

07/25/2003TTAB

Exhibits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PUMA AG RUDOLF DASSLER SPORT,)	
)	
Opposer,)	
)	Opposition No. 123,141
v.)	
)	
MOURAD, SAMIR DBA DON REGALON,)	
)	
Applicant.)	
)	

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TROJAN LAW OFFICES

APPLICANT SAMIR MOURAD'S
MOTION FOR SUMMARY JUDGMENT

In accordance with Rule 56(c) of the Federal Rules of Civil Procedure, Applicant, Samir Mourad, moves for summary judgment of the above captioned Opposition. As set forth in the accompanying Memorandum of Points and Authorities, Opposer is estopped from arguing there is a likelihood of confusion between its puma marks and Applicant's tiger mark due to Opposer's previous position during prosecution of one of the cited marks that there was not. Likewise, even if Opposer is not estopped from so arguing, there is no likelihood of confusion. As such, summary judgment must be granted.

DATED: July 11, 2003

Respectfully submitted,

TROJAN LAW OFFICES

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07/25/2003TTAB

TABLE OF CONTENTS

I. Introduction 1

II. Procedural And Factual Background 1

III. Summary Judgment In Favor Of Applicant Is Proper 5

IV. This Opposition Must Fail Because Opposer Is Estopped From Claiming That A Leaping Puma And A Leaping Tiger Are So Similar As To Cause The Public To Be Confused 7

 A. Puma Versus Tiger 8

 B. Puma Versus Panther 8

 C. Puma Versus Lion 9

V. Even If Opposer Is Not Estopped, Prior Statements Are Considered Admissions And May Be Considered Evidence Of The Truth Of The Assertions Therein 10

VI. In The Alternative, There Is No Likelihood Of Confusion .12

 A. Relevant Du Pont Factors 13

 1. The Similarity Or Dissimilarity Of The Marks In Their Entireties As To Appearance, Sound, Connotation And Commercial Impression 13

 2. The Similarity Or Dissimilarity And Nature Of The Goods Or Services As Described In An Application Or Registration Or In Connection With Which A Prior Mark Is In Use 16

 3. The Similarity Or Dissimilarity Of Established, Likely To Continue Trade Channels 17

 4. The Conditions Under Which And Buyers To Whom Sales Are Made ("Impulse" Versus Careful, Sophisticated Purchasing) 18

 5. The Fame Of The Prior Mark (Including Sales, Advertising, Length Of Use). 18

 6. The Number And Nature Of Similar Marks In Use On Similar Goods. 19

7. The Nature And Extent Of Any Actual Confusion.19

8. The Length Of Time During And Conditions Under Which
There Has Been Concurrent Use Without Evidence Of Actual
Confusion.20

9. The Variety Of Goods On Which A Mark Is Or Is Not Used
(House Mark, "Family" Mark, Product Mark).20

12. The Extent Of Potential Confusion (Whether De Minimus
Or Substantial) 20

B. According To The Relevant Du Pont Factors, There Is
No Likelihood Of Confusion Conclusion For The Foregoing
Reasons, Applicant's Motion For Summary Judgment Must
Be Granted. 21

VI. Conclusion21

07/25/2008TTAB

TABLE OF AUTHORITIES

CASES

Anderson v. Liberty Lobby, Inc.,
477 U.S., 248 (1986) 6

Blazon, Inc. v. Blazon Mobile Homes Corp.,
416 F.2d 598, 163 U.S.P.Q. 156 (7th Cir. 1969) 6

Celotex Corp. v Catrett,
477 U.S. 317, 322-23 (1986) 5

Champagne Louis Roederer, S.A. v. Delicato Vineyards,
148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) .
15, 17, 21

Chore-Time Equipment, Inc. v. Cumberland Corporation,
713 F.2d 774, 778-79 (Fed. Cir. 1983) 6

Coro Inc. v. Delsa Mfg. Co. of R.I., Inc.,
119 U.S.P.Q. 58 (Pat. Off. Examiner in Chief 1958) 13

Coro, Inc. v. Erich Schewe O.H.G,
126 U.S.P.Q. 518, WL 7393 (T.T.A.B. 1960) 13

Cunningham v. Laser Golf Corp.,
222 F.3d 943, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000) 12

Exxon Corp. v. National Foodline Corp.,
579 F.2d 1244, 1246, 198 U.S.P.Q. 407, 408 (C.C.P.A. 1978) .6

EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.,
213 U.S.P.Q. 597, 1982 WL 52013 (T.T.A.B. 1982),
aff'd 706 F.2d 1213, 217 U.S.P.Q. 986 (Fed. Cir. 1983) . .
10, 11

First Sav. Bank, F.S.B. v. Bank Sys., Inc.,
101 F.3d 645, 654 (10th Cir. 1996) 19

