

T TAB

DOCKET: 740120-179

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

PUMA AG RUDOLF DASSLER SPORT,)
)
Opposer,)
)
v.)
)
MOURAD, SAMIR DBA DON REGALON,)
)
Applicant)

Opposition No. 91/123,141
73292728

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on 10/22/03
John C. Hayes

Box NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Washington, D.C. 20231

10-23-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64

Transmitted herewith is the following:

- 1. Opposer's Reply Memorandum in Support of its Cross-Motion for Summary Judgment.

Respectfully submitted,

Stuart J. Friedman

Stuart J. Friedman
NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, Virginia 22102
(703) 770-9300
(703) 770-9400 FAX

Attorneys for Opposer

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

PUMA AG RUDOLF DASSLER SPORT,)
)
Opposer,) Opposition No. 91/123,141
)
v.)
)
MOURAD, SAMIR DBA DON REGALON,)
)
Applicant)
_____)

OPPOSER'S REPLY MEMORANDUM IN SUPPORT
OF ITS CROSS-MOTION FOR SUMMARY JUDGMENT

David S Safran
Stuart J. Friedman

NIXON PEABODY LLP
401 9th Street, N.W., Suite 900
Washington, DC 20004-2128
Telephone: (202) 585-8000
Facsimile: (202)-585-8080

Attorneys for Opposer

TABLE OF CONTENTS

| | <u>Page</u> |
|--|-------------|
| INTRODUCTION | 2 |
| ARGUMENT | |
| I. Opposer’s Prior Statements Do Not Bar Opposer From Asserting That Applicant’s Mark is Confusingly Similar to Opposer’s Leaping Cat Marks..... | 3 |
| II. Board’s Determination of Likelihood of Confusion Must Be Based On the Specific Marks A Issue The Presence of Additional Marks Does Not Affect The Similarity Between the Marks At Issue..... | 5 |
| III. In the Absence of a Limitation in the Identification of Goods the Board Must View the Purchasers of Applicant’s Clothing as no More Sophisticated Than the Average Purchasing Public | 6 |
| IV. Applicant’s Citation of Such Dissimilar Third Party Registrations Reinforces the Strength of Opposer’s Leaping Cat Marks | 7 |
| CONCLUSION..... | 8 |

Opposer, Puma AG Rudolf Dassler Sport, hereby requests that the Board exercise its discretion to consider this reply brief. The arguments presented herein will assist the Board in deciding the cross motion for summary judgment by addressing the issues raised by Applicant in its memorandum in opposition to Opposer's cross-motion.

INTRODUCTION

Opposer's Cross-Motion for Summary Judgment asks the Board to find that there are no genuine issues of material fact which remain for trial on the issue of likelihood of confusion and that Applicant's "V" and leaping cat mark, which it seeks to register based on its U.S. Trademark Application Serial No. 75/936,519, filed March 4, 2000, is confusingly similar to Opposer's leaping cat marks. In its memorandum in support of its cross-motion, Opposer established ownership of U.S. Registrations Nos. 1,354,044 and 1,039,274 and prior and continuous use of the leaping cat marks shown in these registrations, in U.S. Registration No. 1,189,319 (for the leaping cat over the word PUMA) and in U.S. Trademark Application Serial No. 76/422,721, filed June 17, 2002 (for a design mark comprising the letter "D" with a cat silhouette leaping through the "D") on goods which are identical or substantially identical to the goods identified in Applicant's Serial No. 75/936,519.¹

In response Applicant argues, *inter alia*, that: (1) Opposer is estopped from asserting confusing similarity based upon a statement it made during the prosecution of the application which became U.S. Registration No. 1,039,274; (2) there is no likelihood of confusion based upon the use by Applicant of multiple different marks on each article of clothing; (3) there is no

¹ It is noteworthy that Opposer has never asserted priority or confusing similarity based upon use of its "P" with leaping cat mark. Rather, that mark has been asserted to show that Opposer continues to use its leaping cat mark alone as well as leaping through letters, such as "D" and "P".

marks and not upon the name , e.g., puma or tiger, an applicant or registrant may use to describe its mark.²

Opposer has not established any basis for the asserted estoppel and this Board should decline Applicant's invitation to find any estoppel arising from the prosecution of the application which became U.S. Registration No. 1,039,274. To the extent that the Board finds that there is an inconsistency between Opposer's prior statement and its present position, *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 U.S.P.Q. 955 (TTAB 1986) is instructive that no estoppel arises therefrom. In *Giant Food* opposer, Giant Food, Inc., during prosecution of its registered mark "SUPER SORB", had argued that "SUPER SORB" for paper towels was not likely to cause confusion with a third party's mark "SUPERSORB" for paper hospital supplies. Applicant, Standard Terry Mills, Inc., argued that opposer was estopped from asserting that its "SUPER SORB" mark and applicant's "SUPRASORB" mark for utility towels were likely to give rise to confusion. In denying Applicant's motion for summary judgment on other grounds, the Board stated "[w]e reach this conclusion, moreover, despite applicant's arguments as to the preclusive effect of opposer's statements in response to the later withdrawn refusal of registration in light of a subsisting registration for 'SUPERSORB' for paper hospital supplies since, as correctly noted by opposer, the doctrine of 'file wrapper estoppel' does not apply to trademark cases." *Id.* at

