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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TSI Brands, Inc.

Serial No. 78243978

Michael R. Clogan of Strasburger & Price, LLP for TSI  
Brands, Inc.

Richard F. White, Trademark Examining Attorney, Law Office  
113 (Odette Bonnet, Managing Attorney).

Before Hohein, Bucher and Zervas, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

TSI Brands, Inc. seeks registration on the Principal  
Register of the mark **DEEP DYE** (standard character drawing)  
for goods recited in the application, as amended, as  
follows:

"clothing, namely shirts and slacks;  
menswear apparel items, namely, shirts and  
slacks" in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78243978 was filed on April 28, 2003 based upon applicant's allegation of first use anywhere and first use in commerce at least as early as January 15, 1996. Applicant has amended the application, claiming acquired distinctiveness for the involved mark under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register the 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 mark **DEEP DYE SELECT** (standard character drawing), which is registered for goods identified as "fibers for use in manufacturing fabrics, clothing and home furnishings" in International Class 24,<sup>2</sup> as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

In arguing for registrability, applicant contends that the marks are not confusingly similar because the words "Deep Dye" are highly descriptive as applied to registrant's goods and, hence, are correctly disclaimed. As a result, applicant argues that it is registrant's addition of the word "Select" that provides the composite

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<sup>2</sup> Reg. No. 2296878 issued to Courtaulds Fibers Inc. on November 30, 1999, and was later assigned to Acordis Cellulosic Fibers Inc., the current owner. The words "Deep Dye" are disclaimed apart from the mark as shown.

mark with trademark significance and hence would be the dominant element, creating a totally different commercial impression from applicant's mark. In fact, as contrasted with registrant's disclaimer of the words "Deep Dye," applicant claims that the record shows that it has created a significant level of acquired distinctiveness through its extensive use and promotion of its DEEP DYE mark. Applicant also contends that the marks are used in different channels of trade inasmuch as manufacturers of fibers for use in fabrics sell bulk products to finished goods manufacturers, like clothing manufacturers, with no overlap of customers herein. Applicant points to the extensive promotion and use of its mark without any reported instances of actual confusion.

By contrast, the Trademark Examining Attorney argues that the commercial impression created by applicant's DEEP DYE mark is highly similar to DEEP DYE SELECT, the registered mark, inasmuch as the words DEEP DYE comprise applicant's total mark and the dominant portion of registrant's mark. As to the goods, the Trademark Examining Attorney argues that applicant's identified goods are substantially related to the registrant's goods because registrant's identified goods, textile fibers, are

used in the manufacture of clothing, the type of goods marketed by the applicant.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on 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).

We turn first to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. Due to the consuming public's fallibility of memory, the emphasis is on the likely recollection of the average customer, who normally retains a general commercial impression rather than a specific impression of trademarks or service marks. Spoons Restaurants, Inc. v. Morrison, Inc., 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and In re Steury Corp., 189 USPQ 353 (TTAB 1975). On this du Pont factor, the Trademark Examining Attorney argues as follows:

The dominant feature of the registered mark DEEP DYE SELECT is the wording, DEEP DYE. This is because the term SELECT serves only to slightly modify the wording DEEP DYE. It appears highly unlikely that consumers calling for the registrant's goods will reference the term SELECT at the exclusion of the wording DEEP DYE.

To the contrary, applicant argues, as follows, that its mark is easily distinguished from the cited mark:

Focusing on the words "deep dye" in the previous registration is itself error, as there *is* no dominant part of a phrase mark which is registered (or sought to be registered) in block letters. See *In re Hearst Corp.*, 982 F.2d 493 [25 USPQ2d 1238] (Fed. Cir. 1992). In any event, however, the Examining Attorney noted that the words "deep dye" are highly descriptive. Accepting *arguendo* that they are, then it can only be the addition and inclusion of the word "Select" that gives them trademark significance at all to the previous registrant, and even then that significance can only be very weak.

