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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Avraham Kadar

Serial No. 76577255

Howard Natter of Natter & Natter for Avraham Kadar.

William T. Verhosek, Trademark Examining Attorney, Law
Office 114 (K. Margaret Le, Managing Attorney).

Before Grendel, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark FWD (in standard character form) for Class 45
services recited in the application as "providing
information about trends in fashion."¹

¹ Serial No. 76577255, filed February 23, 2004. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b). The application also recites services in Class 41 ("providing information about trends in books, music, motion pictures, art and entertainment") and in Class 44 ("providing information about trends in health, beauty and nutrition"). The Class 41 and Class 44 services are not at issue in this appeal.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the recited Class 45 services, so resembles the mark depicted below,



previously registered for Class 42 services recited in the registration as "design and development of new products for others, namely, products used in advertising and marketing and clothing and footwear products,"² as to be likely to cause confusion, to cause mistake, or to deceive.

Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The appeal is fully briefed; no oral hearing was requested. We affirm the refusal to register.

Initially, we must address applicant's contention that the recitation of services in the cited registration is "ambiguous, uncertain and indefinite especially with regard to '...products used in...clothing and footwear products.'"

² Registration No. 2415518, issued December 26, 2000. The registration includes the following description of the mark: "The Mark is a logo consisting of the letters 'FWD' with two leaves."

(Applicant's Brief at 4.) Applicant, for the first time with its appeal brief, submitted what it asserts to be the specimen of use from the file of the cited registration. This specimen appears to be a representation of several hockey sticks bearing the mark NIKE. Applicant contends:

The specimen appears to be a "brand identification" marking used in the marketing and advertising of Nike clothing and/or footwear products. It would logically follow that for the description of the services to be consistent with the specimen usage the registered services should read: "design and development of new products for others, namely products used in advertising and marketing **of** clothing and footwear products."

(Applicant's Brief at 4; emphasis in original.)

In his brief, the Trademark Examining Attorney has objected to applicant's submission of the registration specimen, on the ground that such submission is untimely. Because this evidence was not made of record prior to appeal, we sustain the Trademark Examining Attorney's objection and have given the evidence no consideration. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). We add that we fail to see how the specimen, which appears to depict NIKE hockey sticks, supports applicant's contention in any event.

In his reply brief, applicant argues that even without consideration of the registration specimen, applicant's proffered "interpretation" of the registration's recitation of services, "namely, that the registrant designs and develops new products for others that are used in advertising and marketing of clothing and footwear, (for example, brand identification products and the like)," is the only logical interpretation. Applicant argues that the Trademark Examining Attorney, in his attempt "to impart the following meaning to the services recitation - clothing and footwear product design and development -" has "misinterpreted, redefined, or changed the meaning of registrant's identified services." Applicant continues:

...this is not how the services are described in the registration. Furthermore, when considering the remaining portion of the identification, (product design and development in advertising and marketing), the meaning so imparted would appear to be inconsistent with the remainder [sic - of the] services. A designer of clothing and footwear would not ordinarily be expected to design and develop products for advertising and marketing, as suggested by the examining attorney.

(Reply brief at 2; emphasis in original.)

We are not persuaded by applicant's argument. Indeed, it appears that it is applicant, not the Trademark Examining Attorney, who is attempting to redefine or change

the wording and meaning of the cited registration's recitation of services, by substituting the word "of" for the penultimate "and" in the recitation. We find that the registrant's recitation of services clearly identifies two types of "new products" which are the subject of registrant's design and development services, i.e., "products used in advertising and marketing," and "clothing and footwear products." Applicant's attempt to collapse these two categories of products into one, i.e., "products used in advertising and marketing **of** clothing and footwear products," (emphasis is applicant's), simply is contrary to the plain meaning of the cited registration's recitation of services.³ We therefore agree with the Trademark Examining Attorney's contention that the recitation of services in the cited registration must be deemed to include the "design and development of new products for others, namely, ... clothing and footwear products."

³ To the extent that applicant's argument regarding the indefiniteness of the registration's recitation of services might be construed as an attack on the validity of the registration, we note that such an attack is not appropriate in this ex parte proceeding. We note as well that even if we were to accept applicant's "interpretation" and rewording of the registrant's recitation of services, we would find that such services, i.e., "design and development of products used in the marketing of clothing and footwear products," are sufficiently related to applicant's "providing information about trends in fashion" that confusion is likely to result from use of the nearly identical marks involved herein.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & 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); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the first *du Pont* factor, i.e., whether applicant's mark, FWD (in standard character form), and the cited registered mark



are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles.