For the foregoing reasons, there is no estoppel and the Board should so conclude.³

² Opposer stands by its previous statement that its mark is intended to be a puma, not a tiger. Accordingly, there is no inconsistency between its former and present statements.

³ Applicant's reference to Opposition No. 91/073,446, *Puma AG Rudolf Dassler Sport v. The Greyhound Corporation* (TTAB 1987) is clearly misplaced. In that case the Board found no likelihood of confusion between Puma's leaping cat marks and Greyhound's running dog mark because the marks conveyed a dissimilar commercial impression, particularly since the differences between the representations of cats and dogs could not be ignored and because both marks were well known if not famous. No issue of estoppel was decided by the Board.

II. BOARD'S DETERMINATION OF LIKELIHOOD OF CONFUSION MUST BE BASED ON THE SPECIFIC MARKS AT ISSUE – THE PRESENCE OF ADDITIONAL MARKS DOES NOT AFFECT THE SIMILARITY BETWEEN THE MARKS AT ISSUE

Opposer has maintained that Applicant's leaping feline, whatever it may be named, is very similar to Opposer's leaping cat marks⁴ and has pointed out that Applicant's characterization of its leaping feline as a leaping tiger is a very convenient and self serving characterization, particularly since Applicant's leaping feline lacks a tiger's most distinguishing characteristic, namely stripes. As a result, a large segment of the purchasing public would be unable to distinguish Applicant's leaping feline from any other leaping feline. In response, Applicant points out that it uses multiple marks on its articles of clothing, including the mark of its U.S. Registration No. 2,750,752 for VARESSI JEANS with a tiger's head design encircled in a Greek key design. It argues that the use of the '752 design mark, in which the tiger's face has stripes, would be sufficient to inform the purchasing public that the unmarked leaping feline which forms a part of the mark here sought to be registered is also a tiger. Applicant's rationale is unsound.

Applicant is arguing, notwithstanding that the purchasing public may not be able to distinguish between Opposer's leaping cat marks and the mark Applicant seeks to register, that the presence of Applicant's '752 mark on the goods would somehow inform the prospective purchaser that the unknown cat leaping through the letter "V" is indeed a tiger. Applicant has

⁴ Opposer has shown by its evidence that it uses its leaping cat mark with the cat leaping from right to left as well as from left to right. Such usage is encompassed by the language of paragraph 3 of the Second Amended Notice of Opposition wherein Opposer alleged that prior to Applicant's filing date it had adopted and used a leaping cat silhouette as a trademark in connection with the marketing, promoting, offering for sale and selling of items of clothing in the U.S. Opposer's allegation does not limit the direction of the cat's leap. Moreover, during discovery, in response to Applicant's request for documents, Opposer produced numerous catalogs showing the cat leaping from right to left as well as from left to right.

not applied to register a cat leaping through the letter “V” together with the words VARESSI JEANS with a striped tiger’s head design encircled in a Greek key design. Rather, it has only applied to register a cat leaping through the letter “V”. It follows that the Board’s determination of likelihood of confusion must be based only on the specific marks at issue. *In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1690 n.4 (Fed. Cir. 1993; *Interstate Brands Corp. v. McKee Foods Corp.*, 53 U.S.P.Q.2d 1910, 1915 (TTAB 2000). Applicant is not limited by anything in its application to using the mark sought to be registered together with the mark of the ‘752 registration. Registrability is determined based on the mark shown and description in the application, and restrictions on how the mark is used are not inferred. *In re Shell Oil Co.*, *supra*. If a registration were to issue for Applicant’s cat leaping through the letter “V” mark, Applicant would be free to use it without its other marks. *See, Interstate Brands, supra*. Accordingly, the presence of additional marks does not affect the degree of similarity between the marks at issue. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 228 U.S.P.Q. 648, 656 (SDNY 1985).

III. IN THE ABSENCE OF A LIMITATION IN THE IDENTIFICATION OF GOODS THE BOARD MUST VIEW THE PURCHASERS OF APPLICANT’S CLOTHING AS NO MORE SOPHISTICATED THAN THE AVERAGE PURCHASING PUBLIC

Opposer has taken the position that potential purchasers of articles of clothing are not highly discriminating professional buyers, but are ordinary consumers who exercise only reasonable care in their selection and purchasing decisions. Opposer also argued that articles of clothing are relatively inexpensive and frequently replaced items and that purchasers of such items are generally held to a lesser standard of purchasing care.

