

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: April 11, 2013

Mailed: September 30, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wolverine Outdoors, Inc.

v.

Marker Volkl (International) GmbH

Opposition No. 91161363

Marker Volkl (International) GmbH

v.

Wolverine Outdoors, Inc.

Opposition Nos. 91177732 & 91177736

Douglas Dozeman and Michael B. O’Neal of Warner Norcross & Judd LLP for
Wolverine Outdoors, Inc.

Sarah K. Duran and Warren J. Rheume of Davis Wright Tremaine LLP for
Marker Volkl (International) GmbH.

Before Cataldo, Wolfson, and Adlin, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

These consolidated proceedings involve the rights of Wolverine Outdoors, Inc. (“Wolverine”) and Marker Volkl (International) GmbH (“Marker”) to register design marks depicting stylized representations of the letter “M” for a variety of goods and

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services. The oppositions were consolidated on March 5, 2009, with Opp. No. 91161363 designated as the parent case. The cases have been fully briefed and we have considered all arguments and evidence filed in each case. To begin with, we outline the parties' claims and defenses in each opposition.

Opposition No. 91161363

This opposition involves Marker's application (filed April 5, 2003) to register the design mark depicted below (the "FLYING M" mark):



for:

skiing and snowboarding helmets (International Class 9);

all-purpose sport bags, carry-on bags, rucksacks (International Class 18);

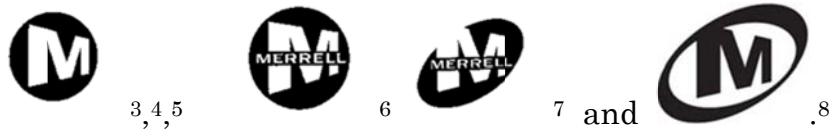
clothing, namely, after-ski boots, ski boot bags, ski bibs, boots, sport coats, winter sport gloves, headwear, skiing and snowboarding mittens, athletic shoes and socks (International Class 25);

skiing and snowboarding gloves, elbow, knee and shin guards for athletic use, ski bindings and parts therefor, snow skis, snowboard bindings and parts therefor, snowboards (International Class 28);

organizing festivals featuring winter sports, organizing winter sports tournaments, providing facilities and equipment for winter sports tournaments (International Class 41).

¹ Application Serial No. 76507077, filed under Section 44(e), 15 U.S.C. § 1126(e), based on German Registration No. 30242690, which registered on February 26, 2003. Priority under Section 44(d) was not claimed.

Wolverine opposed registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the FLYING M mark, when applied to the listed goods and services, so resembles Wolverine's previously used and registered marks shown below as to be likely to cause confusion, mistake or deception:²



The first and last marks depicted above are referred to hereinafter as the “CIRCLE M” and the “OVAL M” marks, respectively, and are registered for “footwear”; the CIRCLE M marks are also registered for clothing, and various types of bags.⁹

² Wolverine also asserted a dilution claim, but did not pursue this claim in its brief. Therefore, we consider this claim to be waived. *See, e.g., Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer is deemed to have waived the claim).

³ Reg. No. 2670836 for “footwear; clothing, namely shirts”; registered January 7, 2003; renewed.

⁴ Reg. No. 2772456 for “clothing, namely, shirts, t-shirts, sweatshirts, sweaters, pants, shorts, jackets, shells, vests, coats, hats, scarves, socks and belts”; registered October 7, 2003; Section 8 affidavit accepted; subject to counterclaim in this proceeding.

⁵ Reg. No. 2860830 for “backpacks, daypacks, all purpose sport and athletic bags, duffel bags, travel bags, fanny packs, shoulder bags and tote bags”; registered July 6, 2004; Section 8 affidavit accepted; subject to counterclaim in this proceeding.


⁶ Reg. No. 2408922 for “footwear”; registered November 28, 2000; cancelled under Section 8 on July 1, 2011.

⁷ Reg. No. 2433428 for “footwear”; registered March 6, 2001; cancelled under Section 8 on October 7, 2011.

⁸ Reg. No. 3249275 for “footwear”; registered June 5, 2007. On February 22, 2012, the Board granted Wolverine's motion to amend the notice of opposition to include a claim of rights to this registration and construed Marker's answer to paragraph 2 of Wolverine's original notice of opposition (admitting only that Wolverine is listed as the owner of the registrations) “as extending” to Wolverine's newly added registration.

⁹ The two marks including the word MERRELL were cancelled under Section 8 in 2011. Accordingly, the registrations have not been considered in the likelihood of confusion analysis. *See Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987) (expired registration has no probative value “other than for what it shows on its face, i.e., only that the registration issued” on the registration date). Wolverine is relying on its common law rights to these marks.



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Wolverine also pleaded common law rights in the below-depicted stylized letter “M” mark (the “BLOCK M” mark) for “footwear:” .¹⁰

In its answer, Marker denied the salient allegations in Wolverine’s notice of opposition and asserted that it was the first to use its FLYING M mark and “an ‘M’ as a source indicator” for the goods listed in its application.¹¹

Marker later amended its answer to add counterclaims seeking cancellation of two registrations for Wolverine’s CIRCLE M mark (Reg. No. 2772456 for clothing and Reg. No. 2860830 for bags) on the ground of fraud. Marker further asserts priority and likelihood of confusion as an additional ground for cancellation of the CIRCLE M mark for bags (Reg. No. 2860830).¹² Wolverine has denied the salient allegations in the counterclaims.

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On May 3, 2006, Wolverine filed intent to use applications to register the OVAL M mark ¹³ and the BLOCK M mark ¹⁴ for “clothing, namely shirts, sweatshirts, pants, shorts, pullovers, jackets, hats, gloves, socks and belts.”

Marker filed notices of opposition against Wolverine’s applications, alleging prior use of the FLYING M mark  on the goods listed in Marker’s application

¹⁰ Amended Notice of Opposition paragraph 2.

¹¹ Answer, paragraphs 2 and 3.

¹² Marker unsuccessfully sought to amend its answer to add counts of abandonment and non-use, and to include a counterclaim against Reg. No. 2670836. See Board order dated January 27, 2011, denying Marker’s motion to amend.

¹³ Serial No. 78875659.

¹⁴ Serial No. 78874991.

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for the mark, including clothing and bags, as well as priority of use and ownership of a registration for the mark **M** (in typed characters) for “safety ski bindings.”¹⁵ Marker further alleges prior use of “the letter M” in association with clothing¹⁶ and that Wolverine’s registration of its marks is likely to cause confusion, mistake or deception among relevant consumers.

Wolverine has denied the salient allegations in Marker’s notices of opposition.¹⁷

The Parties

Opposer Wolverine Outdoors, Inc. is a subsidiary of Wolverine World Wide Inc., an international company “doing business through international licensees and distributors.”¹⁸ At one point, it comprised four operating groups: “The Hush Puppies Group, the Outdoor Group, the Heritage Group and the Wolverine Group.”¹⁹ In 1998, Wolverine World Wide Inc. bought the footwear company Merrell,²⁰ which had “started out in 1981 as a maker of high performance hiking

¹⁵ Reg. No. 1595584 for “safety ski bindings”; registered May 8, 1990; renewed.

¹⁶ Notices of opposition paragraphs 7 and 8.

¹⁷ Wolverine did not assert as an affirmative defense that it claims priority of use of any of its marks, but we find that the issue has been tried by implied consent of the parties. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1650, 1655-56 (TTAB 2010) (Board deemed unpleaded affirmative defense of tacking by prior use of an unpleaded mark to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b)), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (“Mere denial by applicant of opposer’s allegation of priority of use is sufficient to put opposer on notice that it must prove its pleaded priority, but it is insufficient to put opposer on notice that any priority opposer will attempt to prove will have to predate the priority that applicant will attempt to prove through tacking”).

¹⁸ *Zwiers Dep.*, p. 6.

¹⁹ *Id.*

²⁰ *Brown Dep.*, p. 10; exhibit 1. The exhibit, “The First 20,” is a brochure describing Merrell’s first twenty years of operation. In this brochure, the company is referred to as the

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boots”²¹ and which, over the years, “expanded its footwear line to include backcountry ski shoes, trail running shoes, sport sandals, walking shoes and a full line of footwear for outdoor enthusiasts.”²² Wolverine World Wide Inc. formed Wolverine Outdoors, Inc. upon the acquisition of Merrell, and the Merrell brands have since been continuously controlled by Wolverine Outdoors. Mr. Zwiers, president of Wolverine Outdoors, Inc., testified to the continuous expansion of the MERRELL brand “both in terms of its categories and in terms of its global reach.”²³

Applicant Marker Volkl (International) GmbH began as a family-run business founded in 1952 in Germany by Hannes Marker, who invented the first safety release bindings for ski boots.²⁴ In 1981, Mr. Marker sold his business to a United States company that became Marker International. The company was located in Salt Lake City until the mid to late-1980’s, when it filed for bankruptcy and was purchased by two European investors, one of whom owned the “Volkl” company (which used VOLKL for skis). The company thereafter consolidated Marker International with Volkl, becoming Marker Volkl (International) GmbH, and returned to Germany.²⁵ In 2004, Marker was purchased by a company named “K2, Inc.” and moved to New Hampshire.²⁶ In 2007, K2, Inc. was bought by Jarden Corporation, where Marker remains today.²⁷ Its primary product line continues to

“Merrell Boot Company.” The parties use the shorthand “Merrell” to refer to Wolverine’s predecessor.

