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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gabriel J. Carrera

Serial No. 87133450

Barry L. Haley of Malin Haley DiMaggio & Bowen, P.A.
for Gabriel J. Carrera

Jonathan R. Falk, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Cataldo, Heasley, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background and Evidentiary Matter

Gabriel J. Carrera ("Applicant") seeks registration on the Principal Register of the mark ATTORNEY THAT RIDES in standard characters for "Legal services" in

International Class 45.[1] The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark THE ORIGINAL ATTORNEYS WHO RIDE in standard characters, with ORIGINAL ATTORNEYS disclaimed, for services including "Legal services" in International Class 45.[2] After the Examining Attorney made the refusal final, Applicant appealed.

Before turning to the merits, we exclude the list of third-party registrations Applicant offered for the first time in its Reply Brief.[3] Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides that the record should be complete prior to the filing of an appeal. *See also In re Procter & Gamble Co.,* 105 USPQ2d 1119, 1120 (TTAB 2012) (the applicant's discussion in its brief of third-party registrations not considered because the registrations were not properly introduced during the examination process); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.02(e) (2018) ("Evidentiary references made in briefs but not supported by timely submissions may not be considered."). Regardless, a mere list of third-party registrations, without the underlying registrations themselves, does not suffice to make them of record. *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996) ("In order to make third-party registrations properly of record in a proceeding such as this, applicant should submit copies of the registrations themselves, or the

[1] Application Serial No. 87133450 was filed August 10, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on alleged use of the mark in commerce.

[2] Registration No. 5113286 issued January 3, 2017.

[3] 9 TTABVUE 6.

electronic equivalent thereof, namely, printouts from the electronic records of the Patent and Trademark Office's Trademark Automated Search System").

II. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as "*du Pont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the relatedness of the services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *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 [or services] and differences in the marks.").

A. The Services, Trade Channels, and Classes of Consumers

The subject application and cited registration both identify "legal services." Thus, the services at issue are identical. We must therefore presume that the channels of trade and potential consumers are also identical. *See In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

Thus, the second and third *du Pont* factors weigh strongly in favor of a finding of likely confusion.

B. Similarity of the Marks

We turn to comparing ATTORNEY THAT RIDES to THE ORIGINAL ATTORNEYS WHO RIDE "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). We bear in mind that where, as here, marks would appear on identical services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir.1992); *Viterra*, 101 USPQ2d at 1908.

The marks are alike in their meaning and commercial impression because they refer to a lawyer or lawyers who ride. Applicant's specimen of use and evidence submitted by Applicant indicate that "ride" in both cases refers lawyers who ride motorcycles.[4] As the Examining Attorney characterizes it, "[b]oth marks contain the

[4] Applicant's December 20, 2017 Response to Office Action at .pdf 6-9.

wording 'ATTORNEY' or its plural followed by 'RIDE' with a pronoun in between."[5] While the cited mark includes the additional wording THE ORIGINAL at the beginning, this article and adjective modify the more dominant phrase ATTORNEYS WHO RIDE. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("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"); *see also Stone Lion Capital Partners v. Lion Capital LLP,* 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). In the context of this mark, the disclaimed term ORIGINAL conveys a laudatory sense, while the term THE has no source-indicating significance. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE "virtually identical" marks; "[t]he addition of the work 'The' at the beginning of the registered mark does not have any trademark significance."). And although Applicant's mark refers to ATTORNEY in the singular while the cited mark refers to ATTORNEYS in the plural, this difference is minimal. *See Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (singular and plural of SWISS GRILL deemed "virtually identical"); *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (singular and plural forms of SHAPE considered essentially the same mark). The common elements in Applicant's and

[5] 8 TTABVUE 4 (Examining Attorney's Brief).

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