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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86135128

MARK: COYOTES ICE SPORTS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Coyotes Ice, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

29098-016

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EXAMINING ATTORNEY'S APPEAL BRIEF

Consolidated Brief for Application Nos. 86135128 and 86135177

Coyotes Ice, LLC (hereinafter referred to as “Applicant”) has appealed the Office’s refusal to register the marks “COYOTES ICE SPORTS” (one in standard characters and the other in stylized form) for use in International Class 35 with “Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags” due to a likelihood of confusion under Section 2(d) of the Trademark Act with the marks in U.S. Registration No. 3655451, namely, W COYOTE (in stylized form) in International Class 35 for use with “Retail sporting goods stores,” U.S. Registration No. 3688377, namely, W COYOTE OUTDOORS (in stylized form) in International Class 35 for use with “On-line retail store services featuring Outdoor equipment and sport goods,” and U.S. Registration No. 4379914, namely, RED COYOTE and design in International Class 35 for use with “Computerized on-line retail store services in the field of running and fitness; On-line retail store services featuring shirts; t-shirts; singlets; shorts; sports jackets; wind jackets; hats; visors; beanies; arm warmers; Retail apparel stores; Retail sporting goods stores; Retail store services featuring a wide variety of consumer goods of others; Retail clothing stores.”

U.S. Registration No. 3655451 (Reg. ‘451) – W COYOTE – and U.S. Registration No. 3688377 (Reg. ‘377) – W COYOTE OUTDOORS – are owned by WCoyote LLC, and U.S. Registration No. 4379914 (Reg. ‘914) – RED COYOTE – is owned by Red Coyote LLC.

I. FACTS

On December 4, 2013, Applicant applied for registration on the Principal Register of the wording “COYOTES ICE SPORTS” (in standard characters and in stylized form) for use with “Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties.”¹

On March 18, 2014, the Office initially refused registration of the marks because of a likelihood of confusion with the marks in U.S. Registration Nos. 3655451, 3688377, and 4379914, because the marks did not show an association with the identified services, and because the marks differed materially on the drawings and specimens, and required a disclaimer of the words “ICE SPORTS” and an amendment of the identification of services.

On September 18, 2014, Applicant submitted responses to Office action in which Applicant argued against the likelihood of confusion refusal, argued against the determination that the marks differed materially on the drawings and the specimens, amended the mark description, disclaimed the words “ICE SPORTS, and amended the identification of services to: “Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags.

On October 16, 2014, the examining attorney issued final refusals pursuant to Section 2(d) of the Trademark Act with respect to U.S. Registration Nos. 3655451, 3688377, and 4379914, and refused the specimens on the ground that the marks materially differed on the drawings and the specimens.

¹ The records for Application Nos. 86135128 and 86135177 are identical, thus the citations to the record are the same in each case.

On April 16, 2015, Applicant submitted requests for reconsideration in which Applicant argued against the likelihood of confusion refusals and amended the filing bases of the application to intent-to-use pursuant to Section 1(b).

On May 18, 2015, the examining attorney denied the requests for reconsideration with respect to the likelihood of confusion refusals and found that the specimen refusals were moot because Applicant had amended the filing bases of the applications to intent-to-use.

On July 20, 2015, Applicant filed its appeals to the Board.

On August 5, 2015, the examining attorney filed a motion to consolidate the appeals of the likelihood of confusion refusals of U.S. Application Nos. 86135128 and 86135177 because they involve common issues of law and fact, which motion the Board granted.

II. ISSUE

WHETHER A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT EXISTS BETWEEN THE APPLIED-FOR MARK AND THE MARKS IN U.S. REGISTRATION NOS. 3655451, 3688377, and 4379914

III. ARGUMENT

The Court in *In re E.I. du Pont de Nemours* listed the principal factors to be considered in determining whether a likelihood of confusion under Section 2(d) of the Trademark Act exists. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In this *ex parte* appeal, the most relevant *du Pont*

factors are the similarity of the marks and similarity or relatedness of the services. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); see TMEP §1207.01. Under the *du Pont* analysis, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1361, 177 USPQ 567); TMEP §1207.01(b)-(b)(v). Additionally, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

