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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steve Purcell

Serial No. 77058644

Richard W. Stim for Steve Purcell.

Bernice L. Middleton, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Bucher, Drost and Cataldo, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Steve Purcell seeks registration on the Principal Register of the mark Sam & Max *(in standard character format)* for goods identified in the application as "T-Shirts" in International Class 25.[1]

This cases is 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 has found that

[1] Application Serial No. 77058644 was filed on December 6, 2006 based upon claims of first use anywhere and first use in commerce at least as early as December 1, 1992.

applicant's mark, when used in connection with the identified goods, so resembles the mark SAM & MAX *(in standard character format)* registered in connection with "women's apparel, namely pants, jackets and blouses" in International Class 25,[2] as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney fully briefed the appeal. We affirm the refusal to register.

Applicant contends that there is no likelihood of confusion given that applicant's use of the mark Sam & Max in connection with comic book characters since 1987 has created a distinct commercial impression connected uniquely with applicant; that applicant's and registrant's channels of distribution, advertising and promotion have no overlap, and there is no "proximity" between the respective goods; that buyers of the respective goods are sophisticated and can distinguish the source of these very different goods; and that applicant's decades-earlier adoption of the mark demonstrates his good faith intent, and negates the stated concerns of the Trademark Examining Attorney that this registrant needs protection from a "newcomer."

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[2] Registration No. 3281385 issued on August 21, 2007.

By contrast, the Trademark Examining Attorney argues that since the marks of the applicant and registrant are identical and the goods of applicant and registrant are closely related, there is likelihood that purchasers would confuse the sources of these goods.

Likelihood of Confusion

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on 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 and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Marks

We turn first to the *du Pont* factor focusing on the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The marks herein are identical as to appearance, sound and meaning. Furthermore, we agree with the Trademark Examining Attorney that applicant's particular history with its Sam & Max cartoon characters is irrelevant to the intrinsic commercial impression of these arbitrary words when applied to T-shirts.

Hence, this critical *du Pont* factor favors a finding of likelihood of confusion.

Relationship of the goods:

We begin our discussion of this *du Pont* factor keeping in mind that whenever the marks of the respective parties are identical, the relationship between the goods of the respective parties need not be as close to support a holding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); and *Amcor, Inc. v. Amcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981).

When dealing with different items in International Class 25 (the clothing class), we have often stated that there is no *per se* rule that all clothing items are related. However, the Trademark Examining Attorney has cited to a series of cases finding some quite-divergent

items of clothing to be related for purposes of Section 2(d) of the Trademark Act:

women's *boots*	men's and boys' underwear[3]
underwear	neckties[4]
women's pants, blouses, shorts and jackets	women's *shoes*[5]
women's *shoes*	outer shirts[6]
hosiery	trousers[7]
men's suits, coats, and trousers	*ladies' pantyhose and hosiery*[8]
brassieres and girdles	slacks for *men* and young men[9]

Interestingly, the goods in these reported cases are often quite different in descriptive properties (e.g., items clearly directed to persons of the opposite gender, under-clothes vs. outer clothes or accessories, items of apparel vs. footwear, etc.). By contrast, in the instant case, the

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[3] *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549 (CCPA 1961).

[4] *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992).

[5] *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

[6] *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985).

[7] *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982).

[8] *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975).

[9] *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964).

goods are all common items of clothing that are worn together. In fact, we note that women's blouses and T-shirts are alternative types of tops worn by women. Hence, we are most comfortable finding that T-shirts are closely-related to women's pants, jackets and blouses. Undoubtedly, if consumers who are acquainted with SAM & MAX blouses, pants, and jackets later saw Sam & Max T-shirts, many, if not most, would assume that there was some association between the sources of these respective goods.

