

Chapter 4

Similarity of the Marks

- § 4:1 Similarity in Context
- § 4:2 Degree of Similarity
- § 4:3 The Three-Part Test: Sound, Meaning, Appearance
 - § 4:3.1 Commercial Impression
 - § 4:3.2 Sound
 - § 4:3.3 Meaning
 - [A] Word Versus Picture
 - [B] Foreign Word Versus English Word
 - [C] Foreign Word Versus Foreign Word
 - § 4:3.4 Appearance
 - [A] Design Versus Design
 - [B] Letters Versus Letters
 - [C] Different Word/Similar Design
- § 4:4 Consider the Marks As Would the Relevant Public
- § 4:5 Consider the Marks Singly
- § 4:6 Weigh Similarities More Heavily than Differences
- § 4:7 Compare the Marks in Their Entireties
- § 4:8 Consider the Marks in Their Settings
- § 4:9 Give Dominant Portions of Composite Marks Greater Weight
 - § 4:9.1 Family Features
 - § 4:9.2 Words/Designs
 - § 4:9.3 Letters/Designs
 - § 4:9.4 Effect of Registration Disclaimers
- § 4:10 Marks Having Portions in Common
 - § 4:10.1 One Mark Incorporating Another
 - § 4:10.2 Common Portion Comparatively Strong, Dominant
 - § 4:10.3 Common Portion Weak, Recessive
 - § 4:10.4 Common Portion Generic or Functional
 - § 4:10.5 Given Name/Surname
 - § 4:10.6 Marks Suggesting an Association
 - § 4:10.7 Marks with Source Modifiers
 - § 4:10.8 Marks with Geographic Modifiers

2nd Proofs 10/04/17

- § 4:11 Reversal of Elements
- § 4:12 The Familiar Versus the Unfamiliar
- § 4:13 Parody
- § 4:14 Combining Complainant's Marks

§ 4:1 Similarity in Context

Similarity of the marks is an analytical factor in every court.¹ (See section 2:4.) If this is the factor “without which the others have no probative value,”² then it is “the most important consideration, for it is in [the] similarity [of the marks] that the roots of the confusion lie.”³

-
1. The similarity factor is built into the registration statute, 15 U.S.C. § 1052(d), which prohibits registration of any mark “which so resembles” another name or mark “as to be likely . . . to cause confusion.” Seemingly more restrictive, the registered mark infringement statute, 15 U.S.C. § 1114, prohibits the use of “any reproduction, counterfeit, copy, or colorable imitation” that is likely to cause confusion. All four terms seem to imply that the registered mark somehow be the intended target or model for the infringer, but the statute has not been so restrictively applied, since it is well established that one may infringe a mark without knowledge of it or intent to infringe. (See section 8:1.) By contrast, the unregistered mark infringement statute, 15 U.S.C. § 1125(a), more generally prohibits the use of “any word, term, name, symbol or device, or any combination thereof,” which is likely to cause confusion.
 2. *Sleeper Lounge Co. v. Bell Mfg. Co.*, 253 F.2d 720, 723, 117 U.S.P.Q. 117 (9th Cir. 1958), *distinguished in Jada Toys, Inc. v. Mattel, Inc.*, 496 F.3d 974, 980, 83 U.S.P.Q.2d 1591 (9th Cir. 2007); *see Golden Door, Inc. v. Odisho*, 646 F.2d 347, 351, 208 U.S.P.Q. 638, 642 (9th Cir. 1980) (“some factors are entitled to greater weight than others. For instance, the similarity of any competing marks is of substantial importance”); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293, 18 U.S.P.Q.2d 1417, 1430, 1434 (3d Cir. 1991) (“Perhaps the most important of these factors. . . . Highly probative”), *cited in Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 31 U.S.P.Q.2d 1592, 1599 n.11 (3d Cir. 1994) (“We have emphasized the importance of the similarity of the marks in likelihood of confusion [citing Ford], but we have not ranked the factors otherwise”).
 3. *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 501, 203 U.S.P.Q. 19 (5th Cir. 1979); *Hewlett-Packard Co. v. Packard Press*, 281 F.3d 1261, 1265, 62 U.S.P.Q.2d 1001, 1003 (Fed. Cir. 2002) (“a predominant inquiry”); *GoTo.com v. Walt Disney*, 202 F.3d 1199, 53 U.S.P.Q.2d 1652, 1656 (9th Cir. 2000) (similarity of marks “has always been considered a critical question in the likelihood of confusion analysis”); *Brookfield v. W. Coast*, 174 F.3d 1036, 1054, 50 U.S.P.Q.2d 1545 (9th Cir. 1999) (“the similarity of the marks will always be an important factor”); *King of the Mountain Sports v. Chrysler Corp.*, 185 F.3d 1084, 1090, 51 U.S.P.Q.2d 1349 (10th Cir. 1999); *USA Network v. Gannett Co.*, 584

2nd Proofs 10/04/17

Thus “[s]imilarity of the marks is a hallmark of consumer confusion.”⁴ Without a threshold similarity of the marks that might result in confusion, it may even be unnecessary to weigh the other factors.⁵

However, the overall likelihood of confusion analysis generally should not be collapsed into the similarity factor alone.⁶ Other factors remain, and the crucial question is not merely whether the marks are

F. Supp. 195, 223 U.S.P.Q. 678, 681 (D. Colo. 1984) (“seminal factor”); *Lambda Elecs. Corp. v. Lambda Tech., Inc.*, 515 F. Supp. 915, 925, 211 U.S.P.Q. 75, 85 (S.D.N.Y. 1981) (“It scarcely need be stated that the likelihood of confusion that exists in any case will be a function of the degree of similarity between the senior user’s marks and the junior user’s allegedly infringing uses.”); *Frito-Lay v. Bachman Co.*, 704 F. Supp. 432, 435, 14 U.S.P.Q.2d 1027, 1030 (S.D.N.Y. 1989) (similarity of marks “a fundamental Polaroid factor”). *See* section 2:3.

4. *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1330, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999); *Hornady Mfg. Co. v. Doubletap, Inc.*, 746 F.3d 995, 1001, 110 U.S.P.Q.2d 1140 (10th Cir. 2014) (the “first and most important factor”) (**see illustration, Appendix A24**).
5. *Brookfield v. W. Coast*, 174 F.3d 1036, 1054, 50 U.S.P.Q.2d 1545 (9th Cir. 1999) (“Where the two marks are entirely dissimilar, there is no likelihood of confusion. PEPSI does not infringe Coca-Cola’s COKE. Nothing further need be said.”); *Dippin’ Dots v. Frosty Bites*, 369 F.3d 1197, 1208–09, 70 U.S.P.Q.2d 1707, 1714 (11th Cir. 2004) (logos “overwhelmingly dissimilar”); *Abercrombie & Fitch v. Am. Eagle Outfitters*, 280 F.3d 619, 647–48, 61 U.S.P.Q.2d 1769, 1788 (6th Cir. 2002); *Am. Cyanamid Corp. v. Connaught Labs., Inc.*, 800 F.2d 306, 231 U.S.P.Q. 128, 130 (2d Cir. 1986); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346, 93 U.S.P.Q.2d 2030, 2032 (Fed. Cir. 2010) (cartoon designs; “unquestionably different commercial impressions”) (**see illustration, Appendix A20**); *Omega SA v. Alpha Phi Omega*, 118 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 2016); *Kellogg Co. v. Pack’em Enters., Inc.*, 951 F.2d 330, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991); *Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc.*, 656 F.2d 186, 189, 213 U.S.P.Q. 91, 93–94 (5th Cir. 1981) (“The two marks must bear some threshold resemblance in order to trigger inquiry into extrinsic factors”); *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 116, 223 U.S.P.Q. 1000, 1003 (2d Cir. 1984); *Mfg. Co. v. Trainer*, 101 U.S. 51, 56 (1880) (“The two labels are so unlike in every particular . . . that it is impossible that anyone can be misled. . . . The whole structure of the case thus falls to the ground.”); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1384, 1 U.S.P.Q.2d 1779, 1783 (9th Cir. 1987), quoting *Freixenet, S.A. v. Admiral Wine & Liquor Co.*, 731 F.2d 148, 222 U.S.P.Q. 770, 773 (3d Cir. 1984) (“labels . . . so dissimilar as to rule out any possibility of confusion”); *Alchemy II, Inc. v. Yes! Entm’t Corp.*, 844 F. Supp. 560, 30 U.S.P.Q.2d 1770, 1776 (C.D. Cal. 1994); *Jada Toys, Inc. v. Mattel, Inc.*, 496 F.3d 974, 83 U.S.P.Q.2d 1591 (9th Cir. 2007); *see Paulsson Geophysical Servs., Inc. v. Sigmar*, 529 F.3d 303, 86 U.S.P.Q.2d 1813 (5th Cir. 2008) (use of “the exact same mark” justified limited “digits of confusion” analysis).
6. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 350, 204 U.S.P.Q. 808, 816 (9th Cir. 1979) (“Viewing the foundational question as one of ‘confusing similarity’ is improper because it merges analysis of one of the preliminary inquiries with the conceptually distinct step of applying the statutory standard.”); *see Int’l Data Grp., Inc. v. J&R Elecs., Inc.*, 798 F. Supp. 135,

similar, but whether the similarity is likely to cause confusion.⁷ Even close similarity is not in and of itself dispositive; confusion ultimately may be deemed unlikely once the other factors have been considered.⁸ Identical marks may coexist in remote fields. (See section 5:1.2.)

The other factors come into play in various ways. Similarity cannot be assessed without reference to the strength of plaintiff's mark (see sections 3:2–3:3):

If the similarity between two marks would lead consumers to expect that they identify the same source, that similarity is likely to cause confusion. If the similarity between the two marks would lead consumers to assume the similar marks were chosen because they describe similar, desirable attributes of the products, the similarity is less likely to invite a mistaken assumption that the products must come from the same source.⁹

Also as to the strength factor, the degree of similarity of the marks in issue governs the relevance of more or less similar third-party marks. (See section 3:6.2.)

139 n.4 (S.D.N.Y. 1992) (“Courts have minimized the importance of the similarity factor.”), *aff’d without opinion*, 986 F.2d 499 (2d Cir. 1992). See section 1:1.4.

7. *Brennan’s, Inc. v. Brennan’s Rest., L.L.C.*, 360 F.3d 125, 133, 69 U.S.P.Q.2d 1939, 1944 (2d Cir. 2004); *W. Publ’g Co. v. Rose Art Indus.*, 910 F.2d 57, 15 U.S.P.Q.2d 1545, 1548 (2d Cir. 1990), citing *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 202 U.S.P.Q. 81, 89 (2d Cir. 1979); *cf. Nautilus v. Icon*, 372 F.3d 1330, 1344, 71 U.S.P.Q.2d 1173, 1184 (Fed. Cir. 2004) (“The Ninth Circuit has never held that, in addition to considering the *Sleekcraft* factors, a court must satisfy itself that a separate causal relationship exists between the similarity of the marks and consumer confusion.”).
8. *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786, 790 (1st Cir. 1983); *Jada Toys, Inc. v. Mattel, Inc.*, 496 F.3d 974, 83 U.S.P.Q.2d 1591 (9th Cir. 2007) (“we have never countenanced a likelihood of confusion determination based on a consideration of dissimilarity alone . . .”); *amended by* 518 F.3d 628, 85 U.S.P.Q.2d 1895 (9th Cir. 2008); *Fortres Grand Corp. v. Warner Bros. Entm’t Inc.*, 763 F.3d 696, 112 U.S.P.Q.2d 1154 (7th Cir. 2014) (similarity “not enough” when “juxtaposed against the weakness of all the other factors”); *J.B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 192, 189 U.S.P.Q. 10, 14 (9th Cir. 1975); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1130, 202 U.S.P.Q. 81, 89 (2d Cir. 1979); *Lindy Pen Co. v. Bic Pen Corp.*, 725 F.2d 1240, 226 U.S.P.Q. 17, 20 (9th Cir. 1984); *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 257, 216 U.S.P.Q. 177, 182 (2d Cir. 1982) (“Even close similarity between two marks is not dispositive”); *In re Thor Tech Inc.*, 113 U.S.P.Q.2d 1546, 1547 (T.T.A.B. 2015) (“[T]he identity of the marks alone is not sufficient to establish likelihood of confusion in the absence of probative evidence that the goods are related. If that were the case, then the Registrant would have rights in gross, and that is against the principles of trademark law.”).
9. *TCPIP Holding Co. v. Haar Commc’ns*, 244 F.3d 88, 101, 57 U.S.P.Q.2d 1969 (2d Cir. 2001).

“[S]imilarity is not a binary factor but is a matter of degree.”^{9,1} The more similar the marks, the less similarity of the goods is required to support finding of likelihood of confusion—a “viable relationship” between the goods may suffice.¹⁰ Conversely, where the goods or services are more closely related or competitive and travel through the same channels to the same consumers, the similarity of marks factor may gather importance,¹¹ and the less similarity of the marks is required.¹²

As for the degree of care factor, consumers are less likely to perceive or remember specific details of marks for low-cost shelf goods,¹³ but

-
- 9.1. *In re St. Helena Hosp.*, 774 F.3d 747, 752, 113 U.S.P.Q.2d 1082 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003)).
 10. *In re Opus One*, 60 U.S.P.Q.2d 1812, 1815 (T.T.A.B. 2001); *In re Concordia Int'l Forwarding Corp.*, 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 2 U.S.P.Q.2d 1677, 1680 (2d Cir. 1987), citing *SquirtCo. v. Seven-Up Co.*, 628 F.2d 1086, 1091, 207 U.S.P.Q. 897, 900 (8th Cir. 1980); *In re Engine Supply, Inc.*, 225 U.S.P.Q. 216, 217 (T.T.A.B. 1985) (citing cases); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993) (“even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”); TMEP 1207.01(a) (2009).
 11. *Checkpoint v. Check Point*, 269 F.3d 270, 60 U.S.P.Q.2d 1609, 1614 (3d Cir. 2001).
 12. *La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, 762 F.3d 867 (9th Cir. 2014); *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 318, 211 U.S.P.Q. 844, 850 (5th Cir. 1981) (“With this similarity of service comes the potential for the public’s mistaken assumption of connexity between the providers of related services. The more likely the public is to make such an association, the less similarity in the marks is needed for a finding of likelihood of confusion.”), citing *Am. Steel Foundries v. Robertson*, 269 U.S. 372 (1926); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 925, 231 U.S.P.Q. 913, 916 (10th Cir. 1986) (“a small degree of similarity between two marks may lead to a finding that confusion is likely when the products are identical, inexpensive items”); *In re L.C. Licensing, Inc.*, 49 U.S.P.Q.2d 1379, 1381 (T.T.A.B. 1998); *Quadrex Corp. v. Inficon Leybold-Heraeus, Inc.*, 228 U.S.P.Q. 300, 303 (T.T.A.B. 1985) (“the degree of similarity in the goods is inversely proportional to the degree of similarity in the marks”); *Jules Berman & Assoc., Inc. v. Consol. Distilled Prods., Inc.*, 202 U.S.P.Q. 67 (T.T.A.B. 1979); TMEP 1207.01(b) (2009).
 13. *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 U.S.P.Q.2d 1719, 1722 (Fed. Cir. 1988) (Nies, J., dissenting), citing *Colgate-Palmolive Co. v. Purex Corp.*, 451 F.2d 1401, 172 U.S.P.Q. 176 (C.C.P.A. 1971); *AM Gen. Corp. v. DaimlerChrysler Corp.*, 311 F.3d 796, 828, 65 U.S.P.Q.2d 1001, 1023 (7th Cir. 2002) (“Visual similarity may have greater importance when the products are low-priced items not likely to receive considerable study from the consumer.”); *Kemp v. Bumble Bee*, 398 F.3d 1049, 1055, 73 U.S.P.Q.2d 2002, 2007 (8th Cir. 2005). See section 6:4.

2nd Proofs 10/04/17

when the goods are relatively expensive, even a very similar mark may not cause confusion.¹⁴

Actual confusion may belie arguments that the marks are not confusingly similar.¹⁵

§ 4:2 Degree of Similarity

Marks need not be identical to be in conflict.¹⁶ The test is one of resemblance.¹⁷ “What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases.”¹⁸ “[S]imilarity is not a binary factor but is a matter of degree.”¹⁹ “There is no simple rule as to when marks are too similar.”²⁰

-
14. *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 925, 231 U.S.P.Q. 913, 916 (10th Cir. 1986); *cf. Teledyne Techs. Inc. v. W. Skyways Inc.*, 78 U.S.P.Q.2d 1203 (T.T.A.B. 2006) (likelihood of confusion found between identical marks for airplane engines and airplane engine parts; no actual confusion for ten years).
 15. *Beacon v. Onebeacon*, 376 F.3d 8, 18, 71 U.S.P.Q.2d 1641 (1st Cir. 2004); *Jada Toys, Inc. v. Mattel, Inc.*, 496 F.3d 974, 83 U.S.P.Q.2d 1591 (9th Cir. 2007).
 16. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 117, 79 U.S.P.Q.2d 1481 (2d Cir. 2006); *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 538 n.3, 76 U.S.P.Q.2d 1852, 1856 n.3 (2d Cir. 2005); *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 33 (1900) (“It is not necessary to constitute an infringement that every word of a trademark should be appropriated. It is sufficient that enough be taken to deceive the public in the purchase of a protected article.”); *McLean v. Fleming*, 96 U.S. 245, 255 (1878) (“that requirement would always enable the wrong-doer to evade responsibility for his wrongful acts”); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 229, 91 U.S.P.Q.2d 1385, 1388 (5th Cir. 2009) (“Even if a person recognized that the marks are not identical, she might believe that XTENDED BEAUTY is a product line offered by the makers of XTREME LASHES, such as a discount line. Confusion of origin, not the identity of marks, is the gravamen of trademark infringement.”); *Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 128, 13 U.S.P.Q.2d 1257, 1281 (S.D.N.Y. 1989) (“An infringer is not absolved from liability merely because it has not replicated every single aspect of a trademark”); *Gracie v. Gracie*, 217 F.3d 1060, 1067, 55 U.S.P.Q.2d 1256 (9th Cir. 2000).
 17. 15 U.S.C. § 1052(d) (prohibiting registration of a mark “which so resembles” another name or mark “as to be likely . . . to cause confusion”); *Syntex Labs., Inc. v. Norwich Pharmacal Co.*, 315 F. Supp. 45, 166 U.S.P.Q. 312, 315–16 (S.D.N.Y. 1970), *aff’d*, 437 F.2d 566, 169 U.S.P.Q. 1 (2d Cir. 1971); *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1926) (injunction “where the resemblance is so close as to be likely to produce confusion”).
 18. *Country Floors, Inc. v. Gepner*, 930 F.2d 1056, 1064, 18 U.S.P.Q.2d 1577, 1584 (3d Cir. 1991), quoting *McLean v. Fleming*, 96 U.S. 245, 251 (1878).
 19. *In re Coors Brewing Co.*, 343 F.3d 1340, 1344, 68 U.S.P.Q.2d 1059 (Fed. Cir. 2003).
 20. *Kos v. Andrx*, 369 F.3d 700, 713, 70 U.S.P.Q.2d 1874, 1885 (3d Cir. 2004).

2nd Proofs 10/04/17

Generally, the more similar the marks, the more confusion is likely.²¹ Identity of the marks, especially when the senior mark is inherently strong, can weigh heavily against the junior user, even when the goods or services are not competitive or intrinsically related.²²

[W]here there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two marks had been identical in design or nearly indistinguishable to a casual observer.²³

§ 4:3 The Three-Part Test: Sound, Meaning, Appearance

§ 4:3.1 Commercial Impression

The standard analysis compares the marks in sound, meaning and appearance;²⁴ these are the primary ways in which marks are “encountered in the marketplace.”²⁵ As a separate element or “proxy” for the sum of the three, one compares “the overall impression created by the designations as they are used in marketing. . . .”²⁶ Similarity is

-
21. *Kibler v. Hall*, 843 F.3d 1068, 1077, 121 U.S.P.Q.2d 1069 (6th Cir. 2016) (“The more similar the marks are, the more likely it is that relevant consumers will confuse their sources.”); *Brookfield v. W. Coast*, 174 F.3d 1036, 1054, 50 U.S.P.Q.2d 1545 (9th Cir. 1999) (“the more similar the marks in terms of appearance, sound, and meaning, the greater the likelihood of confusion”); *Exxon Corp. v. Tex. Motor Exch. of Houston, Inc.*, 628 F.2d 500, 208 U.S.P.Q. 384, 388 (5th Cir. 1980); *Country Floors, Inc. v. Mizak*, 29 U.S.P.Q.2d 1468, 1471 (D. Conn. 1993) (“it is, of course, an inescapable conclusion that the greater the similarity between the plaintiff’s and defendant’s marks, the greater the likelihood of confusion among consumers”); *Ocean Bio-Chem, Inc. v. Turner Network Television, Inc.*, 741 F. Supp. 1546, 16 U.S.P.Q.2d 1264, 1270 (S.D. Fla. 1990); *MCA, Inc. v. Mid-Continent Adjustment Co.*, 8 U.S.P.Q.2d 1840, 1844 (N.D. Ill. 1988).
 22. *In re Majestic*, 315 F.3d 1311, 1316, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003).
 23. *In re Coors Brewing Co.*, 343 F.3d 1340, 1344, 68 U.S.P.Q.2d 1059 (Fed. Cir. 2003).
 24. *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 49 U.S.P.Q.2d 1355, 1358 (6th Cir. 1999); *Miss World (U.K.) Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1450, 8 U.S.P.Q.2d 1237, 1241 (9th Cir. 1988); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 975, 219 U.S.P.Q. 515, 524 (11th Cir. 1983); *Henri’s Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 220 U.S.P.Q. 386, 388 (7th Cir. 1983).
 25. *Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.*, 22 F.3d 1527, 30 U.S.P.Q.2d 1930, 1933 (10th Cir. 1994); *Heartsprings, Inc. v. HeartSpring, Inc.*, 143 F.3d 550, 46 U.S.P.Q.2d 1481, 1483 (10th Cir. 1998).
 26. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21(a)(i) (1995); *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 53 U.S.P.Q.2d 1652 (9th Cir. 2000) (“With a single glance at the two images, one is immediately

not to be considered in the abstract, but from the ordinary consumer's perspective.²⁷

The facts permitting, each facet should be considered.²⁸ Similarity of any one permits but does not require a finding that the marks are confusingly similar.²⁹

In appropriate cases, two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation. Of course, two marks may be extremely similar or even identical in one aspect (sound, appearance or

struck by their similarity.") (see **illustration, Appendix A21**); *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 25 U.S.P.Q.2d 1593, 1597 (2d Cir. 1993) ("general impression"); *UMG Recordings Inc. v. O'Rourke*, 92 U.S.P.Q.2d 1042, 1048–49 (T.T.A.B. 2009) ("When comparing the marks, we must consider the appearance, sound, connotation and commercial impression of each mark . . . The overall commercial impressions of the marks is [sic] a consideration occasionally used as a proxy for the ultimate conclusion of similarity or dissimilarity. In the case at hand . . . we specifically consider commercial impression as a distinct consideration when comparing the marks.") (internal quotation marks omitted); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 955 F.2d 1327, 21 U.S.P.Q.2d 1824, 1832 (9th Cir. 1992); *Palm Bay v. Veuve Clicquot*, 396 F.3d 1369, 1372, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) ("the phrase 'commercial impression' is occasionally used as a proxy for the ultimate conclusion of similarity or dissimilarity of marks resulting from a comparison of their appearance, sound, and meaning"); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983); *TMEP 1207.01(b)* (2009) ("the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks").

27. *Reno Air Racing Ass'n v. McCord*, 452 F.3d 1126, 1136–37, 79 U.S.P.Q.2d 1431 (9th Cir. 2006); *In re I.Am.Symbolic, LLC*, 116 U.S.P.Q.2d 1406, 1409 (T.T.A.B. 2015).
28. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 204 U.S.P.Q. 808, 816 (9th Cir. 1979); *Recot v. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) ("All relevant facts pertaining to appearance, sound and connotation must be considered before similarity as to one or more of these factors may be sufficient to support a finding that the marks are similar or dissimilar").
29. *Volkswagenwerk AG v. Wheeler*, 814 F.2d 812, 817, 2 U.S.P.Q.2d 1264, 1268 (1st Cir. 1987) (appearance alone); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801, 223 U.S.P.Q. 979, 980 (Fed. Cir. 1984); *United Glob. Media Grp., Inc. v. Tseng*, 112 U.S.P.Q.2d 1039, 1047 (T.T.A.B. 2014) ("any one of these means of comparison may be critical"); *In re White Swan, Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (T.T.A.B. 1987); *In re Aquamar, Inc.*, 115 U.S.P.Q.2d 1122, 1127 (T.T.A.B. 2015) ("[E]quivalency in connotation does not, in and of itself, determine the question of likelihood of confusion in this case . . . the similarity in connotation must be viewed as but a single factor in the overall evaluation of likelihood of confusion.") (quoting *In re Ithaca Indus.*, 230 U.S.P.Q. 702, 704 (T.T.A.B. 1986)).

connotation), and yet not be confusingly similar because of significant differences in one or more of the other two aspects.³⁰

Visual dissimilarity may outweigh aural similarity depending on the circumstances of sale;³¹ for example, appearance may be the more important where the goods are sold in self-service markets.³² Or similarity of sound may trump visual dissimilarities.³³

Where the marks in dispute are common words with well-known meanings, relatively slight differences in sound or appearance suffice to avoid conflict in some cases.³⁴ By contrast, where the marks in issue are coined, a lesser degree of similarity of sound or appearance has been required to establish likelihood of confusion.³⁵ “Two names that look and sound similar will naturally seem even more similar where there

-
30. Kabushiki Kaisha Hattori Seiko v. Satellite Int’l Ltd., 29 U.S.P.Q.2d 1317, 1318 (T.T.A.B. 1991), *aff’d without opinion*, 979 F.2d 216 (Fed. Cir. 1992) (emphasis in original; citation omitted); TMEP 1207.01(b)(i) (2009).
 31. Del Labs., Inc. v. Alleghany Pharmacal Corp., 516 F. Supp. 777, 215 U.S.P.Q. 421, 426 (S.D.N.Y. 1981); Mem Co. v. Yardley of London, Inc., 212 U.S.P.Q. 280, 284 (S.D.N.Y. 1981); Heartsprings, Inc. v. Heartspring, Inc., 143 F.3d 550, 46 U.S.P.Q.2d 1481, 1483 (10th Cir. 1998); Viacom Int’l, Inc. v. Komm, 46 U.S.P.Q.2d 1233, 1238 (T.T.A.B. 1998).
 32. One Indus., LLC v. Jim O’Neal Distrib., Inc., 578 F.3d 1154, 1162 (9th Cir. 2009) (as buyers select the goods “inside a store or during online browsing, *sight* is significantly more important when comparing these marks than sound or meaning”) (emphasis in original); Del Labs., Inc. v. Alleghany Pharmacal Corp., 516 F. Supp. 777, 215 U.S.P.Q. 421, 426 (S.D.N.Y. 1981), quoting Spangler Candy Co. v. Crystal Pure Candy Co., 235 F. Supp. 18, 22, 143 U.S.P.Q. 94 (N.D. Ill. 1964), *aff’d*, 353 F.2d 641, 147 U.S.P.Q. 434 (7th Cir. 1965).
 33. All. Bank v. New Century Bank, 742 F. Supp. 2d 532, 98 U.S.P.Q.2d 1292 (E.D. Pa. 2010) (CUSTOMER FIRST versus CUSTOMERS 1st) (**see illustration, Appendix A15**).
 34. Playboy Enters., Inc. v. Chuckleberry Publ’g, Inc., 486 F. Supp. 414, 206 U.S.P.Q. 70, 76 (S.D.N.Y. 1980), citing cases; E.R. Squibb & Sons, Inc. v. Cooper Labs., 536 F. Supp. 523, 214 U.S.P.Q. 441, 450 (S.D.N.Y. 1982); Racemark Int’l, Inc. v. Specialty Prods., Inc., 217 U.S.P.Q. 772, 779 (N.D.N.Y. 1982) (RACEMARK v. ROSSMARK); Chesebrough-Pond’s, Inc. v. Faberge, Inc., 666 F.2d 393, 214 U.S.P.Q. 44, 48 (9th Cir. 1982) (MATCH v. MATCHO); Swatch AG v. Beehive Wholesale, LLC, 739 F.3d 150, 159 (4th Cir. 2014) (SWAP versus SWATCH, both for watches) (**see illustration, Appendix A25**); Ava Enters., Inc. v. P.A.C. Trading Grp., Inc., 86 U.S.P.Q.2d 1659 (T.T.A.B. 2008) (BOSS v. BOOSTER).
 35. See E.I. du Pont de Nemours & Co. v. Yoshida Int’l, Inc., 393 F. Supp. 502, 185 U.S.P.Q. 597, 604 (E.D.N.Y. 1975) (TEFLON v. EFLON); Procter & Gamble Co. v. Johnson & Johnson, 485 F. Supp. 1185, 1197, 205 U.S.P.Q. 697, 709 (S.D.N.Y. 1979) (“When arbitrary or fanciful marks are involved, the distinctiveness of the marks will make the public more conscious of similarities than differences.”), *aff’d without opinion*, 636 F.2d 1203 (2d Cir. 1980), *cited in* Inter IKEA Sys. B.V. v. Akea, LLC, 110 U.S.P.Q.2d 1734, 1741 (T.T.A.B. 2014). See the hypothetical illustration in TCPIP Holding Co. v. Haar Commc’ns, 244 F.3d 88, 101, 57 U.S.P.Q.2d 1969 (2d Cir. 2001).

are no differences in meaning to distinguish them. Nor can the similarity of coined marks be explained by, or ameliorated by virtue of, any relationship between the marks and the products identified.”³⁶

§ 4:3.2 Sound

The sounds of two marks may create a confusingly similar impression when heard.³⁷ The sounds must be compared as if heard singly, subject to the consumer’s indefinite recollection. According to one court, it is an “accepted fact that people develop biases to particular sounds which they have heard over a long period of time and which they expect to hear in the future such that a word which sounds similar to the word people expect to hear can be easily perceived as the word the people expect to hear and not the word which was actually said.”³⁸

Because a trademark owner cannot control how its mark will be vocalized, there is not necessarily one, correct pronunciation, especially where the mark is coined or unusual. Nor is there any rule for gauging how a mark will sound.³⁹ “[I]t is impossible to predict how the public will pronounce a particular mark.”⁴⁰ “Prospective purchasers do not necessarily speak the word portions of marks the way advertising agencies or manufacturers would have them spoken”; purchasers who have only seen the mark in a particular form may have never heard or spoken it.⁴¹ Evidence, as always, is

-
36. *Kos v. Andrx*, 369 F.3d 700, 713, 70 U.S.P.Q.2d 1874, 1885 (3d Cir. 2004) (ADVICOR v. ALTOCOR).
 37. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 204 U.S.P.Q. 808, 817 (9th Cir. 1979), quoting *G.D. Searle & Co. v. Chas. Pfizer & Co.*, 265 F.2d 385, 387, 121 U.S.P.Q. 74, 75–76 (7th Cir. 1959); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1340, 186 U.S.P.Q. 436, 443 (2d Cir. 1975); *In re Energy Telecomms. & Elec. Ass’n*, 222 U.S.P.Q. 350, 351 (T.T.A.B. 1983).
 38. *Pathfinder Commc’ns Corp. v. Midwest Commc’ns Co.*, 593 F. Supp. 281, 284, 224 U.S.P.Q. 203, 205 (N.D. Ill. 1984); *see, e.g., Orkin Exterminating Co. v. Parrill*, 223 U.S.P.Q. 564, 566 (S.D. W. Va. 1983) (ORKIN v. ORKO; differences in second syllables not as likely to be picked up once the “ear focuses” on the same, distinctive first syllable).
 39. *Smithkline Beckman Corp. v. Procter & Gamble Co.*, 591 F. Supp. 1229, 223 U.S.P.Q. 1230, 1237 (N.D.N.Y. 1984); *ConAgra, Inc. v. Saavedra*, 4 U.S.P.Q.2d 1245, 1247 (T.T.A.B. 1987); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.3 (T.T.A.B. 1987); *Trak, Inc. v. Traq, Inc.*, 212 U.S.P.Q. 846, 850 (T.T.A.B. 1981); *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 U.S.P.Q. 848, 850 (T.T.A.B. 1983); *Joujou Designs, Inc. v. Jojo Ligne Internationale, Inc.*, 821 F. Supp. 1347, 1354, 25 U.S.P.Q.2d 1855, 1859 (N.D. Cal. 1992) (“The issue of likelihood of confusion is determined according to how consumers react to the mark, regardless of how ‘correct’ that reaction might be.”); TMEP 1207.01(b)(iv) (2009).
 40. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 U.S.P.Q.2d 1399, 1409 (T.T.A.B. 2010).
 41. *Henry I. Siegel Co. v. A&F Originals, Inc.*, 225 U.S.P.Q. 626, 628 (T.T.A.B. 1985).

