

This Opinion is Not a  
Precedent of the TTAB

Hearing: August 20, 2019

Mailed: September 26, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Inventive, LLC*

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Serial No. 86796893

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Charles R. Clark for Inventive, LLC.

Deborah E. Lobo, Trademark Examining Attorney, Law Office 109,  
Michael Kazazian, Managing Attorney.

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Before Lynch, Larkin, and Hudis,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Inventive, LLC (“Applicant”) seeks registration on the Principal Register of the  
mark shown below



for “fishing tackle hand tools, namely, fishing pliers and fishing knives,” in  
International Class 8; “fishing measuring tapes; fishing sinker size measuring  
gauges,” in International Class 9; “athletic apparel, namely, shirts, jackets, hats and

caps; baseball caps and hats; button down shirts; fishing shirts; fishing vests; hats; hooded pullovers; hooded sweat shirts; knit shirts; polo shirts; shirts; short-sleeved or long-sleeved t-shirts; sports caps and hats; sweat bands; sweat shirts; tank tops; wind shirts,” in International Class 25; and “fish hook removal tools; fishing rod holders; fishing rod racks; fishing tackle; fishing tackle bags; fishing tackle boxes; fishing tackle containers,” in International Class 28.<sup>1</sup> Applicant describes its mark as a “stylized three-segment arched fin over italicized ‘FISH FIGHTER.’” Color is not claimed as a feature of the mark. Applicant has disclaimed the exclusive right to use FISH apart from the mark as shown.

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the mark so resembles the registered mark shown below



for “sweaters; shirts; socks; stockings; gloves; mittens; bandanas; neckerchiefs; mufflers; thermal supporters, namely, thermal arm warmers, hand warmers, knee warmers, leg warmers, and insulated vests; hats; caps; headwear; coats; neckties; ear muffs; anoraks; waistbands; belts; footwear; footwear for sports; clothing for fishing,

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<sup>1</sup> Application Serial No. 86796893 was filed on October 22, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. When the application was filed, it also contained goods in International Class 6, but it was subsequently divided and the Class 6 goods were placed in a divisional application.

namely, fishing vests, fishing waders, fishing caps, fishing hats, fishing jackets, fishing shirts, fishing suits, fishing sweaters and thermal underwear for fishing; footwear for fishing,” in International Class 25, and “fishing tackle; fishing gloves,” in International Class 28,<sup>2</sup> as to be likely, when used on or in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive. The registrant describes its mark as “consist[ing] of a Wrestling mask featuring a stylized letter ‘f’ on the forehead portion and in between the words ‘fishing’ in stylized letters on the left side of the mask and the word ‘fighters’ in stylized letters on the right side of the mask.” Color is not claimed as a feature of the mark. The registrant has disclaimed the exclusive right to use FISHING apart from the mark as shown.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, 4 TTABVUE,<sup>3</sup> which was denied. 5 TTABVUE.<sup>4</sup> The appeal is fully briefed, and counsel for Applicant and the Examining Attorney appeared at an oral hearing before the panel. We affirm the refusal to register.

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<sup>2</sup> The cited Registration No. 4766395 issued on July 7, 2015.

<sup>3</sup> Citations in this opinion to the briefs and the reconsideration request refer to TTABVUE, the Board’s online docketing system. *Turbin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

<sup>4</sup> After the request for reconsideration was denied, Applicant moved to add the goods in Class 9 to its appeal, 8 TTABVUE 3-4, acknowledging that an “appeal fee is required for each class that is brought by applicant on appeal.” *Id.* at 4. In a subsequent order, the Board noted that the Class 9 fee had not been paid, and allowed Applicant 20 days to submit it. 10 TTABVUE 1 n.1. Applicant never did so, and the final refusal as to Class 9 is thus not before us.

## I. Record on Appeal<sup>5</sup>

The record on appeal includes the following:

1. Dictionary definitions of “fish” and “fighter,” made of record by the Examining Attorney,<sup>6</sup> and of “fishing,” “fish,” and “fishing tackle,” made of record by Applicant;<sup>7</sup>
2. Pages from the USPTO’s Trademark Electronic Search System (“TESS”) database regarding third-party registrations of, and applications to register, various FISHING-, FISH-, and FIGHT-formative marks for shirts, hats, caps, or gloves, and FISH- and FIGHT-formative marks for fishing equipment, made of record by Applicant;<sup>8</sup>
3. Internet webpages displaying and offering for sale various forms of fishing tackle, including fishing pliers and knives, and various clothing items, made of record by the Examining Attorney;<sup>9</sup> and

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<sup>5</sup> Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

<sup>6</sup> February 11, 2016 Office Action at TSDR 2-4 (MACMILLAN DICTIONARY (macmillandictionary.com)); April 10, 2017 Office Action at TSDR 2-7 (COLLINS DICTIONARY (collinsdictionary.com)).

<sup>7</sup> 4 TTABVUE 33-36 (March 8, 2017 Request for Reconsideration) (MACMILLAN DICTIONARY (macmillandictionary.com)); October 10, 2017 Response to Office Action at TSDR 104-107.

<sup>8</sup> August 11, 2016 Response to Office Action at TSDR 9-55; October 10, 2017 Response to Office Action at TSDR 32-103. Applicant also made of record TSDR pages regarding its application and the cited registration. *Id.* at TSDR 108-114. We discuss below the Examining Attorney’s objections to certain of these materials.

<sup>9</sup> September 8, 2016 Office Action at TSDR 2-176; April 10, 2017 Office Action at TSDR 8-130.

4. Archived pages from the registrant's website at fishingfighters.com, and pages from Applicant's website at fishfighterproducts.com, made of record by Applicant.<sup>10</sup>

## II. Analysis of Likelihood of Confusion Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under § 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key factors in every § 2(d) case are the similarity or dissimilarity of the marks, and the goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Applicant devotes almost all of its main brief and reply brief to the similarity or dissimilarity of the marks, and makes only passing references to the similarity or dissimilarity of the goods, 9

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<sup>10</sup> October 10, 2017 Response to Office Action at TSDR 9-31; 4 TTABVUE 18-32 (March 8, 2017 Request for Reconsideration).

TTABVUE 22-23; 13 TTABVUE 9, and to the sixth *DuPont* factor, the nature and number of similar marks in use as they bear on the strength of the cited mark. 9 TTABVUE 18. The Examining Attorney discusses the similarity or dissimilarity of the marks, 12 TTABVUE 6-11, the similarity or dissimilarity of the goods, the third *DuPont* factor, their channels of trade, *id.* at 12-18, and the sixth *DuPont* factor. *Id.* at 11-12.

