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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JDK Select, Inc.¹

Serial No. 78324310

Lauri S. Thompson of Greenberg Traurig LLP for JDK Select, Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Seeherman, Drost and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On November 6, 2003, JDK Select, Inc. of Las Vegas, Nevada (applicant) filed an intent-to-use application to register SIN CITY BREWING COMPANY in standard-character form on the Principal Register for goods identified as, "wearing apparel, namely, shirts, t-shirts, polo shirts, golf shirts, tank tops, vests, blouses, sweaters, parkas, turtlenecks, pullovers, skirts, shorts, jeans, slacks, pants, robes, nightshirts and night gowns, pajamas, robes,

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rompers, socks, coveralls, mittens, gloves, undergarments, jerseys, leotards, hosiery, booties, slippers, scarves, belts, neckties, suspenders, headbands, hats, caps, visors, blazers, rain ponchos, jackets, wind resistant jackets, warm-up suits, jogging suits, sweatshirts, sweat pants, beach wear, namely, bathing suits, beach sandals, beach towels, footwear, namely shoes, boots, sandals, sneakers and athletic shoes" in International Class 25.

The examining attorney refused registration on two grounds.

First, the examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with Reg. No. 2591771 for the SIN CITY mark, also in standard-character form, registered for "clothing namely tops and bottoms, t-shirts, sweatshirts, sweaters, shorts, sweatpants, socks, underwear, pants, sweatbands, hats, caps, socks, shoes, boots, and sneakers" in International Class 25. The registration issued on July 9, 2002. The registration claims both first use anywhere and first use in commerce on March 3, 2001.

¹ This application was filed by Barry Shier and later assigned to JDK Select, Inc. in a document recorded at Reel 2990/Frame 0426.

Secondly, the examining attorney refused registration based on a requirement to disclaim "SIN CITY" under Trademark Act Section 6, 15 U.S.C. § 1056, on the ground that "SIN CITY" is "primarily geographically descriptive" of the goods under Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2).

Applicant responded to the refusals; the examining attorney made the refusals final; and applicant filed this appeal. Applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing. For the reasons indicated below, we affirm the refusal under Section 2(d) and reverse the refusal under Sections 6 and 2(e)(2).

Section 2(d) - Likelihood of Confusion

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the

applicant and registrant. 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."). Below we will discuss these and all other factors as to which applicant or the examining attorney argued or presented evidence.

Comparison of the Goods and Channels of Trade

Applicant does not argue that its goods differ from those of registrant. Applicant's argument related to the goods focuses exclusively on the trade channels for its goods. As applicant states, "It is also recognized that if the goods of one party are sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is less than if both parties sold the goods through the same channels of distribution (citation omitted). Applicant suggests that because applicant is presenting its goods to the public under the purview of its primary service, which is brewing and selling 'microbrewed' beer, the channels of marketing for the product will differ from those of the Registrant, which markets and sells its goods on their own value."

Applicant concludes this portion of its argument by stating, "The relevant consuming public will be very aware that the Applicant is offering the goods only in connection with, and as a direct promotion tool for the primary goods. Similarly, consumers may be able to see Registrant's goods offered at a multitude of completely unrelated locations, further distancing any association that they may have had between the two marks." Applicant's Brief, unnumbered page 6.

The examining attorney points out that both the application and registration include the following identical goods, "t-shirts, sweaters, shorts, pants, socks, hats, socks, caps, sweatshirts, sweat pants, shoes, boots and sneakers" and that the balance of the goods of applicant and registrant are closely related. The examining attorney argues further that neither the application nor the registration includes any restrictions as to trade channels "and therefore it is assumed that the registrant's and applicant's goods are sold everywhere that is normal for such items . . . (citations omitted)."

In comparing the goods, we must consider the goods as identified in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB

1991). A simple comparison of the goods identified in the application and registration reveals that both include identical items, as noted by the examining attorney. Furthermore, consistent with the examining attorney's argument, the Board has previously held that various clothing items, such as those at issue here, are related. See, e.g., Jockey Intl., Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1236 (TTAB 1992); In re Pix of America, Inc., 225 USPQ 691, 692 (TTAB 1985) and cases cited therein. Therefore, there is no question but that the goods of the applicant and registrant, as identified in the application and registration, are, at least in part, identical and otherwise related.