2nd Proofs 10/04/17

important.^{41.1} Absent substantial evidence, one considers all reasonable possibilities.⁴² “The relevant comparison is not between the proper pronunciations but rather how prospective purchasers are likely to hear or use the words.”⁴³ Even so, auditory analysis is not an end-all; confusion about the proper pronunciation of a mark is not necessarily confusion about the source or sponsorship of the goods.⁴⁴

Similarity of sound is especially significant for marks which are primarily used orally—for example, in telephone solicitation and sales markets;⁴⁵ radio or word-of-mouth advertising;⁴⁶ requesting the goods.⁴⁷ Different appearances such as logos are lost on listeners.⁴⁸

-
- 41.1. Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC, 826 F.3d 1376, 119 U.S.P.Q.2d 1286 (Fed. Cir. 2016) (MAYA versus MAYARI, both for wines, not confusingly similar).
 42. StonCor Grp., Inc. v. Specialty Coatings, Inc., 759 F.3d 1327, 1332, 111 U.S.P.Q.2d 1649 (Fed. Cir. 2014) (error to ignore “the weight of the evidence” on how “potential consumers would pronounce the mark”); Centraz Indus., Inc. v. Spartan Chem. Co., 77 U.S.P.Q.2d 1698, 1701 (T.T.A.B. 2006) (iShine and ICE SHINE confusingly similar; “purchasers may roll the ‘s’ sound from the pronunciation of ‘ice’ into the ‘sh’ sound beginning the second syllable ‘shine’”); Edison Bros. Stores, Inc. v. Brutting E.B. Sport-Int’l GmbH, 230 U.S.P.Q. 530, 533 (T.T.A.B. 1986); cf. Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha, 228 U.S.P.Q. 672, 674 (T.T.A.B. 1985) (“it strains credulity that either SUBARU or SUPRA could conceivably be so badly pronounced as to be mistaken in verbal marketplace communications”).
 43. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 note on cmt. d, at 241 (1995); Smithkline Beckman Corp. v. Procter & Gamble Co., 591 F. Supp. 1229, 223 U.S.P.Q. 1230, 1237 (N.D.N.Y. 1984); Pfizer, Inc. v. Cody John Cosmetics, Inc., 211 U.S.P.Q. 64, 69 n.4 (T.T.A.B. 1981) (“the issue of confusion is determined according to how consumers react, whether or not such reaction might be ‘correct’”).
 44. Lebow Bros., Inc. v. Lebole Euroconf. S.p.A., 503 F. Supp. 209, 212 U.S.P.Q. 693, 695 (E.D. Pa. 1980).
 45. Sensient Techs. Corp. v. SensoryEffects Flavor Co., 613 F.3d 754, 765, 96 U.S.P.Q.2d 1164, 1171 (8th Cir. 2010); Lindy Pen Co. v. Bic Pen Corp., 725 F.2d 1240, 226 U.S.P.Q. 17, 20 (9th Cir. 1984), *later proceeding*, 796 F.2d 254, 230 U.S.P.Q. 791, 793 (9th Cir. 1986); TBC Corp. v. Holsa, Inc., 126 F.3d 1470, 1472, 44 U.S.P.Q.2d 1315 (Fed. Cir. 1997) (“in this age of business over the telephone and advertising on TV and radio”).
 46. Virgin Enters. Ltd. v. Nawab, 335 F.3d 141, 149, 67 U.S.P.Q.2d 1420, 1426–27 (2d Cir. 2003); Armco, Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 217 U.S.P.Q. 145, 150 (5th Cir. 1982); Kimberly-Clark Corp. v. H. Douglas Enters., Ltd., 774 F.2d 1144, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985); Forum Corp. of N. Am. v. Forum, Ltd., 903 F.2d 434, 14 U.S.P.Q.2d 1950, 1955 (7th Cir. 1990).
 47. E. Remy Martin & Co. v. Shaw-Ross Int’l Imps., Inc., 756 F.2d 1525, 225 U.S.P.Q. 1131, 1135 (11th Cir. 1985); Schieffelin & Co. v. Molson Cos. Ltd., 9 U.S.P.Q.2d 2069, 2073 (T.T.A.B. 1989) (alcoholic beverages ordered verbally).
 48. Meridian Mut. Ins. Co. v. Meridian Ins. Grp., Inc., 128 F.3d 1111, 1116, 44 U.S.P.Q.2d 1545 (7th Cir. 1997); Grotrian, Helfferich, Schulz,

Sound is less important if prospective purchasers are likely to encounter the marks visually rather than aurally—for example, on the shelf in a self-service store,⁴⁹ but, even then, consumers may use the mark orally in asking for the product location.⁵⁰ Also, “the sound of a mark plays a role in the commercial impression created by the mark, in the minds of purchasers, even when the mark is presented visually. . . .”⁵¹

Slight differences of sound will not avoid infringement.⁵² “Verbalization of the mark must be considered within the environs of the marketplace.”⁵³

Sound comparisons include rhyme,⁵⁴ alliteration, cadence, rhythm, and stress patterns (primary and secondary accents).⁵⁵ Sounds are

-
- Th. Steinweg Nachf. v. Steinway & Sons, 523 F.2d 1331, 186 U.S.P.Q. 436, 443 (2d Cir. 1975); Giant Food, Inc. v. Nation’s Foodservice, Inc., 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983); Fuji Photo Film Co. v. Shinohara Shoji, 754 F.2d 591, 225 U.S.P.Q. 540, 544 (5th Cir. 1985); Marathon Mfg. Co. v. Enerlite Prods. Corp., 767 F.2d 214, 226 U.S.P.Q. 836 (5th Cir. 1985); Universal Motor Oils Co. v. Amoco Oil Co., 15 U.S.P.Q.2d 1613, 1619 (D. Kan. 1990); Accuride Int’l, Inc. v. Accuride Corp., 871 F.2d 1531, 10 U.S.P.Q.2d 1589, 1593 (9th Cir. 1989).
49. See First Int’l Servs. Corp. v. Chuckles, Inc., 5 U.S.P.Q.2d 1628, 1632 (T.T.A.B. 1988) (goods may “be taken from a shelf without the purchaser having the need to ask for them by name”).
50. *Id.*; Bell Publ’g Corp. v. Bantam Doubleday Dell Publ’g Grp., Inc., 17 U.S.P.Q.2d 1634, 1637 (E.D. Pa. 1990).
51. *In re* Great Lakes Canning, Inc., 227 U.S.P.Q. 483, 484 (T.T.A.B. 1985).
52. G.D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 387, 121 U.S.P.Q. 74 (7th Cir. 1959); *In re* Energy Telecomms. & Elec. Ass’n, 222 U.S.P.Q. 350, 351 (T.T.A.B. 1983).
53. Ga.-Pac. Corp. v. Great Plains Bag Co., 614 F.2d 757, 760–61, 204 U.S.P.Q. 697, 699–700 (C.C.P.A. 1980) (considering whether “those who would be the ones to verbalize [the mark] are also sufficiently sophisticated in the pertinent goods to know whose trademark they are verbalizing”).
54. Kimberly-Clark Corp. v. H. Douglas Enters., Ltd., 774 F.2d 1144, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985) (HUGGIES and DOUGIES); Andersen Corp. v. Therm-O-Shield Int’l, Inc., 226 U.S.P.Q. 431, 434 (T.T.A.B. 1985) (PERMA-SHIELD and THERM-O-SHIELD); Mister Twister, Inc. v. JenEm Corp., 710 F. Supp. 202, 11 U.S.P.Q.2d 1310, 1311 (S.D. Ohio 1989) (MISTER TWISTER and WEST SISTER TWISTER).
55. Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co., 22 F.3d 1527, 30 U.S.P.Q.2d 1930, 1933 (10th Cir. 1994) (cadence); G.D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 387, 121 U.S.P.Q. 74 (7th Cir. 1959); HQ Network Sys. v. Exec. Headquarters, 755 F. Supp. 1110, 18 U.S.P.Q.2d 1897, 1902 (D. Mass. 1991) (phonetic emphasis); Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 231 U.S.P.Q. 850, 854 (N.D. Ga. 1986) (stress pattern); Block Drug Co. v. Den-Mat, Inc., 17 U.S.P.Q.2d 1315, 1317 (T.T.A.B. 1989), *aff’d*, Den-Mat Corp. v. Block Drug Co., 17 U.S.P.Q.2d 1318 (Fed. Cir. 1990) (cadence); Schmidt v. Honeysweet Hams, Inc., 656 F. Supp. 92, 1 U.S.P.Q.2d 1135, 1138 (N.D. Ga. 1986) (sound and cadence); *In re* Nat’l Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985) (general similarity in cadence); *In re* Energy Telecomms. & Elec. Ass’n, 222 U.S.P.Q. 350 (T.T.A.B. 1983) (syllables, stress patterns, primary accents).

sometimes characterized informally, such as “hard” or “soft,”⁵⁶ or sometimes with jargon, such as “velar plosives” or “glottal stops.”⁵⁷ The testimony of linguistics or language experts, if admissible (see section 1:8.4), is weightier if supported by a survey, which would more directly reflect actual usage.⁵⁸ Phoneticians and phonologists have also been heard.⁵⁹ On the question of pronunciation of a mark, the Trademark Trial and Appeal Board has said: “[W]e will not substitute the opinion of a witness, even an expert witness, for our evaluation of the facts.”⁶⁰

§ 4:3.3 Meaning

“Two designations may be dissimilar in appearance yet create the same mental impression because they share the same meaning or connotation. To the extent that the similarity of mental impression predominates over the dissimilarities in appearance, a likelihood of confusion may result.”⁶¹ Classic cases of confusingly similar connotation involved the marks CYCLONE v. TORNADO, both for fencing, and JELLIBEANS v. LOLLIPOPS, both for roller rinks.⁶² Like slight

-
56. Bell Publ’g Corp. v. Bantam Doubleday Dell Publ’g Grp., Inc., 17 U.S.P.Q.2d 1634, 1637 (E.D. Pa. 1990); Chesebrough-Pond’s, Inc. v. Soulful Days, Inc., 228 U.S.P.Q. 954, 956 (T.T.A.B. 1985).
57. Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 231 U.S.P.Q. 850, 854 (N.D. Ga. 1986); Pathfinder Commc’ns Corp. v. Midwest Commc’ns Co., 593 F. Supp. 281, 224 U.S.P.Q. 203, 205 (N.D. Ill. 1984).
58. Water Pik, Inc. v. Med-Systems, Inc., 726 F.3d 1136, 1156, 107 U.S.P.Q.2d 2095 (10th Cir. 2013) (professor of English; “the report covers a matter on which the trier of fact does not need expert advice”) (see **illustration, Appendix A22**); Han Beauty v. Alberto-Culver, 236 F.3d 1333, 1337, 57 U.S.P.Q.2d 1557 (Fed. Cir. 2001) (French language professor testimony); Mister Twister, Inc. v. JenEm Corp., 710 F. Supp. 202, 11 U.S.P.Q.2d 1310, 1311 (S.D. Ohio 1989); Schieffelin & Co. v. Molson Cos. Ltd., 9 U.S.P.Q.2d 2069, 2073 n.5 (T.T.A.B. 1989); Fisons Ltd. v. UAD Labs., Inc., 219 U.S.P.Q. 661, 663 (T.T.A.B. 1983) (no weight); ConAgra, Inc. v. George A. Hormel & Co., 784 F. Supp. 700, 717 (D. Neb. 1992), *aff’d*, 990 F.2d 368, 26 U.S.P.Q.2d 1316 (8th Cir. 1993); Scott v. Mego Int’l, Inc., 519 F. Supp. 1118, 213 U.S.P.Q. 824, 836 (D. Minn. 1981); Chesebrough-Pond’s, Inc. v. Faberge, Inc., 666 F.2d 393, 214 U.S.P.Q. 44, 48 (9th Cir. 1982) (little or no weight for testimony of English professor on sounds and spellings of the marks).
59. Pathfinder Commc’ns Corp. v. Midwest Commc’ns Co., 593 F. Supp. 281, 224 U.S.P.Q. 203, 205 (N.D. Ill. 1984) (voice prints and spectrographic analysis).
60. Edwards Lifesciences Corp. v. VigiLanz Corp., 94 U.S.P.Q.2d 1399, 1402 (T.T.A.B. 2010).
61. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. f, at 231 (1995).
62. Hancock v. Am. Steel & Wire Co. of N.J., 203 F.2d 737, 97 U.S.P.Q. 330 (C.C.P.A. 1953); Jellibean, Inc. v. Skating Clubs of Ga. Inc., 716 F.2d 833, 222 U.S.P.Q. 10 (11th Cir. 1983); see Mohawk Rubber Co. v. Mobiliner Tire Co., 217 U.S.P.Q. 929, 932 and n.20 (T.T.A.B. 1981) (MOHICAN, MOHAWK).

differences in sound, fine semantical distinctions unlikely to be made or remembered by consumers are irrelevant.⁶³ The meanings need not be identical to be confusingly similar; even if different, they may be associative or parallel in a way that suggests a common source. (See section 4:10.6.) Conflict was found in these cases:

PLAY-DOH	and	FUNDOUGH ⁶⁴
DOWNTOWNER	and	UPTOWNER ⁶⁵
MR. CLEAN	and	MR. RUST ⁶⁶
CITY GIRL	and	CITY WOMAN ⁶⁷
BLUE NUN	and	BLUE CHAPEL ⁶⁸
BLACK GIRLS ROCK	and	BLACK MEN ROCK ^{68.1}

The meaning of a word is, simply, what consumers understand it to be. The dictionary is an obvious but not necessarily the best source of proof;⁶⁹ the public understanding of the meaning, if disputed, is always subject to other, more direct proof.⁷⁰ Where a meaning would be understood by an appreciable number of consumers with resulting confusion, but missed by others, without confusion, then generally conflict will be found.⁷¹ Confusion may be avoided, however, where the words in

-
63. *Hancock v. Am. Steel & Wire Co. of N.J.*, 203 F.2d 737, 97 U.S.P.Q. 330 (C.C.P.A. 1953); *Mohawk Rubber Co. v. Mobiliner Tire Co.*, 217 U.S.P.Q. 929 (T.T.A.B. 1981); *In re Iolo Techs. LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010) (two separate words joined as a single compound term; “We find this difference to have no trademark significance”).
64. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1992).
65. *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 U.S.P.Q. 105, 109 (T.T.A.B. 1973), *aff’d without opinion*, 508 F.2d 847, 183 U.S.P.Q. 427 (C.C.P.A. 1974).
66. *Procter & Gamble Co. v. Lewis Research Labs Co.*, 222 U.S.P.Q. 359, 360 (T.T.A.B. 1984).
67. *In re M. Serman & Co.*, 223 U.S.P.Q. 52, 53 (T.T.A.B. 1984), citing cases.
68. *H. Sichel Söhne GmbH v. John Gross & Co.*, 204 U.S.P.Q. 257, 260 (T.T.A.B. 1979).
- 68.1. *Bond v. Taylor*, 119 U.S.P.Q.2d 1049 (T.T.A.B. 2016).
69. *Scotch Whisky Ass’n v. Majestic Distilling Co.*, 958 F.2d 594, 22 U.S.P.Q.2d 1050, 1053 (4th Cir. 1992); *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 182 U.S.P.Q. 77, 82 n.5 (5th Cir. 1974).
70. *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 U.S.P.Q.2d 1913, 1919 (T.T.A.B. 2015); *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 U.S.P.Q.2d 1286 (Fed. Cir. 2016) (MAYA versus MAYARI, both for wines, not confusingly similar). *See Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 224 U.S.P.Q. 185, 192–93 (4th Cir. 1984).
71. *In re White Swan, Ltd.*, 8 U.S.P.Q.2d 1534, 1536 (T.T.A.B. 1988) (SHAKE-N-GROW v. SHAKE SCATTER & GROW); *Blue Cross & Blue Shield*

issue have multiplicities of meanings or synonyms, and consumers would not necessarily make a mistaken mental connection.⁷²

Meaning is not to be determined in the abstract, but in relation to the goods and the context in which the mark is used and encountered by consumers.⁷³ The issue is whether the consumers are likely to make the mental effort to reach the nexus.⁷⁴ Similarity of meaning is more significant in cases of inherently strong marks⁷⁵ than if the terms are highly suggestive, laudatory, or descriptive and lack secondary meaning. One may not exclusively appropriate the connotation of such terms: competitors must be free to describe and praise their own goods.⁷⁶ No conflict was found in the following cases:

-
- Ass'n v. Harvard Cmty. Health Plan, Inc., 17 U.S.P.Q.2d 1075, 1077 (T.T.A.B. 1990) (THE BLUES v. THE CURE FOR THE BLUES—applicant intended a distinct connotation, but the slogan was likely to confuse).
72. Hansen v. Nat'l Beverage, 493 F.3d 1074, 1079, 83 U.S.P.Q.2d 1276 (9th Cir. 2007) (MONSTER v. FREAK).
73. Xtreme Lashes, LLC v. Xtended Beauty, Inc., 576 F.3d 221, 228, 91 U.S.P.Q.2d 1385, 1388 (5th Cir. 2009) (context of use, such as labels, packaging, and advertising); Elvis Presley v. Capece, 141 F.3d 188, 197, 46 U.S.P.Q.2d 1737 (5th Cir. 1998) (“the context of the presentation of a mark, including advertising, is relevant to the meaning that the mark conveys”); Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988); Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 U.S.P.Q.2d 1713, 1721 (Fed. Cir. 2012) (COACH for handbags versus COACH for educational software; “[e]ven where the marks at issue are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity”); Embarcadero Techs., Inc. v. RStudio, Inc., 105 U.S.P.Q.2d 1825, 1835 (T.T.A.B. 2013); TMEP 1207.01(b)(v) (2009).
74. Floss Aid Corp. v. John O. Butler Co., 205 U.S.P.Q. 274, 285 (T.T.A.B. 1979) (FLOSSAID v. FLOSSMATE, both for dental floss holders; “Opposer has attempted to equate MATE with HELPER and then with AID; but it is not likely that the average purchaser would sense that significance or make the mental effort sufficient to reach this nexus.”).
75. Hancock v. Am. Steel & Wire Co. of N.J., 203 F.2d 737, 97 U.S.P.Q. 330 (C.C.P.A. 1953) (CYCLONE v. TORNADO both for fencing); Am. Home Prods. Corp. v. Johnson Chem. Co., 589 F.2d 103, 200 U.S.P.Q. 417, 419–20 (2d Cir. 1978) (ROACH INN v. ROACH MOTEL).
76. Am. Cyanamid Corp. v. Connaught Labs., Inc., 800 F.2d 306, 309, 231 U.S.P.Q. 128, 129 (2d Cir. 1986) (VAX, IMUNE—“They may well have a similar meaning, but that meaning lies entirely in their descriptive reference to vaccination and immunization”); Physicians Formula Cosmetics, Inc. v. W. Cabot Cosmetics, Inc., 857 F.2d 80, 84, 8 U.S.P.Q.2d 1136, 1139 (2d Cir. 1988) (PHYSICIANS—“The concept of medical endorsement is no more subject to exclusive use by a single party than a concept such as ‘best quality’”); *but see* Beer Nuts, Inc. v. Clover Club Foods Co., 711 F.2d 934, 221 U.S.P.Q. 209, 216 (10th Cir. 1983) (BREW NUTS v. BEER NUTS), and Kenner Parker Toys, Inc. v. Rose Art Indus.,

PURE BREW	and	CLEAR BREW ⁷⁷
LIP-FIX	and	LIP REPAIR ⁷⁸
SUPEROXIDE	and	HYPER-OXIDE ⁷⁹
PENN BEST	and	PENSUPREME ⁸⁰
APPROVAL FIRST	and	APPROVAL PLUS ⁸¹
MINI BASS	and	LIL' BASS ⁸²

[A] Word Versus Picture

Words and pictures which designate the same thing are often deemed to have a confusingly similar meaning.⁸³ The issue is whether the pictorial representation is likely to trigger recollection of its literal equivalent, or vice versa.⁸⁴ The issue is one of fact, not law,⁸⁵ and ultimately depends on (a) whether the one mark readily evokes the other and (b) whether the consumers are likely to make the “translation.”⁸⁶

Inc., 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed Cir. 1992) (PLAY-DOH v. FUNDOUGH); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985) (THE CASH MANAGEMENT EXCHANGE v. CASH MANAGEMENT ACCOUNT; refusal to register affirmed).

77. *Sunbeam Corp. v. Green Bay Tissue Mills, Inc.*, 199 U.S.P.Q. 695, 697–98 (T.T.A.B. 1978).
78. *Eli Lilly & Co. v. Revlon, Inc.*, 577 F. Supp. 477, 223 U.S.P.Q. 251, 256 (S.D.N.Y. 1983).
79. *Roux Labs., Inc. v. Kaler*, 214 U.S.P.Q. 134, 138 (T.T.A.B. 1982).
80. *Penn Dairies, Inc. v. Penn. Agric. Coop. Mktg. Ass'n*, 200 U.S.P.Q. 462, 466 (T.T.A.B. 1978).
81. *Sears Mortg. Corp. v. Ne. Sav. FA*, 24 U.S.P.Q.2d 1227, 1229 (T.T.A.B. 1992).
82. *In re Haddock*, 181 U.S.P.Q. 796 (T.T.A.B. 1974).
83. *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 2 U.S.P.Q.2d 1677, 1679 (2d Cir. 1987) (PEGASUS and winged horse design), citing *Beer Nuts, Inc. v. King Nut Co.*, 477 F.2d 326, 329, 177 U.S.P.Q. 609, 611 (6th Cir. 1973) (BEER NUTS and an overflowing stein of beer), and *Izod, Ltd. v. Zip Hosiery Co.*, 405 F.2d 575, 160 U.S.P.Q. 202, 203 (C.C.P.A. 1969) (TIGER HEAD and tiger design); *Penguin Books Ltd. v. Eberhard*, 48 U.S.P.Q.2d 1280, 1286 (T.T.A.B. 1998) (PENGUIN and penguin design); *Squirrel Brand Co. v. Green Gables Inv. Co.*, 223 U.S.P.Q. 154, 155 (T.T.A.B. 1984) (SQUIRREL BRAND and squirrel cartoon); *In re Rolf Nilsson AB*, 230 U.S.P.Q. 141, 142 (T.T.A.B. 1986) (LION and lion silhouette); TMEP 1207.01(c)(i) (2009).
84. *In re Hungry Pelican, Inc.*, 219 U.S.P.Q. 1202, 1203–04 (T.T.A.B. 1983) (citing cases).
85. *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 2 U.S.P.Q.2d 1677, 1679 (2d Cir. 1987).
86. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 note on cmt. d, at 241 (1995); *In re Serac, Inc.*, 218 U.S.P.Q. 340, 341 (T.T.A.B. 1983) (no confusion where the design was so stylized that it could hardly be recognized or connected with the word); *see Spaulding Bakeries, Inc. v. Interstate Brands*

Courts have often “applied the doctrine of word-picture equivalency only when the word mark and its pictorial representation are concrete and narrowly focused.”⁸⁷

If a word aptly describes a design, then they may be confusingly similar even if the design might suggest other words as well.⁸⁸ If a design is not an obvious equivalent of any particular word, but rather is subject to a variety of interpretations, then confusing similarity is unlikely to be found.⁸⁹ Ultimately, the issue is not a technical one of design-word “translation,” but depends on the overall commercial impressions of the marks seen from the ordinary consumer’s perspective.

[B] Foreign Word Versus English Word

In cases involving American-English language word marks and foreign language word marks, the words are to be translated as part of the comparison of meaning or connotation.⁹⁰ This “doctrine of foreign equivalence” recognizes “the cosmopolitan character of the population and . . . the international character of trade. Bilingualists or even multilingualists are numerous, especially in cosmopolitan centers; and there are even more persons who have a slight familiarity with foreign words. Foreign goods with labels are commonly imported and sold in the United States.”⁹¹ Translation alone does not decide the question, however. “[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and

Corp., 209 U.S.P.Q. 355, 356 (T.T.A.B. 1980) (“the application of the principle . . . as in the case of other ‘established’ principles in trademark cases, must not be literally and indiscriminately applied without regard to the particular marks and the particular record involved in any given case”).

87. *Hansen v. Nat’l Beverage*, 493 F.3d 1074, 1079, 83 U.S.P.Q.2d 1276 (9th Cir. 2007).
88. *In re Rolf Nilsson AB*, 230 U.S.P.Q. 141, 142–43 (T.T.A.B. 1986); see *Puma-Sportschuhfabriken v. Garan, Inc.*, 224 U.S.P.Q. 1064, 1066 (T.T.A.B. 1984) (designs of wild felines create the same commercial impression, even if one is a puma, the other a mountain lion).
89. *Riceland Foods, Inc. v. Pac. E. Trading Corp.*, 26 U.S.P.Q.2d 1883, 1885 (T.T.A.B. 1993).
90. *Matsushita Elec. Indus. Co. v. Nat’l Steel Constr. Co.*, 442 F.2d 1383, 170 U.S.P.Q. 98, 99 (C.C.P.A. 1971); *Mary Kay Cosmetics, Inc. v. Dorian Fragrances, Ltd.*, 180 U.S.P.Q. 406, 407 (T.T.A.B. 1973) (EXQUISITE v. EXQUISITE); *In re Sarkli, Ltd.*, 721 F.2d 353, 220 U.S.P.Q. 111, 112–13 (Fed. Cir. 1983); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 224 U.S.P.Q. 185, 191–92 (4th Cir. 1984). The connotation of an English term is irrelevant if not commonly known in the United States. *In re Mucky Duck Mustard Co.*, 6 U.S.P.Q.2d 1467, 1469 (T.T.A.B. 1988) (MUCKY DUCK).
91. RESTATEMENT (FIRST) OF TORTS § 723 cmt. a (1938).

all other factors⁹²—for example, the strength of the mark,⁹³ the similarity of the goods, and purchaser care.⁹⁴

The words need not be exact synonyms to be deemed confusingly similar, but “where the only similarity between the marks is in connotation, a much closer approximation” may be required “to justify” a finding of confusing similarity. In addition, the “test to be applied to a foreign word vis-à-vis an English word with respect to equivalency is not less stringent than that applicable to two English words.”⁹⁵ For example, where the marks at issue were PALOMA (Spanish for dove or pigeon) and DOVE, the tribunal applied as “equally stringent” a test in judging the similarity of meaning between the foreign word (*paloma*) and the English word (dove), as it would “between two English words (for example, pigeon and dove).”⁹⁶ Arguments on appeal that there are alternative or multiple meanings to a foreign word are undermined if applicant agreed to a single translation during prosecution.⁹⁷

The analysis should never end in mere semantics; the foreign language must be “familiar to an appreciable segment of American consumers,”⁹⁸ *i.e.*, “common, modern languages”⁹⁹ and “[t]he translation . . . must be one that is likely to be made by a significant number of prospective purchasers.”¹⁰⁰ The relevant public is the

-
92. *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 220 U.S.P.Q. 111, 113 (Fed. Cir. 1983).
 93. *In re L'Oreal S.A.*, 222 U.S.P.Q. 925, 925–26 (T.T.A.B. 1984) (HI FASHION, HAUTE MODE obviously suggestive of cosmetics); *In re Ness & Co.*, 18 U.S.P.Q.2d 1815, 1816 (T.T.A.B. 1991) (GOOD-NESS and LA BONTE “totally dissimilar” in sound and appearance and highly laudatory for foods); *cf. In re Hub Distrib., Inc.*, 218 U.S.P.Q. 284, 285 (T.T.A.B. 1983) (SUN/EL SOL weak but for closely related goods; refusal to register affirmed); *Matsushita Elec. Indus. Co. v. Nat'l Steel Constr. Co.*, 442 F.2d 1383, 170 U.S.P.Q. 98, 99 (C.C.P.A. 1971) (NATIONAL and Japanese equivalent likely to be confused).
 94. *In re Buckner Enters. Corp.*, 6 U.S.P.Q.2d 1316 (T.T.A.B. 1987) (DOVE and PALOMA not confusingly similar for different albeit related goods).
 95. *In re Sarkli, Ltd.*, 721 F.2d 353, 354–55, 220 U.S.P.Q. 111, 113 (Fed. Cir. 1983) (REPECHAGE and SECOND CHANCE not confusingly similar).
 96. *In re Buckner Enters. Corp.*, 6 U.S.P.Q.2d 1316, 1317 (T.T.A.B. 1987); *see In re Perez*, 21 U.S.P.Q.2d 1075, 1076 (T.T.A.B. 1991) (EL GALLO/ROOSTER held exact synonyms).
 97. *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d 1645, 1649 (T.T.A.B. 2008).
 98. TMEP 1207.01(b)(vi) (2009); *In re Thomas*, 79 U.S.P.Q.2d 1021 (T.T.A.B. 2006) (French: BLACK MARKET versus MARCHÉ NOIR).
 99. *In re La Peregrina*, 86 U.S.P.Q.2d 1645, 1647 (T.T.A.B. 2008).
 100. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. e, at 231 (1995).

“ordinary American purchaser who is knowledgeable in English as well as the pertinent foreign language.”¹⁰¹ If one of the terms at issue is from “an obscure, little known or dead language,” similarity of meaning is likely to be unimportant.¹⁰² The understanding of ordinary purchasers, not of linguistic experts, controls.¹⁰³ Foreign words in some cases are easily understood or translated,¹⁰⁴ and some foreign expressions are so common that people will, without translation, simply accept them as they are.¹⁰⁵ “When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied.”¹⁰⁶ Commercially targeting a brand for a foreign-language-speaking market is probative that ordinary consumers in that market “would stop and translate” the mark into English, and become confused about an existing English language equivalent mark.^{106.1}

[C] Foreign Word Versus Foreign Word

Neither does the “doctrine of foreign equivalents” indiscriminately apply in cases where the marks are both foreign words.¹⁰⁷ It would be improper to translate each mark and compare the English translations for similarity of connotation if consumers are unlikely to do so.¹⁰⁸ Marks likely to be perceived as being from the same foreign language (in “sounding” or “seeming” to be, for example, Italian, German, Spanish, to those who do not understand the languages) may convey confusingly similar commercial impressions even though their meanings are different. Conflict was found in the following cases:

-
101. *In re La Peregrina*, 86 U.S.P.Q.2d 1648, 1649 (T.T.A.B. 2008).
102. RESTATEMENT (FIRST) OF TORTS § 723 cmt. a (1938).
103. *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 U.S.P.Q. 964, 967 (T.T.A.B. 1985), quoting *Jules Berman & Assoc., Inc. v. Consol. Distilled Prods., Inc.*, 202 U.S.P.Q. 67, 70 (T.T.A.B. 1979).
104. *Nat’l Distillers & Chem. Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 U.S.P.Q. 34 (C.C.P.A. 1974) (*DUVET v. DUET*).
105. *Cont’l Nut Co. v. Le Cordon Bleu, S.A.R.L.*, 494 F.2d 1395, 181 U.S.P.Q. 646, 647 (C.C.P.A. 1974) (*CORDON BLEU*); *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524, 525–26 (T.T.A.B. 1975) (*TIA MARIA*); cf. *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d 1459 (T.T.A.B. 1987) (*BUENOS DIAS* and *GOOD MORNING*).
106. *Palm Bay v. Veuve Clicquot*, 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689, 1696 (Fed. Cir. 2005).
- 106.1. *In re Aquamar, Inc.*, 115 U.S.P.Q.2d 1122, 1127 (T.T.A.B. 2015).
107. “In general, the Board does not apply the doctrine of foreign equivalents in cases where both marks are non-English words from two different languages.” *Brown Shoe Co. v. Robbins*, 90 U.S.P.Q.2d 1752, 1756 (T.T.A.B. 2009).
108. *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 U.S.P.Q.2d 1980, 1982 (T.T.A.B. 1987) (*BEL ARIA* and *BEL-AIR* not confusingly similar).

