylized, italicized font. The digits are thick and have a slight shadow effect, giving them a three-dimensional appearance. The '4' and '8' are connected at the top.

for goods identified in the application, as amended, as
follows:

"motorsports racing souvenirs and memorabilia, namely,
printed paper signs, calendars, trading cards, decals,
bumper stickers, static decals, notebooks, posters,
mounted photographs, unmounted photographs,

lithographs, arts prints, post cards, binders, and school supplies, namely, folders, notebooks, ring binders, pencils, and spiral composition books, address books, paintings, books featuring racing themes, bumper stickers, calendars, cardboard boxes, coloring books, aquarium backdrops made of paper, commemorative sheets of trading cards, non-magnetically encoded credit cards, decals, erasers, writing tablets, limited edition pictorial prints, lithographic prints, paper magazine covers, decals for model cards, paper napkins, paper pennants, pens, paper identification tags, non-magnetically encoded telephone calling cards, framed photographs, daily planners, stationary-type portfolios, placemats made of paper, postcards, posters, static decals, stickers, paper table linens, framed trading cards, window decals, wireless subject notebooks, and plastic aquarium ornaments, distributed and sold to motorsports racing fans through specialized outlets featuring motorsports racing merchandise and paraphernalia" in International Class 16;

"clothing for motorsports racing fans, namely, belts, leather jackets, leather caps, cloth bibs, boxer shorts, button-down collar shirts, crewneck shifts, dresses, fashion shirts, golf shirts, gripper socks, bats, caps, infant shirts, jackets, jerseys, neckties, pants, polo shins, pullover shirts, rugby shirts, shoes, shorts, socks, sunsuits, suspenders, sweatpants, sweatshirts, T-shirts, tank tops, tank top dresses, toboggan type knit caps, trousers, turtle neck shirts, visors, wind resistant suits, infantwear, namely sleepwear and play suits, and outerwear, namely sweaters, jackets, and warm up suits, distributed and sold to motorsports racing fans through specialized outlets featuring motorsports racing merchandise and paraphernalia" in International Class 25; and

"motorsports racing souvenirs and memorabilia, namely, miniature toy cars made of pewter, hand-held units for playing electronic games, toy replica car and truck side portions of plastic, toy replica car and truck front end portions of plastic, toy replica hoods of plastic, toy replica trunk lids of plastic, Christmas tree ornaments, toy banks, toy tractor/trailers of metal and plastic, toy cars of plastic and metal, yo-yos, toy vehicle haulers, toy model cars and related accessories sold as a unit, toy trucks, wooden toy cars, miniature toy helmets, diecast toy cars, and diecast toy vehicle haulers, collectible miniature toy model vehicles, toy car model kits, action figures,

footballs, basketballs, latex balloons, fishing lures, tackle boxes, fishing rod holster, Christmas tree ornaments, except confectionery or illuminating ornaments, and baby rattles, distributed and sold to motorsports racing fans through specialized outlets featuring motorsports racing merchandise and paraphernalia" in International Class 28.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the following two registered marks, owned by two different registrants, as to be likely to cause confusion, to cause mistake or to deceive:

REGISTRATION No. 0555116 **48** (STANDARD CHARACTER DRAWING)
for "playing cards" in International Class 16²

REGISTRATION No. 2225249 **48 JEANS** (STANDARD CHARACTER DRAWING)
for "denim pants, denim shirts, knit shirts, T-shirts, baseball caps, footwear and jackets" in International Class 25.³

¹ Application Serial No. 78155921 was filed on August 20, 2002 based upon applicant's allegation of first use anywhere and first use in commerce in all these classes of goods at least as early as February 2002. This application, as filed, also contained goods and services in International Classes 6, 9, 12, 14, 18, 19, 20, 21, 24, 26, 35, and 41, which were not refused registration herein, and after a request to divide, have been moved into a divisional or "child" application Serial No. 78975619.

² Registration No. 0555116 issued on February 19, 1952 reciting a date of first use in commerce at least as early as 1895; Third Renewal.

³ Registration No. 2225249 issued on February 23, 1999 reciting a date of first use in commerce at least as early as May

Applicant and the Trademark Examining Attorney submitted briefs. Applicant did not request an oral hearing.

We affirm the refusals to register.

In arguing for registrability, applicant asserts that its mark creates an entirely different commercial impression from that of 48 JEANS; that items of designer denim clothing are distinctly different from automobile racing goods; that playing cards are not closely related to its listed goods in International Classes 16 and 28; and most importantly, that any potential confusion is highly unlikely because applicant has restricted its channels of trade to "specialized outlets featuring motorsports racing merchandise and paraphernalia."

By contrast, the Trademark Examining Attorney takes the position that applicant's mark is confusingly similar in appearance, sound and connotation to both of the cited registrants' marks; and that applicant's goods are highly related to the goods of the first registrant and legally identical to the goods of the second registrant.

1994. The word "Jeans" is disclaimed apart from the mark as shown. Section 8 affidavit accepted and Section 15 affidavit acknowledged.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. 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 relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Accordingly, we turn first to the du Pont factor focusing on the similarity of the marks in their entirety as to appearance, sound and connotation.

As to the cited mark for 48 JEANS, applicant argues that consumers are not likely to remember the source of designer denim clothing by the "48" portion of the registrant's mark, but will identify its clothing by the entire mark, 48 JEANS. Additionally, applicant contends that when one takes into consideration the differing contexts of applicant's and registrant's uses, "the commercial impression of the marks are completely and distinctly different." Applicant's brief, p. 5.