²¹ Brown Dep., p. 10.

²² Wolverine’s Brief, p. 9.

²³ Zwiers Dep., p. 8.

²⁴ Wiant Dep., p. 20.

²⁵ *Id.*, p. 21.

²⁶ *Id.*, p. 23.

²⁷ *Id.*, p. 22.

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be ski bindings and accessories, i.e. helmets and goggles, supplemented by “apparel primarily for skiing, which is outer wear, but also layering for apparel,”²⁸ and a sublicensee sells bags.²⁹

Evidentiary Matters

Before proceeding to the merits of the parties’ respective claims, we address several evidentiary matters.

Wolverine’s Objections –Marker’s Notice of Reliance Evidence

Wolverine objects to the admission of certain news articles³⁰ to the extent Marker offers these news articles to prove that Wolverine did not enter the apparel and bags markets until December 2003 (the earliest date on any of the news articles submitted by Marker). Wolverine also objects to the admission of certain magazine advertisements³¹ to the extent these advertisements are offered as evidence that the public is familiar with Marker’s trademarks.

Wolverine’s objections go to the probative value of the news articles and magazine advertisements and not to their admissibility. Marker has properly submitted these documents as printed publications under a notice of reliance. Printed publications made of record by notice of reliance are admissible and probative for what they show on their face, but not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117

²⁸ *Id.*, p. 23.

²⁹ *Id.*, p. 24; exhibit 8.

³⁰ Marker’s Notice of Reliance, exhibits 83 through 101.

³¹ Marker’s Notice of Reliance, exhibits 10 through 27.

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n.7 (TTAB 2009). Accordingly, these documents have been considered for what they show on their face but not to demonstrate the truth of what has been printed.

Marker's Objections - Motion to Strike

On December 8, 2011, Marker filed a motion to strike evidence attached to Wolverine's "Second and/or Supplemental Notice of Reliance," alleging that the evidence was untimely because the notice of reliance was filed after Wolverine's testimony period had closed. The motion was granted as conceded. Wolverine resubmitted the material on February 27, 2012, during its rebuttal period as plaintiff in the parent case. Marker filed a second motion to strike the evidence as improper rebuttal evidence, arguing that the evidence goes to Wolverine's case-in-chief in the parent case.

Wolverine argues that due to the consolidation of the cases, all proceedings must be tried on the same record; and that because the evidence is admissible in the child cases, it would be impractical for the Board to "put on blinders" and preclude the evidence in the parent case.³² Wolverine's rebuttal period as plaintiff in the parent case was at the same time its main testimony period as defendant in the child cases. Marker replies that the mere fact that the cases are consolidated does not require the Board to treat the evidence as admitted in all proceedings; that the evidence has already been excluded by the Board's prior order; and that "[t]o the extent that Wolverine seeks to introduce the evidence identified in the Notice of

³² Wolverine also argued that Marker's motion to strike should be denied as premature because it was not based on an objection that could have been promptly cured if raised by motion to strike, and that Marker should have raised the issue for the first time in its brief. We do not construe the admonition in TBMP § 532 so narrowly as to require summary denial of Marker's motion on this basis; however, the better practice is for Marker to have filed its objections to said evidence at the briefing stage.

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Reliance as part of its rebuttal to Marker's evidence, the evidence should be disregarded and stricken."³³

The evidence Marker seeks to exclude consists of newspaper and magazine articles that were identified during the testimony deposition of Sue Harvey Brown, Patagonia Footwear's³⁴ marketing manager, as exhibit Nos. 15-34. As such, the evidence has been properly made of record during Wolverine's main trial period. As for Marker's objection that the evidence was not properly authenticated during the deposition, inasmuch as newspaper and magazine articles appearing in periodicals are considered self-authenticating under Federal R. Evid. 902(6), the evidence is admitted.³⁵ However, we agree with Marker that the evidence goes to Wolverine's case-in-chief and that the timing of its filing of the evidence via notice of reliance was otherwise improper rebuttal vis-à-vis the parent case. Trademark Rule 2.122(e).

Accordingly, we have considered the documents insofar as they were filed as exhibit Nos. 15-34 to Ms. Brown's testimony.

Marker's Objections - Filed by Marker With its Brief

Marker's Objections to Ms. Brown's Testimony

³³ Marker's Motion to Strike Notice of Reliance, pp. 1-2. Emphasis in original.

³⁴ Ms. Brown testified that she works for the Patagonia Footwear division of Wolverine Worldwide, Inc., which has the "official license to market and make and sell [Wolverine] footwear globally." Brown dep., p. 8.

³⁵ During her testimony, Ms. Brown specifically identified exhibit Nos. 15 and 16 as product reviews that appeared in Travel & Leisure (No. 15) and Aspen Peak magazine (No. 16) as well as confirming that "all of these [i.e., the products being reviewed in the articles] I recognize as Merrell products that were featured in PR reviews." Brown dep., pp. 39 and 40-41. Ms. Brown also stated that she worked directly on the product placement ads for Wolverine's goods shown in exhibit Nos. 23 and 30. Even if we were to have excluded the exhibits generally, these four would have been admitted based on Ms. Brown's authentication.

Marker objects to portions of Ms. Brown's testimony. First, as Ms. Brown was only employed by Wolverine during 2001–2009, Marker objects to her testimony regarding events that occurred prior to 2001 and after 2009, and to Exhibit Nos. 10 and 14 as having been created before Ms. Brown's employment. Ms. Brown's direct testimony regarding events that took place outside the 2001-2009 timeframe have not been considered where it is clear the witness has no personal knowledge of such events. We also have not considered exhibit No. 14 and the second page of exhibit No. 10. Ms. Brown testified concerning exhibit No. 14 that she had no personal knowledge of the promotional event described therein.³⁶ Similarly, although Ms. Brown testified that she was familiar with the vendor who printed Wolverine's t-shirts in 2002, Ms. Brown did not specify that she was familiar with them in 1998, when the second page of exhibit No. 10 (an invoice) was created.³⁷

Secondly, Marker objects to Ms. Brown's statements regarding whether there is a close relationship between apparel and footwear. Marker contends that Ms. Brown lacks personal knowledge about any such purported relationship and has not been qualified as an expert to offer her opinion regarding same. We find that Ms. Brown has the necessary background and experience in the outdoor footwear market to be aware of companies that have both footwear and clothing brands, and have considered her statements of fact regarding examples of such companies and

³⁶ Brown Dep., p. 61.

³⁷ Brown Dep., p. 23. The objection to the first page of exhibit No. 10 is overruled because that page is dated April 2, 2002, which was within the relevant timeframe. The exhibit consists of two pages referencing two separate transactions.

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her lay opinion as to whether this is a common practice in the industry, giving it whatever probative weight it merits. *See* Fed. R. Evid. 701 (allowing lay opinions of witnesses where (a) rationally based on the witness's perception; (b) helpful to clearly understanding the witness's testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702. We do not, however, consider her qualified as an expert in this field.



Third, Marker objects to Ms. Brown's testimony regarding Wolverine's advertising expenditures or marketing and sales numbers, as well as the introduction of Exhibit 8 to her deposition, for lack of personal knowledge. We have considered Ms. Brown's testimony to the extent she testified based on her personal knowledge regarding sales of Wolverine's products, but have not considered her testimony outside the relevant timeframe. As to exhibit No. 8, Ms. Brown stated affirmatively that she recognized the figures listed therein. Therefore, we have considered the exhibit, with the exception of the two years post-2009 (i.e., 2010 and 2011) that occurred following her tenure. However, neither her testimony nor the evidence identified a breakdown of the figures in terms of what goods were represented thereby or what marks were depicted on the goods covered by the sales figures. In view thereof, both testimony and evidence have been considered for whatever probative value they may have.

