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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Zinky Electronics

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Serial No. 78383898

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Anthony Palazzolo Jr. for Zinky Electronics.

Susan Kastriner Lawrence, Trademark Examining Attorney, Law  
Office 116 (Michael W. Baird, Managing Attorney).

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Before Bucher, Zervas, and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Zinky Electronics filed an application to register the  
mark SUPRO for "t-shirts, jackets, and headwear."<sup>1</sup>

Applicant claimed ownership of two previously registered  
SUPRO marks:

1. Registration No. 2,970,326 for "electronic  
musical equipment, namely, amplifiers, electronic  
effects in the nature of signal processors, and  
parts therefore, namely pedals and speakers,  
excluding headsets and parts therefore, namely,

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<sup>1</sup> Application Serial No. 78383898, filed on March 13, 2004. In  
an Amendment Alleging Use filed March 24, 2005, applicant claimed  
first use of its mark as of January 22, 2005.

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headset microphones, headset earpieces and headset headbands"; and,

2. Registration No. 2,968,781 for "musical instruments, namely, guitars and parts for guitars in the nature of necks, bodies, strings and pick guards."

The Trademark Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

The Examining cited the mark shown below for "footwear" as a bar to registration.<sup>2</sup>

**S.U.P.R.O.  SOCK**  
**Super Under-foot Pedorthic Radical Orthotic**

When the refusal was made final, the applicant appealed. Applicant and the Examining Attorney have filed briefs.

We affirm.

The record consists of the following evidence:

1. Numerous third-party registrations based on use for footwear and some combination of t-shirts, jackets, and headwear;
2. Websites advertising and/or offering the sale of footwear, t-shirts, jackets, and headwear; and,
3. The registrant's response to a Section 2(d) refusal filed during the prosecution of the cited registration. A prior application (now abandoned) for the mark SUPRO filed by an

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<sup>2</sup> Registration No. 2,824,252, issued on March 23, 2004. Registrant disclaimed the exclusive right to use "Sock," "Super," "Pedorthic," and "Orthotic." The registrant described the design element of its mark as "a stylized design of a deer's head and antlers."

ostensibly unrelated third party for the following products was cited as a bar to registration:

- a. Electronic musical equipment, in Class 9;
- b. Musical instruments, in Class 15; and,
- c. Clothing, namely, t-shirts, jackets, pants, footwear and headwear, in Class 25.

Applicant argued that SUPRO and  create different commercial impressions, that the goods on which the marks are used are distinctly different, and that the goods of the registrant and the applicant are sold through different channels of trade. As the underlying basis for its arguments, applicant relied heavily on the registrant's response during the prosecution of registrant's application. Applicant asserted that the registrant is "bound by its prior statements and is now estopped from arguing otherwise." Indeed, applicant maintains that registrant's response is "tantamount" to a consent agreement and should be "afforded the deference commonly accorded a consent agreement." (Applicant's Reply Brief, p. 3).

Applicant's reliance on the registrant's response is misplaced. First, the Board is required to make its own independent evaluation of the likelihood of confusion factors. Registrant's response may be considered as

evidence in that evaluation. As the Court of Customs and Patent Appeals observed in *Interstate Brands*:

That a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.

*Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 U.S.P.Q. 151, 154 (C.C.P.A. 1978).

Accordingly, registrant's arguments in its response regarding the lack of a likelihood of confusion, specifically the difference between the products and the channels of trade, are not controlling or determinative. We reach our conclusions regarding the likelihood of confusion based on our own independent evaluation of the record. In so doing, the Board considers the goods identified in the application and registration at issue regardless of what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells*

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*Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813, 1815 (Fed. Cir. 1987); *In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981).

