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Mailed: November 28, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re New York Native, LLC

Serial No. 78543976

Charles W. Grimes of Grimes & Battersby, LLP for New York Native, LLC.

Paul F. Gast, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Walters, Rogers and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by New York Native, LLC to register the mark shown below on the Principal Register for the following goods, as amended:

Women's t-shirts, long sleeve t-shirts, cotton tops, sweaters, sweat suits, pants, skirts, jackets, hats, lingerie, tank tops, scarves, jeans and wraps; men's t-shirts, long sleeve t-shirts, jeans, sweat suits, pants, jackets, hats, undergarments, tank tops, sweaters, golf shirts and button down shirts

in International Class 25.¹



The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used in connection with applicant's goods, so resembles the following previously registered marks,

Native New Yorker
RESTAURANT

for "clothing, namely, golf shirts," in International Class 25,² and

¹ Application Serial No. 78543976 was filed on January 7, 2005, based on applicant's allegation of a bona fide intent to use the mark in commerce, with a disclaimer of "NEW YORK and the map of the State of New York" and the following description of the mark: "The mark consists of an outline of a map of New York State together with the wording 'new york native.'"

² Registration No. 2822360 was issued on March 16, 2004 with a disclaimer of "RESTAURANT" and with the following description of the mark: "The words 'NATIVE NEW YORKER RESTAURANT' in stylized print."



also for "clothing, namely, golf shirts," in International Class 25,³ as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. In addition, applicant filed a reply brief.

Evidentiary Issues

Before turning to the substantive ground for refusal, we note that applicant has submitted several exhibits with its main brief on appeal. These exhibits consist of copies of the specimens of use from the application files of the cited registrations; printouts from "a website evidencing use of the Registered Marks" (brief, p. 4); printouts from the United States Patent and Trademark Office's Trademark Electronic Search System (TESS) of a listing of third-party

³ Registration No. 2824536 was issued on March 23, 2004 with a disclaimer of "RESTAURANT" and the following description of the mark: "The design consists of the outline of the New York skyline and the words 'NATIVE NEW YORKER RESTAURANT.'"

registrations for various "NATIVE" formative marks; and copies of third-party registrations for various "NATIVE" formative marks for various goods. Normally such evidence would be viewed as untimely and would not be considered. See Trademark Rule 2.142(d), which provides that the record in the application should be complete as of the filing of the appeal. However, the examining attorney has acknowledged in his brief that "[a]pplicant's brief included numerous registrations containing the term 'native' as evidence that the term is common and diluted" (brief. p. 3). Accordingly, we deem the examining attorney to have treated these third-party registrations and TESS listing of third-party registrations as being of record, and we have therefore considered them. In contrast, the copies of registrant's specimens and website printout concerning registrant's use of its mark will be given no further consideration, as these were not treated by the examining attorney as items of record.

Likelihood of Confusion

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).

Similarity of the Goods

We begin by comparing applicant's proposed goods with those of registrant. In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ

76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

In this case, the goods identified in both cited registrations, namely "golf shirts," are included among the various clothing items identified in the involved application. As such, applicant's recited goods are identical in part to those of registrant. In addition, we find that applicant's recited "t-shirts, long sleeve t-shirts, jeans, pants, jackets, hats, undergarments, tank tops, sweaters, and button down shirts" are common articles of clothing, many of which may be worn with "golf shirts" and thus are closely related to registrant's identified goods. We also note that applicant presents no arguments that its goods and those of registrant are dissimilar or unrelated. Further, inasmuch as the identifications of goods in both the involved application and the cited registrations are not limited to any specific channels of trade, we presume an overlap and that the goods would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Similarity of the Marks

Turning to our consideration of the marks at issue, we note initially that, "[w]hen marks would appear on virtually identical ... [goods or] services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1994). See also *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980). 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. See *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 and services offered under the respective marks is likely to result.

In comparing the marks, we find that NEW YORK NATIVE is the dominant element of applicant's mark and NATIVE NEW YORKER is the dominant element in the cited marks, and

accordingly these elements are entitled to more weight in our analysis. It is a well-established principle 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 the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In registrant's marks, the term "RESTAURANT" is disclaimed, and the term has little, if any, source distinguishing quality and is subordinate to NATIVE NEW YORKER both in size and significance. The minor line and star design in both registrations is visually much smaller than the wording NATIVE NEW YORKER. Further, the New York City skyline design in cited Registration No. 2824536, while significant, reinforces the wording NATIVE NEW YORKER and is visually less prominent than such wording. Moreover, it is settled that if a mark consists of both wording and a design, then the wording is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). For these reasons, we consider NATIVE NEW YORKER to be the dominant

feature of the registered mark. Likewise, insofar as applicant's mark is concerned, the outline of the State of New York reinforces the wording NEW YORK NATIVE, which in addition would be used by purchasers to request the recited goods. Thus, NEW YORK NATIVE is the dominant portion of applicant's mark, and the portion that is most likely to be remembered by purchasers. See *In re Appetito Provisions Co., supra*.