Unfortunately, the ten third-party registrations placed into the record by the Trademark Examining Attorney are not at all probative of this point. While each of these registrations does list both sets of goods, none of these registrations is based on use of the mark in the United States. Rather, all are owned by non-U.S.-based companies relying upon recently-issued foreign country registrations.[10] The majority of the identifications of goods contain pages-long, alphabetical listings of substantially all the International Class 25 goods listed in the United States Patent and Trademark Office's *ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL*.

[10] Registration Nos. 3268608 [Spain], 3283246 [Japan], 3318382 [Germany], 3360033 [Sweden], 3376226 [Switzerland], 3382122 [Italy], 3385745 [Germany], 3402119 [Japan], 3409447 [Australia] and 3411794 [Italy].

Nonetheless, as to this factor, we conclude that the goods are related items of clothing.

Channels of Trade, Classes of Consumers and Conditions of Sale

Applicant's theory of the case relies upon the specific history of his mark and the ever-expanding enterprises associated with his Sam & Max franchise:

> Applicant Steve Purcell created the characters Sam & Max for his 1987 comic book, *Sam & Max: Freelance Police.* Sam and Max are wise-cracking fictional detectives; Sam is a dog and Max is a rabbit-like creature. Like many comic book characters, they have anthropomorphic qualities. *The New York Times* described the pair as "a trench-coated hound dog and his psychopathically violent rabbit partner."
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> The adventures of the characters continued through three additional *Sam & Max* comic books between 1988 and 1992. In 1992, Purcell began authorizing the sale of *Sam & Max* t-shirts.
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> In 1993, Purcell licensed the Sam & Max video game rights to LucasArts for *Sam & Max Hit the Road*. The popularity of that videogame led to a license for an animated TV series, *Sam & Max: Freelance Police.* Thirteen episodes of the TV series aired on the Fox Kids programming block in the U.S. and Channel 4/S4C in the UK from 1997 through 1998.
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> In 2005, Purcell licensed the Sam & Max videogame rights to Telltale Games. Telltale created a series of episodic *Sam & Max* video games, released during 2006 and 2007. In July, 2007, Purcell received an Eisner Award (Best Digital Comic) at San Diego's Comic-Con for his *Sam & Max* comics.
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> After two decades, the cumulative result of the *Sam & Max* comic books, video games, television series, and merchandise is that the mark SAM

> & MAX, as associated with Purcell, creates a strong commercial impression. It is the type of strong source connection between comic book character and creator that the Board has previously acknowledged *(See DC Comics v. Pan American Grain Mfg. Co.,* 77 USPQ 2d 1220 (TTAB 2005)). When consumers — particularly fans of comic books and video games — see the mark SAM & MAX on T-shirts they likely view it as Applicant's exclusive indicia.

However, in making determinations of likelihood of confusion, it is well-established that we must look to the goods as identified in the registration and application. Although applicant points to evidence that registrant and applicant tend to employ distinct channels of trade, we cannot resort to such extrinsic evidence in order to restrict registrant's or applicant's goods. *See, e.g., In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) [evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration]. Neither of these identifications contains any limitations as to trade channels, classes of purchasers, etc. Therefore, we must assume that registrant's clothing and applicant's T-shirts are sold everywhere that is normal for such items, and that the same classes of ordinary purchasers will be shopping for both types of items.

Accordingly, these related *du Pont* factors also support a determination of likelihood of confusion.

Finally, we note that under the circumstances of this *ex parte* appeal, we do not find relevant to our determination the discussions by applicant and/or the Trademark Examining Attorney of issues relating to priority of use, good faith adoption, speculation about the anticipated zones of expansion for manufacturers or merchants in the clothing field or claims that are unsupported by evidence, such as the alleged sophistication of the purchasers or the actual locations where the respective goods are usually marketed within specific retail establishments.

Conclusion

We find that with identical, arbitrary marks applied to related items of clothing, there is a likelihood of confusion herein.

Decision: The refusal to register this mark based upon Section 2(d) of the Lanham Act is hereby affirmed.