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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jan T. Hornbacher

Serial No. 76591635
(filed May 11, 2004)

Robert L. Farris of Farris Law, P.C. for Jan T. Hornbacher

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

Before Seeherman, Grendel, and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Jan T. Hornbacher has applied to register the mark
shown below on the Principal Register for "clothing namely,
shirts, trousers, coats and hats" in International Class
25:¹



¹ Application Serial Number 76591635 is based on an allegation that applicant first used the mark in commerce on November 15, 2000.

Ser. No. 76591635

The application contains a disclaimer of the term APPAREL and a statement that color is not claimed as a feature of the mark.

The examining attorney has refused to register the mark under Section 2(d) of the Trademark Act because of a prior registration for the mark shown below:



for "clothing, namely, blouses, shirts, t-shirts, vests, sweaters, jumpers, skirts, dresses, pants, jackets, blazers, suits, shorts, ties, scarves, robes, belts, hosiery, sleepwear, rainwear, raincoats, overcoats, evening gowns, tuxedos, waistcoats, sashes, cummerbunds, bow ties, capes; footwear; hats and headwear" in International Class 25.² The registration contains a statement that the mark

² Registration No. 3064983, issued March 7, 2006 pursuant to Section 44(e) (based on a foreign registration) and obtaining a priority filing date of March 21, 2002. The registration also issued under Section 2(f) (acquired distinctiveness). The registration also covers "retail store services" in International Class 35; however, the refusal was limited to the goods.

"consists of a pattern of black and white stripes of various sizes used on shopping bags, hang tags, store signage, banners, displays and promotional materials."

After the examining attorney made the refusal final, this appeal followed. The record consists solely of the application file as neither applicant nor the examining attorney submitted evidence regarding the likelihood of confusion refusal. As discussed further below, we affirm the refusal.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act 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. See *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 between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Initially, we look to the level of similarity of the goods and find them to be identical. Indeed, the cited registration's identification of goods encompasses all of the specific articles of clothing identified in the subject application, i.e., shirts, trousers ("pants" in the cited registration), coats ("blazers, raincoats, overcoats, waistcoats" in the registration) and hats. Applicant attempts to argue that purchasers of his goods are sophisticated buyers, that the goods are marketed to different customers and move in different trade channels. However, inasmuch as the respective goods are legally identical and the identifications in the application and cited registration contain no restrictions, we must presume that the goods will be marketed and sold to the same classes of consumers through the same channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958).

Therefore, we find the goods, channels of trade, and classes of purchasers are all factors which strongly support the refusal to register.

We now focus our inquiry on the similarities and dissimilarities in the respective marks, when considered in their entirety. In doing so, we are mindful that where, as here, the goods are identical, the degree of similarity

necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enter. Corp.*, 212 USPQ 957, 959 (TTAB 1981).

As shown above, applicant's mark consists of a barcode design encapsulating a rectangular border containing the wording BARCODE APPAREL.³ The design portion of the mark may be viewed as two barcodes, or as a single barcode which has been divided by the words. The term "apparel," which applicant has disclaimed, is generic and does not have any source-indicating significance. Thus, the obvious dominant features of applicant's mark are the literal term BARCODE along with the barcode design. The word BARCODE reinforces the connotation of the design, while the design reinforces the connotation of the word. The mark as a whole conveys the commercial impression of a barcode.

³ In attempting to distinguish his mark from the cited mark, applicant argues that his mark is not "a black and white design" and that his mark is embroidered on clothing "over a background of [various colors]." Brief, p. 4. However, as noted, the application contains no limitation as to how applicant's mark is to be used and color is not claimed as a feature of applicant's mark. As such, we must assume he will use his mark in the same manner shown on the application drawing page and without any limitation as to the background color, i.e., it may appear on white cloth or any background color, as well as on hangtags, as the registrant indicates its mark is displayed.

As to the registered mark, it, too, will be perceived as a barcode design. While the mark may not be an exact representation of an actual barcode, it is comprised of many various width-bars with varying distances between them and thus it gives the commercial impression that it is a barcode. Applicant correctly points out that the bars in the registered mark are horizontal, not vertical like applicant's, and that the registration does not contain a description of the mark or otherwise indicate that it is intended to represent a barcode. Reply Brief, p. 1.

Nonetheless, based on the widespread use of barcodes in the world of commerce, consumers will perceive the registered mark as a barcode, albeit a fanciful one or one placed on its side. Nearly every product in this country contains a barcode on it and one would be hard-pressed to find a person who does not recognize the pattern of bars/ lines of various widths and separations as a barcode.

In comparing applicant's mark to the cited mark, we find that they create the same commercial impression, namely, that of a barcode. Visually, applicant's mark has the literal phrase BARCODE APPAREL which is obviously not present in the cited mark; however, this does not distinguish the marks and only enhances the connotation and overall commercial impression of the barcode design.

Likewise, the fact that applicant's mark has two vertically-lined barcodes versus the cited mark's single horizontally-lined barcode is not sufficient to distinguish the marks. Ultimately, the same impression will be conveyed to consumers who view the respective marks in connection with identical clothing goods. They will be left with the mental image of a barcode, and they are likely to later refer to the goods as the "barcode" brand of clothing or apparel.

In view of the above, we find that applicant's mark is substantially similar to that of the prior registrant, and this factor supports the examining attorney's refusal to register.

There is no evidence in the record to suggest that the cited mark is weak or that it should otherwise be accorded a limited scope of protection. In particular, we have no evidence of third-party use of the word BARCODE or barcode designs *as source indicators* and, therefore, we must assume that applicant and registrant are the only ones to use a barcode design in their marks. Although barcodes themselves are ubiquitous in the commercial world, they are not ubiquitous as trademarks. We also point out that the cited registered mark is entitled to all presumptions accorded it under Section 7(b) of the Trademark Act.

Specifically, as a registered mark, we must assume that it is a source indicator for the identified goods.

Finally, applicant asserts that he has used his mark since November 15, 2000 and he is unaware of any actual confusion between his mark and the cited mark. Brief, pp. 8-9. In an *ex parte* case, as we have here, the absence of actual confusion is hardly unusual and seldom is a significant factor in finding that there is no likelihood of confusion. In particular, we have no evidence here as to extent of either applicant's or the registrant's use of the respective marks, and therefore we cannot determine whether there has been any significant opportunity for actual confusion to have occurred. See *Majestic Distilling*, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight"). Thus, we consider this factor to be neutral.

After considering the relevant du Pont factors, as discussed above, we find that applicant's mark is likely to cause confusion with the mark in Registration No. 3064983.

Decision: The refusal to register is affirmed.