

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: September 3, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Roush Fenway Racing, LLC

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Serial No. 75932713

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Jesse B Ashe III of Summa & Allan for Roush Fenway Racing,  
LLC.

David H Stine, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

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Before Walters, Bucher and Ritchie de Larena, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Roush Fenway Racing, LLC has filed an application to register the mark shown below on the Principal Register for "Clothing, namely, tops, hats, night shirts, shirts, socks, sweat shirts, T-shirts, tank tops, caps, jackets, shorts, visors, sweat pants, sweaters, sweat suits, suspenders, pants, and bibs, all related to the field of professional automobile racing," in International Class 25.<sup>1</sup>

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<sup>1</sup> Serial No. 75932713, filed March 1, 2000, based on use of the mark in commerce, alleging first use and use in commerce as of June 1, 1999.

# 17

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SEVENTEEN, previously registered for "shirts,"<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

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. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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<sup>2</sup> Registration No. 2693602 issued March 4, 2003, and is owned by Roush Fenway Racing LLC.

In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We consider, first, the goods involved in this case. Applicant's main point in arguing that the goods are different is that the clothing identified by its mark is race-oriented apparel marketed in connection with professional automobile racing to "middle-aged male race fans" (brief, p. 6); whereas, applicant contends that registrant's goods are marketed to teenage girls interested in fashion. However, we must consider the question of likelihood of confusion based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

In this regard, registrant's goods, identified as "shirts," encompass shirts of all types for all usual purchasers of shirts, including teenage girls interested in fashion and racing fans, related to all fields, including both fashion and racing. Applicant's "night shirts," "shirts," "sweat shirts," "t-shirts," and "tank tops" are all different types of "shirts" and, as such, are encompassed within the broad identification of goods in the cited registration.

Therefore, applicant's goods are, in part, legally identical to registrant's "shirts."

While the application is limited to the specified clothing "related to the field of professional automobile racing," this limitation does not take applicant's goods out of the purview of those in the cited registration because registrant's "shirts" encompasses such goods. In view of the identity of the shirt items in applicant's identification of goods, it is unnecessary to consider whether or to what extent the other clothing items listed therein are related to registrant's "shirts."

The analysis of the trade channels, the class of purchasers and the level of care involved in purchasing the respective goods leads to the same result. Applicant's goods are presumed to travel through all normal trade channels for the specified clothing related to professional automobile racing, and to all of the usual purchasers of

such goods. Again, in view of the lack of limitations on the goods in the cited registration, applicant's identified trade channels and purchasers are encompassed by those for the registrant's goods. Applicant's evidence of the nature of the actual goods identified by the respective marks in the marketplace is not relevant to our determination of registrability.

Additionally, applicant argues that the purchasers of its goods are sophisticated, knowledgeable consumers who purchase these items with care. Applicant does not establish this allegation in the record and, certainly, the purchasers of such clothing items encompass the general consumer who may or may not be exercising care in such a purchase. Moreover, even sophisticated purchasers are not immune from confusion when the marks are as similar as these marks, as discussed below, and the goods with which they are used are legally the same. See *In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

Turning, next, to consider the marks, we note that "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). We must determine whether applicant's mark and the registered mark, when

viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 overall commercial impressions that confusion as to the source of the goods 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).

Furthermore, although the marks at issue 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).

The registered mark is the standard character word SEVENTEEN, which means that no particular format is claimed. Applicant's mark is a stylized numeral "17." Certainly, these marks are aurally identical and they have the same connotation, i.e., the number seventeen ("17"). Applicant's contentions that these two marks have different connotations pertaining either to automobile racing or fashion are not

well taken. We must consider the connotation of the marks in the context of the identified goods and, as previously stated, applicant's shirts pertaining to professional automobile racing are encompassed within registrant's "shirts." Extrinsic evidence that may tend to limit the scope of registrant's goods is essentially a collateral attack on the cited registration, which is not appropriate in this context, nor is such evidence probative of the registrability of applicant's mark.

We also do not find the stylization of applicant's mark a distinguishing factor. First, it consists merely of a relatively non-distinctive font style. Second, registrant's mark is in standard character format and, thus, registrant could conceivably display its mark in any lettering style, including the same font used to display the number "17" in applicant's mark. 37 C.F.R. § 2.52(a); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (when registering a mark in block letters, registrant remains free to change the display of its mark at any time). See e.g., *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744 (TTAB 1987) (styling of letters is irrelevant to the issue of confusion where applicant seeks to register mark without any special form of lettering or design).

While applicant's mark, which represents the number "17" as a numeral, is visually different from the registered

mark, which represents the same number as a word, we find that the marks are more similar than dissimilar and, in fact, they have substantially similar commercial impressions.

In its reply brief, applicant states that, while there is case law that presumes registrant's shirts encompass those directed to the field of professional racing, "the Board cannot ignore the commercial realities of the publishing and auto racing industries, and expect the publisher of SEVENTEEN magazine to offer shirts targeting NASCAR fans [or] that applicant ... offers fashion advice to teenagers" (reply brief, p. 4). Applicant implores the Board to consider commercial realities and cites the case of *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), in support of its position. However, that case differed from the case herein because the parties' goods as identified were different and noncompetitive products directed to different and sophisticated purchasers, even if within the same fields.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of

applicant's mark and registrant's mark, their contemporaneous use on the same goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

In its reply brief, applicant states that it is "amenable" to amending its identification of goods to further limit the trade channels by adding "all promoting a racing team, and all offered by authorized vendors at trackside booths, on racing related websites, and racing affiliated retail outlets." Not only is this point in the proceeding too late for remand to the examining attorney for discussion of a possible amendment, but the proposed amendment would not resolve the issue of likelihood of confusion because, as stated herein, the cited registration does not contain any limitations to the channels of trade for the identified shirts.

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