

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lisa Frank, Inc.

Serial No. 75/028,659

Anne Aikman-Scalese for Lisa Frank, Inc.

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Office 109 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Lisa Frank, Inc. has appealed from the final refusal
of the Trademark Examining Attorney to register HUNTER as a
trademark for "clothing, namely, caps, T-shirts, and
sweatshirts sold exclusively through the applicant's retail

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stores."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark is likely to cause confusion with the following registrations, both of which are owned by the same individual, Susan P. Scola:

HUNTER ATHLETICS for "athletic, work out, exercise, sporting, and casual clothing, namely shorts, shirts, leotards, unitards, tights, tank tops, sweatshirts, sweatpants, sweatsuits, sports bras, and baseball caps."² The word ATHLETICS has been disclaimed.

HUNTER ATHLETICS and design, as shown below, for "athletic and exercise clothing, namely, shirts and sweatshirts."³ The word ATHLETICS has been disclaimed.



¹ Application Serial No. 75/028,659, filed December 6, 1995, based on an asserted bona fide intention to use the mark in commerce.

² Registration No. 2,388,014, issued September 19, 2000.

³ Registration No. 2,306,329, issued January 4, 2000.

The appeal has been fully briefed.⁴ Applicant had requested an oral hearing, but subsequently withdrew that request.

We affirm the refusal of registration.

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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's mark is HUNTER; the cited marks are HUNTER ATHLETICS and HUNTER ATHLETICS and design. Applicant's

⁴ With its appeal brief applicant submitted copies of third-party registrations to show instances in which the Office allowed the registration of certain marks for clothing despite the existence of registrations of similar marks also for clothing. This evidence is untimely, see Trademark Rule 2.142(d), and, because the Examining Attorney did not treat it as of record, we have not considered it. Even if the evidence had been properly made of record, it would not have affected our decision herein. See **In re Nett Designs Inc.**, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (the PTO's allowance of prior registrations does not bind the Board).

Applicant submitted with its reply brief a copy of a Board decision marked "THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB," despite applicant's recognition that the decision was not citable. Board policy is very clear that we will not consider such decisions. **General Mills Inc. v. Health Valley Foods**, 24 USPQ2d 1270, 1275 (TTAB 1992) at n. 9.

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mark is identical in appearance, pronunciation and connotation to the first word in the cited marks. Although the cited registrations contains the additional word ATHLETICS and, in the case of Registration No. 2,306,329, a partial oval design, these elements are not sufficient to distinguish the marks. It is well-established that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entireties. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The descriptive and disclaimed word ATHLETICS in the cited marks has little source-indicating significance compared to the word HUNTER, which is the dominant word in both marks. The design is not entitled to any real weight, either. It is used as merely a background element; moreover, because the goods would be referred to or called for by the words, the design is not likely to be noted or remembered. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987).

Accordingly, we find that the marks convey the same commercial impression.

In reaching this conclusion, we have considered applicant's arguments that the connotation of the registered mark is "that of a sports environment," brief, p. 1, "a sporting contest or university athletic department." Reply brief, p. 3. Although the word "athletics" per se may suggest the meanings asserted by applicant, in the context of the marks HUNTER ATHLETICS/HUNTER ATHLETICS and design, and given that these marks are used for athletic clothing, the term ATHLETICS would be viewed as merely describing the use or purpose of the goods. Thus, the marks as a whole do not convey the connotations put forth by applicant. Instead, they indicate HUNTER athletic clothing. Moreover, since applicant's mark is proposed to be used for caps, t-shirts and sweatshirts, which are types of athletic clothing, the absence of this term in applicant's mark does not give it a different commercial impression. HUNTER ATHLETICS/HUNTER ATHLETICS and design for athletic clothing, and HUNTER for athletic clothing, convey the same connotation and the same commercial impression.

Turning to the goods, they are, in part, legally identical. Applicant's identification includes sweatshirts, which are also listed in the two cited registrations. Applicant's identification is also for

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caps, which would encompass the baseball caps identified in Registration No. 2,388,014. Applicant's t-shirts, sweatshirts and caps are otherwise closely related to the shirts, tank tops, sweatsuits, sweatpants and shorts of Registration No. 2,388,014, and the "athletic and exercise clothing, namely shirts and sweatshirts" identified in Registration No. 2,306,329. When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant has limited its channels of trade to "the applicant's retail stores." Thus, we must assume that applicant's goods and the registrant's goods will not be sold in the same stores. However, the class of purchasers must still be considered to be the same, as sweatshirts and the like may be purchased by the public at large. Further, because these purchasers will not have the opportunity to make side-by-side comparisons of the marks, the slight differences in the marks discussed above will have even less of an impact that they might otherwise. See **Dassler KG v. Roller Derby Skate Corporation**, 206 USPQ 255 (TTAB 1980) (under actual marketing conditions, consumers do not

necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections).

Applicant argues that the customers who patronize its stores are girls between the ages of 4 and 14 "who enter Applicant's stores for the specific purpose of buying Lisa Frank branded goods." Brief, p. 2. There is, of course, no restriction in applicant's application that would limit the customers of its retail stores to this demographic. However, even if we were to assume that to be the case, such customers (and their parents) would still shop in other stores, where they would be exposed to the HUNTER ATHLETICS marks. They are likely to assume, upon seeing the HUNTER ATHLETICS clothing, that it is associated with applicant. In this connection, we note that applicant has not stated that its other Lisa Frank branded goods are sold exclusively in its own retail stores.

Applicant has also asserted that its goods "are not directed at the popular sports or athletics market." Brief, p. 2. However, applicant's goods are not limited as to purpose, and certainly as identified, t-shirts, sweatshirts and caps can and, indeed, are likely to be used for sports or athletics. It is well established that the question of likelihood of confusion must be determined on

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the basis of an analysis of the mark as applied to the 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. **Canadian Imperial Bank of Commerce v. Wells Fargo Bank**, NA, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Although applicant and the Examining Attorney have not discussed any other duPont factors, we also point out that the goods in question are relatively inexpensive, so they would not be purchased with great care. Further, the goods are general consumer items which would be purchased by the public at large, rather than specialized items which are sold to discriminating purchasers.

Applicant has made reference to Section 18, which gives the Board authority to restrict the channels of trade specified in an application or registration in order to avoid a finding of likelihood of confusion. It is not clear what applicant's purpose is in invoking Section 18. In any event, as the Examining Attorney has pointed out, Section 18 refers to restrictions which are imposed as the result of an inter partes proceeding, and has no relevance to an ex parte appeal such as this.

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Finally, applicant states that "in the event that the previous registrant believes the marks to be confusingly similar despite the exclusivity of Applicant's trade channel, then the appropriate remedy is for the previous registrant to file opposition to Applicant's mark when published." Brief, p. 2. However, it is the duty of the Board to afford rights to registrants without constantly subjecting them to the financial and other burdens of opposition proceedings. See **In re Dixie Restaurants, Inc.**, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). See also, **In re Majestic Distilling Company, Inc.**, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Decision: The refusal of registration is affirmed.`