COMPARISON OF THE MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

Further, marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Computer Sys. Ctr. Inc.*, 5 USPQ2d 1378, 1381 (TTAB 1987) (holding CSC ADVANCED BUSINESS SYSTEMS for retail computer store services and computer maintenance and repair services in connection therewith, and CSC for various computer-related services, likely to cause confusion, noting that "the inclusion of 'ADVANCED BUSINESS SYSTEMS' as a feature of applicant's mark is not likely to help customers . . . distinguish the source of each party's service"); TMEP §1207.01(b)(ii)-(iii).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

COMPARISON OF THE SERVICES

The services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if

the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i). Thus, where the services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); TMEP §1207.01(b).

A. APPLICANT’S MARK AND REG ‘451 CREATE A SIMILAR COMMERCIAL IMPRESSION BECAUSE THE MARKS ARE SIMILAR IN APPEARANCE, SOUND, AND CONNOTATION

Applicant’s proposed marks are COYOTES ICE SPORTS (in standard characters and in stylized form) with the descriptive wording ICE SPORTS disclaimed, and the registered mark is W COYOTE (in stylized form).

COYOTES is the dominant element in Applicant’s proposed mark because it is the first word in the proposed mark and because it creates a distinctive commercial impression, which, as the evidence attached to the Office action dated March 18, 2014 (“Initial Office Action”) from <http://www.vocabulary.com/dictionary/coyote> and <http://www.merriam-webster.com/dictionary/coyote> shows is that of “a small wild animal that is related to dogs and wolves and that lives in North America.” See Office action dated March 18, 2014, at 25-30. The remaining words in the mark, ICE SPORTS, are disclaimed and are descriptive of Applicant’s identified services (*e.g.*, retail

sporting goods stores and retail stores featuring hockey and figure skating equipment, merchandise and novelties), and, therefore, is less significant or less dominant than COYOTES as a source identifier.

COYOTE also is the dominant element in the registered mark as it is the only word in the registered mark – W COYOTE. Although the letter W precedes the word COYOTE in the registered mark, the letter does not create as significant an impression as does the word COYOTE, which immediately brings to mind a wild animal related to dogs and wolves.

Applicant's proposed mark is similar to the registered mark in terms of appearance and sound because the dominant element in both marks is a form of the word COYOTE, Applicant's proposed mark using the word in the plural case while the registered mark uses the word in the singular case. The difference in the form of the word is not a distinguishing feature in terms of the appearance or sound of these marks. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (finding the singular and plural forms of SHAPE to be essentially the same mark) (citing *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark).

Applicant's proposed mark and the registered mark have a similar connotation and create a similar commercial impression given that the dominant element of both marks is a form of the word COYOTE and given that the marks are for use in connection with similar services.

B. APPLICANT'S AND REG '451'S SERVICES ARE IDENTICAL IN PART

Applicant's identified services are "**Retail sporting goods stores**; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear,

hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags.”

Registrant’s identified services are “**Retail sporting goods stores.**”

Applicant’s and Registrant’s services are identical in part, and Registrant’s services encompass Applicant’s services in the remaining part of the recitation of services. Unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Absent restrictions in an application and/or registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers.

The Internet evidence attached to the Initial Office Action consisting of webpages from the websites of www.dickssportinggoods.com, www.big5sportinggoods.com, and www.sportsauthority.com establishes that it is common for entities that provide retail sporting goods store services to market

hockey equipment. See Office action dated March 18, 2014, at 11-17 (each company's website has a retail store locator). Evidence obtained from the Internet may be used to support a determination under Section 2(d) that services are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009). Therefore, as indicated by the evidence of record, applicant's and registrant's services are related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

C. APPLICANT'S MARK AND REG '377 CREATE A SIMILAR COMMERCIAL IMPRESSION BECAUSE THE MARKS ARE SIMILAR IN APPEARANCE, SOUND, AND CONNOTATION

Applicant's proposed marks are COYOTES ICE SPORTS (in standard characters and in stylized form) with the descriptive wording ICE SPORTS disclaimed, and the registered mark is W COYOTE OUTDOORS (in stylized form) with the descriptive wording OUTDOORS disclaimed.

