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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fakedelic Holdings Co., Ltd.

Serial No. 78816943

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Before Seeherman, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Fakedelic Holdings Co., Ltd. filed an application to register the mark SLY for goods identified in International Classes 9, 14, 18 and 25. When the trademark examining attorney issued a final refusal with respect to Class 25 only, applicant filed a request to divide. Pursuant to this request, the goods listed in Classes 9, 14 and 18 were placed in "child" application serial no. 78978874. That

application was published in the Official Gazette, and no opposition was filed.

The goods listed in Class 25 remain in the present "parent" application. These goods are identified as follows:

clothing not used in connection with or for the promotion of the sport of basketball, namely, bandanas, bathrobes, belts, belts made of leather, bikinis, blouses, blousons, boots, bottoms, brassieres, camisoles, caps, coats, corsets, coveralls, denim jackets, denim pants, down jackets, dress shirts, dress suits, dresses, ear muffs, fitted swimming costumes with bra cups, flight suits, footwear, fur coats and jackets, fur hats, fur muffs, fur stoles, golf caps, golf shirts, golf shoes, halter tops, hats, headwear, heels, hoods, jackets, jeans, jerseys, knit shirts, knitted caps, knitted underwear, ladies' underwear, leather coats, leather jackets, leather pants, leather shoes, leg warmers, lingerie, loungewear, mantles, miniskirts, mules, neck bands, neckerchiefs, neckties, negligees, nightwear, overalls, parkas, polo shirts, ponchos, pumps, rain boots, robes, sandals, shawls, shirts, shoes, shorts, short-sleeved or long-sleeved t-shirts, short-sleeved shirts, shoulder pads for clothing, skirts, socks, stockings, stoles, suits, suspenders, sweat pants, sweaters, tank tops, ties, tops, tuxedos, t-shirts, underclothes, vests, v-neck sweaters, wraps, and wrist bands.¹

¹ Application Serial No. 78816943, filed February 16, 2006, alleging a bona fide intention to use the mark in commerce.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark SLY for

clothing, namely, hosiery, footwear, T-shirts, sweatshirts, sweatpants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters, belts, ties, nightshirts, hats, warm-up suits, jackets, parkas, coats, cloth bibs, head bands, wrist bands, aprons, boxer shirts, slacks, caps, ear muffs and gloves; all to be used in connection with or for the promotion of the sport of basketball²

as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

The examining attorney maintains that the marks are identical and the goods are closely related. The examining attorney essentially contends that the fact registrant's goods are used in connection with the promotion of the sport of basketball and applicant's goods are not so used is not a basis on which to distinguish otherwise identical and/or closely related goods. In support of the refusal, the examining attorney submitted excerpts of third-party

² Registration No. 2563959, issued April 23, 2002.

websites and articles retrieved from the Internet.

Applicant argues that registrant uses its mark in an ornamental fashion in connection with a basketball team's mascot, whereas applicant intends to utilize SLY as a trademark for fashionable clothing not used in connection with or for the promotion of basketball. Applicant has submitted evidence to show that registrant's mark references "Sly," the mascot of the New Jersey Nets professional basketball team. Applicant further contends that its goods will be sold in retail clothing stores (not in sports merchandise stores) to consumers looking to purchase trendy, upscale clothing. In response to the examining attorney's evidence regarding the similarity between the goods, applicant argues that, at best, the evidence demonstrates that manufacturers of sports clothing also market clothing for use in playing various sports. Applicant also maintains that the cited mark is not strong and, in connection therewith, applicant submitted seven third-party registrations of marks comprising, in part, the term "SLY." Finally, applicant contends that the target customers for registrant's and applicant's clothing are highly sophisticated and will be readily able to distinguish between the marks and goods sold thereunder so that they will not be confused as to source or origin. In

addition to the third-party registrations, applicant submitted a dictionary definition of "sly" and excerpts from applicant's and registrant's websites.

We first turn our attention to an evidentiary matter. Applicant's brief was accompanied by several exhibits, all but one made of record during the prosecution of the application. Exhibit A includes the specimens of use submitted in support of the cited registration; applicant requests that the Board accept them into the record by way of judicial notice because the specimens were not available via the Office's TDR database until May 11, 2007, that is, after applicant's submission of its last response before filing the appeal.

Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of the appeal. The specimens were available prior to the appeal, and applicant had an opportunity to file a request for reconsideration, accompanied by the specimens, prior to the appeal. It is also possible to request remand of an application to submit additional evidence after appeal, if good cause can be shown. See TBMP §1207.02 (2d ed. rev. 2004). What is not acceptable is for an applicant simply to submit evidence with an appeal brief, at a point where the examining attorney has no opportunity to submit

evidence in response. Applicant's submission of the specimens with its appeal brief is untimely. Moreover, the Board does not take judicial notice of registrations and/or their file histories, including the specimens. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998). Accordingly, the specimens have not been considered.