2nd Proofs 10/04/17

BORSA VENETO	and	BOTTEGA VENETA ¹⁰⁹
GOLDTROPFCHEN	and	GOLDENER TROPFEN ¹¹⁰
KUHULA	and	CHULA ¹¹¹

Confusion may be avoided if the marks create overall impressions of different types, for example, an abstract word as distinguished from one with a geographic or surname connotation.¹¹² Likewise, consumers may be able readily to translate some common foreign expressions which, though having a similar meaning, are sufficiently distinguishable to avoid conflict.¹¹³

§ 4:3.4 Appearance

Marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words¹¹⁴ A host of nonverbal features may also affect the overall appearance and commercial impression of marks: spacing, location, emphasis, size, layout, design, color,

-
109. *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 U.S.P.Q. 964, 970 (T.T.A.B. 1985) (marks confusingly similar, especially to “those not versed in foreign languages in general, or Italian in particular”).
110. *Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 U.S.P.Q.2d 1073, 1075 (T.T.A.B. 1988) (“To those American customers who do not speak German and thus do not know how the respective marks translate into English, we agree with opposers’ counsel that both marks may be seen as the familiar word GOLD ‘followed by a jaw-breaking string of consonants.’”).
111. *Jules Berman & Assoc., Inc. v. Consol. Distilled Prods., Inc.*, 202 U.S.P.Q. 67, 70 (T.T.A.B. 1979) (KUHULA was a coined mark; CHULA means “pretty”); *cf. Haagen-Dazs, Inc. v. Frusen Gladje, Ltd.*, 493 F. Supp. 73, 210 U.S.P.Q. 204, 206 (S.D.N.Y. 1980) (no conflict even though both marks seemed to be Swedish).
112. *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 U.S.P.Q.2d 1980, 1982 (T.T.A.B. 1987) (BEL-AIR said to have a geographic or French connotation; BEL ARIA an Italian connotation); *Am. B.D. Co. v. N.P. Beverages, Inc.*, 213 U.S.P.Q. 387, 389 (T.T.A.B. 1981) (OPICI likely to be understood as a surname or arbitrary term; AMICI to have the connotation of friendliness); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1741 (T.T.A.B. 2014) (IKEA, AKEA confusingly similar); *Tampico Beverages, Inc. v. US Co Pack, LLC*, 2012 WL 933107 (M.D. Fla.), *magistrate report and recommendation adopted*, 2012 WL 933119 (M.D. Fla. 2012) (TAMPICO versus TAN RICO QUE RICO) (see illustration, **Appendix A18**).
113. *In re Lar-Mor Int’l, Inc.*, 221 U.S.P.Q. 180, 181 (T.T.A.B. 1983) (BIEN JOLIE versus TRES JOLIE).
114. *TMEP 1207.01(b)(ii)* (citing COMMUNICASH versus COMMCASH; TURCOOL versus TRUCOOL; MILLTRONICS versus MILTRON); *In re USA Warriors Ice Hockey Program, Inc.*, 122 U.S.P.Q.2d 1790 (T.T.A.B. 2017) (identically stylized shared term outweighed differences between marks).

2nd Proofs 10/04/17

style, logotype, conspicuity, typeface.¹¹⁵ “Use of similar lettering or typeface is an important factor to consider in determining the similarity of the marks,” and is often found to aggravate the likelihood of confusion arising from the words themselves.¹¹⁶ However, similarity of such

-
115. *Giggle, Inc. v. netFocal, Inc.*, 856 F. Supp. 2d 625 (S.D.N.Y. 2012) (see **illustration, Appendix A14**); *Perfetti Van Melle USA v. Cadbury Adams USA LLC*, 732 F. Supp. 2d 712, 98 U.S.P.Q.2d 1623 (E.D. Ky. 2010) (see **illustration, Appendix A12**); *Polar Corp. v. PepsiCo, Inc.*, 789 F. Supp. 2d 219 (D. Mass. 2011) (see **illustration, Appendix A11**); *Mktg. Displays v. TrafFix Devices*, 200 F.3d 929, 934–35, 53 U.S.P.Q.2d 1335 (6th Cir. 1999) (similar script and capitalization of fifth letter), *rev'd on other grounds*, *TrafFix Devices v. Mktg. Displays*, 532 U.S. 23, 121 S. Ct. 1255, 58 U.S.P.Q.2d 1001 (2001); *Packman v. Chi. Tribune*, 267 F.3d 628, 60 U.S.P.Q.2d 1245, 1255 (7th Cir. 2001) (“Although the words on [the parties’ products] are the same, the words’ appearances do not resemble each other and are not likely to cause confusion. Different packaging, coloring, and labelling can be significant factors”); *Patsy’s Brand v. I.O.B. Realty*, 317 F.3d 209, 218, 65 U.S.P.Q.2d 1442 (2d Cir. 2003) (script, legend, bordering, location of design elements, coloring); *Vitek Sys., Inc. v. Abbott Labs., Inc.*, 675 F.2d 190, 216 U.S.P.Q. 476, 479 (8th Cir. 1982) (spacing, size, color and style); *Henri’s Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 220 U.S.P.Q. 386, 388–89 (7th Cir. 1983) (words on separate lines); *C.L.A.S.S. Promotions, Inc. v. D.S. Magazines, Inc.*, 753 F.2d 14, 18, 225 U.S.P.Q. 275, 277 (2d Cir. 1985) (size, layout, design and logotype); *Penta Hotels Ltd. v. Penta Tours*, 9 U.S.P.Q.2d 1081, 1098 (D. Conn. 1988) (size, layout, design and logo); *Time, Inc. v. Globe Commc’ns Corp.*, 712 F. Supp. 1103, 10 U.S.P.Q.2d 1915, 1921 (S.D.N.Y. 1989) (typeface); *Reeves v. Motley Crue, Inc.*, 21 U.S.P.Q.2d 1587, 1591 (N.D. Ala. 1991) (styles); *Wash. Nat’l Ins. Co. v. Blue Cross & Blue Shield United of Wis.*, 727 F. Supp. 472, 14 U.S.P.Q.2d 1307, 1309 (N.D. Ill. 1990) (size, style, color or print); *Lang v. Ret. Living Publ’g Co.*, 949 F.2d 576, 582, 21 U.S.P.Q.2d 1041, 1045 (2d Cir. 1991) (typeface and location); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c (1995); *Nabisco Brands, Inc. v. Conusa Corp.*, 722 F. Supp. 1287, 11 U.S.P.Q.2d 1788, 1791 (M.D.N.C. 1989) (conspicuity), *aff’d*, 892 F.2d 74, 14 U.S.P.Q.2d 1324 (4th Cir. 1989); *Edison Bros. Stores, Inc. v. Cosmair, Inc.*, 651 F. Supp. 1547, 2 U.S.P.Q.2d 1013, 1019 (S.D.N.Y. 1987) (typeface); *Bell Publ’g Corp. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 17 U.S.P.Q.2d 1634, 1636 (E.D. Pa. 1990) (location, size, upper/lower case); *Grondin v. Rossington*, 690 F. Supp. 200, 8 U.S.P.Q.2d 1108, 1117 (S.D.N.Y. 1988) (clarifying or identifying matter not visible due to manner of display); *Merriam-Webster, Inc. v. Random House, Inc.*, 18 U.S.P.Q.2d 1755, 1759–60 (S.D.N.Y. 1991) (position of product on shelf may obscure differentiating features, but consumer unlikely to buy without further examination); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1457–58 (Fed. Cir. 1992) (marks appearing in coinciding locations on respective packages; noting expert testimony on “graphic confusability”).
116. *Bausch & Lomb, Inc. v. Nevitt Sales Corp.*, 810 F. Supp. 466, 473, 26 U.S.P.Q.2d 1275, 1280 (W.D.N.Y. 1993), quoting *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 638 F. Supp. 652, 656 (S.D.N.Y. 1986) (“[S]imilarity of typefaces must be considered as aggravating the similar impression generated by the two closely worded labels”), *aff’d*, 841 F.2d 486, 6 U.S.P.Q.2d 1187 (2d Cir. 1988). See section 8:3.6.

features does not necessarily establish likelihood of confusion,¹¹⁷ and their dissimilarity may reduce the confusing similarity of even identical words.¹¹⁸ Just as the sound factor is important where marks are used aurally, the visual impression is where customers encounter the mark in that manner, for example, on tags or labels.^{118.1} On the other hand, an accused infringer cannot rely on the distinguishing power of fonts or logotypes in “text-based” environments where the literal element appears typewritten.¹¹⁹ Recurring appearance problems include the following.

[A] Design Versus Design

For design marks incapable of being spoken, the question of similarity is necessarily determined primarily on the basis of visual similarity.¹²⁰ In the absence of consumer reaction surveys, the decision is even more subjective than usual.¹²¹

In comparing design marks, the relevant public’s “state of mind or reaction must be considered along with the fallibility of the human memory and its propensity to retain but an overall impression of designs and similar type marks.”¹²² Especially with pure design marks, the consumer’s recollection is often imprecise, vague, hazy.¹²³

-
117. Hyatt Corp. v. Hyatt Legal Servs., 736 F.2d 1153, 1157, 222 U.S.P.Q. 669, 671 (7th Cir. 1984).
118. Private Eyes Sunglass Corp. v. Private Eye Vision Ctr., 25 U.S.P.Q.2d 1709, 1715 (D. Conn. 1992).
- 118.1. *In re Covalinski*, 113 U.S.P.Q.2d 1166, 1168 (T.T.A.B. 2014).
119. Savin Corp. v. Savin Grp., 391 F.3d 439, 458, 73 U.S.P.Q.2d 1273, 1284 (2d Cir. 2004); Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 588 F.3d 97, 117, 92 U.S.P.Q.2d 1769, 1782 (2d Cir. 2009); All. Bank v. New Century Bank, 742 F. Supp. 2d 532, 98 U.S.P.Q.2d 1292 (E.D. Pa. 2010) (CUSTOMER FIRST versus CUSTOMERS 1st) (see illustration, Appendix A15); Fancaster, Inc. v. Comcast Corp., 832 F. Supp. 2d 380 (D.N.J. 2011) (see illustration, Appendix A19). See section 4:3.2 at n.36 on the aural impression of marks.
120. *In re Vienna Sausage Mfg. Co.*, 16 U.S.P.Q.2d 2044, 2047 (T.T.A.B. 1990); *Textron, Inc. v. Maquinas Agricolas “Jacto” S.A.*, 215 U.S.P.Q. 162, 163 (T.T.A.B. 1982) (highly stylized letter marks treated essentially as design marks incapable of being pronounced). Where a design has a verbal equivalent, voicing by customers may indicate confusion. *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 331, 86 U.S.P.Q.2d 1162 (5th Cir. 2008) (customer requests for “girl rice” evidences confusion as to young woman logo for rice).
121. *Franklin Mint Corp. v. Master Mfg. Co.*, 209 U.S.P.Q. 350, 354 (T.T.A.B. 1980), *aff’d*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981).
122. *Envirotech Corp. v. Solaron Corp.*, 211 U.S.P.Q. 724, 733 (T.T.A.B. 1981); *Roffler Indus., Inc. v. KMS Research Labs, Inc.*, 213 U.S.P.Q. 258, 262–63 (T.T.A.B. 1982); TMEP 1207.01(c) (2009); *Fort James v. Royal Paper*, 83 U.S.P.Q.2d 1624, 1628–29 (T.T.A.B. 2007).
123. *Freedom Fed. Sav. & Loan Ass’n v. Heritage Fed. Sav. & Loan Ass’n*, 210 U.S.P.Q. 227, 231 (T.T.A.B. 1981); *N. Face Apparel Corp. v. Sanyang*

2nd Proofs 10/04/17

Ordinary designs are less memorable, therefore weaker and entitled to a narrower scope of protection.¹²⁴ “[C]ommon basic shapes such as circles, diamonds, triangles, squares, ovals, arrows, and the like have been so commonly adopted as marks or as a part of marks for a variety of products in a variety of fields that whatever rights one possesses in such a design are confined to the particular design and cannot serve to preclude the subsequent registration of a similar yet readily distinguishable design. . . .”¹²⁵

Where one design is well known, the addition of words to a similar design may not avoid confusion, and may even lead consumers to mistakenly believe that the mark represents a new line of products from the owner of the senior mark.¹²⁶

[B] Letters Versus Letters

Arbitrary or inherently “meaningless” combinations of letters are more difficult to remember than ordinary words and more likely to be found in conflict with other letter combinations.¹²⁷ “Confusion of letter combinations is a concern” with impulse purchasers and “even when the prospective purchasers of the goods are sophisticated purchasers.”¹²⁸ Also increasing the scope of protection is the fact that letter marks are often abbreviations intended to be comprehended at a glance.¹²⁹ Highly stylized letter marks are essentially treated as design marks.¹³⁰

Indus. Co., 116 U.S.P.Q.2d 1217, 1228 (T.T.A.B. 2015) (see illustration, Appendix A29).

124. *In re Giordano*, 200 U.S.P.Q. 52 (T.T.A.B. 1978) (chef’s head and cap); cf. *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 134 U.S.P.Q. 504 (C.C.P.A. 1962) (plaintiff’s humanized peanut design was famous).
125. *Guess?, Inc. v. Nationwide Time, Inc.*, 16 U.S.P.Q.2d 1804, 1806 (T.T.A.B. 1990); *Hupp Corp. v. AER Corp.*, 157 U.S.P.Q. 537, 540 (T.T.A.B. 1968).
126. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 U.S.P.Q.2d 1594, 1599 (T.T.A.B. 2009) (citing cases).
127. *CAE v. Clean Air*, 267 F.3d 660, 60 U.S.P.Q.2d 1449, 1466 (7th Cir. 2001); *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 U.S.P.Q.2d 1840, 1841 (Fed. Cir. 1990) (TMS v. TMM); *Edison Bros. Stores, Inc. v. Brutting E.B. Sport-Int’l GmbH*, 230 U.S.P.Q. 530, 533 (T.T.A.B. 1986) (EBS v. EB) (collecting cases). The difficulty may be reduced where the letters are arranged to suggest a well-known company name or word. *ECI Div. of E-Sys., Inc. v. Envtl. Commc’ns, Inc.*, 207 U.S.P.Q. 443, 451 (T.T.A.B. 1980) (ECI v. EC).
128. *B.V.D. Licensing Corp. v. Rodriguez*, 83 U.S.P.Q.2d 1500, 1509 (T.T.A.B. 2007).
129. *Cont’l Connector Corp. v. Cont’l Specialties Corp.*, 492 F. Supp. 1088, 207 U.S.P.Q. 60, 66 (D. Conn. 1979) (CCC v. CSC).
130. *Textron, Inc. v. Maquinas Agricolas “Jacto” S.A.*, 215 U.S.P.Q. 162, 163 (T.T.A.B. 1982), citing cases.

Cases arise in all combinations depending on the number of letters in the marks which are the same; the extent of overlap,¹³¹ and the position or transposition of the letters.¹³²

The fact that the letter marks in dispute are acronyms derived from different words is not controlling where the relevant public is unaware of the derivations.¹³³ The mere intention of the trademark owner to convey the derivation makes no difference when the intention is unknown to the consumer¹³⁴ or not indicated by visual cues.¹³⁵ Use of the “full name” with the acronym may reduce likelihood of confusion, so long as the full names are sufficiently different.¹³⁶ However, consumers not exercising great care may “glaze over” the full name and use the acronym alone as shorthand, for example, in oral communications.¹³⁷ An acronym or

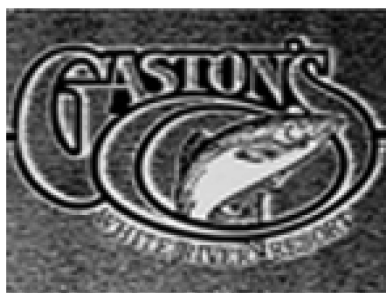
-
131. Cont'l Connector Corp. v. Cont'l Specialties Corp., 492 F. Supp. 1088, 207 U.S.P.Q. 60, 67 (D. Conn. 1979).
132. Specialty Measurements, Inc. v. Measurement Sys., Inc., 763 F. Supp. 91, 19 U.S.P.Q.2d 1444, 1446 (D.N.J. 1991) (SMI v. MSI); Postal Instant Press v. Personalized Instant Printing—P.I.P. Corp., 201 U.S.P.Q. 732 (E.D. Mo. 1978) (PIP v. IPP); Alberto-Culver Co. v. F.D.C. Wholesale Corp., 16 U.S.P.Q.2d 1597, 1602 (T.T.A.B. 1990) (FDC v. FDS); W-K-M Div. of Joy Mfg. Co. v. WK Indus., 2 U.S.P.Q.2d 1967 (S.D. Tex. 1987) (WKM v. WK).
133. B.V.D. Licensing Corp. v. Body Action Design, Inc., 846 F.2d 727, 6 U.S.P.Q.2d 1719, 1723 (Fed. Cir. 1988) (Nies, J., dissenting), citing Aerojet-Gen. Corp. v. Comput. Learning Corp., 170 U.S.P.Q. 358, 362 (T.T.A.B. 1971); *In re* Burroughs Corp., 2 U.S.P.Q.2d 1532, 1532 n.4 (T.T.A.B. 1986), citing Varian Assocs. v. Leybold-Hercues Gesellschaft, 219 U.S.P.Q. 829, 833 (T.T.A.B. 1983); Am. Optical Corp. v. Siemens AG, 213 U.S.P.Q. 510, 517 n.4 (T.T.A.B. 1982); Byk Gulden, Inc. v. Trimen Labs., Inc., 211 U.S.P.Q. 364, 367 (T.T.A.B. 1981) (derivation usually has little relevance, especially when such analysis involves dissection of the mark); HRL Assocs., Inc. v. Weiss Assocs., Inc., 12 U.S.P.Q.2d 1819, 1821 (T.T.A.B. 1989), *aff'd*, 902 F.2d 1546, 14 U.S.P.Q.2d 1840 (Fed. Cir. 1990).
134. Hercules, Inc. v. Nat'l Starch & Chem. Corp., 223 U.S.P.Q. 1244, 1248 (T.T.A.B. 1984).
135. *In re* Max Capital Grp. Ltd., 93 U.S.P.Q.2d 1243, 1247 (T.T.A.B. 2010).
136. NEC Elecs., Inc. v. New Eng. Circuit Sales, Inc., 722 F. Supp. 861, 13 U.S.P.Q.2d 1058, 1061 (D. Mass. 1989) (NEC v. NECS New Eng. Circuit Sales); Welding Servs., Inc. v. Forman, 509 F.3d 1351, 1360, 85 U.S.P.Q.2d 1233 (11th Cir. 2007) (WSI v. WTI Welding Techs. Inc.); IMS Ltd. v. Int'l Med. Sys., Inc., 1 U.S.P.Q.2d 1268, 1274 (E.D.N.Y. 1986) (IMS Int'l Medication Sys. v. IMS Int'l Med. Sys.); EA Eng'g, Sci. & Tech., Inc. v. Envtl. Audit, Inc., 703 F. Supp. 853, 12 U.S.P.Q.2d 1294, 1297 (C.D. Cal. 1989) (EA v. “EAI Environmental Audit, Inc.”); Elec. Realty Assocs., Inc. v. Extra Risk Assocs., Inc., 217 U.S.P.Q. 810, 815–16 (T.T.A.B. 1982) (ERA v. ERA Extra Risk Assocs.); *In re* TSI Brands, 67 U.S.P.Q.2d 1657 (T.T.A.B. 2002) (AK and “highly stylized” design versus AK AMERICAN KHAKIS).
137. Nat'l Rural Elec. Coop. Ass'n v. Nat'l Agric. Chem. Ass'n, 26 U.S.P.Q.2d 1294, 1297 (D.D.C. 1992) (ACRE Alliance for a Clean Rural Environment).

initials may be confusingly perceived as a shortened version of the full name.¹³⁸

[C] Different Word/Similar Design

Similarity of design or stylization may contrive to make words having entirely different sounds and connotations confusingly similar.¹³⁹

Likelihood of confusion was found between the following pairs of logos:¹⁴⁰



138. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 U.S.P.Q.2d 1257, 1260 (Fed. Cir. 2010) (ML—Mark Lees).
139. *Consol. Freightways, Inc. v. Cent. Transp., Inc.*, 201 U.S.P.Q. 524, 529 (E.D. Mich. 1978); *Gale Grp., Inc. v. King City Indus. Co.*, 23 U.S.P.Q.2d 1208, 1213 (M.D. Fla. 1992) (word marks which “might not, in other circumstances” be confusingly similar, found to be in conflict due to close similarities in labels, layout, etc.); *but see Minturn Advert., Inc. v. Hermsen Design Assocs., Inc.*, 728 F. Supp. 430, 16 U.S.P.Q.2d 1937, 1939 (N.D. Tex. 1990).
140. *WSM, Inc. v. Tenn. Sales Co.*, 709 F.2d 1084, 1085–87, 220 U.S.P.Q. 17, 18–19 (6th Cir. 1983); *Gaston’s White River Resort v. Rush*, 701 F. Supp. 1431, 8 U.S.P.Q.2d 1209, 1217 (W.D. Ark. 1988); *Victory Lane Quick Oil Change, Inc. v. Darwich*, 799 F. Supp. 2d 730 (E.D. Mich. 2011).

In these cases, the overall visual similarities viewed at a glance outweighed the dissimilarities apparent on closer observation.

§ 4:4 Consider the Marks As Would the Relevant Public

Just as the likelihood of confusion analysis must observe market realities (see section 2:2), so too the similarities of marks must be assessed in terms of their total effect or general impression upon the relevant public in the marketplace.¹⁴¹ One considers the marks in the context not of the courtroom but of the circumstances surrounding the purchase of the goods.¹⁴² Since ultimately a state of mind is in question, the analysis must cover “all the factors that could reasonably

-
141. Gruner + Jahr USA Publ'g v. Meredith Corp., 991 F.2d 1072, 1078, 26 U.S.P.Q.2d 1583, 1587 (2d Cir. 1993) (“In assessing similarity, courts look to the overall impression created by the logos and the context in which they are found and consider the totality of factors that could cause confusion among prospective purchasers.”); Bristol-Myers Squibb Co. v. McNeil-PPC., Inc., 973 F.2d 1033, 1046, 24 U.S.P.Q.2d 1161, 1167 (2d Cir. 1992) (see **illustration, Appendix A4**); McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1133, 202 U.S.P.Q. 81, 89 (2d Cir. 1979); Lever Bros. Co. v. Am. Bakeries Co., 693 F.2d 251, 257, 216 U.S.P.Q. 177, 182 (2d Cir. 1982); Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 12 U.S.P.Q.2d 1740, 1745 (9th Cir. 1989); Charles Jacquin et Cie, Inc. v. Destileria Serralles, Inc., 921 F.2d 467, 17 U.S.P.Q.2d 1104, 1110 (3d Cir. 1990); Barbecue Marx v. 551 Ogden, 235 F.3d 1041, 1044, 57 U.S.P.Q.2d 1307 (7th Cir. 2000) (restaurant marks: “Because the public will encounter the marks in written as well as spoken form, we believe it is essential to consider the marks’ visual characteristics.”); TMEP 1207.01(b) (2009).
142. Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc., 815 F.2d 500, 2 U.S.P.Q.2d 1285, 1288 (8th Cir. 1987); Heartsprings, Inc. v. Heartspring, Inc., 143 F.3d 550, 46 U.S.P.Q.2d 1481, 1483 (10th Cir. 1998); Procter & Gamble Co. v. Conway, 419 F.2d 1332, 1335, 164 U.S.P.Q. 301, 303–04 (C.C.P.A. 1970) (“the cardinal consideration here is the impact of the marks *as used* on the basis of conditions and circumstances surrounding the purchase of the goods of the parties in the market place”) (emphasis in original); James Burrough Ltd. v. Sign of the Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555, 562–63 (7th Cir. 1976); Vitek Sys., Inc. v. Abbott Labs., Inc., 675 F.2d 190, 216 U.S.P.Q. 476, 479 (8th Cir. 1982); Lindy Pen Co. v. Bic Pen Corp., 725 F.2d 1240, 226 U.S.P.Q. 17, 20 (9th Cir. 1984); Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1187–88, 5 U.S.P.Q.2d 1944 (6th Cir. 1988); AutoZone, Inc. v. Strick, 543 F.3d 923, 930, 88 U.S.P.Q.2d 1225 (7th Cir. 2008).

2nd Proofs 10/04/17

be expected to be perceived by and remembered by potential purchasers.”¹⁴³ The relevant public is expected to exercise “ordinary care” and “reasonable prudence” under the circumstances. (See section 6:2.)

§ 4:5 Consider the Marks Singly

While it may be “a person’s natural reaction” to compare marks side by side, if the analysis ends there, it is deficient.¹⁴⁴ Unless consumers normally encounter the marks together in the marketplace,¹⁴⁵ the likelihood of confusion analysis should not rest on a comparison of the marks side by side, point by point, isolating similarities and differences.¹⁴⁶ Instead, the marks should be considered singly, just as they are encountered by consumers, the first at one time and place, the other at another time and place.¹⁴⁷ “[A]n effort must be made to move

-
143. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1133, 202 U.S.P.Q. 81 (2d Cir. 1979), *cited in* *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 573, 25 U.S.P.Q.2d 1593, 1597 (2d Cir. 1993); *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 257, 216 U.S.P.Q. 177, 182 (2d Cir. 1982) (“the overall packaging context”).
144. *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 534, 76 U.S.P.Q.2d 1852, 1853 (2d Cir. 2005).
145. *Lever Bros. Co. v. Winzer Co. of Dall.*, 326 F.2d 817, 819–20, 140 U.S.P.Q. 247 (C.C.P.A. 1964); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 937, 12 U.S.P.Q.2d 1423, 1427 (7th Cir. 1989) (“where the trade dress relates to the same products which are sold side by side in retail channels, a direct visual comparison is appropriate . . . even though such comparison may be inappropriate where a similar trade dress or mark is used on dissimilar products”).
146. *Data Concepts, Inc. v. Dig. Consulting, Inc.*, 150 F.3d 620, 47 U.S.P.Q.2d 1672, 1676 (6th Cir. 1998); *Meridian Mut. Ins. Co. v. Meridian Ins. Grp., Inc.*, 128 F.3d 1111, 1115, 44 U.S.P.Q.2d 1545 (7th Cir. 1997); *Harold F. Ritchie, Inc. v. Chesebrough-Pond’s, Inc.*, 281 F.2d 755, 762, 126 U.S.P.Q. 310 (2d Cir. 1960); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 U.S.P.Q. 39, 40 (C.C.P.A. 1971); *TMEP 1207.01(b)* (2009); *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 275, 192 U.S.P.Q. 555, 562 (7th Cir. 1976) (“The consuming public is unlikely ever to be presented with the opportunity for [side-by-side] comparison”); *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 208 U.S.P.Q. 713, 718 (9th Cir. 1980); *Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc.*, 656 F.2d 186, 192, 213 U.S.P.Q. 91, 96 (5th Cir. 1981); *see* *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 U.S.P.Q. 335, 344 (T.T.A.B. 1980).
147. *King of the Mountain Sports v. Chrysler Corp.*, 185 F.3d 1084, 1090, 51 U.S.P.Q.2d 1349 (10th Cir. 1999); *Springs Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1133, 217 U.S.P.Q. 298, 304 (2d Cir. 1982); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 711 F.2d 934, 221 U.S.P.Q. 209, 216 (10th Cir. 1983); *AHP Subsidiary Holding Co. v. Stuart Hale Co.*, 1 F.3d 611, 27 U.S.P.Q.2d 1758, 1764 (7th Cir. 1993) (“Although side-by-side comparison may be marginally helpful at times [citation omitted] it

into the mind of the roving consumer.”¹⁴⁸ Consumers usually rely on memory rather than direct comparison.¹⁴⁹ Memory often is fallible, recall imperfect. Consumers do not deliberately memorize marks. From advertising or other exposure, they retain only a general, indefinite, vague, or even hazy impression of a mark and so may be confused upon encountering a similar mark.¹⁵⁰ Consumers may “equate a new mark or experience with one that they have long experienced without making an effort to ascertain whether or not they are the same marks.”¹⁵¹

must be remembered always that the ultimate focus is on the purchasing public’s state of mind when confronted by somewhat similar trademarks singly presented”) (internal quotation marks omitted); *In re Great Lakes Canning, Inc.*, 227 U.S.P.Q. 483, 485 (T.T.A.B. 1985) (“if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other”); *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 30, 39 S. Ct. 401, 63 L. Ed. 822 (1919) (Holmes, J.) (*compare* the “memory” of the one mark with the “presence” of the other); *In re Decombe*, 9 U.S.P.Q.2d 1812, 1814 (T.T.A.B. 1988); *Comput. Care v. Serv. Sys. Enter., Inc.*, 982 F.2d 1063, 1070, 25 U.S.P.Q.2d 1020, 1025 (7th Cir. 1992) (“For example, a dealer might be given a sales pitch by [plaintiff], and be impressed by [plaintiff’s] record of service, but not certain that at that point he needs such a program. Several weeks or even months later, he might get a call from [defendant’s] salesperson, who shows him brochures and other documents that look very similar to those he was shown by [plaintiff’s] representative. . . . [T]he dealer might now subscribe to the service thinking that it is the same one he had heard about before.”). For the use of “sequentially” rather than “singly,” see *Bos. Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 29, 87 U.S.P.Q.2d 1385 (1st Cir. 2008) (quoting *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 117, 79 U.S.P.Q.2d 1481 (2d Cir. 2006)).

148. *A&H Sportswear v. Victoria’s Secret Stores*, 237 F.3d 198, 216, 57 U.S.P.Q.2d 1097 (3d Cir. 2000).

149. *Sicilia di R. Biebow & Co. v. Cox*, 732 F.2d 417, 433 (5th Cir. 1984).

150. *Time Warner v. Jones*, 65 U.S.P.Q.2d 1650, 1660 (T.T.A.B. 2002) (average purchaser “normally retains a general rather than specific impression of trademarks”); *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 192 U.S.P.Q. 555, 562 (7th Cir. 1976); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1187–88, 5 U.S.P.Q.2d 1944, 1947 (6th Cir. 1988); *Salton, Inc. v. Cornwall Corp.*, 477 F. Supp. 975, 205 U.S.P.Q. 428, 441 (D.N.J. 1979); *United Glob. Media Grp., Inc. v. Tseng*, 112 U.S.P.Q.2d 1039 (T.T.A.B. 2014); *Dubonnet Wine Corp. v. Schneider*, 218 U.S.P.Q. 331, 335 (T.T.A.B. 1983); *Holiday Inns, Inc. v. Holiday Inn*, 364 F. Supp. 775, 177 U.S.P.Q. 640, 646 (D.S.C. 1973), *aff’d*, 182 U.S.P.Q. 129 (4th Cir. 1974); *cf.* *Taco Time Int’l, Inc. v. Taco Town, Inc.*, 217 U.S.P.Q. 268, 270–71 (T.T.A.B. 1982) (no confusion despite similar typeface because consumers do not have photographic memories or opportunities for side-by-side comparisons).