In re DuPont DeNemours & Co.,
476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973) . . 12,
15, 16, 17, 21

Application of Kopy Kat, Inc.,
182 U.S.P.Q. 372 (C.C.P.A. 1974) 13

Izod Ltd. v. Zip Hosiery Co., Inc.,
160 U.S.P.Q. 202, 405 F.2d 575 (C.C.P.A. 1969) 14

Kay Corp. v. Westfield's, Inc.,
190 U.S.P.Q. 565, 1976 WL 20945 (T.T.A.B. 1976) 7,
8, 9, 10

07/25/2003TAB

Levi Strauss & Co. v. Genesco, Inc.
742 F.2d 1401, 222 U.S.P.Q. 939 (Fed. Cir. 1984)5

Murray v. Cable Nat'l Broadcasting Co.,
86 F.3d 858, 39 U.S.P.Q.2d 1214 (9th Cir. 1996) 6

Petro Stopping Centers L.P. v. James River Petroleum,
130 F.3d 88, 44 U.S.P.Q.2d 1921 (4th Cir. 1997) 7,
9, 10

Pizzeria Uno Corp. v. Temple,
747 F.2d 1522, 1530-31 (4th Cir. 1984)19

Pure Gold, Inc., v. Syntex (U.S.A.), Inc.,
739 F.2d 624 (Fed.Cir.1984) 6

Riverhead Paints Plus, Inc. v. PPG Industries, Inc.,
2 U.S.P.Q.2d 2035, 1987 WL 16877 (E.D.N.Y. 1987)6

Plus Products v. Natural Organics, Inc.,
223 U.S.P.Q. 27, 1984 WL 33 (S.D.N.Y. 1984)7,
9, 10

Shunk Manufacturing Co. v. Tarrant Manufacturing Co.,
137 U.S.P.Q. 881, 883, 318 F.2d 328 (C.C.P.A. 1963)14

Squirrel Brand Co. v. Green Gables Investment Co.,
223 U.S.P.Q. 154, 155 (T.T.A.B. 1984)14

STATUTES

FED.R.CIV.P. 56(c) 5

15 U.S.C.A. § 1052 12

I. INTRODUCTION

In this opposition to the registration of Trademark Application Serial No. 75/936,519, Opposer PUMA AG RUDOLF DASSLER SPORT, (hereinafter "Opposer") seeks to bar Applicant SAMIR MOURAD, doing business as DON REGALON (hereinafter "Applicant") from registering the trademark "V with Leaping Tiger Design" for clothing, namely, t-shirts, overalls, polo shirts, knit shirts, sweaters, belts, ties, pants, shirts, jackets, shorts, suits, socks, and underwear in International Class 025. The sole issues presented by this motion are as follows: First, Opposer is estopped from arguing there is a likelihood of confusion between its puma marks and Applicant's tiger mark due to its previous position during prosecution of one of the cited marks, that there was not; and second, even if Opposer is not estopped from so arguing, there is no likelihood of confusion.

II. PROCEDURAL AND FACTUAL BACKGROUND

Samir Mourad is the sole owner and president of Don Regalon, and is the Applicant in this Opposition. See ¶ 1 to the Declaration of Samir Mourad (hereinafter "Mourad Dec."). Applicant owns United States Trademark Registration No. 2,500,926 for the word mark VARESSI registered October 23, 2001 for clothing; Serial No. 75/942,066 for VARESSI JEANS with a tiger's head design encircled in a Greek key design, which has been allowed for registration and a Statement of Use has been accepted for clothing; Serial No. 75/936,520 for VARESSI with a leaping tiger design (being separately opposed by Opposer in proceeding

07/25/2003TTAB

No. 152,132), and Serial No. 75/936,519 for a V with a leaping tiger design, which is the subject of this Opposition. See ¶ 2, Mourad Dec.

These four marks are a part of a family of marks. The "V" in the instant application stands for the letter "V" in VARESSI. Likewise, the tiger shown either straight on or as a leaping figure is also symbolic of Applicant's goods. Taken in concert, all four of the above marks evidence Applicant's adoption of a tiger logo and the word or a shortened version of VARESSI as indicative of his clothing. See ¶ 3, Mourad Dec.

The Varessi family of marks is extremely valuable due to the substantial recognition it enjoys in the Latin clothing market. Clothing bearing these marks has grossed approximately \$1,500,000 in sales in the last three years alone. See ¶ 4, Mourad Dec. Based on these numbers, there is no doubt that the Varessi family of marks has quickly established itself as one of the prominent players in the Latin clothing industry.

The instant trademark application, Serial No. 75/936,519, was filed on March 4, 2000. It earned publication without citation by the Examiner of any potentially conflicting marks and was published for opposition November 21, 2000. Opposer received extensions to oppose and finally did so on June 11, 2001.

