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Mailed: July 24, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ware

Serial No. 78389002

Delphine James, Attorney at Law, for Ishman Ware.

Mark Rademacher, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Quinn, Hairston and Cataldo, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Ishman Ware has appealed from the final refusal of the
trademark examining attorney to register DOWN IN SOUTHERN
COMFORT as a trademark for goods ultimately identified as
"men's, women's and children's wearing apparel, namely,
t-shirts, head gear, foot gear, shirts, pants, dresses,
blouses, skirts, sport jackets, sport pants."¹

¹ Application Serial No. 78389002, filed March 23, 2004, based on
a bona fide intention to use the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the following four marks, registrations of which are owned by the same entity for the identified goods, that if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

SOUTHERN COMFORT (standard character form) for "clothing, namely, shirts, shorts, caps, scarves, jackets, coats, sweatshirts, hats, bandanas, sweaters, and ski gloves." Registration No. 2,334,067 issued March 28, 2000; Section 8 affidavit accepted; Section 15 affidavit received.



for "footwear, headgear; namely, caps, hats, headbands, visors, bandannas; clothing; namely, aprons, sleeve quarters, t-shirts, golf shirts, baseball shirts, polo shirts, shirts, tops, tank tops, sweatshirts, sweatpants, jogging suits, pants, jackets, coats, belts, neckties, neckwear, scarves, suspenders, braces, leather jackets." Registration No. 2,650,492 issued November 12, 2002. The words "ESTABLISHED 1874" appear above

SOUTHERN COMFORT and have been disclaimed apart from the mark as shown.

**SOUTHERN
COMFORT**

for "footwear, headgear; namely, caps, hats, headbands, visors, bandannas; clothing; namely, aprons, sleeve quarters, t-shirts, golf shirts, baseball shirts, polo shirts, shirts, tops, tank tops, sweatshirts, sweatpants, jogging suits, pants, jackets, coats, belts, neckties, neckwear, scarves, suspenders, braces, leather jackets." Registration No. 2,670,044 issued December 31, 2002.



for "footwear, headgear; namely, caps, hats, headbands, visors, bandannas; clothing; namely, aprons, sleeve quarters, t-shirts, golf shirts, baseball shirts, polo shirts, shirts, tops, tank tops, sweatshirts, sweatpants, jogging suits, pants, jackets, coats, belts, neckties, neckwear, scarves, suspenders, braces, leather jackets." Registration No. 2,775,057 issued October 21, 2003. The words REG. U.S. PAT. OFF. appear beneath SOUTHERN COMFORT.

The appeal has been fully briefed, but an oral hearing was not requested.

Initially, we sustain the examining attorney's objection to the evidentiary materials applicant submitted for the first time with his brief. Those materials (which consist of copies of purported third-party registrations for marks which include the term SOUTHERN COMFORT and Internet printouts wherein the term "Southern Comfort" appear) are untimely under Trademark Rule 2.142(d), and we have given them no consideration.² Likewise, we have given no consideration to the mere listing of purported third-party registrations and applications for marks which include the term SOUTHERN COMFORT that applicant set forth in his response to the first Office action. As the examining attorney correctly observed in his second and final Office action, a mere listing of third-party registrations and applications is not the way to make such registrations and applications of record. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983); *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974).

² We should add that, even if this evidence had been properly before us, the decision in this case would be the same.

We turn then to the issue of likelihood of confusion. Our determination of this issue 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. duPont 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 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).

Turning first to a consideration of the respective goods, it is clear that applicant's clothing items are identical in part (e.g. shirts, pants and headgear) and are otherwise closely related to the clothing items in registrant's registrations. Suffice it to say that both applicant's and registrant's kinds of wearing apparel would be sold to the same classes of purchasers, namely, the general public, through the same trade channels such as clothing stores, department stores, and mass merchandisers. Applicant does not dispute this, but concentrates the

arguments in his appeal brief on asserted differences in the marks.

Applicant contends that the examining attorney has failed to analyze the marks in their entireties. Applicant argues as follows:

Applicant's mark is "DOWN IN SOUTHERN COMFORT; [and] as such the mark must be reviewed for likelihood of confusion as a whole and should not be broken into component parts to reach a conclusion of confusingly similarity. Marks tend to be perceived in their entireties and all components thereof must be given weight. Here, the applicant's mark contains the term "DOWN IN" which provides a different overall commercial impression. As defined by the Webster dictionary, the term "DOWN" have (sic) several different meanings which provide different suggestive terms to the consumer. The term, "DOWN," can mean the movement of position toward a lower level or ground. Secondly, "DOWN" can mean soft fluffy feathers or covering of soft hairs. Thirdly, "DOWN" can mean grassy treeless hills. Thus, if all of the components of the applicant's mark is [sic] taken as a whole the public would have a different commercial meanings [sic]. (citations omitted). (Brief at p. 3).

