

**THIS OPINION IS NOT A  
PRECEDENT OF  
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Mailed: August 13, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re TBAC Investment Trust

Serial No. 76662158

Diane K. Lettelleir of Winstead PC for TBAC Investment Trust.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Seeherman, Cataldo and Taylor,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by TBAC Investment Trust to register on the Principal Register the mark shown below for "men's wallets" in International Class 18.<sup>1</sup>



<sup>1</sup> Application Serial No. 76662158 was filed on June 26, 2006, based on applicant's assertion of its bona fide intent to use the mark in commerce. Applicant also claims ownership of Registration Nos. 0674224, 0911958, 0998500 and 2049808.

The examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used in connection with its goods, so resembles the mark shown below, previously registered on the Principal Register for "bags, namely, suitcases, trunks for traveling, traveling bags, attaché cases, briefcases, handbags, and purses" in International Class 18,<sup>2</sup> as to be likely to cause confusion.<sup>3</sup>



When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

#### **Preliminary Matters**

Before turning to the substantive ground for refusal, we note that applicant has submitted several exhibits with

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<sup>2</sup> Registration No. 1692993 issued on June 9, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

<sup>3</sup> The examining attorney further based his Section 2(d) refusal on Registration No. 1462806, owned by the same registrant as No. 1692993, which expired under Section 9 of the Trademark Act on August 2, 2008. Accordingly, the refusal to register as to Registration No. 1462806 is moot.

its reply brief. These exhibits consist of a copy of one of its asserted registrations, and printouts from registrant's Internet website. We find that these exhibits are untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). We note, however, that had we considered these exhibits in our determination of the issue on appeal, the result would be the same.

#### **Likelihood of Confusion**

Turning now to the matter under appeal, our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors outlined in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, though not exclusive, 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, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

Similarity of the Marks

We first consider whether applicant's mark and registrant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, applicant's mark,



is similar to registrant's mark,



in that both contain the word ACE as the most prominent feature thereof. ACE, as it appears in both marks, is identical in sound and meaning, and similar in appearance. Moreover, ACE appears to have the connotation of a playing card in applicant's mark, and there is nothing in registrant's mark that suggests a different connotation.

The word ACE in applicant's mark is clearly the dominant element. It is displayed in letters that are much larger in size than the remaining wording, BY CANTERBURY, in applicant's mark. Thus, ACE is the portion of applicant's mark to which the viewer is drawn, as well as the portion that the viewer is most likely to remember. The ace of spades design in applicant's mark, though visually prominent, is less significant than the word ACE. This is because, as further discussed below, it is by the word ACE that consumers will refer to or request the identified goods. *See In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Further, the ace of spades design lends additional emphasis to the word ACE. For these reasons, we consider ACE to be the dominant feature of the applied-for mark.

As for the presence of BY CANTERBURY in applicant's mark, this term appears in very small script as compared to the script in which ACE appears and thus is far less

visually prominent. Consumers are likely to regard this phrase as less important, and thus will refer to the mark as ACE, instead of pronouncing the six-syllable ACE BY CANTERBURY. See *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks.”)

With regard to applicant’s argument that “CANTERBURY is a famous house mark” (brief, p. 5), it is well established that the addition of a house mark may not obviate the similarity between the marks overall or overcome a likelihood of confusion under Section 2(d). See *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE for retail clothing store and clothing and CREST CAREER IMAGES for uniforms); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY’S ACCU TUNE for automotive service centers and ACCUTUNE for automotive testing equipment); and *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982) (MENNEN SKIN SAVERS for hand and body lotion and SKIN SAVERS for face and throat lotion). Applicant’s further argument that its CANTERBURY mark is famous also does not help in this effort to distinguish the marks because purchasers familiar with registrant’s ACE and design mark in connection with its goods, upon encountering applicant’s ACE BY CANTERBURY and

design mark on its goods are likely to believe that applicant is the source of registrant's ACE goods.<sup>4</sup> "[I]t [the house mark] would only serve to aggravate the likelihood of confusion that would arise from the contemporaneous use of the marks on the respective goods." *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark DIOR to applicant's LE CACHET DE DIOR for shirts does not obviate likely confusion with CACHET for dresses and toiletries).

