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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Foster

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Serial No. 78305992

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Scott M. Hervey of Weintraub Genshlea Chediak Sproul Law Corporation for Ryan M. Foster.

Tricia McDermott Thompkins, Acting Senior Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Quinn, Drost and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Ryan M. Foster has appealed from the final refusal of the trademark examining attorney to register

**nemesis**  
clothing innovations

**Serial No. 78305992**

as a trademark for "shirts, hats, pants, belts, sweatshirts, [and] T-shirts"<sup>1</sup> in International Class 25.

The examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark NEMESIS (in standard character form) for "jackets, [and] shirts,"<sup>2</sup> also in International Class 25, that, as used on applicant's identified goods, applicant's mark is likely to cause confusion or mistake or to deceive.

Applicant has appealed the final refusal of his application. Both applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing. As discussed below, the refusal to register is affirmed.

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*

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<sup>1</sup> Application Serial No. 78305992, filed September 26, 2003, asserting a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). Applicant and has entered a disclaimer of the term CLOTHING apart from the mark as shown.

<sup>2</sup> Registration No. 2441872, issued April 10, 2001.

**Serial No. 78305992**

*Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. 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 consider the goods involved in this case. Because both applicant's and registrant's identifications of goods recite "shirts" without limitation, and applicant's t-shirts are a type of shirt, applicant's goods are in part identical to, or encompassed within, registrant's identification of goods.

As for the remaining items in applicant's identification of goods, i.e., sweatshirts, hats, pants and belts, which are all clothing items or clothing accessories, we find that they are related to registrant's shirts and jackets. For example, "jackets" in registrant's identification of goods is a broad term that encompasses jackets for use in outdoor exercise such as jogging. Purchasers seeking an exercise outfit could easily choose between a sweatshirt and a jacket for exercise, or both. Similarly, "jackets" encompasses ski jackets. The terms

"pants" and "hats" in applicant's identification of goods are broad enough to include ski pants and ski hats, which are related to ski jackets, because one may require all three when skiing and all three are sold in ski shops to skiers. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989). See also *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). Therefore, we hold that applicant's goods are related to, encompassed within, or identical to the goods recited in registrant's identification of goods.<sup>3</sup>

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<sup>3</sup> Applicant argues that the goods are dissimilar because "the essential characteristic of Applicant's branded goods is their fashionableness and resultant appeal to youth participating in extreme sports"; and that "this is opposite and distinct from the essential characteristic of Registrant's goods." Brief at p. 17. In other words, applicant's goods are "different, edgy, and fashionable," while registrant's goods are not, being "unbranded clothing" upon which third-party corporate logos may be imprinted. *Id.* at p. 16.

Applicant's argument regarding "the essential characteristics" of the goods is legally irrelevant. It is well settled that in Board proceedings, the question of likelihood of confusion must be determined based on an analysis of the marks as applied to the

In addition, we note that there are no restrictions on the channels of trade of the identified goods. We must hence assume that all the goods travel in the normal channels of trade for these goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981) ("where the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers."). Thus, the channels of trade for applicant's shirts and t-shirts and registrant's shirts are identical, and the channels of trade for applicant's hats, pants, belts and sweatshirts, and registrant's shirts and jackets, would be very similar, if not overlapping.

Regarding the prospective purchasers, we find that the prospective purchasers of registrant's and applicant's

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goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited registration], rather than what the evidence shows the goods and/or services to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Applicant's identification of goods is not limited to goods having the characteristics described by applicant.

**Serial No. 78305992**

goods would likely overlap. Furthermore, there is no evidence that the purchasers of these goods would be particularly careful or sophisticated and there is no per se rule that purchasers of casual shirts, hats, pants, belts, sweatshirts and t-shirts on one hand, and shirts and jackets on the other hand, are anything other than ordinary purchasers exercising ordinary care in their purchases.