Applicant also asserts that the examining attorney failed to take into account the evidence it presented to show that the term SOUTHERN COMFORT is weak, and as such, registrant's marks are entitled to only a narrow scope of protection.

With respect to the marks, we must determine whether applicant's mark and registrant's marks, when compared in

their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, 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 terms of their commercial impression that confusion as to the source of the goods and/or services 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). Finally, "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely conclusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 864, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Considering, therefore, the marks at issue, we concur with the examining attorney that when considered in their entirety, each of the registered marks is similar to applicant's mark in sound, appearance, connotation and commercial impression. Specifically, due to the shared term SOUTHERN COMFORT, which forms the dominant element of applicant's mark and each of registrant's marks (for the reasons discussed below), the respective marks are similar in sound, appearance, connotation and commercial impression.

With respect to applicant's mark DOWN IN SOUTHERN COMFORT, this mark is dominated by the term SOUTHERN COMFORT which is modified by the phrase DOWN IN. Thus, it is the term SOUTHERN COMFORT that is entitled to more weight in our likelihood of confusion analysis.

Insofar as registrant's marks are concerned, one of registrant's marks is SOUTHERN COMFORT in standard character form and another is SOUTHERN COMFORT in stylized letters. Applicant has added the phrase DOWN IN to SOUTHERN COMFORT. This additional phrase does not serve to distinguish the marks in terms of sound or appearance. Further, because applicant has applied for its mark in standard character form, this means that a registration would not be limited to a particular style of lettering.

If a registration were to issue for applicant's mark, the protection to be accorded it would include stylization similar to the registered mark SOUTHERN COMFORT in stylized letters.

Registrant's other two marks are SOUTHERN COMFORT - ESTABLISHED 1874 and a design element consisting of a plantation-style home situated along water, a steamboat, and persons riding in a horse-drawn buggy within an oval, and SOUTHERN COMFORT - REG. U.S. PAT. OFF. with the same design element. Although the design element in both of the marks is clearly noticeable, it does not serve to distinguish these marks in sound or appearance. The design element evokes a southern setting and thus reinforces the term SOUTHERN COMFORT. Further, it is the term SOUTHERN COMFORT that is the dominant portion of these marks because it would be used by purchasers to call for registrant's goods. Thus, it would make a greater impression on purchasers and it is the portion that is more likely to be remembered. See *In re Appetitio Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Further, the wording "ESTABLISHED 1874" and "REG. U.S. PAT. OFF." in registrant's marks is clearly subordinate matter with no source-indicating significance. Again, because applicant has applied for its mark in standard character form, this means that a registration

would not be limited to a particular style of lettering. If a registration were to issue for applicant's mark, the protection to be accorded it would include stylization similar to the term SOUTHERN COMFORT in registrant's marks.

Insofar as connotation is concerned, the term SOUTHERN COMFORT in applicant's mark and each of the four registered marks suggests a southern state of ease or well-being. Contrary to applicant's contention, the additional phrase DOWN IN does not change this connotation. Overall, given the noted similarities in sound, appearance and connotation, the respective marks, when used on clothing, engender a substantially similar commercial impression. Consumers of clothing who are familiar with any of registrant's SOUTHERN COMFORT marks are likely to believe that applicant's DOWN IN SOUTHERN COMFORT clothing is a new or additional line of clothing from the same source as the line of clothing marketed under the SOUTHERN COMFORT marks.

Finally, applicant contends that marks consisting of or containing SOUTHERN COMFORT are weak marks which are entitled to only a limited scope of protection. Specifically, applicant maintains that the term SOUTHERN COMFORT, as applied to clothing, is so frequently used in trade names and marks for such goods that no one party may claim exclusive rights to SOUTHERN COMFORT on clothing.

For the reasons discussed infra, we have given no consideration to the evidence submitted by applicant with his brief in support of his contention in this regard. The evidence properly of record consists of the results of a search of the website www.switchboard.com for businesses with names that include "Southern Comfort;" and a copy of a page from a Houston, Texas telephone directory listing businesses with names that include "Southern Comfort." As to such evidence, the examining attorney correctly points out the search results show "use of the term 'Southern Comfort' with businesses unrelated to the apparel industry" and the telephone directory "lists housecleaning, heating and air conditioning, realty/mortgage and security businesses. The two remaining business entries consist of addresses with no indication of field of endeavor of the businesses." (Examining attorney's brief, page 5.)

In short, this evidence does not demonstrate that the term SOUTHERN COMFORT has been so frequently incorporated into marks for clothing that the registered marks are entitled to only a limited scope of protection.

Accordingly, we conclude that purchasers and prospective customers, familiar with the registered marks SOUTHERN COMFORT in standard character form, in stylized letters and with the design element for clothing items,

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would be likely to believe, upon encountering the substantially similar mark DOWN IN SOUTHERN COMFORT for applicant's clothing items, that such identical and otherwise closely related clothing items emanate from or are associated with or sponsored by the same source.

Decision: The refusal under Section 2(d) is affirmed.