Applicant responds that its items of clothing are “not cheap” (\$99.99 for emblem shirts and \$129.99 for jeans) and purchasers of its items are brand-conscious shoppers who are not

unsophisticated shoppers buying replaceable staples at the grocery store. Its purchasers, according to Applicant, should not be held to a lesser standard of purchasing care.

However expensive Applicant views its current line of clothing, its application for registration identifies shirts (without limitation) and pants (without limitation). Applicant is not limited by its identification of goods to using its mark only on expensive shirts and pants. Rather, Applicant can, at any time, alter its marketing approach and sell “inexpensive” shirts and pants. Thus, the Board must assess confusing similarity on the basis of the identification of goods without limitations or restrictions as to the actual nature of the goods or trade channels or classes of purchasers which are not reflected therein. *In re Q-Sport, Inc.*, _____, 2002 TTAB LEXIS 202 (TTAB 2002).

When so viewed, it will be appreciated that purchasers of Applicant’s clothing items are, generally, ordinary consumers who exercise no more than reasonable care in their selection and purchasing decisions. There is no evidence that Applicant’s purchasers are any more sophisticated than the average purchasing public. Moreover, there is no basis for the Board to consider only the purchase of expensive clothing. In the absence of a restriction in the identification of goods, the Board should assume that Applicant’s clothing includes all price ranges. *In re Peebles Inc.*, 23 U.S.P.Q.2d 1795, 1797 (TTAB 1992).

IV. APPLICANT’S CITATION OF SUCH DISSIMILAR THIRD PARTY REGISTRATIONS REINFORCES THE STRENGTH OF OPPOSER’S LEAPING CAT MARKS

Applicant has cited seven third party registrations of leaping cat marks for wearing apparel to “evidence that Opposer does not own a monopoly on all leaping cat marks.” Of course, Opposer has never asserted any sort of monopoly and Applicant’s characterization of Opposer’s position in this proceeding is a conscious overstatement. Rather, Opposer has, from

time to time, sought to enforce its trademark rights in its famous leaping cat marks against those marks of others which it considers likely to confuse the purchasing public. Applicant's mark in this proceeding is one such mark for all of the reasons presented in support of Opposer's cross-motion for summary judgment.

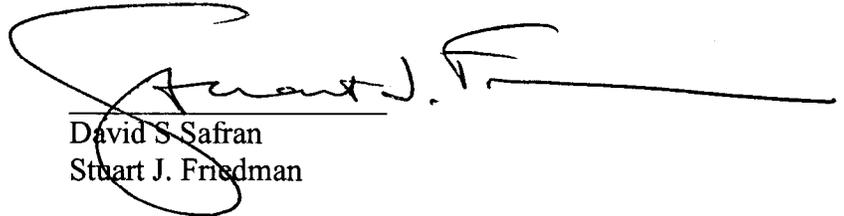
The registered third party marks asserted by Applicant include matter other than a leaping cat design, such as wording or design features, which easily distinguishes the cited registrations from Opposer's leaping cat marks. Many have clear visual dissimilarities. There are no marks in the cited group submitted by Applicant which even bear some similarity to the registered marks asserted by Opposer. Thus, Applicant's citation of such dissimilar third party marks suggests that Opposer's leaping cat marks are strong rather than weak. *Puma-Sportschuhfabriken Rudolf Dassler, KG v. Garan, Inc.*, 224 U.S.P.Q. 1064, 1066 (TTAB 1984); *Dubonnet Wine Corp. v. Schneider*, 218 U.S.P.Q. 331, 335 (TTAB 1983).

CONCLUSION

For the reasons discussed at length hereinabove, and since there are no remaining genuine issues of fact to be resolved which are material to the likelihood of confusion issue, Applicant's

motion for summary judgment should be denied and Opposer's cross-motion for summary judgment on the issue of likelihood of confusion should be granted.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stuart J. Friedman", is written over a horizontal line. The signature is stylized and extends to the right.

David S. Safran
Stuart J. Friedman

NIXON PEABODY LLP
401 9th Street, N.W., Suite 900
Washington, DC 20004-2128
Telephone: (202) 585-8000
Facsimile: (202)-585-8080

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing:

OPPOSER'S REPLY MEMORANDUM IN SUPPORT
OF ITS CROSS-MOTION FOR SUMMARY JUDGMENT

was mailed by first class mail, postage prepaid, on October 22, 2003 to:

Jessica J. Slusser, Esq.
TROJAN LAW OFFICES
9250 Wilshire Blvd., Suite 325
Beverly Hills, CA 90212

10/22/03
Date

Freida C. Hayden