Marker's Objections to Mr. Zwiers' Testimony

Marker objects to Mr. Zwiers' testimony on several grounds. First, Marker objects to the testimony to the extent it would be considered part of Wolverine's case-in-chief in Opp. No. 91161363. Secondly, Marker claims that Mr. Zwiers does

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not have personal knowledge of the use of Wolverine's marks in connection with promotional activities. Third, Marker objects to Mr. Zwiers' testimony regarding whether a likelihood of confusion exists with respect to the parties' marks and certain third-party marks.

Mr. Zwiers testified to Wolverine's first use of the CIRCLE M mark  and the OVAL M mark . We agree with Marker that to the extent this testimony was presented to prove that Wolverine has priority in Opp. No. 91161363, it should have been presented during Wolverine's case-in-chief in that opposition. His testimony has not been considered for this purpose. However, to the extent this testimony goes to Wolverine's defense of its application to register the OVAL M mark in the child cases, the evidence was not improper rebuttal. In addition, we find that Mr. Zwiers had the requisite personal knowledge under Fed. R. Evid. 602 to testify regarding Wolverine's use of its marks. Any purported inadequacy that may exist in the testimony, such as that it was indicated to be to the best of his knowledge, goes to the weight of the testimony and not its admissibility. We have also considered Mr. Zwiers' testimony regarding third-party uses of similar marks, to the extent he testified that he was personally familiar with any such marks. We further admit his testimony comparing Wolverine's marks with such third-party marks and with Marker's mark, and his lay opinion regarding whether the marks are confusingly similar. We find that this opinion testimony satisfies the rational-basis and helpfulness requirements of Fed. R. Evid. 701. On the other hand, opinion testimony has minimal probative value as to consumer perception, and we

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will not substitute the opinion of a witness, even an expert witness, for our evaluation of the facts. *Edwards Lifesciences Corp.*, 94 USPQ2d 1399 (TTAB 2010); *citing Fisons Ltd. v. UAD Laboratories, Inc.*, 219 USPQ 661, 663 (TTAB 1983).


Marker's Objections to Ms. Bovee's Testimony

Marker objects to Ms. Bovee's testimony on the ground that it is improper rebuttal and should have been presented during Wolverine's case-in-chief. This objection is directed to Ms. Bovee's testimony regarding when Wolverine distributed apparel and what marks appeared on such apparel. Marker's objection is well taken with regard to the testimony to the extent it concerns when Wolverine first used those marks pleaded in Opp. No. 91161363, and the extent of such use. This was improper rebuttal testimony and should have been presented during Wolverine's opening testimony period. However, this information, as with Mr. Zwiers' testimony, is relevant not only to Wolverine's case against Marker's FLYING M mark, but also with respect to Wolverine's defense in the oppositions brought by Marker against Wolverine's OVAL M and BLOCK M marks. Thus, we have considered the testimony to the extent it may rebut Marker's case against Wolverine's pending applications in Opp. Nos. 9177732 and 91177736.


Marker's Objections to the Fall 2001 Wolverine Catalog


Marker argues that Wolverine should be estopped from relying upon its Fall 2001 catalog because it was not produced during discovery, but rather was submitted after Wolverine's testimony period closed. Wolverine contends that its failure to include the catalog in Wolverine's timely responses to Marker's document requests was inadvertent; that Marker will not suffer prejudice; and that Marker

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itself untimely disclosed nearly 100 pages that it had in its possession for almost a full year, well after the testimony cut-off period. Marker rebuts the charge that it was not prejudiced by arguing that until the catalog appeared, Marker was led to believe that no catalogs showed use of the OVAL M mark  on shoes before Spring 2002, which was after Marker began using its FLYING M mark at the 2002 Winter Olympics. We agree with Marker that reliance on the 2001 catalog is prejudicial. Marker had no opportunity to cross-examine Wolverine's witnesses as to the information disclosed in the catalog. We have not considered it.

The Record

Pursuant to Trademark Rule 2.122(b), the record includes Marker's application file (for Serial No. 76507077), Wolverine's application files (for Serial Nos. 78875659 and 78874991), and the pleadings. In addition, the record consists of copies of the parties' pleaded registrations that they have introduced in the respective cases. Marker also filed status and title copies of additional registrations (with its notice of reliance): for the mark  (hereinafter the "SERIF M" mark);³⁸ for a typed letter M mark,³⁹ the standard character mark MARKER,⁴⁰ the stylized



³⁸ Reg. No. 1719521 for "ski bindings"; registered September 22, 1992; renewed. Submitted with Marker's Notice of Reliance exhibit 6. *See, e.g.,* Wolverine's Brief, p. 6. Marker also referred to Reg. No. 1638400 for the SERIF M mark  for clothing, but as the registration has expired and thus has no probative value, we have not considered it. *Sunnen Products, supra.*

³⁹ Reg. No. 1595584 for "safety ski bindings"; registered May 8, 1990; renewed. Marker's Notice of Reliance exhibit 4.

⁴⁰ Marker submitted copies of two registrations for the mark MARKER:

Reg. No. 1850699 for "luggage; namely, travel bags, flight bags, ruck sacks, fanny packs, knapsacks and multi-use bags; namely, all purpose sports bags"; clothing; namely, parkas, jackets, ski suits, ski pants, ski vests, ski hats, pullovers, anoraks, shell suits, shell

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mark ,⁴¹ and the stylized mark .⁴² Marker also submitted a copy of Wolverine's registration for the mark MERRELL (standard character form) for "retail store services featuring footwear, clothing, bags, and accessories" under Marker's Supplemental Notice of Reliance.⁴³ The parties have treated these additional marks as being of record in this consolidated proceeding.


Wolverine has submitted six testimonial deposition transcripts (including exhibits) and two notices of reliance (introducing Marker's discovery responses to certain of Wolverine's discovery requests; third-party registrations and applications; newspaper and magazine articles; and the discovery deposition transcript of Michael Pereyo, including exhibits). We have considered this evidence and testimony in accordance with our evidentiary rulings.

pants, sweaters, hats, headbands, shirts, T-shirts, shorts, caps, and gloves; and sport bags; namely, ski boot bags, ski bags, and ski binding bags"; renewed. Marker's Notice of Reliance exhibit 7.

Reg. No. 2558197 for "ski bindings and parts therefor"; renewed. Marker's Notice of Reliance exhibit 8.

⁴¹ Marker submitted copies of two registrations for the mark:

Reg. No. 899119 for "ski bindings"; renewed as amended to . Marker's Notice of Reliance exhibit 3.

Reg. No. 1711716 for "all purpose sport bags, totebags and rucksacks" and "clothing; namely, pants, shirts, sweaters, jackets, headwear and gloves"; renewed as amended to . Marker's Notice of Reliance exhibit 5.

⁴² Reg. No. 2876482 for "skiing and snowboarding helmets" in Class 9; "all-purpose sport bags, carry-on bags and rucksacks" in Class 18; clothing, namely, ski boot bags, ski bibs, sport coats, winter sport gloves, headwear, winter sports mittens" in Class 25; "skiing and snowboarding gloves, skiing and snowboarding goggles, elbow, knee and shin guards for athletic use, skiing and snowboarding mittens, ski bindings and parts therefor, snow skis, snowboard bindings and parts therefor and snowboards" in Class 28; and "organizing festivals featuring winter sports, organizing winter sports tournaments and providing facilities and equipment for winter sports tournaments" in Class 41; Sections 8 and 15 combined declaration accepted and acknowledged. Marker's Notice of Reliance exhibit 9.

⁴³ Reg. No. 3368041; registered January 15, 2008. Marker's Supplemental Notice of Reliance dated April 25, 2012; exhibit 104.

Marker has submitted six testimonial depositions (including exhibits); the affidavit of Greg Grip, Vice President of Marker Volkl USA (with exhibits; cross examination and redirect was taken orally)⁴⁴; a notice of reliance (introducing copies of its registrations; magazine advertisements and news articles; third-party registrations;⁴⁵ portions of Mr. Zwiers' discovery deposition and exhibits; two statements of use; several SEC filings; and discovery responses produced by Wolverine in response to Marker's discovery requests); and a supplemental notice of reliance (introducing a status and title copy of Wolverine's registration for the mark MERRELL, a magazine article, portions of the discovery depositions of Michael Pereyo and Mr. Zwiers, with exhibits, and further discovery responses produced by Wolverine).

Standing

Both Wolverine (as plaintiff in Opp. No. 91161363) and Marker (as plaintiff in Opp. Nos. 91177732 and 91177736) have made their pleaded registrations of record, showing themselves as owner and that the registrations are valid and subsisting. Accordingly, they have established their standing in the respective oppositions. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Marker also has standing in the counterclaims by

⁴⁴ The parties are commended for stipulating to submission of Mr. Grip's direct testimony under affidavit and the efficiencies realized thereby, despite their evidentiary contentions discussed above.