By contrast, the Trademark Examining Attorney argues against each of applicant's contentions, as follows:

The additional term in the registrant's mark, JEANS, is simply the generic term for the goods and has little or no trademark significance. It identifies the type of goods rather than the source of the goods; it is the number 48 which will be viewed as the source indicator and therefore most likely to be impressed upon the memories of purchasers. And it is this number - this portion - of the registrant's mark which is identical to the entirety of the applicant's mark.

Furthermore, because the registrant's mark is typed, there is nothing preventing the registrant from using its mark in a fashion which would appear nearly identical to the applicant's mark. For example, the registrant could present its mark with the number 48 looking exactly like the applicant's mark with the wording JEANS in very small letters below, barely discernible. In that instance, purchasers certainly would not be able to distinguish between the applicant's mark and the registrant's mark.

And finally, the applicant contends that when viewed in the context of their use, the commercial impressions of the marks are "completely and distinctly different." However, the type of goods on which the marks are used and the channels of trade through which the goods travel cannot be said to create the commercial impression of the marks....

The Trademark Examining Attorney acknowledges that a disclaimed portion of a mark may not be ignored when making a determination under Section 2(d) of the Act. However, she also notes the well-established principle enunciated by our principal reviewing Court that, in articulating reasons

for reaching a conclusion on the issue 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 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). She points out that "Jeans" is disclaimed in the cited registration, and that disclaimed matter is typically considered less significant.

As to the cited registration of the designation 48 alone for playing cards, the Trademark Examining Attorney points out that applicant offers no argument disputing the fact that its mark is substantially the same as this registrant's mark. We agree with the assessment of the Trademark Examining Attorney as to the similarity of these marks.

Accordingly, when applicant's applied-for mark is compared with each of the cited marks, we find that it is confusing similar in appearance, sound, connotation and overall commercial impression.

We turn next to the du Pont factor focusing on the relationship of the goods as described in the application and the goods covered by the cited registrations.

Applicant argues strenuously that inasmuch as it has amended its identification of goods in International Classes 16, 25 and 28 to make it clear that applicant's goods are sold through specific channels of trade (e.g., "motorsports racing [products] ... distributed and sold to motorsports racing fans through specialized outlets featuring motorsports racing merchandise and paraphernalia"), any potential confusion between applicant's mark and the registrants' marks is highly unlikely.

However, the Trademark Examining Attorney points out that although applicant has narrowed its identification of goods to limit its distribution to specialized outlets featuring motorsports racing products, neither of the registrants has placed any such limitations on their identifications of goods. Accordingly, we must presume that some portion of both of these registrants' goods could travel through the same or similar specialized outlets.

As to the specific goods in cited Registration No. 0555116, the Trademark Examining Attorney notes that registrant's goods simply include "playing cards," while applicant's goods in Classes 16 and 28 include trading

cards, decals and stickers, art prints and posters and other printed paper items, as well as toys and games.

The Trademark Examining Attorney has included in the record a sampling of third-party registrations showing that a single entity is likely to use the same mark for playing cards as well as for the type of goods applicant listed in both Classes 16 and 28. Similarly, retail ordering services located by the Trademark Examining Attorney on numerous third-party websites demonstrate that it is not unusual for playing cards to be marketed along with toy cars, action figures, and/or trading cards. Moreover, Internet evidence shows the popularity of a fairly uniform set of spin-off merchandise/collectibles (e.g., playing cards, trading cards, toy cars, action figures, etc.) displaying entertainment themes, including ones drawn from movies and television shows (e.g., "Hello Kitty," "Lord of the Rings," "The Simpsons," and "X-Men"). The websites featuring collectibles contain broad categories for easy browsing, the same sites having choices such as television shows, movies, video games and NASCAR racing teams.

As to the specific goods in cited Registration No. 2225249, the Trademark Examining Attorney notes that applicant's long list of goods includes clothing items

identical to those of registrant - e.g., pants, shirts, caps, shoes and jackets. As noted above, despite applicant's express limitations on its distribution channels, registrant's goods have no such limitation. Therefore, we must presume that registrant's goods may also travel through these same or similar specialized outlets. Nor are there any limitations in the identification of goods in the registration indicating that the registrant's goods are "more traditional items of wearing apparel marketed through traditional retail channels and outlets" (applicant's language).

Accordingly, based upon this entire record, we find that applicant's goods are closely related, or legally identical, to the respective goods of each of the registrants. As to a related du Pont factor, we agree with the Trademark Examining Attorney that they are likely to travel through the same channels of trade as the registrants' goods and be encountered by the same classes of purchasers. These prospective purchasers, upon viewing the substantially identical marks, would mistakenly believe they come from a single source.

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, while there

is no evidence on this point, certainly applicant's listed goods could include inexpensive items, and hence, presumably, they would not be directed to sophisticated purchasers.

We conclude that given highly similar marks, customers who are acquainted with applicant's mark for its listed goods would be likely to believe, upon encountering registrants' substantially identical marks for their playing cards and clothing items, that such goods emanate from, or are sponsored by or associated with, the same source. Thus, even given applicant's limited channels of trade, confusion remains likely as to the marks in both of the cited registrations.

In conclusion, we find that the marks are confusingly similar; that the goods are closely related, if not identical; and that in spite of applicant's limitations, all of these goods may well move through the same, or quite similar, specialized channels of trade to the same classes of consumers.

Decision: The refusal to register under Section 2(d) of the Act is hereby affirmed as to both of the cited registrations.