As discussed in Section III.A of this Brief, COYOTES is the dominant element in Applicant's proposed mark because it is the first word in the proposed mark and because it creates a distinctive commercial impression.

COYOTE also is the dominant element in the registered mark – W COYOTE OUTDOORS. Although the letter W precedes the word COYOTE in the registered mark, the letter does not create as significant an impression as does the word COYOTE. With respect to the word OUTDOORS, it trails the word COYOTE and is descriptive of the on-line retail store services featuring outdoor equipment and sporting goods that Registrant provides. Thus, being descriptive, OUTDOORS is not as dominant or significant as COYOTE as a source indicator. It is the distinctive part of the mark – COYOTE – that consumers are more

likely to remember and use. As stated above, the difference in the form of the word COYOTE is not a distinguishing feature in terms of the appearance or sound of these marks.

Applicant's proposed mark and the registered mark have a similar connotation and create a similar commercial impression given that the dominant element of both marks is a form of the word COYOTE followed by a descriptive word. Specifically, ICE SPORTS and OUTDOORS create a related commercial impression because ice sports are often played outdoors, as indicated by the evidence attached to the final Office action dated October 16, 2014 ("Final Office Action") from

<http://www.pentagonrowskating.com/>, http://powellrec.com/program_details.php?prog_id=305,

<http://www.glenburnieiceskating.com/index.php>,

<http://www.minneapolisparcs.org/default.asp?PageID=677>,

http://www.nytimes.com/2008/01/01/sports/hockey/01hockey.html?_r=0,

<http://www.buffalonews.com/apps/pbcs.dll/article?aid=/20121103/cityandregion/121109717>,

<http://www.anchorage.net/articles/sledding-skating-anchorage>, and

<http://everyoneoutdoors.blogspot.com/2011/12/ice-sleds-available-for-public-skating.html>

This evidence shows that ice sports are often played outdoors, especially ice skating. See final Office action dated October 16, 2014, at 2-9.

Given the similarity between Applicant's proposed mark and the registered mark, consumers would be likely to be confused about the source of Applicant's and Registrant's services if the marks were used in connection with similar or related services.

D. APPLICANT'S AND REG '377'S SERVICES ARE CLOSEY RELATED

Applicant's identified services are "Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags."

Registrant's relevant identified services are "on-line retail store services featuring Outdoor equipment and sport goods."

Applicant's and Registrant's services are closely related, if not identical.

With respect to Applicant's and Registrant's services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

The trademark examining attorney attached evidence to the Final Office Action from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence shows that the services listed therein, namely, "retail sporting goods stores" and "on-line retail store services featuring sporting goods," are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *See* final Office action dated October 16, 2014, at 11-38.

The Internet evidence attached to the Initial Office Action consisting of webpages from the websites of www.dickssportinggoods.com, www.big5sportinggoods.com, and www.sportsauthority.com also establishes that "retail sporting goods stores" and "on-line retail store services featuring sporting goods" are of a kind that may emanate from a single source under a single mark, that it is common for such entities to market hockey equipment, and that the relevant services are provided through the same trade channels. See Office action dated March 18, 2014, at 11-17 (each company's website contains a retail store locator and the means to buy goods online). Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

E. APPLICANT'S MARK AND REG '914 CREATE A SIMILAR COMMERCIAL IMPRESSION BECAUSE THE MARKS ARE SIMILAR IN APPEARANCE, SOUND, AND CONNOTATION

Applicant's proposed marks are COYOTES ICE SPORTS (in standard characters and in stylized form) with the descriptive wording ICE SPORTS disclaimed, and the registered mark is RED COYOTE and a coyote design.

As discussed above, COYOTES is the dominant element in Applicant's proposed mark.

COYOTE also is the dominate element in the registered mark. COYOTE is more significant than RED because COYOTE is a noun that describes the animal at issue and RED is an adjective that describes the coyote's color. See Office action dated March 18, 2014, at 27, which dictionary definition describes a coyote as "a buff-gray to reddish gray North American canid closely related to but smaller than the wolf"). Thus, the addition of the color red to the mark does not change the commercial impression of

the mark as coyotes are naturally a red color. The dominance of the word COYOTE is underscored by the design, which features a drawing of a coyote.

