

2007 WL 2219708 (Trademark Tr. & App. Bd.)

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Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

**IN RE JACQUELYN SILBERBERG AND COURTNEY SILBERBERG**

SERIAL 78712155

July 24, 2007

\*1 Valerie Ann Memeth for **Jacquelyn Silberberg** and **Courtney Silberberg**

Daniel J. Russell, Trademark Examining Attorney

Law Office 105

([Thomas G. Howell](#), Managing Attorney)

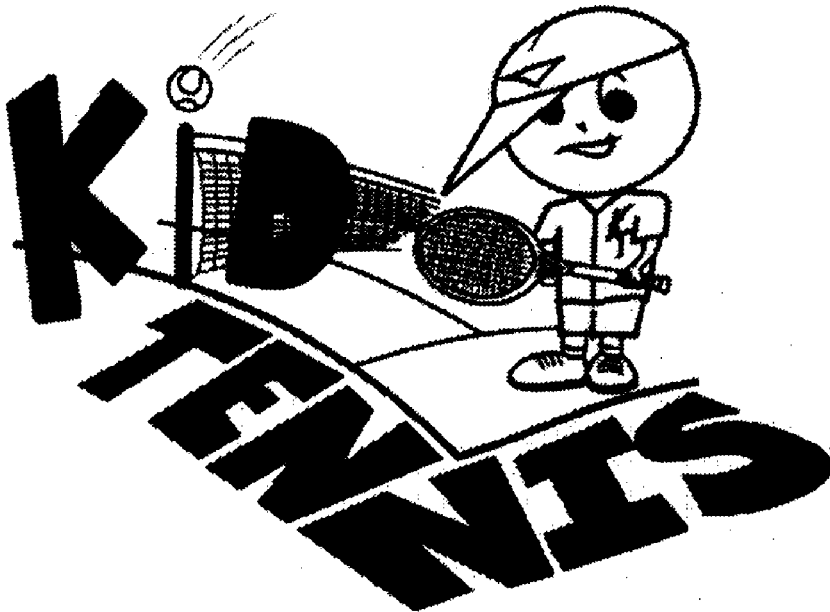
Before [Grendel](#), [Kuhlke](#) and [Walsh](#)

Administrative Trademark Judges

Opinion by [Grendel](#)

Administrative Trademark Judge:

**Jacquelyn Silberberg** and **Courtney Silberberg**, joint applicants herein, seek registration on the Principal Register of the mark depicted below, for goods identified in the application as “clothing, namely, hats, shirts, caps, sweatsuits, shorts, pants, socks, wristbands, headbands, jackets and socks [sic], for men, women and children,” in Class 25.<sup>1</sup>



Applicants have disclaimed KID TENNIS apart from the mark as shown.

At issue in this appeal is the Trademark Examining Attorney’s final refusal to register applicants’ mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark **TENNISKIDS**, previously registered on the Principal Register (in standard character form) for various Class 25 goods,<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), [15 U.S.C. §1052\(d\)](#). The goods identified in the cited registration are:<sup>3</sup> Clothing, namely, children’s t-shirts, children’s sweatshirt, children’s polo shirt, children’s spot [sic - sport?] shirt, child’s dress, toddler’s tennis dress, children’s shirt, children’s shirt, children’s shorts, children’s pants, children’s cap, children’s sweater, adult t-shirt, adult sweatshirt, adult sport and polo shirt, adult tennis dress, adult sweater, adult cap, adult hat, adult

skirt, adult pants, adult shorts, sweatbands.

The appeal is fully briefed. After careful consideration of the evidence of record and the arguments of counsel, we reverse the refusal to register.

Initially, we note that applicants submitted with their appeal brief various items of evidence. The Trademark Examining Attorney has objected to such evidence on the ground that it is untimely. We sustain the objection. To the extent that any of this evidence was not made of record prior to appeal, we have given it no consideration. See [Trademark Rule 2.142\(d\)](#).<sup>4</sup>

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 Fondee En 1772](#), 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); [In re Majestic 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).

\*2 We turn first to the second *du Pont* factor, i.e., the similarity or dissimilarity of the goods. We find that applicants' Class 25 goods, as identified in the application, are for the most part identical to, and otherwise are closely related to, the Class 25 goods identified in the cited registration. Applicants do not contend otherwise. This *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Given the essentially identical nature of the respective goods, we also find that the trade channels in which and the classes of purchasers to whom applicants' and registrant's Class 25 goods are or would be marketed are identical. The third *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

We find that the purchasers of the identified goods would be ordinary consumers who would exercise only an ordinary degree of care in purchasing the goods. The fourth *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

We turn finally to the crux of the dispute in this case, which is the first *du Pont* factor. This factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. [Palm Bay Imports, Inc.](#), *supra*. The test, under the first *du 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 impression that confusion as to the source of the goods 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). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See [In re Chatam International Inc.](#), 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); [In re National Data Corp.](#), 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's goods are identical to the goods identified in the cited registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. [Century 21 Real Estate Corp. v. Century Life of America](#), 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

\*3 Applying these principles in the present case, we find as follows.

