

This Opinion is not a
Precedent of the TTAB

Hearing:
January 15, 2015

Mailed:
October 7, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re i.am.symbolic, llc

Serial Nos. 85044495

Jill M. Pietrini of Sheppard Mullin Richter & Hampton,
for i.am.symbolic, llc.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104,
Chris Doninger, Managing Attorney.

Before Quinn, Taylor, and Shaw,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

i.am.symbolic, llc (“Applicant”), by way of assignment from William Adams, filed an application to register the mark I AM (in standard characters) for the goods ultimately identified as (emphasis added)¹:

Cameras; cell phones and accessories therefor, namely, decorative charms, hands-free headsets, batteries and chargers, power adapters, face plates, belt clips and holsters, and mounting devices; cases or fitted plastic skins for scratch protection for cameras, cell phones,

¹ After the appeal was filed the application was assigned in a document executed on July 19, 2013; the assignment document was recorded on July 25, 2013 in the Assignment Branch records of the Office at reel 5078, frame 0946.

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laptop computers, PDAs, portable music players, handheld gaming devices, and handheld global positioning devices; PDAs; portable global positioning devices; portable music players; mobile radios; computer and video games, namely, cartridges, discs, software, controllers, and consoles for use with an external display screen or monitor; backpacks adapted for holding laptop computers; computer storage devices, namely, flash drives; computer hardware and computer peripherals; computer storage devices, namely, high-speed storage subsystems for storage and backup of electronic data either locally or via a telecommunications network; downloadable electronic, digital or computer games, graphics, ring tones and multi-media files; downloadable audio and video files featuring music, dramatic and comedic performances; digital trading cards in the nature of multimedia software recorded on magnetic media featuring musical, dramatic and comedic content; answering machines; baby monitors; decorative magnets; electric door bells; electric hair dryers, irons and curlers; electronic diaries; eyeglasses and eyeglass cases; headphones and earphones; juke boxes; lighted displays for outdoor use in the nature of LED displays; mouse pads; neon signs; safety eyewear; slot machines; sporting helmets; sunglasses and sunglass cases **associated with William Adams, professionally known as "will.i.am"**; switch plate covers; educational software featuring instruction in health and well-being; motion picture films, downloadable television programs, and documentary motion picture films featuring dramatic, comedic and musical performances; musical sound recordings; musical video recordings; and pre-recorded DVDs, videotapes, and other audiovisual recordings featuring musical, dramatic and comedic performances (in International Class 9).²

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when

² Application Serial No. 85044495, filed May 21, 2010, alleging a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant, in its Supplemental Brief filed on April 21, 2014, requested that its application be amended as highlighted above. (Supplemental Brief, p. 3, 17 TTABVue 3). The Examining Attorney, in his brief filed on June 8, 2014, accepted the amendment. (Brief, pp. 3, 6, 19 TTABVue 4, 7).

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applied to Applicant's goods ("sunglasses and sunglass cases"), so resembles the previously registered mark shown below



for "sunglasses" in International Class 9,³ as to be likely to cause confusion.⁴

The crux of Applicant's position centers on the purported dissimilarity of its goods and the goods of Registrant due to the specific language highlighted above in Applicant's identification of goods (namely, the language "associated with William Adams, professionally known as 'will.i.am'"). After a final refusal issued, Applicant appealed. Applicant's counsel and the Examining Attorney filed briefs, and both appeared at an oral hearing. We affirm the refusal of registration. *See In re i.am.symbolic, llc*, ___USPQ2d___, S.N. 85044494 (TTAB Oct. 7, 2015).

Background

William Adams is an American musician known by his stage name "will.i.am" as the front man of the music group The Black Eyed Peas. The evidence shows that

³ Registration No. 3188447, issued December 26, 2006; Section 8 affidavit accepted. The registration is owned by Beeline GmbH.