Applicant has argued that the trade channels of applicant's and registrant's goods differ and are unlikely to be encountered by the same consumers. According to applicant, applicant's market is a niche market and his sponsorship is limited to extreme sport athletes, and his advertising is in extreme sport publications such as "Alliance Wakeboarding." Sales are through applicant's catalogs and through action sports shops. As for the level of care applicant's potential purchasers would exhibit, applicant maintains that "no clothing shopper is more sophisticated concerning current fashion trends than the teen/young adult consumers to whom Applicant markets. Consequently, Applicant's consumers are likely to obtain Applicant's goods only after significant and careful consideration as to their current fashionability." Brief at pp. 19 - 20.

Applicant's arguments are of no avail. To the extent that the goods are in part identical and otherwise closely related, we must assume that the channels of trade, prospective purchasers and the level of care that they exhibit to be the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade."). Also, although applicant contends that purchasers of applicant's goods are sophisticated purchasers, as noted above, there is no evidence to support this contention. We add that even if there was evidence that applicant's purchasers are sophisticated, such evidence would not change our opinion because applicant's identification of goods is not restricted and all purchasers of shirts, hats, pants, etc. are not sophisticated purchasers.

Thus, we resolve the second, third and fourth *du Pont* factors against applicant.

We next consider the first *du Pont* factor, i.e., the similarities of the marks. Specifically, we consider whether applicant's and registrant's marks, when viewed in

**Serial No. 78305992**

their entireties, are similar in terms of appearance, sound, connotation and commercial impression. We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Also, we are guided by the well-established principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The examining attorney has argued that the term NEMESIS is the dominant portion of applicant's mark because it is "arbitrary" inasmuch as the term "has no apparent or immediate relationship to the goods: clothing"; that CLOTHING "merely describes the type of goods and would not immediately be identified by prospective consumers as a source indicator"; that INNOVATIONS is "suggestive of the goods [but] is still less dominant than the arbitrary term

NEMESIS"; that CLOTHING INNOVATIONS is "less distinctive" than NEMESIS and "merely describ[es] the type of clothing, specifically, the uniqueness or novelty thereof"; and, of course, that the dominant part of applicant's mark is identical to registrant's mark. Brief at pp. 3-4. Also, as an exhibit to her brief, the examining attorney has provided a definition of "innovation" from *Merriam-Webster Online Dictionary* found at [www.merriamwebster.com](http://www.merriamwebster.com),<sup>4</sup> and has requested that we take judicial notice of this definition.

Applicant disputes the examining attorney's contention that NEMESIS is the dominant term in the mark. Rather, applicant contends that INNOVATIONS must be accorded the same weight as NEMESIS; and that "the Examiner has committed an error here by inappropriately dissecting Applicant's mark and stressing ... NEMESIS." Additionally, applicant maintains that "[t]he suggestive nature of ... INNOVATIONS, which Applicant has not disclaimed, requires

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<sup>4</sup> The examining attorney did not submit the dictionary definition of "innovation" prior to the time when applicant filed his appeal. The record on appeal must be complete by the time the notice of appeal is filed, Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Also, pursuant to *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999) the Board does not take judicial notice of definitions in on-line dictionaries that are not available in printed format, and there is no indication in the record that the definition offered by the examining attorney is also available in printed format. Thus, we do not take judicial notice of the dictionary definition of "innovation" offered by the examining attorney.

**Serial No. 78305992**

that it be considered in distinguishing Applicant's Mark from Registrant's Mark"; that "[t]he importance of ... INNOVATIONS to Applicant's Mark is apparent when Applicant's Mark is properly considered 'in connection with the particular goods or services for which they are used'; that "Applicant's goods are targeted for men and women ranging in age from ten to twenty-six years old and who engage in extreme sports"; and that "INNOVATIONS conveys to consumers that Applicant's goods are as 'different, edgy, and fashionable' as the extreme sports in which they participate." Brief at p. 9.

