THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Mailed:
November 16, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hudson Salvage, Inc.

Serial No. 76453963

W. Whitaker Rayner of Watkins Ludlam Winter & Stennis, P.A. for Hudson Salvage, Inc.

Robert Coggins, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Simms, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Hudson Salvage, Inc. seeks registration on the Principal Register of the mark DIRT CHEAP for services identified in the application, as amended, as follows:

> "Retail department store services, specifically excluding the sale of beer, liquor and cigarettes," in International Class 35.[1]

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register

[1] Application Serial No. 76453963 was filed on September 30, 2002 based upon applicant's allegation of use of the mark in commerce since at least as early as December 31, 1993.

this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has held that applicant's mark, when used in connection with the recited services, so resembles the mark DIRT CHEAP registered for services recited as "wholesale distributorship, on-line and retail store services featuring beer, liquor and cigarettes," also in International Class 35,[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.

In arguing for registrability, applicant contends that these retail store services are distinct and represent different channels of trade; that this term is used widely by third parties and hence is a relatively weak mark entitled to a narrow scope of protection; and that an affidavit of applicant's representative speaks to ten years of contemporaneous usage without a single known incident of actual confusion.

---

[2] Reg. No. 2613728 issued to D.C., Inc., on September 3, 2002 alleging a date of first use in commerce at least as early as January 1993.

By contrast, the Trademark Examining Attorney argues that the marks are identical; that evidence in the record shows that applicant's recited services are closely related to those of registrant; and that applicant's claim of an absence of actual confusion is entitled to little probative value in the context of this *ex parte* appeal.

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).

As to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound and connotation, there is no question but that the marks are identical in every respect. Hence, with both registrant and applicant using the identical designation, "the relationship between the goods [or services] on which the parties use their marks need not be as great or as close as in the situation where the marks

are not identical or strikingly similar." *Amcor, Inc. v. Amcor Industries, Inc.,* 210 USPQ 70, 78 (TTAB 1981). *See also In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Accordingly, we turn to the similarity or dissimilarity and nature of the goods as described in the application and cited registration. As applicant points out, registrant's retail store services are restricted by the words of the recitation to the retail sale of cigarettes and alcoholic beverages. However, while it is clear that these two recitations provide for no overlap, this fact alone is not determinative herein on the question of likelihood of confusion under Section 2(d) of the Act.

Applicant's recited retail services are offered in department stores and specifically exclude the sale of cigarettes and alcoholic beverages, while the services recited in the registration are limited to the sale of cigarettes and alcoholic beverages. Although applicant amended its recitation of services explicitly to preclude any overlap with registrant's recited services, it is well

established that it is not necessary that the goods or services of the parties be similar or competitive, or even that they move in the same channels of trade, in order to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the Trademark Examining Attorney has made of record a number of third-party registrations which show that a number of third-party retailers have registered marks for both general merchandise typically found in department stores as well as for cigarettes and/or liquor. See, for example, Reg. No. 2484642 for, *inter alia*, retail department store services featuring general merchandise and cigarettes.

Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that

the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

These registrations, thus, serve to demonstrate that services of the type identified in applicant's application and the cited registration can emanate from the same source, and be offered under the same mark.

This evidence is also corroborated with evidence that the Trademark Examining Attorney has drawn from the LEXIS/NEXIS database:

> HEADLINE: *District Crime Watch*
> H St., 700 block, 4 p.m. Feb. 7. A man entered a department store, pointed a gun at a person's head and robbed the store of three cartons of cigarettes and cash.
> *The Washington Post*, February 21, 2002.

> HEADLINE: *Police Report*
> A man was arrested after he was alleged to have concealed cigarettes, underwear and a package of bed sheets under his coat and left the Meijer department store, 855 S. Randall Rd., without paying. Police said Dean Bockman, 36, of the 100 block of South 3rd Street was charged with retail theft.
> *Chicago Tribune*, January 14, 2003.

HEADLINE: *Letters to the Editor*
I personally have been approached on Wood Street to purchase cigarettes or incense or cologne that had been appropriated at local department stores and contained their respective store labels. I think the tax increase will just increase the black market for cigarettes in the state and force people to look elsewhere to satisfy their habit.
Pittsburgh Post Gazette, June 11, 2002.

HEADLINE: *Downtown Will Adapt and Thrive*
My dad has worked for more than 25 years as retail manager for a combination pharmacy/liquor store/gift shop/department store in "beautiful downtown Yankton," as he calls it. That store, Yankton Drug, had already been a downtown landmark for years when the Yankton Mall opened in 1969.
The Desert News (Salt Lake City, UT), May 13, 2002.

HEADLINE: Musical's Webb City Memories
When Webb's City began discounting items featured by Rutland's, the leading department store, the latter countered by discounting cigarettes. The "war" got down to a penny a pack, and ended as both stores offered a free pack with any purchase.
Sarasota Herald-Tribune, July 28, 2001.