⁴ The Examining Attorney, in the final refusal dated October 6, 2013 (as shown in the USPTO's TSDR database), indicated that Applicant's options included deletion of "sunglasses and sunglass cases" from the identification or a request to divide out the other goods in Class 9 to which the refusal did not pertain, pursuant to Trademark Rule 2.87. *See generally* TMEP §§ 1110 *et seq.* (July 2015) (regarding the requirements for filing a request to divide). However, Applicant did not file a request to divide. *See* TBMP §§ 1202.05, 1205.02 (2015). Nevertheless, it is clear from both the Examining Attorney's final refusal and appeal brief that the refusal to register pertains to only "sunglasses and sunglass cases" in the application. TBMP § 1202.05 provides, in pertinent part, that if no request to divide is filed, after the appeal is decided, the application, containing only those goods for which no refusal was made (and any goods for which the refusal has been reversed), will be published for opposition. Accordingly, the application will proceed with the remaining goods in Class 9.

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Mr. Adams became well-known as a member of that highly successful group, and that he has embarked in expanding his career beyond music, to acting, fashion and political advocacy. Applicant, by way of assignment from Mr. Adams, owns the following registrations: WILL.I.AM (in standard characters) for “series of pre-recorded phonograph records, CDs and audio cassettes featuring music; series of pre-recorded video tapes and DVDs featuring music videos and musical performances” in International Class 9;⁵ and for “entertainment services, namely, live musical performances by a male artist; and fashion designer” in International Class 41;⁶ and I AM (typed drawing) for “clothing, namely, hats, caps, socks, shirts, t-shirts, sweatshirts, tank tops, shorts, pants, sweatpants, jeans, swimwear, swimsuits, beachwear and footwear, namely, shoes, athletic footwear, boots, clogs, sneakers and sandals” in International Class 25.⁷ As discussed further below, Applicant contends that its I AM mark now sought to be registered is a natural extension of its registered WILL.I.AM and I AM marks, and “conveys the synthesis of [Mr. Adams’] own artistry, expression, and activism.” (Response, March 14, 2011).

Discussion

Applicant contends that there is no likelihood of confusion because its mark identifies Applicant’s founder “will.i.am”; Applicant’s goods are exclusively

⁵ Registration No. 3678106, issued September 1, 2009 on the Supplemental Register.

⁶ Registration No. 3707981, issued November 10, 2009.

⁷ Registration No. 2433688, issued March 6, 2001; renewed. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i).

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associated with Applicant's founder "will.i.am"; the goods under the respective marks are marketed differently; and the cited mark is not famous.

Applicant filed excerpts of Registrant's website. The Examining Attorney introduced copies of numerous third-party registrations.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). "In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods." *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1217 (TTAB 2008). *See also Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("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.").

In determining the issue of likelihood of confusion, we are guided by the following legal principles that pertain to the first and second *du Pont* factors. With respect to the first *du Pont* factor, we must 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 *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the

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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). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With respect to the second *du Pont* factor regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014), (quoting *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

"Associated With" Language in Identification of Goods

We first address Applicant's main argument against the refusal, that is, that the language "associated with William Adams, professionally known as 'will.i.am'" in its identification of goods ensures that consumers are unlikely to be confused as to the source of the goods. Applicant contends that its goods represent a creative extension of Mr. Adams' growing commercial interests beyond music. However, we view the language "associated with William Adams, professionally known as 'will.i.am'" in Applicant's identification of goods as merely highlighting an association with

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Applicant's presumed principal, Mr. Adams.⁸ Contrary to Applicant's assertion, we do not see the language as imposing a meaningful limitation on Applicant's goods in any fashion, most especially with respect to either trade channels or class of purchasers. The language does not, in any meaningful way, alter the nature of the goods identified; nor does it represent that the goods will be marketed in any particular, limited way, through any particular, limited trade channels, or to any particular class of customers. It does not even represent that Mr. Adams will be named, or otherwise identified, in the promotion of the goods. The language "associated with William Adams, professionally known as 'will.i.am'" is precatory language, and not binding on consumers when they encounter Applicant's mark. *Cf. M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (based on restrictions to specific industries in both of the identifications of goods in Opposer's registration and Applicant's application, the goods are unrelated and travel in different trade channels to different purchasers). Purchasers are unlikely to know of the assertion in a registration issued to Applicant that Applicant's goods are limited to those associated with Mr. Adams.

