

This Opinion is not a  
Precedent of the TTAB

Mailed: July 24, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Critelli*  
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Serial No. 86445003  
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Bernhard P. Molldrem, Jr. of Law Office of Bernhard Molldrem,  
for Ernest J. Critelli, DBA Lava Gear.

Kyle Christopher Peete, Trademark Examining Attorney, Law Office 112,  
Angela Wilson, Managing Attorney.

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Before Cataldo, Goodman and Larkin,  
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Ernest J. Critelli, DBA Lava Gear (“Applicant”) seeks registration on the Principal  
Register of the mark LAVA GEAR (in standard characters) for

outdoor survival wear, namely, jackets and pants for  
extended periods of use outdoors in extreme cold weather  
in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 86445003 was filed on November 5, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. “Gear” is disclaimed.

The Trademark 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 so resembles the previously registered mark LAVA ACCESSORIES (standard characters) for "scarfs; travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf,"<sup>2</sup> in International Class 25, as to be likely to cause confusion, mistake, or deceive.

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

### **I. Section 2(d) Analysis**

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA

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In this decision, page references to the application record refer to the .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs refer to the Board's TTABVue docket system.

<sup>2</sup> Registration No. 4458714, issued December 31, 2013. "Accessories" is disclaimed.

In the February 27, 2015 Office Action p.1 the Examining Attorney also cited Registrant's Registration No. 4435257 for the mark LAVA ACCESSORIES for "scarves" as a bar to registration and, as a potential bar, prior pending application Serial No. 86408977 for the mark LAVA BRAND. In the April 12, 2016 Office Action p.1 the Examining Attorney noted the abandonment of the prior pending application and limited the Section 2(d) refusal to Registration No. 4458714.

1976). These factors, and the other relevant *du Pont* factors now before us, are discussed below. The other *du Pont* factors, for which no argument or evidence was presented, we treat as neutral.

**A. The similarities or dissimilarities between the marks**

We turn first to a comparison of the marks. We compare the marks “in their entireties as to appearance, sound, connotation and commercial impression” to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The 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). In reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). It is well-established that prospective consumers are often more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay*, 73 USPQ2d at 1692; *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB

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”).

Applicant's mark is LAVA GEAR (GEAR disclaimed) in standard characters, and the cited mark is LAVA ACCESSORIES (ACCESSORIES disclaimed) in standard characters. Applicant's mark is similar in construction to the cited mark. Each mark is composed of two terms, beginning with the same first word LAVA followed by a word which is descriptive of the identified goods and disclaimed. Disclaimed matter generally will not constitute the dominant part of a mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat'l Data Corp.*, 224 USPQ at 752); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). Thus, LAVA is both the first word and the dominant, source-identifying element of each mark and it is therefore more likely that prospective consumers will focus on this term more than the secondary, descriptive wording in each mark. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Viewed in their entirety with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical”).

The marks are similar in appearance and sound in that the word “LAVA” is the first word in each mark. There is no evidence that “lava” has any significance in connection with the goods in question. Rather, “lava” appears arbitrary as applied to the goods in the cited registration and, at worst, incongruous as applied to Applicant's cold weather gear. This non-descriptive word plays a significant role in determining

the connotation, and hence the commercial impression, each mark has. The second word in Applicant's mark is "GEAR," whereas the second word in the cited mark is "ACCESSORIES." While the terms "GEAR" and "ACCESSORIES" clearly differ in appearance and sound, they are somewhat similar in meaning. As the Examining Attorney points out, "Accessory" is defined as "a small article or item of clothing carried or worn to complement a garment or outfit."<sup>3</sup> (April 12, 2016 Office Action p. 5). "Gear" is defined as (informal) clothing, especially of a specified kind. (April 12, 2016 Office Action p. 2). Although there may be differences in meaning between "Accessory" and "Gear," we find the connotations are closely related and complementary, both pointing to clothing and accessories that may be used together and emanating from a common source. Likewise, we find the overall commercial impression of the marks is more similar than dissimilar.