**A. Similarity or Dissimilarity of the Goods and Channels of Trade**

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567), while the third *DuPont* factor “considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.’” *Id.* at 1052 (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of goods in the application and cited registration. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). There are three classes of goods before us on appeal, with multiple goods in each class. If there is a likelihood of confusion as to any good in a particular class, we may affirm the refusal to register as to that entire class. *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018) (citing *SquirtCo. v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) and *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

The goods identified in the pertinent classes in the application are “fishing tackle hand tools, namely, fishing pliers and fishing knives,” in International Class 8; “athletic apparel, namely, shirts, jackets, hats and caps; baseball caps and hats; button down shirts; fishing shirts; fishing vests; hats; hooded pullovers; hooded sweat shirts; knit shirts; polo shirts; shirts; short-sleeved or long-sleeved t-shirts; sports caps and hats; sweat bands; sweat shirts; tank tops; wind shirts,” in International Class 25;<sup>11</sup> and “fish hook removal tools; fishing rod holders; fishing rod racks; fishing tackle; fishing tackle bags; fishing tackle boxes; fishing tackle containers,” in International Class 28.

The goods identified in the cited registration are “sweaters; shirts; socks; stockings; gloves; mittens; bandanas; neckerchiefs; mufflers; thermal supporters, namely, thermal arm warmers, hand warmers, knee warmers, leg warmers, and insulated vests; hats; caps; headwear; coats; neckties; ear muffs; anoraks; waistbands; belts; footwear; footwear for sports; clothing for fishing, namely, fishing vests, fishing waders, fishing caps, fishing hats, fishing jackets, fishing shirts, fishing suits, fishing sweaters and thermal underwear for fishing; footwear for fishing,” in International Class 25, and “fishing tackle; fishing gloves,” in International Class 28.

### **1. Classes 25 and 28**

The Class 25 goods in the application and cited registration are identical to the extent that they both include “shirts,” “fishing shirts,” “fishing vests,” “hats,” and “caps,” and they are legally identical to the extent that the “jackets” and “sweaters”

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<sup>11</sup> “Shirts” and “hats” appear twice in Applicant’s identification of goods.

broadly identified in the application encompass the “fishing jackets” and “fishing sweaters” identified in the cited registration. The Class 28 goods in the application and cited registration are identical to the extent that both include “fishing tackle.” Given the identity and legal identity of these particular goods in Classes 25 and 28, “there is no need for us to further consider the relatedness of the [other] goods” in those classes. *FabFitFun*, 127 USPQ2d at 1672.

In addition, the identifications of these particular goods do not contain any restrictions or limitations, and “[i]t is well established that absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same channels of trade to the same classes of purchasers.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). Accordingly, the second and third *DuPont* factors strongly support a finding of a likelihood of confusion as to the goods in Classes 25 and 28 in the application.

## **2. Class 8**

With respect to the Class 8 goods identified in the application as “fishing tackle hand tools, namely, fishing pliers and fishing knives,”<sup>12</sup> Applicant argues that the meaning of “fishing tackle,” which it describes as “the equipment, [such] as hooks,

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<sup>12</sup> Applicant initially identified its Class 8 goods simply as “fishing tackle hand tools.” The Examining Attorney required Applicant to list the specific types of those goods, February 11, 2016 Office Action at TSDR 1, and Applicant responded that they were “fishing measuring tapes, fish hook removal tools, fishing pliers, and fishing knives.” August 11, 2016 Response to Office Action at TSDR 1. Applicant subsequently deleted the Class 8 goods identified as “fishing measuring tapes” and “fish hook removal tools.” 4 TTABVUE 6 (March 8, 2017 Request for Reconsideration).

lines, rods, reels, etc., used in fishing,” 9 TTABVUE 23,<sup>13</sup> does “not seem to suggest or support a position that . . . hand tools for working on fishing tackle (class 008) are themselves fishing tackle by virtue of being used . . . as pliers or knives.” *Id.* Applicant also argues that the “reach by registrant’s class 028 ‘fishing tackle’ to form support for refusing applicant’s class[ ] 008 . . . seems to applicant to be too large a reach.” *Id.* at 24. The Examining Attorney responds that Applicant’s Class 8 goods “are related to registrant’s Class 28 goods in that they are all types of equipment and tools used in the sport of fishing.” 12 TTABVUE 14.

Applicant’s argument based on the meaning of the term “fishing tackle” is unpersuasive. As Applicant acknowledges, the cited definition states that “[f]ishing tackle consists of **all of the equipment that is used in the sport of fishing**, such as fishing rods, lines, hooks, and bait.” 9 TTABVUE 23 (emphasis added). It is self-evident that goods identified as “fishing pliers” and “fishing knives” are “equipment that is used in the sport of fishing,” and Applicant specifically described those goods as a subset of “fishing tackle hand tools.”<sup>14</sup> Both the cited dictionary definition and Applicant’s own characterization of its goods suggest that “fishing tackle hand tools,

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<sup>13</sup> Applicant cites a definition of “fishing tackle” from COLLINS ENGLISH DICTIONARY (collinsdictionary.com). October 10, 2017 Response to Office Action at TSDR 104.

<sup>14</sup> Applicant’s characterization of its goods as “fishing tackle hand tools” is consistent with the record, which shows that fishing pliers and fishing knives are commonly offered together with other forms of fishing tackle. September 8, 2016 Office Action at TSDR 3-4, 12-16, 21-25, 33-34, 40-43, 90, 92-97; April 10, 2017 Office Action at TSDR 8-9, 13-24, 26-33, 36-51, 55-76, 78-87, 90-124. An example is the website of FishUSA, which describes itself as “America’s Tackle Shop” and offers fishing knives and fishing pliers as parts of fishing tackle. *Id.* at TSDR 13-16 (fishusa.com).

namely, fishing pliers and fishing knives” are subsumed within the goods identified as “fishing tackle” in the cited registration, and thus are legally identical to them.<sup>15</sup>

The Class 8 goods, of course, need not be legally identical to fishing tackle, or even competitive with those goods, to support a finding of a likelihood of confusion. The Class 8 goods and the registrant’s “fishing tackle” must only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Even if Applicant’s Class 8 goods were not subsumed within the goods identified in the registration as “fishing tackle,” the record shows that Applicant’s Class 8 goods and the registrant’s “fishing tackle” are very closely related.

