

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
May 1, 2014

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June 10, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Shield Mfg., Inc.*  
*v.*  
*OPRO International Limited*

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Opposition No. 91190276

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Ellen S. Simpson of Simpson & Simpson PLLC for Shield Mfg. Inc.

Anthony Handal of Handal & Morofsky LLC for OPRO International Limited.

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Before Bergsman, Shaw and Adlin, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

OPRO International Limited (“Applicant”) filed an application to register the mark OPROSHIELD, in standard character form, for “gum shields for protecting the mouth from injury,” in Class 9. The application was filed under the provisions of Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on International Registration No. 0933960, registered June 28, 2007.

Shield Mfg., Inc. (“Opposer”) filed a notice of opposition to registration of applicant’s mark on the grounds of likelihood of confusion, Section 2(d) of the

Trademark Act of 1946, 15 U.S.C. § 1052(d), and dilution, Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). With respect to the likelihood of confusion claim, opposer pleaded ownership of Registration No. 0835151 for the mark SHIELD, in typed drawing form, for “protective mouth guards for all contact sports, and eyeglass holders,” in Class 10.<sup>1</sup> Opposer also alleged that it “has extensively used and promoted its aforesaid mark [SHIELD] and as a result of Opposer’s extensive sales, advertising and other promotional efforts, its mark is well known to consumers and has been distinctive and famous since prior to the filing date of application opposed herein.”<sup>2</sup>

Applicant, in its Answer, denied the salient allegations in the notice of opposition and filed a counterclaim to cancel opposer’s pleaded registration on the ground that the term “shield is generic to [sic] protective devices for protecting the mouth, gums and/or teeth from injury.”

Opposer as counterclaim defendant, in its reply, denied the salient allegations in the counterclaim.

#### I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the application and registration at issue. In addition, the parties introduced the following testimony and evidence:

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<sup>1</sup> Issued September 12, 1967; third renewal.

<sup>2</sup> Paragraph No. 3 of the notice of opposition (1 TTABVue 4).

A. Opposer's testimony and evidence.<sup>3</sup>

1. First notice of reliance comprising applicant's responses to Interrogatory Nos. 6, 8, 13, 14, 16, 17, 18, and 22 (TTABVue 57);<sup>4</sup>

2. Second notice of reliance (TTABVue 58) comprising the following items:

- a. Dictionary definition of "mouth guard" from the WebMD Medical Dictionary (July 29, 2012);
- b. Copies of newspaper articles referencing opposer;
- c. The list of the search results from the GOOGLE search engine for "Shield Mouth Guard"; and
- d. The results from a YouTube search for "shield mouth guard."

3. Fourth notice of reliance (TTABVue 68) comprising the following items:

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<sup>3</sup> Opposer's third notice of reliance (TTABVue 59) comprises photographs of the parties' packaging. The photographs are not admissible through a notice of reliance and have been given no consideration.

<sup>4</sup> Opposer proffered documents produced in response to specific requests for the production of documents. Such documents are not admissible through a notice of reliance. Trademark Rule 2.120(j)(3)(ii) ("A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e)."). However, a party's response that no documents exist may be made of record. *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 at n.7 (TTAB 2012). Applicant's produced documents have not been considered.

Opposer also proffered its own responses to specific interrogatories served by applicant through the notice of reliance. An answer to an interrogatory may generally be submitted and made part of the record by only the inquiring party. Trademark Rule 2.120(j)(5), 37 CFR § 2.120(j)(5). Opposer's above-noted responses to applicant's interrogatories have not been considered.

- a. Excerpts from third-party websites showing use of the term “gum shield”;
  - b. Copies of 22 third-party registrations and one application that show use of the term “gum shield” in the description of goods;<sup>5</sup>
  - c. Copy of the USPTO records for an abandoned application to register the mark FORCE SHIELD MOUTH GUARD;
  - d. Copy of Registration No. 4120856 for the mark SPORTS SHIELD for bandages for skin wounds (the use of the word “shield” was not disclaimed);
  - e. A definition of the word “shield” from **WEBSTER’S II – NEW COLLEGE DICTIONARY** (1995);
  - f. Screen shot from a YouTube video; and
  - g. Excerpt from the website uxcell.com purporting to show the use of the term “gum shield;”
4. Fifth notice of reliance (TTABVue 67) comprising the following items:<sup>6</sup>

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<sup>5</sup> A pending application is incompetent to prove anything other than the fact that it was filed. *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981); *Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 594 (TTAB 1980).

<sup>6</sup> Opposer proffered the affidavit of James Geraci, its President. An affidavit or declaration of a witness may be admissible when the parties stipulate in writing that testimony may be submitted by affidavit or declaration. Trademark Rule 2.123 (b), 37 CFR § 2.123(b). Because the parties did not file a written stipulation to submit testimony by affidavit or declaration, we have not considered the affidavit.

Opposer also proffered a copy of a cease and desist letter and a settlement agreement. Neither of these documents is admissible through a Notice of Reliance and, therefore, they have not been given any consideration.

- a. Notice of Abandonment for application Serial No. 85505294 for the mark FORCE SHIELD MOUTH GUARD;
  - b. Printout from the USPTO database for application Serial No. 85505294 for the mark FORCE SHIELD MOUTH GUARD;
  - c. Excerpts from the Sports Shield website (sportshield.com);
  - d. Copy of Registration No. 4120856 for the mark SPORTS SHIELD for bandages for skin wounds;
  - e. Copy of Registration No. 2935099 for the mark PRACTI-SHIELD for a cardiopulmonary resuscitation training mannequin face shield; and
  - f. A printout of the Wikipedia editing policy;
5. Testimony deposition of James Geraci, opposer's President, with attached exhibits (TTABVue 69);
  6. Testimony deposition of Robert Berghash, opposer's founder and Chairman of the Board of Directors, with attached exhibits (TTABVue 70); and
  7. Testimony deposition of David Berghash, opposer's CEO, with attached exhibits (TTABVue 71).