Applicant also argues that its mark will be perceived as identifying Mr. Adams, and that this perception will, in some way, affect the marketing of the goods and the customers to whom they are directed. It should be noted, however, that Applicant is seeking to register the mark I AM, not WILL.I.AM. The record falls short of establishing that Mr. Adams is widely known by "i.am" (as opposed to "will.i.am"),

⁸ As indicated earlier, Mr. Adams transferred his rights in the applied-for mark and ownership of the application to Applicant. In the appeal brief, Mr. Adams is referred to as Applicant's "founder and manager." (12 TTABVue 4).

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or that “i.am” and “will.i.am” are used interchangeably by either Mr. Adams or the public; Applicant’s registration for the mark I AM (which it acquired by assignment) does not persuade us to the contrary. In this connection, we note that Applicant’s registration for the mark WILL.I.AM includes a statement that “[t]he name shown in the mark identifies a living individual whose consent to register is of record.” Although the lack of such a statement is not proof that a mark does not identify a particular living individual, we note Applicant’s registration for the mark I AM for clothing does not include such a statement.

Applicant is seeking to register the mark I AM (no periods), and not WILL.I.AM. Even if we were to accept Applicant’s contention that Mr. Adams is known by “i.am” and that this brand has gained notoriety, the statute still “protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). As the Federal Circuit stated:

The term “reverse confusion” has been used to describe the situation where a significantly larger or prominent newcomer “saturates the market” with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957 & n.12, 24 USPQ2d 1001, 1010 & n.12 (7th Cir. 1992), *cert. denied*, 61 U.S.L.W. 3621 (U.S. Apr. 19, 1993) (No. 92-1400). The junior user does not seek to benefit from the goodwill of the senior user; however, the senior user may experience diminution or even loss of its mark’s identity and goodwill due to extensive use of a confusingly similar mark by the junior user. *Banff, Ltd. v. Federated Department Stores, Inc.*, 841 F.2d 486, 490, 6 USPQ2d 1187, 1191 (2d Cir. 1988); *Ameritech, Inc. v. American Information*

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Technologies Corp., 811 F.2d 960, 966, 1 USPQ2d 1861, 1866 (6th Cir. 1987).

The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. *See DeCosta v. Viacom International Inc.*, 981 F.2d 602, 607-10, 25 USPQ2d 1187, 1191-93 (1st Cir. 1992).

The language in the identification of goods simply is not a reasonable basis to assume that purchasers would be able to distinguish the source of such goods from those emanating from the prior Registrant. As we view it, the language essentially is a distinction without a difference for purposes of our likelihood of confusion analysis.

We now turn to consideration of the relevant *du Pont* factors. We state, at the outset, that we have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion.

Relatedness of the Goods and Channels of Trade

We begin our analysis with the second *du Pont* factor, which deals with the similarity of the goods. Applicant's goods in Class 9 are identified, in part, as "sunglasses and sunglass cases associated with William Adams, professionally known as 'will.i.am'"; Registrant's goods are identified in part as "sunglasses." Although we have considered the additional language in Applicant's identification when comparing these goods, we reiterate that we see it as a distinction without a

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difference for purposes of our analysis. We find the goods to be essentially identical, and this factor weighs heavily in favor of a likelihood of confusion.

Further, because we do not view the additional language as restricting Applicant's identification, we presume that the goods travel through all usual channels of trade and are offered to all normal potential purchasers. These trade channels would include optical sections of department stores, online retailers, and retail stores specializing in sunglasses. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). The classes of purchasers would include ordinary consumers, who would be expected to exercise nothing more than ordinary care in purchasing sunglasses and sunglass cases and, because sunglasses can be inexpensive items, may even purchase them on impulse. "When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Specialty Brands, Inc. v. Coffee Bean*

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Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984). The identity in trade channels and purchasers and the conditions under which and buyers to whom sales are made are factors that weigh in favor of a finding of a likelihood of confusion.