We agree with the examining attorney that NEMESIS is the dominant term in applicant's mark. NEMESIS appears above CLOTHING INNOVATIONS, in lettering that is roughly three times larger than the lettering of CLOTHING INNOVATIONS. It is the first term that potential purchasers will read when perceiving the mark. Also, CLOTHING and INNOVATIONS are identical in size and font, and appear next to one another, below NEMESIS. We therefore find that potential purchasers will consider CLOTHING INNOVATIONS as one phrase, meaning that the look of applicant's NEMESIS clothing is new or unusual as

compared to previous clothing designs.<sup>5</sup> Hence, when considering applicant's mark as a whole as applied to the goods identified in the application, we find NEMESIS, an arbitrary term as applied to applicant's clothing, to be the dominant term in the mark.<sup>6</sup>

Because the dominant term in applicant's mark is the same as registrant's entire mark, we find that the connotations<sup>7</sup> and commercial impressions of the marks are similar. In so finding, we reject applicant's contention

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<sup>5</sup> We take judicial notice of the following dictionary definition of "innovation" in *Webster's II New Riverside Dictionary* (1994) (in printed format); "2. Something new or unusual." See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>6</sup> As noted above, the identification of goods does not specify to whom applicant's goods are targeted, and we are limited to consideration of the marks as applied to the goods recited in the application. See *Canadian Imperial Bank, supra*. Applicant's contention in arguing that INNOVATIONS must be accorded the same weight as NEMESIS because his goods are "targeted for men and women ranging in age from ten to twenty-six years old and who engage in extreme sports" is therefore given limited weight.

<sup>7</sup> With respect to the connotation of the marks, applicant has argued that NEMESIS, when used with the wording CLOTHING and INNOVATIONS, "conveys the overall impression that Applicant's goods are cutting-edge clothing for unbeatable extreme sports competitors." Brief at p. 13. Applicant cites to *The American Heritage Dictionary of the English Language* (4<sup>th</sup> Ed.) definition of "nemesis," i.e., "[a]n opponent that cannot be beaten or overcome." We take judicial notice of this definition which was not submitted prior to the time when applicant filed his appeal. *University of Notre Dame du Lac, supra*.

Because nothing in the wording CLOTHING INNOVATIONS suggests to us that the goods are intended for use with extreme sports (which applicant identifies as "skateboarding, wakeboarding, wake-skating, snowboarding, surfing, and freestyle motocross," see brief at p. 9), and because the identification of goods does not limit the goods for use with such extreme sports, applicant's argument is not well taken.

that the additional wording CLOTHING INNOVATIONS, when used with NEMESIS, "bears a direct connection to applicant's customer base of extreme sports competitors," capturing "the essence of the [extreme sports] lifestyle" and creating different "commercial connotations" of the marks. *Id.* at p. 13. As noted above, CLOTHING INNOVATIONS simply suggests that the look of applicant's NEMESIS clothing is novel and different from previous clothing designs.

We next consider the appearance of the marks. The mark depicted in the cited registration is in standard character form. As such, registrant is not limited to presentation of his mark in any particular stylization, and may end up with a mark very similar in appearance to that of the term NEMESIS in applicant's mark. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); 37 C.F.R. §2.52(a). Thus, we find that the marks are, or can be, similar in appearance.

Turning next to the issue of phonetic similarity or dissimilarity of the marks, applicant maintains that the marks are dissimilar when spoken, noting that applicant's mark contains nine syllables and that registrant's mark contains three syllables. Of course, the dominant portion of applicant's mark is identical to registrant's entire mark, and is the first word that one would speak in calling

**Serial No. 78305992**

for applicant's goods. Also, it is reasonable to conclude that consumers will shorten applicant's mark and call for applicant's shirts as, e.g., NEMESIS shirts, rather than NEMESIS CLOTHING INNOVATIONS shirts, thereby increasing any likelihood of confusion between the marks. For these reasons, we conclude that the marks are similar in sound.

Because the connotation, commercial impression, appearance and sound of the marks are similar, we also resolve the first *du Pont* factor against applicant.

In view of the foregoing, considering all of the relevant *du Pont* factors, and mindful that in cases such the present one, where applicant's goods are identical in part to registrant's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), we conclude that consumers familiar with registrant's "jackets, [and] shirts" offered under the mark NEMESIS would be likely to believe, upon encountering applicant's mark NEMESIS CLOTHING INNOVATIONS (and design), also (in part) for shirts, that they both originate with or are somehow associated with or sponsored by the same entity.

**Serial No. 78305992**

**DECISION:** The refusal to register the mark under Section 2(d) of the Trademark Act is affirmed.