B. Applicant's testimony and evidence.

1. Notice of reliance (TTABVue 61) on the following items:<sup>7</sup>

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<sup>7</sup> Applicant proffered the declaration of its counsel to authenticate various documents. However, as indicated above in n.6, testimony may not be admitted through declarations or affidavits unless stipulated to in writing. The declaration of applicant's counsel has been given no consideration.

- a. Dictionary definition of the word “shield” from **WEBSTER’S NEW UNIVERSAL UNABRIDGED DICTIONARY** (1996);
  - b. A copy of opposer’s catalog from shieldsports.com;
  - c. Excerpts from the gungfu.com website;
  - d. Wikipedia entry for “mouthguard”;
  - e. Copies of third-party patents using the word “shield”;
  - f. Copies of third-party registrations “directed to the ‘mouth shield’”;
  - g. Excerpts from third-party websites showing use of the term “gum shield”;
  - h. List of results from a GOOGLE search engine search for “mouth shield”; and
  - i. Dictionary definition of the word “shield” from Webster’s II New College Dictionary (1995);
2. Second notice of reliance (TTABVue 61) on opposer’s responses to Interrogatory Nos. 4, 10, 11, 14, 15 and 16 to applicant’s first set of interrogatories;
  3. Third notice of reliance (TTABVue 62) comprising the following items;<sup>8</sup>
    - a. Copies of third-party patents; and
    - b. Opposer’s response to applicant’s Interrogatory No. 3;
  4. Testimony deposition of Laura Pollander, law clerk and patent engineer for applicant’s counsel, with attached documents (TTABVue 63); and

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<sup>8</sup> Applicant’s third notice of reliance is largely duplicative of its first notice of reliance. We are not listing copies of documents that applicant previously introduced.

5. Testimony deposition of Dr. Anthony Lovat, applicant's Managing Director, with attached exhibits (TTABVue 64).

II. Whether SHIELD is generic for mouth guards?

We first address applicant's counterclaim to cancel opposer's pleaded registration.

A. Standing.

Applicant has standing based on opposer's assertion of its registration against applicant in its notice of opposition. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999) (“[A]pplicant's standing to assert the counterclaim arises from applicant's position as a defendant in the opposition and cancellation initiated by opposer”).

B. Genericness.

It is applicant's burden to establish that “shield” is generic by a preponderance of the evidence. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991) (“Magic Wand had the burden to show by a preponderance of the evidence that the primary significance of the TOUCHLESS mark to the relevant public is the automobile washing service itself, rather than a washing service provided by a particular entity.”).<sup>9</sup>

There is a two-part test used to determine whether a designation is generic: (1) what is the genus of goods or services at issue? and (2) does the relevant public

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<sup>9</sup> We also note that one seeking to cancel a registration must rebut the presumption that the registration is valid by a preponderance of the evidence. *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979).

understand the designation primarily to refer to that genus of goods or services? *H. Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). The public's perception is the primary consideration in determining whether a term is generic. *Loglan Inst. Inc. v. Logical Language Group Inc.*, 902 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992). Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Loglan Inst.* 22 USPQ2d at 1533; *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979).

1. The genus of the goods at issue.

The category of goods is mouth guards. *Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1552 (“[A] proper genericness inquiry focuses on the description of services set forth in the certificate of registration.”). *See also In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1112 (TTAB 2010) (“the genus of goods at issue in this case is adequately defined by applicant's identification of goods...”).

Applicant argues “that the genus of goods is devices which protect the human body from injury due to physical impact during sporting, martial arts and other activities.”<sup>10</sup> However, “the description in the registration certificate identifies the [goods] in connection with which the registrant uses the mark. The Lanham Act permits cancellation when a ‘registered mark becomes the generic name for the goods or services ... for which it is registered...’ 15 U.S.C. §1064(3). Thus, a proper

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<sup>10</sup> Applicant's Brief, p. 29 (79 TTABVue 38).



genericness inquiry focuses on the description of [goods] set forth in the certificate of registration.” *Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1552, *citing Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (the question of registrability must be decided on the basis of the identification of goods in the application).

There are cases where the identification of goods or services does not accurately identify the genus of the goods or services, and in those circumstances we may look at the record to determine the genus of the goods. *See e.g. In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (ambiguity in the term “computerized on-line retail services” in the identification of services, led the Board to construe the genus of applicant's services too narrowly); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1655 (TTAB 2005), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (record shows that the services of providing a website with a database of information covering the identified topics of law, legal news and legal services and that a central and inextricably intertwined element of that genus is information about lawyers and information from lawyers). “[T]he analytical focus on the description of [goods] is based on the premise that the description reflects actual conditions of use of a mark.” *Reed Elsevier Properties*, 77 USPQ2d at 1654. That is, the identification of goods is rooted in reality. *Id.*

In this case, there is no ambiguity as to the goods for which the parties use SHIELD: mouth guards. *See In re Minnetonka, Inc.*, 3 USPQ2d 1711, 1713 (TTAB 1987) (SOFTSOAP for “liquid hand soap in a pump-type dispenser”: the genus is

liquid hand soaps, not soaps *per se*). Thus, to paraphrase Judge Learned Hand in *Bayer Co. v. United Drug Co.*, 272 F. 505 (SDNY 1921): the basic question before the Board is one of fact: What do the buyers understand by the word “shield” in connection with mouth guards? *Id.* at 509.

2. The relevant public.

The second part of the genericness test is whether the relevant public understands the designation primarily to refer to that class of goods. The relevant public for a genericness determination is the purchasing or consuming public for the class of goods. *Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1553, citing *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 228 USPQ at 530; *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 202 USPQ at 105 (CCPA 1979).

Mouth guards are used by athletes.<sup>11</sup> Mouth guards are sold or distributed to athletes through trainers and coaches,<sup>12</sup> retailers,<sup>13</sup> people who run leagues, team

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<sup>11</sup> Geraci Dep., pp. 9, 11-12 (69 TTABVue 13, 15-16); D. Berghash Dep., p. 17 (71 TTABVue 19); Lovat Dep., p. 47 (64 TTABVue 48).