Second, applicant may not derive any equitable estoppel from registrant's prior statements, nor is registrant barred from taking an inconsistent position in a subsequent proceeding. *American Rice, Inc. v. H.I.T. Corporation*, 231 U.S.P.Q. 793, 798 (T.T.A.B. 1986); *Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 U.S.P.Q. 799, 802 (T.T.A.B. 1982). An essential element of equitable estoppel is that the party asserting it (*i.e.*, applicant) is prejudiced by the opposing party's (*i.e.*, registrant) inconsistency. *Keebler Company v. Rovira Biscuit Corporation*, 624 F.2d 366, 207 U.S.P.Q. 465, 471-472 n.7 (1<sup>st</sup> Cir. 1980); *Institutional Wholesalers, Inc. v. Saxons Sandwich Shoppes, Inc.*, 170 U.S.P.Q. 107, 109 (T.T.A.B. 1971). Applicant has not argued that it has been prejudiced by registrant's inconsistent positions, if any.

Third, Fed. R. Civ. P. 8(e)(2) provides for alternate or hypothetical pleadings regardless of consistency. Thus, the fact that registrant argued before the Trademark Office that its mark was not likely to cause confusion with a mark filed by a third party does not preclude registrant from later asserting likelihood of confusion against applicant.

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*Taffy's of Cleveland, Inc. v. Taffy's Inc.*, 189 U.S.P.Q. 154, 156-157 (T.T.A.B. 1975); *Eskimo Pie Corporation v. Canada Dry Corporation*, 181 U.S.P.Q. 191, 192 (T.T.A.B. 1973).

We next consider the issue of likelihood of confusion. Since applicant and the Examining Attorney have submitted arguments and evidence regarding the *du Pont* likelihood of confusion factors concerning the similarity of the marks, the similarity of the goods, and the similarity of the trade channels, we will focus our analysis on those factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 131, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

1. SUPRO and **S.U.P.R.O.  SOCK** are similar.  
Super Under-foot Pedorthic Radical Orthotic

In determining whether the marks are similar, we consider the appearance, sound, connotation, and commercial impression of each mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these bases for comparison may be critical in finding marks to be similar. In addition, it is a well-established principle that, in articulating reasons for reaching a conclusion on the similarities of the mark, while the marks must be compared in their entireties,

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including descriptive or disclaimed portions, "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 that the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corporation*, 732 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985).

Applicant's mark is SUPRO and the registrant's mark is

**S.U.P.R.O.  SOCK**  
Super Under-foot Pedorthic Radical Orthotic .

The marks share the terms SUPRO and S.U.P.R.O. Consumers are likely to treat the initialism, S.U.P.R.O., as an acronym, SUPRO, and pronounce S.U.P.R.O. and SUPRO identically.

Consumers will view the initialism S.U.P.R.O. as the dominant portion of applicant's mark for the following reasons:

- A. There is no evidence in the record to suggest that SUPRO has any meaning in the English language. Neither applicant, nor the Examining Attorney, has identified any meaning for SUPRO. Therefore, we conclude that it does not have any meaning in English. Likewise, there is no evidence in the record to suggest that S.U.P.R.O. is a well-known

initialism. Finally, there is no evidence in the record to suggest that either SUPRO or S.U.P.R.O. have any significance when used in connection with clothing. Accordingly, SUPRO and S.U.P.R.O. are coined or arbitrary terms which are entitled to a broad scope of protection;

B. In registrant's mark, S.U.P.R.O. is emphasized by virtue of its larger size and position as the first term of the mark. The additional elements which make-up registrant's mark namely, the words "Sock" and "Super Under-foot Pedorthic Radical Orthotic" are descriptive or generic.<sup>3</sup> Although we have not ignored these words, descriptive and disclaimed matter is less significant in creating the mark's commercial impression. *In re Code Consultants, Inc.*, 60 U.S.P.Q.2d 1699, 1702 (T.T.A.B. 2001). In registrant's mark the term "Super Under-foot Pedorthic Radical Orthotic" describes registrant's S.U.P.R.O. Sock (and identifies what S.U.P.R.O. is an abbreviation for), therefore, it would be viewed as informative or descriptive as opposed to indicating source;

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<sup>3</sup> "Sock", "Super", "Pedorthic", and "Orthotic" are disclaimed.

