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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

L.A. Gear, Inc.
v.
Calcados Ferracini Ltda.

Opposition No. 91168866
to application Serial No. 78476776
filed on August 31, 2004

Anthony R. Masiello and Paul F. Kilmer of Holland & Knight
for L.A. Gear, Inc.

Dana E. Stewart of Global Trademarks, Inc. for Calcados
Ferracini Ltda.

Before Quinn, Drost and Taylor, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Calcados Ferracini Ltda. filed an intent-to-use
application to register the mark shown below



for "footwear, shoes, sandals, belts, clothing, namely,
shirts, t-shirts, pants, socks, Bermuda shorts" in
International Class 25.

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L.A. Gear, Inc. opposed registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with applicant's goods, so resembles opposer's previously used and registered marks shown below as to be likely to cause confusion.



for "apparel, namely, pants, dresses, shorts, skirts, shirts, blouses, jackets, socks, hats, leotards and tights" in International Class 25;¹ and "footwear" in International Class 25;² and



for "footwear, namely, shoes" in International Class 25.³ Opposer also claims that applicant's mark is likely to dilute the distinctive quality of opposer's marks under Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

Applicant, in its answer, denied the salient allegations in the notice of opposition.

The record consists of the pleadings; the file of the

¹ Registration No. 1768103, issued April 27, 1993; renewed.

² Registration No. 1792665, issued September 14, 1993; renewed.

³ Registration No. 2160298 (Section 2(f) as to "LA"), issued May 26, 1998; renewed.

involved application; status and title copies of three of opposer's pleaded registrations, excerpts from printed publications, and applicant's answers to certain discovery requests, all introduced by way of opposer's notices of reliance; and status and title copies of four of applicant's registrations, and copies of fifteen third-party registrations, all made of record by applicant's notices of reliance.⁴ Both parties filed briefs on the case.

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made its pleaded registrations of record and, further, has shown that it is not a mere intermeddler. Opposer's use and registration of its mark establish that opposer has standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

⁴ Opposer objected to applicant's notice of reliance on exhibit nos. 1-13 comprising applicant's own answers to certain interrogatories and requests for admission. Applicant did not respond to opposer's objection. Trademark Rule 2.120(j)(5) provides that an answer to an interrogatory or a response to a request for admission may be submitted and made part of the record by only the inquiring party, except in limited circumstances. Inasmuch as applicant did not respond to the objection and, thus, did not justify reliance on its own discovery responses, we decline to consider the additional responses. See TBMP §704.10 (2d ed. rev. 2004). We hasten to add that, even if considered, this evidence would not mandate a different result in this proceeding.

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Further, in view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion.

We accordingly turn to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. The relevant *du Pont* factors in the proceeding now before us are discussed below.

The goods involved in this case are, in significant part, identical, and applicant does not contend otherwise. Both parties list "footwear; shoes; shirts; pants; socks; and shorts" in their respective identifications of goods. Neither opposer's nor applicant's identification of goods is restricted as to trade channels or classes of purchasers. Accordingly, we must presume that the parties' goods are marketed in all of the normal trade channels for such goods

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(department stores, mass merchandisers, shoe stores, clothing stores, and the like),⁵ and that the goods are bought by the usual classes of purchasers. Thus, it is presumed that the footwear and clothing move in the same trade channels to the same classes of purchasers. In view of the nature of the goods, these purchasers would include ordinary consumers, who would be expected to exercise nothing more than ordinary care in their purchasing decisions. Further, the goods are relatively inexpensive, and are capable of being purchased on impulse.

The *du Pont* factors of the identity of the goods and trade channels, as well as the identity of the impulse conditions under which and buyers to whom sales are made, weigh heavily in favor of a finding of likelihood of confusion.

We now turn to compare the marks. In comparing the marks, opposer focused its attention on its design mark *per se*, not the stylized "LA" mark. Likewise, we will focus on opposer's design mark inasmuch as this mark is the closest to applicant's mark and, thus, presents opposer's strongest case for likelihood of confusion. Accordingly, the two

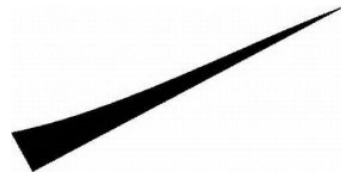
⁵ In point of fact, both parties' goods are sold at J.C. Penney.

marks being compared are reproduced below.

Opposer's Mark:



Applicant's Mark:



In considering the marks, we initially note that when marks are used in connection with identical goods, as is the case herein (at least with respect to footwear, shoes and specific clothing items), "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Because the marks at issue are both design marks, the issue of the similarity between the marks must be decided primarily on the basis of visual similarity. The test, under the first *du Pont* factor, 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 that confusion as to the source of the goods offered under the respective marks is likely to result. In this situation, consideration must be given to the fact that a purchaser's recollection of design marks is often of a general and hazy

nature. See, e.g., *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986); and *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973). In the view of Professor McCarthy, “[s]imilarity in appearance between marks is really nothing more than a subjective ‘eyeball’ test.” J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:25 (4th ed. 2009).

Applicant points out, in painstaking detail, distinctions between, as applicant describes the marks, its “triangle device” and opposer’s “stylized exclamation point.” Arguing that there is a “vast difference” in the overall commercial impressions of the two marks, applicant essentially contends that opposer minimizes the importance of the “five-sided base” when comparing the marks. (Brief, pp. 8-10).