<sup>12</sup> Geraci Dep., pp. 37-38 (69 TTABVue 41-42); R. Berghash Dep., p. 13 (70 TTABVue 17); Lovat Dep., p. 48 (64 TTABVue 49).

<sup>13</sup> Geraci Dep., p. 38 (69 TTABVue 42); D. Berghash Dep., pp. 15, 19 (71 TTABVue 18, 22); Lovat Dep., p. 47 (64 TTABVue 48). Retailers include Dick's sporting goods, Modell's, Rite Aid, CVS, Walgreens, Target, Wal-Mart. Geraci Dep., pp. 50-51 (690 TTABVue 54-55); D. Berghash Dep., p. 20 (71 TTABVue 23).

dealers, school dealers,<sup>14</sup> and dentists.<sup>15</sup> Thus, the relevant public comprises athletes, trainers, coaches, people who run sports leagues, dentists and retailers.

3. Public perception.

To determine how the relevant purchasers understand the meaning of the word “shield” when used in connection with mouth guards, we have considered dictionary definitions, opposer’s use of the word “Shield,” applicant’s use of the of the word “Shield,” and third-party use of the word “Shield,” including third-party registrations and patents. Applicant’s theory of the case is that the use of the term “shield” in terms such as “gum shield,” “heart shield,” etc. for protective devices, shows that the term “shield” standing alone is generic for “mouth guards. Accordingly, we considered the evidence of the term “shield” alone and in various combinations with specific body parts.

a. Definitions.

“Mouth guard” is defined as follows:

A pliable plastic device, adapted to cover the maxillary teeth, which is worn to reduce potential injury to the oral structures during participation in contact sports.<sup>16</sup>

The Wikipedia entry for “mouthguard” provides the following information:

A mouthguard (also known as a mouth protector, mouth piece or gumshield) is a protective device for the mouth that covers the teeth and gums to prevent and reduce injury to the teeth, arches, lips and gums. Mouthguards are most often used to prevent injury in contact sports, as

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<sup>14</sup> Geraci Dep., p. 53 (69 TTABVue 57); D. Berghash Dep., p. 22 (71 TTABVue 25). School dealers are distributors who sell to schools. *Id.*

<sup>15</sup> Geraci Dep., p. 62 (69 TTABVue 66).

<sup>16</sup> WebMD: Medical Dictionary (dictionary.webmd.com) (58 TTABVue 7).

a treatment for bruxism or TMD, or as part of certain dental procedures, such as tooth bleaching.<sup>17</sup>

The definitions are consistent with the testimony introduced during the trial.<sup>18</sup> In fact, applicant's Patent 8100131 for a "Mouthguard" explains that "[m]outhguards are commonly used in sports such as hockey and rugby in order to protect a player's facial and oral hard and soft tissue from damage caused by external forces."<sup>19</sup>

The primary definition of a shield is "1. A piece of armor made of leather, metal, or wood and carried on the forearm. 2. A means of defense: PROTECTION."<sup>20</sup> However, for purposes of this proceeding, a "shield" is defined, *inter alia*, as "a person or thing that protects."<sup>21</sup> **THE MACMILLAN DICTIONARY** defines "shield," *inter alia*," as follows:

an object that protects a particular part of your body, for example the gum shield that boxers wear to protect their teeth.<sup>22</sup>

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<sup>17</sup> 61 TTABVue 44.

<sup>18</sup> Geraci Dep., p. 8 (69 TTABVue 12) ("The purpose is to protect against athletic injury; mouth, gums, teeth, and to a degree concussion."); R. Berghash Dep., p. 30 (70 TTABVue 34) ("Mouth guard protects the teeth and the gums.") and p. 114 (70 TTABVue 118); D. Berghash Dep., p. 54 (71 TTABVue 57) (mouth guards protect the teeth and gums).

<sup>19</sup> 86 TTABVue 11 and 14.

<sup>20</sup> **WEBSTER'S II NEW COLLEGE DICTIONARY**, (1995) (61 TTABVue 151). *See also* **WEBSTER'S NEW UNIVERSAL UNABRIDGED DICTIONARY**, p. 1764 (1996) (61 TTABVue 14).

<sup>21</sup> **WEBSTER'S NEW UNIVERSAL UNABRIDGED DICTIONARY**, p. 1764 (1996) (61 TTABVue 14). *See also* **WEBSTER'S II NEW COLLEGE DICTIONARY**, (1995) (61 TTABVue 151) ("a means of defense: PROTECTION.").

<sup>22</sup> Macmillandictionary.com at 86 TTABVue 76. Applicant's Exhibit 215 at 86 TTABVue 80 is from the same source. Applicant's Exhibit 214, **THE MACMILLAN DICTIONARY** entry at 86 TTABVue 78 has limited probative value because it is a British version

*See also TheFreeDictionary.com* thesaurus defining gumshield as follows:

gumshield – (especially boxing) equipment that protects an athlete’s mouth<sup>23</sup>

b. Opposer’s use of the terms “shield or “gum shield.”

Opposer uses the word “shield” as its trademark. Opposer does not use the word “shield” descriptively in the sale or advertising of its mouth guards.<sup>24</sup>

Opposer does not use the term “gum shield” in advertising or describing its products. Opposer uses the term “mouth guard” to identify its products. However, Opposer refers to its Redi-fit mouth guard as a mouthpiece.<sup>25</sup>

Opposer also sells “hand shields.” A “hand shield” is a protective device that slips on a hockey stick and moves up and down the shaft as the player moves hand positions. It protects the hands from errant balls, pucks and sticks.<sup>26</sup> However, the description of goods in opposer’s registration is “protective mouth guards for all contact sports, and eyeglass holders,” not hand shields, and controlling authority requires us to determine whether the relevant public understands SHIELD to refer to mouth guards, not “hand shields.”

c. Applicant’s use of the terms “shield” or “gumshield.”

