

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
July 14, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wiesner Products, Inc.

Serial No. 76173079

Ezra Sutton of Ezra Sutton P.A. for Wiesner Products, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Hohein, Bucher and Holtzman, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Wiesner Products, Inc. seeks registration on the
Principal Register of the mark IT'S OFF THE HOOK for goods
identified in the application as "socks and hosiery" in
International Class 25.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register this mark based upon Section 2(d) of the Trademark
Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney

¹ Application Serial No. 76173079 was filed on November 26,
2000 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark shown below:



registered for goods identified as "Men's, Women's, Children's and Infant's Clothing, Footwear, Headgear, and Fashion Accessories Namely, T-shirts, sweatshirts, shirts, sweaters, pants, shorts, sweatpants, vest, shoes, caps, bandannas, coats, jackets, suits, swimwear, undergarments, gloves, headbands, dresses, lingerie, brassieres, sleepwear, boxer shorts, socks, belt for clothing, sneakers, boots, pajamas, rainwear, scarves, wristbands, slippers, sandals, blouses, ties, slacks, booties, and cloth bibs," also in International Class 25,² as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

² Registration No. 2638396 issued on October 22, 2002.

In arguing for registrability, applicant contends that the highly-stylized design of the cited mark is its dominant feature; that most of the wording in the cited mark is indecipherable; and that the word "HOOK" is diluted and weak on the federal trademark register.

By contrast, the Trademark Examining Attorney argues that the involved marks create highly similar commercial impressions; that the goods are identical and otherwise closely-related products; and that applicant has failed to make a showing that the registered mark is entitled to a narrow scope of protection.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. 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 relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Accordingly, we turn first to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound and connotation.

As to appearance, as argued by applicant, registrant's mark is displayed in a special format, while applicant has chosen to apply for a typed drawing:



Registrant's mark

IT'S OFF THE HOOK

Applicant's mark

Applicant argues as follows:

The Examining Attorney has given no consideration to the fact that registrant's highly stylized lettering and unusual design is the dominant aspect of registrant's mark such that the wording in the cited registration is virtually relegated to being undecipherable, and the cited registration is essentially a design mark ...

... The dominance of registrant's design and stylization of it's [sic] letters cannot be ignored as has been done by the Examining Attorney's mechanical construction of the marks; as such, registrant's design cannot be treated as a word mark ...

Applicant's appeal brief, pp. 1 - 2.

While we must consider these two marks in their entireties, nevertheless, one feature or part of a mark may be recognized as having a more significant role in creating the commercial impression of the mark, and we may give greater weight to that part or feature in determining whether confusion is likely. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). As noted by the Trademark Examining Attorney, typically, when a mark

consists of a word portion and a design element, the word portion is more likely to be impressed upon the memory of a prospective purchaser and to be recalled and used in calling for or recommending the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). For this reason, we consider registrant's mark to be a stylized word mark, and hence accord "OFF THA HOOK," the word portion of the cited registered mark, more weight in determining whether confusion is likely than to the stylization of the lettering and the surrounding stars, etc.

With this background, we find that when spoken, the only difference in the marks is that applicant's begins with the contraction, "It's." This is relatively minor compared with the significant phonetic similarity of the majority of the syllables of the marks when compared in their entireties.

When placed side by side, as shown above, applicant's beginning word "It's," the difference in spelling between the words "tha" and "the," the bubble letters and the surrounding stars do create a visual difference between these two marks. However, the test to be applied in determining likelihood of confusion is not whether the

marks are distinguishable upon side-by-side comparison, but rather whether the marks, as they are used in connection with the registrant's and applicant's goods, so resemble one another as to be likely to cause confusion. Under actual marketing conditions, consumers do not necessarily have the opportunity to make side-by-side comparisons between marks. Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). The proper emphasis is thus on the recollection of the average customer, and the correct legal test requires us to consider the fallibility of human memory. The average purchaser normally retains a general rather than a specific impression of trademarks. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973) [the figure of a stooped, elderly man holding a cane and the words "G•R•A•N•D•P•A PIDGEON" v. the figure of a seemingly more spry but elderly man in a mark having no wording, both used with retail store services]; Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), affirmed in unpublished opinion, Appeal No. 92-1086 (Fed. Cir. June 5, 1992) ["SILVER SPOON CAFÉ" and "SILVER SPOON BAR & GRILL" for "restaurant and bar services" v. "SPOONS," "SPOONBURGER," "SPOONS with cactus

design," and "SPOONS within a diamond logo design"³; Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

As to connotation, the words "off the hook" (or their phonetic equivalent, "off tha hook") combine to create a single phrase meaning "out of trouble."⁴ This creates a nearly identical meaning between the two marks involved herein. Nothing in the record suggests that this phrase is anything other than an arbitrary term in this context, and hence a fairly strong mark, for registrant's clothing items.

Accordingly, because each of these marks contains the phrase "OFF THE HOOK" (or its phonetic equivalent), and having reviewed the similarities in sound, meaning and appearance of these two marks, we find that these two marks create very similar overall commercial impressions.

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SPOONS and



⁴ **off the hook** adv. (or adj): out of a difficulty or trouble <counted on his friends to get him *off the hook*>, Webster's Third New International Dictionary of the English Language Unabridged, 1088 (1993).

We turn then to the relatedness of the goods as listed in the cited registration and in the instant application. Both list "socks," and the balance of registrant's clothing items appear to be closely related to socks. Certainly applicant makes no attempt to argue otherwise.

Finally, as to the number and nature of similar marks in use on similar goods, applicant included copies of seventeen third-party registrations and approved applications from the Office's TESS records. Applicant argues that these registrations and applications demonstrate that HOOK-formative marks are so common as applied to clothing that members of the public are conditioned to look to other distinguishing factors to discover the source of the goods, citing to In re Dayco Products-Eaglemotive, Inc., 9 USPQ2d 1910 (TTAB 1988) [third parties in the vehicular field have adopted the word "IMPERIAL" consistent with the laudatory significance of the term]. However, applications alone are of no value to applicant in this regard, and the cited Dayco Products-Eaglemotive case itself notes that third-party registrations are of limited probative value. Moreover, we find that these registrations do not demonstrate any weakness of the term OFF THE HOOK for clothing. Applicant

seems to argue that any mark containing the word "HOOK" narrows the scope of protection for the cited mark. However, we find that these third-party registered marks convey quite different commercial impressions than registrant's and applicant's marks (e.g., HOOK AND BULLET, SET THE HOOK, HOOKED ON PHOENIX, HOOKED ON PHONICS, HOOK-UPS, HOOK & TACKLE, HOOK & LADDER, HOOK 'EM HORNS, J.G. HOOK, HOOK SPORT, RED HOOK ESB, HOOKED ON FISHING NOT ON DRUGS, HOOK LINE & SINKER, DUCK HOOKS UNLIMITED, etc.), and hence can hardly be the basis for concluding that the cited mark is a weak trademark.

In conclusion, we find that the marks create quite similar overall commercial impressions, that registrant's identification of goods includes applicant's goods, and that applicant has failed to demonstrate that the phrase OFF THE HOOK is weak in the field of clothing. Accordingly, we find that applicant's mark, when used in connection with the identified goods, so resembles registrant's mark as to be likely to cause confusion, to cause mistake or to deceive.

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