

**THIS OPINION IS  
NOT A PRECEDENT  
OF THE TTAB**

*Decision Mailed:  
September 24, 2007  
GDH/CJH/gdh*

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Eco-Mills, LLC

Serial No. 78441505

John Alunit of Patel and Alunit, P.C. for Eco-Mills, LLC.

Bernice Howse, Trademark Examining Attorney, Law Office 106<sup>1</sup>  
(Mary Sparrow, Managing Attorney).

Before Hohein, Zervas and Taylor, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Eco-Mills, LLC has filed an application to register the  
mark "TAHOE SPORTSWEAR" on the Principal Register in standard  
character form for "clothes, namely jackets, vests, pullovers,  
robes, hats, gloves, and socks" in International Class 25.<sup>2</sup>

Registration has been finally refused under Section  
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

<sup>1</sup> The application referenced above was originally examined by another  
examining attorney.

<sup>2</sup> Ser. No. 78441505, filed on June 25, 2004, which sets forth a date of  
first use of the mark anywhere and in commerce of April 30, 2003. The  
word "SPORTSWEAR" is disclaimed.

applicant's mark, when applied to its goods, so resembles the mark "TAHOES" and design, as reproduced below,



which is registered on the Principal Register for "shoes for men, women, and children" in International Class 25,<sup>3</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed.<sup>4</sup> We affirm the refusal to register.

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<sup>3</sup> Reg. No. 835,523, issued on September 19, 1967, which sets forth a date of first use of such mark anywhere and in commerce of September 21, 1966; renewed.

<sup>4</sup> Applicant submitted, for the first time with its appeal brief, printouts of third-party registrations to show that "the word TAHOE is entitled to only a narrow scope of protection because there are at least eight third-party registrations that bear this mark in connection with clothing in class 025," and asked that we take judicial notice of the third-party registrations. (App. Br. at 6.) The Examining Attorney has objected to this evidence as untimely under Trademark Rule 2.142(d). The objection is proper and sustained. We hasten to add, however, that even if such evidence were to be considered, it would not be persuasive of a different result in this case.

We also note applicant's argument, set forth on page 6 of its brief under the heading "No Family of Marks Exist," that "[w]hile the Examining Attorney may consider the fact that the Registrant has applied for a second trademark bearing the common wording TAHOE, Applicant submits that Registrant may not claim exclusive rights to the word TAHOE based on only two marks." The record, however, does not disclose that registrant owns any application, although a third party's application for the mark "T TAHOE" and design for "footwear," which was cited as a potential bar to applicant's application, was subsequently abandoned. Moreover, to the extent that applicant may be contending that registrant may not claim exclusive rights to its mark if it only has one registration for the mark, as opposed to a family of marks, applicant is plainly incorrect. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides in relevant part that: "A certificate of registration of a mark upon the principal register ... shall be prima facie evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods ... stated in the certificate."

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.<sup>5</sup>

Turning first to consideration of the respective goods, it is well settled that the goods at issue need not be identical or directly competitive in order for there to be a likelihood of confusion. It is sufficient, instead, that the goods at issue are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984); Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

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<sup>5</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

Applicant does not dispute that the goods are related. Indeed, applicant acknowledges that "both the Applicant's mark and the cited mark relate to clothing." (App. Br. at 2.) In addition, the record contains copies of numerous use-based third-party registrations and web site printouts, submitted by the Examining Attorney, which list or show clothing items of the kinds set forth in applicant's identification of goods along with those identified in registrant's registration, namely, shoes for men, women and children. It is settled that use-based third-party registrations have some probative value to the extent that they serve to suggest that the various listed goods therein are of a type which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd as not citable precedent*, 864 F.2d 149 (Table, unpublished) (Fed. Cir. 1988).