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(macmillandictionary.com/dictionary/british/shield). The MacMillan Dictionary is the only dictionary that references a gum shield in its definition of the word shield.

<sup>23</sup> Applicant’s Exhibit 222 (86 TTABVue 474).

<sup>24</sup> Geraci Dep., Opposer’s Exhibits 2-35 (72 TTABVue 6-129); R. Berghash Dep., Opposer’s Exhibits 39-92 (72 TTABVue 136-213 and 73 TTABVue 3-61). *See also* Applicant’s Exhibit 228 (86 TTABVue 497-512).

<sup>25</sup> 72 TTABVue 164.

<sup>26</sup> 72 TTABVue 51, 107, 126.

Applicant, on its website, uses the word “shield” as part of its trademark, OPROSHIELD, but it identifies its products as “mouthguards.”<sup>27</sup> The package displayed on applicant’s website uses the term “mouthguard.” We also note that during the testimony of Dr. Lovat, applicant’s Managing Director, Dr. Lovat never referred to mouth guards as shields without a modifier (*e.g.*, gum shield or mouth shield). For example, Dr. Lovat testified that when he is in the United States he refers to his products as “gum shields, mouthguards [sic], primarily OPROShields.”<sup>28</sup>

Dr. Lovat testified that the common name for the “boil and bite mouthguards [sic] that we designed a few years in the U.K.” are “[m]outhguards [sic], gum shields, mouth protectors,” “mouthpieces” and “gum guards.”<sup>29</sup>

Dr. Lovat provided contradictory testimony regarding whether he considered the word “shield” generic for mouth guards.

Q. And you’ve seen their labeling of products with the word shield, haven’t you?

A. I have.

Q. When you saw that, did you think that they could stop you from using the word shield as part of a trademark?

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A. It would never have occurred to me, no.

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<sup>27</sup> 57 TTABVue 26.

<sup>28</sup> Lovat Dep., p. 53 (64 TTABVue 54).

<sup>29</sup> Lovat Dep., p. 8 (64 TTABVue 9).

Q Did you view the term as generic or not generic when you saw it on their labeling, the term shield?

\* \* \*

A. Well, shield is generic.<sup>30</sup>

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A. If you're asking the question does the generic word shield mean gum shield, the answer is no.

In applicant's Patent No. 8100131, applicant referred to the invention as a mouth guard. Applicant did not use the terms "shield" or "gumshield."<sup>31</sup> Likewise, in Dr. Lovat's book **HOW MOUTHGUARDS WORK**, Dr. Lovat never used the terms "shield" or "gumshields" to refer to mouth guards.<sup>32</sup>

d. Third-party use of the term "shield" in connection with mouth guards.

1. Third-party websites.

A. GungFu Martial Arts website (gungfu.com).<sup>33</sup>

GungFu Martial Arts is a retail store in the field of martial arts and boxing supplies located in Fullerton, California. Through the menu of "training gear," "protective gear," and "mouth guards," the GungFu.com website advertises the sale of a "Double Gum Shield." The "[s]et includes mouth guard, instructions and yellow case."<sup>34</sup>

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<sup>30</sup> Lovat Dep., pp. (11-12 (64 TTABVue 12-13).

<sup>31</sup> Applicant's Exhibit 202 (86 TTABVue 11).

<sup>32</sup> Applicant's Exhibit 206 (86 TTABVue 30).

<sup>33</sup> 61 TTABVue 33-42.

<sup>34</sup> 61 TTABVue 35.

Through the menu of “training gear” and “punching targets,” the GungFu.com website posts a “Shields” page advertising the sale of “Top Shields,” including “rib savers,” “arm shields,” and “body shields.”<sup>35</sup>

B. MyKarateStore.com.<sup>36</sup>

My Karate Store is a discount martial arts supplies and equipment retailer. The excerpt from the website made of record advertises the sale of a “Double Gum Shield.” The advertising copy is the same as the “Double Gum Shield” sold by Gungfu Martial Arts.

C. Smile Fairy Dental Spa (thesmilefairy.com).<sup>37</sup>

The website for this dental practice advertises the sale of “Playsafe Mouthguards.” As part of the advertisement, the Smile Fairy Dental Spa provides a history of mouth guards explaining that “[b]oxing is thought to have been the first sport to use Gumshields or Tooth Guards as they were called then. The original Gumshield or Toothguard was no more than a preformed rubber rim that fitted over the top teeth.” The excerpt further describes the type of “Mouthguards (Gumshields or Toothguards) available [today].”

D. Google search engine list of results for “Mouth Shield.”<sup>38</sup>

Applicant introduced a list of the results from the Google search engine for the term “Mouth Shield” through a notice of reliance and the results for “gum shield

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<sup>35</sup> 61 TTABVue 41.

<sup>36</sup> 61 TTABVue 117.

<sup>37</sup> 61 TTABVue 121.

<sup>38</sup> 61 TTABVue 125.



through Dr. Lovat's testimony deposition."<sup>39</sup> A list of Google search results has little probative value, because it does not show the context in which the term is used on the listed web pages. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011). *See also In re BayerAG*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (deeming Google search results that provided very little context concerning the use of ASPIRINA to be "of little value in assessing the consumer public perception of the ASPIRINA mark"); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google search results entitled to little probative weight without additional evidence of how the searched term is used); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (noting that "[e]vidence of actual use of a phrase by a website has far greater probative value" than a search summary).

E. Amateur International Boxing Association  
(aiba.org)<sup>40</sup>

Applicant introduced the "Headguards, gumshields & cup protectors" webpage from the Amateur International Boxing Association website. The website provides the following information regarding gumshields:

Gumshields

Gumshields are the equipment that protects boxers from knockouts, concussions and other internal head injuries contributed by a blow to the jaw.