151. *Cumberland Packing Corp. v. Estee Corp.*, 224 U.S.P.Q. 50, 52 (T.T.A.B. 1984).

None of this is to “prohibit comparison of the parties’ marks; it prohibits consideration of differences so minuscule they are only detectable via a side by side comparison.”¹⁵²

§ 4:6 Weigh Similarities More Heavily than Differences

In comparing marks or trade dress, basic similarities generally outweigh peripheral differences,¹⁵³ especially when the marks are inherently strong;¹⁵⁴ the goods are impulse purchases;¹⁵⁵ or the goods are the same and packaged in the same manner.¹⁵⁶ A similarity seen in one mark may trigger a confused recollection of another mark, whereas a difference might be overlooked. Consumers may not recognize differences and do not typically set out to find them; the rule accommodates their capacity to discriminate and propensity for mistake.¹⁵⁷ “Even if prospective purchasers recognize that the two designations are distinct, confusion may result if purchasers are likely

-
152. Heartsprings, Inc. v. Heartspring, Inc., 143 F.3d 550, 46 U.S.P.Q.2d 1481, 1483 (10th Cir. 1998).
153. GoTo.com v. Walt Disney, 202 F.3d 1199, 53 U.S.P.Q.2d 1652, 1656 (9th Cir. 2000); Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co., 22 F.3d 1527, 30 U.S.P.Q.2d 1930, 1933 (10th Cir. 1994); AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 351, 204 U.S.P.Q. 808, 816 (9th Cir. 1979); Vitek Sys., Inc. v. Abbott Labs., Inc., 675 F.2d 190, 216 U.S.P.Q. 476, 479 (8th Cir. 1982); Beer Nuts, Inc. v. Clover Club Foods Co., 711 F.2d 934, 940, 221 U.S.P.Q. 209, 215 (10th Cir. 1983). *See, e.g.*, Time Warner v. Jones, 65 U.S.P.Q.2d 1650, 1660 (T.T.A.B. 2000).
154. Edison Bros. Stores, Inc. v. Cosmair, Inc., 651 F. Supp. 1547, 1555, 2 U.S.P.Q.2d 1013, 1019 (S.D.N.Y. 1987) (“When arbitrary or fanciful marks are involved, the distinctiveness of the marks will make the public more conscious of similarities than differences.”), citing Procter & Gamble Co. v. Johnson & Johnson, 485 F. Supp. 1185, 205 U.S.P.Q. 697, 708 (S.D.N.Y. 1979), *aff’d without opinion*, 636 F.2d 1203 (2d Cir. 1980).
155. Pom Wonderful LLC v. Hubbard, 775 F.3d 1118, 1130, 113 U.S.P.Q.2d 1369 (9th Cir. 2014) (court “must” weigh similarities more heavily than their differences) (**see illustration, Appendix A27**); Storck USA, L.P. v. Farley Candy Co., 785 F. Supp. 730, 22 U.S.P.Q.2d 1204, 1210 (N.D. Ill. 1992) (candy).
156. Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920, 925, 231 U.S.P.Q. 913, 916 (10th Cir. 1986) (“virtually identical products packaged in the same manner”), *cited in* Sally Beauty v. Beautyco, 304 F.3d 964, 972, 64 U.S.P.Q.2d 1321, 1324 (10th Cir. 2002).
157. Storck USA, L.P. v. Farley Candy Co., 785 F. Supp. 730, 22 U.S.P.Q.2d 1204, 1207 (N.D. Ill. 1992); Alfacell v. Anticancer Inc., 71 U.S.P.Q.2d 1301, 1305 (T.T.A.B. 2004) (ONCASE v. ONCONASE; “As seen and spoken, this middle portion may be missed by many of the relevant purchasers”).

to assume that the similarities in the designations indicate a connection between the two users.”¹⁵⁸

It is no defense that there are dissimilarities which, if called to purchasers’ attention, would undeceive them.¹⁵⁹ “Even if close examination would differentiate the products, that is not sufficient to dispel the initial confusing similarity.”¹⁶⁰ Where prospective purchasers typically hear the marks and have little opportunity to see the product or promotional material, dissimilarities in appearance have no distinguishing effect.¹⁶¹

The rule that similarities outweigh differences also frustrates the intentional infringer who introduces differences as a ploy to escape liability. “[F]ew would be stupid enough to make exact copies of another’s mark or symbol. It has been well said that the most successful form of copying is to employ enough points of similarity to confuse the public with enough points of difference to confuse the courts.”¹⁶²

Of course, the imitation is not exact; it never is in such cases. The details . . . have been varied in trifling regards, and the maker’s name has been put on the [product]. All that is almost a convention, when you appropriate another man’s mark; for there must be some color of good faith, some defense to put forward. Minor differences are supposed to help over hard places. . . . It is impossible to mistake the defendant’s purpose, the very ancient desire to trade on another man’s name and reputation. The unctuous disclaimers in the affidavits are an added indication to those familiar of how true the case is to type.¹⁶³

-
158. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c, at 229 (1995), *quoted in* *Elvis Presley v. Capece*, 141 F.3d 188, 201, 46 U.S.P.Q.2d 1737 (5th Cir. 1998).
159. *Emra Corp. v. Superclips Ltd.*, 559 F. Supp. 705, 218 U.S.P.Q. 124, 133 (E.D. Mich. 1983).
160. *Chevron Chem. Co. v. Voluntary Purchasing Grps.*, 659 F.2d 695, 704, 212 U.S.P.Q. 904, 912 (5th Cir. 1981) (**see illustration, Appendix A2**).
161. *Lindy Pen Co. v. Bic Pen Corp.*, 725 F.2d 1240, 226 U.S.P.Q. 17, 20 (9th Cir. 1984); *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 149, 67 U.S.P.Q.2d 1426–27 (2d Cir. 2003).
162. *Bos. Athletic Ass’n v. Sullivan*, 867 F.2d 22, 30, 9 U.S.P.Q.2d 1690, 1696 (1st Cir. 1989); *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 U.S.P.Q.2d 1719, 1723 (Fed. Cir. 1988) (Nies, J., dissenting).
163. *Stamford Foundry Co. v. Thatcher Furnace Co.*, 200 F. 324 (S.D.N.Y. 1912) (Learned Hand, J.); *see* *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 161, 136 U.S.P.Q. 508 (9th Cir. 1963) (Differences were “insufficient to protect the defendants against the injunction sought. An examination of the whole range of decisions in this field brings out one conclusion, that an infringer seldom makes a Chinese copy of another’s trademark, package or label.”).

2nd Proofs 10/04/17

While the rule stands, both similarities and differences must ultimately be considered in the overall analysis.¹⁶⁴ The test is not the total number of points of similarity, but whether the marks make the same general impression.¹⁶⁵ Dissimilarities may in fact be so prominent as to negate likelihood of confusion.¹⁶⁶ At some point in the analysis, the cumulative similarities or differences (combined with the other factors) reach “critical mass” and yield a decision.¹⁶⁷

It is inappropriate, except in close cases, to give significant weight to minor verbal or stylistic distinctions which are unlikely to be perceived or, if perceived, remembered by consumers;¹⁶⁸ for example,

-
164. *In re* Electrolyte Labs., Inc., 929 F.2d 645, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990); *Petro Stopping Ctrs. L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 94, 44 U.S.P.Q.2d 1921 (4th Cir. 1997); *see, e.g., Henri’s Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 220 U.S.P.Q. 386, 389 (7th Cir. 1983).
165. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 24 U.S.P.Q.2d 1161, 1170 (2d Cir. 1992) (see illustration, **Appendix A4**).
166. *Procter & Gamble Co. v. Johnson & Johnson*, 485 F. Supp. 1185, 205 U.S.P.Q. 697, 708–09 (S.D.N.Y. 1979), *aff’d without opinion*, 636 F.2d 1203 (2d Cir. 1980).
167. *Cooper Indus., Inc. v. Repcoparts USA, Inc.*, 218 U.S.P.Q. 81, 85 (T.T.A.B. 1983).
168. *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 46 U.S.P.Q.2d 1561, 1565 (9th Cir. 1998) (spelling); *Int’l Kennel Club of Chi., Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1088, 6 U.S.P.Q.2d 1977, 1984 (7th Cir. 1988) (“it is inappropriate to focus on minor stylistic differences in determining the likelihood of confusion”); *Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020, 1025 (T.T.A.B. 2009) (space between words); *Stern’s Miracle-Gro Prods., Inc. v. Shark Prods., Inc.*, 823 F. Supp. 1077, 1086, 27 U.S.P.Q.2d 1267, 1272–73 (S.D.N.Y. 1993) (“the Court attaches no significance to the minor lettering and stylistic differences between the marks”); *Hercules, Inc. v. Nat’l Starch & Chem. Corp.*, 223 U.S.P.Q. 1244, 1246 (T.T.A.B. 1984) (“when there are small differences between the marks, the differences may be insignificant in obviating the likelihood of confusion when compared to the marks’ overall similarities”); *In re Accelerate s.a.l.*, 101 U.S.P.Q.2d 2047, 2047 (T.T.A.B. 2012) (addition of the letter “o”) (citing *In re Bayer*, 488 F.3d 960, 965, 82 U.S.P.Q.2d 1828, 1832 (Fed. Cir. 2007) (addition of the letter “a”)); *see, e.g., Moore Bus. Forms, Inc. v. Ryu*, 960 F.2d 486, 22 U.S.P.Q.2d 1773, 1775 (5th Cir. 1992) (use of capital letter within mark insignificant); *compare Polo Fashions, Inc. v. LaLoren, Inc.*, 224 U.S.P.Q. 509, 512 (T.T.A.B. 1984) (“la” or “the” virtually devoid of trademark significance), *and Wonder Labs, Inc. v. Procter & Gamble Co.*, 728 F. Supp. 1058, 14 U.S.P.Q.2d 1645, 1650 (S.D.N.Y. 1990) (presence of “the” noteworthy); *Dan River, Inc. v. Apparel Unlimited, Inc.*, 226 U.S.P.Q. 186, 188 (T.T.A.B. 1985) (weight given to apostrophe in finding confusion); *Miss Universe, Inc. v. Flesher*, 605 F.2d 1130, 204 U.S.P.Q. 354, 358 (9th Cir. 1979); *Induct-O-Matic Corp. v. Inductotherm Corp.*, 747 F.2d 358, 224 U.S.P.Q. 119, 121 (6th Cir. 1984) (hyphens); *In re St. Helena Hosp.*, 774 F.3d 747, 751, 113 U.S.P.Q.2d 1082 (Fed. Cir. 2014) (exclamation point).

the addition of minor or generic words, or brief, common suffixes.¹⁶⁹ In cases involving Internet addresses, courts give little or no distinguishing weight to the top level domain (".com," ".net," etc.), and "generally look to the second level domain name to determine whether it is identical or confusingly similar to a given mark."¹⁷⁰ Common contractions or barbarizations of words generally do not alter their basic sound and meaning.¹⁷¹

§ 4:7 Compare the Marks in Their Entireties

Trademarks should be considered in their entireties, the way consumers encounter them. Their individual components or features should not be "dissected," analyzed piecemeal.¹⁷² "[D]iscrete

169. *DaimlerChrysler v. The Net*, 388 F.3d 201, 206, 72 U.S.P.Q.2d 1912, 1915 (6th Cir. 2004) (confusing similarity analysis under ACPA); *U.S. Olympic Comm. v. Olymp-Herrenwaschefabriken Bezner GmbH*, 224 U.S.P.Q. 497, 498 (T.T.A.B. 1984); *In re Pellerin Milnor Corp.*, 221 U.S.P.Q. 558, 560 (T.T.A.B. 1983) ("ICS"); *Hercules, Inc. v. Nat'l Starch & Chem. Corp.*, 223 U.S.P.Q. 1244, 1246 (T.T.A.B. 1984) ("OL").

170. *Coca-Cola v. Purdy*, 382 F.3d 774, 783–84, 72 U.S.P.Q.2d 1305, 1313 (8th Cir. 2004).

171. *In re S. Bend Toy Mfg. Co.*, 218 U.S.P.Q. 479, 480 (T.T.A.B. 1983) (LITTLE, LIL').

172. *Kibler v. Hall*, 843 F.3d 1068, 1077, 121 U.S.P.Q.2d 1069 (6th Cir. 2016) ("the anti-dissection rule"); *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 49 U.S.P.Q.2d 1355, 1359 (6th Cir. 1999) ("the 'anti-dissection rule' . . . serves to remind courts not to focus only on the prominent features of the mark, or only on those features that are prominent for purposes of the litigation, but on the mark in its totality"); *August Storck K.G. v. Nabisco, Inc.*, 59 F.3d 616, 35 U.S.P.Q.2d 1211, 1214 (7th Cir. 1995); *Forschner Grp., Inc. v. Arrow Trading Co.*, 124 F.3d 402, 409, 43 F.3d 1942 (2d Cir. 1997) ("we are not so much concerned with dissecting the competing trade dress and enumerating discrete points of similarity, but rather we focus on the overall image created"); *SquirtCo. v. Seven-Up Co.*, 628 F.2d 1086, 207 U.S.P.Q. 897, 900 (8th Cir. 1980); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 219 U.S.P.Q. 515, 524 (11th Cir. 1983); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 750–51 (Fed. Cir. 1985); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986); *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 231 U.S.P.Q. 634, 638 (5th Cir. 1986); *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 4 U.S.P.Q.2d 1942, 1944–45 (6th Cir. 1987); *Bausch & Lomb, Inc. v. Nevitt Sales Corp.*, 810 F. Supp. 466, 477, 26 U.S.P.Q.2d 1275, 1283 (W.D.N.Y. 1993) ("in an action for trade dress infringement, as in an action for trademark infringement, the elements of the trade dress must be evaluated in their entirety and not separately"); *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 730, 6 U.S.P.Q.2d 1719, 1722 (Fed. Cir. 1988) (Nies, J., dissenting), citing *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 29 (1919) (Holmes, J.) ("It is a fallacy to break the fagot stick by stick.").

differences should not be considered in isolation.”^{172.1} Instead, one looks to the overall impression,¹⁷³ “total concept and feel,”¹⁷⁴ or “total effect” of the mark or dress.¹⁷⁵ “[T]he commercial impression of a trademark is derived from it as a whole, not from elements separated and considered in detail.”¹⁷⁶

The public does not and is not expected to study marks.¹⁷⁷ The ordinary person is unlikely to perceive or consider specific details or engage in “recognitional contortions.”¹⁷⁸ “While individual features may be dissimilar, the total effect may be one of similarity. Or the total effect may appear dissimilar despite similarities in individual features.”¹⁷⁹

In any event, “[c]onsideration of a trademark as a whole does not prevent infringement when less than the entire trademark is

-
- 172.1. Innovation Ventures, LLC v. N2G Distrib., Inc., 763 F.3d 524, 535, 112 U.S.P.Q.2d 1423 (6th Cir. 2014) (“the jury could use their eyes and see that Defendants’ products use similar marks”) (see illustration, Appendix A26).
173. Gen. Mills, Inc. v. Kellogg Co., 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987).
174. Universal City Studios, Inc. v. T-Shirt Gallery, Ltd., 634 F. Supp. 1468, 230 U.S.P.Q. 23, 27 (S.D.N.Y. 1986).
175. Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass’n, 651 F.2d 311, 211 U.S.P.Q. 844, 850 (5th Cir. 1981) (trade dress); Chevron Chem. Co. v. Voluntary Purchasing Grps., 659 F.2d 695, 212 U.S.P.Q. 904, 912–13 (5th Cir. 1981) (trade dress) (see illustration, Appendix A2); I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 49 U.S.P.Q.2d 1225, 1236 (1st Cir. 1998); Pignons S.A. de Mecanique v. Polaroid Corp., 657 F.2d 482, 486–87, 212 U.S.P.Q. 246, 250 (1st Cir. 1981); Sicilia di R. Biebow & Co. v. Cox, 732 F.2d 417, 432 (5th Cir. 1984); Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397, 5 U.S.P.Q.2d 1314, 1316 n.4 (8th Cir. 1987); H. Lubovsky, Inc. v. Esprit de Corp, 627 F. Supp. 483, 228 U.S.P.Q. 814, 817 (S.D.N.Y. 1986) (image and presentation); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c, at 230 (1995).
176. Sec. Ctr., Ltd. v. First Nat’l Sec. Ctrs., 750 F.2d 1295, 1302, 225 U.S.P.Q. 373, 378 (5th Cir. 1985), and Opryland USA, Inc. v. Great Am. Music Show, Inc., 970 F.2d 847, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992), both quoting Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538, 545–46 (1920).
177. Marker Int’l v. DeBruler, 635 F. Supp. 986, 228 U.S.P.Q. 906, 917 (D. Utah 1986), *aff’d*, 844 F.2d 763, 6 U.S.P.Q.2d 1575 (10th Cir. 1988); *In re Johnson Prods. Co.*, 220 U.S.P.Q. 539, 540 (T.T.A.B. 1983) (“studied analysis” of marks unlikely to occur in marketplace).
178. B.V.D. Licensing Corp. v. Body Action Design, Inc., 846 F.2d 727, 728, 6 U.S.P.Q.2d 1719, 1721 (Fed. Cir. 1988).
179. RESTATEMENT OF TORTS § 729 cmt. b (1938); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c, at 230 (1995); PF Cosmetique, S.A. v. Minnetonka, Inc., 605 F. Supp. 662, 669, 226 U.S.P.Q. 86, 90 (S.D.N.Y. 1985) (three-page list of minute trade dress differences irrelevant “since the key to this case is overall impression”).

appropriated.”¹⁸⁰ In the course of analyzing the degree of similarity it is not improper (indeed, it is unavoidable) to identify elements or features of the marks that are more or less important to the decision, provided that the ultimate conclusion rests on the marks in their entirety.¹⁸¹ While one “should not miss the forest for the trees,” one may consider “the trees in order to determine the character of the forest.”¹⁸²

While it is true that consumers do not and are not expected to “count letters when reacting to trademarks in the marketplace,”¹⁸³ still many tribunals analyze word marks structurally in terms of the format and position, number and similarity of the letters, syllables, or words comprising the marks.¹⁸⁴ The analysis is valid to the extent

-
180. Universal Motor Oils Co. v. Amoco Oil Co., 15 U.S.P.Q.2d 1613, 1619 (D. Kan. 1990).
181. Merriam-Webster, Inc. v. Random House, Inc., 35 F.3d 65, 32 U.S.P.Q.2d 1010, 1014 (2d Cir. 1994); Opryland USA, Inc. v. Great Am. Music Show, Inc., 970 F.2d 847, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992); Cunningham v. Laser Golf, 222 F.3d 943, 947, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); AmBRIT, Inc. v. Kraft, Inc., 812 F.2d 1531, 1 U.S.P.Q.2d 1161, 1169 n.48 (11th Cir. 1986); Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 U.S.P.Q.2d 1793, 1798 (Fed. Cir. 1987); Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381, 42 U.S.P.Q.2d 1641 (2d Cir. 1997) (“focus on the overall look of a product does not permit a plaintiff to dispense with an articulation of the specific elements which comprise its distinct dress”).
182. Blockbuster Entm't Grp. v. Laylco, Inc., 869 F. Supp. 505, 33 U.S.P.Q.2d 1581, 1586 (E.D. Mich. 1994).
183. Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha, 228 U.S.P.Q. 672, 674 (T.T.A.B. 1985) (SUBARU/SUPRA); Am. B.D. Co. v. N.P. Beverages, Inc., 213 U.S.P.Q. 387, 388 (T.T.A.B. 1981) (AMICI/OPICI).
184. Kimberly-Clark Corp. v. H. Douglas Enters., Ltd., 774 F.2d 1144, 1147, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985) (HUGGIES and DOUGIES; no other users of “a short, two-syllable mark ending in “IES”); Faberge, Inc. v. Dr. Babor GmbH & Co., 219 U.S.P.Q. 848, 851 (T.T.A.B. 1983) (BABE v. BABOR; double as opposed to single sound); Chesebrough-Pond's, Inc. v. Soulful Days, Inc., 228 U.S.P.Q. 954, 956 (T.T.A.B. 1985) (AZIZA and AZANIA had same first two letters and a hard “z” sound in the second syllable); Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 223 U.S.P.Q. 1281, 1283 (Fed. Cir. 1984) (SPICE ISLANDS and SPICE VALLEY format consisted of two words of fairly equal weight, the first of which was SPICE and the second of which was a topographically defined place); Roger & Gallet S.A. v. Venice Trading Co., 1 U.S.P.Q.2d 1829, 1832 (T.T.A.B. 1987) (TENAX and DINAX had same number of letters, three of which were the same); Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 U.S.P.Q. 431, 434 (T.T.A.B. 1985) (PERMA-SHIELD and THERM-O-SHIELD had same number of syllables; the first words rhymed and were followed by short vowel and same ending); Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1457 (Fed.

2nd Proofs 10/04/17

such features contribute to the total impression made by the mark on the relevant public.¹⁸⁵ While one may consider, one must not “focus on minor stylistic differences” which are apt to be overlooked.¹⁸⁶ “Each syllable of each mark generates an ‘impact,’ but the only impact to be considered is that of the whole.”¹⁸⁷

-
- Cir. 1992) (PLAY-DOH/FUNDOUGH marks two one-syllable words with similarly sounding suffixes); *Nat'l ICEE Corp. v. J&J Snack Foods, Inc.*, 22 U.S.P.Q.2d 1783, 1786 (E.D. Pa. 1992) (ICER/ICEE marks had four letters each, the first three of which were the same); *HQ Network Sys. v. Exec. Headquarters*, 755 F. Supp. 1110, 18 U.S.P.Q.2d 1897, 1902 (D. Mass. 1991) (different total number of syllables; use of one mark as a noun, the other as an adjective); *Block Drug Co. v. Den-Mat, Inc.*, 17 U.S.P.Q.2d 1315, 1317 (T.T.A.B. 1989) (POLIDENT and POWERDENT had same initial letter and suffix and number of syllables), *aff'd mem.*, *Den-Mat Corp. v. Block Drug Co.*, 17 U.S.P.Q.2d 1318 (Fed. Cir. 1990); *Bell Publ'g Corp. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 17 U.S.P.Q.2d 1634, 1637 (E.D. Pa. 1990) (DELL and BELL each one syllable with same last three letters, outweighing different connotations); *CPC Int'l, Inc. v. Caribe Food Distrib.*, 731 F. Supp. 660, 16 U.S.P.Q.2d 1856, 1860 (D.N.J. 1990) (MAZOLA/MAZORCA—same first four and last letters); *Educ. Testing Servs., Inc. v. Touchstone Applied Sci. Assocs., Inc.*, 739 F. Supp. 847, 16 U.S.P.Q.2d 1865, 1867 (S.D.N.Y. 1990) (BOOKWHIZ and BOOKWIZE, same prefix and similar suffix); *Donut Shops Mgmt. Corp. v. Mace*, 209 U.S.P.Q. 615, 626 (T.T.A.B. 1981) (DONUTS GALORE and CHICKEN GALORE “constructed in the same manner”); *Hester Indus., Inc. v. Wing King, Inc.*, 23 U.S.P.Q.2d 1066, 1070 (N.D. Ga.) (WING DINGS and WING KING both two-syllable words with rhyme), *aff'd without opinion*, 979 F.2d 1539 (11th Cir. 1992); *Bigfoot 4 × 4, Inc. v. Bear Foot, Inc.*, 5 U.S.P.Q.2d 1444, 1447 (T.T.A.B. 1987) (BIGFOOT/BEARFOOT both comprise two-word marks having identical second word and one syllable first word beginning with B); *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 U.S.P.Q.2d 1597, 1602 (T.T.A.B. 1990) (FDC and FDS both three-letter marks which differ by only last letter); *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 U.S.P.Q.2d 1840, 1841 (Fed. Cir. 1990) (letter marks differing only in last letter); *Cuisinarts, Inc. v. John Boos & Co.*, 622 F. Supp. 1168, 227 U.S.P.Q. 153, 154 (S.D.N.Y. 1985) (CUISINART and CUISI CART differ by only one letter); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 231 U.S.P.Q. 850, 854 (N.D. Ga. 1986) (CABBAGE PATCH KIDS and GARBAGE PAIL KIDS, both three-word marks with same number of syllables).
185. *Johnson & Johnson v. Colgate-Palmolive Co.*, 345 F. Supp. 1216, 1222, 175 U.S.P.Q. 287, 291 (D.N.J. 1972) (dissecting marks is “not the manner in which potential purchasers shop”).
186. *Int'l Kennel Club of Chi., Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1088, 6 U.S.P.Q.2d 1977 (7th Cir. 1988).
187. *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 117, 223 U.S.P.Q. 1000, 1004 (2d Cir. 1984), quoting *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 685, 196 U.S.P.Q. 1, 3 (C.C.P.A. 1977).

§ 4:8 Consider the Marks in Their Settings

Just as the marks themselves should not be dissected, they should not be viewed in isolation, outside the context or setting in which they are used and encountered by consumers.¹⁸⁸ “The setting in which a designation is used affects its appearance and colors the impression conveyed by it.”¹⁸⁹ “Indeed, the impression conveyed by the setting in which the mark is used is often of critical importance.”¹⁹⁰ While the placement and display of functional and generic features may in some cases contribute to overall confusing similarity of package design,¹⁹¹ such matter, since it does not by itself indicate source, usually has less psychological effect and is less likely to be noticed or remembered.¹⁹² “[A] mark may be surrounded by additional words of lesser importance

-
188. *Henri’s Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 220 U.S.P.Q. 386, 388–89 (7th Cir. 1983) (“[A] comparison of the labels rather than simply the trademarks is appropriate. . . . When a prospective purchaser goes to the supermarket to buy salad dressing, it is the label that the purchaser sees.”); *Nabisco v. Warner-Lambert*, 220 F.3d 43, 47, 55 U.S.P.Q.2d 1051 (2d Cir. 2000) (“Our inquiry does not end with a comparison of the marks themselves. Rather, in determining whether two marks are confusingly similar, we must appraise the overall impression created by . . . the context in which they are found and consider the totality of factors that could cause confusion among prospective purchasers.”) (citation and quotation marks omitted) (**see illustration, Appendix A8**); *King of the Mountain Sports v. Chrysler Corp.*, 185 F.3d 1084, 1091, 51 U.S.P.Q.2d 1349 (10th Cir. 1999); *Hasbro v. Clue Computing*, 232 F.3d 1, 2, 56 U.S.P.Q.2d 1766 (1st Cir. 2000) (although defendant’s domain name was identical to plaintiff’s mark, the “content [of defendant’s Web site] strongly indicated that the site had little to do with [plaintiff’s] business”); *Sorensen v. WD-40 Co.*, 792 F.3d 712, 727, 115 U.S.P.Q.2d 1128 (7th Cir. 2015) (rejecting “zoomed-in” view of a device on a label; “the similarity of the marks analysis does not focus on the appearance of the trademarks in isolation; rather, it looks at the labelling as a whole”) (**see illustration, Appendix A28**).
189. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1133, 202 U.S.P.Q. 81, 89 (2d Cir. 1979), and *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 205 U.S.P.Q. 969, 977 (5th Cir. 1980), both quoting RESTATEMENT OF TORTS § 728 cmt. b, at 593 (1938); *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 257, 216 U.S.P.Q. 177, 182 (2d Cir. 1982) (“the overall packaging context”); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c and note (1995).
190. *Savin Corp. v. Savin Grp.*, 391 F.3d 439, 458, 73 U.S.P.Q.2d 1273, 1284 (2d Cir. 2004).
191. *Springs Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1132–33, 217 U.S.P.Q. 298, 303–04 (2d Cir. 1982) (instructions for care on hang-tag); *Sally Beauty v. Beautyco*, 304 F.3d 964, 979, 64 U.S.P.Q.2d 1321, 1329 (10th Cir. 2002) (listing of ingredients on container) (**see illustration, Appendix A9**); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 480, 89 U.S.P.Q.2d 1338 (5th Cir. 2008) (slang expressions used with trade dress colors).
192. *Ty, Inc. v. Jones Grp.*, 237 F.3d 891, 899, 57 U.S.P.Q.2d 1617 (7th Cir. 2001) (disregarding different shape and color of hang tags).

2nd Proofs 10/04/17

and not have its strength diluted.”¹⁹³ However, if the setting of a mark involves additional trade symbols (such as company names, division names, brand names, house marks, product marks, logos, or other dress) which do serve to distinguish source, then the setting is more likely to affect the impression generated by the mark. Thus, a case is colored by the way in which the marks in issue are identified, just as each party defines the products in issue in ways favorable to its cause.¹⁹⁴ (See section 5:5.)

The mere fact that a challenged mark is accompanied by another indicator of source does not avoid likelihood of confusion as a matter of law.¹⁹⁵ In many cases, added trade names *mitigate* likelihood of confusion arising from similar marks or dress.¹⁹⁶ On the other hand, there are many cases in which it is said that added marks *aggravate* likelihood of confusion.¹⁹⁷ While it is particularly difficult to draw

-
193. *Frehling v. Int'l Select Grp.*, 192 F.3d 1330, 1337, 52 U.S.P.Q.2d 1447 (11th Cir. 1999).
194. *Playtex Prods. v. Ga.-Pac. Corp.*, 390 F.3d 158, 164, 73 U.S.P.Q.2d 1127, 1132 (2d Cir. 2004) (“defendants’ mark is ‘QUILTED NORTHERN MOIST-ONES’ and not ‘MOIST-ONES’ alone”) (see illustration, **Appendix A13**); *Perfetti Van Melle USA v. Cadbury Adams USA LLC*, 732 F. Supp. 2d 712, 98 U.S.P.Q.2d 1623 (E.D. Ky. 2010) (see illustration, **Appendix A12**).
195. *See Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786, 790 (1st Cir. 1983); *Sunbeam Corp. v. Equity Indus. Corp.*, 635 F. Supp. 625, 229 U.S.P.Q. 865, 869 (E.D. Va. 1986) (labeling trade dress), *aff’d without opinion*, 811 F.2d 1505, 1 U.S.P.Q.2d 1752 (4th Cir. 1987); *Farberware, Inc. v. Mr. Coffee, Inc.*, 740 F. Supp. 291, 16 U.S.P.Q.2d 1103, 1108 n.10 (D. Del. 1990) and note 198, below.
196. *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167, 178, 225 U.S.P.Q. 805, 813 (6th Cir. 1985), quoting *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 U.S.P.Q. 97, 111 (Fed. Cir. 1984) (“[t]he most common and effective means of apprising intending purchasers of the source of the goods is a prominent disclosure on the container, package, wrapper, or label of the manufacturer’s or trader’s name * * * [and when that is done], there is no basis for a charge of unfair competition”). The presence of a house mark may reduce the importance of the similarity factor, and require the plaintiff to make a stronger showing on the other factors. *Therma-Scan v. Thermoscan*, 295 F.3d 623, 634, 63 U.S.P.Q.2d 1659 (6th Cir. 2002).
197. *Americana Trading, Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 23 U.S.P.Q.2d 1031, 1035 (9th Cir. 1992), and *A.T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692, 176 U.S.P.Q. 15, 17 (2d Cir. 1972) (“a purchaser could well think plaintiff had licensed defendant”), both quoting *Menendez v. Holt*, 128 U.S. 514, 521 (1888) (use by defendant of its house mark along with plaintiff’s trademark “an aggravation and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the true proprietor”); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 483, 89 U.S.P.Q.2d 1338 (5th Cir. 2008) (where plaintiffs required that licensed products contain the licensee’s name, a consumer could believe that defendant’s logo merely indicated that it was a licensee); *In re Fiesta Palma, LLC*, 85 U.S.P.Q.2d 1360, 1364, 1367 (T.T.A.B. 2007)

reliable rules,¹⁹⁸ added indicators “can be integral, if not dispositive, factors in determining overall similarity of trade dress.”¹⁹⁹ The effect of added source indicators is a question of a fact in each case²⁰⁰

(“purchasers familiar with the registrant’s mark are likely to assume that the house mark simply identifies what had previously been an anonymous source”); *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 49 U.S.P.Q.2d 1260, 1267 (2d Cir. 1998), *aff’g* 969 F. Supp. 895, 900 (S.D.N.Y. 1997) (jury may properly find intent to deceive by copying of garment styles even though defendant used its own garment labels), *rev’d on other grounds*, *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 120 S. Ct. 1339, 54 U.S.P.Q.2d 1065 (2000); *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 6 U.S.P.Q.2d 1187, 1192 (2d Cir. 1988); *Int’l Kennel Club of Chi., Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1088, 6 U.S.P.Q.2d 1977, 1984 (7th Cir. 1988) (defendants’ house mark argument “a smoke screen and a poor excuse”; consumers “would necessarily believe that [plaintiff] had licensed, approved or otherwise authorized the defendants’ use”); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 631 F. Supp. 735, 228 U.S.P.Q. 648, 655–56 (S.D.N.Y. 1985), *aff’d*, 799 F.2d 867, 876, 230 U.S.P.Q. 831, 836 (2d Cir. 1986), citing *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 662, 168 U.S.P.Q. 1, 5 (2d Cir. 1970); *Tveter v. AB Turn-O-Matic*, 633 F.2d 831, 209 U.S.P.Q. 22, 29 (9th Cir. 1980) (label identifying defendant an aggravation where defendant was known as plaintiff’s distributor). See *Playtex Prods. v. Ga.-Pac. Corp.*, 390 F.3d 158, 165, 73 U.S.P.Q.2d 1127, 1132 (2d Cir. 2004) (noting “the tension between these two lines of cases”) (see **illustration, Appendix A13**).