It is of great importance that as TSI Brands has shown, its extensive use and promotion of DEEP DYE have caused the DEEP DYE mark to achieve secondary meaning, while the previous registrant disclaimed any source-identifying distinctiveness of that portion of its mark apart from its mark as shown. It is not the mere *fact* of the previous registrant's disclaimer that is compelling, but rather its *substance*: the previous registrant disclaimed that that those words in and of themselves were or would be source-indicative of its goods. The Applicant's mark has *become* distinctive. The previous registrant's never tried.

Applicant's appeal brief, p. 3, *emphasis* in original.

We have fully considered applicant's arguments, and concur that, because registrant's mark contains the word "Select," the marks at issue are somewhat different as to sound and appearance. However, the more prominent, first two words of registrant's mark do comprise the whole of applicant's mark. Even though the words "Deep Dye" appear to be descriptive of registrant's goods, and are therefore disclaimed apart from registrant's composite mark as a whole, we find it unlikely that a highly suggestive term like "Select" - especially appearing as the last word in this three-word term - can be said to be the dominant portion of registrant's mark. When compared in their entireties, we find that the respective marks are quite similar as to both connotation and commercial impression in light of the prominence of the common term, "Deep Dye." Hence, we find that these two marks are sufficiently similar that if they were contemporaneously used on related goods, confusion as to the source or sponsorship of such goods would be likely.

Accordingly, we turn next to the du Pont factor focusing on the relatedness of the goods as described in the application and the cited registration. The Trademark Examining Attorney argues that these goods are related by their very own terms, i.e., registrant's textile fibers

are used to manufacture clothing. Although the record contains no direct evidence from written publications, LEXIS/NEXIS computerized databases, the Internet, or the like, about the trade channels of these respective goods in the actual commercial marketplace, the Trademark Examining Attorney points to three third-party registrations of record where the same mark is used on "fibers" and on items of "clothing." Those registrations are:

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REGISTRATION NO. 2522979 **OPTIMER** (standard character drawing)  
for "yarn, textile, and synthetic fibers ..." and "clothing ..."

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REGISTRATION NO. 1861843 **HIGH PERFORMANCE ERMENEGILDO ZEGNA**  
(standard character drawing)  
for "fabric; namely, wool and other natural fibers for use in tailoring clothes and the clothing industry ..." and "clothing; namely, suits, sport jackets, pants and overcoats ..."

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REGISTRATION NO. 1849912 **PRIMALOFT** (standard character drawing)  
for "artificial textile fibers, down, stuffing, padding and filling materials ..." and "thermally insulated clothing; namely, gloves, thermal underwear, jackets, tops, trousers, hats, and coats."

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Although they are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, they do have probative value to the extent that they may serve to suggest that such goods are of a type which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The Trademark Examining Attorney also points to earlier cases of the Board in which similar marks for fibers were found to support a likelihood of confusion with finished clothing products (see e.g., E.I. du Pont de Nemours & Co. v. Sunlyra International Inc., 35 USPQ2d 1787 (TTAB 1995) [applicant's LYRA brand children's clothing related to opposer's LYCRA brand spandex synthetic fibers]). The Board found in that case that the fibers were advertised to the ultimate consumers of the involved children's clothing. Given that there are no trade channel restrictions in the instant registrant's identification of goods, it is possible that registrant similarly advertises its fibers to members of the general public.

While the evidence demonstrating a relationship of these goods, or pointing towards an overlap in the trade channels herein, is quite limited, we agree with the Trademark Examining Attorney that the consumer familiar with finished goods having a label or hang tag that contains the wording, "Made with DEEP DYE SELECT fibers," who later comes across applicant's DEEP DYE shirts or slacks, would think that there is a commonality of source between these goods.

As to the du Pont factor focusing on the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion, while applicant may not have encountered any instances of actual confusion despite claims of extensive promotion and use of its mark, these claims are without evidentiary significance given applicant's claims about the very limited extent, or even alleged discontinuation, of registrant's use of the cited mark. However, applicant has not filed a petition to cancel this registration, which at this time is still subsisting on the register.

In conclusion, we find that the marks are quite similar as to connotation and overall commercial impression, that these goods are related, and that under the circumstances of this case, an alleged absence of actual confusion is not probative of a contrary result on the question of likelihood of confusion.

*Decision:* The refusal to register this mark based upon Section 2(d) of the Lanham Act is hereby affirmed.