Moreover, where word portion of the marks are similar, the addition of a design element does not obviate the similarity of the marks. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

Applicant's proposed mark is similar to the registered mark in terms of appearance and sound because the dominant element in both marks is a form of the word COYOTE. As discussed above, the difference in the form of the word is not a distinguishing feature in terms of the appearance or sound of these marks. Applicant's mark merely discards the word RED in the registered mark and adds the descriptive words ICE SPORTS.

Given the similarity between Applicant's proposed mark and the registered mark, consumers would be likely to be confused about the source of Applicant's and Registrant's services if the marks were used in connection with similar or related services.

F. APPLICANT'S AND REG '914 SERVICES ARE IDENTICAL IN PART

Applicant's identified services are "**Retail sporting goods stores**; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags."

Registrant's identified services are "Computerized on-line retail store services in the field of running and fitness; On-line retail store services featuring shirts; t-shirts; singlets; shorts; sports jackets; wind jackets; hats; visors; beanies; arm warmers; Retail apparel stores; **Retail sporting goods stores**; Retail store services featuring a wide variety of consumer goods of others; Retail clothing stores."

Applicant's and Registrant's services are identical in part.

Here, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers.

The Internet evidence attached to the Initial Office Action consisting of webpages from the websites of www.dickssportinggoods.com, www.big5sportinggoods.com, and www.sportsauthority.com establishes that it is common for entities that provide retail sporting goods store services to market hockey equipment. See Office action dated March 18, 2014, at 11-17 (each company's website has a retail store locator). Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes.

G. APPLICANT'S ARGUMENTS ARE UNPERSUASIVE

1. ALLEGATIONS OF NO ACTUAL CONFUSION IN AN EX PARTE PROCEEDING ARE NOT PERSUASIVE

Applicant alleges that it is unaware of any instances of actual confusion between Applicant's proposed mark and the registered marks during at least five years of concurrent use. Applicant's Brief at 8-9. However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v.*

Kappa Books, Inc., 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP

§1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Thus, the lack of actual confusion asserted by Applicant is not persuasive.

2. THE REGISTERED MARKS ARE STRONG MARKS

Applicant argues that the word COYOTE is diluted, citing several youth instructional and amateur sports teams in this country that call themselves Coyotes. Applicant's Brief at 13-14; Applicant's Response to Office Action at 3-4, 6, 8-11. Applicant argues that because the cited sports teams call themselves COYOTES, the word COYOTE is diluted for use with retail store sporting goods services in Class 35. Applicant overlooks the fact that entertainment services in the nature of sports exhibitions are complementary services, not competitive services. Therefore, Applicant's sports team dilution argument is not relevant in the instant case.

With regard to Class 35, the evidence attached to the Final Office Action from the USPTO's X-Search database of registered marks and pending applications shows that the only federally registered marks containing the word COYOTE in Class 35 for use with retail sporting goods stores services or online retail store services featuring sporting goods are W COYOTE, W COYOTE OUTDOORS, and RED COYOTE. See final Office action dated October 16, 2014, at 10. Therefore, the three registered marks, which have just two owners, are strong marks for the services at issue here.

3. "W," "OUTDOORS," "RED," AND "ICE SPORTS" ARE NOT THE DOMINANT ELEMENTS IN THE MARKS

Applicant also argues that the examining attorney gave too much weight to the "COYOTE" portion of the marks and no weight to the dominant portion of the marks. Applicant's Brief at 13- 14. Applicant argues that the dominant portions of the marks are "W," "OUTDOORS," "RED," and "ICE SPORTS." *Id.* at 14.

As previously noted, although the letter W precedes the word COYOTE in the Reg. '451 and Reg. '377, the letter, which is the same size as the letter C in COYOTE, does not create as significant an impression as does the word COYOTE, which immediately brings to mind a wild animal. See Office action dated March 18, 2014, at 25-30 (defining "coyote" as a "small wild animal that is related to dogs and wolves and that lives in North America").

OUTDOORS in Reg. '377 is merely descriptive of the "on-line retail store services featuring outdoor equipment and sporting goods" that Registrant provides and is not a source indicator.

