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Mailed:
July 18, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Daron Fashions Inc.

Serial No. 78507267

Simon Block of Katten Muchin Rosenman LLP for Daron Fashions Inc.

Richard F. White, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Hairston, Taylor, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Daron Fashions Inc. filed an intent-to-use application on October 28, 2004 for the mark HAWKE & CO. OUTFITTER and Design shown below for the following goods:

Clothing, namely, jackets, coats, suits, shirts, pants, jeans, shorts, undergarments, underwear, pajamas, scarves, gloves, ties, belts, socks, hosiery, footwear, swimwear, headwear, dresses, skirts, intimate apparel, lingerie, blouses, beachwear, vests, bathrobes, blazers, bodysuits, sweatsuits, sweatshirts, sweatpants, sweatshorts, jogging suits, rainwear and ski wear.

Applicant disclaimed the exclusive right to use "Co." and "Outfitter."



Registration was refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark HAWK, typed drawing, for pants as to be likely to cause confusion.¹

The appeal has been fully briefed. For the reasons set forth below we affirm the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The number and nature of similar marks in use on similar goods.

Applicant's primary argument in support of registration is that registrant's mark HAWK when used in

¹ Registration No. 0509215, issued May 3, 1949; second renewal.

connection with clothing is a weak mark, entitled to only a narrow scope of protection. Applicant submitted copies of twenty-one (21) third-party registrations consisting in part of the word "hawk" in Class 25.²

Evidence of third-party use falls under the sixth *du Pont* factor - the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence "is relevant to show that a mark is relatively weak and entitled to only a narrow scope

² Applicant only provided the first page of each registration from the Trademark Office TARR database. Many of those registration excerpts do not include a description of goods or a complete description of goods. To make registrations of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). If the applicant submits improper evidence of third-party registrations, the examining attorney should object to the evidence in the next Office action, or the Board may consider the objection to be waived. *See In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001) (objection to evidence waived where it was not interposed in response to applicant's reliance on listing of third-party registrations in response to initial Office action). In this case, examining attorney did not object to applicant's evidentiary submission and treated them as if they were complete copies of the registrations. Accordingly, the registrations have been considered and given appropriate evidentiary weight.

of protection." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

However, applicant submitted only copies of third-party registrations and no evidence of third-party use. The existence of third-party registrations alone cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973) (third party registrations do not aid applicant in registering another confusingly similar mark because they are not evidence of what happens in the marketplace or that consumers are familiar with them); *In re Delbar Products, Inc.*, 217 USPQ 859, 861 (TTAB 1981) (existence of confusingly similar marks on the Principle Register should not aid applicant in registering another confusingly similar mark); *Maybelline Co. v. Matney*, 194 UPSQ 438, 440 (TTAB 1977); *American Hospital Supply v. Air Products and Chemicals*, 194 UPSQ 340, 343 (TTAB 1977).

[I]n the absence of any evidence showing the *extent of use* of any such marks or whether any of them are now in use, they [third-party registrations] provide no basis for saying that the marks so registered have had, or may

have, any effect at all on the public mind.

Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (Emphasis in the original).

Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983); *American Hospital Supply v. Air Products and Chemicals, supra*. Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. See, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987). However, the dictionary definitions of the word "hawk" provide no insight as to any descriptive or

suggestive meaning or any reason competitors in the clothing field would need to adopt and use that word.³

Even if the third-party registrations were sufficient to establish that "hawk" is a suggestive or descriptive term entitled to only a narrow scope of protection or exclusivity of use, even weak marks are entitled to be protected against the registration of the same or similar marks for closely related goods or services. *Giant Food Inc. v. Rosso and Mastracco, Incorporated*, 218 USPQ 521, 526 (TTAB 1982); *In re Industrial Expositions, Inc.*, 194 USPQ 456, 459 (TTAB 1977); *Hollister Incorporated v. Ident A Pet*, 193 USPQ 439, 442 (TTAB 1976).

As discussed *infra*, the addition to applicant's mark of the descriptive terms "Co." and "Outfitters" and the oval background do not create a viable distinction with the registered mark. On the other hand, the third-party registrations submitted by applicant contain nondescriptive terms upon which a viable distinction between the marks could be made (e.g., HAWK'S LANDING, SILVER HAWK and wing design, SHADOW HAWK, etc.). In fact, some of the "Hawk"

³ Applicant submitted a dictionary definition of the word "hawk" from *Merriam-Webster Online* (www.m-w.com). The word "hawk" has three definitions, including (1) any number of diurnal birds of prey, (2) a small board or metal sheet with a handle on the underside used to hold mortar, and (3) one who takes an aggressive attitude and advocates immediate action such as a supporter of war.

registrations identify collateral merchandising products sold by sporting teams which further distinguish these third-party registrations (e.g., MILWAUKEE HAWKS, ATLANTA HAWKS, BOISE HAWKS BASEBALL CLUB, CHICAGO BLACK HAWKS, HUNTER COLLEGE HAWKS).

We find that the number and nature of similar marks in use on similar goods is a factor that favors finding a likelihood of confusion.

B. The similarity or dissimilarity and nature of the goods.

The mark in the cited registration is used to identify pants, and pants are one of the products listed in the application. The goods are, therefore, essentially identical. This is a factor that favors finding a likelihood of confusion.