⁴⁵ Marker also submitted copies of third-party registrations for the first time with its brief. These have not been considered. Trademark Rule 2.142(d); TBMP §§ 1203.02(e), 1207.01.

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virtue of being the defendant in the parent case, and the fact that Wolverine has asserted its registrations against Marker therein. *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Company, Inc.*, 95 USPQ2d 1271, 1274 (TTAB 2009); *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1930 n.12 (TTAB 1993).

Marker's Counterclaims for Fraud

Because Wolverine's claims in Opp. No. 91161363 are dependent upon whether its pleaded registrations are cancelled, we first address Marker's counterclaims to cancel Reg. Nos. 2772456 and 2860830.

Both registrations have been attacked as having been fraudulently procured. "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *In re Bose Corp.*, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009), quoting *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraud bears a heavy burden of proof. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939, citing *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 153 USPQ 749, 750 (CCPA 1967). "Indeed, 'the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.'" *In re Bose*, 91 USPQ2d at 1939, citing *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Marker claims that Wolverine knew, at the time it filed the statements of use in 2009 (Reg. No. 2772456) and 2010 (Reg. No. 2860830), that it was not using the mark on all of the goods recited in the registrations. Upon careful consideration of the testimony of Mr. Zwiers, Wolverine's corporate counsel, and Ms. Brown, Wolverine's employee, regarding the circumstances surrounding their signing of the respective statements of use, we find that they did not have the requisite intent to defraud the Office. Each independently testified to Wolverine's corporate procedures, which we find reasonable, for ensuring that the statements accurately represented the goods upon which the marks were used, and each independently advised that they followed those procedures at the time. For Reg. No. 2860830, covering backpacks and bags, Mr. Zwiers further testified that he believed the mark was in use at the time he signed the statement of use (on January 21, 2004) because Wolverine first presented its line of packs and bags at a New York trade show on December 10, 2003.⁴⁶ As to clothing, Ms. Brown testified to her awareness of the Oobe project,⁴⁷ the presentation that Oobe made to Wolverine in January 2002, the sample line of clothing produced by Oobe as part of its presentation, and Wolverine's subsequent agreement to, in her words, "purchase the apparel and then it was sold at retail. Liquidated, basically."⁴⁸ Mr. Pereyo confirmed that the Oobe apparel was liquidated and identified the date as being sometime in the "Fall" of

⁴⁶ Zwiers Dep., p. 35.

⁴⁷ Oobe Inc. was contracted by Wolverine in 2002 to make a presentation of a sample line of apparel for Wolverine to consider in connection with its future entry into the apparel market. *See, gen.*, Pereyo deposition.


⁴⁸ Brown Dep., p. 35.

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2002.⁴⁹ The Oobe sample line of clothing included shirts, pants, vests, pullovers, jackets, cardigans, caps, and t-shirts.⁵⁰ Thus, as of the date Ms. Brown signed the statement of use (July 21, 2003), the record evidence shows the mark was in use on most, if not all, of the clothing items identified in the registration, and Marker has not shown that Wolverine intentionally sought to defraud the Office into awarding it a registration for an overly broad list of goods.

The record does not support a determination that Wolverine committed fraud in procuring the registrations. Accordingly, Marker's counterclaims to cancel Reg. Nos. 2772456 and 2860830 on the basis of fraud are dismissed with prejudice.

Marker's Counterclaim - Likelihood of Confusion

We turn next to Marker's counterclaim to cancel Reg. No. 2860830 for the CIRCLE M mark  for "backpacks, daypacks, all-purpose sport and athletic bags, duffel bags, travel bags, fanny packs, shoulder bags and tote bags" on the ground of priority and likelihood of confusion.


Because the registration is subject to cancellation, priority is at issue. *Cf.*, *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1283-1284 (TTAB 1998). *See also*, *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) ("prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation"). Both parties may rely on the filing date of any


⁴⁹ Pereyo Dep., p. 75.

⁵⁰ *Id.*, p. 74, exhibit 46.

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pleaded or involved registration they own as establishing a constructive date of first use of its mark for the goods listed in such registration. *Brewski Beer*, 47 USPQ2d at 1283-1284 (parties may rely on the respective filing dates of any registrations they own, but the evidence of record otherwise determines priority).

Wolverine's Reg. No. 2860830 was filed on March 27, 2002, based on Wolverine's bona fide intent to use the mark in commerce. The earliest date Wolverine has claimed as the date of first use of its CIRCLE M mark  on bags is December 10, 2003. Because the application filing date is the earliest of these two dates, Wolverine may rely upon March 27, 2002 as its priority date.

Marker must therefore demonstrate that it established rights in its FLYING M mark , or in a mark confusingly similar to Wolverine's CIRCLE M mark, as of March 27, 2002, and that a likelihood of confusion exists between the marks.

Marker claims first use of the FLYING M mark "internationally for the 2003 winter ski season."⁵¹ Ski seasons run from August of one year to February of the next; the 2003 winter ski season accordingly would have run from August 2002 to February 2003. Marker allegedly started filling orders for ski-season 2003 merchandise (bearing the FLYING M mark) in July 2002;⁵² but the earliest catalog showing luggage⁵³ bearing the FLYING M mark is dated "04-05,"⁵⁴ and the testimony does not support an earlier date of use of the mark on luggage. Indeed,

⁵¹ Wiant Dep., p. 52.


⁵² Santos Dep., p. 85.

⁵³ We use the term "luggage" with respect to Marker's goods to include the goods of its FLYING M application, namely, "all-purpose sport bags, carry-on bags, rucksacks." The term "luggage" is taken from Marker's catalogs for these goods.

⁵⁴ Exhibit 1-R to Wiant deposition.

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Marker's response to Wolverine's discovery request for first use dates of the mark on luggage indicates that samples bearing the FLYING M mark on luggage was first shown to prospective purchasers in December 2003 and that these samples were displayed in the 2004-2005 catalog.⁵⁵ Thus, the earliest date on which the FLYING M mark appears to have been used on luggage post-dates Wolverine's priority date of March 27, 2002.


Marker argues that it first used an INTERMEDIARY FLYING M mark  on luggage during the Winter Olympics at Salt Lake City in February 2002,⁵⁶ and that use of this mark gives it priority. We consider the INTERMEDIARY FLYING M mark to be legally equivalent to Marker's FLYING M mark and Marker may therefore "tack" the earlier use of the INTERMEDIARY FLYING M mark onto its later use of the FLYING M mark. *See American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd* 923 F.2d 869 (Fed. Cir. 1990) (A party seeking to rely on its use of an earlier mark may do so only if the earlier mark is "the legal equivalent of the mark in question or indistinguishable therefrom, and would be considered by purchasers as the same mark"); *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224, 188 USPQ 485, 487 (CCPA 1976) (marks must create same, continuing commercial impression). However, the "Salt Lake 2002" catalog from the 2002 Winter Olympics does not support Marker's claim that the INTERMEDIARY FLYING M mark was used during the timeframe on

⁵⁵ Wolverine's Notice of Reliance exhibit C, Marker's Responses to Interrogatories Nos. 1 and 2.

⁵⁶ *Wiant Dep.*, p. 43.

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luggage, bags, packs or the like. The catalog, exhibit 1-L to Wiant's testimony deposition, shows use of the mark MARKER on luggage, not the INTERMEDIARY FLYING M mark, which is shown in use only as to a "competition glove" and a baseball cap. It is in the 2004-2005 catalog, as noted above, that the first appearance of the FLYING M mark is seen as applied to luggage. Therefore, Marker has not pre-dated Wolverine's priority date of March 27, 2002 through use of the INTERMEDIARY FLYING M mark. Marker cannot claim priority based on use of these marks on luggage.⁵⁷

Marker argues that it can pre-date Wolverine's priority date through its use and registration of two other marks. First, Marker owns Reg. No. 1719521 for the SERIF M mark  for "ski bindings," filed March 5, 1990. Marker has also shown that it used the SERIF M mark on bags as early as 1998.⁵⁸ As noted above, Marker may rely on earlier use of a different mark only if it is considered to be legally equivalent to its FLYING M mark, that is, only if they create the same, continuing commercial impression. We do not consider Marker's SERIF M mark to be sufficiently similar to its FLYING M mark to allow Marker to "tack" its first use of the SERIF M mark onto its later use of the FLYING M mark. Accordingly, Marker cannot claim priority on the basis of this mark.⁵⁹

⁵⁷ Marker does not hold a registration for the INTERMEDIARY FLYING M mark. And while Marker's registration for the MARKER mark does pre-date Wolverine's priority date, the mark is not legally equivalent to the FLYING M mark and therefore does not enable Marker to "tack" the priority date of the MARKER mark to the FLYING M mark.