First, we cannot agree with the Trademark Examining Attorney's contention that it is the wording in applicant's mark that necessarily is the dominant feature of the mark's commercial impression. The design element of the mark certainly is visually prominent in the mark. The manner in which the words and the design are visually integrated, with the letter "i" in "kid" serving also as the post to which the tennis net is attached, and the tennis ball serving as the dot over the letter "i" in "kid," and the word TENNIS stretching around the corner of the tennis court, creates a whole in which neither the words nor the design, per se, dominates the other in terms of the overall commercial impression created by the mark.

Comparing the marks in their entireties in terms of appearance, we find them to be dissimilar rather than similar. The design

element in applicant's mark, and the creative way in which the design element and the words are integrated, create a visual impression that is quite different from the appearance of the registered TENNISKIDS mark. Contrary to the Trademark Examining Attorney's contention, we do not find it dispositive in this case that the cited registered mark is presented in standard character format. It is true that, in our likelihood of confusion analysis, a mark registered in standard character format is not limited to any particular manner of display, but rather must be considered in all reasonable manners in which it might be depicted. *See, e.g., INB National Bank v. Metrohost*, 22 USPQ2d 1585 (TTAB 1992). However, we deem applicant's mark to be so highly stylized that it does not fall within the range of "reasonable" manners of display that should be reserved to the registered standard character mark. *Cf. Fossil, Inc. v. The Fossil Group*, 49 USPQ2d 1451 (TTAB 1998) (in an *inter partes* context, opposer's registration of the word FOSSIL in typed drawing form affords opposer a scope of protection which encompasses all reasonable manners in which the word FOSSIL could be depicted, but it does not afford opposer rights in the word FOSSIL combined with other wording or with designs). On balance, we find the marks to be visually dissimilar.

In terms of sound, the marks obviously are similar to the extent that each includes the word TENNIS and also the singular or plural version of the word KID. However, the marks are dissimilar in terms of sound to the extent that the order of the two words is reversed in the two marks. On balance, we find the marks to be more similar than dissimilar in terms of sound.

In terms of connotation, we find that applicant's mark, when viewed in its entirety, connotes a particular character, i.e., a character named "Kid Tennis." This construction of the mark would be similar to other characters or personalities that go by or are known by a name which begins with the designation "Kid," such as "Kid Galahad" or "Kid Rock." This connotation of the mark as identifying a particular character is reinforced by the design element of the mark, which depicts what is most likely going to be seen as a specific cartoon character named "Kid Tennis." This specific connotation of applicant's mark is not the same as the connotation of the cited registered mark, which would be understood to be referring to "tennis kids" in general, i.e., to the general idea of "kids who play tennis." On balance, we find that the marks viewed in their entireties are dissimilar in their connotations.

\*4 We likewise find that the marks are dissimilar in terms of overall commercial impression. The prominence of the design feature of applicant's mark and the way it is integrated with the wording in the mark to create the impression of a cartoon character named "Kid Tennis" results in a commercial impression which differs from the commercial impression of the registered TENNISKIDS mark. The words "tennis" and "kid(s)" are at best highly suggestive of the Class 25 goods identified in the application and in the registration, given the likelihood that both applicant and registrant are or would likely be marketing the clothing items to tennis-playing kids and/or their parents. The mere presence in both marks of these highly suggestive words does not outweigh the dissimilarities between the marks in their overall commercial impressions. *See In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

Considering the two marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that the marks are dissimilar rather than similar. The high level of stylization and design in applicant's mark, along with the obviously highly suggestive nature of the wording in both marks, renders the marks dissimilar. The first *du Pont* factor weighs against a finding of likelihood of confusion.

Balancing all of the *du Pont* factors, we conclude that confusion is not likely. Notwithstanding the legal identity of the respective goods, trade channels and purchasers, and the fact that only an ordinary degree of care is likely to be exercised in purchasing the goods, we find that the marks are sufficiently dissimilar that confusion is unlikely. In this *ex parte* proceeding, we cannot conclude that the scope of protection to be accorded the registered mark extends so far as to preclude registration of applicants' dissimilar mark. The dissimilarity of the marks under the first *du Pont* factor simply outweighs the other *du Pont* factors in this case, making confusion unlikely. *See Truescents LLC v. Ride Skin Care, L.L.C.*, 81 USPQ2d 1334 (TTAB 2006); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The refusal to register is reversed.

#### Footnotes

<sup>1</sup> Serial No. 78712155, filed on September 13, 2005. The application is based on applicant's asserted bona fide intention to use the

mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b). The application also seeks registration of the mark for various Class 9 goods. The Trademark Examining Attorney has not refused registration as to Class 9.

- <sup>2</sup> Registration No. 2393152, issued on October 10, 2000. Affidavits under Sections 8 and 15 accepted and acknowledged. The registration also includes various Class 28 goods, which are not cited by the Trademark Examining Attorney and are not at issue in this appeal.
- <sup>3</sup> The Class 25 identification of goods in the registration, as set forth in the Office's electronic records, is somewhat garbled and repetitive, and includes some misspelled words. We have reproduced the identification of goods as it appears in the registration, without correcting the apparent errors.
- <sup>4</sup> We note that most of this evidence, which includes a California state trademark registration and a copyright registration, as well as several third-party registrations, a mere listing of third-party registrations and applications, and printouts of other registrations owned by applicant, would be of little or no probative value in any event. We do not rely on this evidence in reaching our decision herein.

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