Similarity of the Marks

We now turn to the first *du Pont* factor, which deals with the similarity of the marks. We are mindful that where, as here, the goods are legally identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The marks are similar in appearance due to the common element I AM, which comprises the entirety of each mark. Moreover, because Applicant's mark is in standard characters, the marks may be considered to be legally identical. The stylization of Registrant's mark is insufficient to distinguish it from Applicant's mark. Because Applicant's mark is presented in standard characters, Applicant is not limited to any particular depiction of its mark. Thus, if Applicant were to obtain a registration, Applicant would be entitled to all depictions of its standard character mark regardless of the font style, size, or color; Applicant's mark could at any time

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in the future be displayed in a manner similar to Registrant's mark, that is, the terminology I AM displayed in the same font style and size. *In re Viterro Inc.*, 101 USPQ2d at 1909-10; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that a mark in standard character format (typed) is distinct from a mark in a stylized format; "[b]y presenting its mark in a typed drawing, a difference cannot legally be asserted by that party").

The marks are identical in sound. As to connotation, there is also no question that typical customers know the meaning of the words I AM; accordingly, both marks would immediately be perceived to have the same literal meaning.

Applicant also refers to excerpts of Registrant's website in an attempt to show that the marks are somehow different, with Registrant's mark representing a "declaration of love to a modern and feminine lifestyle," which "is consistent with the informal and feminine flair conveyed by the highly cursive, lower-case font style of the mark." (Brief, p. 11, 12 TTABVue 14). Regardless of how Applicant or Registrant currently intends to promote its mark, it is indisputable that the two marks at issue are legally identical, carry the same meaning, and have the potential to be used (at least in terms of their grammatical meaning) in exactly the same manner. Aside from our serious doubts that consumers would consider the website excerpts as conveying the meanings asserted by Applicant, we do not look to extrinsic evidence to distinguish the meaning of the mark, since such material can

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be changed at any time. Further, it is not clear to what extent the public would be aware of the website material when purchasing Registrant's sunglasses at a bricks and mortar location. Finally, Applicant has not argued, and we see no basis for finding that these legally identical marks would have different meanings because of the nature of the goods. *Cf. In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977). Thus, although we acknowledge Applicant's intentions in this regard and Registrant's marketing surrounding the registered mark, we find that the marks, when used in connection with the goods as set forth in the identifications of goods, would be perceived similarly.

Given the similarities between the marks, we find that the marks I AM in standard characters and I AM in a stylized format engender similar overall commercial impressions. The similarity, if not legal identity, of the marks weighs in favor of a finding of a likelihood of confusion.

Other Factors

The purported lack of fame of Registrant's mark, as argued by Applicant, is of little consequence. *See* TMEP § 1207.01(d)(ix). Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the Examining Attorney to submit evidence as to the fame of the cited mark in an *ex parte* proceeding. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). And, in an *ex parte* analysis of the *du Pont* factors for determining likelihood of confusion, the "fame of the mark" factor is normally treated as neutral when no

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evidence as to fame has been provided. *See id.*; *see also In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (noting that the absence of evidence as to the fame of the registered mark “is not particularly significant in the context of an *ex parte* proceeding”).⁹

After considering all of the evidence properly of record and arguments pertaining to the relevant *du Pont* likelihood of confusion factors, we find that there is a likelihood of confusion between Applicant’s mark covering sunglasses and sunglass cases and Registrant’s mark for sunglasses.

Decision: The refusal of registration is affirmed. However, the application will proceed to publication for the Class 9 goods for which no refusal was made (that is, the entire Class 9 identification, **except** “sunglasses and sunglass cases associated with William Adams, professionally known as ‘will.i.am’”).

⁹ Applicant’s fame or renown is another matter. The fame of *either* mark increases the likelihood of confusion by making it more likely that purchasers will remember the famous mark and think of it when encountering similar goods sold under a similar mark. Of course, such likelihood of confusion is only a reason to *refuse* a new registration, not grant one. To the extent that Mr. Adams and Applicant’s mark are well-known, such fact supports refusal of Applicant’s application, because when confusion is likely, it is the prior Registrant which must prevail. Even if it eclipses the renown of the prior Registrant, Applicant’s fame does not entitle it to usurp the cited Registrant’s rights in the mark.