⁵⁸ Wiant Dep., p. 40.




⁵⁹ For the same reason, Marker cannot rely on earlier use of the MARKER marks to establish priority. These marks create entirely different impressions from the single letter "M" marks. Marker's argument that because the Office allowed it to amend its registration

Marker also owns Reg. No. 1595584 for the typed letter **M** mark for “safety ski bindings,” filed October 16, 1989.⁶⁰ Marker has shown that it used the mark as part of a combination mark, such as M48, M38, or M27, on safety ski bindings.⁶¹ The evidence does not show that Marker has used the letter **M** alone, or in the letter/number combination forms, on luggage. While the filing date of Marker’s registration for the letter **M** mark, and its use of the marks M48, M38, and M27 pre-date Wolverine’s use of its mark, there is no evidence that “safety ski bindings” are related to luggage, such that Marker can “tack” its use of these marks on ski bindings to the FLYING M mark. Thus, Marker cannot claim priority on the basis of the typed letter **M** mark.

Because Marker cannot show that it has priority in connection with luggage, its counterclaim to cancel Reg. No. 2860830 on the ground of likelihood of confusion is dismissed.

Priority

We now turn to the issue of priority with respect to Wolverine’s claim under Section 2(d) in Opp. No. 91161363. As noted above, priority was at issue in connection with our decision vis-à-vis Marker’s counterclaim. However, priority is not typically at issue in an opposition where a plaintiff pleads and later proves ownership in a valid and subsisting Principal Register registration. *King Candy*,

 (with serifs) to the “modernized version”  (without serifs) does not compel the conclusion that the MARKER marks are legally equivalent to the FLYING M mark . Moreover, the fact that the “M” within the FLYING M and the “M” within the modernized MARKER mark is the same does not make them legally equivalent.

⁶⁰ Registered May 8, 1990; renewed.

⁶¹ Grip affidavit, paragraph 6.

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182 USPQ at 110 (Trademark Act requires consideration under Section 2(d) of an opposer's registration, regardless of whether the opposer is the prior user).

Because Wolverine owns an unchallenged registration, as well as two registrations the counterclaims against which have been dismissed herein, priority would ordinarily not be at issue in this case, leaving Wolverine to prove its pleaded ground of likelihood of confusion. Likewise, in Opp. Nos. 91177732 and 91177736, because Marker pleaded ownership of an unchallenged registration, priority would ordinarily not be at issue in these oppositions, leaving Marker to its proof on the issue of likelihood of confusion. In this consolidated proceeding, however, Wolverine has proven ownership of its pleaded registrations (in Opp. No. 91161363) and Marker has proven ownership of its pleaded registration (in Opp. Nos. 91177732 and 91177736). We must therefore decide whether to treat priority as at issue in both oppositions, or as being not at issue in either.

The predecessor court to our reviewing court, the Court of Custom and Patent Appeals, in *King Candy* interpreted Section 2(d) as prohibiting any requirement that an opposer who owns an unchallenged registration prove prior use. The Court's rationale was that to hold otherwise would negate the language of the statute ("No trademark...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...,*or*...previously used in the United States by another and not abandoned").⁶² The court also concluded that if such opposer were required to prove prior use, this would place the validity of its pleaded registration in issue,

⁶² Emphasis supplied.

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directly conflicting with Trademark Rule 2.106(b), which requires that a counterclaim (*i.e.* petition to cancel) must be filed in order to place the validity of a pleaded registration in issue. It would also conflict with the benefits conferred by Section 7(b), including the presumptions that a registration is *prima facie* evidence of ownership, validity and exclusive right to use the registered mark, and of Section 7(c)'s constructive use priority.

We find these reasons pertinent to the case at hand. Here, both parties have obtained registrations, and with respect to the marks and the goods/services recited therein, are entitled to the benefits of Section 7, the prohibition against having to prove priority embedded in Section 2(d), and the procedural protection afforded them by Rule 2.106(b). Thus, in Opp. No. 91161363, even if Marker were to show that it is the prior user of its marks, and in Opp. Nos. 91177732 and 91177736, even if Wolverine were to show that it is the prior user of its marks, priority is not at issue for the registered marks and the respective listed goods and services. *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010); *M.C.I. Foods, Inc. v. Bunte v. M.C.I. Foods, Inc.*, 86 USPQ2d 1044, 1046 (TTAB 2008) (“despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings....”). *Cf. Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1219 (TTAB 2011) (in combined opposition and cancellation proceeding, priority was not at issue in the opposition but was at issue in the cancellation, where both parties owned registrations); and TBMP § 511 (2013).

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On the other hand, we have considered the evidence of use that each party has submitted in its attempt to prove that it is the first to have used its marks on goods that fall outside the scope of the pleaded registrations.

Likelihood of Confusion



We now turn to a discussion of the substantive merits of Wolverine's likelihood of confusion claims in Opp. No. 91161363. Our likelihood of confusion determination under Section 2(d) is a legal conclusion, based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). "In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services." *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010). See also *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1357, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors in the proceeding now before us, are discussed below. Because evidence has been made of record regarding the use of "M" marks by third-parties; the channels of trade; the relevant classes of consumers; and the alleged lack of actual confusion, we have considered these additional factors in making our determination. To the extent any other *du Pont* factors for which no evidence or argument was presented may nonetheless be applicable, we treat them as neutral.



Comparison of the Marks

Under the first *du Pont* factor, we consider the similarity or dissimilarity of the parties' marks when they are viewed in their entirety in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992); *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980) (under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).


Marker's FLYING M mark  is strikingly similar to Wolverine's OVAL M mark  in terms of overall appearance. Both marks comprise the letter M in black set against a white background with a brushstroke oval drawn around it. Both ovals are drawn so that their larger section is horizontal. The fact that the ovals slant in different directions is unlikely to make a significant impression on prospective purchasers, who under actual marketing conditions, are likely to merely

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recall a letter “M” in an oval design. The letter “M” in the marks is also an essential feature of both marks. “[T]o that extent, the marks would sound the same when spoken and they would have the same letter mark meaning.” *Nike, Inc. v. WNBA Enterprises, LLC*, 85 USPQ2d 1187, 1199 (TTAB 2007) (comparing the marks  and , both containing a stylized letter “S”). Although the letter M in each party’s mark stands for quite different words, no record evidence exists to prove that the public is aware of the underlying derivation of the letters. *Cf., The Christian Broadcasting Network, Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1569 (TTAB 2007) (no evidence that the public was aware of the meaning of the conflicting initials CBN and ABS-CBN). Accordingly, the first *du Pont* factor favors a finding of likelihood of confusion with respect to Wolverine’s OVAL M mark.

Comparing Wolverine’s CIRCLE M mark  with Marker’s FLYING M mark , we again find the marks to be similar in their overall commercial impressions. Both marks contain a slanted letter “M” with a prominent front-leading edge. The letter itself appears to be on an incline, decreasing in size from a longer front “leg” to a shorter back “leg.” Both letters are set against circular carriers of reverse background. These visual similarities create similar overall commercial impressions. In pronunciation, again, both marks would sound the same to the extent the marks would be spoken, and there is no evidence to suggest the relevant consumer is aware of the derivation of the letter “M’s” in the parties’ marks. The first *du Pont* factor thus also favors a finding of likelihood of confusion with respect to Wolverine’s CIRCLE M mark.

Third-party Use of “M” Marks

The strength of a mark is determined by a variety of factors, including the length of time the mark has been in use, the volume of sales under the mark and the extent of advertising or promotion of the goods with which the mark is used. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Wolverine has not argued that its marks are famous and has not presented probative evidence regarding volume of sales under its marks or the extent of advertising sufficient to show that its marks are famous or strong. On the other hand, the marks are fanciful, have been registered on the Principal Register without resort to claims of acquired distinctiveness under Section 2(f) and, as such, have strong inherent source-indicating power with respect to the goods listed in the registrations. The evidence shows that Wolverine has used the CIRCLE M mark  for a relatively long period of time nationwide; first use was in 1999 on footwear and in 1998 on t-shirts.⁶³

Marker argues that Wolverine’s marks are weak in connection with clothing, because marks comprised of the letter “M” within a circular carrier are commonly in use. Marker argues that this evidence demonstrates that consumers distinguish between various “M” marks for clothing, and that they could therefore distinguish between Wolverine’s OVAL M and CIRCLE M marks and Marker’s FLYING M marks.

⁶³ Brown Dep., p. 21; exhibit 9.