Applicant’s current use of its mark on various forms of fishing tackle,<sup>16</sup> and its claimed intention to use its mark on fishing pliers and fishing knives, is itself significant evidence of the relatedness of those goods, particularly because Applicant identified its “fishing pliers and fishing knives” as a subset of “fishing tackle hand tools.” *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 2d 1187, 1195 (TTAB 2007)

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<sup>15</sup> The fact that the goods are in different classes has no bearing on their similarity. “The classification system was established for the convenience of the [USPTO] rather than to indicate that goods in the same class are necessarily related or that classification in different classes indicates that they are not related.” *Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

<sup>16</sup> October 10, 2017 Response to Office Action at TSDR 24-31; 4 TTABVUE 18-32 (March 8, 2017 Request for Reconsideration).

(finding that wearing apparel was closely related to various bags in part because “the applicant itself offers or intends to offer both types of products” under its mark).<sup>17</sup>

In addition, by definition, and as corroborated by the record, goods identified as “fishing tackle,” and “fishing pliers and fishing knives,” are all used in the sport of fishing, and such “conjoint use is a fact proper to be considered along with other facts present in particular cases.”<sup>18</sup> *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014) (quoting *Sholl Dental Lab. Co. v. McKesson & Robbins, Inc.*, 150 F.2d 718, 66 USPQ 223, 226 (CPA 1945)). See also *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (complementary use of goods “has long been recognized as a relevant consideration in determining a likelihood of confusion”). The record also shows that fishing pliers and fishing knives are commonly offered to consumers engaged in the sport of fishing together with other fishing equipment on the websites of outdoor equipment retailers and fishing retailers.<sup>19</sup> Such evidence that “a consumer would likely encounter one product while purchasing the other” and

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<sup>17</sup> Applicant also made of record, for another purpose, two used-based third-party registrations of marks including both “fishing tackle” and either “fishing tackle pliers” or “fishing knives.” October 10, 2017 Response to Office Action at TSDR 41-42, 100-101. As discussed below, this is some evidence that those goods are related.

<sup>18</sup> Fishing pliers appear to be used primarily in the process of catching fish, while fishing knives appear to be used primarily after the fish have been caught. For example, a page from the website of Academy Sports + Outdoors offers “fishing tools that aide [sic] in catching the fish including fishing nets, bait traps, [and] fishing lights,” as well as “fishing tools that help you process the fish for after the catching including fish scales and filet knives.” September 8, 2016 Office Action at TSDR 52 (academy.com). The website displays a fishing knife as part of a “Fish Processing” category of fishing equipment. *Id.* at TSDR 48.

<sup>19</sup> *Id.* at TSDR 3-4, 12-16, 21-25, 33-34, 40-43, 90, 92-97; April 10, 2017 Office Action at TSDR 8-9, 13-24, 26-33, 36-51, 55-76, 78-87, 90-124. We infer from the common presence of these goods on the websites of these retailers that the goods also appear together in the retailers’ brick-and-mortar world stores.

that “consumers are likely to purchase the products at the same time and in the same stores” is further corroboration of their relatedness. *Davia*, 110 USPQ2d at 1816 (evidence that agave sweeteners and pepper sauce are sold online by the same grocery stores was probative of their relatedness).

Finally, the Examining Attorney made of record evidence of the sale of fishing lines, fishing hooks, fishing pliers, and fishing knives under the Bass Pro Shops mark.<sup>20</sup> This one instance of third-party use of the same mark for both sets of goods is obviously limited in scope, but, together with the third-party registration evidence made of record by Applicant, it is additional evidence of relatedness. *See, e.g., In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355-56 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

On the basis of the record as a whole, including Applicant’s description of its Class 8 goods as a form of “fishing tackle hand tools,” we agree with the Examining Attorney that the “fishing pliers and fishing knives” identified in the application and the “fishing tackle” identified in the cited registration are “all types of equipment and tools used in the sport of fishing,” and that those “goods are all used for the same activity, i.e., fishing,” and “are sold in the same channels of trade where they will be encountered by the same group or classes of purchasers.” 12 TTABVUE 14. The “circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722. Regardless of whether the Class 8 goods in the application are subsumed

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<sup>20</sup> September 8, 2016 Office Action at TSDR 3-5, 12-14, 21-22.

within “fishing tackle” in the registration and are thus legally identical to those goods, or are instead highly related to them, we find that the second and third *DuPont* factors also strongly support a finding of a likelihood of confusion as to the Class 8 goods in the application.

### **B. Similarity or Dissimilarity of the Marks**

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Davia*, 110 USPQ2d at 1812 (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)).

The proper test regarding similarity “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.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

“[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors*

*Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). Because various goods in the application are identical or legally identical to counterpart goods in the cited registration, “the degree of similarity between the marks necessary to support a determination that confusion is likely declines” with respect to those goods and classes. *i.am.symbolic*, 127 USPQ2d at 1630 (citing *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d. 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); and *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

Applicant “contends that the dissimilarity of the marks is dispositive.” 9 TTABVUE 9. Because Applicant devoted most of its briefing, and all of its argument at the oral hearing, to the claimed dispositive dissimilarity of the marks, we will first summarize Applicant’s arguments and the Examining Attorney’s responses in some detail before beginning our analysis of this *DuPont* factor. For ease of reference in following our summary of their arguments and our analysis of similarity, we again reproduce the marks below:<sup>21</sup>



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<sup>21</sup> We reiterate that the display of the marks together does not reflect the permitted mode of their comparison.



### 1. Applicant's Arguments

Applicant bases many of its arguments on the requirement that the marks must be considered in their entirety. Citing *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015), Applicant requests that the Board “not overemphasize the word elements of the marks and consider the entirety of the marks including the significant design elements of the compared marks.” 9 TTABVue 10.

Applicant argues that “the words FISHING F FIGHTERS in the registered mark are dominated by the wrestling mask design portion of the mark that make the three FISHING F FIGHTERS words of five syllables not easily discernable,” *id.*, that those words are “seriously embedded in one monolithic scowling face-like mask design,” *id.*, and that the words “FISH in one mark is not the FISHING in the other mark; and the FIGHTER in one mark is not the FIGHTERS in the other mark.” *Id.* at 11.

