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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Smoke Merchandise, LLC

Serial No. 78706972
Serial No. 78706973

Samuel Fifer of Sonnenschein Nath & Rosenthal LLP for Smoke Merchandise, LLC.

Angela M. Micheli, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Grendel, Drost and Zervas, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Because the factual and legal issues involved in applicant's appeals in the two above-captioned applications are essentially the same, we hereby consolidate the appeals and shall decide them in this single opinion. The applicant in both of these applications is Smoke Merchandise, LLC.

In application Serial No. 78706972, applicant seeks registration on the Principal Register of the mark **SMOKE** (in standard character form) for goods identified in the application as "denim jackets; head scarves; headwear; jackets; jerseys; leather jackets; pants; polo shirts; shirts; shorts; skirts; sweat shirts; t-shirts; tank tops; underwear," in Class 25.¹

In application Serial No. 78706973, applicant seeks registration on the Principal Register of the mark **SMOKE** (in standard character form) for goods identified in the application as "belts; jeans; loungewear; swim wear," in Class 25.²

¹ Serial No. 78706972, filed on September 6, 2005. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). April 27, 2004 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

² Serial No. 78706973, filed on September 6, 2005. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

This application also includes Class 3 goods identified as "fragrances for personal use." The Trademark Examining Attorney issued a final refusal of registration as to these Class 3 goods, in addition to the Class 25 goods. Applicant filed a notice of appeal as to both classes. However, at page 2 of its appeal brief, applicant stated that "Applicant hereby withdraws and abandons its application as to Class 3." We construe this statement in applicant's brief to be applicant's express abandonment of the application as to Class 3. See Trademark Rule 2.68, 37 C.F.R. §2.68. The application therefore is deemed to be abandoned as to Class 3, and we shall give it no further consideration on appeal.

The Trademark Examining Attorney has issued a final refusal to register applicant's mark in each of the applications, on the ground that the mark in each application, as applied to the goods identified in each application, so resembles the mark **SMOKE**, previously registered (in standard character form) for "footwear" in Class 25,³ as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant has appealed the final refusal in each application.

The appeals are fully briefed. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register in each application.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic*

³ Registration No. 2753582, issued to Oakley, Inc. on August 19, 2003.

Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc., supra*. We find that applicant's mark SMOKE (in standard character form) is identical to the cited registered mark SMOKE (in standard character form) in terms of appearance, sound, connotation and commercial impression.

We reject applicant's suggestion that the two marks are dissimilar in terms of appearance because applicant's mark, as actually used on applicant's goods, is depicted in stylized lettering. Applicant seeks to register the mark in standard character form, not in any stylized lettering, and the alleged stylization of the mark as actually used therefore is irrelevant in this proceeding. We also reject applicant's argument that the marks have different connotations and commercial impressions because SMOKE in applicant's mark refers to the NASCAR race driver Tony Stewart, whose nickname is alleged to be "Smoke." Even if this contention were supported by evidence in the record (it is not), it is irrelevant because the mark applicant

seeks to register includes no reference to Mr. Stewart. We find that SMOKE is an arbitrary term as applied to the goods at issue here, and that it has the same connotation and creates the same commercial impression in both marks. Additionally, we reject applicant's contention that SMOKE is a weak mark. Applicant bases this contention on the alleged existence on the Register of numerous third-party registrations of SMOKE-formative marks, including sixty such marks in Class 25. Applicant has not supported this contention with printouts of these registrations, or with any other evidence of third-party use of SMOKE marks. On this record, and on the face of the mark itself, we find that SMOKE is an arbitrary term as applied to the goods.

For these reasons, we find that the marks are identical, and that the first *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as identified in the applications and in the cited registration. It is settled that it is not necessary that the goods be identical or even competitive in order to find that the goods are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather

whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). In cases such as this where the applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applying these principles in the present case, we find as follows. The goods identified in the cited registration are "footwear." Applicant's goods as identified in the '972 application are "denim jackets; head scarves; headwear; jackets; jerseys; leather jackets; pants; polo shirts; shirts; shorts; skirts; sweat shirts; t-shirts; tank tops; underwear." The goods identified in applicant's '973 application are "belts; jeans; loungewear; swimwear." We find that applicant's goods and the goods in the cited registration are similar and related, for purposes of the second *du Pont* factor.

The Trademark Examining Attorney has made of record a printout of registrant's website home page which shows that registrant itself markets both footwear and apparel items.

This evidence supports a finding that the goods are related.

The Trademark Examining Attorney also has submitted printouts of sixteen third-party registrations (one of which (Reg. No. 3143623) is owned by registrant) which include in their identifications of goods both footwear as identified in the cited registration and other apparel items as identified in applicant's applications. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). This evidence supports a finding that applicant's and registrant's goods are related for purposes of the second *du Pont* factor.

