

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Forsyth of Canada, Inc.

Serial No. 78202126

Norman P. Soloway of Hayes Soloway for applicant.

Steven R. Berk, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Seeherman, Quinn and Rogers, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Forsyth of Canada, Inc. to
register the mark

EXPAND - A - COLLAR

for "men's shirts."¹

¹ Application Serial No. 78202126, filed January 10, 2003, based on an allegation of a bona fide intention to use the mark in commerce.

The trademark examining attorney refused registration on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered marks EXPAND-A-WAIST for "women's apparel, namely, pants"² and EXPAND-A-BAND for "hats"³ as to be likely to cause confusion under Section 2(d) of the Trademark Act. The registrations are owned by two different entities.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.⁴ An oral hearing was not requested.

Applicant argues that its mark is different from each of the cited marks, pointing to differences in sound and appearance and to the weakness of the "EXPAND-A" portion of the marks. The commercial impression created by its stylized mark, according to applicant, is that of a shirt collar, which is different from the commercial impressions engendered by the cited marks. Applicant also contends that the goods are different, and move in different trade channels. In connection with its argument that "EXPAND-A" is suggestive and renders each of the cited marks weak, applicant submitted copies of twelve third-party

² Registration No. 2241115, issued April 20, 1999.

³ Registration No. 2391279, issued October 3, 2000.

⁴ The examining attorney identified above did not assume responsibility of the application until the filing of the appeal brief.

registrations of "EXPAND-A-" formative marks, highlighting, in particular, the "peaceful coexistence" of the two cited marks.

The examining attorney maintains that the similarities between the marks outweigh any differences, pointing to the similar construction of the marks in that all begin with "EXPAND-A" followed by a highly descriptive term. Insofar as the stylization of applicant's mark is concerned, the examining attorney responds by indicating that the cited marks, being in typed form, could be used in the same manner of display. As for the goods, the examining attorney asserts that all are clothing items that move in the same trade channels to the same classes of purchasers, and that the distinctions relied upon by applicant are unsupported by any evidence. In support of the refusal, the examining attorney introduced several third-party registrations showing that entities have adopted a single mark for all of the types of clothing involved herein.

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 set forth in *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

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(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). We acknowledge, at the outset, that there is no *per se* rule governing likelihood of confusion in cases involving clothing items. *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984).

With respect to the marks, we recognize that there are similarities between them in sound, appearance and meaning to the extent that all begin with "EXPAND-A" and end with a descriptive term related to clothing. The only common feature of the marks, however, is this highly suggestive "EXPAND-A" portion, and we find that the highly suggestive nature of the marks is a significant factor to consider in this case. See *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910 (TTAB 1988). Each of the respective marks conveys the notion that the product sold thereunder is expandable for a comfortable fit. The mere common presence in the marks of the highly suggestive terminology "EXPAND-A," which conveys the notion that the product is expandable, is insufficient here to support a finding of

likelihood of confusion. The descriptive words that follow, namely "COLLAR," "WAIST" and "BAND," are all different in sound, appearance and meaning. See: In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); and Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). Also, the stylization of applicant's mark conjures up the image of a shirt collar, and this stylization serves to further distinguish applicant's mark in appearance and connotation from either of the registrants' marks. In comparing the marks, we recognize that the cited marks are in typed form and, thus, as pointed out by the examining attorney, they can be displayed in a variety of formats. We are required, however, to consider only reasonable forms of display for the cited marks. Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1235 (TTAB 1992). Applicant's particular form of display, approximating a shirt collar, is not within the range of forms of display we would consider reasonable for the cited marks. Thus, even if the cited marks were set forth in stylized forms of display, they would not be set forth in a form approximating applicant's shirt collar display.

In gauging the suggestiveness of the involved marks, we have considered the twelve third-party registrations

introduced by applicant. These registrations are of limited probative value inasmuch as only two of the registrations, which happen to be the two cited registrations under Section 2(d), are in the clothing field. Be that as it may, it is clear that the terminology "EXPAND-A" is suggestive, and that consumers primarily will look to other elements in the marks to distinguish the source of the goods. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984). This finding is supported by the coexistence of the two cited registrations on the register.

Insofar as the goods are concerned, applicant acknowledges that men's shirts, women's pants and hats are all clothing items. As noted above, the examining attorney introduced several third-party registrations which individually cover these clothing items and which are based on use. This evidence serves to suggest, not surprisingly in the present case, that men's shirts, women's pants and hats are the types of goods which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Nevertheless, although men's shirts, women's pants and hats are clothing items that travel in the same trade channels to the same classes of consumers, each item is specifically different.

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Based on the highly suggestive nature of the involved marks, and the cumulative differences between the marks and the goods sold thereunder, we find that confusion is not likely to occur among consumers in the marketplace.

Decision: The refusals to register are reversed.