Comparing applicant's mark to those in the cited registrations, we note that the wording NEW YORK NATIVE in applicant's mark is nearly identical to the wording NATIVE NEW YORKER in registrant's mark in appearance and sound. Applicant has taken the dominant terms in registrant's marks, that is, NATIVE and NEW YORKER, transposed them, and deleted "ER" from NEW YORKER. These differences do not serve to distinguish the marks in terms of sound and appearance. Further, we are not persuaded that reversing the order of these terms makes a significant difference in connotation or commercial impression. As the Board has previously stated:

Further, the reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion only if the transposed marks create distinctly different commercial impressions. See *Bank of America National Trust and Savings Assn. v. American National Bank of St. Joseph*, 201 USPQ

842 (TTAB 1978), and cases cited therein. Here, where the goods in question are legally identical, and where both marks, when applied to the goods in question, are likely to be perceived by purchasers as signifying that the product sold thereunder busts through, or breaks up, rust, we agree with the Examining Attorney that the marks create substantially similar commercial impressions, and there is a likelihood of confusion. *Cf. In re Inco*, 154 USPQ 629 (TTAB 1967) ["GUARDIAN OF POSTURE for mattresses versus "POSTURGUARD" for mattresses - registration refused], and *McNamee Coach Corp. v. Kamp-A-While Industries, Inc.* v. 148 USPQ 765 (TTAB 1965) ["KING KAMPER" for camping trailers versus "KAMP KING KOACHES" for campers - registration refused].

See In re Nationwide Industries, Inc., 6 USPQ2d 1882, 1884 (TTAB 1988) (RUST BUSTER for rust-penetrating spray lubricants confusingly similar to BUST RUST for penetrating oil). Further, the examining attorney has introduced evidence consisting of articles taken from the Internet that suggest the same individuals, namely, residents of the New York City area, refer to themselves both as "New York Natives" and "Native New Yorkers."

Thus, while applicant disagrees with the examining attorney's determination that applicant's and registrant's marks have the same commercial impression, its argument on this point is unpersuasive. Although there may be subtle differences in the meanings of the marks when they are subjected to close analysis, we do not believe that consumers will undertake such an analysis. The test for

likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Also, in evaluating similarities between the marks, the emphasis must be 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). Registrant's marks NATIVE NEW YORKER RESTAURANT and design and applicant's mark NEW YORK NATIVE and design have highly similar commercial impressions, when used in connection with goods that are identical in part and otherwise related. Both marks suggest a long-term resident of New York City or New York State.

In addition, the respective wording NATIVE NEW YORKER RESTAURANT and NEW YORK NATIVE appears to be at worst suggestive as applied to the parties' goods. Thus, we find that the similarities in sound, appearance, meaning and commercial impression of the marks outweigh the dissimilarities so that confusion as to source is likely to result if used in connection with the parties' identical and otherwise related goods. See *In re Chatam International Incorporated*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004).

In considering the involved marks, we have taken into account third-party registrations of marks containing the term NATIVE for various goods and services including clothing items. This evidence is of limited probative value. Firstly, the registrations are not evidence of use of the marks shown therein and also are not proof that consumers are familiar with said marks so as to be accustomed to the existence of similar marks in the marketplace. See *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). Secondly, the registrations cover goods and services which are not as closely related to those in the cited registrations as applicant's identified goods.⁴ We accordingly find that the cited registered marks are entitled to more than a narrow scope of protection, particularly in the field of clothing, namely, golf shirts. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Federal Circuit, June 5, 1992).

⁴ We note that none of the third-party registrations submitted by applicant include "golf shirts" among the goods recited therein.

Summary

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced marks would be likely to believe, upon encountering applicant's goods rendered under its mark 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. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.

Rogers, Administrative Trademark Judge, in dissent:

The refusal at hand presents a number of interesting twists on the typical analysis of likelihood of confusion,

not the least of which is that it appears neither applicant nor registrant is located in New York (city or state).

Although applicant is organized under the laws of Delaware and has a Greenwich, Connecticut address, it has acknowledged that its goods will originate in the state of New York. Thus, applicant has disclaimed the wording NEW YORK and the line drawing of the map of the state of New York.

Given the relative size of the map and the words, such a disclaimer covers the vast majority of the mark, when assessed visually. Further, even if we focus on just the words in applicant's mark, applicant has disclaimed two of the three words in the mark. Finally, when the only remaining element—the word NATIVE—is considered in conjunction with the disclaimed portions of the mark, and in light of the identified goods, even this element has a limited and highly suggestive meaning, i.e., "being such by birth or origin."⁵ The overall impression conveyed by the mark is that the clothing is native to New York or is that which a New York native would wear. In sum, even if

⁵ The American Heritage Dictionary of the English Language p. 874 (New College Ed. 1976). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

applicant's mark were registered it could not command a broad scope of protection.