Moreover, we note that many prior CCPA and Board decisions have found that confusion is likely when shoes and items of clothing are sold under the same or substantially similar marks.<sup>6</sup> In view thereof, the evidence of record

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<sup>6</sup> See, e.g., General Shoe Corp. v. Lerner Bros. Mfg. Co., Inc., 254 F.2d 154, 117 USPQ 281, 283 (CCPA 1958) ["HOLIDAY" for men's outer shirts versus "HOLIDAY" for men's boots and shoes]; In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991) ["ESSENTIALS" for women's pants, blouses, shorts and jackets versus "ESSENTIALS" for women's shoes]; In re Apparel Ventures, Inc., 229 USPQ 225, 227 (TTAB 1986) ["SPARKS BY SASSAFRAS" for blouses, skirts and sweaters versus "SPARKS" for shoes, boots and slippers]; In re Pix of America, Inc., 225 USPQ 691, 692 (TTAB 1985) ["NEWPORT" for outer shirts versus "NEWPORTS" for women's shoes]; In re Alfred Dunhill Ltd., 224 USPQ 501, 504 (TTAB 1984) ["DUNHILL" for men's hosiery v. "DUNHILL" for shoes]; In re Kangaroos U.S.A., 223 USPQ 1025, 1026 (TTAB 1984) ["BOOMERANG" and design for men's shirts versus "BOOMERANG" for athletic shoes]; In re Tender Tootsies Ltd., 185 USPQ 627, 629 (TTAB

establishes that applicant's clothing items and registrant's shoes are so related that the use of the same or substantially similar marks in connection therewith is likely to cause confusion as to the source or sponsorship thereof.

Turning, then, to consideration of the marks at issue, our principal reviewing court has indicated that in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "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 entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "[t]hat a particular feature is descriptive or generic with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark." *Id.*

The Examining Attorney contends that "[a]pplicant's mark and the registrant's mark are similar because both share the word 'Tahoe'; and that applicant's "addition of [the] generic wording 'sportswear' [does] not change the overall commercial impression of the marks." (Ex. Atty. Br. at 3.) She further states that greater weight is given to the dominant feature of a

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1975) ["TENDER TOOTSIES" for women's and children's shoes and slippers v. "TOOTSIE" for ladies' nylon hosiery]; *B. Rich's Sons, Inc. v. Frieda Originals, Inc.*, 176 USPQ 284, 285 (TTAB 1972) ["RICH'S CHEVY CHASERS" for shoes versus "FRIEDA'S CHEVY CHASE ORIGINALS" for women's knitwear, namely, dresses, suits, skirts and blouses]; and *U.S. Shoe Corp. v. Oxford Industries, Inc.*, 165 USPQ 86, 87 (TTAB 1970) ["COBBIES" for shoes versus "COBBIES BY COS COB" for women's and girls' shirt-shifts].

mark in determining likelihood of confusion, and that here, the "dominant wording is the arbitrary term 'Tahoe.'" (Id. at 4.)

While applicant acknowledges, as it must, that both marks contain the word "TAHOE" and that the term "SPORTSWEAR" in its "TAHOE SPORTSWEAR" mark is "disclaimed as descriptive" (App. Br. at 2-3), applicant asserts that "the Examining Attorney may not diminish the contribution of the SPORTSWEAR portion when comparing applicant's mark to TAHOES." (Id. at 3.) In support of its assertion, applicant relies on *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), which it characterizes as having facts "nearly identical" to this case. We find that *Hearst*, however, is distinguishable from the facts at hand and does not control our determination in this case.

In *Hearst*, the mark VARGA GIRL for calendars was held not to be confusingly similar to the mark VARGAS for, *inter alia*, calendars. The court found that "the Board erred in its diminution of the contribution of the word 'girl,'" which the Board found to be merely descriptive, and that "[w]hen GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely." 25 USPQ2d at 1239. Contrary to applicant's assertions, in *Hearst* the applicant did not add a disclaimed, highly descriptive, if not generic, term to the registered mark, as applicant has essentially done here. Rather, while the registered mark was VARGAS and the applicant's mark was VARGA GIRL, the word GIRL was not disclaimed and the court did not view such word as merely descriptive. 25 USPQ2d at 1238-39.

Moreover, the court in *Hearst* explicitly recognized that the weight to be given terms in a mark is "not entirely free of subjectivity" and provided examples to "illustrate the fact-dependency of such determinations." 25 USPQ2d at 1239. The court confirmed, in *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004), that the determination of appropriate weight is highly fact-specific (affirming the Board's decision that JOSE GASPAR GOLD for tequila was likely to cause confusion with GASPAR'S ALE for beer and ale). As we noted supra, the court has also recognized the fact "[t]hat a particular feature is descriptive or generic with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark." *In re National Data Corp.*, supra. Accordingly, there is nothing improper in giving less weight to the descriptive term "SPORTSWEAR" and more weight to the term "TAHOE," as the dominant term in applicant's mark, when consideration is given to the similarity of the marks in their entireties.

