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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carman Licciardello

Serial No. 75412303

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Before Holtzman, Zervas and Cataldo, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Carman Licciardello, has filed an application to register the mark CARMAN in typed form for "clothing, namely, hats, jackets, bandannas, t-shirts, shirts, jerseys, and tank tops" in Class 25.¹

¹ Serial No. 75412303, filed December 30, 1997, based on an allegation of first use and first use in commerce in May 1983. Applicant has claimed ownership of Registration Nos. 2262448 and 2203001, both for the mark CARMAN, for musical recordings and live performances, respectively. However, the registrations have been cancelled, and they

Serial No. 75412303

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the registered mark CARMEN in typed form for "clothing, namely, shirts, T-shirts, sweatshirts, hats and jackets" in Class 25, as to be likely to cause confusion.²

When the refusal was made final, applicant appealed. Briefs have been filed.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). The relevant du Pont factors are discussed below.

are therefore not evidence of any presently existing rights in the mark for the goods or services identified in the registrations.

² Registration No. 2035888; issued on February 4, 1997; assigned to Vina Carmen S.A., a corporation of Chile; renewed. The registration also includes Class 33 for "wine" but it is clear that the refusal to register is based only on Class 25.

Goods/trade channels/purchasers/conditions of purchase

The goods in the application and cited registration are, in substantial part, identical. Both applicant and registrant are using the mark on shirts, t-shirts, hats and jackets.

Applicant contends that the respective goods "are marketed to different customers in different industries." Brief and Reply Brief at 6. Applicant argues that CARMAN is the given name of a well-known Christian musician and teacher; that the clothing is sold by applicant to fans, music lovers and people interested in applicant's ministry; and that the goods are sold through record stores, his own website and fan websites. In contrast, according to applicant, registrant is a vineyard in Santiago, Chile and its clothing is sold in association with the vineyard on "souvenir" apparel to visitors to registrant's winery, tourists, wine industry enthusiasts and wine connoisseurs; and that registrant "probably" advertises mainly to such customers "nearly exclusively in Chile." Brief at 13. To support his position, applicant has submitted printouts from applicant's website, carman.org, and registrant's website, carmen.com; and relies on an infringement case, *Taj Mahal Enterprises, Ltd. v. Donald J. Trump*, 745 F. Supp. 240, 16 USPQ2d 1577 (D.N.J. 1990).

To begin with, the web pages of record provide no evidence as to how or to whom the goods are actually sold. Neither website provides information about or even reference to the sale

of clothing. In any event, the authority is legion that the question of likelihood of confusion in a Board proceeding, in contrast to an infringement proceeding, must be decided on the basis of the goods set forth in the application and registration, without limitations as to the actual nature of the goods, their channels of trade and/or classes of purchasers that are not reflected therein. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

The goods in this case are identical in part, and there are no limitations in the application or registration.³ It must therefore be presumed that both applicant's and registrant's clothing would be purchased by all the usual consumers of such goods; and that the clothing would be sold through all normal channels of trade, including all of the usual retail outlets for such goods. In other words, we must presume that applicant and registrant compete for the same customers through the same channels of trade. See *Octocom Systems*, supra at 1787 ("the factors which OSI asks to have considered are not reflected, either expressly or inherently, in its application. Thus, it was

³ Further, we will not infer any restrictions to trade channels or purchasers from the inclusion of Class 33 for wine in the registration.

Serial No. 75412303

not error, as OSI argues, for the board to give no weight to OSI's evidence purporting to show that OCTOCOM modems are brought by a particular class of purchasers."); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of SquirtCo's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks."); and *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1337, 209 USPQ 986, 988 (CCPA 1981) ("Here, appellant seeks to register the word MONOPOLY as its mark without any restrictions reflecting the facts in its actual use which it argues on this appeal prevent likelihood of confusion. We cannot take such facts into consideration unless set forth in its application").

Furthermore, because t-shirts, hats, and the like are relatively inexpensive items of clothing, we may assume that such items are more likely to be purchased with less care than more expensive types of wearing apparel. See, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (purchasers of relatively inexpensive products are held to a lesser standard of purchasing care).

