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Hearing:
October 20, 2005

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Umbro International Limited

Serial No. 78294292

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114 (K. Margaret Le, Managing Attorney).

Before Rogers, Zervas and Walsh, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Umbro International Limited has appealed from the
final refusal of the trademark examining attorney to
register



as a trademark for the following goods:

"sport bags, handbags, school bags, bags for
athletic use, holdalls in the nature of sacks for
athletic use, haversacks, rucksacks, luggage,

wallets, purses, briefcases and umbrellas" in International Class 18;

"rugby and soccer jerseys and shorts, goal keepers' sweaters and shorts and pants, track suits, T-shirts, sweat tops, polo shirts, socks, shoes, gloves, fleece tops, track singlets and track shorts, jackets, shower jackets, training bibs, hats, caps and belts" in International Class 25; and

"sport balls, footballs and rugby balls, tennis racquets, squash racquets and badminton racquets, shin guards for athletic use, knee guards for athletic use, shoulder pads for athletic use, gloves specifically adapted for use in boxing, golf and baseball, bags specifically adapted to carry sports articles; sports training appliances and devices namely cones, flags and nets" in International Class 28.¹

The examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles (i) the previously registered mark FUTSAL (in standard character form) for "soccer balls"² in International Class 28; and (ii) the previously registered mark

FUTSAL

(stylized) for goods including "clothing, namely, warm up suits, jerseys, trousers, footwear and headwear" in

¹ Application Serial No. 78294292, filed August 29, 2003, asserting a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 2280951, issued September 28, 1999. Section 8 and 15 filings accepted and acknowledged.

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International Class 25,³ that, as intended to be used on applicant's identified goods, applicant's mark is likely to cause confusion or mistake or to deceive. Office records reflect that the same entity or person does not own the cited registrations, but that the owners thereof share the same correspondence address.

Applicant has appealed the final refusal. Both applicant and the examining attorney have filed briefs. An oral hearing was held on October 20, 2005.

We affirm the Section 2(d) refusal of registration.

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

³ Registration No. 1717966, issued September 22, 1992. Renewed April 27, 2003.

also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We initially consider the similarities between registrant's and applicant's goods for each International Class in the subject application.

International Class 25

Applicant's "rugby and soccer jerseys," "shoes," and "hats" are encompassed within registrant's "jerseys," "footwear" and "headwear," respectively. Further, applicant's "track suits" are legally identical to registrant's "warm up suits."

International Class 28

Inasmuch as applicant's identification of goods includes "sport balls," and registrant's identification of goods is "soccer balls," and soccer balls are sports balls, at least with respect to soccer balls, applicant's and registrant's goods are legally identical.

International Class 18

In her brief, the examining attorney has not offered any specific arguments regarding any similarities between the goods in International Class 18 and the goods of the cited registrations.⁴ Also, the examining attorney has not

⁴ The examining attorney argues that with respect to Registration No. 2280951, "the registrant is using the mark on soccer balls,

submitted any evidence showing that applicant's International Class 18 goods and the goods in the cited registrations are related. However, applicant specifies in its identification of goods that its bags and sacks are for "sport[s]" or "for athletic use," and applicant's attorney conceded in the oral hearing that the goods, including the goods in International Class 18, are related. Thus, we find that the goods of International Class 18 are similar or related to the goods of the cited registrations.

In view of the foregoing, we conclude that several of applicant's goods in International Class 25 and one of the goods in International Class 28 are encompassed within, or are legally identical to, registrants' listed goods, and that several of applicant's International Class 18 goods are similar or related to the goods of the cited registrations.

We next consider the similarities of the marks. We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the

while the applicant uses the mark on 'sports balls' as well as other balls and equipment for use therewith." Brief at unmarked p. 9. Ostensibly, the examining attorney's reference to "equipment for use therewith" would include the "sport bags" "bags for athletic use" and "holdalls in the nature of sacks for athletic use" in International Class 18.

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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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Also, we are guided by the well-established principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we are in agreement with the examining attorney that the word portion is the most significant feature of applicant's mark. When a mark has a word portion and a design portion, as does applicant's mark, it is the word portion of a mark, rather than the design feature, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods or services and, thus, it is the word portion that will be accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994). The design component of applicant's mark consists of an ordinary depiction of a

soccer ball and is not so distinctive as to be accorded more or even equal weight with the wording of the mark.

The examining attorney characterizes the wording in the mark as "the word "FUT5AL," "which is almost identical to the registered marks, each of which consists solely of the word FUTSAL." Brief at unmarked p. 5. Applicant argues that the word "futsal" is generic and used to identify the game of futsal; that "Registration Nos. 1717966 and 2280951 should not be protected from registration of a distinguishable mark"; and that "the marks look different because of the substitution of the numeral '5' for the letter 'S' in the word 'futsal.'" Brief at p. 3; reply at p. 3.