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<sup>39</sup> Applicant also introduced numerous Google search engine results for the term "shield" used in connection with specific body parts. See applicant's Exhibits 281, 285, 287, 289, 291, 293, 295, 297, 299, 301, 303, 305 (86 TTABVue 337, 350, 357, 364, 369, 374, 379, 385, 392, 397, 404, 419).

<sup>40</sup> Applicant's Exhibit 307 (86 TTABVue 424).

F. Uxcell.com<sup>41</sup>

The excerpt from this website advertises the sale of a “Sports Boxing Double Sided Soft Plastic Mouth Guard Gum Shield” for use in “boxing, kick boxing, taekwondo [sic], free combat training.”

G. Photo Researchers (db2.photoresearchers.com)<sup>42</sup>

This webpage advertises the sale of photographs for “Bleach-filled gum shield to whiten women’s teeth.”

H. MRX website (mrxproducts.com)<sup>43</sup>

This website advertises the sale of a “Gum Shield” mouth guard.

I. WiseGeek.com<sup>44</sup>

This website purportedly provides answers to questions. In this case, the question is “What Is a Gum Shield?”

Gum shields, or mouth guards, are simple devices that are placed in the mouth in order to protect the teeth, gums, and tongue. They are often used in sports, especially those sports in which players come into contact with one another.

J. Cramer Products, Inc.<sup>45</sup>

In 2004, opposer learned that Cramer Products, Inc. was using the mark PRO SHIELD to identify its mouth guards. In response to a cease and desist letter

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<sup>41</sup> Applicant’s Exhibit 309 (86 TTABVue 430).

<sup>42</sup> Applicant’s Exhibit 310 (86 TTABVue 433).

<sup>43</sup> Applicant’s Exhibit 311 (86 TTABVue 435).

<sup>44</sup> Applicant’s Exhibit 223 (86 TTABVue 477).

<sup>45</sup> Robert Berghash Dep., pp. 102- 104 (71 TTABVue 106-108); Opposer’s Exhibit 93 (72 TTABVue 62).

from opposer, Cramer Products, Inc. agreed to change the name of their product.

Cramer Products, Inc. wrote the following:

We unknowingly infringed on your client's mark, and have discontinued using the Pro Shield mark in conjunction with our mouthguard. The products [sic] name will be changed along with all collateral materials.

2. Patents.

Through a notice of reliance, applicant introduced two patents for mouth guards that reference the term "mouth shield."<sup>46</sup>

a. Patent 6802079 is for a "Protective Mouth Shield."<sup>47</sup> The invention is "a mouth protector assembly comprising a grid-like mouth protector.

b. Design Patent D485944 for a "Mouth Shield." The claim is for "the ornamental design for the mouth shield, as shown and described."<sup>48</sup>

Through Dr. Lovat's testimony, applicant introduced several more patents that reference mouth guards as "mouth shields" (e.g., Patent 2800898 (1957)<sup>49</sup>). *See*

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<sup>46</sup> Applicant also introduced patents that use the term "shield" in connection with mouth protectors, but not mouth guards used in sports. For example, Patent 5938435 for an "orthodontic appliance shield system" to protect the patient from an installed orthodontic appliance (61 TTABVue 61); Patent 4104530 for a "dental and medical X-ray apparatus" for equipment to enable rapid X-ray examination of teeth to reduce radiation exposure (61 TTABVue 78); and Patent 7025060 for "a personal breathing filter" that is a personal breathing filter retained in the mouth by the user's lips or teeth. (61 TTABVue 89). The device described in the last invention has a "shield" that covers the interior of the lips so that the user does not have to maintain a tight seal around the mouthpiece.

<sup>47</sup> 61 TTABVue 47. This patent is a continuation of Patent 6553569 introduced in the Lovat deposition (86 TTABVue 96).

<sup>48</sup> 61 TTABVue 73.

<sup>49</sup> 86 TTABVue 82.

also Patent 5954500 (1999) for a “guard for teeth with braces” comprising an “upper shield” and “lower shield” that is used as a guard for teeth having braces.<sup>50</sup>

3. Third-party trademark registrations.

a. Registration No. 3697340 for the mark LONSDALE, in standard character form, for a wide variety of products including “mouth protectors, namely, gum shields for athletic use.”<sup>51</sup> This registration was registered under the provisions of Section 44(d) of the Trademark Act and, therefore, there is no evidence that the mark has been used in the United States.

b. Registration No. 2680226 for the design of a cross for, *inter alia*, “first aid supplies and health care products, namely, ... mouth shields,” in Class 10.<sup>52</sup> This registration is based on use in commerce.

c. Registration No. 3754064 for the mark EVOSHIELD, in standard character form, for “athletic protective equipment, namely, chest shields, back shields, rib shields, wrist shields, thigh shields, elbow shields, leg shields, foot shields, shoulder recoil shields, and multi-format shields,” in Class 28.<sup>53</sup> This registration is based on use in commerce.

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<sup>50</sup> As it did with the patents introduced through a notice of reliance, applicant, through Dr. Lovat, introduced copies of patents used in dentistry (*e.g.*, Patent 5954500 for a “guard for teeth with braces” comprising an “upper shield” and “lower shield” (86 TTABVue 91)

<sup>51</sup> 61 TTABVue 106.

<sup>52</sup> 61 TTABVue 103.

<sup>53</sup> Applicant’s Exhibit 312 (86 TTABVue 436).

d. A list of results from a search in the USPTO database for “gum shields” or “gumshields” in the goods and services field.<sup>54</sup> The list has limited probative value because we cannot tell whether the registrations are based on use in commerce or Sections 44 or 66 of the Trademark Act and whether there may or may not have been use in commerce, and, if these marks were used, whether the mark owners identified the products as a gum shield on their packaging or in their advertising.<sup>55</sup>

Opposer, however, introduced 22 of the registrations listed in applicant’s list of results to show that these registrants were European entities, that the use of the term “gumshield” in the description of goods is not an American term, and that there is no evidence of use in commerce.<sup>56</sup>

4. Dentists’ use of the term “shield” in connection with mouth guards.

Applicant’s Exhibit 209, “Policy on Prevention of sports related Orofacial Injuries,” American Academy of Pediatric Dentistry (1991) to educate dental

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<sup>54</sup> 61 TTABVue 114.

