

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Hearing:
3/8/07

Mailed: 7/5/07

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paul Stuart, Inc.

Serial No. 78246819

Paul Fields, Laura J. Winston and Kathryn A. Starnella of
Darby & Darby for Paul Stuart, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Bucher and Cataldo, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Paul Stuart, Inc. filed an application to register the
mark SILKY POWDER ("SILKY" disclaimed) for "clothing,
namely, suits, pants, skirts, and jackets" in International
Class 25.¹

The trademark examining attorney refused registration
under Section 2(d) of the Trademark Act on the ground that

¹ Application Serial No. 78246819, filed May 7, 2003, alleging a
bona fide intention to use the mark in commerce. Applicant
subsequently filed an amendment to allege use setting forth dates
of first use of July 15, 2003.

Ser No. 78246819

applicant's mark, as used in connection with applicant's goods, so resembles the previously registered mark shown below



for "clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts and hats" in International Class 25² as to be likely to cause confusion.

When the refusal to register was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was held at which applicant's attorney and the examining attorney appeared.

Applicant argues, in urging reversal of the refusal, that the involved marks are different in sight, sound and meaning. Applicant also contends that, in view of the existence of third-party registered marks of POWDER-formative marks in the clothing field, the cited mark is

² Registration No. 2843001, issued May 18, 2004.

entitled to only a narrow scope of protection. In connection with this argument, applicant submitted five third-party registrations that, applicant asserts, demonstrate that the Office "has ascertained an improbable likelihood of consumer confusion among these marks for clothing products." (Brief, p. 10).

The examining attorney maintains that the goods are identical in part, and otherwise are closely related. As to the marks, the examining attorney contends that they are similar inasmuch as applicant essentially has adopted the entirety of the literal portion of registrant's mark and merely added the descriptive word "silky" to it. The examining attorney is not persuaded by the third-party registration evidence, stating that none of the five registered marks is as close to the cited mark as is applicant's mark. In support of the refusal, the examining attorney submitted a dictionary definition of the word "silky."

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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed.

Cir. 2003). In any likelihood of confusion analysis, however, 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).

Insofar as the goods are concerned, the goods are identical in part, or otherwise are related. The identifications of goods in the application and the cited registration both list "pants, skirts, [and] jackets."

Given that applicant's and registrant's goods are legally identical or otherwise related, we assume that these goods travel in the same channels of trade (e.g., retail clothing stores, boutiques, etc.), and that the same classes of purchasers buy these goods. These purchasers would include ordinary consumers who would be expected to exercise nothing more than ordinary care in buying either applicant's or registrant's goods.

That the goods are legally identical in part, and that they move in the same trade channels to the same purchasers are factors that weigh heavily in favor of a finding of a likelihood of confusion.

We next turn to compare registrant's mark POWDER and design with applicant's mark SILKY POWDER. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test 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 their entireties 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. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, where, as in the present case, the marks appear on, at least in part, legally identical goods, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

With respect to the cited mark, 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. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."] For example, in the past it has been stated that the literal portion of a mark dominates a design feature because consumers will use the literal portion to refer to the goods. *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). We find this clearly to be the case with registrant's mark. The literal element, POWDER, is the dominant element of the mark and is therefore accorded greater weight in determining the likelihood of confusion. Although we acknowledge that there is no general rule as to whether a word or a design dominate in any particular mark, it is highly unlikely that consumers will remember the rather non-distinct background design in registrant's mark. We disagree with applicant's assessment that the design feature is "significant." (Reply Brief, p. 3). Rather,

given the easily pronounced word "Powder," it is far more likely that this term will be the element remembered and used by customers in buying registrant's clothing.

Applicant's mark SILKY POWDER is similar to the dominant element, "POWDER," in registrant's mark. Applicant has merely added a descriptive, disclaimed term to the literal portion of registrant's mark. The term "silky" is defined, in pertinent part, as "resembling silk; lustrous." The American Heritage Dictionary of the English Language (3d ed. 1992). Given the descriptiveness of this term for applicant's goods, and the fact that it has been disclaimed, the addition of "SILKY" in applicant's mark does not serve to sufficiently distinguish it from registrant's mark. The general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or subordinate matter thereto. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) [HEWLETT PACKARD and PACKARD TECHNOLOGIES]; *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) [MACHO and MACHO COMBOS]; *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) [RESPONSE and RESPONSE CARD]; and *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) [CONFIRM and CONFIRMCELLS]. Although applicant adopted the entirety

of only the literal portion of registrant's mark, the same principle applies here.

The marks involved herein, POWDER and design, and SILKY POWDER, are similar in sound and appearance. Neither the stylization of the letters in "POWDER" nor the design feature in registrant's mark serves to sufficiently distinguish the marks in appearance. As to meaning, the term "silky" accentuates or further defines the term "powder," giving applicant's mark a lustrous image. Thus, we agree with applicant that its mark suggests a smoothness or softness about the feel of applicant's clothing, a suggestion not present in registrant's mark. Nonetheless, the terms "silky" and "powder" go together, and the involved marks, when applied to identical goods, engender sufficiently similar overall commercial impressions. Consumers familiar with registrant's pants, skirts and jackets sold under the mark POWDER and design are likely to mistakenly believe that the mark SILKY POWDER identifies a silk line of clothing sold by registrant.

In attempting to distinguish the marks, applicant points to the existence of five third-party registrations of POWDER-formative marks. Applicant essentially argues that if these third-party registered marks can peacefully

coexist on the register, then applicant's and registrant's marks likewise can peacefully coexist.

The third-party registration evidence is entitled to limited probative value. The registrations are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result would be able to distinguish between the POWDER marks based on differences between them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). In any event, as thoroughly discussed by the examining attorney, each of the third-party registered marks, GOT POWDER?, POWDER ROOM, POWDER BLU, POWDER RIVER and POWDER BANDIT, has a meaning and commercial impression different from each other and from registrant's mark. (Appeal Brief, pp. 9-10). Contrary to the gist of applicant's argument, we view applicant's mark to be closer in sound, appearance, meaning and commercial impression to registrant's mark than any of the third-party registered marks.

We conclude that consumers familiar with registrant's pants, skirts, and jackets sold under the mark POWDER and design would be likely to believe, upon encountering

Ser No. 78246819

applicant's mark SILKY POWDER for the identical clothing items, that the goods originated with or are somehow associated with or sponsored by the same entity.

Lastly, 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. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.