With respect to the marks' appearance, the means of comparison on which Applicant relies most heavily, Applicant first argues that they are dissimilar because its mark “is two words (totaling three syllables) – FISH FIGHTER and a design and the referenced mark is three words (totaling five syllables) – FISHING F FIGHTERS and a design.” *Id.* Applicant then claims that the respective design elements of the marks are very different. *Id.* at 14. In support of its arguments for visual dissimilarity, Applicant repeatedly cites the descriptions of the respective marks in

the application (a “stylized three-segment arched fin over italicized FISH FIGHTER”) and in the cited registration (a “[w]restling mask featuring a stylized letter ‘f’ on the forehead portion and in between the words ‘fishing’ in stylized letters on the left side of the mask and the word ‘fighters’ on the right side of the mask”). *Id.* at 7, 11-12, 14-15, 18, 20; 13 TTABVue 4.

Applicant describes the design elements of the respective marks in extensive detail. Applicant argues that the registered mark

features an anthropomorphic, grimacing, scowling wrestling mask facing forward having an upright stylized letter “F” on its forehead bracketed to the left by a bordered appendage curving left and downwardly from the right cheek of the marks imprinted with heavily stylized tightly packed letters spelling the word “Fishing” with the “g” intersecting the right cheek and bracketed to the right by a bordered appendage curving right and downwardly from the left cheek of the mask imprinted with the heavily stylized tightly packed letters spelling the word “Fighters” with “F” intersecting the left cheek of the mask.

*Id.* at 20-21. Applicant “contends that the dominant feature of the registered mark is the central mask that likely would be remembered by more members of the relevant public in marketplace who encounter the registered mark, than those who would remember the literal elements of the mark: FISHING F FIGHTERS.” *Id.* at 20. Applicant “notes and asks the members of the board to note that people often are heard to remark to the effect that they remember faces much more easily than names.” *Id.* at 20-21.<sup>22</sup>

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<sup>22</sup> To the extent that this constitutes a request that we take judicial notice that “people often are heard to remark to the effect that they remember faces much more easily than names,” we decline that request because this is not a “fact that is not subject to reasonable dispute” within the meaning of Rule 201(b) of the Federal Rules of Evidence. *See generally*

Applicant also argues that the design element is dominant because the “stylized FISHING and FIGHTERS are on opposite sides of the grimacing face the stylized F on the forehead [and] likely could be overlooked by a relevant member of the internet marketplace,” and a “reasonable consumer encountering the registered composite mark . . . might well only remember the appearance of what may be characterized as a grimacing face with an F on the forehead of the face.” *Id.* at 16. In Applicant’s view, “it seems highly likely that members of the consuming public encountering the registered mark would note and more likely remember the scowling mask and perhaps not even notice or scarcely remember the literal elements deeply embedded in the mark.” *Id.* at 20.

Applicant contrasts the design element in the cited mark with the “fish-like finned stylized slanted words of applicant’s mark FISH FIGHTER (the arching fins above and together with the words reasonably could be remembered by a relevant member of the marketplace as suggesting a fish with a large dorsal fin swimming to the right).” *Id.* at 14. Applicant argues in its reply brief that “applicant’s design suggest [sic] a fish and the registered mark suggests a human.” 13 TTABVUE 6.

With respect to sound, Applicant argues that the marks are dissimilar because its “mark has only three syllables (FISH FIGHTER) that can be vocalized and the referenced mark has five syllables (FISHING F FIGHTERS) that can be vocalized.”

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TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 1208.04 n.3 (June 2019) (collecting cases in which the Board has taken and declined to take judicial notice of various claimed facts and other matters). For the same reason, we also decline the requests made by Applicant’s counsel at the oral hearing that we take judicial notice that the respective marks are not verbalized on applicant’s and the registrant’s websites, and that we take judicial notice of the manner in which consumers interact with the Internet.

9 TTABVUE 11. Applicant also notes that the word FIGHTER is in the singular in its mark, while the word FIGHTERS is in the plural in the cited mark. *Id.*

Finally, as to the connotations and commercial impressions of the marks, Applicant argues that the “piscine nature of applicant’s mark is a stark contrast to the anthropomorphic nature of registrant’s mark.” *Id.* at 22. With respect to its mark, Applicant argues that a “relevant member of the marketplace could reasonably interpret the arched fin (large dorsal fin) over the leftward slanted wording (sleek body form) as suggesting a FISH,” and “could conclude that the FISH term of the mark is referring to the animal and the FIGHTER is referring to a person who fights with a fish or could conclude that the FISH FIGHTER is referring to a fish that is a fighter.” *Id.* at 14. According to Applicant, the “arched fin over the stylized FISH FIGHTER reasonably may lead to such interpretations.” *Id.*

With respect to the cited mark, Applicant argues that if a consumer “remembered the wordings then it is reasonable that they might remember FISHING (the sport or business of catching fish) . . . and the wrestler (a type of fighter) to be engaged in battling the fishing experience and not directly referring to fighting a FISH.” *Id.* at 16. In its reply brief, Applicant argues that the “design of the registered mark does not conjure up the image of a fish or conjure up the activity of fishing.” 13 TTABVUE 7.

## **2. The Examining Attorney’s Arguments**

The lynchpin of the Examining Attorney’s arguments is her claim that the dominant word portions of the respective marks are virtually identical. She argues

that in “applicant’s mark, the literal element, i.e., the wording ‘FISH FIGHTER,’ is considered the dominant portion of the mark because the only remaining element in the mark is a design element which is generally accorded less weight in the likelihood of confusion analysis,” 12 TTABVUE 7, while “in the registrant’s mark, the wording ‘FISHING FIGHTERS’ is considered dominant because the only other element in the mark is a design element featuring a wrestling mask that includes a ‘stylized letter ‘F’ on the forehead portion of the mask,” and FISHING FIGHTERS “is the primary wording in the mark and is the wording that consumers will use in calling for the goods.” *Id.*

The Examining Attorney also argues that the words dominate the cited mark because “the letter ‘f’ appears as a small and inconspicuous element which is imbedded in the design and does not create a commercial impression that is separate and apart from the overall design.” *Id.* She points to the registrant’s 2017 catalog, in which the “registrant uses ‘FISHING FIGHTERS’ separately multiple times,” *id.*, as support for her arguments that the words, not the design, dominate the mark. She claims that the registrant’s website “is evidence that even registrant considers ‘FISHING FIGHTERS’ to be the primary source indicator for its goods.” *Id.* at 8.

The Examining Attorney further argues that the term ‘FISH’ in applicant’s mark and the term ‘FISHING’ in registrant’s mark are both fish-formative terms that are similar in appearance and convey the same connotation,” and that the “terms ‘FIGHTER’ and ‘FIGHTERS’ are essentially identical terms in that they are merely the singular and plural forms of the same term.” *Id.* According to the Examining

Attorney, the “resulting combination, FISH FIGHTERS in applicant’s mark and ‘FISHING FIGHTERS’ in registrant’s mark, are overwhelmingly similar in appearance, connotation and commercial impression such that they are likely to cause confusion as to the source of the parties’ goods.” *Id.* at 8-9.