In its Notice of Opposition, Opposer cited U.S. Trademark Registration No. 1,354,044, a design mark comprising a leaping puma registered August 13, 1985 for "Clothing-Namely, Leisure Shoes, Boots, House Slippers, Sports Shoes, Sports and Leisure Clothing-Namely, Training Suits, Shorts, Sweaters, Pullovers, T-

07/25/2003TAS

Shirts, Tennis Wear, Ski Wear, Leisure Suits, All Weather Suits, Wind Resistant Jackets, Slickers, Stockings, Soccer Socks, Gloves, Caps, Headbands, Bathing Trunks and Bathing Suits;" U.S. Trademark Registration No. 1,039,274, a leaping puma on a square background registered May 11, 1976 for "Football Shoes, Baseball Shoes, Training Shoes, Track Shoes, Boxing Shoes, Basketball Shoes, Soccer Shoes, Tennis Shoes, Bathing Shoes, Sneakers, Golf Shoes, Ski Boots, Tennis Garments for Men-Namely, Tricot Shirts, Shorts, Socks, Overalls for Men, Sweatsuits for Men, Sweat Shirts for Men, Sport Shorts for Men;" as well as a "variety of puma type cat marks" for clothing including U.S. Registrations 1,475,983, a design mark showing two pumas facing each other with paws raised as if to scratch one another registered February 9, 1988 for t-shirts; U.S. Registration 1,356,742 for the word plus design mark PUMA with a small puma sitting on top of the word registered August 27, 1985 for t-shirts; and U.S. Registration No. 1,095,276 for the word plus design mark PUMA with a cartoon-like puma sitting on top of the word which expired for failure to renew on April 12, 1999.

Opposer amended the Notice of Opposition with leave of the Board in an Order dated March 5, 2003 to add two marks, namely, the design mark D with a leaping puma recently registered on July 8, 2003 and assigned U.S. Registration No. 2,734,292 for clothing, namely shirts and footwear; and a design mark P with a leaping puma which Opposer apparently adopted around June of 2001 for t-shirts, but never sought federal registration.

During prosecution of Opposer's Registration No. 1,039,274 cited above, the mark was initially rejected by the examiner as likely to cause confusion when compared to U.S. Registration No. 696,473 for the word plus design mark TIGER with a leaping tiger registered April 19, 1960 for girdles; and U.S. Registration No. 688,778 for the word mark TIGER registered November 24, 1959 for girdles and panty girdles. See ¶ 2 and Exhibit 1, Declaration of Jessica J. Slusser (hereinafter "Slusser Dec."). In a response to the Office Action filed in February of 1975, Opposer distinguished its leaping puma design from a leaping tiger design, the main difference being that the marks consist of different types of cats, one being a puma, the other a tiger. See ¶ 2 and Exhibit 2, Slusser Dec.

Also during prosecution of what became No. 1,039,274, registration was opposed by Slazengers, Ltd., owner of three design marks showing leaping panthers, namely, U.S. Registration No. 840,521 for a leaping panther registered December 12, 1967 for clothing; U.S. Registration No. 880,503 for the word plus design mark SLAZENGER with leaping panther registered November 11, 1969 for clothing; and U.S. Registration No. 883,711 for the word plus design mark SLAZENGER with leaping panther registered January 6, 1970 for sports equipment and shoes. See ¶ 3 and Exhibit 3, Slusser Dec. Slazengers subsequently withdrew its opposition without prejudice. See ¶ 3 and Exhibit 4, Slusser Dec.

Around February of 1984, Opposer filed several requests for extensions of time to consider opposing Trademark Application Serial No. 392,658 filed September 29, 1982 by Pennsylvania State

07/25/2003TAB

University for the design mark of a lion (See ¶ 4 and Exhibit 5, Slusser Dec.), which subsequently issued as U.S. Registration No. 1,350,286 on July 23, 1985, when no opposition was formally instituted. See ¶ 4 and Exhibit 6, Slusser Dec.

Likewise, on January 8, 1986, Opposer filed a Notice of Opposition against registration of Trademark Application Serial No. 73/504,928 filed by the Greyhound Corporation on October 22, 1984 for a design mark showing an image of a running dog for clothing and shoes. Opposition No. 91,073,446 was dismissed with prejudice on November July 21, 1987 when defendant Greyhound's motion for summary judgment was granted. See ¶ 5 and Exhibit 7, Slusser Dec.

At least 12 other companies have registrations or pending applications for registrations of symbols of leaping cats for clothing in International Class 025. See Exhibit 8, Slusser Dec.