<sup>55</sup> Applicant, through Dr. Lovat’s testimony deposition, also introduced similar search results for “gum shield,” “heart shield,” “knee shield,” “wrist shield,” “elbow shield,” “rib shield,” “chest shield,” “arm shield” “face shield,” “finger shield,” “eye shield,” “thigh shield,” “gum guard,” “head guard,” “knee guard,” “wrist guard,” “elbow guard,” “rib guard,” “chest guard,” “arm guard,” “face guard,” “eye guard,” “finger guard,” and “thigh guard,” all in Class 28. (Applicant’s Exhibits 257 -281)(86 TTABVue 262-335). As indicated in the main body of this decision, these search results have limited probative value because there is no way of knowing whether the mark owners use these marks in commerce and, if they do, whether they identify the products as some sort of shield on their packaging and in their advertising.

<sup>56</sup> 68 TTABVue 26-138.

professionals, health care providers, and educational and athletic personnel on sports related orofacial injuries referenced “gumshield” in passing.<sup>57</sup>

Initially used by professional boxers, the mouthguard has been used as a protective device since the early 1900’s. The mouthguard, also referred to as a gumshield or mouth protector, is defined as a “resilient device or appliance placed inside the mouth to reduce oral injuries, particularly to teeth and surrounding structures.”<sup>58</sup>

There was no other use of the terms “shields” or “gumshields.”

5. Use of the term “shield” for other protective devices.

a. XO Heartshield (xoathletic.com)<sup>59</sup>

This website excerpt advertises the sale of a heartshield comprising a hard protective shield for chest impact.

b. Dick’s Sporting Goods (discksportinggoods.com)<sup>60</sup>

This excerpt from the Dick’s Sporting Goods website advertises the sale of the following items:

1. Defender Sports Shield Youth Face Guard;
2. OAKLEY Clear Football Shield (a helmet face guard);
3. Combat Sports Curved Body Shield;
4. All-Star Teen d30 Heart Shield Compression Shirt;
5. BAUER RBE I Half Shield;
6. BAUER Junior Concept II Full Shield;

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<sup>57</sup> Applicant’s Exhibit 209 (86 TTABVue 54).

<sup>58</sup> Applicant’s Exhibit 209 (86 TTABVue 55).

<sup>59</sup> Applicant’s Exhibit 254 (86 TTABVue 253).

<sup>60</sup> Applicant’s Exhibit 255 (86 TTABVue 256).

7. UNDER ARMOUR Youth Clear Face Shield;
8. NIKE Pink Football Chin Shield;
9. UFC Muay Thai Shield; and
10. SCHUTT XV Flex Skill Shield Football Shoulder (football shoulder pads).

The items in Nos. 1, 3-7, and 9 appear to be protective devices used in martial arts.

- c. JT Head Shield Single Paintball Goggles (ansgear.com)<sup>61</sup>

This excerpt from a website advertises the JT head shield used as a protective mask in paintball competitions.

- d. Body Glove 901108 Kinetic Knee Shield (amazon.com)<sup>62</sup>

This excerpt from the Amazon.com website displays a knee shield that is currently unavailable for sale (“We don’t know when or if this items will be back in stock.”). However, there is a link to “Shield Knee Pads” by ANSgear Paintball.

- e. EvoShield Protective Wrist Guard (evoshield.com)<sup>63</sup>

The website advertises the EvoShield protective wrist guard. The advertising reads as follows:

**STAND STRONGER:** Our Wrist Guard offers a comfortable compression fit with a custom-molding protective Shield insert to provide the compression of tape, the comfort of cotton, and the protection of a Shield. Simply remove the Shield insert from the foil bag to air

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<sup>61</sup> Applicant’s Exhibit 286 (86 TTABVue 354).

<sup>62</sup> Applicant’s Exhibit 288 (86 TTABVue 360).

<sup>63</sup> Applicant’s Exhibit 290 (86 TTABVue 367).

activate the custom-molding processes. The Gel-to-Shell Technology transforms the soft insert into a protective Shield in minutes.

f. Techna – Flex Elbow Shield (no url)<sup>64</sup>

This excerpt from a website advertises an elbow pad. This excerpt is of limited value because it is from an unidentified source (no url was included) and Dr. Lovat did not authenticate the source of the document.<sup>65</sup> It is not clear that this product is sold in the United States.

g. Millennium Gear (themillenniumgear.com)<sup>66</sup>

The excerpt from this website advertises the sale of shin, forearm and rib shields. “The thin Diamond Shields 3 can be inserted into sleeves to help prevent injuries, bruises, and turf burns.”

h. Shampa Chest Shield (motorcycle-superstore.com)<sup>67</sup>

The Shampa Chest Shield is a product that is no longer available. It is not entirely clear from the website, but the product appears to be a protective device worn under a jacket used by motorcycle riders.

i. Kungfu4less.com<sup>68</sup>

This excerpt advertises the sale of arm shields used as protective devices in connection with martial arts sparring.

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<sup>64</sup> Applicant’s Exhibit 292 (86 TTABVue 373).

<sup>65</sup> Dr. Lovat Testimony Dep., p. 72 (64 TTABVue 73 (“292, an example of an elbow shield for sale.”).

<sup>66</sup> Applicant’s Exhibit 294 (86 TTABVue 377).

<sup>67</sup> Applicant’s Exhibit 296 (86 TTABVue 382).