198. For an effort in this direction, see M. Beran, *Likelihood of Confusion: Will That House Mark Get You ‘Home-Free’?*, 83 TRADEMARK REP. 336, 361–63 (1993). See also *In re Bay State Brewing Co.*, 117 U.S.P.Q.2d 1958, 1966 (T.T.A.B. 2016) (“In general, use of a house mark does not obviate confusion.”).
199. *Nora Beverages v. Perrier Grp.*, 269 F.3d 114, 122, 123, 60 U.S.P.Q.2d 1038, 1043, 1044 (2d Cir. 2001) (affirming summary judgment of non-infringement; “the presence of the prominent and distinctive labels alone negates any possibility of a likelihood of confusion”).
200. *Sunbeam Prods., Inc. v. W. Bend Co.*, 123 F.3d 246, 44 U.S.P.Q.2d 1161, 1171 (5th Cir. 1997) (“Obviously, the proposition that a court *may* conclude that a manufacturer’s labels alleviate the risk of consumer confusion is not tantamount to the proposition that the court *must* reach such a conclusion. . . .”) (emphasis in original); *Vitek Sys., Inc. v. Abbott Labs., Inc.*, 675 F.2d 190, 216 U.S.P.Q. 476, 479 (8th Cir. 1982) (display of the manufacturer’s name is not determinative), citing *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193, 206 U.S.P.Q. 961, 963–64 (1st Cir. 1980); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1446, 221 U.S.P.Q. 97, 111–12 (Fed. Cir. 1984) (“We recognize that this rule is not without exception. The legal effect of labeling a product with its manufacturer’s name depends or may depend on both the prominence of the label and the type of product.”); *In re Cosvetic Labs., Inc.*, 202 U.S.P.Q. 842, 845 (T.T.A.B. 1979) (that added indicia do not avoid likelihood of confusion “is not an inflexible rule. Rather, in each case consideration must be given to . . . the effect of the entire mark. . . .”); *In re Fiesta Palms, LLC*, 85 U.S.P.Q.2d 1360, 1364 (T.T.A.B. 2007); *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 10 U.S.P.Q.2d 1001, 1009–10 (7th Cir. 1989); see *In re C.F. Hathaway Co.*, 190 U.S.P.Q. 343, 344 (T.T.A.B. 1976) (“a general rule that the addition of a trade name

and depends on the overall commercial impression of the display.²⁰¹ The TTAB states: “In general, use of a house mark does not obviate confusion. The exceptions to the general rule are where 1) the marks in their entirety convey significantly different commercial impressions, or 2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing the source because it is merely descriptive or diluted.”²⁰²

When a defendant relies on other trade indicia to avoid infringement, the plaintiff is required or well advised to prove why confusion still is likely.²⁰³ The issue is whether the added symbol is likely under the circumstances to be perceived and remembered by the ordinary customer as the means to differentiate the marks and sources from one another. Application of the usual factors helps to clarify.

Relative Strength. Of central importance is whether the added mark is dominant or secondary to the mark in issue.²⁰⁴ For example,

-
- or house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them”); *Americana Trading, Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 23 U.S.P.Q.2d 1031, 1035 (9th Cir. 1992) (use of house mark does not avoid infringement as a matter of law); *Bos. Athletic Ass’n v. Sullivan*, 867 F.2d 22, 29, 9 U.S.P.Q.2d 1690, 1696 (1st Cir. 1989) (citing cases); *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 4 U.S.P.Q.2d 1026, 1033 n.13 (9th Cir. 1987) (issue of fact for jury).
201. *Playtex Prods. v. Ga.-Pac. Corp.*, 390 F.3d 158, 166, 73 U.S.P.Q.2d 1127, 1133 (2d Cir. 2004) (“considering the presence of [defendant’s] house-brand in the context of other differences between the two marks . . . and the overall effect of the size, prominence and placement of the [house mark] on the [defendant’s] packing”) (see illustration, Appendix A13). The addition of a tag line to one of the marks may help avoid infringement. *Groupion, LLC v. Groupon, Inc.*, 826 F. Supp. 2d 1156, 101 U.S.P.Q.2d 1341 (N.D. Cal. 2011) (see illustration, Appendix A17).
202. *Gen. Mills, Inc. v. Fage Dairy Processing Indus. SA*, 100 U.S.P.Q.2d 1584, 1602 (T.T.A.B. 2011) (citations omitted).
203. *Commerce Foods, Inc. v. PLC Commerce Corp.*, 504 F. Supp. 190, 196, 212 U.S.P.Q. 137, 143 (S.D.N.Y. 1980) (plaintiff must “offer evidence to overcome the apparent presumption that confusion will not arise”); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1447, 221 U.S.P.Q. 97, 112 (Fed. Cir. 1984) (“why affixing a name is not sufficient to avoid a likelihood of confusion should be shown by the plaintiff, and not assumed by the trial judge”).
204. *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 14 U.S.P.Q.2d 1577, 1595–96 (S.D. Ohio 1990) (*Morningstar Farms Heartwise Grillers v. Kellogg’s Heartwise*); *S.C. Johnson & Son, Inc. v. Lever Bros.*, 19 U.S.P.Q.2d 1027, 1036 (E.D. Wis. 1991) (*MORNING FRESH SNUGGLE v. MORNING FRESH GLADE*); *Ty, Inc. v. Jones Grp.*, 237 F.3d 891, 899, 57 U.S.P.Q.2d 1617 (7th Cir. 2001); *Bass Pro Trademarks, L.L.C. v. Sportsman’s Warehouse, Inc.*, 89 U.S.P.Q.2d 1844 (T.T.A.B. 2008) (*BASS PRO SHOPS* logo “arbitrary and distinctive”; *SPORTSMAN’S WAREHOUSE* descriptive); *Sorensen v. WD-40 Co.*, 792 F.3d 712, 728, 115 U.S.P.Q.2d 1128 (7th Cir. 2015) (see illustration, Appendix A28).

where trade dress is in dispute, the consumer may remember the appearance of the product or package but forget the accompanying word mark.²⁰⁵ The added mark is more likely to reduce confusion if it is memorable and strong.²⁰⁶ As explained by the Second Circuit appellate court: “We do not mean to intimate that the distinctive elements of any trade dress may be freely appropriated as long as the junior user clearly identifies the source of the goods. In many cases, the distinctive elements of a trade dress may themselves be eligible for trademark protection. In other cases, the trade name may be a less dominant feature of the entire trade dress and thus have less force in countering other similarities between two trade dresses.”²⁰⁷ Adding

-
205. *Sturm, Ruger & Co. v. Arcadia Mach. & Tool, Inc.*, 10 U.S.P.Q.2d 1522, 1530 (C.D. Cal. 1988); *Nat'l Presto Indus., Inc. v. Hamilton Beach, Inc.*, 18 U.S.P.Q. 1993, 2001 (N.D. Ill. 1990) (effect of label a question of fact); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 219 U.S.P.Q. 515, 528 n.24 (11th Cir. 1983).
206. *Progressive Distribution Servs. v. United Parcel Serv.*, 856 F.3d 416, 433 (6th Cir. 2017) (no confusion where complainant's mark is weak and defendant's mark is strong) (see **illustration, Appendix A32**); *Walter v. Mattel*, 210 F.3d 1108, 54 U.S.P.Q.2d 1501 (9th Cir. 2000) (BARBIE); *Nabisco v. Warner-Lambert*, 220 F.3d 43, 55 U.S.P.Q.2d 1051 (2d Cir. 2000) (prominent use of well-known house brand DENTYNE) (see **illustration, Appendix A8**); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 24 U.S.P.Q.2d 1161, 1170 (2d Cir. 1992) (EXCEDRIN; TYLENOL); *distinguished in Fun-Damental Too Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 42 U.S.P.Q.2d 1348, 1356 (2d Cir. 1997); *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 22 U.S.P.Q.2d 1013, 1023 (N.D. Ill. 1991) (SIMONIZE); *Calvin Klein Co. v. Farah Mfg. Co.*, 229 U.S.P.Q. 795, 799 (S.D.N.Y. 1985) (CALVIN KLEIN); *Tree Tavern Prods., Inc. v. ConAgra, Inc.*, 640 F. Supp. 1263, 231 U.S.P.Q. 260, 266 (D. Del. 1986); *Taj Mahal Enters. Ltd. v. Trump*, 742 F. Supp. 892, 15 U.S.P.Q.2d 1641, 1645 (D.N.J. 1990) (TRUMP); *W.W.W. Pharm. Co. v. Gillette Co.*, 808 F. Supp. 1013, 23 U.S.P.Q.2d 1609, 1617–18 (S.D.N.Y. 1992), *aff'd*, 984 F.2d 567, 25 U.S.P.Q.2d 1593 (2d Cir. 1993) (RIGHT GUARD); *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482, 212 U.S.P.Q. 246, 250 (1st Cir. 1981) (POLAROID LAND CAMERA); *Knight Textile Corp. v. Jones Inv. Co.*, 75 U.S.P.Q.2d 1313, 1315 (T.T.A.B. 2005) (NORTON MCNAUGHTON); *G. Heileman Brewing Co. v. Anheuser-Busch Inc.*, 676 F. Supp. 1436, 1470, 6 U.S.P.Q.2d 1481, 1502–03, 1523 (E.D. Wis. 1987) (“strong house mark virtually precludes confusion”), *aff'd*, 873 F.2d 985, 10 U.S.P.Q.2d 1801, 1813 (7th Cir. 1989).
207. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1047, 24 U.S.P.Q.2d 1161, 1171 (2d Cir. 1992) (see **illustration, Appendix A4**); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 191 U.S.P.Q. 79, 88 (8th Cir. 1976) (addition of well-known name may promote rather than ensure against confusion); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 631 F. Supp. 735, 228 U.S.P.Q. 648, 655 (S.D.N.Y. 1985), *aff'd*, 799 F.2d 867, 230 U.S.P.Q. 831, 836 (2d Cir. 1986); *E.R. Squibb & Sons, Inc. v. Cooper Labs.*, 536 F. Supp. 523, 214 U.S.P.Q. 441, 450 (S.D.N.Y. 1982) (Squibb ANGLE/Oral-B Right Angle); *In re Apparel Ventures, Inc.*, 229

2nd Proofs 10/04/17

even a well-known house mark does not automatically absolve the accused infringer, “for, if accepted, it would allow any company that is well enough known, to infringe a competing company’s mark, especially if the competitor is small, merely by coupling its own name with the competitor’s mark.”²⁰⁸

Similarities and Differences. Added trade symbols militate against confusion when the marks in issue are recognizably different,²⁰⁹ but less so when the marks in issue are similar,²¹⁰ except if the added indicators are prominently displayed.²¹¹ (See below.) When trade dress is in issue and it is strong, a label is less likely to draw as much attention or to be as memorable, thus failing to serve a distinguishing function.²¹²

Prominence and Consistency. The prominence and location of the added symbols are important.

-
- U.S.P.Q. 225, 226 (T.T.A.B. 1986); *In re Cosvetic Labs. Inc.*, 202 U.S.P.Q. 842, 845 (T.T.A.B. 1979) (added matter avoids conflict “where the product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms”); *In re Shawnee Milling Co.*, 225 U.S.P.Q. 747, 748–49 (T.T.A.B. 1985) (GOLDEN CRUST for flour v. ADOLPH’S GOLD’N CRUST and design for food coating and seasoning); *MarCon Ltd. v. Avon Prods., Inc.*, 4 U.S.P.Q.2d 1474, 1476 (T.T.A.B. 1987) (SILK v. AVON SILKEN SOAP).
208. *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 662, 168 U.S.P.Q. 1, 5 (2d Cir. 1970) (Revlon).
209. *Playtex Prods. v. Ga.-Pac. Corp.*, 390 F.3d 158, 165, 73 U.S.P.Q.2d 1127, 1132 (2d Cir. 2004) (WET ONES v. MOIST-ONES) (see **illustration, Appendix A13**); *In re C.F. Hathaway Co.*, 190 U.S.P.Q. 343, 344 (T.T.A.B. 1976); *In re Apparel Ventures, Inc.*, 229 U.S.P.Q. 225, 226 (T.T.A.B. 1986); cf. *In re Christian Dior, S.A.*, 225 U.S.P.Q. 533 (T.T.A.B. 1985), citing *In re Cosvetic Labs., Inc.*, 202 U.S.P.Q. 842, 845 (T.T.A.B. 1979); *In re Hill-Behan Lumber Co.*, 201 U.S.P.Q. 246 (T.T.A.B. 1978).
210. *Bulk Mfg. Co. v. Schoenbach Prods. Co.*, 208 U.S.P.Q. 664, 668 (S.D.N.Y. 1980) (“the Court does not find that the manufacturer’s name is prominently displayed so that prospective purchasers of the machine would be alerted to the different origin, especially in view of the almost identical appearance of the machines”); *Key W. Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 U.S.P.Q. 168, 170 (T.T.A.B. 1982) (SKIN SAVERS v. MENNEN SKIN SAVER).
211. *Ziebart Int’l Corp. v. After Mkt. Assocs., Inc.*, 802 F.2d 220, 231 U.S.P.Q. 119, 124 (7th Cir. 1986) (dicta); *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482, 487, 212 U.S.P.Q. 246, 250 (1st Cir. 1981) (“in certain circumstances otherwise similar marks are not likely to be confused where used in conjunction with the clearly displayed name and/or logo of the manufacturer”).
212. *Sturm, Ruger & Co. v. Arcadia Mach. & Tool, Inc.*, 10 U.S.P.Q.2d 1522, 1530 (C.D. Cal. 1988); *Source Perrier S.A. v. Waters of Saratoga Springs, Inc.*, 217 U.S.P.Q. 617, 620 (S.D.N.Y. 1982) (“Here the near identity of the bottle shapes, even with different labels, is likely to lead to purchaser confusion as to origin”); *Charles Jacquinet Cie, Inc. v. Destileria Serralles, Inc.*, 921 F.2d 467, 475, 17 U.S.P.Q.2d 1104, 1110 (3d Cir. 1990) (“the similarity of the bottle designs is lessened considerably when the bottles are viewed with their complete labeling”).

[A] starkly different logo . . . prominently display[ed] on [the product] and on all . . . sales and marketing literature . . . is why the differential labeling is critical—it transforms a practice that would otherwise be anticompetitive into one that is procompetitive. And by specifically targeting [plaintiff’s] customers, [defendant] focuses its competitive activity on those who are most interested in such competition, thereby decreasing the consumers’ search costs and intensifying competition where it matters most. . . . The point, rather, is that the state of affairs where consumers are aggressively courted and offered competitive options is beneficial as a matter of public policy.^{212.1}

Inconspicuous, indistinct, or inconsistently used features are likely to be overlooked or forgotten.²¹³ Confusion as to a mark for one of the

-
- 212.1. *Greeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 515, 108 U.S.P.Q.2d 1022 (6th Cir. 2013) (see **illustration, Appendix A23**).
213. *Abercrombie & Fitch v. Am. Eagle Outfitters*, 280 F.3d 619, 648, 61 U.S.P.Q.2d 1769, 1787 (6th Cir. 2002) (“the ubiquitousness of the producers’ respective trademarks constantly indicating—on practically every page—the catalog’s origin”); *Nautilus v. Icon*, 308 F. Supp. 2d 1208, 1216 (W.D. Wash. 2003), *aff’d*, 372 F.3d 1330, 71 U.S.P.Q.2d 1173 (Fed. Cir. 2004); *Autozone v. Tandy*, 373 F.3d 786, 796–97, 71 U.S.P.Q.2d 1385, 1392 (6th Cir. 2004); *Walter v. Mattel*, 210 F.3d 1108, 1111, 54 U.S.P.Q.2d 1501 (9th Cir. 2000) (“The term ‘Pearl Beach’ in Mattel’s products never appears alone; rather, it is invariably accompanied by a reference to Barbie, which is clearly the ‘salient part of the mark indicative of the product’s origin.’”); *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 35, 32 U.S.P.Q.2d 1010, 1014 (2d Cir. 1994) (conspicuous, prominent logos and names); *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 296, 46 U.S.P.Q.2d 1026 (7th Cir. 1998) (embossed name “difficult to see”); *Purolator, Inc. v. EFRA Distrib., Inc.*, 687 F.2d 554, 561, 216 U.S.P.Q. 457, 461 (1st Cir. 1982) (“Clear and prominent display of the name of the true manufacturer, while not determinative, can substantially mitigate any confusion. . . .”); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 828, 24 U.S.P.Q.2d 1121, 1132 (Fed. Cir. 1992); *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167, 225 U.S.P.Q. 805, 813 (6th Cir. 1985); *Ziebart Int’l Corp. v. After Mkt. Assocs., Inc.*, 802 F.2d 220, 231 U.S.P.Q. 119, 124 (7th Cir. 1986); *Cal. Prods. Corp. v. PPG Indus., Inc.*, 18 U.S.P.Q.2d 1232, 1234 (D.N.H. 1990), citing *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482, 487, 212 U.S.P.Q. 246 (1st Cir. 1981); *Letica Corp. v. Sweetheart Cup Co.*, 805 F. Supp. 482, 25 U.S.P.Q.2d 1727, 1732 (E.D. Mich. 1992); *Prince Mfg., Inc. v. Bard Int’l Assocs., Inc.*, 11 U.S.P.Q.2d 1419, 1422 n.5 (D.N.J. 1988) [house mark placement in a manner followed throughout industry a “positive factor” in finding slight similarity between marks in issue]; *Pump, Inc. v. Collins Mgmt., Inc.*, 746 F. Supp. 1159, 15 U.S.P.Q.2d 1716, 1723 (D. Mass. 1990); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 482, 89 U.S.P.Q.2d 1338 (5th Cir. 2008) (“We cannot conclude, without more, that this small and inconspicuous placement of the logo would disabuse customers of a mistaken belief that the [plaintiffs] sponsored, endorsed or were otherwise affiliated with the [goods.]”); *Charles Schwab & Co. v. Hibernia Bank*, 665 F. Supp. 800, 3 U.S.P.Q.2d 1561, 1567 (N.D. Cal. 1987) (“downplayed”

defendant's products may be diminished where the accompanying mark or dress is the same as the defendant uses for all other non-infringing products.²¹⁴

Use by Both Parties. While the use by one party of an added house mark may or may not help to avoid confusion, the use by *both* parties of their respective house marks is more likely to differentiate by reinforcement.²¹⁵

house mark has “negligible” effect); *Salt Water Sportsman v. B.A.S.S., Inc.*, 685 F. Supp. 12, 4 U.S.P.Q.2d 1407, 1410 (D. Mass. 1987) (added matter fails to distinguish where four times smaller than the term in issue); *cf.* *Salt Water Sportsman v. B.A.S.S., Inc.*, 5 U.S.P.Q.2d 1620, 1621 (D. Mass. 1987); *Keds Corp. v. Renee Int’l Trading Corp.*, 888 F.2d 215, 12 U.S.P.Q.2d 1808, 1813 (1st Cir. 1989) (“words can only be read a few feet away from the eyes”) (see illustration, Appendix A3); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 U.S.P.Q. 58, 61 (T.T.A.B. 1984) (retailers’ ads dropped manufacturer’s logo); *Bulk Mfg. Co. v. Schoenbach Prods. Co.*, 208 U.S.P.Q. 664, 668 (S.D.N.Y. 1980) (manufacturer’s name not prominent given product size); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 981, 219 U.S.P.Q. 515, 528 n.24 (11th Cir. 1983) (defendant’s name “in very small print”); *T. Anthony, Ltd. v. Louis Vuitton Malletier*, 30 U.S.P.Q.2d 1214, 1218–19 (S.D.N.Y. 1993) (house mark illegible, negligible and easily removed); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 969, 209 U.S.P.Q. 969 (2d Cir. 1981) (“When similar marks are *always* presented in association with company names, the likelihood of confusion is reduced”) (emphasis added); *Ferrari S.p.A. v. McBurnie*, 11 U.S.P.Q.2d 1843, 1847 (S.D. Cal. 1989) (defendant’s “name cannot be seen even from reasonably short distances” and was sometimes removed by customers); *Hunting Hall of Fame Found. v. Safari Club Int’l*, 6 U.S.P.Q.2d 1765, 1771 (D. Ariz. 1987) (inconsistent use of defendant’s name); *Elecs. Corp. of Am. v. Republic Indus., Inc.*, 507 F.2d 409, 410, 184 U.S.P.Q. 129, 130 (1st Cir. 1974); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1446, 221 U.S.P.Q. 97, 111 (Fed. Cir. 1984) (conspicuous, multiple use; labeling met the trade standards; “Clearly, ordinary users of microwave ovens are accustomed to seeing the maker’s or the brand name conspicuously placed for their edification, and distributors and dealers must suppose that this information is important to the consumer”).

214. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1046, 24 U.S.P.Q.2d 1161 (2d Cir. 1992); *Mem Co. v. Yardley of London, Inc.*, 212 U.S.P.Q. 280, 284 (S.D.N.Y. 1981); *Gray v. Meijer Inc.*, 295 F.3d 641, 648, 63 U.S.P.Q.2d 1735 (6th Cir. 2002).

215. *Cohn v. Petsmart*, 281 F.3d 837, 842, 61 U.S.P.Q.2d 1688, 1691 (9th Cir. 2002); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1047, 24 U.S.P.Q.2d 1161, 1170 (2d Cir. 1992) (see illustration, Appendix A4); *Edison Bros. Stores, Inc. v. Cosmair, Inc.*, 651 F. Supp. 1547, 2 U.S.P.Q.2d 1013, 1019 (S.D.N.Y. 1987); *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 22 U.S.P.Q.2d 1013, 1023 (N.D. Ill. 1991) (well-known house mark on defendant’s product; nothing comparable on plaintiff’s product); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983) (“there is nothing in applicant’s mark that indicates the source or origin of its hamburgers. A purchaser could only speculate on who sponsored or produced such products. . . .”); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209

Sponsorship Confusion (see section 1:4.2). Where the goods are different and the case is one of sponsorship, not source, confusion, the presence of defendant's house mark on the accused product may not avoid infringement. Consumers might assume that the defendant is using its own house mark even though the additional mark which is being challenged is sponsored by or associated with the plaintiff.²¹⁶

Cost and Type of Product. It is often said that for high price, single purchase items, there is little likelihood of confusion where the manufacturer's name is clearly displayed.²¹⁷ Consumer care and sophistication play their part.²¹⁸ (See section 6:5.) On the other hand, labeling "a relatively inexpensive product may do little to avoid confusion because the average buyer of such items may give little thought to the purchase."²¹⁹

Actual Confusion and Intent to Infringe. These facts militate against giving weight to added source indicators.²²⁰

-
- U.S.P.Q. 969, 977 (2d Cir. 1981); *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 10 U.S.P.Q.2d 1801, 1813 (7th Cir. 1989); *Moore Bus. Forms, Inc. v. Rite Aid Corp.*, 21 U.S.P.Q.2d 2024, 2028 (W.D.N.Y. 1991), *modified*, 1992 U.S. Dist. LEXIS 8130 (1992); *Wash. Nat'l Ins. Co. v. Blue Cross & Blue Shield United of Wis.*, 727 F. Supp. 472, 14 U.S.P.Q.2d 1307, 1309 (N.D. Ill. 1990); *Schmid Labs. v. Youngs Drug Prods. Corp.*, 482 F. Supp. 14, 206 U.S.P.Q. 468, 471 (D.N.J. 1979) (parties used their respective brand names).
216. *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 422, 102 U.S.P.Q.2d 1693 (6th Cir. 2012). "[T]he presence of a house mark . . . is more significant in a palming off case [where the goods in issue are the same] than in an association case . . . when the two products [differ but] are related enough . . . one might associate with or sponsor the other and still use their [*sic*] own house mark." (internal quotation marks omitted).
217. *Merch. & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628, 22 U.S.P.Q.2d 1730, 1736 (3d Cir. 1992) (roofing panels); *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193, 194-95, 206 U.S.P.Q. 961, 963 (1st Cir. 1980) (stoves); *Pignons S.A. de Mecanique v. Polaroid Corp.*, 498 F. Supp. 805, 210 U.S.P.Q. 10, 20 (D. Mass. 1980), *aff'd*, 657 F.2d 482, 212 U.S.P.Q. 246 (1st Cir. 1981) (cameras); *Vitek Sys., Inc. v. Abbott Labs., Inc.*, 675 F.2d 190, 216 U.S.P.Q. 476, 479 (8th Cir. 1982) (automated computerized microbial testing instruments); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1446, 221 U.S.P.Q. 97, 112 (Fed. Cir. 1984) (contrasting cookies and microwave ovens); *Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*, 791 F.2d 423, 230 U.S.P.Q. 118, 122 (5th Cir. 1987) (machines for making snowball ice-shaving desserts); *Blue Bell Bio-Med. v. Cin-Bad, Inc.*, 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1876 (5th Cir. 1989) (hospital medical carts).
218. *Birtcher Electro Med. Sys., Inc. v. Beacon Labs., Inc.*, 738 F. Supp. 417, 16 U.S.P.Q.2d 1411, 1414 (D. Colo. 1990).
219. *Artemide SpA v. Grandlite Design & Mfg. Co.*, 672 F. Supp. 698, 4 U.S.P.Q.2d 1915, 1926 (S.D.N.Y. 1987) (lamps).
220. *Tveter v. AB Turn-O-Matic*, 633 F.2d 831, 209 U.S.P.Q. 22, 29 (9th Cir. 1980).

§ 4:9 Give Dominant Portions of Composite Marks Greater Weight

In comparing marks, the “dominant” or “salient” features receive greater weight than other features.²²¹ Likelihood of confusion generally increases where the dominant portions of the marks are the same.²²² Dominant features are important because they attract attention and consumers are more likely to remember and rely on them for purposes of source identification.²²³ Therefore, even lesser similarity may cause confusion if it attaches to the salient feature of a mark.²²⁴

The weight given to the respective portions of the marks “is not entirely free of subjectivity. . . .”²²⁵ It is often said, for example, that the first part of a mark, especially if distinctive, is most likely to catch the eye and ear and make an impression on the purchaser’s memory.²²⁶ Usually, the dominant portion of a mark is that which has the greater strength or origin-indicating power, inherent or

-
221. *Mktg. Displays v. Traffix Devices*, 200 F.3d 929, 53 U.S.P.Q.2d 1335 (6th Cir. 1999), *rev’d on other grounds*, *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 121 S. Ct. 1255, 58 U.S.P.Q.2d 1001 (2001); *Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.*, 22 F.3d 1527, 30 U.S.P.Q.2d 1930, 1933 (10th Cir. 1994); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983); *Henri’s Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 356, 220 U.S.P.Q. 386, 389 (7th Cir. 1983); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 224 U.S.P.Q. 185, 190 (4th Cir. 1984).
222. *In re Denisi*, 225 U.S.P.Q. 624 (T.T.A.B. 1985).
223. *Forum Corp. of N. Am. v. Forum, Ltd.*, 903 F.2d 434, 14 U.S.P.Q.2d 1950, 1955 (7th Cir. 1990) (“memorable feature”); *Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.*, 17 U.S.P.Q.2d 1435, 1438 (D. Kan. 1990), *aff’d*, 22 F.3d 527, 30 U.S.P.Q.2d 1930 (10th Cir. 1994); *Ass’n of Coop. Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 216 U.S.P.Q. 361, 367 (5th Cir. 1982) (dominant feature most readily associated with product it identifies); *Express Mortg. Brokers, Inc. v. Simpson Mortg., Inc.*, 31 U.S.P.Q.2d 1371, 1374 (E.D. Mich. 1994) (“distinctive, or ‘catchy’”).
224. *Universal Motor Oils Co. v. Amoco Oil Co.*, 15 U.S.P.Q.2d 1613, 1619 (D. Kan. 1990); *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 113 U.S.P.Q.2d 1369 (9th Cir. 2014) (finding confusion even though the accused word was relatively small in the context of the label having a different, more prominent brand) (see **illustration, Appendix A27**).
225. *In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992).
226. *Palm Bay v. Veuve Clicquot*, 396 F.3d 1369, 1372, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) (“presence of . . . strong distinctive term as the first word in both parties’ marks renders the marks similar”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992) (CENTURY 21 v. CENTURY LIFE OF AMERICA); *In re Morinaga Nyugyo Kabushiki Kaisha*, Serial No. 86338392, slip op. at 8, ___ U.S.P.Q.2d ___ (T.T.A.B. Sept. 8, 2016); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d 1629, 1639 (T.T.A.B. 2007); *Brown Shoe Co. v. Robbins*, 90 U.S.P.Q.2d 1752, 1755 (T.T.A.B. 2009); *Venture Out Props.*

2nd Proofs 10/04/17

acquired. Descriptive or generic components, having little or no source identifying significance, are generally recessive and less significant in the analysis.²²⁷ However, even a descriptive feature may dominate if it is used in a prominent manner,²²⁸ and may play a role in creating

LLC v. Wynn Resorts Holdings, LLC, 81 U.S.P.Q.2d 1887, 1891 (T.T.A.B. 2007); Pathfinder Commc'ns Corp. v. Midwest Commc'ns Co., 593 F. Supp. 281, 284, 224 U.S.P.Q. 203, 205 (N.D. Ind. 1984) (referring to "the accepted fact that people perceive differences which occur at the end of words less clearly than when differences occur at the beginning of words"); La Touraine Coffee Co. v. Lorraine Coffee Co., 157 F.2d 115, 117, 70 U.S.P.Q. 429, 432 (2d Cir. 1946); Bunte Bros. v. Standard Chocolates, Inc., 45 F. Supp. 478, 53 U.S.P.Q. 668, 671 (D. Mass. 1942); Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered") (KID STUFF v. KIDWIPES); Starlog Commc'ns Int'l, Inc. v. HG Pubs, Inc., 32 U.S.P.Q.2d 1061, 1062 (S.D.N.Y. 1994); Guardian Life Ins. Co. v. Guardian Grp., 27 U.S.P.Q.2d 1465, 1467 (D. Conn. 1993); *but see* Oakville Hills Cellular, Inc. v. Georgallis Holdings, LLC, 826 F.3d 1376, 119 U.S.P.Q.2d 1286 (Fed. Cir. 2016) (MAYA versus MAYARI, both for wines, not confusingly similar); Sally Beauty v. Beautyco, 304 F.3d 964, 972, 64 U.S.P.Q.2d 1321, 1324 (10th Cir. 2002) ("Although both marks begin with the same six letters, this similarity is not enough to outweigh the visual differences in the marks.") (see illustration, Appendix A9); and AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 204 U.S.P.Q. 808, 817 (9th Cir. 1979) (common endings add similarity). The Fourth Circuit "generally use[s] the phrase 'dominant portion' to refer to the non-generic words in multiword marks," not letter strings. Swatch AG v. Beehive Wholesale, LLC, 739 F.3d 150, 159 (4th Cir. 2014) (SWAP versus SWATCH, both for watches) (see illustration, Appendix A25). *Cf.* Hornady Mfg. Co. v. Doubletap, Inc., 746 F.3d 995, 1002, 110 U.S.P.Q.2d 1140 (10th Cir. 2014) (TAP versus DOUBLETAP, both for firearm ammunition; relative positions as prefix or suffix "appear starkly different") (see illustration, Appendix A24); Swatch AG v. M.Z. Berger & Co., 108 U.S.P.Q.2d 1470 (T.T.A.B. 2013) (initial letters distinguish marks sharing a subsequent generic term).