HEADLINE: *When You Sing a Song You Can Rise Up*
Kitchenware, liquor, cookies and clothes – albeit cheaply made ones – line department store shelves.
Los Angeles Times, October 25, 2000.

HEADLINE: Police Blotter
LARCENY: At an area department store, an unknown subject reportedly left with $52.69 in cigarettes. Office: Joseph DeSeve, Jr.
The Times Union (Albany NY), August 9, 2000.

Further, even though the retail store services recited in the registration would be limited to the sale of

cigarettes and alcoholic beverages, consumers acquainted with registrant's services are certainly going to encounter both kinds of services. That is, individuals who would be the consumers of cigarettes and alcoholic beverages would also be prospective purchasers of general merchandise offered in applicant's retail department stores. Moreover, both applicant and registrant would appear to be marketing inexpensive items that fall under the category of "impulse items" to the same class of ordinary consumers.

Hence, we find that applicant's and the registrant's identified services are closely related, and that the public is likely to believe, if they were offered under the same mark, that they emanate from the same source.

As to the *du Pont* factor focusing on the number and nature of similar marks in use on similar goods and services, applicant has listed in its reply brief four third-party registrations having composite marks consisting in part of the term "Dirt Cheap." Applicant justifies this tardy attempt to place these registrations into the record by saying the Trademark Examining Attorney for the first time had made an issue of the strength of the mark DIRT CHEAP" in his appeal brief. We reject this argument by applicant.

The Trademark Examining Attorney, in pointing out ever so briefly that the marks are identical, included a single sentence that seems to have been directed to the connotation of the shared term (brief, p. 4): "DIRT CHEAP is a recognized English compound word meaning 'exceedingly cheap.'[with a footnote citation to Merriam-Webster's Collegiate Dictionary]." This statement is likely not even essential in his discussion of the identical commercial impressions created by applicant's and registrant's marks, and certainly does not open the door to applicant's trying to get into the record, by way of its reply brief, evidence from the federal trademark register on the number and nature of similar marks in use on similar goods and services.

Accordingly, we have not considered this proffer of third-party registrations as they were neither timely nor properly made of record.

It is well established that the Board does not take judicial notice of registrations that reside in the United States Patent and Trademark Office, and that the submission of a list of registrations is insufficient to make them of record. *See In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

Moreover, Trademark Rule 2.142(d)[3] provides that the record in an application should be complete prior to appeal and that the Board will ordinarily not consider late-filed evidence. Hence, in reaching our decision, we have not considered the listing contained in applicant's reply brief.

In any event, we hasten to add that even if the third-party registrations had been considered, it would not have persuaded us to reach a different conclusion in this appeal. Third-party registrations, by themselves, are not entitled to much weight in determining whether confusion is likely. *See In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence of what happens in the marketplace or that the public is so familiar with the use of such marks that the other elements are emphasized in order to allow purchasers to distinguish among such marks. *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB

[3] "(d) The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination." 37 C.F.R. §2.142(d).

1975). *See also AMF Inc. v. American Leisure Products, Inc*., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) [third-party registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks]. Thus, applicant has not shown that the registered mark is entitled to a narrow scope of protection. Moreover, even weak marks are entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.,* 193 USPQ 439 (TTAB 1976).

Furthermore, even if we had proof that these marks were used on the goods and services listed in each registration, these registrations would not support the conclusion that the cited mark is a weak trademark for retail store services. Some of the marks convey different commercial impressions than applicant's mark (e.g., LIVING A FULL LIFE DIRT CHEAP), or reflect marks registered for goods (e.g., magazines and computer hardware and software) and services (e.g., travel agency and car rental services) quite different from the services involved herein.

Finally, we turn to the *du Pont* factor focusing on the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. Applicant asserts that it and the registrant have used their marks concurrently for more than ten years without any evidence of actual confusion, and that this shows that confusion is not likely to occur. We are not persuaded by this argument. Rather, we agree with the Trademark Examining Attorney that the affidavit alleging that applicant is unaware of any instances of actual confusion during this period is not determinative herein.

The test under Section 2(d) of the Lanham Act is likelihood of confusion, not actual confusion. Moreover, aside from the facts that we do not know what the registrant's level of usage and promotion of its mark has been or whether the registrant has encountered any confusion, we have no information regarding the amount or geographic area of applicant's sales or its level of advertising such that we could ascertain whether there has been an opportunity for confusion to occur.

Finally, while solid evidence of actual confusion is the best evidence of likelihood of confusion, any confusion about mutual sponsorship or affiliation is notoriously

difficult to obtain and would not necessarily be brought to the attention of either applicant or registrant. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ["The lack of evidence of actual confusion carries little weight … especially in an *ex parte* context"]. Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur, and we find this to be a neutral factor in our balancing of the *du Pont* factors herein.

In conclusion, we find that given the use of identical marks on these related services, the extent of potential confusion herein is substantial.

Decision: The refusal to register based upon a likelihood of confusion with the cited registration is hereby affirmed.