Considering the marks in their entireties based on these findings, we conclude that the marks are more similar than dissimilar, and that this *Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

#### **B. Number and Nature of Similar Marks in Use on Similar Goods**

Applicant argues that the shared term "LAVA" is commercially weak and that consumers will recognize subtle differences between the marks due to the number and nature of similar marks in use on similar goods. In this regard, Applicant

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<sup>3</sup> In its July 20, 2015 Response to Office Action p. 5, Applicant provided the following definition for "accessory": "something added to something else to make it more useful, attractive or effective (fashion/clothing accessories such as scarves, handkerchiefs, bracelets and rings)." [Learnersdictionary.com](http://Learnersdictionary.com).

submitted three use-based registrations that contain the term “LAVA” and are registered for clothing: LAVA JUNKIE (Registration No. 4526319); the composite



mark (Registration No. 4651903); and LAVA HURTS (Registration No. 3666647).<sup>4</sup>

Evidence of extensive registration and use of a term by others can be “powerful” evidence of weakness. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). However, a handful of use-based registrations showing registration of a term is not very availing, especially in the absence of any evidence of the actual use of the registered marks. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). In *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record, *see* 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n. 2. We find this *du Pont* factor to be neutral.

### **C. Relatedness of the Goods, Their Channels of Trade and Consumers**

We now turn to the *du Pont* factor regarding the relatedness of the goods. We base our evaluation on the goods as they are identified in the application and the cited

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<sup>4</sup> July 20, 2015 Response pp. 8-10. Registration No. 3666647 cancelled on March 18, 2016.

registration. *Stone Lion Capital Partners*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Houston Computers Servs. 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, 1004 (Fed. Cir. 2002).

The Examining Attorney argues that the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in Registrant's "more narrow identification." (6 TTABVUE 12). The Examining Attorney submits that the "Registration (may be read as): Outdoor survival wear, namely, travel clothing contained in a package comprising reversible jackets, pants for extended periods of use outdoors in extreme cold weather" and contends that "[n]othing in the registration precludes the registered goods from being for "use outdoors in extreme cold weather." (*Id.* 11-12).

Applicant, on the other hand, argues "that the goods do not compete, and are not sold to the same customers nor purchased for the same or related purposes." (4 TTABVUE 4). Applicant submits that Registrant's goods are "either fashion accessories or a package of travel clothing that is sold with a fashion accessory (namely a belt or scarf) as a characterizing component of the package" while Applicant's goods are "survival gear, that is, outdoor survival wear, i.e., extreme-cold-weather jackets and pants, intended to allow the wearer to be able to spend extended periods of time outdoors in the extreme cold weather." (*Id.*).

When analyzing the similarity of the goods, "it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of

confusion.” *Coach Servs.*, 101 USPQ2d at 1722 (citation omitted). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *Id.*

We find that the Examining Attorney has failed to establish that Applicant’s goods and Registrant’s goods are similar or related in any way which would result in source confusion, even when marketed under similar marks. Although the Examining Attorney contends that outdoor survival wear could include travel clothing and that travel clothing such as Registrant’s could be for use outdoors in extreme cold weather, there is no evidence to support these contentions. Nor is there evidence that Applicant’s goods and Registrant’s goods are of a type which may emanate from a single source. Absent any evidence to show that these goods are related, we simply cannot draw the inference suggested by the Examining Attorney. The terminology of the identifications of goods, standing alone in the present case, is an insufficient basis upon which to conclude that the goods are related for purposes of our analysis.

Because there is insufficient evidence that Applicant’s goods are related to the goods identified in the cited registration, there is no presumption that these goods travel in common trade channels and are marketed to the same consumers, and there is no evidence that these goods are sold in the same channels of trade to the same consumers. While extreme cold weather gear on the one hand and travel clothing on the other may possibly be purchased by the same consumers at some point, there is no evidence in the record to support a finding that the goods typically emanate from

the same source. *Sports Authority Michigan Inc. v. PC Authority*, 63 USPQ2d 1782, 1793-94 (TTAB 2002).

## II. Conclusion

In sum, we find that there is no likelihood of confusion. On this record, Applicant's goods and Registrant's goods do not appear to be sufficiently related for any confusion to be likely, even when marketed under similar marks.<sup>5</sup>

**Decision:** The Section 2(d) refusal to register Applicant's mark LAVA GEAR is reversed.

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<sup>5</sup> In reaching our decision on likelihood of confusion we have not relied upon Applicant's arguments that customers of its clothing are "careful" and "selective." There is no evidence of record to support his contention, but even if that were the case, it is settled that even sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Accordingly, we find this *du Pont* factor neutral.