227. John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 219 U.S.P.Q. 515, 524 (11th Cir. 1983); Henri's Food Prods. Co. v. Kraft, Inc., 717 F.2d 352, 220 U.S.P.Q. 386, 389 (7th Cir. 1983); ConAgra, Inc. v. Singleton, 743 F.2d 1508, 224 U.S.P.Q. 552, 556 (11th Cir. 1984); Truescents LLC v. Ride Skin Care, L.L.C., 81 U.S.P.Q.2d 1334 (T.T.A.B. 2006); Time Warner v. Jones, 65 U.S.P.Q.2d 1650, 1660 (T.T.A.B. 2000) (considering the mark ROADRUNNER MAPS for road maps, the word MAPS is "entitled to less weight" since "[p]urchasers are likely to view that word as identifying the goods themselves, rather than in any trademark sense as a means of distinguishing between different sources"); PACCAR v. TeleScan, 319 F.3d 243, 252, 65 U.S.P.Q.2d 1761, 1766 (6th Cir. 2003) ("[e]xcluding the generic or descriptive words following the mark"); TMEP 1207.01(b)(viii) (2009).
228. Mktg. Displays v. Traffic Devices, 200 F.3d 929, 935, 53 U.S.P.Q.2d 1335 (6th Cir. 1999) (WINDMASTER v. WINDBUSTER, both for wind resistant traffic signs; finding likelihood of confusion, court gives weight to "the dominance of the 'wind' prefix") *rev'd on other grounds*, 532 U.S. 23

2nd Proofs 10/04/17

confusion.²²⁹ One seeking to establish the dominance of a descriptive term bears a heavier burden of proof.²³⁰ “If a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or services.”²³¹ However, “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.”²³² “[T]he common-sense precept is that the more forceful and distinctive aspects of a mark should be given more weight, and the other aspects less weight.”²³³

The ultimate arbiter, the public, effectually decides dominance in many instances by abbreviating the mark or adopting a portion of it as a “nickname.” “[T]he users of language have a universal habit of shortening full names—from haste or laziness or just economy of words.”²³⁴ “[C]ompanies are frequently called by shortened names, such as, Penney’s for J.C. Penney’s, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward’s for Montgomery Ward’s, and Bloomies for Bloomingdale’s.”²³⁵ Abbreviation was found to be likely in the following cases:

-
- (2001); *ConAgra, Inc. v. Singleton*, 743 F.2d 1508, 1514, 224 U.S.P.Q. 552, 556 (11th Cir. 1984) (dominant name “set out, apart from” generic terms); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 224 U.S.P.Q. 185, 190 (4th Cir. 1984) (letter size); *In re Hal Leonard Publ’g Corp.*, 15 U.S.P.Q.2d 1574, 1576 (T.T.A.B. 1990) (descriptive word may be dominant if it is comparatively prominent); *L. & J.G. Stickley, Inc. v. Cosser*, 81 U.S.P.Q.2d 1956 (T.T.A.B. 2007) (even though recessive in appearance, a distinctive term may be dominant in a composite logo).
229. TMEP 1207.01(b)(viii) (2009).
230. *Mr. Travel, Inc. v. V.I.P. Travel Serv., Inc.*, 268 F. Supp. 958, 962, 153 U.S.P.Q. 18, 22 (N.D. Ill. 1966), *aff’d per curiam*, 385 F.2d 420, 155 U.S.P.Q. 231 (7th Cir. 1967); *Watermark, Inc. v. United Stations, Inc.*, 219 U.S.P.Q. 31, 33 (C.D. Cal. 1982) (plaintiff bears burden).
231. TMEP 1207.01(c)(ii) (2009).
232. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990); *In re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282 (T.T.A.B. 2009) (design element larger than word portion of mark insufficient to distinguish it).
233. *A&H Sportswear v. Victoria’s Secret Stores*, 237 F.3d 198, 216 (3d Cir. 2000).
234. *In re Abcor Dev. Corp.*, 588 F.2d 811, 815, 200 U.S.P.Q. 215, 219 (C.C.P.A. 1978) (Rich, J., concurring); *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 U.S.P.Q.2d 1913, 1919 (T.T.A.B. 2015) (POPMONEY V. PMONEY); *see Atec, Inc. v. Société Nationale Industrielle Aérospatiale*, 798 F. Supp. 411, 24 U.S.P.Q.2d 1951, 1953 n.6 (S.D. Tex. 1992) (discounting significance of the word “Inc.” as used in the mark).
235. *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 U.S.P.Q.2d 1321, 1333 (T.T.A.B. 1992).

GIANT	for	GIANT HAMBURGERS ²³⁶
REMY	for	REMY MARTIN ²³⁷
RICCI	for	NINA RICCI ²³⁸
CARNIVAL	for	CARNIVAL CLUB ²³⁹
BeauTV	for	THE BEAUTY CHANNEL ^{239.1}
PALACE	for	TRUMP'S PALACE ²⁴⁰
PURO	for	PUROLATOR ²⁴¹
QUINTA	for	LA QUINTA and QUINTA REAL ^{241.1}
PMONEY	for	POPMONEY ^{241.2}

The defendant itself may contract its name, thus readily proving what it regards as the dominant portion.²⁴²

-
236. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1655, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983).
237. E. Remy Martin & Co. v. Shaw-Ross Int'l Imps., Inc., 756 F.2d 1525, 225 U.S.P.Q. 1131, 1135 (11th Cir. 1985); *cf.* Jim Beam Brands Co. v. Beamish & Crawford Ltd., 852 F. Supp. 196, 31 U.S.P.Q.2d 1518, 1520 (S.D.N.Y. 1994) (plaintiff's mark identified as JIM BEAM, not BEAM alone).
238. Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989).
239. Blumenfeld Dev. Corp. v. Carnival Cruise Lines, Inc., 669 F. Supp. 1297, 4 U.S.P.Q.2d 1577, 1594-95 (E.D. Pa. 1987).
- 239.1. United Glob. Media Grp., Inc. v. Tseng, 112 U.S.P.Q.2d 1039 (T.T.A.B. 2014).
240. Trump v. Caesars World, Inc., 645 F. Supp. 1015, 230 U.S.P.Q. 594, 600 (D.N.J. 1986), *aff'd without opinion*, 2 U.S.P.Q.2d 1806 (3d Cir. 1987).
241. Purolator, Inc. v. EFRA Distrib., Inc., 524 F. Supp. 471, 475, 213 U.S.P.Q. 961, 965 (D.P.R. 1981), *aff'd*, 687 F.2d 554, 216 U.S.P.Q. 457, 461 (1st Cir. 1982); *see also* Foremost Corp. of Am. v. Burdge, 638 F. Supp. 496, 230 U.S.P.Q. 455, 458 (D.N.M. 1986).
- 241.1. La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V., 762 F.3d 867 (9th Cir. 2014) ("the dominant words frequently appear without anything more in the marketplace").
- 241.2. Fiserv, Inc. v. Elec. Transaction Sys. Corp., 113 U.S.P.Q.2d 1913, 1919 (2015) (both for overlapping financial services).
242. Rockland Mortg. Corp. v. S'holders Funding, Inc., 835 F. Supp. 182, 30 U.S.P.Q.2d 1270, 1277 (D. Del. 1993); Health Net v. U.S.A. Healthnet, Inc., 26 U.S.P.Q.2d 1187, 1193 (C.D. Cal. 1993) (contraction HEALTHNET of defendant's HEALTHNET USA proved in part by defendant's own witness); *cf.* Pan Am. World Airways, Inc. v. Panamerican Sch. of Travel, Inc., 648 F. Supp. 1026, 1 U.S.P.Q.2d 1020, 1023 (S.D.N.Y. 1986) (plaintiff PAN AM failed to show significant reference to its full name PAN AMERICAN); Dunfey Hotels Corp. v. Meridien Hotels Inv. Grp., Inc., 504 F. Supp. 371, 209 U.S.P.Q. 678, 685 (S.D.N.Y. 1980) (argument for "natural abbreviation" unproved). *See* Barbara's Bakery, Inc. v. Landesman, 82 U.S.P.Q.2d 1283, 1288 (T.T.A.B. 2007) (BARBARA'S BAKERY v. BARB'S BUNS BAKERY).

2nd Proofs 10/04/17

Identifying the dominant portion of a mark never ends the analysis. No element of a mark is ignored simply because it is not dominant. The presence of even identical dominant terms does not necessarily make two marks confusingly similar.²⁴³ The mark must ultimately be considered in its entirety.²⁴⁴

§ 4:9.1 Family Features

As explained by the Federal Circuit appeals court:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. . . . Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.²⁴⁵

“A family of marks may have a *synergistic* recognition that is greater than the sum of each mark.”²⁴⁶ “[T]he question is not whether applicant’s mark is similar to opposer’s individual marks, but whether applicant’s mark would be likely to be viewed *as a member of*

243. Duluth News-Tribune v. Mesabi Publ’g Co., 84 F.3d 1094, 38 U.S.P.Q.2d 1937, 1940 (8th Cir. 1996); King of the Mountain Sports v. Chrysler Corp., 185 F.3d 1084, 1090, 51 U.S.P.Q.2d 1349 (10th Cir. 1999); Sullivan v. CBS, 385 F.3d 772, 778, 72 U.S.P.Q.2d 1586, 1589 (7th Cir. 2004).

244. *In re* Electrolyte Labs., Inc., 929 F.2d 645, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990); Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co., 22 F.3d 1527, 30 U.S.P.Q.2d 1930, 1933 (10th Cir. 1994).

245. J&J Snack Foods Corp. v. McDonald’s Corp., 932 F.2d 1460, 18 U.S.P.Q.2d 1889, 1891–92 (Fed. Cir. 1991); Oriental Fin. Grp., Inc. v. Cooperativa de Ahorro y Crédito Oriental, 832 F.3d 15, 28–30, 119 U.S.P.Q.2d 1701 (1st Cir. 2016); 7-Eleven, Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1720 n.38 (T.T.A.B. 2007) (examples of family usage); Reynolds & Reynolds Co. v. I.E. Sys., Inc., 5 U.S.P.Q.2d 1749, 1751 (T.T.A.B. 1987) (“advertising, promotion and use of two or more of opposer’s marks conjointly in a manner calculated to impress upon the relevant public that ACCU marks used in opposer’s field of endeavor indicate source in opposer”); McDonald’s Corp. v. McKinley, 13 U.S.P.Q.2d 1895, 1899 (T.T.A.B. 1990) (“Mc”).

246. Quality Inns Int’l v. McDonald’s Corp., 695 F. Supp. 198, 212, 8 U.S.P.Q.2d 1633, 1643 (D. Md. 1989) (“Mc”) (emphasis added).

opposer's . . . family of marks."²⁴⁷ A family of marks does not have unlimited strength; the degree of relatedness of products remains a significant factor.²⁴⁸ The family concept covers trade dress in addition to marks.²⁴⁹ A "couple" of marks is not a family.²⁵⁰ Nor are marks which merely share a common element.²⁵¹ The proponent must prove that the common characteristic is distinctive.²⁵² Evidence of significant third-party use of the family feature works to frustrate the proponent's claim.²⁵³ "A family of products in a particular field does not necessarily connote a family of marks."²⁵⁴

While not technically a "family" feature, a significant common portion of a group of marks may be given weight as the "dominant" and "unifying" feature of the marks.²⁵⁵ Even where the owner has not proved a family of marks as such, if it uses several variations of its core

247. 7-Eleven, Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1720 (T.T.A.B. 2007) (emphasis added); McDonald's Corp. v. McSweet, LLC, 112 U.S.P.Q.2d 1268, 1280 (T.T.A.B. 2d at 1720).

248. 7-Eleven, 83 U.S.P.Q.2d at 1720.

249. Walt Disney Co. v. Goodtimes Home Video Corp., 830 F. Supp. 762, 29 U.S.P.Q.2d 1047, 1050 (S.D.N.Y. 1993) ("consistent overall look"); AM Gen. Corp. v. DaimlerChrysler Corp., 311 F.3d 796, 814–15, 65 U.S.P.Q.2d 1001, 1012 (7th Cir. 2002) ("One claiming family trade dress protection must articulate a specific trade dress and demonstrate that it has consistently used that trade dress. . . .").

250. Land-O-Nod Co. v. Paulison, 220 U.S.P.Q. 61, 66 (T.T.A.B. 1983); Evans Prods. Co. v. Boise Cascade Corp., 218 U.S.P.Q. 160, 162 (T.T.A.B. 1983); AM Gen. Corp. v. DaimlerChrysler Corp., 311 F.3d 796, 816, 65 U.S.P.Q.2d 1001, 1014 (7th Cir. 2002).

251. Colony Foods, Inc. v. Sagemark Ltd., 735 F.2d 1336, 222 U.S.P.Q. 185, 186 (Fed. Cir. 1984); Consol. Foods Corp. v. Sherwood Med. Indus., Inc., 177 U.S.P.Q. 279, 282 (T.T.A.B. 1973).

252. Marion Labs., Inc. v. Biochemical/Diagnostics, Inc., 6 U.S.P.Q.2d 1215, 1220 (T.T.A.B. 1988) (TOXI suggestive for drug detection products); Gen. Instrument Corp. v. Autotote Ltd., 220 U.S.P.Q. 283, 286 n.4 (T.T.A.B. 1983); Miles Labs. Inc. v. Int'l Diagnostic Tech., Inc., 220 U.S.P.Q. 438, 443 (T.T.A.B. 1983), *aff'd in part*, Int'l Diagnostic Tech., Inc. v. Miles Labs., Inc., 746 F.2d 798, 223 U.S.P.Q. 977 (Fed. Cir. 1984); Spraying Sys. Co. v. Delavan, Inc., 975 F.2d 387, 24 U.S.P.Q.2d 1181, 1187 (7th Cir. 1992) (JET descriptive for spray nozzles and could not serve as a family surname); AM Gen. Corp. v. DaimlerChrysler Corp., 311 F.3d 796, 814, 815, 65 U.S.P.Q.2d 1001, 1012, 1013 (7th Cir. 2002).

253. Con-Stan Indus. v. Nutri-Sys. Weight Loss Med. Ctrs., 212 U.S.P.Q. 953, 957 (T.T.A.B. 1981); *cf.* J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 U.S.P.Q.2d 1889, 1892 (Fed. Cir. 1991).

254. AM Gen. Corp. v. DaimlerChrysler Corp., 311 F.3d 796, 816, 65 U.S.P.Q.2d 1001, 1014 (7th Cir. 2002).

255. Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 1073, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989); Ty, Inc. v. Jones Grp., 237 F.3d 891, 899, 57 U.S.P.Q.2d 1617 (7th Cir. 2001) ("the common thread"); *see* Raypak, Inc. v. Dunham-Bush, Inc., 216 U.S.P.Q. 1012, 1015 (T.T.A.B. 1983).

mark, consumers may become so accustomed to the varied usage that they naturally perceive an infringer's mark as yet another variation from the same source.²⁵⁶

Giving weight to a "family" feature or "dominant portion" must, however, be done in the context of considering the marks "as a whole as they are encountered by consumers in the marketplace."^{256.1}

On appeal of a refusal to register due to confusing similarity with a prior registered mark, "the focus of the likelihood of confusion analysis must be the mark applicant seeks to register, not other marks applicant may have used or registered. In other words, a family-of-marks argument is not available to an applicant seeking to overcome a likelihood of confusion refusal."²⁵⁷

§ 4:9.2 Words/Designs

In composite word and design marks, the word portion is usually deemed dominant.²⁵⁸ The word generally is the more easily remembered portion and is used in communications such as product requests.²⁵⁹ The design element of a mark would not be used by word-of-mouth, of course, and it may not be used in textual material such as catalogs, alphabetical listings, or media stories. In such instances, the design is diminished as a basis for distinguishing the marks.²⁶⁰

-
256. *Humana, Inc. v. Humanomics, Inc.*, 3 U.S.P.Q.2d 1696, 1700 (T.T.A.B. 1987), citing *Varian Assocs. v. Leybold-Hereues Gesellschaft*, 219 U.S.P.Q. 829, 833 (T.T.A.B. 1983); *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F. Supp. 457, 20 U.S.P.Q.2d 1579, 1582–83 (N.D. Cal. 1991) (GALLO); *Am. Optical Corp. v. Siemens AG*, 213 U.S.P.Q. 510, 516 (T.T.A.B. 1982); *In re Hitachi High-Techs. Corp.*, 109 U.S.P.Q.2d 1769, 1774 (T.T.A.B. 2014) (OPTI and six OPTI- prefix marks for liquid chromatography apparatus).
- 256.1. *Hornady Mfg. Co. v. Doubletap, Inc.*, 746 F.3d 995, 1001, 110 U.S.P.Q.2d 1140 (10th Cir. 2014) (see illustration, Appendix A24).
257. *In re Cynosure, Inc.*, 90 U.S.P.Q.2d 1644, 1644 (T.T.A.B. 2009).
258. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 U.S.P.Q. 198, 200 (Fed. Cir. 1983); *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 U.S.P.Q.2d 1618, 1621 (T.T.A.B. 1989); *Skincode AG v. Skin Concept AG*, 109 U.S.P.Q.2d 1325, 1329 (T.T.A.B. 2013).
259. *In re Decombe*, 9 U.S.P.Q.2d 1812, 1814 (T.T.A.B. 1988); *In re Carriage, Inc.*, 189 U.S.P.Q. 648 (T.T.A.B. 1975); *In re Big Wrangler Steak House, Inc.*, 230 U.S.P.Q. 634 (T.T.A.B. 1986); *Amoco Oil Co. v. Amerco, Inc.*, 192 U.S.P.Q. 729, 734 (T.T.A.B. 1976); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983); *In re Appetito Provisions Co.*, 3 U.S.P.Q.2d 1553, 1554 (T.T.A.B. 1987).
260. *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 46 U.S.P.Q.2d 1561, 1565 (9th Cir. 1998) (general press and industry magazines); *Lobo Enters., Inc. v. Tunnel, Inc.*, 693 F. Supp. 71, 8 U.S.P.Q.2d 1764, 1768 (S.D.N.Y. 1988); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 U.S.P.Q. 198, 200 (Fed. Cir. 1983).

Even so, the issue of dominance between word and design is one of fact in each case.^{260.1} A weak word mark may not dominate an associated design.²⁶¹ The design, particularly if prominent or well known, may dominate or at least be a significant factor in distinguishing the marks.²⁶² Where a design and a word reinforce each other, neither serves to distinguish the overall mark from the same word or design of another.²⁶³ Consumers are unlikely to remember or rely on minor design features to differentiate the marks.²⁶⁴ But differences in designs may outweigh similarity of words, and vice versa. (See section 4:3.4[C].)²⁶⁵

§ 4:9.3 Letters/Designs

With composite letter and design marks there is “no general rule as to whether letters or design will dominate.”²⁶⁶ Stylized letter marks have both visual and oral facets, and both must be weighed in context. Such marks are in “the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.”²⁶⁷ When

-
- 260.1. Jack Wolfskin Ausrüstung für Draussen GmbH & Co. v. New Millennium Sports, S.L.U., 797 F.3d 1363, 1372, 116 U.S.P.Q.2d 1129 (Fed. Cir. 2015).
261. *In re* Box Sols. Corp., 79 U.S.P.Q.2d 1953, 1958 (T.T.A.B. 2006); *Fancaster, Inc. v. Comcast Corp.*, 832 F. Supp. 2d 380 (D.N.J. 2011) (see **illustration, Appendix A19**).
262. *Compare In re* Covalinski, 113 U.S.P.Q.2d 1166 (T.T.A.B. 2014), *with In re* Davia, 110 U.S.P.Q.2d 1810 (T.T.A.B. 2014); *see* *Omega SA v. Alpha Phi Omega*, 118 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 2016) (“prominent, ornate and highly distinctive design”); *In re* Elbaum, 211 U.S.P.Q. 639, 641 (T.T.A.B. 1981); *Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 163, 23 U.S.P.Q.2d 1945 (Fed. Cir. 1992); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1409 (T.T.A.B. 1998); *Ass’n of Coop. Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 216 U.S.P.Q. 361, 367 (5th Cir. 1982); *Gaston’s White River Resort v. Rush*, 701 F. Supp. 1431, 8 U.S.P.Q.2d 1209, 1214 (W.D. Ark. 1988).
263. *In re* Shipp, 4 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 1987) (PURITAN with design of woman in Puritan costume); *In re* Kangaroos U.S.A., 223 U.S.P.Q. 1025 (T.T.A.B. 1984) (BOOMERANG with swirl design); *In re* Inspection Tech., Inc., 223 U.S.P.Q. 46, 47 (T.T.A.B. 1984).
264. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 U.S.P.Q. 198, 200 (Fed. Cir. 1983).
265. *Jordache Enters., Inc. v. Hogg Wyld Ltd.*, 828 F.2d 1482, 4 U.S.P.Q.2d 1216, 1219 (10th Cir. 1987); *Guthrie Healthcare Sys. v. ContextMedia, Inc.*, 826 F.3d 27 (2d Cir. 2016) (see **illustration, Appendix A30**). The *Guthrie* court stated that the “jaw-dropping,” “astounding” similarity of logos would suggest that the different names reflected “a mutually consenting or affiliated business relationship.” *Id.* at 39.
266. *In re* Electrolyte Labs., Inc., 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990); *cf.* *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 U.S.P.Q. 335, 344 (T.T.A.B. 1980) (letter design marks not normally spoken and are primarily visual).
267. *Ga.-Pac. Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 760, 204 U.S.P.Q. 697, 699 (C.C.P.A. 1980).

such marks are presented in so highly stylized a form that they are essentially design marks incapable of being pronounced or conveying any inherent meaning, the primary point of comparison is appearance.²⁶⁸

§ 4:9.4 Effect of Registration Disclaimers

The statutory presumptions that flow from registration apply to the “registered mark” *as a whole*, not to any component of the mark.²⁶⁹ Thus, without attacking the validity of the registration, one may argue that a component is descriptive or generic, therefore entitled to less weight in determining likelihood of confusion.²⁷⁰ However, a disclaimer involving a portion of one’s own registered mark cannot affect the scope of protection to which another’s mark is entitled.²⁷¹ Nevertheless, a party’s disclaimer of one portion of its mark may result in the remaining portion being treated as dominant and a source of confusion.²⁷²

Registration disclaimers play a role in identifying weak components. The PTO requires an applicant “to disclaim an unregistrable component of a mark otherwise registrable.”²⁷³ A disclaimed portion of a mark is not *apt* to be deemed dominant;²⁷⁴ however, there is no prohibition, and the Federal Circuit has “found that the dominant portion of a composite word and design mark is the literal portion,

268. *Textron, Inc. v. Maquinas Agrícolas “Jacto” S.A.*, 215 U.S.P.Q. 162, 163 (T.T.A.B. 1982).

269. 15 U.S.C. § 1057(b); 15 U.S.C. § 1115(b); *Igloo Prods. v. Brantex*, 202 F.3d 814, 817, 53 U.S.P.Q.2d 1753 (5th Cir. 2000).

270. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 33 U.S.P.Q.2d 1481, 1490–91 (4th Cir. 1995) (court rejected defendant’s contention that plaintiff’s registration, being for LONE STAR CAFE, did not confer incontestable status for the words LONE STAR alone); *cf. Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 106 F.3d 355, 362, 41 U.S.P.Q.2d 1896 (11th Cir. 1997).

271. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985).

272. *In re Chica, Inc.*, 84 U.S.P.Q.2d 1845 (T.T.A.B. 2007).

273. 15 U.S.C. § 1056.

274. *Country Floors, Inc. v. Gepner*, 930 F.2d 1056, 18 U.S.P.Q.2d 1577, 1585 (3d Cir. 1991); *cf. A&H Sportswear v. Victoria’s Secret Stores*, 237 F.3d 198, 217–18, 57 U.S.P.Q.2d 1097 (3d Cir. 2000); *see Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1529–30, 224 U.S.P.Q. 185, 189 (4th Cir. 1984); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 926, 33 U.S.P.Q.2d 1481 (4th Cir. 1995) (“courts should concentrate on the words not disclaimed in assessing likelihood of confusion”); *Motion Picture Ass’n of Am. v. Respect Sportswear Inc.*, 83 U.S.P.Q.2d 1555, 1559 (T.T.A.B. 2007).

2nd Proofs 10/04/17

even where the literal portion has been disclaimed.”²⁷⁵ Likewise, the absence of a disclaimer does not require that the nondisclaimed portion be treated as an arbitrary feature. However, the rule that a mark be viewed in its entirety requires that even a disclaimed portion be considered. A disclaimer “does not remove the disclaimed matter from the purview of determination of likelihood of confusion” because the public is unaware of disclaimers. Therefore, the disclaimed portion cannot be ignored in the likelihood of confusion analysis.²⁷⁶

For purposes of the likelihood of confusion analysis in the case of product design marks, the “entirety” of the mark does not include any portions of the design shown in broken lines in the drawing. Unlike disclaimed matter in a word mark, which actually forms part of the mark, the portion of a design shown in dotted lines is expressly excluded from the mark.²⁷⁷

§ 4:10 Marks Having Portions in Common

The root of alleged confusing similarity in most cases is the fact that the marks in issue have at least some portion in common. However, the mere fact that the marks in issue share elements, even dominant elements, does not compel a conclusion of likely confusion.²⁷⁸ The proper comparison is between the overall commercial impressions of the marks as consumers would view and remember

275. *In re Viterra Inc.*, 101 U.S.P.Q.2d 1905, 1911, 671 F.3d 1358 (Fed. Cir. 2012).

276. *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993); *Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.*, 22 F.3d 1527, 30 U.S.P.Q.2d 1930, 1934 (10th Cir. 1994); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *In re MCI Commc'ns Corp.*, 21 U.S.P.Q.2d 1534, 1538 (T.T.A.B. 1991); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983) (“disclaimers are not helpful in preventing likelihood of confusion in the mind of the consumer, because he is unaware of their existence”); *cf. Oakwood Mfg., Inc. v. Novi Am., Inc.*, 213 U.S.P.Q. 1014, 1022 (E.D. Mich. 1982) (no infringement where the only common feature between the marks is disclaimed).

277. *In re Homeland Vinyl Prods., Inc.*, 81 U.S.P.Q.2d 1378, 1382 (T.T.A.B. 2006).

278. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (“The use of identical, even dominant, words in common does not automatically mean that two marks are similar.”), citing *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 1183, 226 U.S.P.Q. 123, 127 (11th Cir. 1985); *see also Penta Hotels Ltd. v. Penta Tours*, 9 U.S.P.Q.2d 1081, 1098 (D. Conn. 1988); *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F. Supp. 1058, 3 U.S.P.Q.2d 1194, 1203 (D.N.J. 1987), *aff'd*, 834 F.2d 368, 5 U.S.P.Q.2d 1073 (3d Cir. 1987) (trade dress).

2nd Proofs 10/04/17

them.²⁷⁹ The placement of words within marks may have a major impact on the overall similarity of the marks.²⁸⁰

§ 4:10.1 One Mark Incorporating Another

Likelihood of confusion is often found where the entirety of one mark is incorporated within another,²⁸¹ however, the determination is one of fact depending on the case.²⁸² The risk is especially great when the portion common to both marks has inherent or acquired distinctiveness, but the additional portion in the incorporating mark is relatively inconspicuous, descriptive, or generic. In such cases, the incorporating mark is apt to retain the basic commercial impression of the other; the additional portion at best merely imparts information about the product and not about the source.

If all that a newcomer in the field need do in order to avoid the charge of confusing similarity is to select a word descriptive of his goods and combine it with a word which is the dominant feature of a registered trade-mark so that the borrowed word becomes the dominant feature of his mark, the registered trade-mark, made valuable and outstanding by extensive advertising and use, soon becomes of little value. . . .²⁸³

-
279. *E.g.*, Long John Distilleries, Ltd. v. Sazerac, 426 F.2d 1406, 166 U.S.P.Q. 30 (C.C.P.A. 1970) (LONG JOHN v. FRIAR JOHN; no confusion where marks have a common portion but convey different commercial impressions).
280. Nabisco v. Warner-Lambert, 220 F.3d 43, 55 U.S.P.Q.2d 1051 (2d Cir. 2000) (**see illustration, Appendix A8**); *see note 226, supra*.
281. Girls Clubs of Am., Inc. v. Boys Clubs of Am., Inc., 683 F. Supp. 50, 6 U.S.P.Q.2d 2049, 2051 (S.D.N.Y. 1988) (conflict “extremely likely”); Christian Broad. Network, Inc. v. ABS-CBN Int’l, 84 U.S.P.Q.2d 1560, 1568 (T.T.A.B. 2007) (citing cases); (CBN v. ABS-CBN); Johnson Publ’g Co. v. Int’l Dev. Ltd., 221 U.S.P.Q. 155, 156–57 (T.T.A.B. 1982) (noting cases) (same word followed by second term); Omega SA v. Alpha Phi Omega, 118 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 2016) (OMEGA incorporated in ALPHA PHI OMEGA and “prominent, ornate and highly distinctive design”).
282. Kibler v. Hall, 843 F.3d 1068, 1077–78, 121 U.S.P.Q.2d 1069 (6th Cir. 2016) (DJ LOGIC v. LOGIC, dissimilar); Thane Int’l v. Trek Bicycle, 305 F.3d 894, 901, 903, 64 U.S.P.Q.2d 1564, 1567, 1569 (9th Cir. 2002) (TREK v. ORBITREK); M2 Software v. Madacy Entm’t, 421 F.3d 1073, 1082, 76 U.S.P.Q.2d 1161 (9th Cir. 2005) (M2 v. M2 ENTERTAINMENT); *In re* Mr. Recipe, LLC, 118 U.S.P.Q.2d 1084, 1088 (T.T.A.B. 2016) (where opposer’s mark is incorporated in applicant’s, the addition to the latter “calls to mind” the former).
283. Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 224 U.S.P.Q. 185, 190 (4th Cir. 1984), quoting Bon Ami Co. v. McKesson & Robbins, 93 F.2d 915, 916–17, 36 U.S.P.Q. 260 (C.C.P.A. 1938); Fisons Horticulture, Inc. v. Vigoro Indus., Inc., 30 F.3d 466, 31 U.S.P.Q.2d 1592, 1600 (3d Cir. 1994) (FAIRWAY v. FAIRWAY GREEN); TMEP 1207.01(b)(iii) (2009).