“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.” *In Re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996); *Carefirst of Maryland, Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005). Marker introduced several apparel items offered by different companies with stylized “M” design marks displayed within circular or oval carriers. The marks and the goods on which they were displayed are:



displayed on a t-shirt;⁶⁴



displayed on a t-shirt;⁶⁵



displayed on a t-shirt⁶⁶ and on a glove;⁶⁷



displayed on a t-shirt and a pair of boxer shorts;⁶⁸



displayed on a t-shirt;⁶⁹

⁶⁴ Killian Dep., exhibit 3. A copy of this company’s website was also included as exhibit 5, offering for sale hats and a shoulder bag. The mark has been registered by Marmot Mountain LLC; Reg. No. 3431634; registered May 20, 2008; Marker’s notice of reliance exhibit 28.

⁶⁵ *Id.*, exhibit 6. The mark has been registered by LeMans Corporation; Reg. No. 2812205; renewed; Marker’s notice of reliance exhibit 34.

⁶⁶ *Id.*, exhibit 9.

⁶⁷ Chermoshnyuk Dep., exhibit 3.

⁶⁸ Neves Dep., exhibit 3.



displayed on a glove;⁷⁰



displayed on a hat;⁷¹



displayed on a hat⁷²; and



displayed on a t-shirt;⁷³

Based on Marker's showing, we agree that marks comprised of a letter "M" within a circular carrier commonly identify clothing. Accordingly, we find that Wolverine's marks are not strong in this class. The *du Pont* factor regarding the strength of plaintiff's mark(s) favors a finding of likelihood of confusion only in classes 9, 18, 28, and 41, but not in class 25.⁷⁴

⁶⁹ *Id.*, exhibit 7. The mark has been registered by Motorola Trademark Holdings, LLC.; Reg. No. 2201018; renewed; Marker's notice of reliance exhibit 31.

⁷⁰ Chermoshnyuk Dep., exhibit 5.




⁷¹ *Id.*, exhibit 6. The mark has been registered by the Memphis Redbirds Baseball Foundation; Reg. No. 2298792; renewed; Marker's notice of reliance exhibit 32.

⁷² *Id.*, exhibit 9. The mark has been registered by the Regents of the University of Minnesota without the carrier; Reg. No. 2788911; a Sections 8 and 15 combined declaration has been accepted and acknowledged; Marker's notice of reliance exhibit 30.

⁷³ *Id.*, exhibit 17. The mark has been registered by an individual, Bryan Kettles; Reg. No. 3820041; registered on July 20, 2010; Marker's notice of reliance exhibit 40.

⁷⁴ We note that the evidence of third-party use provided by Marker includes some third-party use of "M" marks on "bags," namely, an online catalog of merchandise being offered

Comparison of the Goods

Under the second *du Pont* factor, we determine the similarity or dissimilarity of the goods as they are identified in Marker's application and in Wolverine's registrations. Wolverine has registered its OVAL M mark  for footwear, and its CIRCLE M mark  for footwear, various articles of clothing, and assorted types of bags. Marker has applied to register its FLYING M mark  in International Classes 9, 18, 25, 28 and 41. A multiple-class application may be viewed as a group of applications for registration of a mark in connection with goods or services in each class, combined into one application. Each class of goods or services must be considered separately. *See G&W Laboratories, Inc. v. G W Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) (an applicant for a multiple class application is in the same position it would be had it filed several single-class applications).

Inasmuch as opposer has opposed all five classes of goods in Marker's application, we address the similarity of goods for each class.

1. International Class 9 – “Skiing and snowboarding helmets.”

Wolverine has not made use of any of its pleaded marks on skiing or snowboarding helmets or goods related to such helmets. While priority is not at issue with respect to the goods for which Wolverine has registrations (i.e., footwear,

under the Mazamba letter “M” mark (shown above) that includes “bags” (see Chermoshnyuk Dep., exhibit 20); and a catalog under the Marmot letter “M” mark (shown above) that includes an over-the-shoulder bag (see Killian Dep., exhibit 5.). We find this showing insufficient proof of market weakness of Wolverine's marks with respect to “bags.”

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clothing or bags), Wolverine has not presented any testimony or evidence showing that footwear, clothing or bags are related to skiing or snowboarding helmets. Marker, on the other hand, has shown that it has made use of its FLYING M mark on helmets.⁷⁵ Accordingly, as Wolverine cannot prove priority for these goods, Wolverine cannot prevail on its claims with respect to class 9.

2. International Class 28 – “Skiing and snowboarding gloves, elbow, knee and shin guards for athletic use, ski bindings and parts therefor, snow skis, snowboard bindings and parts therefor, snowboards.”


Because the goods in Class 28 cover a variety of items, we note that in the context of likelihood of confusion, it is sufficient if priority and likelihood of confusion is found with respect to any item that comes within the identification of goods in the class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1073 (TTAB 2011) (“[A] likelihood of confusion may be found with respect to a particular class based on any item within the identification of goods for that class.”).

Wolverine has not made use of any of its marks on any of the items listed in Marker’s application.⁷⁶ It also has not presented any testimony or evidence showing that these goods are related to footwear, clothing or bags. On the other

⁷⁵ Marker states in its Notice of Reliance that exhibits 10-27 thereto show products bearing the FLYING M mark. The exhibits appear to show the mark on helmets and snow skis (although the copies are quite indistinct).

⁷⁶ It is noted that “gloves” appear in class 25, but that “skiing and snowboarding gloves” appear in class 28. Wolverine’s class 25 registration (Reg. No. 2772456) initially included “gloves” but these were deleted from the identification of goods upon the filing of the Section 8 affidavit.

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hand, Marker owns a registration for the typed letter **M** for “safety ski bindings,”⁷⁷ has used variations of the letter “M” (i.e., M48, M38, M27) on ski bindings,⁷⁸ and has used the FLYING M mark  on ski gloves.⁷⁹ Accordingly, as Wolverine cannot prove priority, Wolverine cannot prevail on its claims with respect to class 28.

3. International Class 41 – “Organizing festivals featuring winter sports, organizing winter sports tournaments, providing facilities and equipment for winter sports tournaments.”

Neither Wolverine nor Marker has shown that it has made use of any of its marks in association with any of these services. Wolverine has not shown that footwear, clothing or bags are related to these services. Wolverine, as plaintiff in the opposition, bears the burden of proof on its claims. Accordingly, as Wolverine cannot prove priority, Wolverine cannot prevail on its claims with respect to class 41.

In accordance with the above findings, Marker is entitled to a registration for the FLYING M mark for the goods and services in Classes 9, 28 and 41.


4. International Class 18 – “All-purpose sport bags, carry-on bags, rucksacks.”

Wolverine’s Reg. No. 2860830 for the CIRCLE M mark  covers “backpacks, daypacks, all-purpose sport and athletic bags, duffel bags, travel bags, fanny packs, shoulder bags and tote bags.” As we have denied Marker’s counterclaim to cancel this mark, priority is not at issue in this case with respect to

⁷⁷ Reg. No. 1595584; registered May 8, 1990; renewed. See Wiant Dep., p. 31; exhibit 10.

⁷⁸ Grip affidavit, paragraph 6.

⁷⁹ Wiant Dep., p. 7; exhibit 1K.

these goods. The goods of Wolverine's registration for the CIRCLE M mark  are legally identical in part to those in Marker's application.

Wolverine's registrations for the OVAL M and CIRCLE M marks also cover "footwear." Wolverine argues that footwear and "all-purpose sport bags, carry-on bags, rucksacks" are related goods because these types of bags are within its "zone of natural expansion" of footwear.

As the Board has previously explained:

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods or services, but also as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark. ... The application of the doctrine is strictly limited to those cases where the expansion, whether actual or potential, is "natural," that is, where the goods or services of the subsequent user, on the one hand, and the goods or services as to which the first user has prior use, on the other, are of such nature that purchasers would generally expect them to emanate from the same source.

Among the factors to be considered in determining whether an expansion is natural are: (1) whether the second area of business (that is, the subsequent user's area of business, into which the first user has or potentially may expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business; (2) the nature and purpose of the goods or services in each area; (3) whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the

second area; and (4) whether other companies have expanded from one area to the other.

Mason Engineering and Design Corp. v. Mateson Chemical Corp., 225 USPQ 956, 962 (TTAB 1985) (internal citations omitted).