III. SUMMARY JUDGMENT IN FAVOR OF APPLICANT IS PROPER

FED.R.CIV.P. 56(c) authorizes the Court to enter summary judgment where "there is no genuine issue as to any material fact and ... the moving party is entitled to a judgment as a matter of law." The Supreme Court strongly favors summary judgment as an efficient means for resolving issues. See Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986). Trademark oppositions are no exception. The Federal Circuit, in Levi Strauss & Co. v. Genesco, Inc. instructs, "[o]ne of our predecessor courts has previously endorsed the Board's grant of summary judgment where 'a full trial ... is unnecessary because the essential facts

necessary to decision of the issue can be adequately developed by less costly procedures, as contemplated by the FRCP rules here involved, with a net benefit to society.'" 742 F.2d 1401, 222 U.S.P.Q. 939 (Fed. Cir. 1984), citing Exxon Corp. v. National Foodline Corp., 579 F.2d 1244, 1246, 198 U.S.P.Q. 407, 408 (C.C.P.A. 1978); Pure Gold, Inc., v. Syntex (U.S.A.), Inc., 739 F.2d 624 (Fed.Cir.1984). Indeed, the Federal Circuit encourages the proper use of Rule 56, "[w]here no issue of material fact is present... courts should not hesitate to avoid an unnecessary trial by proceeding under Fed.R.Civ.P. 56..." Chore-Time Equipment, Inc. v. Cumberland Corporation, 713 F.2d 774, 778-79 (Fed. Cir. 1983); See also, Anderson v. Liberty Lobby, Inc., 477 U.S., 248 (1986).

While in most circuits, the issue of likelihood of confusion is reviewed as a factual issue on appeal, this does not preclude a trial court from determining, via an appropriate procedural vehicle in a particular case, that there is no need for a jury trial as a matter of law. Murray v. Cable Nat'l Broadcasting Co., 86 F.3d 858, 39 U.S.P.Q.2d 1214 (9th Cir. 1996). A defendant may prevail on summary judgment if it shows a lack of any triable issue of fact on likelihood of confusion, due, for example, to the totally unrelated nature of the goods involved (See Blazon, Inc. v. Blazon Mobile Homes Corp., 416 F.2d 598, 163 U.S.P.Q. 156 (7th Cir. 1969)) or the distinctly dissimilar marks (See Riverhead Paints Plus, Inc. v. PPG Industries, Inc., 2 U.S.P.Q.2d 2035, 1987 WL 16877 (E.D.N.Y. 1987)). There is certainly no likelihood of confusion here, and Opposer is estopped from arguing to the

07/25/2003TTAB

contrary, therefore summary judgment is not only appropriate, but required.

IV. THIS OPPOSITION MUST FAIL BECAUSE OPPOSER IS ESTOPPED FROM CLAIMING THAT A LEAPING PUMA AND A LEAPING TIGER ARE SO SIMILAR AS TO CAUSE THE PUBLIC TO BE CONFUSED

Opposer has taken the position on several occasions that the purchasing public is able to choose between goods bearing competing cat symbols without confusion in the market place. See ¶¶ 2-5 and Exhibits 2-5, Slusser Dec. As such, Opposer should be estopped now from taking an inconsistent position in the present proceeding, and arguing that Applicant's leaping tiger is likely to cause confusion in light of Opposer's leaping puma marks. See Kay Corp. v. Westfield's, Inc., 190 U.S.P.Q. 565, 1976 WL 20945 (T.T.A.B. 1976) (opposer is "bound" by statements of its predecessor in obtaining a registration as to the scope of its mark); Plus Products v. Natural Organics, Inc., 223 U.S.P.Q. 27, 1984 WL 33 (S.D.N.Y. 1984) (the Court found that a litigation defendant cannot make a fair use defense by arguing that a mark is descriptive when it previously sought to register the term as a trademark); Petro Stopping Centers L.P. v. James River Petroleum, 130 F.3d 88, 44 U.S.P.Q.2d 1921 (4th Cir. 1997) (the Court did not accept the proposition argued by plaintiff which was the opposite of its representations to the PTO during prosecution of its trademark application, and found no likelihood of confusion between the parties' marks in controversy).

07/25/2003TTAB

A. PUMA VERSUS TIGER

Opposer distinguished its leaping puma mark from the leaping Tiger and TIGER marks cited against it (See ¶ 2 and Exhibit 2, Slusser Dec.) and obtained issuance of its Registration No. 1,039,274. In its February 1975 office action response, Opposer argued that its applied for mark,

is intended to show a leaping puma, rather than a tiger. The application [sic] is the owner of Registrations 797,843 and 905,072, both for the word PUMA. The present trademark shows a PUMA. As a matter of interest, a German catalog of the applicant is enclosed. The catalog shows the word mark and the picture mark "PUMA" side by side. (Emphasis added.)

See page 2, paragraph 3 of Exhibit 2, Slusser Dec.