Marks

We turn next to the marks, keeping in mind that when marks would appear on identical goods, the degree of similarity between the marks necessary to support a finding of likelihood of

Serial No. 75412303

confusion declines. Century 21 Real Estate v. Century Life, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In determining the similarity or dissimilarity of the marks we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The marks CARMAN and CARMEN are simply alternative spellings of the same given name.⁴ Thus, the marks are the same in meaning and commercial impression. Furthermore, CARMAN and CARMEN, even with the different spellings, look and sound substantially the same. Considering the fallibility of memory over a period of time, and the fact that the average purchaser normally retains only a general, rather than a specific, impression of many trademarks he encounters, it is the name itself rather than the precise spelling of the name that purchasers are likely to remember when hearing or seeing these marks at separate times on identical goods. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

⁴ We take judicial notice of the United States Census Bureau, Census 1990 (www.census.gov/genealogy/names). See In re Spirits International N.V., 86 USPQ2d 1078 (TTAB 2008) (the Board may take judicial notice of census data). The census information shows that "Carman" as well as "Carmen" are female given names. Although it can be seen that "Carmen" is the more popular spelling, "Carman" is still in approximately the top 1/3 of frequently occurring female names.

We have considered applicant's arguments that the marks are not similar and find none of them persuasive.

Applicant argues that the marks have different meanings and commercial impressions in that, according to applicant, CARMAN is the name of a well-known Christian musician and teacher to the customers and followers of his music and ministry whereas CARMEN would be associated with registrant's vineyard which applicant claims is named after the founder's Chilean wife, Carmen Lanz. Reply Brief at 9. However, as we have said, the purchasers for the respective goods are not limited to fans of applicant's music or visitors to registrant's vineyard. The purchasers of both applicant's and registrant's clothing are deemed to include ordinary members of the general public who may or may not be familiar with either applicant and its music, or registrant and its vineyard.

Applicant argues that "English speaking people use the terms 'man' and 'men' to mean different things in plain language every day without confusion." Reply Brief at 8. However the marks are not "MAN" and "MEN" but rather CARMAN and CARMEN and in the context of the marks as a whole, the difference in spelling does not result in a difference in meaning.

Applicant contends that the marks are not similar in sound, arguing that because registrant's primary customers are Chilean, the question is how customers would pronounce CARMEN in Spanish,

not English. Applicant does not explain how CARMEN would sound significantly different than CARMAN in Spanish, but in any event, the relevant consideration is how the mark would be perceived by consumers in the United States, many of whom do not speak Spanish.

Finally, applicant argues that registrant uses the mark "most often in close association with the additional words 'VINEYARDS CHILE.'" Brief at 12. However, that wording is not part of the registered mark and it is not relevant to a determination of whether the marks before us are similar.

Market interface/absence of actual confusion

Applicant claims that this record reflects the opinions of both applicant and registrant that there is no likelihood of confusion. Applicant argues that he is the senior user of the mark and that he has been using his mark for nearly 24 years; that he is an award-winning musician who has released more than 25 albums, many of which, according to applicant, have reached gold and platinum status; that the clothing sold in association with his music and ministry "has had substantial sales" over those years; and that applicant and registrant have coexisted "in their respective markets" for nearly 14 years without confusion. Reply Brief at 4, 7. Applicant maintains that registrant "agrees that there is no likelihood of confusion between the two marks"; that the parties have a "coexistence" agreement; and, pointing to

Serial No. 75412303

In re Schoeneman Enterprises, Inc. Serial No. 74/126,146 (TTAB Dec. 14, 1993), that the Board has "specifically found that a coexistence agreement between the parties that has not been formalized in a written agreement is to be accorded substantial weight." Brief at 13; Reply Brief at 3.

By way of background, following the refusal to register on May 28, 1998, applicant filed a petition to cancel the cited registration on April 19, 2000 on the ground of priority and likelihood of confusion (Canc. No. 92030390). Further action in the application was then suspended pending the outcome of the cancellation proceeding.

During the pendency of the cancellation proceeding, the parties discussed settlement, and in a letter dated August 29, 2000, registrant's counsel, Robert J. Kenney, made the following proposal:

...we have discussed this matter with our client and propose the following solution. Specifically, our client will agree to always use the terms 'VINEYARDS CHILE' after the term CARMEN on all of its clothing items. This, we believe will eliminate any possibility of confusion or mistaken affiliation between the parties, since the common goods appear to be clothing items only.

In response to this proposal, applicant prepared a draft "consent agreement" purportedly incorporating the proposed terms, and proceedings in the cancellation were suspended for settlement negotiations on March 28, 2001. However, the parties apparently

Serial No. 75412303

failed to reach an agreement, and the petition to cancel was ultimately dismissed on May 18, 2004 in view of petitioner's failure to prosecute the case.

