

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: 5/23/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re BlackIce by Design Inc.

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Serial No. 78228856

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Diane Green for BlackIce by Design Inc.

Anne Madden, Trademark Examining Attorney, Law Office 103  
(Michael Hamilton, Managing Attorney).

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Before Quinn, Walters and Rogers, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by BlackIce by Design Inc. to register the mark BLACK ICE NAKED for "infant, toddler, junior, misses, women's, men's and maternity clothing, namely sleepwear, shirts, blazers, raincoats, capes, jumpers, Bermuda shorts, athletic sweat suits, skirts, sandals, jackets, jeans, jerseys, jogging suits, knitted and woven tops and bottoms, leggings, leotards, lingerie, loungewear, mittens, night shirts, nightgowns, overcoats, pajamas, pants, pantsuits, panty girdles, panty hose, parkas, peignoir sets, polo shirts, pullovers, robes,

Ser No. 78228856

scarves, shawls, shorts, slippers, socks, sports bras, sport coats, suits, sweaters, sweatpants, sweatshirts, swimwear, tank tops, teddies, tennis shoes, thermal underwear, ties, tops, trousers, tankini, t-shirts, turtlenecks, undergarment thongs, undergarments, undergarment supports such as girdles, bodyshapers, undershirts, unitards, vests, warm-up suits, boots, dress shoes, bandannas, bathing suits, bathing trunks, bathrobes, beach thongs, bed jackets, belts, bike shirts and shorts, blouses, body briefs, boleros, boxer shorts, bras, bustier, camisoles, camp shirts, cardigans, casual and athletic footwear, chemises, coats, corsets, crop tops, dresses, dressing gowns, footwear, headbands, headwear, namely, hats, caps and visors, hosiery."<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark BLACK ICE for "outdoor camping apparel, namely, parkas, vests, mittens, and pants"<sup>2</sup> as to be likely to cause confusion.

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<sup>1</sup> Application Serial No. 78228856, filed March 23, 2003, based on an allegation of a bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1216820, issued November 16, 1992; renewed.

When the refusal was made final, applicant appealed.<sup>3</sup> Applicant and the examining attorney filed briefs.<sup>4</sup>

The examining attorney maintains that the marks are similar in that applicant's mark is dominated by the first two words of the mark, BLACK ICE, which happen to be the entirety of registrant's mark. The examining attorney also asserts that the cited mark is arbitrary for registrant's goods, citing to a dictionary definition.<sup>5</sup> As to the goods, the examining attorney contends that the goods are, in part, legally identical, pointing out that applicant's identification of goods is not limited; thus, certain items listed therein must be assumed to encompass clothing items for camping. In her attempt to establish a connection between applicant's and registrant's goods, the examining attorney submitted third-party registrations showing that each entity has registered a single mark for the types of

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<sup>3</sup> The final refusal also was based upon Registration No. 2189636 for the mark BLACK ICE for "sweaters, hats [and] gloves." A check of Office records shows that this registration was cancelled by the Office on June 18, 2005 for failure to file a Section 8 affidavit of continued use. This registration was owned by the same entity that owns the subsisting registration. Inasmuch as Registration No. 2189636 was cancelled, the registration no longer acts as a bar under Section 2(d), and the appeal relating thereto is moot.

<sup>4</sup> Applicant, in a paper filed March 1, 2006, specifically indicated that applicant "wish[ed] to waive the oral hearing."

<sup>5</sup> Pursuant to the examining attorney's request in her brief, we take judicial notice of the definition of "black ice." (see infra).

goods involved herein.

Applicant argues that it has created a "micro-family of marks" (comprising other "NAKED" marks, such as NAKED ATTRACTION, NAKED FANTASY and NAKED INNOCENCE) that will be marketed in commerce so that its applied-for mark will never be isolated in the marketplace. Applicant contends that its mark and registrant's mark are dissimilar in sound, appearance, connotation and overall commercial impression. More specifically, applicant contends that the addition of the term NAKED in its mark is so jarring that consumers will not associate the mark BLACK ICE NAKED with registrant's mark BLACK ICE. Regarding the goods, applicant asserts that it will sell its goods on the Internet, and that registrant does not and will not have any affiliation with this website. In support of its position, applicant submitted a dictionary definition of the term "naked," and an article retrieved from a printed publication.<sup>6</sup>

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<sup>6</sup> Applicant also submitted a copy of an unpublished decision of the Board. Applicant further made reference to four third-party registrations that have coexisted on the register.

The decision submitted by applicant is designated "not citable as precedent." Thus, this decision is not citable and it has not been considered in reaching our decision. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992); and TBMP § 101.03 (2d ed. rev. 2004).