The Examining Attorney concedes that the design elements in the marks differ in appearance, but argues that “they also reinforce the connotation and commercial impression conveyed by the wording in the marks” because in Applicant’s mark “the design which is described as a ‘stylized fin’ conjures images of fish and reinforces the term ‘FISH’ in the mark” and also “reinforces the concept of fishing because fish have fins and fishing involves fish,” while in the cited mark, “the design element described as a ‘wrestling mask’ conjures images of wrestling or fighting which reinforces the connotation of a ‘FIGHTER’ or ‘FIGHTERS’ because wrestling is a sport in which opponents fight.” *Id.* at 10. The Examining Attorney rejects Applicant’s argument regarding the different number of syllables in the literal portions of the mark on the ground that “it improperly relies on a side by side comparison of the marks.” *Id.* at 10-11.

The Examining Attorney concludes that “the marks are sufficiently similar in terms of their overall commercial impression because the dominant elements in each mark, i.e., the words ‘FISH FIGHTER’ in applicant’s mark and the words ‘FISHING FIGHTERS’ in registrant’s mark, are virtually identical in appearance, sound and connotation such that when considered as a whole, the marks convey a confusingly similar commercial impression.” *Id.* at 11.

### 3. Analysis of Similarity or Dissimilarity of the Marks

The marks must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue 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 consideration of the marks in their entireties.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). We will begin our analysis by determining the dominant portion of the cited mark because, as discussed above, Applicant and the Examining Attorney disagree on that issue, with Applicant claiming that the design dominates the mark and with the Examining Attorney taking the view that the words are dominant.<sup>23</sup>

In composite word-and-design marks, “the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908). An underlying rationale for this general principle is “that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.” *Viterra*, 101 USPQ2d at 1911.

In *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983), which involved the marks TINKERTOY and a composite word-and-design mark consisting

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<sup>23</sup> Applicant’s reply brief does not address the Examining Attorney’s argument that the words FISH FIGHTERS dominate Applicant’s mark. We agree with that argument for the reasons discussed below in our analysis of the dominant portion of the cited mark.

of the words “Thinker Toy” and a light bulb design, the Federal Circuit Court of Appeals noted that the general principle that “in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed” is “particularly true when a mark appears in textual material, such as catalog descriptions, in which it is often impossible or impractical to include the design feature of the mark.” 218 USPQ at 200. The court pointed to “applicant’s 17-page catalog (of record) [which] displays the words ‘Thinker Toys’ without the light bulb design some fifteen times.” *Id.* n.5.

Here, the words FISHING FIGHTERS appear alone in text accompanying the cited mark on the registrant’s packaging, in its catalog, and on its website at fishingfighters.com. We reproduce examples below:



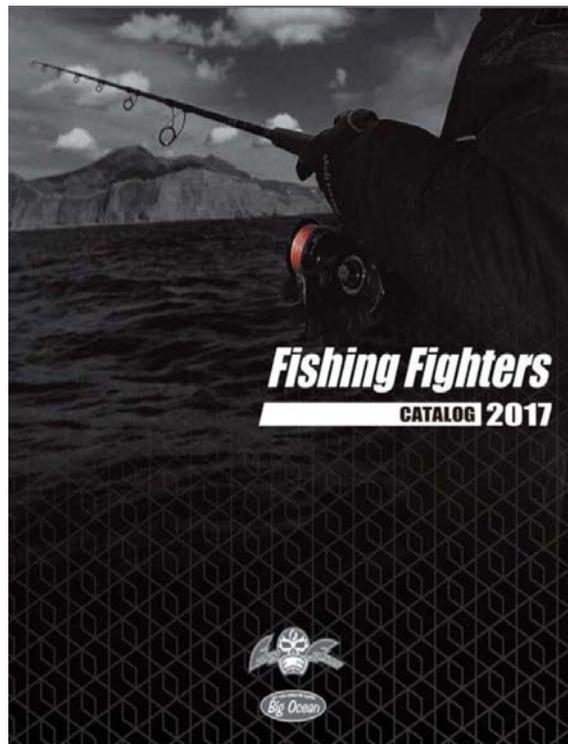
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<sup>24</sup> October 10, 2017 Response to Office Action at TSDR 18.



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<sup>25</sup> *Id.* at TSDR 19.

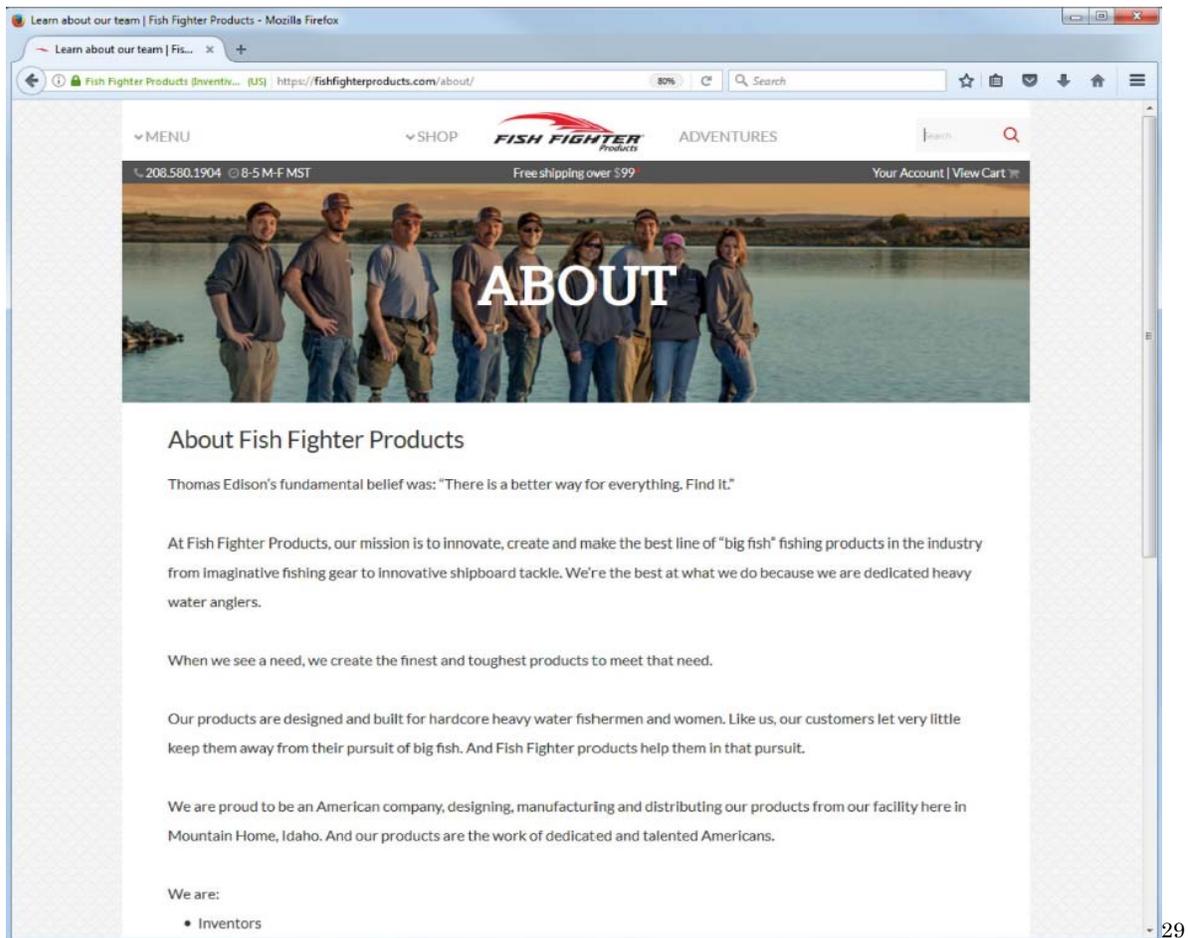
<sup>26</sup> *Id.* at TSDR 11.