Similarly, Applicant's opposed mark consists of a V with a tiger leaping through the letter. In Opposer's own words, its Registration No. 1,039,274 (as well as the other marks cited against Applicant) *is intended to show a leaping puma, rather than a tiger.* Clearly Opposer believed that no confusion would result from the use of a puma and a tiger on related goods. Therefore, according to the Board in Kay Corp., 190 U.S.P.Q. 569-570, Opposer must be bound by its statements made in obtaining registration as to the scope of its mark, and should now be estopped from arguing the exact opposite proposition.

B. PUMA VERSUS PANTHER

Also during prosecution of what became Opposer's Registration No. 1,039,274, the mark was opposed by Slazengers Limited, owner of three leaping panther design marks for clothing, sporting goods

07/25/2005TAA

and shoes. See ¶ 3 and Exhibit 3, Slusser Dec. The opposition was subsequently withdrawn without prejudice and Opposer's mark was registered on May 11, 1975. See ¶ 3 and Exhibit 4, Slusser Dec. The inference, since Opposer's mark went on to register, is that Opposer believed its puma mark was distinct from Slazengers' panther mark such that the public would not be confused. It appears the panther and the puma marks, both covering clothing and sporting goods such as shoes, are now coexisting peacefully in the marketplace.

In the instant proceeding, Applicant's mark also consists of a leaping animal form to be used on apparel. However, Applicant's mark is a tiger instead of a panther. As Opposer evidently distinguishes between discrete cat marks, for example its puma and Slazengers' panther, it must be estopped from arguing the opposite proposition here and not distinguishing between two separate cat marks such as its puma and Applicant's tiger. See Kay Corp., 190 U.S.P.Q. 565; Plus Products, 223 U.S.P.Q. 27; Petro Stopping Centers L.P., 130 F.3d 88.

C. PUMA VERSUS LION

Opposer filed several requests for extension of time in which to oppose Pennsylvania State University's registration of Trademark Application Serial No. 73/392,658 for a lion design for *inter alia* clothing in International Class 025. See ¶ 4 and Exhibit 5, Slusser Dec. The application was never opposed and U.S. Registration No. 1,350,286 issued on July 23, 1985. See ¶ 4 and Exhibit 6, Slusser Dec. Again, a fair inference is that the

two cat-like symbols are co-existing in the marketplace without causing consumer confusion.

Opposer must now be bound to its position taken in regard to Registration No. 1,350,286 in comparison to the other registrations listed above, namely, that differing species of related felines can be distinguished by the consuming public without confusion. See Kay Corp., 190 U.S.P.Q. 565; Plus Products, 223 U.S.P.Q. 27; Petro Stopping Centers L.P., 130 F.3d 88. When Opposer is held to its previous position, it is estopped from arguing that the public will confuse its puma marks with Applicant's tiger mark and the pending opposition must be dismissed.

**V. EVEN IF OPPOSER IS NOT ESTOPPED, PRIOR STATEMENTS ARE
CONSIDERED ADMISSIONS AND MAY BE CONSIDERED EVIDENCE OF THE TRUTH
OF THE ASSERTIONS THEREIN**

Even if the Board finds that Opposer's statements made to the Trademark Office during prosecution of its U.S. Registration 1,039,274 do not necessarily estop it from claiming to the contrary here, its statements clearly constitute admissions and are considered evidence of the truth of the assertions therein. See EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc., 213 U.S.P.Q. 597, 1982 WL 52013 (T.T.A.B. 1982), aff'd 706 F.2d 1213, 217 U.S.P.Q. 986 (Fed. Cir. 1983). The Board, affirmed by the Federal Circuit, in EZ Loader Boat Trailers, considered an applicant's argument in response to an initial refusal by the examiner to publish the application for opposition, that the word

07/25/2003TAB

LOADER was not descriptive of trailers. In the ensuing opposition, the opposing party argued that based upon the applicant's prosecution history, it should be estopped from urging that its mark is descriptive. 213 U.S.P.Q. 597. The Board held that although the applicant was not estopped from such an argument in the opposition, the Board would consider the applicant's statements made during prosecution of the application as evidence. *Id.* In EZ Loader Boat Trailers, the Board determined that the applicant's pleading in the opposition was not necessarily contradictory to its arguments before the examiner since the applicant only argued that the term LOADER was not descriptive for trailers, but had conceded that LOADER was descriptive of other industrial and construction equipment. *Id.* Therefore, the Board in EZ Loader Boat Trailers considered the applicant's admission as evidence when determining the outcome of the opposition. *Id.*

In the instant opposition, Opposer's statement regarding its leaping puma mark in response to the office action citing TIGER and a leaping tiger mark as likely to cause confusion, must be considered evidence of Opposer's awareness that the consuming public is readily able to distinguish between differing species of felines without confusion. In Opposer's own words, "[t] mark is intended to show a *leaping puma, rather than a tiger.*" (Emphasis added.) See Exhibit 2, Slusser Dec. Applicant's mark shows a tiger, not a puma. As such, Opposer should have no concern that the public will be confused.