Conflict was found in the following cases:

OGGETTI	versus	BELL'OGGETTI ²⁸⁴
LASER	versus	LASERSWING ²⁸⁵
VW	versus	VW.NET ²⁸⁶
THE CHILDREN'S PLACE	versus	THECHILDRENSPLACE.COM/NET ²⁸⁷
PERRY'S	versus	PERRY'S PIZZA ²⁸⁸
9000	versus	9000 SERIES ²⁸⁹
YELLOW BOOK	versus	800 YELLOW BOOK ²⁹⁰
LITTLE LADY	versus	LIL' LADY BUGGY ²⁹¹
INDUCTO	versus	INDUCT-O-MATIC ²⁹²
SIMPLICITY	versus	SENSE AND SIMPLICITY ²⁹³

-
284. *Frehling v. Int'l Select Grp.*, 192 F.3d 1330, 1337, 52 U.S.P.Q.2d 1447 (11th Cir. 1999) (“BELL'OGGETTI entirely encompasses OGGETTI and merely adds a descriptive adjective BELL meaning ‘beautiful’ to the dominant portion of the mark”).
285. *Cunningham v. Laser Golf*, 222 F.3d 943, 947, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000).
286. *Virtual Works v. Volkswagen of Am.*, 238 F.3d 264, 270, 57 U.S.P.Q.2d 1547 (4th Cir. 2001) (domain name “confusingly similar” under Anti-cybersquatting Consumer Protection Act).
287. *TCPIP Holding Co. v. Haar Commc'ns*, 244 F.3d 88, 101, 57 U.S.P.Q.2d 1969 (2d Cir. 2001) (names “functionally the same” regardless of separating spaces, possessive punctuation, and top level domains).
288. *In re Denisi*, 225 U.S.P.Q. 624 (T.T.A.B. 1985).
289. *Saab-Scania Aktiebolag v. Sparkomatic Corp.*, 26 U.S.P.Q.2d 1709, 1710–11 (T.T.A.B. 1993).
290. *Multi-Local Media Corp. v. 800 Yellow Book, Inc.*, 813 F. Supp. 199, 26 U.S.P.Q.2d 1611, 1615 (E.D.N.Y. 1993).
291. *In re S. Bend Toy Mfg. Co.*, 218 U.S.P.Q. 479, 480 (T.T.A.B. 1983).
292. *Induct-O-Matic Corp. v. Inductotherm Corp.*, 747 F.2d 358, 224 U.S.P.Q. 119, 122–23 (6th Cir. 1984); *see also* *Lambda Elecs. Corp. v. Lambda Tech., Inc.*, 515 F. Supp. 915, 211 U.S.P.Q. 75, 85–86 (S.D.N.Y. 1981); *Coherent, Inc. v. Coherent Techs., Inc.*, 736 F. Supp. 1055, 19 U.S.P.Q.2d 1017, 1024 (D. Colo. 1990), *aff'd*, 935 F.2d 1122, 19 U.S.P.Q.2d 1146 (10th Cir. 1991); *Penta Hotels Ltd. v. Penta Tours*, 9 U.S.P.Q.2d 1081, 1099 (D. Conn. 1988) (PENTA for hotel services v. PENTATOURS for travel services; “The word ‘Tours’ when added to the mark Penta . . . more likely suggests some type of affiliation”).
293. *Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 U.S.P.Q.2d 1558 (T.T.A.B. 2011).

BUD	versus	WINEBUD ^{293.1}
LION CAPITAL	versus	STONE LION CAPITAL ^{293.2}

An infringer's addition of inconspicuous and common words, particularly to a well-known mark, may *aggravate* confusion by suggesting to consumers that the infringer's mark is a "spin-off" or otherwise connected to the senior user. (See section 4:10.6.) The following marks were deemed likely to cause confusion: AMERICAN EXPRESS Limousine Service,²⁹⁴ AAA Insurance Agency,²⁹⁵ SEARS Financial Services,²⁹⁶ PACKARD Technologies.²⁹⁷

If the common portion is weak, conflict is often avoided even though the noncommon matter is highly suggestive or even descriptive.²⁹⁸ In such cases, the overall differences, albeit relatively minor, between the marks suffice to enable consumers to differentiate them. No likelihood of confusion was found in the following cases:

SILK 'N SATIN	versus	SILK ²⁹⁹
SILK	versus	SILKSTICK ³⁰⁰
CORN-ROYAL	versus	ROYAL ³⁰¹

-
- 293.1. Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd., 115 U.S.P.Q.2d 1816 (T.T.A.B. 2015).
- 293.2. Stone Lion Capital Partners, L.P. v. Lion Capital LLP, 746 F.3d 1317, 110 U.S.P.Q.2d 1157 (Fed. Cir. 2014) (rejecting argument of different sound and meaning).
294. Am. Express Co. v. Am. Express Limousine Serv. Ltd., 772 F. Supp. 729, 733, 21 U.S.P.Q.2d 1009, 1012 (E.D.N.Y. 1991); *see* Standard & Poor's Corp. v. Commodity Exch., Inc., 683 F.2d 704, 708, 216 U.S.P.Q. 841, 843 (2d Cir. 1982) (defendant's use of "500," "often followed by the words 'stock index,' may well create the possible inference that the Standard & Poor's 500 Index is the sponsor of the Comex 500 contract").
295. Am. Auto. Ass'n v. AAA Ins. Agency, Inc., 618 F. Supp. 787, 793, 228 U.S.P.Q. 162, 165 (W.D. Tex. 1985).
296. Sears, Roebuck & Co. v. Sears Fin. Network, Inc., 576 F. Supp. 857, 221 U.S.P.Q. 581, 585 (D.D.C. 1983); *cf. In re Martin's Famous Pastry Shoppe, Inc.*, 221 U.S.P.Q. 364, 367 (T.T.A.B. 1984) ("PASTRY SHOPPE operates to provide a built-in source distinction since one would not expect cheese to emanate from a 'pastry shop.'"), *aff'd*, 748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984).
297. Hewlett-Packard Co. v. Packard Press, Inc. 281 F.3d 1261, 1266, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002).
298. TMEP 1207.01(b)(iii) (2009); *but see* China Healthways v. Wang, 491 F.3d 1337, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007) (CHI v. CHI PLUS, both for electric massagers; "chi" being defined as "vital energy and vital force").
299. Pacquin-Lester Co. v. Charnaceuticals, Inc., 484 F.2d 1384, 179 U.S.P.Q. 45 (C.C.P.A. 1973).
300. Melaro v. Pfizer, Inc., 214 U.S.P.Q. 645, 648 (T.T.A.B. 1982).
301. Standard Brands, Inc. v. Peters, 191 U.S.P.Q. 168, 172 (T.T.A.B. 1975).

BOND-PLUS	versus	WONDER BOND PLUS ³⁰²
ALPHA	versus	ALPHA STEEL ³⁰³
PLUS	versus	MEAT PLUS ³⁰⁴
MAGIC	versus	SOUR MAGIC ³⁰⁵
PETRO	versus	JR JAMES RIVER PETRO CARD ³⁰⁶
EASY	versus	EASYTINT ³⁰⁷
KEYCHECK, KEYBANKER	versus	KEY ³⁰⁸
OOZ BALL	versus	OOZE ³⁰⁹
CONDITION	versus	CURL & CONDITION ³¹⁰
GRAND HOTEL	versus	GRAND HOTELS NYC ³¹¹

In the following cases, likelihood of confusion was avoided because the incorporated mark was combined with other features in such a manner that its identity was lost, or so merged with those other features that, overall, the marks were deemed dissimilar in sound, appearance, or meaning.³¹²

-
302. *Indus. Adhesive Co. v. Borden, Inc.*, 218 U.S.P.Q. 945, 951–52 (T.T.A.B. 1983).
303. *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 205 U.S.P.Q. 981 (9th Cir. 1980).
304. *Plus Prods. v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541, 544 (T.T.A.B. 1983).
305. *Basic Vegetable Prods. Inc. v. Gen. Foods Corp.*, 165 U.S.P.Q. 781, 784 (T.T.A.B. 1970).
306. *Petro Stopping Ctrs. L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 44 U.S.P.Q.2d 1921, 1926–27 (4th Cir. 1997).
307. *Murray Corp. of Am. v. Red Spot Paint & Varnish Co.*, 280 F.2d 158, 126 U.S.P.Q. 390 (C.C.P.A. 1960).
308. *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984).
309. *Monarch Licensing Ltd. v. Ritam Int'l Ltd.*, 24 U.S.P.Q.2d 1456, 1461 (S.D.N.Y. 1992).
310. *Redken Labs., Inc. v. Clairol, Inc.*, 501 F.2d 1403, 183 U.S.P.Q. 84 (9th Cir. 1974).
311. *In re Hartz Hotel Servs. Inc.*, 102 U.S.P.Q.2d 1150 (T.T.A.B. 2012).
312. *Miller Brewing Co. v. Premier Beverages, Inc.*, 210 U.S.P.Q. 43, 48–49 (T.T.A.B. 1981); *see Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 35 U.S.P.Q.2d 1449, 1456 (2d Cir. 1995) (T50 used in six-digit model number); TMEP 1207.01(b)(iii) (2009).

2nd Proofs 10/04/17

MILLER	versus	OL' BOB MILLER'S	both for beverages ³¹³
KISSES	versus	A BIG KISS FOR YOU and SEALED WITH A KISS	both for chocolates ³¹⁴
REX	versus	MERCIREX	both for medications ³¹⁵
FINAL	versus	FINAL FLIP	both for rodenticide ³¹⁶
SPEX, INC.	versus	THE JOY OF SPEX, INC. and logo	both for sale of eyewear ³¹⁷
CRISTAL	versus	CRYSTAL CREEK	both for wine ³¹⁸
JET	versus	AEROB-A-JET	both for waste water treatment devices ³¹⁹
XL	versus	STEAMEX DELUXE 15 XL	both for carpet cleaners ³²⁰
PATIO for Mexican- style foods	versus	TAPATIO for sauce ³²¹	
THE HERTZ #1 CLUB	versus	IN AUTO LEASING THERE IS ONLY ONE NO. 1 . . . THAT'S YOU!	both for auto leasing ³²²

-
313. Miller Brewing Co. v. Premier Beverages, Inc., 210 U.S.P.Q. 43, 48–49 (T.T.A.B. 1981).
314. Hershey Foods Corp. v. Cerreta, 195 U.S.P.Q. 246 (T.T.A.B. 1977).
315. United Drug Co. v. Mercirex Co., 182 F.2d 222, 86 U.S.P.Q. 112 (C.C.P.A. 1950).
316. Bell Labs., Inc. v. Colonial Prods., Inc., 644 F. Supp. 542, 231 U.S.P.Q. 569 (S.D. Fla. 1986).
317. Spex, Inc. v. Joy of Spex, Inc., 847 F. Supp. 567, 31 U.S.P.Q.2d 1019 (N.D. Ill. 1994).
318. Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998).
319. Jet, Inc. v. Sewage Aeration Sys., 165 F.3d 419, 49 U.S.P.Q.2d 1355 (6th Cir. 1999).
320. Oreck Corp. v. U.S. Floor Sys., Inc., 803 F.2d 166, 231 U.S.P.Q. 634, 638 (5th Cir. 1986).
321. ConAgra, Inc. v. Saavedra, 4 U.S.P.Q.2d 1245, 1247 (T.T.A.B. 1987). *See also In re Big Wrangler Steak House, Inc.*, 230 U.S.P.Q. 634 (T.T.A.B. 1986) (design of steer head v. BIG WRANGLER STEAK HOUSE with rope design and design of steer head).
322. Hertz Sys., Inc. v. A-Drive Corp., 222 U.S.P.Q. 625 (T.T.A.B. 1984).

DOLE	versus	FARANDOLE	both for foods ³²³
SURE	versus	USE ARID TO BE SURE	both for deodorants ³²⁴
FOREVER FRESH FOR THE FRIDGE	versus	ARM & HAMMER FRIDGE FRESH	both for refrigerator deodorants ³²⁵

It is a question of fact whether the added matter in the incorporating mark suffices to avoid confusing similarity.³²⁶

§ 4:10.2 Common Portion Comparatively Strong, Dominant

Likelihood of confusion is more to be found where the common portion is suggestive or otherwise comparatively strong, and dominant.³²⁷ What the consumer is likely to remember of both marks is the same. Conflict was found in these cases:

SAFEWAY Stores, Inc.	versus	SAFEWAY Discount ³²⁸
CENTURY 21	versus	CENTURY LIFE OF AMERICA ³²⁹
PIZZERIA UNO	versus	TACO UNO ³³⁰

323. Castle & Cooke, Inc. v. Oulevay, S.A., 370 F.2d 359, 152 U.S.P.Q. 115, 115 (C.C.P.A. 1967).

324. Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794, 167 U.S.P.Q. 713 (9th Cir. 1977).

325. World Wide Sales, Inc. v. Church & Dwight Co., 93 U.S.P.Q.2d 1313 (E.D. Pa. 2009).

326. Entrepreneur Media v. Smith, 279 F.3d 1135, 1145–46, 61 U.S.P.Q.2d 1705, 1710–11 (9th Cir. 2002); Thane Int'l v. Trek Bicycle, 305 F.3d 894, 901, 903, 64 U.S.P.Q.2d 1564, 1567, 1569 (9th Cir. 2002).

327. Universal Motor Oils Co. v. Amoco Oil Co., 809 F. Supp. 816, 15 U.S.P.Q.2d 1613, 1619 (D. Kan. 1990) (“Confusion may be likely if the dominant portion of both marks is the same”), citing cases; *In re Denisi*, 225 U.S.P.Q. 624 (T.T.A.B. 1985), citing cases; Giant Food, Inc. v. Nation’s Foodservice, Inc., 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983).

328. Safeway Stores, Inc. v. Safeway Disc. Drugs, 675 F.2d 1160, 216 U.S.P.Q. 599, 603 (11th Cir. 1982).

329. Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992).

330. Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 224 U.S.P.Q. 185, 193 (4th Cir. 1984).

2nd Proofs 10/04/17

McDONALD'S	versus	McPRETZEL ³³¹
TIGER DISCOUNTER	versus	TIGER MART ³³²
AUSTRALIAN HAIR SALAD	versus	HAIR SALAD CONDITIONER ³³³
WEED EATER	versus	LEAF EATER ³³⁴
CAESARS PALACE	versus	TRUMP'S PALACE ³³⁵
CARNIVAL CRUISE LINES	versus	CARNIVAL CLUB ³³⁶
PROZAC	versus	HERBROZAC ³³⁷
HOME-MARKET.COM	versus	HOME-MARKET.NET ³³⁸
ZOG	versus	ZOGGS TOGS ³³⁹
BEACON MUTUAL INSURANCE COMPANY	versus	ONEBEACON INSURANCE GROUP ^{339.1}
HOTEL MELIÁ	versus	GRAN MELIÁ ^{339.2}
ORIENTAL GROUP	versus	COOP ORIENTAL ^{339.3}

-
331. J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 U.S.P.Q.2d 1889 (Fed. Cir. 1991), *cited in* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c, Rptr. Note, at 239–40 (1995).
332. Super Value Stores, Inc. v. Exxon Corp., 11 U.S.P.Q.2d 1539, 1542 (T.T.A.B. 1989).
333. Redmond Prods., Inc. v. Body Shop, Inc., 20 U.S.P.Q.2d 1233 (D. Minn. 1991).
334. Aktiebolaget Electrolux v. Armatron Int'l, Inc., 999 F.2d 1, 27 U.S.P.Q.2d 1460 (1st Cir. 1993).
335. Trump v. Caesars World, Inc., 645 F. Supp. 1015, 230 U.S.P.Q. 594 (D.N.J. 1986), *aff'd*, 2 U.S.P.Q.2d 1806 (3d Cir. 1987).
336. Blumenfeld Dev. Corp. v. Carnival Cruise Lines, Inc., 669 F. Supp. 1297, 4 U.S.P.Q.2d 1577 (E.D. Pa. 1987).
337. Eli Lilly v. Nat. Answers, 233 F.3d 456, 462, 56 U.S.P.Q.2d 1942 (7th Cir. 2000).
338. Shade's Landing v. Williams, 76 F. Supp. 2d 983, 990 (D. Minn. 1999) (finding the marks "quite similar"; "[b]ecause all domain names include one of these [top level domain name] extensions, the distinction between a domain name ending with ".com" and the same name ending with ".net" is not highly significant": non-infringement found on the other factors).
339. *In re Ginc*, 90 U.S.P.Q.2d 1472 (T.T.A.B. 2007).
- 339.1. Beacon Mut. Ins. Co. v. OneBeacon Ins. Grp., 376 F.3d 8, 71 U.S.P.Q.2d 1641 (1st Cir. 2004).
- 339.2. Dorpan, S.L. v. Hotel Meliá, Inc., 728 F.3d 55, 108 U.S.P.Q.2d 1093 (1st Cir. 2013) (marks "essentially identical").
- 339.3. Oriental Fin. Grp., Inc. v. Cooperativa de Ahorro y Crédito Oriental, 832 F.3d 15, 28, 119 U.S.P.Q.2d 1701 (1st Cir. 2016).

§ 4:10.3 **Common Portion Weak, Recessive**

Where the common portion is weak, otherwise minor differences in the remaining portions could make for marks which, overall, are not confusingly similar.³⁴⁰

[T]hat a descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion reflect[s] the reality of the market place. Where consumers are faced with various usages of descriptive words, our experience tells us that we and other consumers distinguish between these usages. Some usages will be recognized as ordinary descriptive speech. Where a descriptive term forms part of two or more marks for related products . . . the decisions recognize that the purchasing public has become conditioned to this frequent marketing situation and will not be diverted from selecting what is wanted unless the overall combinations have other commonality. In a sense, the public can be said to rely more on the nondescriptive portion of each mark.³⁴¹

The noncommon matter, verbal or pictorial,³⁴² which is “equally suggestive or even descriptive, may be sufficient to avoid confusion.”³⁴³ No likelihood of confusion was found in the following cases:

MAGNIVISION	versus	MAGNADOT both for eyeglasses ³⁴⁴
CHIROPRACTIC and -CHIRO-	versus	CHIRO-MATIC all for mattresses and box springs ³⁴⁵

-
340. Freedom Sav. & Loan Ass’n v. Way, 757 F.2d 1176, 1183, 226 U.S.P.Q. 123, 127–28 (11th Cir. 1985) (“FREEDOM”), citing Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass’n, 651 F.2d 311, 316, 211 U.S.P.Q. 844, 848–49 (5th Cir. 1981) (SUN); Everest Capital v. Everest Funds, 393 F.3d 755, 761, 73 U.S.P.Q.2d 1580, 1584 (8th Cir. 2005); Falcon Rice Mill, Inc. v. Cmty. Rice Mill, Inc., 725 F.2d 336, 346, 222 U.S.P.Q. 197, 204 (5th Cir. 1984) (“slight variation in color or design”).
341. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985).
342. *Nat’l Rural Elec. Coop. Ass’n v. Suzlon Wind Energy Corp.*, 78 U.S.P.Q.2d 1881 (T.T.A.B. 2006) (zigzag lines connoting electricity).
343. *Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316, 318 (T.T.A.B. 1986) (POLY PRO and POLY-GLO v. POLY FLO); *United Foods, Inc. v. J.R. Simplot Co.*, 4 U.S.P.Q.2d 1172, 1174 (T.T.A.B. 1987) (QUICK ‘N prefix).
344. *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1330, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (“The record shows . . . that the MAGNA/MAGNI prefix . . . enjoy[s] wide use in the eyeglass industry on similar goods and services.”).
345. *Land-O-Nod Co. v. Paulison*, 220 U.S.P.Q. 61 (T.T.A.B. 1983) (no family).

FERRO [combination marks]	versus	FERRO-GARD for coating compositions for metal goods ³⁴⁶
SPRAY 'N VAC	versus	RINSENVAC both for vacuum rug cleaners ³⁴⁷
THERM-A-JUG	versus	THERMEX both for insulated food containers ³⁴⁸
NUTRI SCIENCE and other NUTRI- prefix marks for vitamin food supplements	versus	NUTRI/SYSTEM 2000 for low-calorie foods ³⁴⁹
NUTRI/SYSTEM	versus	NUTRI-TRIM both for weight loss centers ³⁵⁰
METRECAL for dietary products	versus	MINIKAL for dietary food products ³⁵¹
RESIFLEX for patient care tubes	versus	STERI-FLEX for sterilized disposable medical tubing ³⁵²
TEKTRONIX	versus	DAKTRONICS both for electronic goods ³⁵³
AQUASEAL and other AQUA- prefix marks	versus	AQUA STREAM both for plumbing products ³⁵⁴

-
346. Ferro Corp. v. Ronco Labs., 356 F.2d 122, 148 U.S.P.Q. 497 (C.C.P.A. 1966).
347. Glamorene Prods. v. Earl Grissmer, 203 U.S.P.Q. 1090 (T.T.A.B. 1979).
348. Knapp-Monarch v. Poloron Prods., 134 U.S.P.Q. 412 (T.T.A.B. 1962).
349. Con-Stan Indus. v. Nutri-Sys. Weight Loss Med. Ctrs., 212 U.S.P.Q. 953 (T.T.A.B. 1981) (no family).
350. Nutri/Sys., Inc. v. Con-Stan Indus., Inc., 809 F.2d 601, 1 U.S.P.Q.2d 1809 (9th Cir. 1987).
351. Mead Johnson & Co. v. Peter Eckes, 195 U.S.P.Q. 187 (T.T.A.B. 1977).
352. Cutter Lab., Inc. v. Air Prods. & Chems., Inc., 189 U.S.P.Q. 108 (T.T.A.B. 1975).
353. Tektronix, Inc. v. Daktronics, Inc., 187 U.S.P.Q. 588 (T.T.A.B. 1975), *aff'd*, 534 F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976).
354. Am. Standard, Inc. v. Scott & Fetzer Co., 200 U.S.P.Q. 457 (T.T.A.B. 1978) (no family).

2nd Proofs 10/04/17

GENUINE SKIN	versus	GENUINE RIDE SKIN CARE both for skin care products ³⁵⁵
SINUCLEANSE	versus	SINUSENSE, both for sinus irrigation products ^{355.1}

Whether the common portion is strong or weak is always subject to proof—for example, evidence of fame or the extent of third-party use. Thus, an apparently weak, common portion may in fact prove to be sufficiently strong for the senior user to prevail. Likelihood of confusion was found in these cases:

ORAL-B	versus	ORAL-ANGLE both for toothbrushes ³⁵⁶
KIDWIPES	versus	KID STUFF both for premoistened disposable towelettes ³⁵⁷
POLIDENT	versus	POWER DENT both for denture cleansers ³⁵⁸
ACCU	versus	ACCUSTAFF both for employment services ³⁵⁹
BOWFLEX	versus	CROSSBOW both for exercise machines using flexible rods ³⁶⁰

-
355. Truescents LLC v. Ride Skin Care, L.L.C., 81 U.S.P.Q.2d 1334 (T.T.A.B. 2006).
- 355.1. Water Pik, Inc. v. Med-Systems, Inc., 726 F.3d 1136, 107 U.S.P.Q.2d 2095 (10th Cir. 2013) (**see illustration, Appendix A22**).
356. Gillette Can., Inc. v. Ranir Corp., 23 U.S.P.Q.2d 1768 (T.T.A.B. 1992).
357. Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988) (no third-party use of KID).
358. Block Drug Co. v. Den-Mat, Inc., 17 U.S.P.Q.2d 1315, 1317 (T.T.A.B. 1989), *aff'd*, Den-Mat Corp. v. Block Drug Co., 17 U.S.P.Q.2d 1318 (Fed. Cir. 1990).
359. Accu Pers., Inc. v. AccuStaff, Inc., 823 F. Supp. 1161, 27 U.S.P.Q.2d 1801 (D. Del. 1993) (only one third-party ACCU use in plaintiff's geographic area).
360. Nautilus v. Icon, 372 F.3d 1330, 71 U.S.P.Q.2d 1173 (Fed. Cir. 2004), *aff'g* 308 F. Supp. 2d 1208, 1213 (W.D. Wash. 2003) (noting no relevant third-party use of "bow" in its name).

2nd Proofs 10/04/17

WINDMASTER	versus	WINDBUSTER both for wind resistant traffic sign stands ³⁶¹
RELIALINE and RELIASEAL for ostomy irrigation sets and adhesive discs	versus	RELIABELT for elastic supports for ostomy appliances ³⁶²
PURO and PUROLATOR	versus	PURO FILTER both for auto filters ³⁶³
PERMA SHIELD for windows and doors	versus	THERM-O-SHIELD for polyester film applied to window and door glass ³⁶⁴
TOXI-DISCS and other TOXI- prefix marks	versus	TOXI-PREP all for clinical laboratory drug detection products ³⁶⁵
AUTOZONE for oil-change products	versus	OIL ZONE for oil-change services ³⁶⁶

Descriptive words may play an important role in leading to likelihood of confusion. By way of example, one court assumed the following successive pairs of hypothetical marks:

-
361. Mktg. Displays v. Traffix Devices, 200 F.3d 929, 53 U.S.P.Q.2d 1335 (6th Cir. 1999), *rev'd on other grounds*, Traffix Devices v. Mktg. Displays, 532 U.S. 23, 121 S. Ct. 1255, 58 U.S.P.Q.2d 1001 (2001).
362. C.R. Bard, Inc. v. Byron, 225 U.S.P.Q. 206 (T.T.A.B. 1985) (no evidence showing that RELIA was weak).
363. Purolator, Inc. v. EFRA Distrib., Inc., 687 F.2d 554, 216 U.S.P.Q. 457, 461 (1st Cir. 1982).
364. Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 U.S.P.Q. 431, 434 (T.T.A.B. 1985) (insignificant third-party use of SHIELD).
365. Marion Labs, Inc. v. Biochemical/Diagnostics, Inc., 6 U.S.P.Q.2d 1215 (T.T.A.B. 1988) (no evidence of record to prove common third-party use or registration of TOXI-prefix).
366. AutoZone, Inc. v. Strick, 543 F.3d 923, 88 U.S.P.Q.2d 1225 (7th Cir. 2008).

ACCOUNT	EXCHANGE
CASH ACCOUNT	CASH EXCHANGE
MANAGEMENT ACCOUNT	MANAGEMENT EXCHANGE
CASH MANAGEMENT EXCHANGE	CASH MANAGEMENT ACCOUNT
CASH MANAGEMENT ACCOUNT BANK	CASH MANAGEMENT EXCHANGE BANK

The court commented:

That these pairs are of progressively greater similarity is readily apparent, with the result that likelihood of confusion of the public becomes a closer question at each step of the progression, until it becomes virtually undeniable even though only a “generic” word, “BANK” has been added to the final stage. The differing portions of each pair of marks, ACCOUNT and EXCHANGE, are as similar or dissimilar in the last pair as in the first, but the marks in their entireties are not. The addition of a string of descriptive and even generic words has altered the mental impression made by the marks until it can only be concluded that the dissimilar part has been submerged. Thus, one cannot . . . focus primarily on the non-common features . . . to determine likelihood of confusion. The marks must be considered, as the public views them, that is, in their entireties.³⁶⁷

§ 4:10.4 Common Portion Generic or Functional

Even though the common portion of the marks is generic, the marks still must be viewed and compared in their entireties.³⁶⁸ Similar *placement* of a generic term in two marks may contribute to confusing structural similarity.

367. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985); *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1472, 44 U.S.P.Q.2d 1315 (Fed. Cir. 1997) [GRAND AM v. GRAND SLAM; “It does not matter that GRAND is ‘laudatory,’ a characteristic the Board thought contributed to its ‘weakness’ as a trademark. It is a major contributor to overall similarity.”].

368. *Beech-Nut, Inc. v. Warner-Lambert Co.*, 480 F.2d 801, 803, 178 U.S.P.Q. 385, 386 (2d Cir. 1973) (no confusion: BREATH SAVERS v. BREATH PLEASERS; “plaintiff possesses no exclusive rights” as to BREATH); *In re Bed & Breakfast Registry*, 791 F.2d 157, 159, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986) (no confusion: BED & BREAKFAST INTERNATIONAL v. BED & BREAKFAST REGISTRY; “The common elements of the marks, even if descriptive, cannot be ignored”); *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 6 U.S.P.Q.2d 1187, 1191 (2d Cir. 1988) (confusion: BEE

SLICKCRAFT	versus	SLEEKCRAFT both for boats ³⁶⁹
SPICE ISLANDS	versus	SPICE VALLEY both for spices ³⁷⁰

According to one court: “Arguments to the effect that one portion of a mark possesses no trademark significance leading to a direct comparison between only what remains is an erroneous approach.”³⁷¹ It may be said that likelihood of confusion will be *primarily* based on the similarity of the nongeneric portions.³⁷² According to another articulation, confusing similarity “cannot rest *solely* on the use of the same generic term when the other terms are dissimilar.”³⁷³

-
- WEAR v. B WEAR); *Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 851, 23 U.S.P.Q.2d 1471, 1474 (Fed. Cir. 1992) (“whether generic or descriptive words are included as part of the mark . . . is simply a factor to be considered when viewing the mark as a whole”).
369. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351, 204 U.S.P.Q. 808, 817 (9th Cir. 1979) (“the common endings do add to the marks’ similarity”).
370. *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 U.S.P.Q. 1281, 1283 (Fed. Cir. 1984).
371. *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 673, 223 U.S.P.Q. 1281, 1283 (Fed. Cir. 1984); *accord* *Builders Square, Inc. v. Wickes Co.*, 227 U.S.P.Q. 644, 647 (C.D. Cal. 1985) (*BUILDERS SQUARE v. BUILDERS EMPORIUM*); *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888, 228 U.S.P.Q. 364, 366 (Fed. Cir. 1986) (*ROMAN and design v. ROMANBURGER*, noting that Opposer had not registered *ROMAN* alone; “We see no reason to believe, and there is no evidence on the point, that consumers are likely to extract ‘Roman’ from ‘Romanburger’ and rely on ‘Roman’ per se as an indication of source”); *Gen. Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270, 1278 (T.T.A.B. 1992) (*FIBER ONE v. FIBER 7 FLAKES*).
372. *Dranoff-Perlstein Assoc. v. Sklar*, 967 F.2d 852, 23 U.S.P.Q.2d 1174, 1182 (3d Cir. 1992); *Times Newspapers Ltd. v. Times Publ’g Co.*, 25 U.S.P.Q.2d 1835, 1841 n.18 (M.D. Fla. 1993) (“Courts have held that where two conflicting marks both employ a word that has become a public domain generic word, that the Court’s attention should focus upon the confusing similarity of the nongeneric portion”); *Bos. Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 24, 87 U.S.P.Q.2d 1385 (1st Cir. 2008) (“we give less weight to the generic portions of the parties’ respective, composite marks”).
373. *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 492, 6 U.S.P.Q.2d 1187, 1192 (2d Cir. 1988); *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 32 U.S.P.Q.2d 1010, 1015 (2d Cir. 1994) (“Although the style and placement of a generic word may be protected as an element of trade dress, the presence of a generic word alone cannot support an inference of likelihood of confusion in the presence of prominent source identifiers and wholly dissimilar logos.”); *Alchemy II, Inc. v. Yes! Entm’t Corp.*, 844 F. Supp. 560, 30 U.S.P.Q.2d 1770, 1777 (C.D. Cal. 1994); *cf.* *Smithkline Beckman Corp. v. Procter & Gamble Co.*, 591 F. Supp. 1229, 1238, 223

Trademark protection benefits consumers by enabling them to select products on the basis of their origin. This encourages sellers to create and maintain good will by marketing products of reliable quality that consumers associate with their mark. Consumers will not benefit, however, if trademark law prevents competitors from using generic or descriptive terms to inform the public of the nature of their product. . . .