<sup>68</sup> Applicant’s Exhibit 298 (86 TTABVue 388).



j. Uline.com<sup>69</sup>

This excerpt advertises the sale of “Headgear/Face Shields” that “protects the face and eyes from flying splinters, chips and splashes.”

k. Amazon.com – catcher’s mitt<sup>70</sup>

This is an excerpt from the Amazon.com website advertising a “Wilson A2403 PSCMT 34” 2-Piece Web Finger Shield Black Catcher’s Mitt.” This item is unavailable for sale (“We don’t know when or if this item will be back in stock.”). The reference to “shield” in the product name is to the webbing: a “two-piece web with finger shield.”

l. Eye shields (sportsdepot.com)<sup>71</sup>

The excerpt from this website advertises the sale of eyeshields used on football helmets.

m. GMC Biomedical Services (no URL)<sup>72</sup>

The excerpt from this website advertises the sale of a pediatric thigh shield. There is no other information provided on the webpage to explain the purpose of the product.

n. Sport Shield website (Sportshield.com).<sup>73</sup>

Opposer and Applicant both introduced the homepage for Sport Shield brand protective strips (*i.e.*, adhesive bandages).

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<sup>69</sup> Applicant’s Exhibit 300 (86 TTABVue 395).

<sup>70</sup> Applicant’s Exhibit 302 (86 TTABVue 400)

<sup>71</sup> Applicant’s Exhibit 304 (86 TTABVue 407).

<sup>72</sup> Applicant’s Exhibit 306 (86 TTABVue 422).

<sup>73</sup> 67 TTABVue 22; Applicant’s Exhibit 308 (86 TTABVue 427).

6. Discussion – Applicant’s Counterclaim v. Opposer’s Mark.

We must determine whether applicant satisfied its burden of showing that SHIELD is generic as applied to mouth guards. As indicated above, “the correct legal test for genericness ... requires evidence of ‘the genus of the goods or services at issue’ and the understanding by the general public that the mark refers primarily to ‘that genus of goods or services.’” *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999), quoting *H. Marvin Ginn Corp. v. Int’l Assn. of Fire Chiefs, Inc.*, 228 USPQ at 530.

“It seems elementary that one must find out how people in the trade and purchasers use the terms with respect to the involved goods in order to determine whether or not they are descriptive.” *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 160 USPQ 233, 237 (CCPA 1969). There is no evidence that anyone uses the term “shield” by itself to refer to mouth guards. See *In re Ferrero S.p.A.*, 24 USPQ2d 1155, 1157 (TTAB 1992) where the Board observed the following:

Common sense leads us to conclude that if a term is generic for a type of a product that has been on the market for decades, evidence of its use by others in the marketplace should be available and should be considered. While, consistent with the *Rubinstein* case [410 F.2d 438, 161 USPQ 606 (CCPA 1969)], the absence of evidence of such use by others is not determinative of the registrability of a term on the Supplemental Register, it remains a factor to be considered.

As explained above, applicant must show that the word “shield” is generic for mouth guards by a preponderance of the evidence. According to the record, when “shield” is used in connection with protective devices, including mouth guards, the word “shield” is the suffix of a unitary term preceded by a specific body part (e.g.,

gum shield, arm shield, etc.). As applicant produced no evidence that the relevant public understands the term “shield” *per se* as it relates to mouth guards is a generic term, it failed to carry its burden. *See In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 160 USPQ 233, 235 (CCPA 1969) (AUTOMATIC RADIO for “portable radios, automobile radios, truck radios, boat radios” is not generic: the Board’s holding that the word “Automatic” followed by the name of a product is part of the descriptive name for the product is unduly broad and contradicted by the evidence); *In re Ideal Industries, Inc.*, 508 F.2d 1336, 184 USPQ 487, 488 (CCPA 1975) (even though “wing nut” is a generic term for a nut with wings that provide a grip for the thumb and finger, WING-NUT for “connecting members for joining the ends of electrical wires or connectors” is not generic because WING-NUT is not being used identify goods commonly known as wing nuts); *In re Minnetonka, Inc.*, 3 USPQ2d at 1713 (“While there is some evidence that the industrial potash soap known as soft soap has some usefulness in the manufacture of some liquid soaps, the record does not demonstrate the frequency of the use of soft soap in the manufacture of liquid hand soaps sold in the United States, or how significant an ingredient soft soap is in liquid hand soap.”). *See also In re Steelbuilding.com*, 75 USPQ2d at 1422-23 (“the record does not show substantial evidence that ‘STEELBUILDING,’ in common usage, is a compound word used to mean either ‘steel building’ or ‘steel buildings.’”); *Magic Wand Inc. v. RBD Inc.*, 19 USPQ2d at 1554 (in finding TOUCHLESS for automobile washing services is not generic, the court held that “[t]he TTAB did not clearly err in concluding that this evidence, considered along with the evidence of

industry use, is not enough to show generic use or understanding by the relevant public.”); *In re Merrill Lynch, Pierce, Fenner, and Smith*, 4 USPQ2d at 1143 (“The mixture of uses unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term.”); *In re Tennis Indus. Ass’n*, 102 USPQ2d 1671 (TTAB 2012) (TENNIS INDUSTRY ASSOCIATION not generic for “association services, namely, promoting the interests of tennis facilities, tennis manufacturers, tennis retailers and tennis court contractors; providing market research services to track the economic vitality of the tennis industry”); *In re Council of Certification of Nurse Anesthetists*, 85 USPQ2d 1403, 1415 (TTAB 2007) (“given the fact that in two of the definitions relied upon by the examining attorney, CRNA may well be understood as a mark; the fact that the evidence relied upon by the examining attorney does not demonstrate interchangeable use of CRNA and “certified registered nurse anesthetist”; and the fact that there is no third-party use of CRNA, but rather, the evidence points to the uniqueness of applicant and its certification program in the field, we find that the examining attorney has not established by clear evidence that CRNA has come to be understood as substantially synonymous with “certified registered nurse anesthetist.”); *Zimmerman v. Nat’l Ass’n of Realtors*, 70 USPQ2d 1425, 1430-1435 (TTAB 2004) (collective service marks REALTOR and REALTORS not generic for real estate brokerage, management, appraisal, and planning services in part

because the record shows no evidence of generic use of marks by competitors or by defendant itself and no generic use in the media). *Compare In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (the fact that applicant chose to not include the term “sprinkler” in the mark ATTIC did not avoid a finding of genericness, where the goods were automatic sprinklers for fire protection of attics); *In re U.S. Cargo, Inc.* 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO for “towable trailers for carrying cargo and vehicles for commercial purposes” is primarily geographically descriptive and “the fact that applicant elected not to include the term ‘trailer’ in the mark sought to be registered cannot avoid the refusal.”).