07/25/2003 TAR

2

VI. IN THE ALTERNATIVE, THERE IS NO LIKELIHOOD OF CONFUSION

Even if Opposer were not estopped from arguing that the public is likely to confuse its puma marks with Applicant's tiger mark, this Motion must prevail because there is absolutely no likelihood of confusion.

Section 2 of the Trademark Statute states:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Lanham Act § 2, 15 U.S.C.A. § 1052.

While there is admittedly no "litmus rule" for determining likelihood of confusion of a pending mark with a previously registered mark, the Court of Customs and Patent Appeals listed 13 elements which, when relevant, should be considered. In re DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973). When applying the DuPont factors, each factor must be shown to be material or relevant to the particular case before evidence on that factor is considered. Therefore, there is no need to discuss all 13 factors. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000) (The Board satisfied the DuPont test by considering each factor for which there was evidence in the record). Consequently, in this analysis, only the relevant factors will be discussed.

A. RELEVANT DU PONT FACTORS

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

In this case, Applicant's pending mark is V with a leaping tiger design, whereas Opposer's marks all consist of puma designs. The appearance of the marks is not the same. Applicant's mark is a readily distinguishable tiger, whereas Opposer's mark is a readily distinguishable puma. Further, Applicant's tiger is leaping in the *opposite direction* as Opposer's puma. Although both animals are cats, this characteristic is not the way in which resemblance under the statute is determined. According to the Patent Office Examiner in Chief in Coro, Inc. v. Delsa Mfg. Co. of R.I., Inc., "[t]he fact that some generic language can be found which would in a broad sense properly describe both marks is not the criterion by which the confusing similarity of the marks is to be determined." 119 U.S.P.Q. 58 (Pat. Off. Examiner in Chief 1958) (trapezoidal figure with a leaping antelope and DELSA is not likely to be confused with a trapezoidal outline with a flying horse, with or without CORO); *See also* Coro, Inc. v. Erich Schewe O.H.G., 126 U.S.P.Q. 518, WL 7393 (T.T.A.B. 1960) (opposition dismissed because opposer's use and registration of a winged horse cannot preclude the use or registration by another of any four-legged animal, for the same or similar goods, regardless of how dissimilar such animals may be); Application of Kopy Kat, Inc., 182 U.S.P.Q. 372 (C.C.P.A. 1974) (registration does not grant the

07/25/2003TAA
registrant exclusive rights with respect to every development of the theme or every use of the words in the registered mark). As both marks are accurate, artistic representations of their respective species, it is plain for all consumers to see that one is a puma and the other is a tiger.

The sound of the two marks is not the same. Translating the trademarks into word marks provides Opposer with no help. The Board has repeatedly held that where a mark comprises a representation of an animal and another mark consists of the name of that animal, such designations are regarded as legal equivalents in determining likelihood of confusion under the Trademark Act. See Squirrel Brand Co. v. Green Gables Investment Co., 223 U.S.P.Q. 154, 155 (T.T.A.B. 1984) (applicant's registration of the word mark "SQUIRREL" would be considered as the legal equivalent of a drawing or design of a squirrel); Shunk Manufacturing Co. v. Tarrant Manufacturing Co., 137 U.S.P.Q. 881, 883, 318 F.2d 328 (C.C.P.A. 1963) (caricature representation of Scotchman, i.e., man in kilts and Scottish garb, and word "SCOTCHMAN" for mechanical equipment); Izod Ltd. v. Zip Hosiery Co., Inc., 160 U.S.P.Q. 202, 405 F.2d 575 (C.C.P.A. 1969) (representation of head of tiger-like animal and words "TIGER HEAD" for clothing items). Application of this doctrine to the present situation merely results in comparing the word TIGER to the word PUMA. Obviously there is not the slightest resemblance between these words.

The connotation and commercial impression of the marks is not the same. When Opposer's puma registrations are viewed as a whole

07/25/2003TAR

and compared with the Applicant's mark, it is immediately obvious that Applicant has not adopted the distinctive feature of the puma family of marks. The unique feature of Opposer's family of marks protected by the registrations and recognized by the public is the puma itself along with the word PUMA. The intended commercial impression and the connotation that comes to the mind of the consuming public is PUMA. Applicant has not adopted a puma for his family of marks. Applicant has his own family of marks with the distinct design feature of VARESSI or V, which stands for VARESSI, and a *tiger*. The intended commercial impression and the connotation that comes to mind when seeing Applicant's mark is VARESSI or a *tiger*. The connotation and commercial impressions of the two marks are not the same because each evokes very different images in the minds of relevant consumers.

