

**This Opinion is Not a
Precedent of the TTAB**

Mailed: January 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Don Calder
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Serial No. 85143799
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Thomas D. Foster of TDFoster – Intellectual Property Law,
for Don Calder.

Geoffrey Fosdick, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

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Before Kuhlke, Greenbaum and Hightower,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Don Calder (“Applicant”) seeks registration on the Principal Register of the mark CALIFORNIA REPUBLIC (in standard characters, CALIFORNIA disclaimed) for goods ultimately identified as

Men's and women's shoes, pants, jeans, hooded
sweatshirts, tanks, T-shirts, socks, woven shirts, hats,
jackets, shorts, and belts in International Class 25.¹

¹ Application Serial No. 85143799 was filed on October 2, 2010, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when applied to Applicant's goods, so resembles the previously registered mark, displayed on the right, for "Hats; Jackets; Pants; Sandals; Shoes; Shorts; Uppers for Japanese style sandals" in International Class 25, as to be likely to cause confusion, mistake or deception.²



After the Examining Attorney made the refusal final, Applicant appealed to this Board. We reverse the refusal to register.

I. Applicable Law

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Drilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

² Registration No. 4181631, issued July 31, 2012. The registration includes a disclaimer of CALIFORNIA, the following stippling statement: "The stippling is a feature of the mark and does not indicate color. The stippling is for shading purposes only," and the following description of the mark: "The mark consists of a bear as human figure holding a board. There is a star at the top and the stylized text 'Republik of Kalifornia' appears below."

A. Relatedness of the Goods, Channels of Trade and Classes of Purchasers

We begin with the *du Pont* factor of the relatedness of the goods. We base our evaluation on the goods as they are identified in the registration and application. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

There is no dispute that the goods are identical in part; both Applicant's and Registrant's identifications include "hats," "jackets," "pants," "shoes" and "shorts." It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

In addition, because the goods are identical in-part, the channels of trade and classes of purchasers for those goods are considered to be the same. See *Stone Lion*, 110 USPQ2d at 1161; *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (the Board may rely on this legal presumption in determining likelihood of confusion); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.").

The similarity between the goods, channels of trade and purchasers are factors that weigh in favor of a finding of likelihood of confusion.

B. The Similarities and Dissimilarities Between the Marks

Despite the overlap in the identifications of goods, we find that confusion is not likely because of the crucial differences between the marks. In comparing the marks, we recognize that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, Registrant's mark features the design of a large bear holding a surf board above the much smaller designation, REPUBLIK OF KALIFORNIA. In terms of appearance, it is the design element, rather than the words, that dominates Registrant's mark. The bear design is much larger than the words REPUBLIK OF KALIFORNIA, and it is by far the most visually significant part of the mark.

We note the Examining Attorney’s argument that the words REPUBLIK OF KALIFORNIA are the dominant feature in Registrant’s mark because the literal portion of a word and design mark generally makes the greatest impact on a

prospective customer, and his further argument that, because of the similarity of the words REPUBLIK OF KALIFORNIA and CALIFORNIA REPUBLIC, the marks are confusingly similar. While it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case. *See, e.g., Viterra*, 101 USPQ2d at 1911; *In re Covalinski*, 113 USPQ2d 1166, 68-69 (TTAB 2014), and cases cited therein. In this case, due to the large size of the design element, we find that the design and wording REPUBLIK OF KALIFORNIA work together to create the overall commercial impression described below as a former Soviet state, such that the wording does not dominate the design. Moreover, to the extent Applicant's and Registrant's goods are articles of clothing, "consumers would be likely to encounter the mark in a retail setting on hang tags or neck labels. In that context the visual impression of the mark is likely to be more important." *Covalinski*, 113 USPQ2d at 1168.

We agree with the Examining Attorney that the marks are similar to the extent that the components of the literal elements sound the same. However, the order in which those terms appear, as well as Registrant's use of the letter "K" as a substitute for the letter "C" in the words "Republic" and "California," result in marks that differ in appearance and connotation; the literal portion of Registrant's mark calls to mind states of the former Soviet Union, while Applicant's mark does not.

For the reasons discussed above, we find that the overall commercial impression of Registrant's mark is heavily influenced by its design features, particularly the

large bear holding a surf board, that the wording REPUBLIK OF KALIFORNIA and CALIFORNIA REPUBLIC convey different commercial impressions, and that this weighs heavily against a conclusion that confusion is likely.

The authority is legion that “when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)). However, Applicant’s mark is so different from Registrant’s mark that even when used on in-part identical goods, confusion is unlikely. “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *Mighty Leaf*, 94 USPQ2d at 1259.

In sum, we find the first *du Pont* factor, the differences between the marks, to outweigh the other factors. *See Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.”).

Decision: The refusal to register Applicant’s mark CALIFORNIA REPUBLIC is reversed.