With respect to Reg. '914, COYOTE is more significant than RED because COYOTE is a noun that describes the animal at issue and RED is an adjective that modifies the noun, describing the coyote's color.

Regarding Applicant's proposed mark – COYOTES ICE SPORTS, ICE SPORTS, which is disclaimed, is merely descriptive of the Applicant's identified services (*e.g.*, retail sporting goods stores and retail stores featuring hockey and figure skating equipment, merchandise and novelties), and, therefore, is less significant or less dominant as a source indicator. Applicant's own evidence demonstrates this fact. In support of its request for reconsideration, Applicant cited three marks with the same descriptive language, showing that ICE SPORTS is not a source indicator. *See* Request for Reconsideration at 2, 4-5 (webpages from CANLAN ICE SPORTS, CENTER ICE SPORTS COMPLEX, ICE SPORTS FORUM).

With respect to the Applicant's and Registrants' marks, it is the distinctive part of the marks – COYOTE – that consumers are more likely to remember and use.

4. APPLICANT'S APPLICATION AND REGISTRANTS' REGISTRATIONS ARE NOT LIMITED TO THE SERVICES THAT APPLICANT ALLEGES

Applicant erroneously argues that its application for registration is limited to retail sporting goods stores featuring hockey and ice skating equipment and "is thoroughly unrelated to [the identified services in the] cited marks." Applicant's Brief at 18-20. However, the evidence of record, which is the identification of services in Applicant's application, shows that Applicant's identified services include the broad identification "Retail sporting goods stores," which is the identical broad identification of services included in Reg. '451 and Reg. '914 and closely related to the relevant services identified in Reg. '377, *i.e.*, "on-line retail store services featuring outdoor equipment and sport goods."

In support of its argument, Applicant erroneously asserts that Reg. '914 is limited to "Computerized online retail store services in the field of running and fitness," *id.* at 19, even though that registration clearly also includes "Retail sporting goods stores."

With respect to Reg. '451, Applicant overlooks Applicant's identification of "Retail sporting goods stores" and also erroneously takes the position that "Retail sporting goods stores" in Reg. '451 does not encompass Applicant's "Retail sporting goods stores featuring hockey and figure skating equipment." *Id.* at 19-20.

With reference to Reg, '377, Applicant erroneously asserts that the identified online retail services are limited to "outdoor equipment," *id.* at 19, when, in fact, the relevant identified services are "on-line retail store services featuring outdoor equipment and sport goods." Applicant's long list of hockey equipment by definition is a list of sport goods. *See* Office action dated March 18, 2014, at 18-20.

5. APPLICANT'S AND REGISTRANTS' TRADE CHANNELS ARE NOT DISSIMILAR

Based on its erroneous services-limitation argument, which is discussed in the preceding section of this Brief, Applicant further argues that the trade channels for Applicant's and Registrants' services are dissimilar. In addition to misstating the scope of the identified services in Applicant's application and Registrants' registrations, *id.* at 21, Applicant denies that retail sporting goods store services and online retail store services featuring sporting goods, such as hockey and ice skating equipment, are related trade channels. *Id.* at 22. In this regard, Applicant contends that "few if any of the current third party registrations submitted by the Examining Attorney in the record have any probative value to show that retail sporting goods stores and online stores emanate from a single source." *Id.* at 23. However, the

evidence of record is to the contrary. See final Office action dated October 16, 2014, at 11-38 (a complete list is presented below for the Board's convenience).