<sup>27</sup> 4 TTABVUE 18 (March 8, 2017 Request for Reconsideration).

We infer from the registrant's uses of the words FISHING FIGHTERS to refer to itself and its products that the words are likely to "be used by [consumers] to request the goods." *Aquitaine Wine USA*, 126 USPQ2d at 1184.<sup>28</sup>

Applicant similarly uses the words FISH FIGHTER to refer to itself and its products on its website at fishfighterprodcts.com:



<sup>28</sup> We also infer from these uses that consumers will use the words FISHING FIGHTERS to call for the goods rather than what Applicant calls "the literal elements of the mark: FISHING F FIGHTERS." 9 TTABVUE 20.

<sup>29</sup> 4 TTABVUE 31 (March 8, 2017 Request for Reconsideration). These uses of FISH FIGHTER support a finding that those words dominate Applicant's mark.

Applicant quibbles with the Federal Circuit’s statement in *Viterra* that a composite word-and-design is generally dominated by the word element. Applicant cites a non-precedential Board decision, *In re O’Connor*, Serial No. 78793021 (TTAB Sept. 29, 2008), which quotes what Applicant calls “instructive language regarding composite marks” from *In re Electrolyte Labs, Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990), 9 TTABVUE 8, including a statement that “[t]here is no general rule as to whether letters or designs will dominate in composite marks.” *Id.* (quoting *Electrolyte Labs.*, 16 USPQ2d at 1240).

Neither *O’Connor* nor *Electrolyte Labs.* aids Applicant because those cases involved stylized letter marks, not composite word-and-design marks such as those involved here. The Federal Circuit’s statement in *Electrolyte Labs.* that “[t]here is no general rule as to whether letters or designs will dominate in composite marks,” 16 USPQ2d at 1240, is not at odds with the court’s subsequent statements in *Viterra* and *Jack Wolfskin* that “when a mark consists of both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.’” *Jack Wolfskin*, 116 USPQ2d at 1134 (quoting *CBS*, 218 USPQ at 200).<sup>30</sup>

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<sup>30</sup> To the extent that Applicant claims that *Jack Wolfskin* supports its argument that the design element of the cited mark is its dominant portion, Applicant’s reliance on that case is misplaced. The registered mark in that case “consist[ed] of two elements, the KELME [word] component and the paw print design.” *Jack Wolfskin*, 116 USPQ2d at 1134. The Federal Circuit held that the Board had erred in finding that the registered mark was confusingly similar to the applicant’s mark, which consisted solely of a paw print design, because “the Board failed to adequately account for the presence of the literal KELME component of the [registered] mark.” *Id.* This holding is fully consistent with the principle that the word portion of a composite mark is generally its dominant portion. The *Jack Wolfskin* court also found that the Board erred in dismissing the significance of “extensive evidence of third-party registrations depicting paw prints and evidence of these marks being used in internet comment for clothing.” *Id.* at 1136. As discussed below, there is no comparable evidence here.

As the Federal Circuit explained in *Electrolyte Labs.*, a “design is viewed, not spoken, and a stylized letter design cannot be treated simply as a word mark.” *Electrolyte Labs.*, 16 USPQ2d at 1240.

Applicant quotes the portion of the *Jack Wolfskin* opinion that reiterates the general principle that words dominate composite word-and-design marks, 9 TTABVUE 10, but emphasizes the Federal Circuit’s statement that “[t]hese principles do not, however, trump our duty to consider the marks on a case-by-case basis.” *Jack Wolfskin*, 116 USPQ2d at 1134. Applicant then argues that the general principle does not apply to the cited mark because the words FISHING FIGHTERS in the cited mark are difficult to discern, and “it seems highly likely that members of the consuming public encountering the registered mark would note and more likely remember the scowling mask and perhaps not even notice or scarcely remember the literal elements deeply embedded in the mark.” 9 TTABVUE 20.

The record does not support Applicant’s position. It is clear that the cited mark contains two words. Each word begins with the same large stylized letter “F” and contains additional letters in the identical stylized font, and each serves as a bookend around the mask when the mark is viewed and read from left to right in the normal English language convention. Even assuming that it is not clear on a first look that the two words are “FISHING” and “FIGHTERS” because they are “deeply embedded in the mark,” *id.*, it is far more likely that consumers would scrutinize the words carefully and discern them on a second look than that they would simply give up and internalize the mark as “a grimacing face with an F on the forehead of the face,” *id.*

at 16, or a “scowling mask.” *Id.* at 20. As Applicant acknowledges “the design portions of the marks cannot readily be vocalized,” *id.* at 11, and their word elements are the only means by which consumers can refer to and request the respective goods. *See, e.g., Viterra*, 101 USPQ2d at 1911. That is why both the registrant and Applicant prominently use the words in their composite marks in their public-facing materials, and why consumers would likely make any required extra effort to understand the words in the cited mark.