Turning to the focus of applicant's argument, the same applies with regard to the channels of trade for the goods. That is, ". . . we must assume, absent any restrictions in the identification of goods of the cited registration [or application], that the goods move in all of the channels of trade which are normal for such goods." In re Pix of America, Inc., 225 USPQ at 691, citing Paula Payne Products Co. v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76 (CCPA 1973). In view of the fact that both the application and registration include identical items of apparel, and neither the application nor the registration includes any

restrictions as to trade channels, we must assume that the trade channels of applicant and registrant are, at least in part, identical, and otherwise overlapping.

Accordingly, we conclude that the goods of applicant and registrant are identical, at least in part, and otherwise related, and that the goods of both applicant and registrant move in the same or overlapping channels of trade.

Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods are identical. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).²

The Marks

Applicant argues that the marks differ when viewed in their entirety and asserts that the examining attorney failed to view the marks in their entirety, as required. Applicant then argues, ". . . incorporation of the BREWING COMPANY terms creates a clear identifier for the consumer

² In its brief applicant has both cited and discussed numerous cases which originated in the district courts. These cases involve infringement and similar claims where the focus is on the actual use of marks. These cases are of limited relevance here due to our focus in this proceeding on the particulars of the application and registration, not actual use.

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that can be used to distinguish this mark from similar uses." Applicant argues further that the addition of BREWING COMPANY creates a commercial impression distinct from the registered mark and concludes by stating, ". . . the addition of the BREWING COMPANY terms conveys the immediate impression that reflects the Applicant's primary business activity." On the other hand, the examining attorney argues that the commercial impressions projected by SIN CITY and SIN CITY BREWING COMPANY are highly similar and that the addition of BEWING COMPANY is not sufficient to distinguish the marks.

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Furthermore, a side-by-side comparison of the marks is not the appropriate test; rather, ". . . the emphasis must be on the average purchaser, who normally retains a general rather than a specific impression of trademarks." Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975) and cases cited therein.

It is significant that both marks begin with the words SIN CITY. Presto Products, Inc. v. Nice-Pak Products Inc.,

9 USPQ2d 1895, 1897 (TTAB 1988) (" . . . [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). Here it is of particular importance because SIN CITY not only comes first but it stands out in projecting the connotation and commercial impression in both marks. The Oxford Dictionary of Modern Slang (1992) includes the following definition: "**sin city** - noun often jocular A city of licentiousness and vice (1973) A. THACKERAY What's going to happen Chicago? . . . All you want to do is run amok in 'Sin City' (1975)."³ Thus, the registered mark projects the image of a place of "licentiousness and vice," a concept which grabs one's attention. Consequently, SIN CITY is the dominant element in both marks. The addition of BREWING COMPANY in applicant's mark does nothing to alter either this impression or the dominance of SIN CITY in the mark. If anything, it reinforces the impression. Applicant's mark may even be regarded as a variation on the theme of the registered mark.

³ We take judicial notice of this dictionary definition. 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).

In concluding that SIN CITY is the dominant element in both marks, we are mindful of the necessity to view the marks overall, as applicant urges, and we have done so. However, it is also true that greater weight may be given to one feature in that overall assessment. As the Court of Appeals for the Federal Circuit observed, “. . . in articulating reasons for reaching a conclusion on the issue 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 entirety. Indeed, this type of analysis appears to be unavoidable.” In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's arguments with regard to the distinction between the marks rests principally on the same theory applicant advances with regard to the goods and channels of trade. That is, applicant posits that purchasers will distinguish between the marks due to the context of applicant's use in conjunction with its "primary business activity," microbrewed beers. This argument assumes the purchaser's knowledge of applicant as a brewer. However, it is no more legitimate for us to consider applicant's allegedly restricted trade channels in considering the

similarity of the marks than it would be in relation to the goods. We must assume that purchasers will encounter applicant's and registrant's marks, applied to identical clothing items, without any knowledge of applicant and its primary products. Under these circumstances we conclude that the connotations and commercial impressions of the marks of applicant and registrant are highly similar.