Mark	Reg. No.	Relevant Class 35 Services
HOCKEYGIANT	2682997	COMPUTERIZED ON-LINE RETAIL SERVICES IN THE FIELD OF HOCKEY EQUIPMENT; ON-LINE RETAIL STORE SERVICES FEATURING HOCKEY EQUIPMENT AND RELATED ACCESSORIES; RETAIL HOCKEY EQUIPMENT STORES; RETAIL APPAREL STORES; [RETAIL SHOP WINDOW DISPLAY ARRANGEMENT SERVICES;] RETAIL SPORTING GOODS STORES.
SPORTSGIANT.COM	2792336	COMPUTERIZED ON-LINE RETAIL SERVICES IN THE FIELD OF SPORTS EQUIPMENT; ON-LINE RETAIL STORE SERVICES FEATURING SPORTS EQUIPMENT AND RELATED ACCESSORIES; RETAIL SPORTS EQUIPMENT STORES; RETAIL APPAREL STORES [; RETAIL SHOP WINDOW DISPLAY ARRANGEMENT SERVICES;] RETAIL SPORTING GOODS STORES.
1 STOP FAN SHOP	3343613	On-line retail store services featuring sports related merchandise; Retail sporting goods stores
JOE'S SPORTS & OUTDOORS	3623722	Retail stores featuring sporting goods, apparel and automotive goods; Retail shops featuring sporting goods, apparel and automotive goods; Retail department stores; On-line retail store services featuring sporting goods, apparel and automotive goods; Retail sporting goods stores.
ALL3SPORTS	3203878	Retail sporting goods stores; retail store services featuring sporting goods; and on-line retail store services featuring sporting goods.

WINNING STROKES	4328002	On-line retail gift shops; On-line retail store services featuring sporting goods and apparel; Retail apparel stores; Retail clothing boutiques; Retail gift shops; Retail sporting goods stores
HEAD PROTECTION ZONE	4456518	On-line retail store services featuring sporting goods, namely, clothing, shoes, helmets, protective padding for playing football, basketball, soccer, cricket, lacrosse, rugby, hockey, squash, baseball, polo, karate, skiing, field hockey, horseback riding, ice hockey, skateboarding, and snowboarding; hand grips for Tennis rackets, baseball bats, bat mitten rackets, hockey sticks, lacrosse sticks, field hockey sticks, cricket bats, polo mallets, ice hockey sticks, racket ball rackets, and squash rackets; and Retail sporting goods stores.
WEBYSHOPS	4546528	Mobile retail store services featuring Sporting Goods; On-line retail store services featuring Sporting Goods; Retail sporting goods stores.
EUROPEAN SPORTS	4561668	Computerized on-line retail store services in the field of sporting goods; on-line retail store services featuring sporting goods; promoting sports competitions and events of others; promoting the interests of people involved and concerned with youth sports; retail apparel stores; retail clothing stores; retail sporting goods stores; retail store services featuring sporting goods, apparel, and uniforms accessible on-line and by telephone, facsimile and mail order
CORE FIVE FITNESS	4271793	On-line retail store services featuring a wide variety of consumer goods of others; On-line retail store services

		featuring sporting goods and equipment, fitness equipment, nutritional products, apparel, sunglasses, and sports injury products.; Retail sporting goods stores
SPORTS AUTHORITY	4317280	retail sporting goods stores; computerized on-line retail store services featuring clothing, footwear, outerwear and headgear; dissemination of advertising for others via an on-line electronic communications network; promoting the goods and services of others by preparing and placing advertisements on a web site accessed through a global computer network; promoting sports teams, competitions and events for others

This evidence and the previously cited Internet evidence clearly demonstrates that retail sporting goods store services and online retail store services featuring sporting goods are related trade channels. See Office action dated March 18, 2014, at 11-17 (each company's website contains a retail store locator and the means to buy goods online).

IV. CONCLUSION

Applicant's proposed mark – COYOTES ICE SPORTS – creates a similar commercial impression to Reg. '451 – W COYOTE – because the marks are similar in appearance, sound, and connotation and because the evidence of record demonstrates that Applicant's and Registrant's services are identical in part.

Applicant's proposed mark – COYOTES ICE SPORTS – creates a similar commercial impression to Reg. '377 – W COYOTE OUTDOORS – because the marks are similar in appearance, sound, and connotation

and because the evidence of record demonstrates that Applicant's and Registrant's services are closely related.

Applicant's proposed mark – COYOTES ICE SPORTS – creates a similar commercial impression to Reg. '914 – RED COYOTE – because the marks are similar in appearance, sound, and connotation and because the evidence of record demonstrates that Applicant's and Registrant's services are identical in part.

Therefore, the refusal as to all three cited registrations being likely to be confused with Applicant's mark should be affirmed.

Respectfully submitted,

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