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

In re i.am.symbolic, llc	)	
Serial No. 85/044,495	)	
Filed : May 21, 2010	)	Appeal No. 2016-
<u>Mark: I AM</u>	)	

NOTICE FORWARDING CERTIFIED LIST

A notice of appeal to the United States Court of Appeals for the Federal Circuit was timely filed on December 7, 2015, in the United States Patent and Trademark Office in connection with the above-identified trademark application. Pursuant to 15 U.S.C. § 1071(a)(3) and Federal Circuit Rule 17(b)(1), the United States Patent and Trademark Office (USPTO) is today forwarding, to counsel for Appellant, a certified list of documents comprising the record in the USPTO.

Associate Solicitors Mary Beth Walker and Thomas L. Casagrande are representing the Director in this appeal. Counsel for Appellant may contact Ms. Walker or Mr. Casagrande at (571) 272-9035 to arrange for designating the appendix. *See generally* Fed. Cir. Rule 30(b).

If a copy of the notice of appeal and the docketing fee of \$500.00 have not been filed with the Federal Circuit, counsel is reminded that a copy

of the notice and the docketing fee should be promptly filed with the Federal Circuit.

The mailing address of the Federal Circuit is:

U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

Respectfully submitted,

Michelle K. Lee
Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office

Date: January 19, 2016

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Docket No. 29WV-165530 – Class 9

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

i.am.symbolic, llc,

Appellant,

v.

United States Patent and Trademark Office,
Trademark Trial and Appeal Board,

Appellee.

NOTICE OF APPEAL

Appellant i.am.symbolic, llc (“Appellant”) hereby gives notice of its appeal of the Order of the Trademark Trial and Appeal Board refusing registration of I AM in Class 9, Serial No. 85/044,495, entered on October 7, 2015 (the “Order”). Appellant received the Order on October 7, 2015. A copy of the Order is attached hereto.

Respectfully submitted,

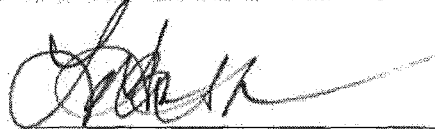
Dated: December 7, 2015


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Attorneys for Applicant i.am.symbolic, llc

CERTIFICATE OF MAILING

I hereby certify that the foregoing Notice of Appeal has been served upon the Trademark Trial and Appeal Board by depositing a copy thereof in an envelope addressed to: U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, with a duplicate copy served upon the Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7th day of December, 2015. A copy of the foregoing Notice of Appeal has also been filed with the United States Court of Appeals for the Federal Circuit.



LaTrina A. Martin

SMRH:473837555.1

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The crux of Applicant's position centers on the purported dissimilarity of its goods and the goods of Registrant due to the specific language highlighted above in Applicant's identification of goods (namely, the language "associated with William Adams, professionally known as 'will.i.am'"). After a final refusal issued, Applicant appealed. Applicant's counsel and the Examining Attorney filed briefs, and both appeared at an oral hearing. We affirm the refusal of registration. *See In re i.am.symbolic, llc*, ___USPQ2d___, S.N. 85044494 (TTAB Oct. 7, 2015).

Background

William Adams is an American musician known by his stage name "will.i.am" as the front man of the music group The Black Eyed Peas. The evidence shows that

³ Registration No. 3188447, issued December 26, 2006; Section 8 affidavit accepted. The registration is owned by Beeline GmbH.