Due to the fact that the marks do not resemble each other in appearance, sound, connotation or commercial impression, there is a clear and strong legal distinction between Opposer's registrations and Applicant's word mark. As a consequence, there is no likelihood of confusion.

It is important to note that the first DuPont factor alone may be dispositive of the issue of likelihood of confusion. According to the Federal Circuit in Champagne Louis Roederer, S.A. v. Delicato Vineyards, it is proper to rely solely on the dissimilarity of the marks in finding no likelihood of confusion. 148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (applicant's proposed "CRYSTAL CREEK" trademark for wine was not confusingly similar to "CRISTAL" and "CRISTAL CHAMPAGNE" marks

07/25/77003TAR

owned by opponent of application, although class of goods was the same, goods traveled in same trade channels, and goods would be purchased by same or similar customers, where marks were dissimilar with respect to appearance, sound, significance, and commercial impression). Thus, because Applicant's pending mark is dissimilar from Opposer's registrations in appearance, sound, connotation and commercial impression, it is proper to determine from the first DuPont factor alone, that there is no likelihood of confusion and this opposition must be dismissed. However, for completeness, the other relevant factors are discussed below.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

In this case, the goods listed in the opposed application for V with the leaping tiger are "Clothing, namely, t-shirts, overalls, polo shirts, knit shirts, sweaters, belts, ties, pants, shirts, jackets, shorts, suits, socks, and underwear" in International Class 025. Applicant's clothing has a western or Latin flavor and includes such best sellers as colored jeans and button up shirts made of micro fiber or rayon with large, brightly colored patterns. See ¶ 5 and Exhibit 1, Mourad Dec. With the sale of such clothing, Applicant has quickly become a major player in the Latin clothing industry (See ¶ 4, Mourad Dec.) and targets mainly the Latino population. He does so through his own advertising publication circulated to the Latino population in the Southern and Western United States, as well as through radio and

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television advertisements on Latino radio and television stations. See ¶ 6, Mourad Dec.

On the other hand, Opposer's registrations cover mainly athletic and casual clothing, shoes and sporting goods. See Exhibit 9, Slusser Dec. Opposer obviously targets mainly the sports and active lifestyle market with its athletic-style and sports-related casual wear, equipment and shoes. See Exhibit 9, Slusser Dec. Therefore, even though the marks at issue broadly cover apparel, each is a very different type of apparel and marketed to a specific market, one very different from the other.

Here the goods covered by the respective marks are clearly not the same. Even so, in keeping with the Champagne court, even where the goods or services are the same, where marks are dissimilar with respect to appearance, sound, significance, and commercial impression (the first DuPont factor) it is proper to find no likelihood of confusion. *Id.* Therefore, whichever way one slices it, there is no likelihood of confusion.

3. The similarity or dissimilarity of established, likely to continue trade channels.

Again, as detailed above, the trade channels covered by the marks at issue are clearly not similar. And likewise, the Champagne court held that even with similar trade channels, marks with dissimilar appearances, sounds, and commercial impressions may be found unlikely to cause confusion. *Id.* There is no likelihood of confusion.

4. The conditions under which and buyers to whom sales are made ("impulse" versus careful, sophisticated purchasing).

Both marks admittedly cover clothing, albeit clothing marketed to very different industries. See Exhibit 9, Slusser Dec., also see Exhibit 1, Mourad Dec. As both Opposer and Applicant advertise heavily in their respective target markets (See ¶ 6, Mourad Dec.), it would follow that potential purchasers are relatively sophisticated and are looking for the particular brand they have seen or heard advertised. Such consumers are not likely to be confused about the source of each brand name. Applicant's consumers are looking for VARESSI or V with a tiger. On the other hand, Opposer's consumers are looking for PUMA or a puma design. In such circumstances buyers are unlikely to be confused.

5. The fame of the prior mark (including sales, advertising, length of use).

Both Applicant and Opposer purport to be relatively well known in their target markets. See ¶ 4, Mourad Dec. Opposer specifically, has taken the position that it is well known for its connection with the word PUMA and a leaping puma. The notion that a potentially famous mark such as Opposer's PUMA will be confused with a tiger mark which has itself achieved widespread recognition in the Latin community to which it caters, does an injustice to both marks. This factor strongly points to no likelihood of confusion.

6. The number and nature of similar marks in use on similar goods.

More than 12 other companies have registrations or pending applications for registration of symbols of leaping cats for wearing apparel. See Exhibit 8, Slusser Dec. The frequency with which a term is used in other trademark registrations is indeed relevant to the distinctiveness inquiry. See Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1530-31 (4th Cir.1984). This is especially true when the number of third-party registrations is great. As the Tenth Circuit has explained, "third-party registrations are 'relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.'" First Sav. Bank, F.S.B. v. First Bank Sys., Inc., 101 F.3d 645, 654 (10th Cir.1996) (quoting 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11.27[2] [b] (3d ed.1995)). Evidence of multiple third party uses of the leaping cat mark is proof that although Opposer's family of PUMA marks is not necessarily weak, Opposer is unable to stop third parties from using and registering leaping cats for wearing apparel. In short, Opposer does not have a monopoly on leaping cats. This factor heavily favors a finding of no confusion.