The test, under the first *du Pont* factor, 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 impression that confusion as to the source of the goods 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).

We find that applicant's mark is similar to the cited registered mark, under the first *du Pont* factor. Indeed, the only difference between the marks is the presence in the cited registered mark of the two-leaf design element and the absence of such element from applicant's mark. This difference does not suffice to distinguish the marks because it is obvious that the dominant feature of the cited registered mark is the letters "FWD." The two-leaf design element would not be articulated by purchasers, and it contributes relatively less to the commercial impression

of the registered mark. Purchasers would use and recall the letters "FWD" in referring to the cited registered mark, a designation which is identical to applicant's mark. On this record, "FWD" appears to be a distinctive and even arbitrary designation as applied to the services at issue, and its presence in both marks renders the marks similar rather than dissimilar. We find that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn next to the second *du Pont* factor, i.e., the similarity or dissimilarity of applicant's and registrant's respective services. It is settled that it is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection

between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

We agree with applicant's contention that the NEXIS evidence submitted by the Trademark Examining Attorney is not particularly probative on the issue of the relatedness of applicant's and registrant's services. This evidence consists of very short excerpts from articles which include various words such as "information," "design," and "fashion" in close proximity to each other. Most of the excerpts retrieved by the search are clearly irrelevant to our analysis.

However, the Trademark Examining Attorney has submitted printouts of several third-party registrations which include both fashion information services of the general type recited in applicant's application and clothing product design services of the type recited in registrant's recitation of services. Registration No. 1936662, of the mark PECLERS PARIS, covers Class 42 services recited as "fashion and product style design consulting services, and providing fashion information regarding the textile, ready-to-wear and fashion

industries." Registration No. 2264961, of the mark BEAUTY IN ALL FORMS, covers Class 42 services recited as "providing fashion information, fashion tips and dress design." Registration No. 2919232, of the mark RED SHIFT, covers Class 42 services recited as "design services in the field of clothing and fashion articles and accessories; providing fashion information; and fashion consultation." Additionally, the relationship between applicant's fashion information services and registrant's "design and development of ... products used in advertising and marketing" is evidenced by Registration No. 2467913, of the mark CODE RED, which covers Class 42 services recited as "fashion, graphic art, industrial, packaging and printing design for others; design of CD ROMs, postcards, textiles, videos and trade show production sets and signs; providing fashion information; product development consultation." Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Based on this evidence, we find that applicant's recited services are similar and related to registrant's recited services, such that use of the distinctive and arbitrary designation FWD in connection with both types of services is likely to cause source confusion. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Neither applicant's nor registrant's recitations of services are limited as to trade channels or classes of purchasers, so we must presume that the services will be marketed in all normal trade channels and to all normal classes of purchasers for such services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We find that purchasers of registrant's clothing product design services would also be in the market for the "information about trends in fashion" that applicant intends to provide. Clothing product design presumably is undertaken with a view toward setting or keeping up with "trends in fashion." Applicant's and registrant's services, as recited in the application and the registration, respectively, could be offered and rendered to the same purchasers, through the same trade channels. Thus, the third *du Pont* factor (similarity of trade channels and purchasers) weighs in favor of a finding of likelihood of confusion.

We are not persuaded by applicant's contention that the purchasers of these services necessarily are sophisticated or careful purchasers. Even to the extent that such sophistication might be assumed (and there is no evidence of record to support such an assumption), we find that even sophisticated purchasers are likely to be confused as to the source of the respective services when they are marketed under the highly similar "FWD" marks at issue here.

Finally, we are not persuaded by applicant's contention that the likelihood of confusion is lessened by the fact that applicant intends to use its mark in connection with providing information not only about trends in fashion but also about trends in "books, music, motion pictures, art and entertainment" and trends in "health, beauty and nutrition." (See *supra* at footnote 1.) It is applicant's service of "providing information about trends in fashion" that is at issue in this case. The fact that applicant's information services might cover other subjects as well does not eliminate the source confusion that is likely to result from use of these marks, both of which contain the identical arbitrary designation "FWD" and both of which are (or are intended to be) used in connection

with applicant's and registrant's related services in the fashion and clothing field.

Weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists. Both applicant's and registrant's marks consist of or are dominated by the arbitrary designation "FWD," and applicant's recited services are sufficiently related to registrant's recited services that use of these highly similar marks is likely to cause source or other confusion among purchasers. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusal to register applicant's mark as to the Class 45 services recited in the application is affirmed. However, the application shall proceed to publication as to the recited Class 41 and Class 44 services, which are not the subject of the Trademark Examining Attorney's refusal.