⁴ The Examining Attorney, in the final refusal dated October 6, 2013 (as shown in the USPTO's TSDR database), indicated that Applicant's options included deletion of "sunglasses and sunglass cases" from the identification or a request to divide out the other goods in Class 9 to which the refusal did not pertain, pursuant to Trademark Rule 2.87. *See generally* TMEP §§ 1110 *et seq.* (July 2015) (regarding the requirements for filing a request to divide). However, Applicant did not file a request to divide. *See* TBMP §§ 1202.05, 1205.02 (2015). Nevertheless, it is clear from both the Examining Attorney's final refusal and appeal brief that the refusal to register pertains to only "sunglasses and sunglass cases" in the application. TBMP § 1202.05 provides, in pertinent part, that if no request to divide is filed, after the appeal is decided, the application, containing only those goods for which no refusal was made (and any goods for which the refusal has been reversed), will be published for opposition. Accordingly, the application will proceed with the remaining goods in Class 9.

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Mr. Adams became well-known as a member of that highly successful group, and that he has embarked in expanding his career beyond music, to acting, fashion and political advocacy. Applicant, by way of assignment from Mr. Adams, owns the following registrations: WILL.IAM (in standard characters) for “series of pre-recorded phonograph records, CDs and audio cassettes featuring music; series of pre-recorded video tapes and DVDs featuring music videos and musical performances” in International Class 9;⁵ and for “entertainment services, namely, live musical performances by a male artist; and fashion designer” in International Class 41;⁶ and I AM (typed drawing) for “clothing, namely, hats, caps, socks, shirts, t-shirts, sweatshirts, tank tops, shorts, pants, sweatpants, jeans, swimwear, swimsuits, beachwear and footwear, namely, shoes, athletic footwear, boots, clogs, sneakers and sandals” in International Class 25.⁷ As discussed further below, Applicant contends that its I AM mark now sought to be registered is a natural extension of its registered WILL.IAM and I AM marks, and “conveys the synthesis of [Mr. Adams’] own artistry, expression, and activism.” (Response, March 14, 2011).

Discussion

Applicant contends that there is no likelihood of confusion because its mark identifies Applicant’s founder “will.i.am”; Applicant’s goods are exclusively

⁵ Registration No. 3678106, issued September 1, 2009 on the Supplemental Register.

⁶ Registration No. 3707981, issued November 10, 2009.

⁷ Registration No. 2433688, issued March 6, 2001; renewed. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i).

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associated with Applicant's founder "will.i.am"; the goods under the respective marks are marketed differently; and the cited mark is not famous.

Applicant filed excerpts of Registrant's website. The Examining Attorney introduced copies of numerous third-party registrations.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). "In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods." *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1217 (TTAB 2008). *See also Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("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.").

In determining the issue of likelihood of confusion, we are guided by the following legal principles that pertain to the first and second *du Pont* factors. With respect to the first *du Pont* factor, we must compare the marks in their entirety 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 *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the

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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). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With respect to the second *du Pont* factor regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registration. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014), (quoting *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

"Associated With" Language in Identification of Goods

We first address Applicant's main argument against the refusal, that is, that the language "associated with William Adams, professionally known as 'will.i.am'" in its identification of goods ensures that consumers are unlikely to be confused as to the source of the goods. Applicant contends that its goods represent a creative extension of Mr. Adams' growing commercial interests beyond music. However, we view the language "associated with William Adams, professionally known as 'will.i.am'" in Applicant's identification of goods as merely highlighting an association with

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Applicant's presumed principal, Mr. Adams.⁸ Contrary to Applicant's assertion, we do not see the language as imposing a meaningful limitation on Applicant's goods in any fashion, most especially with respect to either trade channels or class of purchasers. The language does not, in any meaningful way, alter the nature of the goods identified; nor does it represent that the goods will be marketed in any particular, limited way, through any particular, limited trade channels, or to any particular class of customers. It does not even represent that Mr. Adams will be named, or otherwise identified, in the promotion of the goods. The language "associated with William Adams, professionally known as 'will.i.am'" is precatory language, and not binding on consumers when they encounter Applicant's mark. *Cf. M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (based on restrictions to specific industries in both of the identifications of goods in Opposer's registration and Applicant's application, the goods are unrelated and travel in different trade channels to different purchasers). Purchasers are unlikely to know of the assertion in a registration issued to Applicant that Applicant's goods are limited to those associated with Mr. Adams.

