

THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: February 17, 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Red Bull GmbH

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Serial No. 75694928

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Martin R. Greenstein, Esq. of TechMark for Red Bull GmbH.

Suellen Hickey, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

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Before Hanak, Chapman and Drost, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 30, 1999, Red Bull GmbH (a limited liability  
company of Austria) filed an application to register on the  
Principal Register the mark ENERGY WEAR for goods amended  
to read "footwear; clothing, namely shirts, pants, t-  
shirts, sweat shirts and sweatpants, shorts, blouses,  
skirts, jumpers, socks, hats, caps; riding apparel, namely,  
riding jackets and pants; outerwear, namely jackets and  
coats; activewear, namely shorts, shirts, hats, caps and  
visors; bandannas, neckerchiefs, coats, jackets, sweaters,

sleepwear; resort wear, namely, shorts, shirts, t-shirts and pants; belts and suspenders" in International Class 25. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. Pursuant to a requirement of the Examining Attorney, applicant disclaimed the term "wear."

The Examining Attorney originally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of four prior registered marks issued to three different entities -- (1) the mark shown below

**energie**

for "men's and women's clothing, namely, t-shirts, polo shirts, sweatshirts, sweatpants and shorts" in International Class 25,<sup>1</sup> (2) the mark shown below



for "men's sportswear, namely, shirts and pants" in International Class 25<sup>2</sup> and "clothing, namely tops and

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<sup>1</sup> Registration No. 1515449, issued on the Principal Register on December 6, 1988 to Jeri-Jo Knitwear, Inc.; Section 8 affidavit accepted, Section 15 affidavit acknowledged. The registration includes a statement that "The English translation of the word 'energie' in the mark is 'energy.'"

<sup>2</sup> Registration No. 1140446, issued on the Principal Register on December 14, 1980 to Garan, Incorporated, assigned to Garan

bottoms" in International Class 25,<sup>3</sup> and (3) ENERGY BOOTS for "foot coverings, namely, boots" in International Class 25.<sup>4</sup>

In response to the first Office action, applicant, inter alia, argued that there would be no likelihood of confusion between applicant's mark and the marks in each of the cited registrations. In support of applicant's argument it referred to a typed listing of six registrations that include the term "ENERGY" or a phonetic equivalent thereof in the marks and all being for clothing or footwear in International Class 25, and all issued to different owners. (Registration No. 1447677 for the mark EXTRA ENERGY for sweaters; Registration No. 2015919 for the mark ENERGY FIT for footwear; Registration No. 2130892 for the mark ENERGY CUSHION ("cushion" disclaimed) for shoes; Registration No. 2235984 for the mark ENERGY HEEL ("heel" disclaimed) for women's dress and casual shoes; Registration No. 2187563 for the mark ENERGY SPINE for, inter alia, "footwear, namely, shoes and boots for skis and

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Services Corp.; Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

<sup>3</sup> Registration No. 2016069, issued on the Principal Register on November 12, 1996 to Garan Services Corp.; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>4</sup> Registration No. 1178265, issued on the Principal Register on November 17, 1981 to Air Baby, Incorporated. The term "boots" is disclaimed. This registration was canceled under Section 9 of the Trademark Act, 15 U.S.C. §1059.

snowboards; Registration No. 1412443 for the mark N-R-GEE for insoles for shoes.)

In the second and Final Office action, the Examining Attorney, inter alia, withdrew the refusal to register based on the cancelled registration, and made final the refusal based on the remaining three cited registrations. The Examining Attorney did not object to the listing of third-party registrations and did not advise applicant that a typed list is generally not adequate to make third-party registrations of record. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). Moreover, the Examining Attorney discussed applicant's argument regarding the many registrations in International Class 25, thereby treating them as of record. (Final Office action, p. 2.) Therefore, the Examining Attorney stipulated applicant's typed list of third-party registrations into the record, and we have considered them in our decision herein. See TBMP §1208.02 (2d ed. rev. 2004), and cases cited therein.

Applicant appealed the final refusal to register. Briefs have been filed,<sup>5</sup> but applicant did not request an oral hearing.

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<sup>5</sup> Applicant's motions to extend its time to file a reply brief (filed October 26, 2004 and November 22, 2004) are both granted, and applicant's reply brief is noted.

Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont 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 of the marks and the similarities of the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of applicant's goods vis-a-vis those of the cited registrants. The identified goods of applicant and those of the cited registrants include identical items (e.g., t-shirts, shirts, pants, sweatpants, shorts) and they are otherwise related clothing items (e.g., tops, bottoms). Thus, applicant's goods vis-a-vis each of the cited registrants' respective goods are identical or closely related. Applicant does not argue otherwise.

Because the goods are in part identical, and because there are no limitations in the identifications of goods,

we find no differences in the channels of trade or classes of purchasers. We must presume, given the identifications, that the goods will travel in the same channels of trade, and will be purchased by the same classes of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Turning to a consideration of the marks, it is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. This is so because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corporation v. Master Manufacturing Company*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001).

Because the two cited marks (in three registrations) and applicant's mark would all be pronounced as "energy," we find that the marks are similar in sound. However, as

to appearance and commercial impressions we find that the marks are not similar. The word portion of the cited marks are each phonetic mis-spellings of the word "energy," and these mis-spelling give some measure of separateness to each mark. Also, each of the cited marks has stylized lettering and/or a design feature, whereas applicant's mark is the two typed words ENERGY WEAR. We are aware that because applicant's mark is presented in typed form, the application is not limited to the mark depicted in any special form or lettering. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-1848 (Fed. Cir. 2000); and *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). However, we need not consider applicant's mark in all possible stylization forms, but rather in all reasonable manners in which the words could be depicted. See *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235 (TTAB 1992), and cases and authorities cited therein. Moreover, we note that while applicant's typed presentation covers all reasonable stylized letterings, it does not cover design features such as that in the two cited ENER-G marks.

The Examining Attorney argues that the word "wear" is weak when considered in relation to clothing, and applicant agrees. (Applicant's brief, p. 5.) Further, applicant

contends that the term "energy" (and the phonetic equivalents thereof) are also weak in the field of clothing and footwear as shown by the co-existence of the cited registrations and the third-party registrations. (Brief, pp. 4-5.)<sup>6</sup>

Third-party registrations are not evidence of commercial use of the marks shown therein, or what happens in the marketplace, or that consumers are familiar with the third-party marks. See *Olde Tyme Foods Inc., v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd*, Appeal No. 92-1086 (Fed. Cir. June 5, 1992). However, third-party registrations are competent to show that others in a particular industry have registered marks incorporating a particular term, and that such registrations containing a term common in that trade have been registered because the remaining portions of the marks are sufficient to distinguish the marks as a whole from one another. See *Henry Siegel Co. v. M & R International Manufacturing Co.*, 4 USPQ2d 1154 (TTAB 1987);

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<sup>6</sup> Applicant argues that du Pont factor number 6 (the number and nature of similar marks in use on similar goods must be considered. (See e.g., reply brief, p. 4.) The Examining Attorney argues that the cited registrants have been using their marks for 10 to over 20 years. (Brief, p. 6.) There is no evidence in this record of any use of any mark by any of the cited registrants and/or by any of the third-party registrants.

In re Hamilton Bank, 222 USPQ 174 (TTAB 1984); and BAF Industries v. Pro-Specialties, Incorporated, 206 USPQ 166 (TTAB 1980). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:89 and 11:90 (4th ed. 2001).

Here, applicant has made of record six third-party registered marks, all of which include the word "energy" in some form of spelling or phonetic spelling of the word, and all are for the same or related goods as those of applicant and the two owners of the three cited registrations. In addition, the Examining Attorney made the four cited registrations of record herein, even though only three of those registrations are still cited as bars to registration of applicant's mark. Thus, it appears that the term "energy" is hardly a unique term for use in connection with clothing and footwear.<sup>7</sup>

When considered in their entirety, we find applicant's mark is not similar in appearance or overall

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<sup>7</sup> Applicant also argues that this same Examining Attorney allowed for publication applicant's related application Serial No. 75694926 for the mark RED BULL ENERGY WEAR and design showing a circle and two fighting bulls ("wear" disclaimed) for various clothing items; and that the application issued as Registration No. 2594767 on July 16, 2002. Inasmuch as the mark in applicant's related application is different from the typed word mark ENERGY WEAR, we did not rely on this argument in reaching our decision herein.

**Ser. No. 75694928**

commercial impression to either of the cited registrants' marks.

Based on the record before us in this ex parte case, we find that confusion is not likely.

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