7. The nature and extent of any actual confusion.

Applicant is unaware of any actual confusion. See ¶ 7, Mourad Dec. Thus, the likelihood of confusion is slight.

07/25/2003 TAR

8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Applicant has used the pending mark in commerce since at least as early as July of 2000. See ¶ 4, Mourad Dec. Opposer's marks have apparently been used in commerce since the 1970s. Therefore, concurrent use has lasted approximately three years since Applicant began using the mark and he is unaware of any instance of actual confusion by the public. See ¶ 7, Mourad Dec. This factor also points to no likelihood of confusion.

9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

Here, as explained in greater detail above, both Applicant and Opposer own families of marks. Applicant's marks contain V for VARESSI, or the word VARESSI itself, and all include a tiger, shown either from the front or the side. See ¶ 3, Mourad Dec. Opposer's cited marks all consist of pumas with or without the word PUMA. Each family of marks has a distinct connotation and is not likely to be confused with the other.

12. The extent of potential confusion (whether de minimus or substantial)

There is not a great potential for consumer confusion for the reasons already stated. Namely, (1) the marks are obviously different animals, one a puma, the other a tiger, and they are leaping in opposite directions; (2) the parties sell different kinds of clothing to very different markets; See Exhibit 9, Slusser Dec., see also Exhibit 1, Mourad Dec. (3) each mark is

07/25/2003 TAB
relatively well known in its target market (See ¶ 4, Mourad Dec.) such that potential purchasers will not confuse one for the other.

B. ACCORDING TO THE RELEVANT DU PONT FACTORS, THERE IS NO LIKELIHOOD OF CONFUSION

Consequently, after careful analysis using the relevant DuPont factors, it is clear there is no likelihood of confusion between Applicant's mark and Opposer's many cited registrations. The first DuPont factor alone, similarity or dissimilarity of the marks, can be dispositive of the issue of likelihood of confusion when it is found the marks are dissimilar as to appearance, sound, connotation and commercial impression, as they are here. This is so even if class of goods, trade channels, and potential customers are the same. Champagne, 148 F.3d at 1375. Thus, because the marks are dissimilar according to the first DuPont factor, there should be a finding of no likelihood of confusion. Further analysis of all relevant DuPont factors, shows the evidence clearly weighs in the favor of no likelihood of confusion. Thus, summary judgment must be granted in favor of Applicant.

VII. CONCLUSION

For the foregoing reasons, Applicant's Motion for Summary Judgment must be granted.

DATED: July 11, 2003

Respectfully submitted,

TROJAN LAW OFFICES

By: 
R. JOSEPH TROJAN
JESSICA J. SLUSSER
Attorneys for Applicant
SAMIR MOURAD

07/25/2003TTAB

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07-14-2003

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CERTIFICATE OF EXPRESS MAILING (37 C.F.R. 1.10)

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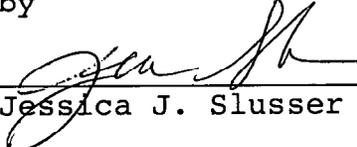
1. APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT (1 page);
2. MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT (23 pages);
3. DECLARATION OF JESSICA J. SLUSSER IN SUPPORT OF APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT (4 pages) (including Exhibits 1-9);
4. DECLARATION OF SAMIR MOURAD IN SUPPORT OF APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT (3 pages) (including Exhibit 1);
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Jessica J. Slusser

PROOF OF SERVICE

I am over the age of 18 years, employed in the County of Los Angeles, and not a party to the above entitled action. My business address is 9250 Wilshire Blvd., Suite 325 Beverly Hills, California 90212.

On July 11, 2003, I served:

07/25/2003TTAB

APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT;

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT;

DECLARATION OF JESSICA J. SLUSSER IN SUPPORT OF APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT (including Exhibits 1-9); and

DECLARATION OF SAMIR MOURAD IN SUPPORT OF APPLICANT SAMIR MOURAD'S MOTION FOR SUMMARY JUDGMENT (including Exhibit 1)

to:

Mr. Stuart J. Friedman, Esq.
NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, VA 22102

BY PERSONAL SERVICE: (Federal Court): I caused such envelope to be delivered by hand to the offices of the addressee(s); (State Court): By personally delivering by hand to the offices of the addressee(s).

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Executed on July 11, 2003, at Beverly Hills, California.



Michiko Speier