Applicant also argues that its mark will be perceived as identifying Mr. Adams, and that this perception will, in some way, affect the marketing of the goods and the customers to whom they are directed. It should be noted, however, that Applicant is seeking to register the mark I AM, not WILL.IAM. The record falls short of establishing that Mr. Adams is widely known by "i.am" (as opposed to "will.i.am"),

⁸ As indicated earlier, Mr. Adams transferred his rights in the applied-for mark and ownership of the application to Applicant. In the appeal brief, Mr. Adams is referred to as Applicant's "founder and manager." (12 TTABVUE 4).

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or that “i.am” and “will.i.am” are used interchangeably by either Mr. Adams or the public; Applicant’s registration for the mark I AM (which it acquired by assignment) does not persuade us to the contrary. In this connection, we note that Applicant’s registration for the mark WILL.IAM includes a statement that “[t]he name shown in the mark identifies a living individual whose consent to register is of record.” Although the lack of such a statement is not proof that a mark does not identify a particular living individual, we note Applicant’s registration for the mark I AM for clothing does not include such a statement.

Applicant is seeking to register the mark I AM (no periods), and not WILL.IAM. Even if we were to accept Applicant’s contention that Mr. Adams is known by “i.am” and that this brand has gained notoriety, the statute still “protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). As the Federal Circuit stated:

The term “reverse confusion” has been used to describe the situation where a significantly larger or prominent newcomer “saturates the market” with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957 & n.12, 24 USPQ2d 1001, 1010 & n.12 (7th Cir. 1992), *cert. denied*, 61 U.S.L.W. 3621 (U.S. Apr. 19, 1993) (No. 92-1400). The junior user does not seek to benefit from the goodwill of the senior user; however, the senior user may experience diminution or even loss of its mark’s identity and goodwill due to extensive use of a confusingly similar mark by the junior user. *Banff, Ltd. v. Federated Department Stores, Inc.*, 841 F.2d 486, 490, 6 USPQ2d 1187, 1191 (2d Cir. 1988); *Ameritech, Inc. v. American Information*

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Technologies Corp., 811 F.2d 960, 966, 1 USPQ2d 1861, 1866 (6th Cir. 1987).

The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. See *DeCosta v. Viacom International Inc.*, 981 F.2d 602, 607-10, 25 USPQ2d 1187, 1191-93 (1st Cir. 1992).

The language in the identification of goods simply is not a reasonable basis to assume that purchasers would be able to distinguish the source of such goods from those emanating from the prior Registrant. As we view it, the language essentially is a distinction without a difference for purposes of our likelihood of confusion analysis.

We now turn to consideration of the relevant *du Pont* factors. We state, at the outset, that we have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion.

Relatedness of the Goods and Channels of Trade

We begin our analysis with the second *du Pont* factor, which deals with the similarity of the goods. Applicant's goods in Class 9 are identified, in part, as "sunglasses and sunglass cases associated with William Adams, professionally known as 'will.i.am'"; Registrant's goods are identified in part as "sunglasses." Although we have considered the additional language in Applicant's identification when comparing these goods, we reiterate that we see it as a distinction without a

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difference for purposes of our analysis. We find the goods to be essentially identical, and this factor weighs heavily in favor of a likelihood of confusion.

Further, because we do not view the additional language as restricting Applicant's identification, we presume that the goods travel through all usual channels of trade and are offered to all normal potential purchasers. These trade channels would include optical sections of department stores, online retailers, and retail stores specializing in sunglasses. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). The classes of purchasers would include ordinary consumers, who would be expected to exercise nothing more than ordinary care in purchasing sunglasses and sunglass cases and, because sunglasses can be inexpensive items, may even purchase them on impulse. "When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Specialty Brands, Inc. v. Coffee Bean*

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Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984). The identity in trade channels and purchasers and the conditions under which and buyers to whom sales are made are factors that weigh in favor of a finding of a likelihood of confusion.