We find that the words FISHING FIGHTERS are the dominant portion of the cited mark and that the words FISH FIGHTER are the dominant portion of Applicant’s mark. We turn now to the required comparison of the marks in their entireties as to appearance, sound, and connotation and commercial impression, giving greater weight in that comparison to the word elements of the marks than to their design elements. As noted above, “[s]imilarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Davia*, 110 USPQ2d at 1812.

We begin with the similarity or dissimilarity of the marks in sound. The marks are very similar in sound when they are verbalized as FISHING FIGHTERS and FISH FIGHTER. Each begins with a word consisting of or starting with “FISH-” and ends with a word consisting of or starting with “FIGHTER-.” The record does not support Applicant’s arguments that a consumer who has an imperfect recollection of the words FISHING FIGHTERS in the cited mark, and who hears the words FISH FIGHTER, would distinguish between the words because they have a different numbers of syllables, or because the word FIGHTER in Applicant’s mark is the

singular form of the word FIGHTERS in the cited mark. *See, e.g., In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969) (there is no material difference, in a trademark sense, between singular and plural forms of a word); *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012) (“[p]urchasers are unlikely to perceive any distinction in overall commercial impression between ANYWEARS and ANYWEAR”).

With respect to appearance, Applicant’s mark contains a fin-like design above the words FISH FIGHTER, which are presented in an italicized, rightward-slanting font:



The cited mark contains a menacing mask that is bookended by the words FISHING FIGHTERS, which are presented in a highly-stylized rightward-slanting font:



These visual differences are obvious where the marks are viewed together, but the “marks ‘must be considered . . . in light of the fallibility of human memory’ and ‘not on the basis of side-by-side comparison.’” *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). As the Federal Circuit’s predecessor court first noted long ago, many consumers “may have but dim recollections from having previously seen or heard one or the other of the involved marks.” *Neutrogena Corp. v. Bristol-*

*Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969). We must consider the possible “dim recollections” of the cited mark that consumers may have in their mind’s eyes when they view Applicant’s mark, and assess whether they would be likely to distinguish the marks solely on the basis of their remembered and perceived appearances.

We agree with Applicant that the design elements of the cited mark are striking, but as Applicant acknowledges, “the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole.” 9 TTABVUE 13 (quoting J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:14 (2016) (internal quotation omitted)). It is very unlikely that consumers would recall the minute details of the mark’s design to which Applicant points, *id.* at 20-21, or the particular stylization of the words FISHING FIGHTERS. It is far more likely that consumers would simply recall the cited mark as consisting of the dominant words FISHING FIGHTERS in some form of stylized form and, as Applicant claims, that consumers “likely would remember the mask.” *Id.* at 16.<sup>31</sup>

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<sup>31</sup> Both Applicant and the Examining Attorney refer to the mask throughout their briefs as a wrestling mask, in the manner in which it is described in the cited registration, but the registrant’s description of the mark does not control how it will be perceived. “A description cannot be used to restrict the likely public perception of a mark” because a “mark’s meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 808.02 (Oct. 2018). It is not clear to us from the drawing of the mark that the mask will inevitably be viewed as a wrestling mask, and the record does not establish that it will. The record contains the page from the registrant’s website shown above that displays what appears to be a wrestler wearing a mask, 4 TTABVUE 18 (March 8, 2017 Request for Reconsideration), but it contains more pages showing people simply wearing a mask while fishing. *Id.* at 21, 23-24.

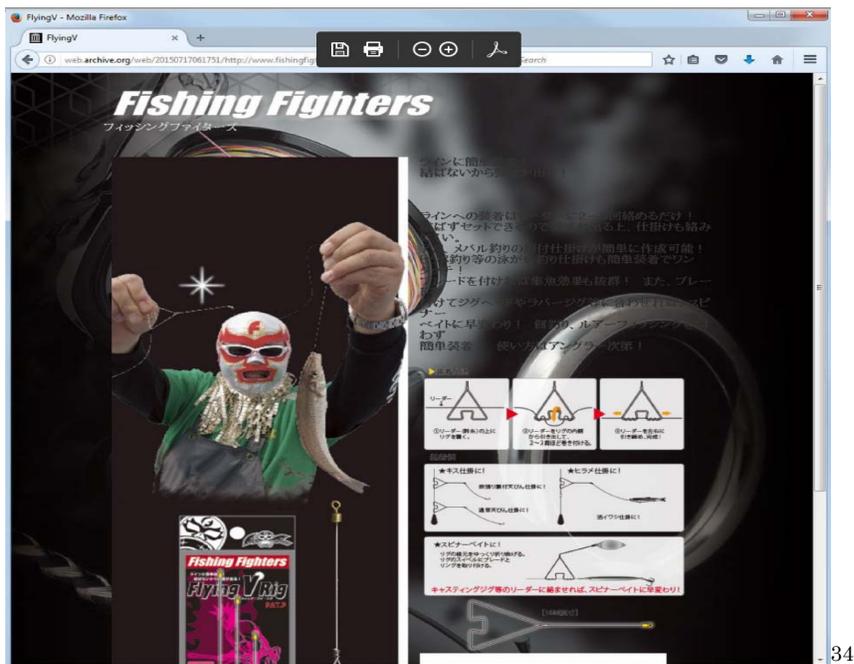
When consumers with an imperfect recollection of the cited mark view Applicant's mark, the modestly-stylized dominant words FISH FIGHTER would not likely be viewed as dissimilar in appearance to the words FISHING FIGHTERS as they are remembered, despite the fact that, as Applicant argues, *id.* at 11, the words have a different number of syllables. The fin design in Applicant's mark, while different from a mask design, serves primarily to "emphasize, in a pictorial way, the main word portion" of Applicant's mark.<sup>32</sup> *In re Wine Soc'y of Am.*, 12 USPQ2d 1139, 1142 (TTAB 1989). Taking into account the dominance of the word elements in the marks, and "the recollection of the average customer, who retains a general rather than specific impression of marks," *i.am.symbolic*, 127 USPQ2d at 1630, we find that the marks are only somewhat different in appearance when considered in their entireties. We reject Applicant's claim that "when viewed in total the two marks are strikingly dissimilar and there is no reasonable likelihood of confusion between the two marks." 9 TTABVUE 13.