While there are obvious differences in the appearance and sound of the two marks due to the additional element BREWING COMPANY in applicant's mark, we believe that the strong similarities in connotations and commercial impressions override those differences. Accordingly, we conclude that the marks of applicant and registrant are similar.

Finally, due to the similarity of the marks and the fact that both the goods and channels of trade for the goods are, at least in part, identical, we conclude that there would be a likelihood of confusion.

The Disclaimer Requirement

As we indicated above, the examining attorney has also refused registration based on a requirement to disclaim "SIN CITY" under Trademark Act Section 6, 15 U.S.C. § 1056, on the ground that "SIN CITY" is "primarily geographically descriptive" of the goods under Trademark Act Section

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2(e)(2), 15 U.S.C. § 1052(e)(2). Accordingly, we must consider whether SIN CITY is primarily geographically descriptive" of the goods.

To determine whether SIN CITY is primarily geographically descriptive of the goods here we must, as a threshold matter, determine whether the primary significance of SIN CITY is as the name of a place which is generally known. In re Societe Generale des Eaux Minerales de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); In re JT Tobacconists, 59 USPQ2d 1080, 1081 (TTAB 2001); In re California Pizza Kitchen Inc., 10 USPQ2d 1704, 1705 (TTAB 1988).

In this case, we are not presented with a "place name" which would appear on any conventional map or in any similar reference work. Rather, the examining attorney relies on cases holding that certain terms "not on the map" may nonetheless fall within the scope of Section 2(e)(2). See In re Charles S. Lobe Pipes, Inc., 190 USPQ 238, 245 (TTAB 1976) (OLD DOMINION held to be geographical term on the basis that it is the "accepted nickname for the State of Virginia").

Here the examining attorney argues that SIN CITY, like OLD DOMINION, should be recognized as a geographical term, because it is the accepted nickname of Las Vegas,

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applicant's place of business. In support of this position the examining attorney has submitted a number of entries from various web sites. In his brief the examining attorney relies on four in particular, and summarizes them as follows:

www.sincitychamberofcommerce.com/las_vegas_sin_city_history.htm: article titled "History of Las Vegas - And the Evolution of Sin City. The website also features various events in Las Vegas: "Sin City Expo," "Sin City Golf Classic," and "Sin City Poker Tournament."

www.igougo.com/planning/journal.asp?JournalID=16276: article states, "two words that perfectly describe Las Vegas are its nickname "Sin City."

www.meagnedwards.com/Vegasland/Las_Vegas_Grocery_Stores.htm: article titled, "Grocery Shopping in Sin City."

www.startribune.com/stories/425/765564.html: article titled "If You go to Sin City: Las Vegas."

On the other hand applicant argues that SIN CITY is suggestive: "Applicant concedes that 'Sin City' may be used by some to identify the city of La Vegas. However, it also can be seen in a broad sense as simply suggesting a certain style of good or service that is prepared or presented in a certain manner that connotes a (sic) uninhibited or hedonistic attitude."

We agree with applicant. The evidence of record indicates nothing more than a suggestive use of SIN CITY in relation to Las Vegas. Furthermore, the entry from the

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Oxford Dictionary referenced above supports this conclusion. It indicates that the term SIN CITY can be applied to any location associated with "licentiousness and vice." This case is distinguishable from the OLD DOMINION case where the Board relied on a dictionary definition to establish OLD DOMINION as the accepted nickname for the State of Virginia and, therefore, as a geographical term for purposes of Section 2(e)(2). In re Charles S. Lobe Pipes, Inc., 190 USPQ at 245.

Accordingly, we find on this record that SIN CITY is not a geographical term and therefore need not be disclaimed.

Decision: We reverse the refusal under Sections 6 and 2(e)(2), and we affirm the refusal under Section 2(d). Registration is refused.