In view of the dismissal of the petition to cancel, the examining attorney on July 16, 2004, resumed action in the application, continuing the refusal to register. In response to the refusal, applicant submitted a copy of a partially executed draft agreement (by applicant) along with the August 29, 2000 letter from Mr. Kenney. The examining attorney was unwilling to accept such documents as sufficient evidence of registrant's consent to registration, and he ultimately issued a final refusal in the application.

Applicant then sent several inquiries to Mr. Kenney beginning on February 24, 2006 regarding the status of applicant's draft agreement, and in a letter dated May 19, 2006, Mr. Kenney responded as follows:

Our client advises that it is willing to sign a simple letter of Consent which will allow [applicant] to obtain his registration over the pending refusal without any additional obligations to our client. For example, our client is not willing to agree to a requirement that it use always VINEYARDS CHILE immediately following the CARMEN mark.

We believe that, given the different channels of trade for the goods, the differences in the goods, and the coexistence of the parties in the marketplace for many years, such restrictions are simply not necessary.

Serial No. 75412303

After a follow-up inquiry by applicant as to the particular terms of the agreement, Mr. Kinney, in a letter dated June 8, 2006 stated:

Regarding the terms of the proposed Consent Letter, our client would agree to the most simple form of Consent letter. Specifically, the terms would be:

1. The parties agree that there is no likelihood of confusion between the marks in view of the differences in the mark, the differences in the products/services, and the differences in the channels of trade;
2. [Registrant] would Consent to the Use and Registration by [applicant] of the mark in the pending application for the goods/services listed in that application.

Terms that would not be included would be (a) limitations on either party's use of its mark, for example, use only with another term; or (b) provisions which allow/prohibit either party to expand its use of its mark to other goods/services.

If your client will agree to a simple Consent Letter incorporating the terms above, please draft a proposed Letter and we will forward it to our client for consideration.

On October 2, 2006, applicant prepared a second draft agreement for registrant's consideration, but having received no response from registrant, applicant sent a follow-up email to Mr. Kenney on October 23, 2006. On October 27, 2006, Mr. Kenney left a voicemail message with applicant's counsel wherein, as transcribed by Ms. Slusser, Mr. Kenney stated that he sent "an urgent reminder" to registrant to get back to him "on the proposal." However, the agreement was never signed.

While the parties attempted to reach an agreement we cannot find, based on the information we have before us, that there was an agreement. Applicant's and registrant's counsel exchanged a series of proposals and drafts but the fact remains that no agreement was ever executed by the parties or ever finalized. Nor will we infer any agreement. It is clear that registrant did not consent to registration based on the terms contained in applicant's original draft agreement. That proposal was expressly withdrawn by registrant. In registrant's subsequent proposal, the consent was provisional. Registrant stated in its June 8, 2006 letter that it would agree to a "simple letter of consent," identifying specific terms and conditions. In response, applicant prepared a draft which we note contains terms and conditions in addition to or other than those specified by Mr. Kenney. We have no way of knowing for certain why registrant did not sign the draft, but if we were to infer anything from that inaction, we would infer that registrant did not agree to its terms.

Nevertheless, even if we assume that Mr. Kenney's June 8, 2006 proposal constitutes an agreement between the parties that there is no likelihood of confusion based on the terms contained therein, this agreement would not persuade us that a likelihood of confusion does not in fact exist in this case. In appropriate circumstances, consent agreements are entitled to substantial

Serial No. 75412303

weight in determining likelihood of confusion. See *Bongrain International (American) Corp. v. Delice De France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987). However, this does not mean that the mere existence of a consent, regardless of the type of consent or the circumstances surrounding the consent, will automatically result in a finding of no likelihood of confusion. See *In re Mastic, Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (SHURLOK for roofing shingles confusingly similar to SHURLOK for vinyl siding notwithstanding existence of consent agreement); *DuPont, supra*; *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); and *In re Donnay International, Societe Anonyme*, 31 USPQ2d 1953 (TTAB 1994). "[A] consent is simply evidence which enters into the likelihood of confusion determination and may or may not tip the scales in favor of registrability, depending upon the entirety of the evidence." *Mastic, supra* at 1294 (citations omitted).

In this case, the purported consent is essentially a "naked" consent. It simply states that "there is no likelihood of confusion in view of the differences in the mark, the differences in the products/services, and the differences in the channels of trade." While even a "naked" consent to registration may be sufficient under certain circumstances to "tip the scales" in favor of registration, in this case it is not.