Likewise, the third-party registrations cited by applicant have not been considered because they were not properly made of record. To make a third-party registration of record, either a

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to consider the goods. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490,

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copy of the USPTO paper record, or a copy taken from the electronic records of the USPTO, should be submitted. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n. 2 (TTAB 1998).

We hasten to add that, even if all of the above were considered, the material would not compel a different result in this appeal.

1 USPQ2d 1783 (Fed. Cir. 1992). Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Further, it is not necessary that the respective goods be identical or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

We acknowledge, at the outset of our consideration of this du Pont factor, that there is no *per se* rule governing likelihood of confusion in cases involving clothing items. In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984). Nevertheless, based on the identifications of goods and the evidence relating to this factor, we find that the similarity between the goods weighs in favor of affirmance of the refusal.

As indicated above, registrant's goods are identified as "outdoor camping apparel, namely, parkas, vests, mittens and pants." Applicant's identification of goods includes, in pertinent part, "parkas," "vests," "mittens" and "pants." Applicant's attempt to distinguish its clothing items from the camping apparel items covered by the cited registration is not persuasive. Applicant's "parkas," "vests," "mittens" and "pants" are not limited in any way as to nature, type, use or purpose and, thus, are broad enough to encompass parkas, vests, mittens and pants worn while camping. When construed as such, the goods are legally identical. We further find that certain of applicant's goods, such as jackets, overcoats and jeans, are related to registrant's apparel. Likelihood of confusion must be found if there is likelihood of confusion involving *any item* that comes within the identification of

goods in the involved application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).<sup>7</sup>

Given that applicant's parkas, vests, mittens and pants are construed to include all types of those items, including ones intended for outdoor camping, we assume that these goods travel in the same channels of trade for registrant's goods (e.g. department stores, on-line retailers, specialty retailers),<sup>8</sup> and that applicant's and registrant's goods are bought by the same classes of purchasers.

In connection with this du Pont factor, the examining attorney introduced four third-party registrations showing that each entity adopted a single mark for a wide variety of clothing items, including some of the items of the type involved herein. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. In re *Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

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<sup>7</sup> It is therefore unnecessary to individually rule as to whether each of the other specific clothing items set forth in the involved application are so related to those in the cited registration that confusion would be likely.

<sup>8</sup> Although applicant suggests that the goods travel in different channels of trade, there are no limitations in the respective identification of goods.

We next turn to consider the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Contrary to applicant's statement that the marks are not similar "[w]hen viewed side by side" (Appeal Brief, p. 4), the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. Finally, where, as in the present case, the marks appear on, at least in part, legally identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The record includes a dictionary definition of the term "black ice" showing that it means "a thin film of ice on paved surfaces (as roads) that is difficult to see."

Merriam-Webster Online ([www.m-w.com](http://www.m-w.com)). The same dictionary defines "naked" as "not covered by clothing: nude."

Applicant has adopted the entirety of registrant's arbitrary mark and merely added NAKED to the mark. Although, as applicant contends, the presence in its mark of the term "naked" may be somewhat "jarring," we find that the mere addition of this term does not sufficiently distinguish the marks BLACK ICE and BLACK ICE NAKED, especially given that the marks are applied to legally identical goods. See, e.g., *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975); and *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979).

The marks BLACK ICE and BLACK ICE NAKED are similar in sound and appearance. As shown by the meaning of "black ice," this term is arbitrary when applied to the goods involved herein. The addition of the term "naked" does not sufficiently change either the meaning of the marks or the overall commercial impression engendered by the marks. Given the common use of the arbitrary words BLACK ICE in the marks, consumers familiar with registrant's mark, upon encountering applicant's mark, will mistakenly believe that applicant's mark just identifies another line of clothing offered by registrant.

Applicant's claim of a "micro-family" of "NAKED" marks is to no avail. Firstly, the claim of a family of marks is entirely unsupported by the record. Secondly, and more significantly, we are concerned in this appeal with the registrability of applicant's specific mark, BLACK ICE NAKED. The existence of other "NAKED" marks owned by applicant is irrelevant to the specific likelihood of confusion issue involving registrant's mark BLACK ICE.

We conclude that consumers familiar with registrant's outdoor camping apparel, namely, parkas, vests, mittens and pants sold under the mark BLACK ICE would be likely to believe, upon encountering applicant's mark BLACK ICE NAKED for clothing items such as parkas, vests, mittens, pants, jackets, overcoats, and jeans, that the goods originated with or are somehow associated with or sponsored by the same source.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register is affirmed.