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. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks are identical in appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Further, the cited mark is arbitrary. The identity between the marks weighs heavily in favor of a finding of likelihood of confusion.

Applicant's argument that the cited mark is entitled to only a narrow scope of protection is not persuasive. In this connection applicant introduced seven third-party registrations of marks comprising, in part, "SLY," but only five of the registrations cover clothing items. The five registered marks are as follows: SLY FOX (with a humanized fox swinging a golf club); SLY 5; SLY BOOGY; SLY SHARK CLOTHING AA; and SLYX CLOTHING. These registrations do not serve to show that SLY has a suggestive meaning for clothing, such that the scope of protection for the cited registration should be limited. In four of the registrations SLY is used as an adjective modifying an object or a number, while because the cited mark is SLY *per se*, it gives a different commercial impression. Further, SLYX in SLYX CLOTHING would not be perceived as the word "SLY" at all. Nor do these registrations demonstrate use of the marks that are the subjects thereof in the marketplace or that the purchasing public is familiar with the use of those marks and has learned to distinguish between them. *See, e.g., Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ["The existence of [third-party] registrations is not evidence of what happens in the market

place or that customers are familiar with them..."]. In any event, even if applicant had established that the third-party marks on which it relies are in use, none of these marks in the clothing field is as similar to registrant's mark as is applicant's mark; in fact, to reiterate, applicant's mark is identical in every respect to registrant's arbitrary mark. Thus, the *du Pont* factor of the nature and number of similar marks in use on similar goods does not favor applicant, while the strength of the cited mark favors a finding of likelihood of confusion.

We next turn to a consideration of the goods. We note, at the outset of considering this *du Pont* factor, that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's goods and registrant's goods that is required to support a finding of likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are the same, as in this case, it is only necessary that there be a viable relationship between the goods in order to support a finding of likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). The proper inquiry is not whether the goods could be confused, but rather whether the source of the goods

could be confused. *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

In determining the issue of likelihood of confusion in ex parte cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The thrust of applicant's argument is based on the exclusionary language in its identification comprising a variety of clothing items - "not used in connection with or for the promotion of the sport of basketball" - compared with the limiting language - "all to be used in connection with or for the promotion of the sport of basketball" - in registrant's identification comprising various clothing items.

We find that the specific exclusion from applicant's identification of the purpose of registrant's clothing items is insufficient by itself to compel a finding that applicant's clothing items are not related to those of registrant. In the present case, the identifications of goods include some identical items, such as belts, shirts, sweaters, ear muffs, caps, coats, pants, sweatpants, pajamas/nightwear, wrist bands, and footwear/shoes.³ It is

³ See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) [likelihood of confusion found on

common knowledge that in today's wearing apparel market, sports-oriented and team-oriented clothing items on the one hand, and fashion-oriented clothing items on the other, are often interchangeable. Moreover, contrary to the gist of applicant's argument, the respective clothing items would travel in the same trade channels. Sports-oriented clothing items are sold in retail stores, such as Wal-Mart, as are general clothing items. As indicated above, applicant's and registrant's identifications include several identical items, including belts, ear muffs, wrist bands and caps. These identical clothing items, whether basketball-oriented or general fashion items displaying the same arbitrary mark, are likely to be sold in close proximity to each other in the same department of the same store. As to relevant purchasers, it hardly need be said that the same classes of consumers, including ordinary ones, purchase such goods.

Applicant's argument that "[t]he complexity and expense related to fashion and the purchase of clothing also dictates that consumers acquiring such goods expend a significant amount of care and sophistication when making purchasing decisions" (Brief, p. 10) is not persuasive.

basis of overlap of any item encompassed by the identifications of goods].

The problem with applicant's argument is that the identifications of goods are not limited as to price, and therefore we must presume that the clothing items cover the entire range of price, from expensive to inexpensive. Many of the items listed (e.g., ear muffs and wrist bands) likely are relatively inexpensive and bought on impulse. See *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1507 (TTAB 2007). The Internet articles about how consumers buy clothing supports the notion that the purchase of clothing often involves an impulse decision.

Even assuming, however, that the purchase of applicant's and registrant's clothing would involve a deliberate decision, this does not mean that the purchasers are immune from confusion as to the origin of the respective clothing items, especially when the identity between the marks and the similarity between the goods outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. In other words, no matter how carefully

a purchaser examines the marks, they would not be able to distinguish them because they are identical.

In sum, we base our finding of likelihood of confusion primarily on the fact that the arbitrary marks are identical, coupled with the relatedness of goods that move in identical trade channels to identical ordinary consumers who may purchase on impulse.

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. *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 refusal to register is affirmed.