We consider first applicant's contention that the registered marks are generic.⁵ Pursuant to Trademark Act Section 7(c), 15 U.S.C. §1057(a), a registered mark is

⁵ In connection with its contention that the mark is generic, applicant stated as follows: An Internet search on www.yahoo.com for "FUTSAL" uncovers at least 1,000 references to "FUTSAL", further highlighting the fact that FUTSAL is the generic name for the sport of the same name. Futsal is defined at www.encyclopedia.thefreedictionary.com as the indoor version of association football that is officially sanctioned by football's international governing body" Reply at p. 2. At the oral hearing, the examining attorney objected to the attempted introduction of this evidence. The objection is sustained and we do not give any further consideration to this evidence. The record on appeal must be completed prior to filing the notice of appeal. Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). See also, TBMP §1207.01 (2d ed. rev. 2004).

presumed valid and distinctive. See also, e.g., *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997), citing *In re Calgon Corp.* 435 F.2d 596, 168 USPQ 278 (CCPA 1971) and *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 165 USPQ 515 (CCPA 1970). Applicant's contention that the registered marks are generic therefore is an impermissible collateral attack on the validity of the cited registrations and will not be further considered.⁶ See *Dixie Restaurants, supra*.

Turning next to the sound or pronunciation of the marks, i.e., as "foot-five-all,"⁷ "foot-five-al" or "futsal," we note that there is no correct pronunciation of a mark. See *Interlego AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002). We conclude that the general public, the potential purchasers of these goods, are most likely to pronounce applicant's mark simply as "futsal." Applicant's suggestion that purchasers will both recognize the "5" as a numeral and adopt the awkward pronunciation of the numeral in the middle of the letter

⁶ Section 14(3) of the Trademark Act, 15 USC §1064(3), permits cancellation if a "registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered ..."

⁷ Applicant maintains too that the "5" "is suggestive of the number of players on a futsal team." Reply at p. 5.

string strains reason. In the absence of any evidence that this is the case, we reject this argument.⁸

Because we have found that the sound or pronunciation of the marks is the same, we find too that the connotation of the marks is similar.⁹

We next consider the appearance of the marks. The examining attorney correctly points out that the mark depicted in Registration No. 2280951 is in standard character form. As such, registrant is not limited to presentation of its mark in any particular stylization and may display its mark in various formats or fonts, in upper or lower case letters, and may, in choosing a particular form of display, end up with a mark very similar in appearance to the word in applicant's mark. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); 37 C.F.R. §2.52(a). Thus, with respect to Registration No. 2280951, we find that the marks are similar in appearance.

⁸ Even if applicant was in the future to attempt to educate the public as to how to pronounce its mark, we are of the firm belief that a significant portion of the consuming public would still pronounce applicant's mark as "futsal."

⁹ The design element of applicant's mark does not suggest a connotation different from the connotation of the cited marks. In other words, the design element is neutral and does not dictate one connotation over another.

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We add too that the stylization of the mark which is the subject of Registration No. 1717966 is minimal, and not particularly noteworthy. Thus, its appearance, in light of the other similarities in the marks, is not such that it serves to otherwise distinguish the marks. Additionally, differences in stylized lettering are generally given less weight than the words per se, because it is by words that purchasers will refer to the goods, and the words themselves, rather than the stylized lettering, will therefore make a greater impression on consumers. See *Ceccato, supra*.

Regarding the commercial impressions of the marks, they are also similar. The wording in applicant's mark figures prominently in creating the commercial impression of the mark, and this wording, when spoken, will likely be identical in pronunciation to the pronunciation of registrants' marks.

Thus, in view of the foregoing, we find that applicant's mark and the cited marks are similar or even identical in sound, appearance, connotation and commercial impression.

Two additional arguments raised by applicant require comment. First, applicant maintains that "there is no evidence of actual confusion" and second, applicant

maintains that "the potential for confusion is de minimis." Brief at p. 3. The lack of actual confusion is seldom decisive in ex parte cases. In *In re Majestic Distilling Co.*, *supra*, the Federal Circuit stated:

... uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 52 CCPA 981, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

In this ex parte case, we have no indication of what registrants' views and evidence on this issue would be, and we similarly give applicant's assertion of no actual confusion little weight. Also, in view of the identity of some of the goods and the sound or pronunciation of the marks, we reject applicant's contention that "the potential for confusion is de minimis."

We conclude by holding that while there are some differences in the marks, when applicant's mark and the registered marks FUTSAL and FUTSAL (stylized) are used on related and identical goods in International Classes 18, 25

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and 28, and sold to ordinary purchasers, confusion is likely.

DECISION: The refusal to register the mark under Section 2(d) of the Trademark Act for the goods in International Classes 18, 25 and 28 is affirmed as to each of the cited registrations.