Similarity of the Marks

We now turn to the first *du Pont* factor, which deals with the similarity of the marks. We are mindful that where, as here, the goods are legally identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The marks are similar in appearance due to the common element I AM, which comprises the entirety of each mark. Moreover, because Applicant's mark is in standard characters, the marks may be considered to be legally identical. The stylization of Registrant's mark is insufficient to distinguish it from Applicant's mark. Because Applicant's mark is presented in standard characters, Applicant is not limited to any particular depiction of its mark. Thus, if Applicant were to obtain a registration, Applicant would be entitled to all depictions of its standard character mark regardless of the font style, size, or color; Applicant's mark could at any time

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in the future be displayed in a manner similar to Registrant's mark, that is, the terminology I AM displayed in the same font style and size. *In re Viterra Inc.*, 101 USPQ2d at 1909-10; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that a mark in standard character format (typed) is distinct from a mark in a stylized format; "[b]y presenting its mark in a typed drawing, a difference cannot legally be asserted by that party").

The marks are identical in sound. As to connotation, there is also no question that typical customers know the meaning of the words I AM; accordingly, both marks would immediately be perceived to have the same literal meaning.

Applicant also refers to excerpts of Registrant's website in an attempt to show that the marks are somehow different, with Registrant's mark representing a "declaration of love to a modern and feminine lifestyle," which "is consistent with the informal and feminine flair conveyed by the highly cursive, lower-case font style of the mark." (Brief, p. 11, 12 TTABVue 14). Regardless of how Applicant or Registrant currently intends to promote its mark, it is indisputable that the two marks at issue are legally identical, carry the same meaning, and have the potential to be used (at least in terms of their grammatical meaning) in exactly the same manner. Aside from our serious doubts that consumers would consider the website excerpts as conveying the meanings asserted by Applicant, we do not look to extrinsic evidence to distinguish the meaning of the mark, since such material can

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be changed at any time. Further, it is not clear to what extent the public would be aware of the website material when purchasing Registrant's sunglasses at a bricks and mortar location. Finally, Applicant has not argued, and we see no basis for finding that these legally identical marks would have different meanings because of the nature of the goods. *Cf. In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977). Thus, although we acknowledge Applicant's intentions in this regard and Registrant's marketing surrounding the registered mark, we find that the marks, when used in connection with the goods as set forth in the identifications of goods, would be perceived similarly.

Given the similarities between the marks, we find that the marks I AM in standard characters and I AM in a stylized format engender similar overall commercial impressions. The similarity, if not legal identity, of the marks weighs in favor of a finding of a likelihood of confusion.

Other Factors

The purported lack of fame of Registrant's mark, as argued by Applicant, is of little consequence. *See* TMEP § 1207.01(d)(ix). Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the Examining Attorney to submit evidence as to the fame of the cited mark in an *ex parte* proceeding. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). And, in an *ex parte* analysis of the *du Pont* factors for determining likelihood of confusion, the "fame of the mark" factor is normally treated as neutral when no

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evidence as to fame has been provided. *See id.*; *see also In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (noting that the absence of evidence as to the fame of the registered mark “is not particularly significant in the context of an *ex parte* proceeding”).⁹

After considering all of the evidence properly of record and arguments pertaining to the relevant *du Pont* likelihood of confusion factors, we find that there is a likelihood of confusion between Applicant’s mark covering sunglasses and sunglass cases and Registrant’s mark for sunglasses.

Decision: The refusal of registration is affirmed. However, the application will proceed to publication for the Class 9 goods for which no refusal was made (that is, the entire Class 9 identification, **except** “sunglasses and sunglass cases associated with William Adams, professionally known as ‘will.i.am’”).

⁹ Applicant’s fame or renown is another matter. The fame of *either* mark increases the likelihood of confusion by making it more likely that purchasers will remember the famous mark and think of it when encountering similar goods sold under a similar mark. Of course, such likelihood of confusion is only a reason to *refuse* a new registration, not grant one. To the extent that Mr. Adams and Applicant’s mark are well-known, such fact supports refusal of Applicant’s application, because when confusion is likely, it is the prior Registrant which must prevail. Even if it eclipses the renown of the prior Registrant, Applicant’s fame does not entitle it to usurp the cited Registrant’s rights in the mark.