Wolverine's admissible evidence does not identify the date it first entered the "bags" market. However, Ms. Brown verified the authenticity of a large number of catalogs during her deposition, the earliest of which is dated "Spring 2004" and covers carry-ons, backpacks, wheelies, messenger bags, duffel-type bags, transit bags and briefcase alternatives.⁸⁰ In considering whether Wolverine's entry into the bags market would be considered a distinct departure from its footwear line, there is no evidence that these products would not involve new technology or know-how in manufacturing. As to the nature and purpose of the goods in each area, however, and whether the goodwill established in its footwear market would carry over to the bags market, Wolverine has shown that it marketed both types of products through similar advertising channels to the same classes of consumers. Indeed, Wolverine's catalogs for footwear include an outdoor line called "Outventure"; in its Fall 2003 catalog, this line includes hiking boots, running and multi-sport shoes and sport sandals.⁸¹ The Spring 2004 "Packs & Bags" catalog also includes a line called "Outventure Packs" where the emphasis is on the "outdoor experience" and "the pulse of the trail." Advertising copy in the catalog carries the idea that the company is expanding: "...building upon long-held Merrell brand principles of intelligent product design, comfortable fit and protection – from the elements, for

⁸⁰ Brown Dep., p. 49; exhibit 68.

⁸¹ *Id.*; exhibit 55.

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yourself, and now for your stuff - Merrell continues to define the New Outdoor with this new product offering. Outventure Packs and Transit Bags: for the trail and around the neighborhood.”⁸²

As to whether other companies have expanded from footwear to bags, Wolverine submitted several use-based, third-party registrations for marks that cover both footwear and various types of bags, such as backpacks and book bags.⁸³ Marker also submitted a number of use-based third-party registrations for “M” marks covering both clothing and bags under a single mark.⁸⁴ While the third-party registrations are generally of limited probative value, they nonetheless suggest that the goods are of a type which may emanate from a single source, *see In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). In addition, the online “2006 MAZAMBA catalog” submitted by Marker shows footwear (shoes, sandals and socks) being offered under the same letter “M” mark as luggage, backpacks, a “padfolio” and a brief case.⁸⁵

Taken as a whole, we find that the evidence shows that “all-purpose sport bags, carry-on bags, rucksacks” are within Wolverine’s zone of natural expansion. Accordingly, the *du Pont* factor regarding the relatedness of the goods favors a finding of likelihood of confusion in Class 18 with respect to both the OVAL M mark and the CIRCLE M mark.


⁸² *Id.*; exhibit 68. The “Outventure” line of bags was featured in each “Packs & Bags” catalog submitted; exhibits 68-73 (spanning years 2003 to 2008).


⁸³ Wolverine’s Notice of Reliance, exhibits O, P, S and T.


⁸⁴ Marker’s Notice of Reliance, exhibits 28-41.

⁸⁵ Chermoshnyuk Dep. p. 29, exhibit 20. “This is available on ... Mazamba.com.”

5. International Class 25 - “After-ski boots, ski boot bags, ski bibs, boots, sport coats, winter sport gloves, headwear, skiing and snowboarding mittens, athletic shoes and socks.”

Wolverine owns Reg. No. 3249275 for the OVAL M mark  for “footwear.”

The goods of Marker’s FLYING M mark  include “after-ski boots, boots, athletic shoes and socks.” After-ski boots, other types of boots and athletic shoes are all considered footwear; thus, these goods are legally identical. As to “socks,” these are inherently related, complementary goods to footwear, inasmuch as they are typically purchased together, may be matched as part of a set, and are obviously worn together. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women’s shoes are complementary to women’s clothing because they may be part of a coordinated outfit). *Accord, In re Sela Products, LLC*, 107 USPQ2d 1580 (TTAB 2013); *American Drill Bushing Co. v. Rockwell Manufacturing Co.*, 52 C.C.P.A. 1173, 342 F.2d 1019, 1022 (1965).

Wolverine also holds Reg. No. 2772456 for the CIRCLE M mark  for “clothing, namely, shirts, t-shirts, sweatshirts, sweaters, pants, shorts, jackets, shells, vests, coats, hats, scarves, socks and belts.” The goods of Reg. No. 2772456 (“coats” and “hats”) overlap with those identified in Marker’s application (“sport coats” and “headwear”). These goods are also legally identical.

Wolverine further argues that sports clothing is within the footwear zone of natural expansion. Marker argues that there is no “per se” rule that footwear and

clothing are within a natural zone of expansion, and that Wolverine's expansion from footwear to apparel was not natural.⁸⁶

On behalf of Wolverine, Mr. Zwiers⁸⁷ and Ms. Brown testified that it is typical for a footwear company to expand into apparel and vice versa. Ms. Brown stated that "ever since I joined the team in 2001 there was [sic] discussions about we're going into apparel."⁸⁸ And while there were several years between the Oobe project and Wolverine's actual launch of its own apparel line with the OVAL M mark, we consider Wolverine's actual expansion from footwear to apparel not to be a distinct departure from its footwear business. Footwear and apparel are designed to be worn together and serve similar purposes; they are typically sold to the same customers through similar channels of distribution. Significantly, other companies have similarly expanded from footwear to apparel or vice versa. Ms. Brown named several examples,⁸⁹ namely North Face, Columbia, Nike and Under Armour, as did Mr. Zwiers, who further explained Wolverine's intentions in expanding to apparel: that having the brand on apparel, in contrast to footwear, gets it "higher up on the body and more visible..."⁹⁰ Wolverine also submitted copies of several use-based, third-party registrations that cover both footwear and apparel.⁹¹ The evidence and testimony shows that the goods are related and may even be considered to be complementary in nature. Thus, the *du Pont* factor regarding the similarity of the

⁸⁶ Marker's Brief, p. 19.

⁸⁷ We have considered Mr. Zwiers' testimony in this regard, inasmuch as Marker also relied on his statements regarding Wolverine's intent to enter the clothing market.

⁸⁸ Brown Dep., p. 31.

⁸⁹ *Id.*, p. 33.

⁹⁰ Zwiers Dep., p. 16.

⁹¹ Wolverine's Notice of Reliance, exhibits N-T.

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goods favors a finding of likelihood of confusion with both the OVAL M and the CIRCLE M mark.

Trade Channels and Classes of Purchasers

Under the third *du Pont* factor, we determine the similarity or dissimilarity of the trade channels in which, and the classes of purchasers to whom, the respective goods are or would be marketed. Because there are no limitations or restrictions as to trade channels or classes of purchasers in the pertinent identifications, we presume that those goods are or would be marketed in all normal trade channels for such services and to all normal classes of purchasers of such services. See *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Moreover, Ms. Brown identified Wolverine's trade channels as "mid to upper tier retailers in a number of different categories, outdoor specialty, sporting goods, department stores, independent shoe accounts."⁹² Marker's trade channels similarly are the "larger non-department store retail locations," as well as "within the ski specialty retail community [and] the sporting good community,"⁹³ which includes "sporting goods stores, sporting goods departments, outdoor recreation stores, winter sports hard goods stores, ski and snowboard specialty stores, winter sport and ski rental shops, mail order sporting goods stores, and online sales via the

⁹² Brown Dep., p. 15.

⁹³ Santos Dep., p. 20.

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Internet.”⁹⁴ Both Ms. Brown on behalf of Wolverine, and Mr. Santos on behalf of Marker, named Dick’s Sporting Goods as a retailer.⁹⁵ Accordingly, we find that the trade channels overlap. The classes of consumers of the parties’ goods are also the same, namely ordinary consumers.

This *du Pont* factor favors a finding of likelihood of confusion.

Actual Confusion

Marker argues that there have been no instances of actual confusion, and that in response to Marker’s First Interrogatories and Requests for Production, specifically Interrogatory No. 15,⁹⁶ Wolverine indicated that it was unaware of any instances of actual confusion. Ms. Brown also testified that she was unaware of any such instances.⁹⁷ The probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred. *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007). We have determined that the first use of the FLYING M mark occurred in 2002 (based on the earlier use of the equivalent INTERMEDIARY FLYING M mark). However, in its September 15, 2009 responses to Wolverine’s discovery requests, Marker stated that it had discontinued use of its FLYING M mark except on ski bindings, helmets, and goggles.⁹⁸ Thus, we give little weight to the alleged absence of actual confusion in light of the relatively short period of time that the marks co-existed in

⁹⁴ Wolverine’s Notice of Reliance exhibit C (Marker’s “Supplemental Responses in Response to Order of March 5, 2009 and Correction of Request for Admission No. 14,” Interrog. 3).

⁹⁵ Santos Dep., p. 21; Brown Dep. p. 19.

⁹⁶ Marker’s Notice of Reliance, exhibit 54.

⁹⁷ Brown Dep., p. 50.

⁹⁸ Wiant Dep., p. 86; Wolverine’s Notice of Reliance exhibit E (Marker’s “Answers to [Wolverine’s] First Set of Discovery Requests,” Interrog. 3 and 5).

