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Decision Mailed:
Monday, April 28, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Yonex Kabushiki Kaisha

Serial No. 78634265

Robert R. Caliri of Olson & Hierl, Ltd. for Yonex Kabushiki Kaisha.

Bonnie Luken, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Hohein, Bergsman, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Yonex Kabushiki Kaisha has filed an application to register on the Principal Register in standard character form the mark POWER CUSHION for "badminton shoes and tennis shoes" in International Class 25.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the

¹ Ser. No. 78634265, filed on November 22, 2004, which alleges a date of first use in commerce of May 25, 2001.

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mark POWER-CUSHIONED, which is registered on the Principal Register in standard character form for "socks" in International Class 25², as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all 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 Company, 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, 29 (CCPA 1976) ("the fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential character of the goods and differences in the marks").

Turning first to determining the similarity or dissimilarity of the marks, we must consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test under this *du*

² Reg. No. 1675934 issued on February 18, 1992, and was renewed (for ten years) on January 10, 2002.

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Pont factor 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 terms of their overall commercial impressions that confusion as to the source of the services 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).

Applicant's mark is POWER CUSHION and the cited mark is POWER-CUSHIONED. In terms of appearance, we find them to be nearly identical. The only differences visually between the marks are applicant's omissions of a hyphen and the letters "ED" at the end of CUSHION. These differences are of little consequence and we find that the marks, on balance, look very similar. In terms of sound, there is only a slight aural distinction in the marks' pronunciations (created by the "ED" at the end "CUSHION" in applicant's mark).

As to the connotation and overall commercial impression, we find that the marks are also very similar. We agree with applicant that the registered mark POWER-CUSHIONED, in connection with socks, creates a commercial impression that the socks are heavily cushioned. Brief, p. 7. However, we disagree with applicant that its mark, POWER CUSHION, somehow creates a different commercial impression in relation to its tennis and

badminton shoes. Rather, we believe the same commercial impression is created by both marks, i.e., that applicant's shoes and the registrant's socks provide a strong cushion for the feet of persons wearing said goods. As demonstrated in the evidence of record (discussed *infra*), impact absorption or "cushioning" is a sought-after quality in shoes, including tennis shoes.³ We disagree with applicant's contention that the omission of the letters "ED" at the end of "CUSHION" in its mark somehow changes the overall commercial impression.⁴ The Board has held that a tense change (or formative change in the root word) does not alter the meaning of the marks. See, e.g., *In re Dahiquist, Inc.*, 192 USPQ 237, 238 (TTAB 1976) ("The past tense, 'phased', of the verb of which 'phase' is the present tense and 'phasing' is the present participle, would, we think, convey to purchasers of, and dealers in, high fidelity sound reproduction equipment the same meaning or connotation as the words 'phase' and 'phasing'"). Herein, consumers will perceive the two marks as conveying or suggesting that the respective goods provide comfort

³ Advertisements for shoes (attached to Office action dated December 30, 2005) contain descriptions "midsole offers cushioning", "cushion running shoe", and "provides maximum shock absorption in the heel and forefoot."

⁴ In this regard, we take judicial notice of the relevant definitions of "cushion" (in the noun form) as meaning "something resilient used as a rest, support, or shock absorber"; and "cushioned" (in the inflected verb form of cushion) as meaning "to protect from impacts or other disturbing effects" in The American Heritage Dictionary of the English Language (4th ed. 2000). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

to the wearer's feet because they either have strong "cushion" or are strongly "cushioned" and thus there is some impact resistance qualities to the goods.

Viewing the marks in their entireties, we find that they are extremely similar and likely to cause confusion when used in connection with the respective goods involved in this case. Thus the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We now turn to a consideration of the goods identified in the application and the cited registration. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in an applicant's application vis-à-vis the goods or services recited in the cited registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an

association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein.

With the above principles in mind and based upon the record, we find that the examining attorney has established that there is a commercial relationship between applicant's badminton and tennis shoes and registrant's socks. In support of her refusal and attached to her Office actions, the examining attorney submitted a variety of evidence that includes the following:

- website printouts from various online sporting goods retailers selling both athletic shoes and socks, with such items included in the same 'drop down' menu;
- website printouts (from www.tennisnuts.com) advertising goods under the heading "tennis shoes, badminton shoes, squash shoes & socks" on one of the pages;
- website printouts (from www.racket-sport.com) advertising tennis and badminton shoes in addition to socks on the same page;
- pictures of the inside of stores selling athletic shoes in proximity to socks; and
- a news article, in discussing Kmart's new store layout, refers to such as "carry[ing] fewer items but displays them more efficiently and attractively.... If shoes are in one area, for example, then socks should be nearby."⁵

The examining attorney also submitted copies of approximately 7 third-party registrations based on use in commerce, each for marks used to identify a variety of apparel, including shoes (which encompass the goods listed in applicant's identification of goods) and socks (registrant's goods). Although third-party registrations which cover a number of

⁵ Dayton Business Journal, December 20, 2002.

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differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Taken together, the evidence demonstrates that there is a commercial relationship between applicant's tennis and badminton shoes and registrant's socks, so that, if such goods were identified by confusingly similar marks, confusion as to source would be likely. This *du Pont* factor weighs in favor of finding a likelihood of confusion.

We turn now to fifth *du Pont* factor regarding the strength of the registered mark and what scope of protection it deserves against conflicting marks of others. Applicant contends that the cited mark POWER-CUSHIONED is "highly descriptive, and therefore weak" with respect to socks and is entitled to "an extremely narrow scope of protection." Brief, p. 4. Applicant's argument is unavailing, however, in view of the presumptions we must accord all registrations under Section 7(c) of the Trademark Act of 1946, 15 U.S.C. §1057(c), which specifically include that a registration is *prima facie* evidence of the validity of the registered mark. Therefore, we must presume that the registered

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mark POWER-CUSHIONED is, at worst, suggestive rather than merely descriptive. Moreover, an *ex parte* proceeding is not the proper forum to attack the validity of a cited registration. *In re Calgon Corp.*, 453 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

We add that even if the cited mark is considered suggestive and hence weak, "weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services." *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 1982). See also *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978). Therefore to the extent that the asserted lack of strength of the registered mark creates any doubt as to whether there is a likelihood of confusion, that doubt is resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, USPQ2d 1025, (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

For the reasons discussed above, and considering all of the evidence of record pertaining to the *du Pont* factors, we conclude that applicant's mark, POWER CUSHION, is very similar to registrant's mark, POWER-CUSHIONED, and their contemporaneous use on the commercially related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.