This principle applies equally to a generic component of a trademark.³⁷⁴

Likewise, product or packaging designs must be compared in their entirety even if certain features are functional. However, “[t]he emphasis is . . . properly on the protectable elements or combination of elements.”³⁷⁵

§ 4:10.5 Given Name/Surname

Conflict often occurs where one uses a surname mark and the other uses the same surname with an added given name. Some tribunals have held as a matter of fact that consumers frequently abbreviate a full name to a surname.³⁷⁶ This consumer usage of the dominant portion leads to likelihood of confusion. Conflict was found in these cases:

SAWYER	versus	TOM SAWYER ³⁷⁷
GORDON'S	versus	JAS. GORDON and design ³⁷⁸

U.S.P.Q. 1230, 1236 (N.D.N.Y. 1984) (“Although as a general rule a Court should not dissect a trademark and consider its component parts, when a portion of a trademark is a common or generic term, the Court may consider the common element separately from the unique portion of the trademark”), *aff’d without opinion*, 755 F.2d 914 (2d Cir. 1985). See *Swatch AG v. M.Z. Berger & Co.*, 108 U.S.P.Q.2d 1463 (T.T.A.B. 2013) (“The incorporation of [a generic] term into both parties’ marks is not a sufficient basis for finding likelihood of confusion.”).

374. *Am. Cyanamid Corp. v. Connaught Labs., Inc.*, 800 F.2d 306, 308, 231 U.S.P.Q. 128, 129 (2d Cir. 1986) (*HibVAX v. HIB-IMMUNE*; *HIB generic*).

375. *RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 21 cmt. c, at 230 (1995).

376. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 955 F.2d 1327, 21 U.S.P.Q.2d 1824, 1832 (9th Cir.), *as amended*, 967 F.2d 1280 (1992); *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989); *see Calvin Klein Indus., Inc. v. Calvins Pharm., Inc.*, 8 U.S.P.Q.2d 1269, 1271 (T.T.A.B. 1988) [*CALVIN KLEIN abbreviated CALVIN'S*].

377. *In re Sawyer of Napa, Inc.*, 222 U.S.P.Q. 923, 924 (T.T.A.B. 1983).

378. *Somerset Distilling, Inc. v. Speymalt Whisky Distrib., Ltd.*, 14 U.S.P.Q.2d 1539, 1542 (T.T.A.B. 1989).

2nd Proofs 10/04/17

HOULIHAN'S	versus	MIKE HOULIHAN'S ³⁷⁹
RICCI	versus	VITTORIO RICCI ³⁸⁰
HENNESSY	versus	LESLIE HENNESSY ³⁸¹
GALLO	versus	JOSEPH GALLO ³⁸²
GUCCI	versus	PAOLO GUCCI ³⁸³
GASPAR'S ALE	versus	JOSE GASPER GOLD ³⁸⁴
ARPEL	versus	ADRIEN ARPEL ³⁸⁵
EDELMAN	versus	SAM EDELMAN ³⁸⁶
WINSTON	versus	BRUCE WINSTON ^{386.1}
JOEL GOTT	versus	GOTT ^{386.2}
HANSON	versus	C.H. HANSON ^{386.3}

Confusion may not be as likely where the marks in issue share the same given name (particularly a common one), but have different surnames; the surnames distinguish the marks just as they do people. No conflict was found in the cases of HELENE CURTIS

-
379. *Gilbert/Robinson, Inc. v. Carrie Beverage-Mo., Inc.*, 758 F. Supp. 512, 19 U.S.P.Q.2d 1481, 1486–87 (E.D. Mo. 1991), *aff'd*, 989 F.2d 985, 26 U.S.P.Q.2d 1378 (8th Cir. 1993).
380. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 U.S.P.Q.2d 1901 (Fed. Cir. 1989).
381. *In re Leslie Hennessy, Jr.*, 226 U.S.P.Q. 274, 276 (T.T.A.B. 1985).
382. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 955 F.2d 1327, 21 U.S.P.Q.2d 1824, 1832 (9th Cir.), *amended by* 967 F.2d 1280 (1992).
383. *Gucci v. Gucci Shops, Inc.*, 688 F. Supp. 916, 7 U.S.P.Q.2d 1833 (S.D.N.Y. 1988); *see also Helga, Inc. v. Helga Howie, Inc.*, 182 U.S.P.Q. 629 (T.T.A.B. 1974) (*HELGA v. HELGA HOWIE*); *cf. Miller Brewing Co. v. Premier Beverages, Inc.*, 210 U.S.P.Q. 43, 48–49 (T.T.A.B. 1981) (*MILLER v. O'L BOB MILLER'S*); *Abraham Zion Corp. v. Lebow*, 593 F. Supp. 551, 225 U.S.P.Q. 173, 182 (S.D.N.Y. 1984), *aff'd*, 761 F.2d 93, 226 U.S.P.Q. 104 (2d Cir. 1985).
384. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004).
385. *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 U.S.P.Q.2d 720 (T.T.A.B. 1984).
386. *In re SL&E Training Stable, Inc.*, 88 U.S.P.Q.2d 1216, 2008 WL 4107225 (T.T.A.B. 2008).
- 386.1. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 U.S.P.Q.2d 1419, 1446 (T.T.A.B. 2014).
- 386.2. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 U.S.P.Q.2d 1424 (T.T.A.B. 2013) (wine and water).
- 386.3. *In re C. H. Hanson Co.*, 116 U.S.P.Q.2d 1351 (T.T.A.B. 2015) (both for hand tools).

versus HELENE CAREW,³⁸⁷ and MARY KAY versus MARY COHR.³⁸⁸ Composites of given names and surnames may be deemed confusingly similar, especially if the senior name is well known and long established.^{388.1}

§ 4:10.6 **Marks Suggesting an Association**

“[I]n line extensions into new product categories adaptations of existing brand names are frequently utilized to gain marketing advantages from the goodwill of the established brands.”³⁸⁹ This well-known marketing technique conditions consumers to associate marks used in different ways and contexts with the same source. Therefore, even if the purchaser remembers a mark and perceives differences between it and another, the noncommon portion may, instead of distinguishing the marks, implicitly prompt or reinforce a perception that there is some kind of relationship between the sources designated by the marks. Like any other trademark hypothesis about the likely mental associations of consumers, this one needs to be proved with the facts of the particular case.³⁹⁰ The newcomer’s mark or dress may be seen as a deliberate variation of the senior mark intended to indicate a companion product, a spin-off, a different medium for the same product, or a product line extension—all from the same source.³⁹¹ Such cases

387. *Helene Curtis Indus., Inc. v. Carew Prods., Inc.*, 124 U.S.P.Q. 429 (T.T.A.B. 1960).

388. *Mary Kay Cosmetics, Inc. v. Société Anonyme Laboratoire Rene Guinot*, 217 U.S.P.Q. 975 (T.T.A.B. 1981).

388.1. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 U.S.P.Q.2d 1419, 1447 (T.T.A.B. 2014).

389. *Miles Labs., Inc. v. Naturally Vitamin Supplements, Inc.*, 1 U.S.P.Q.2d 1445, 1451 n.26 (T.T.A.B. 1986).

390. *In re L.C. Licensing, Inc.*, 49 U.S.P.Q.2d 1381 (T.T.A.B. 1998).

391. *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 46 U.S.P.Q.2d 1561, 1565 (9th Cir. 1998) (“[A] perceptive consumer who does notice the ‘e’ and lower-case ‘w’ in Dreamwerks might shrug off the difference as an intentional modification identifying an ancillary division of the same company.”); *Schieffelin & Co. v. Molson Cos. Ltd.*, 9 U.S.P.Q.2d 2069, 2073 (T.T.A.B. 1989) (“Those consumers who do recognize the differences in the marks may believe that applicant’s mark is a variation of opposer’s mark that opposer has adopted for use on a different product.”); *In re Bay State Brewing Co.*, 117 U.S.P.Q.2d 1958, 1966 (T.T.A.B. 2016) (TIME TRAVELER versus TIME TRAVELER BLONDE, both for beer; “the commercial impression engendered by Applicant’s mark is merely that it is the ‘Blonde’ brew of TIME TRAVELER brand beers”); *Home Juice Co. v. Runmlin Cos., Inc.*, 231 U.S.P.Q. 897, 900 (T.T.A.B. 1986) (consumers may “believe, erroneously, that the two products are companion products emanating from the same source”); *In re H&H Prods.*, 228 U.S.P.Q. 771, 772 (T.T.A.B. 1986) (different logos and background designs may be thought to differentiate two product lines from

may raise the issue of reverse confusion.^{391.1} (See section 1:4.3.) Such confusion would be enhanced where a senior user has a series of related marks, and the junior user's mark creates the impression that it is yet another from that series.³⁹² Conflict was found in these cases:

APPLE	versus	PINEAPPLE ³⁹³
SQUIRT	versus	SQUIRT SQUAD ³⁹⁴
JM ORIGINALS	versus	JM COLLECTABLES ³⁹⁵
TIFFANY	versus	CLASSIC TIFFANY ³⁹⁶
ONE A DAY	versus	VIT-A-DAY ³⁹⁷
ANDREA SIMONE	versus	ALSO ANDREA ³⁹⁸
DAN	versus	DAN'ELLE ³⁹⁹

the same source); *cf.* *Stouffer Corp. v. Health Valley Nat. Foods, Inc.*, 1 U.S.P.Q.2d 1900, 1902 (T.T.A.B. 1986) (it is more likely that customers would see the package as “atypical of what they had come to expect”); *cf.* *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1409 and 1411 (T.T.A.B. 1998) (dissent) (re associative connotation of HARD ROCK CAFE and COUNTRY ROCK CAFE); *Sorensen v. WD-40 Co.*, 792 F.3d 712, 727, 115 U.S.P.Q.2d 1128 (7th Cir. 2015) (**see illustration, Appendix A28**).

391.1. *Sorensen*, 792 F.3d at 727.

392. *Jordache Enters., Inc. v. Levi Strauss & Co.*, 841 F. Supp. 506, 30 U.S.P.Q.2d 1721, 1727 (S.D.N.Y. 1993); *see note 255*.

393. *Apple Comput., Inc. v. Formula Int'l, Inc.*, 725 F.2d 521, 526, 221 U.S.P.Q. 762, 766 (9th Cir. 1984) (“One of the possible effects of the use of the prefix may be to suggest that the computer kits are manufactured by licensees or subsidiaries of Apple.”).

394. *SquirtCo. v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 U.S.P.Q. 937, 939 (Fed. Cir. 1983) (“Because of the alliteration with SQUIRT, SQUAD is an apt choice to combine with SQUIRT to suggest a line or group of toys from the same source as SQUIRT balloons”).

395. *In re J.M. Originals, Inc.*, 6 U.S.P.Q.2d 1393, 1394 (T.T.A.B. 1987) (“consumers would be likely to erroneously assume . . . that the two marks simply identify two different lines of clothing from the same source”).

396. *Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 U.S.P.Q.2d 1835, 1841 (T.T.A.B. 1989).

397. *Miles Labs., Inc. v. Naturally Vitamin Supplements, Inc.*, 1 U.S.P.Q.2d 1445, 1451 (T.T.A.B. 1986).

398. *SMS, Inc. v. Byn-Mar, Inc.*, 228 U.S.P.Q. 219, 220 (T.T.A.B. 1985).

399. *Dan River, Inc. v. Apparel Unlimited, Inc.*, 226 U.S.P.Q. 186, 190 (T.T.A.B. 1985) (“It is likely that one familiar with the mark DAN for denim or other materials from which jeans could be made would, upon seeing the mark DAN'ELLE on jeans, particularly jeans for women, believe that the fabric from which those jeans are made and/or the jeans themselves were associated with the source of DAN fabrics”).

THE COMIC STRIP	versus	COMIC STRIP LIVE ⁴⁰⁰
SPREE	versus	SPREE INTERNATIONAL ⁴⁰¹
IMAGE	versus	IMAGE WEST ⁴⁰²
TIA MARIA	versus	TIA LOLA ⁴⁰³
MISS U.S.A.	versus	MRS. U.S.A. ⁴⁰⁴
ACTION CHAIR	versus	ACTION MATES ⁴⁰⁵
A.1	versus	A.2 ⁴⁰⁶
FORMULA 409	versus	FORMULA 999 ⁴⁰⁷
LIZ	versus	LIZSPORT ⁴⁰⁸
PROZAC	versus	HERBROZAC ⁴⁰⁹

-
400. *Comic Strip, Inc. v. Fox Television Stations, Inc.*, 710 F. Supp. 976, 978, 10 U.S.P.Q.2d 1608, 1611 (S.D.N.Y. 1989) (“The likely impression created by the defendant’s mark is that it presents a live telecast from the plaintiffs’ comedy clubs.”).
401. *In re Dolly, Dolly Fashions, Inc.*, 223 U.S.P.Q. 1351, 1352 (T.T.A.B. 1984).
402. *Jay-Zee, Inc. v. Hartfield-Zoodys, Inc.*, 207 U.S.P.Q. 269, 272 (T.T.A.B. 1980) (“IMAGE WEST lends itself to misinterpretation as a variation of petitioner’s mark denoting clothing from the same source but with a somewhat different slant to the style”).
403. *United Rum Merchs. Ltd. v. Fregal, Inc.*, 216 U.S.P.Q. 217, 220 (T.T.A.B. 1982).
404. *Miss Universe, Inc. v. Pitts*, 714 F. Supp. 209, 14 U.S.P.Q.2d 2004, 2010 (W.D. La. 1989) (reasonable for consumer to assume MRS. USA is an “offshoot” of MISS USA); *Miss Universe, Inc. v. Little Miss U.S.A., Inc.*, 212 U.S.P.Q. 425, 431 (N.D. Ga. 1981).
405. *Herman Miller, Inc. v. Lane Co.*, 221 U.S.P.Q. 922, 924 (T.T.A.B. 1984) (ACTION MATE strongly suggests two-of-a-kind).
406. *Nabisco Brands, Inc. v. Kaye*, 760 F. Supp. 25, 27, 19 U.S.P.Q.2d 1465, 1466 (D. Conn. 1991) (“the use of the numeral ‘2’ as opposed to the numeral ‘1’ rather than differentiate the product, in fact, increases the likelihood that consumers will believe that the defendant’s product is simply a variation on the basic ‘A.1’ sauce or a line extension”).
407. *Clorox Co. v. State Chem. Mfg. Co.*, 197 U.S.P.Q. 840 (T.T.A.B. 1977); *cf. Paddington Corp. v. Attiki Imps. & Distrib., Inc.*, 996 F.2d 577, 27 U.S.P.Q.2d 1189, 1197 (2d Cir. 1993) (common practice in the industry to use numeric designations) (see illustration, Appendix A5).
408. *In re L.C. Licensing, Inc.*, 49 U.S.P.Q.2d 1379 (T.T.A.B. 1998).
409. *Eli Lilly v. Nat. Answers*, 233 F.3d 456, 462, 56 U.S.P.Q.2d 1942 (7th Cir. 2000) (“the district court received evidence that other pharmaceutical companies have expanded their product lines to include dietary supplements based on ‘St. John’s Wort’ (the principal herbal component of HERBROZAC), increasing the likelihood that consumers would mistakenly believe that HERBROZAC is affiliated with or sponsored by Lilly”).

AUTOZONE versus OIL ZONE and WASH
ZONE⁴¹⁰

§ 4:10.7 Marks with Source Modifiers

Often where a newcomer uses the preposition “by . . .” and a source modifier after the common portion of the mark, conflict is found due to the suggestion that the newcomer is an authorized agent or affiliate of the prior user. The addition becomes “an aggravation and not a justification.”⁴¹¹ Conflict was found in these cases:

FOLIO	versus	FOLIO BY FIRE ISLANDER ⁴¹²
SPARKS	versus	SPARKS by sassafras ⁴¹³
COBBIES	versus	COBBIES by Cos Cob ⁴¹⁴
KANGAROO	versus	KANGAROO BY DENNISON ⁴¹⁵
CROSS	versus	LA CROSSE BY BRADLEY ⁴¹⁶
CACHET	versus	LE CACHET DE DIOR ⁴¹⁷

410. *AutoZone, Inc. v. Strick*, 543 F.3d 923, 930, 88 U.S.P.Q.2d 1225 (7th Cir. 2008) (“prominent similarities between the marks may very well lead a consumer . . . to believe . . . that OIL ZONE and WASH ZONE represented AutoZone’s entry into the oil-change and car wash services market”) (reversing summary judgment of noninfringement).

411. *Menendez v. Holt*, 128 U.S. 514, 521 (1888).

412. *Saks & Co. v. TFM Indus., Inc.*, 5 U.S.P.Q.2d 1762, 1764 (T.T.A.B. 1987) (“the use of the phrase BY FIRE ISLANDER may only tend to increase and not decrease the likelihood of confusion”), citing *Du Barry v. Hudnut*, 323 F.2d 986, 139 U.S.P.Q. 112 (9th Cir. 1963).

413. *In re Apparel Ventures, Inc.*, 229 U.S.P.Q. 225, 226 (T.T.A.B. 1986) (“Those already familiar with registrant’s use of its mark in connection with its goods, upon encountering applicant’s mark on applicant’s goods, could easily assume that ‘sassafras’ is some sort of house mark that may be used with only some of the SPARKS goods. Conversely, those familiar with only applicant’s mark would, upon encountering the registered mark on related goods, assume that all SPARKS products come from a single source, and that that source was in some instances further identified with the words ‘by sassafras.’”).

414. *U.S. Shoe Corp. v. Oxford Indus., Inc.*, 165 U.S.P.Q. 86 (T.T.A.B. 1970).

415. *In re Dennison Mfg. Co.*, 220 U.S.P.Q. 1015, 1016 (T.T.A.B. 1983).

416. *A.T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692, 176 U.S.P.Q. 15 (2d Cir. 1972) (“Addition of the words ‘by Bradley’ does not save the day; a purchaser could well think plaintiff had licensed defendant.”).

417. *In re Christian Dior, S.A.*, 225 U.S.P.Q. 533 (T.T.A.B. 1985).

REGENTS IN HYDE PARK	versus	REGENTS PARK OF BARRINGTON ⁴¹⁸
THE BREAKERS	versus	THE BREAKERS OF FORT LAUDERDALE ⁴¹⁹
CORAZON	versus	CORAZON BY CHICA ⁴²⁰

On the other hand, if the common portion is weak (perhaps, having a descriptive connotation), then addition of the source modifier may suffice to avoid conflict, as in the case of HEATHERKNIT versus HEATHERNIT BY ROOSTER.⁴²¹

§ 4:10.8 **Marks with Geographic Modifiers**

For the same reasons, the addition of common geographic terms does not ordinarily distinguish otherwise distinctive and similar marks.⁴²² Conflict was found in the following cases:

MASTER JEWELER'S COLLECTION	versus	JEWELMASTERS Palm Beach ⁴²³
CONCEPT	versus	CALIFORNIA CONCEPT ⁴²⁴
CHIC	versus	L.A. CHIC ⁴²⁵
COLLEGIENNE	versus	COLLEGIAN OF CALIFORNIA ⁴²⁶
HEALTH NET	versus	U.S.A. HEALTHNET ⁴²⁷

418. Clinton Co. v. Health Quest Mgmt. Corp., 1986 WL 405, 230 U.S.P.Q. 865 (N.D. Ill. 1986).

419. Breakers of Palm Beach, Inc. v. Int'l Beach Hotel Dev., Inc., 824 F. Supp. 1576, 28 U.S.P.Q.2d 1606 (S.D. Fla. 1993).

420. *In re Chica, Inc.*, 84 U.S.P.Q.2d 1845 (T.T.A.B. 2007).

421. Joseph & Feiss Co. v. Rooster, Inc., 174 U.S.P.Q. 255 (T.T.A.B. 1972).

422. Birthright v. Birthright, Inc., 827 F. Supp. 1114, 29 U.S.P.Q.2d 1081, 1095 (D.N.J. 1993), citing cases.

423. *In re Jewelmasters, Inc.*, 221 U.S.P.Q. 90, 91 (T.T.A.B. 1983).

424. Wella Corp. v. Cal. Concept Corp., 558 F.2d 1019, 194 U.S.P.Q. 419, 422 (C.C.P.A. 1977).

425. Henry I. Siegel Co. v. M&R Int'l Mfg. Co., 4 U.S.P.Q.2d 1154, 1160 (T.T.A.B. 1987) ("purchasers familiar with petitioner's mark CHIC are likely to assume . . . that the mark L.A. CHIC is simply a variation of petitioner's mark CHIC used to designate a particular line of clothing made by petitioner in Los Angeles, California or being of the style prevalent there").

426. *In re Collegian Sportswear, Inc.*, 224 U.S.P.Q. 174, 176 (T.T.A.B. 1984).

427. Health Net v. U.S.A. Healthnet, Inc., 26 U.S.P.Q.2d 1187, 1193 (C.D. Cal. 1993) ("the mere addition of the geographic qualification 'USA' does little to affect the suggested meaning").

2nd Proofs 10/04/17

LIBERTY OF LONDON	versus	LIBERTY ⁴²⁸
INTERNATIONAL KENNEL CLUB OF CHICAGO	versus	INTERNATIONAL KENNEL CLUB ⁴²⁹

There is no flat rule, of course. Conflict was not found in the case of INC versus MANHATTAN, INC., where the addition of a geographic term created a striking or unusual mark when viewed as a whole. Nor was conflict found in the case of HORIZON MOTOR INN versus LAKE TAHOE HORIZON, where HORIZON was proved to be commonly used and weak in the field.⁴³⁰

§ 4:11 Reversal of Elements

Because of consumers' fallible recall, reversal of the elements of a mark may not avoid likelihood of confusion if substantially the same commercial impression is made. Confusion is less likely where the senior mark is comparatively weak. No conflict was found in the following cases: TOUCH 'O SILK versus SILKY TOUCH,⁴³¹ JEWELERS' BEST versus BEST JEWELRY.⁴³² Conflict was found in the following cases: BUST RUST versus RUST BUSTER,⁴³³ BANKAMERICA versus AMERIBANC.⁴³⁴

§ 4:12 The Familiar Versus the Unfamiliar

It is said that there is no confusing similarity between a familiar, common term and an uncommon, unfamiliar one, because the mind has little difficulty differentiating them. One recognizes instantly that which is familiar.⁴³⁵ Conversely, that which is unfamiliar requires

-
428. Liberty & Co., Ltd. v. Liberty Trouser Co., 216 U.S.P.Q. 65, 68 (T.T.A.B. 1982).
429. Int'l Kennel Club of Chi., Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1088, 6 U.S.P.Q.2d 1977, 1984 (7th Cir. 1988), citing cases.
430. Inc. Publ'g Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 227 U.S.P.Q. 257, 264 (S.D.N.Y. 1985), *aff'd without opinion*, 788 F.2d 3 (2d Cir. 1986); Sidco Indus., Inc. v. Wimar Tahoe Corp., 795 F. Supp. 343, 24 U.S.P.Q.2d 1212 (D. Or. 1992).
431. *In re Akzona, Inc.*, 219 U.S.P.Q. 94, 95-96 (T.T.A.B. 1983).
432. *In re Best Prods. Co.*, 231 U.S.P.Q. 988, 989 (T.T.A.B. 1986).
433. *In re Nationwide Indus., Inc.*, 6 U.S.P.Q.2d 1882, 1884 (T.T.A.B. 1988).
434. Bank of Am. Nat'l Tr. & Sav. Ass'n v. Am. Nat'l Bank of St. Joseph, 201 U.S.P.Q. 842, 845 (T.T.A.B. 1978) (citing cases); TMEP 1207.01(b)(vii) [2009].
435. One must prove that an allegedly familiar term is in fact commonly known. E.I. du Pont de Nemours & Co. v. Sunlyra Int'l, Inc., 35 U.S.P.Q.2d 1787, 1789 (T.T.A.B. 1995).

closer scrutiny and in this way is distinguished. In some cases, the contrast is one between a mark which is a word with dictionary meaning and another mark which, being coined, has no meaning except as a mark. No conflict was found in these cases:

BOSTON TEA PARTY	versus	BOSTON SEA PARTY ⁴³⁶
SUBARU	versus	SUPRA ⁴³⁷
PAYOT	versus	PEYOTE ⁴³⁸
BABE	versus	BABOR ⁴³⁹
AMERICAN	versus	AMERCO ⁴⁴⁰
GULP	versus	GULPY ⁴⁴¹
ALLEGIS	versus	ALLEGIANCE STAFFING ^{441.1}
MAYA	versus	MAYARI ^{441.2}

The familiarity of a mark may be due to its fame, thus paradoxically reducing likelihood of confusion where the other mark is unfamiliar.⁴⁴² (See section 3:2.)

§ 4:13 Parody

In cases of trademark parody, there is, by definition, “a need to evoke the original work being parodied.”⁴⁴³ A successful parody

436. *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982).

437. *Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha*, 228 U.S.P.Q. 672, 675 (T.T.A.B. 1985).

438. *Laboratoires du Dr. N.G. Payot Etablissement v. Sw. Classics Collection Ltd.*, 3 U.S.P.Q.2d 1600, 1606 (T.T.A.B. 1987).

439. *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 U.S.P.Q. 848, 851 (T.T.A.B. 1983).

440. *Amoco Oil Co. v. Amerco, Inc.*, 192 U.S.P.Q. 729, 734 (T.T.A.B. 1976), citing *Nat’l Distillers & Chem. Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 U.S.P.Q. 34, 35 (C.C.P.A. 1974) (*DUVET v. DUET*).

441. *7-Eleven v. Wechsler*, 83 U.S.P.Q.2d 1715 (T.T.A.B. 2007).

441.1. *In re Allegiance Staffing*, 115 U.S.P.Q.2d 1319 (T.T.A.B. 2015).

441.2. *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 U.S.P.Q.2d 1286 (Fed. Cir. 2016) (*MAYA* versus *MAYARI*, both for wines, not confusingly similar).

442. *See Girl Scouts of U.S. of Am. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 808 F. Supp. 1112, 25 U.S.P.Q.2d 1737, 1745 (S.D.N.Y. 1992), *aff’d*, 996 F.2d 1477, 27 U.S.P.Q.2d 1316 (2d Cir. 1993), citing *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 729, 6 U.S.P.Q.2d 1719 (Fed. Cir. 1988).

443. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495, 12 U.S.P.Q.2d 1289, 1293 (2d Cir. 1989) (*CLIFFS NOTES v. SPY NOTES*); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 37

actually avoids or decreases likelihood of confusion because the effect is to create or highlight a clear distinction between the parody and the true mark; the first calls the other to mind without confusion.⁴⁴⁴ However, the two messages must be conveyed “simultaneously,”⁴⁴⁵ and use of words in a humorous or parodic manner is not permitted if it is likely to cause confusion.⁴⁴⁶

The public interest in avoiding consumer confusion (as well as the trademark owner’s interest in its goodwill) must be balanced with the public interest in free expression.⁴⁴⁷ Non-confusing trademark parody is lawful because there is no monopoly or right in gross to a mark or the public’s “penumbral” awareness of it.⁴⁴⁸ (See section 8:4.4.)

-
- U.S.P.Q.2d 1516, 1519 (2d Cir. 1996); *N.Y. Stock Exch. v. N.Y., N.Y. Hotel*, 293 F.3d 550, 62 U.S.P.Q.2d 1250 (2d Cir. 2002); *Jordache Enters., Inc. v. Hogg Wyld Ltd.*, 828 F.2d 1482, 1486, 4 U.S.P.Q.2d 1216, 1219 (10th Cir. 1987) (“no parody could be made without the initial mark”).
444. *Universal City Studios, Inc. v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 230 U.S.P.Q. 23, 28 (S.D.N.Y. 1986) (MIAMI VICE/MIAMI MICE); *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 116, 223 U.S.P.Q. 1000, 1003 (2d Cir. 1984) (“the fact that Donkey Kong so obviously parodies the King Kong theme strongly contributes to dispelling confusion on the part of consumers”); *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785, 217 U.S.P.Q. 1128, 1133–34 (E.D.N.Y. 1983).
445. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 60 U.S.P.Q.2d 1109, 1114 (4th Cir. 2001) (Internet domain name).
446. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 31 U.S.P.Q.2d 1296 (8th Cir. 1994); *Columbia Pictures Indus., Inc. v. Miller*, 211 U.S.P.Q. 816, 820 (T.T.A.B. 1981) (opposition sustained; CLOSE ENCOUNTERS v. CLOTHES ENCOUNTERS; marks “conjure up the same thing since one is an obvious play on the other”); *Bos. Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 1592 (T.T.A.B. 2008) (“Parody is not a defense if the marks would otherwise be considered confusingly similar.”); TMEP 1207.01(b)(x) (2009).
447. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 12 U.S.P.Q.2d 1289, 1292 (2d Cir. 1989); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 1 U.S.P.Q.2d 1753, 1755, 1759 (1st Cir. 1987) (trademark dilution); *see Eli Lilly v. Nat. Answers*, 233 F.3d 456, 463, 56 U.S.P.Q.2d 1942 (7th Cir. 2000) (“even if a junior mark meets the definition of a parody, it still runs afoul of the trademark laws if it is likely to confuse consumers”).
448. *Jordache Enters., Inc. v. Hogg Wyld Ltd.*, 625 F. Supp. 48, 227 U.S.P.Q. 794, 799 (D.N.M. 1985), *aff’d*, 828 F.2d 1482, 4 U.S.P.Q.2d 1216 (10th Cir. 1987); *Am. Express Co. v. Payless Cashways, Inc.*, 222 U.S.P.Q. 907, 909 (T.T.A.B. 1984) (DON’T LEAVE HOME WITHOUT IT v. DON’T DO-IT-YOURSELF WITHOUT US).

§ 4:14 Combining Complainant's Marks

Sometimes a junior user's mark includes elements found in *two* of the senior user's marks, albeit those two are entirely different from one another. To be considered together and compared in combination to the junior user's mark, the senior user's marks must be used conjointly and in such a manner that they have come to be associated by the relevant public. Otherwise, the marks at issue must be compared to one another separately.⁴⁴⁹ No conflict was found in the following cases:

PROFESSIONAL and POWER HANDLE for lawnmowers and mower motors	versus	POW-R-PRO for power lawnmowers ⁴⁵⁰
FASHION TAN and ALO-FACE for skin care items	versus	FACIAL FASHIONS for cosmetics ⁴⁵¹
MISTY and ROTO-POWER for agricultural sprayers and dusters	versus	ROTOMIST for agricultural spraying and dusting machines ⁴⁵²

449. W. Union Tel. Co. v. Graphnet Sys., Inc., 204 U.S.P.Q. 971, 975 (T.T.A.B. 1979); see *Hart Schaffner & Marx v. Marks, Ltd.*, 229 U.S.P.Q. 544, 546 (T.T.A.B. 1986) (noting “nothing inherent in these marks themselves” to suggest an association).

450. *Toro Mfg. Corp. v. Kearney-Nat'l, Inc.*, 168 U.S.P.Q. 383 (T.T.A.B. 1970), *aff'd*, 480 F.2d 905, 178 U.S.P.Q. 406 (C.C.P.A. 1973) (opposition dismissed).

451. *Aloe Creme Labs., Inc. v. Johnson Prods. Co.*, 183 U.S.P.Q. 447 (T.T.A.B. 1974) (opposition dismissed).

452. *H.D. Hudson Mfg. Co. v. Food Mach. & Chem. Corp.*, 230 F.2d 445, 109 U.S.P.Q. 48 (C.C.P.A. 1956) (opposition dismissed).

Conflict was found in the following cases:

UNIVAC and REMINGTON for data processing and transmission equipment	versus	REMVAC for electronic telemetering and control apparatus, ⁴⁵³
DR. SCHOLL'S and AIR-PILLO for footwear insoles	versus	DR. AIR for footwear insoles. ⁴⁵⁴

-
453. Sperry Rand Corp. v. Remvac Sys. Corp., 172 U.S.P.Q. 415 (T.T.A.B. 1971) (registration refused).
454. Schering-Plough HealthCare Prods., Inc. v. Ing-Jing Huang, 84 U.S.P.Q.2d 1323 (T.T.A.B. 2007) (citing cases) (applicant failed to prove third-party use of AIR and DR. marks for relevant goods).

2nd Proofs 10/04/17

2nd Proofs 10/04/17