The marks are not "different" at least in any significant way; and registrant's statement that the goods are "different" is flatly contradicted by the application and registration, which on their face show identical goods.⁵ Furthermore, the mere statement that the trade channels are different is meaningless without any attempt to restrict or delineate the markets in which each party's mark would function. Cf. *Mastic*, supra at 1295 ("The statement in the consent that the parties considered the 'dissimilarity' in their trade channels is as vacuous as the statement that they considered the "dissimilarity of their respective marks which are, in fact, identical...").

Nor will we imply restrictions to the trade channels from the agreement itself. As the Court in *Mastic* observed in rejecting applicant's argument that the consent contained an implicit agreement restricting the parties' use (*italics in original*):

Whatever agreement -- if any -- may exist between the parties with respect to trade channels, for example, has not been disclosed. ... [While the consent states that the parties considered the "dissimilarity of the established, likely to continue trade channels"] [t]hat conclusory statement does not prove that the trade channels are, in fact, dissimilar and likely to continue. Evidence must be submitted which shows what are the established trade channels, together with some statement of the users' intentions. In the absence of

⁵ Applicant has misstated the principle in *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) which, as correctly stated, is that there is no per se rule that the use of the same or similar marks on different items of wearing apparel is likely to cause confusion. Moreover, that principle simply does not apply to the goods in this case which are in part identical.

evidence with respect to the specific channels of trade of Mastic and Flintkote, it is reasonable to conclude that they are the same as those generally used in the trade. Here, the only evidence with respect to trade channels is that submitted by the examiner showing that the trade channels for the types of products are the same, and that evidence stands uncontradicted. Contrary to Mastic's view, the consent itself is not evidence that the channels are different.

Mastic, supra at 1295.

In this case, when we balance all the du Pont factors of record, we find that the parties agreement, stating simply that there is no likelihood of confusion, is far from sufficient to "tip the scales" in favor of registrability when all the other du Pont factors of record demonstrate that there is in fact a likelihood of confusion.

In making this finding, we have also considered applicant's contention that the parties have coexisted for nearly 14 years without any instances of actual confusion. While the absence of actual confusion is a factor indicative of no likelihood of confusion, it is meaningful only where the record demonstrates appreciable and continuous use by applicant of its mark in the same markets as those served by registrant under its mark. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

While we have some information about the applicant's use we have no information regarding registrant's use. Indeed, applicant states, noting that registrant is a corporation of

Serial No. 75412303

Chile, that the respective goods are marketed "in different countries." Reply Brief at 6. Applicant also admits that it was unable to find any advertising of registrant's clothing in any outlet in the United States or even on registrant's website. Registrant may have made only very limited use of the mark in the United States. In any event, the point is that without any information as to the nature and extent of registrant's use in the United States, we have no way of knowing whether the opportunity for confusion ever existed. See *Gillette Canada, supra*. See also, e.g., *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 1072, 12 USPQ2d 1901, 1902 (Fed. Cir. 1989) ("The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF's use of the VITTORIO RICCI mark on the merchandise in question in prior years, and (2) the Board specifically found that ETF was not selling such merchandise at the time of the opposition proceeding in its own stores or elsewhere.")

Thus, the factor of lack of actual confusion does not favor a finding of no likelihood of confusion as applicant contends. Instead, this factor is neutral. See *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005).

Applicant's reliance on the unpublished case of *In re Schoeneman Enterprises, Inc.*, *supra*, is misplaced. The "very

unusual circumstances" of that case simply do not exist here. In that case, the Board in finding no likelihood of confusion noted the contemporaneous use of the marks for over sixty years; and moreover, placed great emphasis on the "unusual registration history" showing "decades of contemporaneous registration" for over fifty years. In the present case, applicant's now-cancelled registrations for entirely different goods and services (sound recordings and live performances) fail to demonstrate contemporaneous registration of the marks for the same goods for any period of time, let alone decades.

In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992) is also readily distinguishable. The finding of no likelihood of confusion in that case was based on a "confluence of facts," not one of which is present here, including the "inherent weakness" of the marks as applied to the respective goods, the coexistence of the marks in the marketplace for nearly thirty years; and the fact that the goods (automobiles) involved a major and expensive purchase.

In view of the foregoing, and because substantially similar marks are used in connection with identical goods, we find that confusion is likely.

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