With regard to the mark in the cited registration, the word ACE is also the dominant element. It is visually prominent, and it is likely to be most noted and remembered inasmuch as it is the sole term in the mark that can be articulated. Accordingly, it is by the word ACE that customers would request the identified goods. See *In re Appetito Provisions, supra*. The design element, while of equal size to the word ACE, consists of a relatively nondescript oval within another oval, and is less likely to make an impression upon viewers than ACE.

Viewing the marks in the involved application and cited registration as a whole, we find that the identity of

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<sup>4</sup> We note that applicant did not introduce sufficient evidence to support a finding that its CANTERBURY marks are famous and, in any event, because BY CANTERBURY is not visually prominent, it would not serve to distinguish the marks.

the dominant feature, namely, the word ACE, in sound and meaning results in the marks conveying similar overall commercial impressions. We note that 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 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).

In this case, we find that the similarities in the marks outweigh the differences and, accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

Similarity of the Goods

Turning now to our consideration of the recited goods, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related

in some manner, and/or that the conditions and activities surrounding the marketing thereof 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, applicant's "men's wallets" are closely related to, at least, registrant's handbags and purses, in that both types of items are used to carry an individual's personal items. Specifically, it is commonly understood that registrant's handbags and purses perform the same function as men's wallets, namely, carrying one's money, identification, credit and other cards, etc. In addition, wallets are frequently carried in handbags. Although we recognize that applicant's goods are identified as men's wallets, and in the United States handbags and purses are generally used by women, women may still buy wallets for men, and thereby would encounter both applicant's and the registrant's goods. Because of the complementary nature of wallets and handbags, such consumers are likely to believe that such goods emanate from a single source if they were sold under confusingly similar marks. Further, registrant's registration is for a variety of items, i.e.,

trunks, traveling bags, attaché cases, briefcases and suitcases, in addition to handbags and purses, most of which can be used by men. Because of the similar nature of wallets to these items, consumers who are familiar with registrant's goods are likely to believe that men's wallets are an extension of registrant's line of goods.<sup>5</sup>

In view of the foregoing, this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

Applicant's and registrant's goods are consumer items that are purchased by the public at large. Applicant has acknowledged that its men's wallets would be sold at the small leather accessories counter of general and specialty stores (brief, p. 6). Handbags and purses and even attaché cases may also be purchased at such a counter. While we agree that items such as trunks and suitcases are not likely to be sold or displayed with men's wallets, it is not necessary that all the goods recited in the registrant's registration be sold with applicant's identified goods in order to find a likelihood of

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<sup>5</sup> In reaching this conclusion, we have given no consideration to the third-party registrations made of record by the Examining Attorney. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the goods. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

confusion. See, for example, *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Moreover, wallets, handbags attaché cases and suitcases may all be found in luggage stores.

Furthermore, because there are no restrictions in either applicant's or registrant's identification of goods as to the channels of trade in which the goods may be encountered, or type or class of customer to whom the goods and services are marketed, both applicant's and registrant's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

As a result, this *du Pont* factor also favors a finding of likelihood of confusion.

#### Sophisticated Purchasers

Another *du Pont* factor discussed by applicant is that of the conditions of sale. Applicant claims that customers for luggage and like items are "sophisticated consumers." However, there is no evidence that either applicant's or registrant's goods would be purchased only by sophisticated persons. Wallets, purses, suitcases, handbags and travel bags may be purchased by any ordinary consumer, who may or may not exercise a great deal of thought with regard to the

purchase. Moreover, and as discussed above, applicant's mark is so similar to that of registrant that even careful purchasers are likely to assume that the marks identify goods emanating from a single source.

As a result, this *du Pont* factor further favors a finding of likelihood of confusion.

Summary

In summary, weighing all of the relevant *du Pont* factors, we find that a likelihood of confusion exists. Moreover, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *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.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.