Turning to the cited registrations, each of these is listed as being owned by Native New Yorker of America, Inc., an Arizona Corporation located in Chandler, Arizona. While the marks are not registered for restaurant services, food items or even clothing identified for use in restaurants, and are registered only for golf shirts, the cited registrations each include a disclaimer of the word RESTAURANT. What is one to make of two registrations for NATIVE NEW YORKER RESTAURANT (one with and one without a design of the New York City skyline) owned by an Arizona corporation and which disclaim rights in the term RESTAURANT?

First, it seems highly unlikely that clothing is registrant's main business, if for no other reason than a single item of clothing is unlikely to support a business. It is more likely that registrant is actually in the restaurant business, that its restaurant is known as the "Native New Yorker Restaurant," and golf shirts are sold or distributed as a collateral item. Second, insofar as one of the marks includes a design of the New York City skyline, it seems very likely that the words in the marks

are a reference to a New York city style restaurant or one founded by a native New Yorker.⁶

Since the registrant is not located in New York and neither registration includes a disclaimer of "New Yorker," it would appear that "New Yorker" was not considered descriptive of registrant's goods when the marks were registered. Perhaps the examining attorney who approved the two marks for publication found the reference to be more of a reference to a person than a place. Even so, however, one must wonder whether a purchaser or wearer of one of registrant's golf shirts would consider the mark more evocative of a place (the city? the restaurant?) than of a person.

Theoretically, the entirety of each of the registered marks is completely arbitrary for registrant's golf shirts, which would make the marks particularly strong. However, I do not find the theoretical arbitrariness of registrant's marks a particularly likely reflection of reality.

Nonetheless, I understand that the majority must pay due

⁶ The cited registrations each claim ownership of a prior registration that, according to USPTO records, is for NATIVE NEW YORKER for "restaurant services." The cited mark with the skyline of New York city also claims a prior registration for that same mark for restaurant services. Thus, while the majority correctly refused consideration of evidence of registrant's use of its marks on the internet, there is no need to resort to such evidence to understand the context in which registrant's marks are employed.

deference to the presumptive strength of the cited registered marks.

In addition, I understand why the majority must consider the very real possibility that the marks, if spoken by consumers calling for the goods by name, might seem very similar. Consumers could easily call for, on the one hand, the NEW YORK NATIVE golf shirt and, on the other hand, the NATIVE NEW YORKER golf shirt. However, just as our case law holds that there is no correct pronunciation of a mark, *see, e.g., Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001), and *E.I. duPont de Nemours & Co. v. Sunlyra International Inc.*, 35 USPQ2d 1787 (TTAB 1995), consumers might call for the respective golf shirts by different designations, *e.g., NEW YORK and NEW YORKER RESTAURANT*, if those are the overall commercial impressions consumers take from, respectively, applicant's and registrant's marks. *See Fero Corp. v. Nicofibers, Inc.*, 196 USPQ 41, 45 (TTAB 1977) ("It is fundamental that the commercial impression of marks depends largely upon how the purchasers of the goods marketed thereunder perceive them..."). Such designations are less alike than NEW YORK NATIVE and NATIVE NEW YORKER.

More significantly, the majority cites nothing from the record that would tend to suggest that prospective

purchasers are more likely to call for these goods by name than to look for them on a store shelf, in a catalogue or on the internet, or, dare I add, behind a restaurant counter. In short, there is nothing to indicate that these goods are typically ordered by phone or in some other manner where the spoken words in the marks would predominate.

While, like the majority, I must presume that the involved goods travel in the same channels of trade to the same class of consumers,⁷ I need not presume that the goods are more likely to be called for by name. When purchased in person, through a catalogue, or on the internet, so that prospective purchasers would see the marks, the involved marks look very different. Further, they are as likely as not to suggest different meanings (New York state and a New York City style restaurant, respectively) and present overall commercial impressions that are different.

In the somewhat artificial world in which the Board must assess likelihood of confusion, this appeal presents numerous uncertainties regarding how consumers may react to the involved marks. The majority, understandably, resolves

⁷ *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) ("[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.").

each uncertainty in favor of the registrant. It is clear, as the majority correctly observes, that any overall doubt about likelihood of confusion must be resolved in favor of the owner of a cited registration. However, when numerous uncertainties must be resolved in favor of registrant to reach a conclusion that confusion among consumers is likely, I cannot but wonder whether we are protecting against a theoretical possibility of confusion rather than a likelihood of confusion. See *Bongrain International (American) Corporation v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987) ("The statute refers to likelihood, not the mere possibility, of confusion.").

I would reverse the refusal of registration and therefore dissent from the majority's nonetheless able opinion.