- C. Since the initialism S.U.P.R.O. is the first term in registrant's mark, it is most likely to catch the eye and make an impression on consumers. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"); and,
- D. The word portion of a composite mark (*i.e.*, S.U.P.R.O.) is usually considered the dominant part of a mark because it is more easily remembered and used in communications. The deer head design will not be used by word-of-mouth and it is unlikely that it will be used in textual materials because it would be impractical to use the design feature. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 U.S.P.Q. 198, 200 (Fed. Cir. 1983); *In re Appetito Provisions Co. Inc.*, 3 U.S.P.Q.2d 1553, 1554 (T.T.A.B. 1987). Moreover, in all likelihood, applicant's mark and registrant's mark would be viewed at different times. Under these circumstances, it is the verbal portion of the marks that would be remembered. The deer head is unlikely to be remembered when the consumer is confronted with an essentially identical

word mark (SUPRO). *In re Decombe*, 9 U.S.P.Q.2d  
1813, 1814 (T.T.A.B. 1988).

While there are obvious differences between applicant's mark and registrant's mark, the deer head design and the descriptive or informational wording "Super Under-foot Pedorthic Radical Orthotic" do not detract from the similarity between the terms SUPRO and S.U.P.R.O. They are identical in sound and commercial impression, and highly similar in appearance. We are satisfied that when the marks are taken as a whole, they are similar in sound, appearance, meaning, and commercial impression.

2. Applicant's Products And Registrant's Products  
Are Related And Move In The Same Channels Of  
Trade.

We now direct our attention to a consideration of the goods. Applicant is seeking to register its mark for the following goods:

"t-shirts, jackets, and headwear."

Registrant has registered its mark for the following products:

"footwear."

As indicated *supra*, the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified

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in the involved application and the cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or the classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra; In re Elbaum, supra.*

Accordingly, applicant's argument that the products are distinctly different because registrant's footwear is essentially an orthotic used for people with foot problems who want a more comfortable shoe and because applicant's products are essentially collateral merchandise used to promote applicant's musical instruments and equipment is unavailing because there are no restrictions in the description of goods. Therefore, we must consider applicant's products and registrant's products as if they were sold in all of the normal channels of trade to all of the normal purchasers for such products. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra; Toys R Us, Inc. v. Lamps R Us, 219 U.S.P.Q. 340, 343 (T.T.A.B. 1983).*

The Examining Attorney submitted numerous third-party registrations issued on the basis of use in commerce that included both footwear and some combination of t-shirts, jackets, and/or headwear. These registrations suggest that the clothing products are of a type that may emanate from a single source in connection with the same mark. *In re*

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*Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783, 1786 (T.T.A.B. 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 U.S.P.Q.2d 1467, 1470 n.6 (T.T.A.B. 198). The Examining Attorney also submitted excerpts from nine (9) websites which all offered for sale footwear, t-shirts, jackets, and headwear.

In contrast to the Examining Attorney's submission of evidence, applicant relied solely on the registrant's response in registrant's application file. In effect, the Examining Attorney's evidence regarding the similarity of the goods and the similarity of the trade channels is un rebutted. Moreover, we note that in the past, the Board has found that many different types of clothing and footwear to be related for purposes of the likelihood of confusion analysis. *Cambridge Rubber C. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623, 128 U.S.P.Q. 549 (C.C.P.A. 1961) (women's boots v. men's and boys' underwear); *In re Melville Corp.*, 18 U.S.P.Q.2d 1386 (T.T.A.B. 1991) (women's pants, blouses shorts and jackets v. women's shoes); *In re Pix of America, Inc.*, 225 U.S.P.Q. 691 (T.T.A.B. 1985) (women's shoes v. shirts).

The evidence clearly shows that footwear and t-shirts, jackets, and headwear are related products that move in the same channels of trade. When such products are sold under

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the same or similar mark, there will be a likelihood of confusion. Accordingly, we find that there is a likelihood of confusion between **S.U.P.R.O. SOCK**  for "footwear" and SUPRO for "t-shirts, jackets, and headwear."

Decision: The refusal to register is affirmed.