C. The similarity or dissimilarity of established, likely to continue trade channels.

Given that the goods are nearly identical and there are no restrictions or limitations in the description of goods, we must presume that the products set forth in the application and registration will be sold in the same channels of trade and will be bought by the same classes of purchasers. *Canadian Imperial Bank v. Wells Fargo Bank,*

811 F.2d 1490, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). In view thereof, the similarity of the channels of trade is a factor that favors finding a likelihood of confusion.

D. The conditions under which and buyers to whom sales are made.

As indicated *supra*, because there are no restrictions or limitations in the descriptions of goods, we must presume that the goods are sold to the same classes of consumers. Purchasers of pants comprise a broad market consisting of both discriminating and ordinary consumers who may give relatively less time and individual attention to trademarks. Pants, which are frequent and routine purchases, may involve a lower level of consumer care than an infrequently purchased product. In view thereof, the conditions under which and buyers to whom sales are made is a factor that favors finding a likelihood of confusion.

E. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.

Turning to the marks, we begin with the premise that when marks appear on virtually identical goods, the degree of similarity necessary to support a conclusion of

likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 824, 23 UPSQ2d 1698, 1700 (Fed. Cir. 1992, *cert. denied*, 506 U.S. 1034 (1992)). As is obvious, the common element of the two marks is the words "Hawk" and "Hawke." The Examining Attorney contends that "Hawke" and "Hawk" are the dominant portions of both marks, while applicant argues that when the marks are compared in their entireties the other portions of applicant's mark are sufficient to distinguish them.

Both applicant and the Examining Attorney recognize the well-established principle that, in articulating the reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for logical 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. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In addition, under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely on their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In this case, applicant's mark, HAWKE & CO. OUTFITTER in an oval design, incorporates in its entirety registrant's HAWK trademark as its most distinctive and dominant feature. Neither the addition of the term "& Co. Outfitters," nor the design element (or combination thereof) offer sufficient distinctiveness to create a different commercial impression. *In re Xerox Corp.*, 194 USPQ 449 (TTAB 1977) (the addition of a descriptive word is an insufficient basis upon which to predicate a viable distinction between marks). Thus, for our purposes, applicant's mark and the registrant's mark are substantially similar.

The term "& Co." is simply an entity designation, and therefore it carries no trademark significance. Similarly, the word "outfitter" indicates a store that sells clothing or other equipment. According to *Merriam-Webster Online*, "outfitter" is defined as follows:

one that outfits: as a: Haberdasher b:
a business providing equipment,
supplies, and often trained guides (as
for hunting trips); also: a guide for
such an outfitter.⁴

Also, the Examining Attorney submitted several websites that use the term "outfitter" to describe retail

⁴ Applicant's Request for Reconsideration; Applicant's November 17, 2005 Response.

clothing store services (e.g., Winnipeg Outfitters Inc., Uncle Sam's Army Navy Outfitters, Half-Moon Outfitters, Sonoma Outfitters).⁵ Accordingly, the word "outfitter" is descriptive, if not generic, for retail store services and as such has little, if any, trademark significance.

The oval background design in applicant's mark, though visually prominent, is less significant than the words. This is because the oval design is an ordinary geometric shape that serves as a background for the words. In addition, when a mark comprises both wording and a design, consumers will use the words to request the identified goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

Further the term HAWKE & CO. in applicant's mark is larger than the word "Outfitter" and it also occupies the center of the oval background design. Thus, HAWKE & CO. is the portion of applicant's mark to which the viewer is drawn, as well as the portion that the viewer is most likely to remember.

The words "hawk" and "hawke" are virtually identical. The addition of the letter "e" to the end of the "hawk" portion of applicant's mark does not sufficiently distinguish it from the registrant's mark. *See In re Home*

⁵ The January 19, 2006 and June 6, 2005 Trademark Office Actions.

Federal Savings and Loan Association, 213 UPSQ 68, 69 (TTAB 1982) ("That applicant's mark 'TRAN\$FUND' has a dollar where registrant's mark has a letter 'S' is inconsequential in a comparison of the sound, appearance, and meaning of the two marks); *Goodyear Tire & Rubber Co. v. Dayco Corp.*, 201 USPQ 485, 488 n. 1 (TTAB 1978) ("Fast-Finder" with a hyphen is the equivalent of "Fastfinder" without a hyphen); *In re Strathmore Products, Inc.*, 136 USPQ 81, 82 (TTAB 1962) (GLISS'N is simply a contraction of GLISTEN and therefore they have the same meaning).

Finally, as discussed *supra*, there is insufficient evidence of record to support a finding that HAWK or HAWKE has a recognized meaning in the clothing field. The word "hawk" has a commonly understood meaning as a bird of prey. Since registrant uses the mark HAWK for clothing, it is not descriptive or suggestive. Thus, the word "Hawk" is at least distinctive, if not arbitrary, as used in connection with clothing.

For the preceding reasons, we believe that consumers are likely to believe that both marks are variations of each other and indicate a single source for the goods. Accordingly, the similarity of the marks favors finding that there is a likelihood of confusion.

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Considering the totality of applicant's mark and the nature of the word "hawk" in connection with clothing, we are of the opinion that applicant's HAWKE & CO. OUTFITTERS and Design for clothing, including pants, so resembles HAWK for pants as to be likely to cause confusion.

Decision: The refusal to register is affirmed.