Applicant's arguments that the presence of the term "SPORTSWEAR" in its "TAHOE SPORTSWEAR" mark imbues its mark with a "quite distinct and dissimilar" commercial impression from the cited "TAHOES" and design mark are likewise unavailing. Despite the fact that there are some specific differences in the marks, overall they convey virtually the same commercial impression. The additional word "SPORTSWEAR" in applicant's mark appears as the second term in the mark and, as previously noted, is highly descriptive, if not generic, of the clothing identified in the

application. Accordingly, it is insufficient to distinguish applicant's mark from that of the registrant. Rather, it is the first and distinctive term "TAHOE" in applicant's mark that is more likely to be impressed upon consumers. See, e.g., *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) [noting the presence of a strong distinctive term as the first word in both parties' marks renders the marks similar, especially where an additional term does not have source-identifying significance]; *Presto Prods, Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ["[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"].

Further, the fact that applicant's mark does not contain stylization or a design element does not help applicant inasmuch as its mark is in standard character form and thus is not limited to display in any particular format. See, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [an application for registration of a mark in typed or standard character form is not restricted to a particular form of display thereof]; and *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) ["[T]he display of a word mark may be changed at any time at the whim of its owner; rights in such a mark reside in the term itself rather than in any particular form thereof"].

Applicant next asserts, relying on *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir.

1990), that the Examining Attorney "erred by focusing on the dominant feature, TAHOE, to the substantial exclusion of the stylized lettering and design feature of the cited mark." (App. Br. at 5.) In response, the Examining Attorney states that (Ex. Atty. Br. at 5):

Applicant concedes that the wording 'Tahoe' is the dominant feature of the composite mark. As such, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co. [Inc.]*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). Greater weight is appropriately attributed to the dominant wording. The registrant's stylized lettering and design element do not change the overall impression of the marks when compared under Section 2(d).

We concur with the Examining Attorney, and we believe that the Federal Circuit's decision in *Electrolyte Laboratories* does not compel a different conclusion. In *Electrolyte Laboratories*, the applicant's mark and the cited mark were both stylized letter design marks containing the descriptive term K+, the symbol for the potassium ion, and both marks were for dietary potassium supplements. On those facts, the court found it was improper to focus on the literal element to the substantial exclusion of the stylization and design elements of the marks.

16 USPQ2d at 1240. Unlike *Electrolyte Laboratories*, where the common literal portions of the marks were descriptive and had little if any source identifying significance, here the marks share the distinctive term TAHOE. Further, nothing about the stylization of the font or the design element on the letter "O" in the registrant's mark appreciably slow notice or comprehension of that term in the registered mark. Rather, it is clear that the word "TAHOES," as the sole literal portion of the registered mark, constitutes the prominent portion of that mark, especially since it would typically be used by customers when calling for or otherwise referring to registrant's goods.<sup>7</sup> Thus, there is nothing improper in giving less weight to the design portion of the registrant's mark in reaching our conclusion that the marks in their entirety are substantially similar.

We accordingly conclude, after considering all the relevant *du Pont* factors and all the relevant evidence of record, that due to the shared distinctive term "TAHOE," customers and prospective purchasers who are familiar or acquainted with registrant's "TAHOES" and design mark for "shoes for men, women, and children" would be likely to believe, upon encountering applicant's substantially similar "TAHOE SPORTSWEAR" mark for "clothes, namely jackets, vests, pullovers, robes, hats, gloves, and socks," that such closely related goods emanate from, or are sponsored by or associated with, the same source. In particular,

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<sup>7</sup> If a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See, e.g., *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554; and *In re Drug Research Reports, Inc.*, 200 USPQ 554, 556 (TTAB 1978).

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consumers could reasonably believe that applicant's "TAHOE SPORTSWEAR" mark designates a new or expanded line of clothing from the same source as the shoes marketed under registrant's "TAHOES" mark.

**Decision:** The refusal under Section 2(d) is affirmed.