To be sure, there are specific differences between the marks. But, contrary to applicant’s contentions, we find that the marks, when considered as a whole, are very similar in appearance, and that they engender very similar overall commercial impressions. We agree with opposer’s “eyeball” comparison of the marks (Brief, p. 20):

Both marks consist of a line that inclines upward from left to right and tapers in thickness as it inclines upward. In each case the slope of the line is at an angle approximately 40° from the horizontal. In both marks, the line is not entirely straight, but incorporates a slight curve. Each mark

has the overall appearance of an elongated triangle.

We likewise view the below "jot" in opposer's mark just as opposer describes it, merely as "a continuation of the tapering, curved line that defines the tail of the mark...Despite the slight break between the jot and the tail, there is smooth continuity between the curves of the tail and the curved side edges of the jot." (Reply Brief, p. 6). Both design marks essentially present diagonal strokes; the slight break present in opposer's mark may not even be noticed by consumers. In any event, the break is insufficient to distinguish the marks.

The similarity between the design marks weighs in favor of likelihood of confusion.

Inasmuch as opposer introduced evidence bearing on the fame of its marks, we now turn to consider this *du Pont* factor. At one point in its brief, opposer claims that its mark is "strong" (Brief, p. 29), while subsequently opposer characterizes its mark as "famous" (Brief, p. 32). Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes

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arises "as long as a significant portion of the relevant consuming public...recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). The relevant consuming public herein comprises the general public.

In support of its position opposer points to widespread print advertisements since 1999; promotional activities with and endorsement by professional basketball players; and reference to opposer's "brand" in fashion magazines.

The evidence falls short of establishing that opposer's design mark is either "strong" or "famous." As applicant correctly points out, much of the evidence relates to the fame of the word mark "LA GEAR," a mark not involved herein. Further, there are no sales or advertising figures relative to opposer's design mark, or any other evidence in the record sufficient to establish fame of the design mark. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) ("Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it."); and *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

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Accordingly, the fame factor is neutral.

The sixth *du Pont* factor focuses on the number and nature of similar marks in use on similar goods. Applicant relied on the existence of fifteen third-party registrations of marks comprising "line or triangle devices" covering footwear and apparel, and copies thereof were introduced. Applicant argues that opposer's mark is weak, and the scope of protection given to opposer's mark "should be limited to the exact illustration presented in the registration upon which its opposition is based." (Brief, p. 12).

As often stated, third-party registrations are not evidence of use of the marks shown therein, or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). "In the absence of evidence of the extent of actual continuing use of registered marks, mere registrations are entitled to little weight in establishing whether there is likely to be confusion because registrations by themselves do not indicate how the public mind may have been conditioned." *Stanadyne, Inc. v. Lins*, 490 F.2d 1396, 180 USPQ 649, 649 (CCPA 1974). We recognize that others in the trade have registered arguably similar marks to the marks involved herein, but applicant has failed to provide any evidence bearing on use of the registered marks. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée*

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En 1772, 73 USPQ2d at 1693. We also would point out that each of the registered marks is less similar to opposer's mark than is applicant's mark. *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971), *cert. denied*, 404 U.S. 938 (1971). This factor is neutral.

Applicant makes much of the absence of actual confusion. Applicant asserts that there is no evidence of any instances of actual confusion despite thirteen years of "coexistence." This is particularly notable, according to applicant, because the parties' goods have been offered at J.C. Penney and the WSA footwear trade show.

Applicant's argument is entitled to little value. The record is devoid of probative evidence relating to the extent of use of applicant's mark and, thus, the existence of meaningful opportunities for instances of actual confusion to have occurred in the marketplace.⁶ See *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1847; and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, as often stated, proof of actual confusion is not necessary to establish likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983).

⁶ We recognize that both parties' goods have been sold at J.C. Penney, but we reiterate that we do not know the extent of use so as to accurately gauge the opportunity for confusion.

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Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

The record includes evidence bearing on the thirteenth *du Pont* factor, namely, any other established fact probative of the effect of use. There is evidence showing that the parties' respective marks have been displayed on shoes in identical fashion, that is, on the sides and tongues of shoes. Moreover, although color is not claimed in either opposer's registrations or the involved application, applicant admitted that, like opposer, it regularly displays the involved mark in the color red. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (trade dress not ordinarily considered, but it may provide evidence of whether the marks project a confusingly similar commercial impression); and *Uncle Ben's Inc. v. Stubenberg International Inc.*, 47 USPQ2d 1310, 1312 (TTAB 1998).

We have carefully considered all of the evidence pertaining to the relevant du Pont factors, as well as all of the arguments with respect thereto (including any arguments not specifically discussed in this opinion), and we conclude that opposer has proven its likelihood of confusion ground of opposition. We conclude that consumers

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familiar with opposer's footwear and clothing sold under opposer's design mark would be likely to believe, upon encountering applicant's very similar design mark for footwear and clothing, that the goods originate from or are associated with or sponsored by the same entity.

Lastly, to the extent that there may be any doubt on our determination of likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user and registrant. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ at 395.

In view of the decision to sustain the opposition on the ground of likelihood of confusion, it is not necessary to consider opposer's dilution claim.

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.