With respect to connotation and commercial impression, given the fallibility of human memory, the dominant words in the marks are likely to be the primary drivers of their meaning, and FISH FIGHTER and FISHING FIGHTERS are very similar in that regard. Particularly in the context of the Class 8 and Class 28 fishing equipment in the application, FISH FIGHTER and FISHING FIGHTERS both connote one or

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<sup>32</sup> As Applicant puts it, the "arched fin over the stylized FISH FIGHTER reasonably may lead" to the interpretation of "the arched fin (large dorsal fin) over the leftward slanted wording (sleek body form) as suggesting a FISH," and "the FISH term of the mark [as] referring to the animal and the FIGHTER [as] referring to a person who fights with a fish," or "that the FISH FIGHTER is referring to a fish." 9 TTABVUE 14.

more persons engaged in the sport of fishing who metaphorically fight with fish. Applicant acknowledges that the words FISH FIGHTER in its mark may evoke a “battle against a fish by a single fisherman.” 9 TTABVUE 15.<sup>33</sup> Applicant claims that the words FISHING FIGHTERS in the cited mark evoke a “wrestler (a type of fighter) . . . engaged in battling the fishing experience,” and do not “directly refer[ ] to fighting a FISH,” *id.* at 16, but there is nothing in the record to support this claim, and pages from the registrant’s website made of record by Applicant show these “fighters” enjoying, not battling, the “fishing experience”:



We think that it is far more likely that when consumers recall the words FISHING FIGHTERS in the cited mark, the mark will evoke fighters of fish, not fighters of the

<sup>33</sup> There is nothing in the record, including on Applicant’s website, to support its alternative claimed meaning of the mark as “a fish that is a fighter.” *Id.*

<sup>34</sup> 4 TTABVUE 23 (March 8, 2017 Request for Reconsideration).

sport of fishing. That meaning of the cited mark is quite similar to the meaning of the words FISH FIGHTER in Applicant's mark.

The marks are quite similar in sound and meaning, and only somewhat different in appearance. The relevant goods are either identical or nearly so, and the degree of similarity between the marks required for confusion to be likely is thus reduced. As discussed immediately below, there is no evidence of any third-party use or registration of a mark for fishing equipment that contains both of the words in the mark, and only two examples of registrations of Class 25 marks that contain the FISH- and FIGHT-formatives, but those marks (FIGHT THE BITE FISHING (stylized) and FISHIN FIGHTIN FARMIN) are not nearly as similar to the dominant words in either of the involved marks as those dominant words are to each other. Under the circumstances, we find that the marks' similarities in sound and meaning outweigh their modest differences in appearance. The first *DuPont* factor supports a finding of a likelihood of confusion.

### **C. Third-Party Registrations and the Sixth *DuPont* Factor**

The sixth *DuPont* factor considers “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. The Examining Attorney notes that “applicant offers third-party registrations as evidence that the term ‘FISH’ and ‘FIGHT’ are weak terms that should only be afforded a narrow scope of protection.” 12 TTABVUE 11 (citing 9 TTABVUE 18).<sup>35</sup> She argues that “the evidence submitted

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<sup>35</sup> The Examining Attorney objects to “those references which only appear in applicant's ‘hit list’ and for which applicant has not provided the full registration record.” 12 TTABVUE 12. Applicant made of record multiple TESS lists. August 11, 2016 Response to Office Action at

by applicant fails to establish that the registrant's mark is a 'weak' mark because applicant has not shown that the unique combination 'FISH(ING) FIGTHER(S)' is weak." *Id.*<sup>36</sup> We agree.

Applicant made of record numerous registrations of marks contain a FISH- or FISHING-formative, and a few registrations of marks containing a FIGHT-formative, but, as noted above, only two registrations of marks in Class 25 that contain both formatives,<sup>37</sup> and no registrations of such marks for any sort of fishing equipment in Classes 8 or 28. Applicant also made of record no evidence of use of any of the registered marks.

The third-party registrations confirm that the disclaimed word FISHING in the cited mark (like the disclaimed word FISH in Applicant's mark) has little or no source-identifying capacity for fishing-related goods, "but such terms, in appropriate circumstances, may—and here, do—contribute to the overall commercial impression created by a mark." *Inn at St. John's*, 126 USPQ2d at 1748. When combined with the

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TSDR 9-14, 23-43, 46-51; October 10, 2017 Response to Office Action at TSDR 32-36. They are all insufficient to make the referenced registrations of record. *See, e.g., Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012). We have considered only the third-party registrations that have been made of record through the submission of full information from the TESS database. August 11, 2016 Response to Office Action at TSDR 15-18, 20-21, 52, 54; October 10, 2017 Response to Office Action at TSDR 37-58, 61-91, 94-103. The third-party application made of record by Applicant, August 11, 2016 Response to Office Action at TSDR 19, is "evidence only that [it was] filed on a certain date; [it is] not evidence of use of the mark[ ]." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd*, Slip Op. No. 18-2236 (mem.) (Fed. Cir. Sept. 13, 2019). We give it no consideration.

<sup>36</sup> As noted above, Applicant only mentions this evidence in passing in its brief, 9 TTABVUE 18, and does not specifically argue that the cited mark is weak. We will nevertheless consider the evidence of record that is potentially probative of the scope of protection to be afforded to the cited mark.

<sup>37</sup> August 11, 2016 Response to Office Action at TSDR 17-18.

word FIGHTERS in the cited mark, the word FISHING causes the mark as a whole to have an overall commercial impression very similar to that of Applicant's mark, which is dominated by the words FISH FIGHTER. Applicant's third-party registration evidence does not show that the cited mark, as a whole, is weak, or that the dominant words FISHING FIGHTERS in the cited mark are weak when combined. *Id.* at 1746 (where the applicant presented "no evidence of third-party use" and at most "four third-party registrations of varying probative value," the record was "a far cry from the large quantum of evidence of third-party use and third-party registration that was held to be significant in both" *Jack Wolfskin* and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015)). On this record, we find that the sixth *DuPont* factor is neutral.

#### **D. Conclusion**

All of the relevant *DuPont* factors for which evidence and argument have been submitted either support a finding of a likelihood of confusion or are neutral. The goods, channels of trade, and classes of customers are identical or nearly so, the marks are similar when considered in their entireties, and there is no evidence that consumers can distinguish between the marks on the basis of their differences in appearance as a result of third-party use and registration of similar marks for similar goods. We find, on the basis of the record as a whole, that a consumer who is familiar with the cited mark for clothing and fishing tackle, and who is exposed to the use of Applicant's mark for the identical or very similar Class 8, 25, and 28 goods identified

in the application, is likely to believe mistakenly that those goods originate with, or are sponsored or authorized, the owner of the cited mark.

**Decision:** The refusal to register is affirmed as to Classes 8, 25, and 28 that are before us on this appeal.