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the marketplace and the lack of record evidence of the marketing conditions under which there has been alleged concurrent use. In any event, the lack of evidence of actual confusion carries little weight in a Board proceeding. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). Accordingly, this *du Pont* factor is considered neutral.


Conclusion – Opp. No. 91161363

Because Wolverine has not shown a likelihood of confusion between its marks and Marker's FLYING M mark in classes 9, 28 and 41, Marker's application for the mark will proceed to registration in these classes.



Wolverine has shown a likelihood of confusion between its OVAL M and CIRCLE M marks and Marker's FLYING M mark in classes 18 and 25. The marks are similar, the goods are legally identical in part, the trade channels are similar and the classes of consumers are the same. In class 25, even though Wolverine's marks have been shown to exist in a crowded field, the goods are in-part identical, and at least with respect to Wolverine's OVAL M mark, the marks are extremely close such that their similarities far outweigh any general conclusion we may make that "M" marks surrounded by circular carriers are generally weak in the clothing class. We note too that likelihood of confusion "is to be avoided, as much between 'weak' marks as between 'strong' marks." *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). Balancing these factors, we





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find a likelihood of confusion between Wolverine's marks and Marker's FLYING M mark as applied to clothing.

In sum, the opposition is sustained on the ground of likelihood of confusion in classes 18 and 25, and registration to Marker of the FLYING M mark  is refused in these classes. The opposition is dismissed in Classes 9, 28 and 41, and the mark will proceed to registration in these classes in due course.

Opposition Nos. 91177732 and 91177736

In Opp. No. 91177732, Wolverine has applied to register the OVAL M mark  for "clothing, namely shirts, sweatshirts, pants, shorts, pullovers, jackets, hats, gloves, socks and belts."⁹⁹ In Opp. No. 91177736, Wolverine applied to register the BLOCK M mark  for the same goods.¹⁰⁰

Marker alleges prior use of the FLYING M mark  on the class 25 goods listed in its application and priority of use and ownership of two pleaded registrations: for the mark M (in typed characters) for "safety ski bindings"¹⁰¹ and for the SERIF M mark  for "ski bindings."¹⁰² Also of record in this proceeding are Marker's registrations for the marks MARKER,¹⁰³ ¹⁰⁴ and ¹⁰⁵ and Wolverine's registration for the mark MERRELL for retail store services.¹⁰⁶

⁹⁹ Serial No. 78875659.

¹⁰⁰ Serial No. 78874991.

¹⁰¹ Reg. No. 1595584.

¹⁰² Reg. No. 1719521.





¹⁰³ Reg. No. 1850699 and No. 2558197.

¹⁰⁴ Reg. No. 899119 and No. 1711716.

¹⁰⁵ Reg. No. 2876482.

¹⁰⁶ Reg. No. 3368041.

Because its pleaded registrations are of record, Marker has standing to oppose Wolverine's applications. Because Marker has proven the status and title of its two pleaded registrations, priority is not at issue with respect to the goods identified therein. However, Marker has not presented any testimony or evidence to show that "safety ski bindings" or "ski bindings" are related to any of the goods identified in Wolverine's applications, or that the listed goods are within the zone of natural expansion for ski bindings. Accordingly, Marker cannot prevail on the basis of these two registrations. We look then to Marker's allegations of prior use and likelihood of confusion with its SERIF M mark, the typed letter M mark, the INTERMEDIARY FLYING M mark and the FLYING M mark. We first address the issue of priority.

The record evidence does not demonstrate Wolverine's use of the OVAL M mark  or BLOCK M mark  on clothing. Wolverine may claim May 3, 2006 as its constructive first use date for both marks on clothing, based on the filing dates of the involved applications. Trademark Act Section 7(c), 15 U.S.C. § 1057(c). In addition, Wolverine has presented the testimony of Wolverine Outdoors, Inc.'s president stating that Wolverine first used the OVAL M mark  on footwear in 1999,¹⁰⁷ but this testimony was not supported by evidence showing use of the mark on footwear. On the other hand, Wolverine has demonstrated first use of the CIRCLE M mark  on t-shirts and hats in 1998,¹⁰⁸ and that it commissioned

¹⁰⁷ Zwiers Dep., p. 52.


¹⁰⁸ Bovee Dep., p. 26; exhibit 9; p. 44; exhibit 103.

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Oobe, Inc. to produce a line of clothing bearing the CIRCLE M mark in 2002 that resulted in commercial sales.¹⁰⁹ Accordingly, Wolverine may claim 1998 as its date of first use, based on use of the CIRCLE M mark on clothing, if Wolverine may “tack” the use of the CIRCLE M mark onto the OVAL M or BLOCK M mark.

In our earlier discussion on tacking, we noted that in order for one mark to be “tacked” onto another, the marks must be considered legal equivalents. That is, they must create the same continuing commercial impression. All of Wolverine’s marks utilize the identical rendering of the letter “M” and thereby create the same continuing commercial impression. Accordingly, Wolverine may tack use of its CIRCLE M mark onto the OVAL M and BLOCK M marks for purposes of establishing priority.

In light of the above, Marker needs to show that it used an “M” mark on clothing or related goods prior to 1998 and that there is a likelihood of confusion between the marks. Marker’s first demonstrated use of an “M” mark on clothing

was in 1989, when it used the SERIF M mark  on a long-sleeved and a short-sleeved t-shirt.¹¹⁰ As to the INTERMEDIARY FLYING M mark, Marker first used this mark on gloves and hats during the February 2002 Winter Olympics in Salt Lake City;¹¹¹ the mark was also used on ski pants and vests during “the Olympic time period.”¹¹² We consider this mark to be the legal equivalent of Marker’s


¹⁰⁹ See discussion *supra* at 18.




¹¹⁰ Wiant Dep., pp. 40-42; exhibit 14.

¹¹¹ See the “Salt Lake 2002” catalog; exhibit 1-L and the “Introducing M-Line 2002-2003” catalog, exhibit 1-K.

¹¹² Wiant Dep., p. 45.

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FLYING M mark , which it first used on jackets in 2003.¹¹³ Accordingly, Marker may rely on February 2002 as the date of its first use of the FLYING M mark. Marker has not submitted testimony or evidence to support a claim of use of a letter M mark (in typed or standard character form, or as used in combination with numerals) on clothing.



Based on the record described above, Marker has priority for clothing based on its earlier use of the SERIF M mark  only. We must therefore consider whether Marker has shown a likelihood of confusion between the SERIF M mark and Wolverine's applied-for marks:  and . As we have earlier discussed, multiple marks comprising "M" designs have been shown to be prevalent in the clothing class, and consumers have been conditioned to distinguish based on minor differences between marks. While the letter "M" in each mark is still an essential feature thereof, the unique stylizations of the letter "M's" in each mark differentiate their appearance and overall commercial impression. Therefore, despite their use on similar goods, we find that confusion would be unlikely.

Marker may not "tack" its earlier use of the SERIF M mark onto its FLYING M mark because the marks are not legal equivalents. Likewise, even were we to consider Marker's letter M mark capable of being represented in a circular carrier similar to the FLYING M mark, tacking would not be permitted because the goods on which Marker has used the M and "M-numerical combination" marks are not


¹¹³ *Id.*, exhibit 15; see also the "Introducing M-Line 2002-2003" catalog, exhibit 1-K and Santos Dep., p. 64.



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substantially identical to clothing, the relevant goods of the FLYING M mark. *Big Blue Products Inc.*, 19 USPQ2d 1072, (TTAB 1991) (tacking permitted only when the two sets of goods are “substantially identical”).

Because Wolverine has shown that it was the first to use its CIRCLE M mark on clothing, and that Wolverine may tack its prior use of the CIRCLE M mark to the OVAL M and BLOCK M marks, Marker cannot show that it has priority, a necessary element in Marker’s claim on the basis of likelihood of confusion. Accordingly, Marker’s oppositions to Wolverine’s applications for the OVAL M mark  and the BLOCK M mark  for “clothing, namely shirts, sweatshirts, pants, shorts, pullovers, jackets, hats, gloves, socks and belts” are dismissed.

Decision-Summary

In Opposition No. 91161363, Wolverine’s opposition to Marker’s application Serial No. 76507077 for the mark  is granted with respect to classes 18 and 25 and registration to Marker is refused in these classes. The opposition is dismissed as to classes 9, 28, and 41, and the application will proceed to registration in these classes.

In Opposition Nos. 91177732 and 91177736, Marker’s oppositions to Wolverine’s applications Serial No. 78875659 for the OVAL M mark  and Serial No. 78874991 for the BLOCK M mark  are also dismissed, and the applications will proceed to registration.

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