Finally and as noted above, because applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the goods to support a finding that the goods are related under the second *du Pont* factor. *In re Opus One Inc.*, *supra*. We find that such a relationship between the goods exists in this case.

Applicant contends that the Office in the past has issued registrations of an identical mark to different parties for Class 25 goods, and has submitted printouts of three registrations of the mark IMPACT, and two registrations of the mark BIG MAC.⁴ However, the clothing items identified in these respective registrations (which include highly specialized items such as motorcycle apparel and volleyball kneepads) clearly are less related to each other than are applicant's and registrant's goods in the present case. Applicant also cites several cases in which it was found that no likelihood of confusion existed as between identical marks for clothing items.⁵ However, the

⁴ The three IMPACT registrations are Reg. No. 2267970 for "clothing, namely dress pants, sports coats, jeans shirts and ties"; Reg. No. 2309160 (now cancelled) for "motorcycle apparel, namely, motorcycle gloves, motorcycle jerseys and motorcycle tights"; and Reg. No. 2110357 (registered under Trademark Act Section 44) for "fabric knee protectors for the sports of volleyball and U.S. and German style handball." The two BIG MAC registrations are Reg. No. 1596524 for "children's clothing, namely, t-shirts"; and Reg. No. 0824962 for "men's work suits, overalls, jeans, pants, jackets, rainwear, belts, suspenders, caps, socks, and bandanas." In its brief, applicant also cites to two co-existing Class 25 registrations (Reg. Nos. 2188714 and 1194385) of the mark FOCUS, but has not made them of record. Even if they were of record, however, they again cover apparel items which are obviously much less related to each other, i.e., the "men's and young men's clothing, namely suits, sportcoats, sweaters, trousers, blazers, vests and reversible jackets" identified in the '385 registration vs. the specialized "bicycle clothing, namely shorts, headware, shoes, gloves, shirts, jackets, leggings, pants and socks," identified in the '714 registration.

⁵ These cases include *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984); *In re Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988);

Trademark Examining Attorney has cited has cited other cases in which a likelihood of confusion was found as between identical marks for clothing items.⁶

In any event, it is settled that we must decide each case based on the evidence in the record before us. On this record, and considering the fact that the marks are identical, we find that the goods identified in applicant's applications are related to the goods identified in the cited registration, under the second *du Pont* factor. The second *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

We also find under the third *du Pont* factor (similarity or dissimilarity of trade channels) that applicant's goods as identified in the application are or would be marketed in the same trade channels as the goods identified in the cited registration. There are no trade channel restrictions or limitations in either applicant's or registrant's respective identifications of goods, and we therefore must deem the respective goods to move in all normal trade channels for such goods and to be marketed to

and *H. Lubovsky, Inc. v. Esprit de Corp.*, 228 USPQ 814 (SDNY 1986).

⁶ These cases include *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549 (CCPA 1961); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985).

all normal classes of purchasers for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). It is irrelevant, even if true, that applicant's goods are marketed only via applicant's own website. See *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992). We find that the normal trade channels and classes of purchasers for applicant's apparel items are the same as or are overlapping with the normal trade channels and classes of purchasers for registrant's footwear. These would be bricks-and-mortar department and clothing stores, as well as the retail sale of clothing items via mail order and the Internet. As noted above, registrant itself markets both apparel and footwear on its website. We find that the third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Finally, we find under the fourth *du Pont* factor (conditions of purchase) that the conditions under which applicant's and registrant's respective goods are or would be marketed are likely to lead to confusion. The goods are ordinary, inexpensive consumer goods which are or would be purchased by ordinary consumers exercising only a normal degree of care. Applicant's contention that purchasers would be sophisticated and knowledgeable and thus readily able to distinguish the sources of the goods is not

supported by the record. We therefore find that the fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion. It certainly does not weigh in applicant's favor.

After considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. The marks are identical, the goods are related, the trade channels are the same, and the goods are ordinary consumer items purchased by ordinary consumers. These facts suffice to establish that a likelihood of confusion exists. We have considered all of applicant's arguments to the contrary (including any arguments not specifically discussed in this opinion), but we are not persuaded. Moreover, to the extent that any doubts might exist as to the correctness of our conclusion that confusion is likely, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *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 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals to register as to Class 25 in Serial. Nos. 78706972 and 78706973 are affirmed. Also,

Ser. Nos. 78706972 and 78706973

application Serial No. 78706973 is expressly abandoned as to Class 3.⁷

⁷ See *supra* at footnote 2.