

This Opinion is Not a
Precedent of the TTAB

Mailed: November 3, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Manuel E. Tellez

Serial No. 87229195

Gene Bolmarcich of the Law Offices of Gene Bolmarcich
for Manuel E. Tellez.

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Before Kuhlke, Kuczma, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Manuel E. Tellez (“Applicant”) seeks registration on the Principal Register of the mark SLAY OR PREY in standard characters for “Athletic tops and bottoms for all sports and exercises; Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts;

Clothing, namely, athletic sleeves; Polo knit tops; Polo shirts; T-shirts; Graphic T-shirts; Hoods; Jackets; Jerseys; Short-sleeved or long-sleeved t-shirts; Tops; Wristbands” in International Class 25.¹

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

**PRAY
THEN
SLAY** for “T-shirts; T-shirts for adults” in International Class 25.² After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request, and the appeal then resumed. We reverse the refusal.

II. Likelihood of Confusion

The 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). In any likelihood of confusion analysis, two key considerations are the similarities between

¹ Application Serial No. 87229195 was filed November 10, 2016, based on Applicant’s claim of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 5066234 issued on the Supplemental Register on October 18, 2016. It includes the following description of the mark: “The mark consists of the wording ‘PRAY THEN SLAY’, with horizontal lines above and below the word ‘THEN.’”

the marks and the relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (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 and differences in the marks.”).

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

As to the goods, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the parties’ goods emanate from the same source. In making this analysis of the second *du Pont* factor, we look to the identifications of goods in the application and cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant’s identification of goods includes “T-shirts,” and the cited registration also identifies “T-shirts.” Thus, the goods are identical in part. The Examining Attorney also submitted ample evidence that the other applied-for goods are related to “T-shirts.” The record includes website printouts of the other applied-for goods and “T-shirts” being sold under the same mark, showing consumer exposure to the same source providing such goods under one mark.³ In addition, the record includes use-based third-party registrations that cover the same types of goods under the same

³ March 2, 2017 Office Action at 69-134; March 30, 2017 Denial of Reconsideration at 6-86.

mark,⁴ suggesting that such goods may emanate from the same source. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). We find Applicant's and Registrant's goods identical in part and otherwise closely related.

Turning to the trade channels, we presume, as we must, that Applicant's and Registrant's identical goods move in the *same* normal channels of trade for T-shirts and that they are available to the same classes of consumers. *In re Viterra*, 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).

B. Similarity of the Marks



Comparing Applicant's mark SLAY OR PREY to Registrant's mark pursuant to the first *du Pont* factor, we consider them "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports*, 73 USPQ2d at 1691 (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 goods offered under the respective marks is likely to result. *Coach Servs. Inc. v.*

⁴ March 2, 2017 Office Action at 3-68.

Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs*, 102 USPQ2d at 1551.

The record does not include definitions of any wording from the marks, but we take judicial notice of the following: “Slay” means: “to kill by violence” or, as slang, “to impress strongly; overwhelm, especially by humor: Your jokes slay me.”⁵ “Pray” is defined as “to offer devout petition, praise, thanks, etc., to (God or an object of worship).”⁶ “Prey” means “an animal hunted or seized for food, especially by a carnivorous animal,” “a person or thing that is the victim of an enemy, a swindler, a disease, etc.” or “the action or habit of preying.”⁷ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Clearly, although “prey” and “pray” are phonetic equivalents, their meanings differ sharply. Taking into account this significant difference, we find that Applicant’s mark most likely gives the impression of presenting a choice to either kill⁸ or become a victim by falling prey to a predator. By contrast, we find that the registered mark

⁵ Dictionary.com entry for “slay,” from *The Random House Dictionary*, accessed November 2, 2017.

⁶ Dictionary.com entry for “pray,” from *The Random House Dictionary*, accessed November 2, 2017.

⁷ Dictionary.com entry for “prey,” from *The Random House Dictionary*, accessed November 2, 2017.

⁸ Given the use of “prey” in Applicant’s mark, we find the traditional, rather than slang, meaning of “slay” more applicable.

most likely conveys a command to first confer with the divine through prayer, and next to impress others (the slang meaning of “slay”). The mark may suggest that prayer will lead to making a strong impression on others – i.e. if you pray, then you will slay. Alternatively, Registrant’s mark could be viewed as a call to faith-inspired violence – i.e. to pray and then slay, in the traditional sense of the word. Throughout the prosecution of the application and in her brief, the Examining Attorney has asserted that the marks have the “same commercial impression” and “same connotation,”⁹ with little or no discussion of the distinct meanings of “pray” and “prey” or the implication of each mark as a whole. We disagree with the assertions, and instead find the overall connotations and commercial impressions of Applicant’s and Registrant’s marks dissimilar.

Admittedly, the appearance and sound of the marks are somewhat similar because of the shared term “slay” and the phonetic equivalence and visual similarity of “pray” and “prey.” However, consumers seeing the marks would certainly read and recognize “prey” and “pray” as distinct words. Furthermore, the marks do not look or sound identical because “slay” and “prey”/“pray” are transposed, and the word separating them differs in each mark – “or” versus “then.” While some cases have deemed confusion likely between marks consisting of transposed words, those holdings depended on the transposition “not chang[ing] the overall commercial impression.” *In*

⁹ 14 TTABVUE 5, 9 (Examining Attorney’s Brief); *see also* February 13, 2017 Office Action at 2 (“same connotation” and “same commercial impression”); March 2, 2017 Office Action at 5 and March 20, 2017 Denial of Reconsideration at 4 (both acknowledging Applicant’s argument based on these terms but nonetheless asserting without further explanation that the marks “create the same connotation” and “have the same commercial impression”).

re Wine Society of America Inc., 12 USPQ2d 1139, 1142 (TTAB 1989) (affirming refusal to register THE WINE SOCIETY OF AMERICA & Design based on registration of AMERICAN WINE SOCIETY 1967 & Design, finding that “the transposition of words does not change the overall commercial impression”); *see also Bank of America National Trust and Savings Ass’n v. The American National Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978) (“the words ‘BANKAMERICA’ and ‘BANK OF AMERICA,’ on the one hand, and ‘AMERIBANC,’ on the other, convey the same meaning and create substantially similar commercial impressions”). In this case, where the commercial impressions of the marks differ not only because of the transposition but also because of the different meanings of the wording used in the marks, this line of cases on confusingly similar transposed terms does not apply.

Overall, we find the marks in this case dissimilar, particularly because of their very different connotations and commercial impressions.

III. Conclusion

Notwithstanding that the goods are, in part, identical, and the channels of trade and purchasers overlap, we conclude that the marks are too dissimilar to warrant a determination of likely confusion. We consider this *du Pont* factor dispositive in this case. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (holding that Board did not err in deciding likelihood of confusion based solely on dissimilarity of marks regardless of other *du Pont* factors, that favored a likelihood of confusion, noting that “we have previously upheld Board determinations that one *DuPont* factor may be dispositive in a

likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Kellogg Co. v. Pack'em Ent.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (upholding Board decision that “a single *duPont* factor – the dissimilarity of the marks – was dispositive of the likelihood of confusion issue,” observing “we know of no reason why, in a particular case, a single *duPont* factor may not be dispositive”).

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