This case is related to *In re Central Sprinkler Co.* (ATTIC for “automatic sprinklers for fire protection” held to be generic term for fire sprinklers for protection of attics), where the Board held that in determining whether a term is generic in reference to the goods or services involved, consideration must be given to the fact that a product or service may fall not only into a broad category, but also into a narrower category within this broad category.

ATTIC            broad category of goods - automatic sprinklers for fire protection

                    narrow category of goods - sprinklers for fire protection of attics

“Upon encountering the term ATTIC for sprinklers, the relevant public surely would understand the term primarily to refer to a sprinkler for the attic, that is, an ‘attic sprinkler.’” 49 USPQ2d at 1197.

In this case, the issue is whether the mark refers to the narrow category of goods (mouth guards) rather than the broad category of goods (protective devices).

SHIELD    broad category of goods - protective devices  
             narrow category of goods - mouth guards

Based on the record before us, specifically, the market strength of opposer's mark discussed below, we cannot conclude that there is clear evidence that the relevant public perceives the term SHIELD to refer to the category of mouth guards even though a mouth guard may be a type of shield.<sup>74</sup> To the extent applicant has shown use of SHIELD for protective devices generally, the evidence does not reveal widespread as opposed to niche use, and much of it appears to come from obscure sources. Applicant has not provided any evidence regarding the extent to which the relevant public has been exposed to the uses of SHIELD revealed by applicant's evidence, such as the number of website "hits," circulation figures for publications, etc.

We will not rely on evidence of unitary terms such as gum shield, arm shield, or knee shield and extrapolate that athletes and other relevant purchasers perceive the term "shield" *per se* to be generic for mouth guards. If the term "shield" is a generic term for a mouth guard, it is hard to explain how applicant could not find one example of generic usage of this term for mouth guards. In this regard, not even applicant uses the word "shield" generically to refer to its products. The fact that there is not even one example of "shield" used generically by itself for mouth guards in dictionaries, by opposer, by applicant or by third parties, is probative that

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<sup>74</sup> We also note that in *Central Sprinkler*, the Board specifically looked to how the relevant public will encounter the mark and found that as used on the specimen, "such use of ATTIC ... is more in the nature of a type of sprinkler than of a source identifier."49 USPQ2d at 1197. In this case, however, opposer consistently uses SHIELD as a trademark. *See* n.24.

“shield” is not generic for those products. *See In re American Fertility Society*, 51 USPQ2d at 1836. The dictionary definitions of shield which refers to it as something that protects the body is insufficient by themselves, or with applicant’s other evidence, to meet applicant’s burden, absent evidence of the extent of the relevant public’s exposure to this evidence.

Applicant argues that “companies in the sports equipment business use the term ‘shield’ in connection with devices for protecting the mouth,” as evidenced by their use of the terms gum shields, mouth shields, hand shields, tooth shields, etc.<sup>75</sup> For example, applicant contends that Mr. Geraci, opposer’s President, testified that a hand shield is a hand protector and, therefore, that testimony supports the conclusion that the term “shield” is generic for sports protective devices.<sup>76</sup> As discussed above, however, there is no evidence of any use of the term “shield” *per se* to identify a mouth guard and the evidence of the extent of the use of the terms “gum shield” and/or “mouth shield” does not amount to a preponderance of the evidence.

With respect to its failure to introduce any evidence showing the use of the word “shield” *per se* to identify mouth guards, applicant points to **THE MACMILLAN DICTIONARY** that defines “shield” as “an object that protects a particular part of your body, for example the gum shield that boxers wear to protect their teeth.”<sup>77</sup> The dictionary does not state that boxers use a shield to protect their teeth; they use

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<sup>75</sup> Applicant’s Brief, p. 32 (79 TTABVue 41).

<sup>76</sup> Applicant’s Counterclaim Reply Brief, p. 3 (79 TTABVue 12) referencing Geraci Dep., pp. 149 – 153 (69 TTABVue 153-156).

<sup>77</sup> Applicant’s Counterclaim Reply Brief, p. 3 (79 TTABVue 12).

a gum shield. In this regard, as previously pointed out, applicant failed to introduce any news articles or works of fiction reporting a boxer who had his shield, let alone a gum shield, knocked out of his mouth during an especially violent bout.

In view of the foregoing, we find that applicant did not prove by a preponderance of the evidence that the relevant public understands that the word “shield” primarily refers to mouth guards (*i.e.*, that it is a generic term for mouth guards). In view thereof, applicant’s counterclaim to cancel opposer’s pleaded registration is denied.

### III. Likelihood of Confusion

Opposer did not introduce its pleaded registration into evidence. However, because opposer’s registration file as the subject of the counterclaim automatically forms part of the record of the proceeding by operation of Trademark Rule 2.122(b)(1), it was unnecessary for opposer to take any further action to make its pleaded registration of record.

#### A. Standing and priority.

Because opposer’s registration file and, therefore, its pleaded registration, is part of the record by operation of the Trademark Rules, opposer has established its standing. *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).

Because opposer’s registration file and, therefore, its pleaded registration, is properly made of record, Section 2(d) priority is not an issue in this case as to the



mark and the goods covered by the pleaded registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. *du Pont Analysis.*

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision, involving comparison of opposer’s mark SHIELD for mouth guards and applicant’s mark for OPROSHIELD for “gum shields for protecting the mouth from injury.”

1. *Fame of opposer’s mark.*

This *du Pont* factor requires us to consider the fame of opposer’s mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC*

*Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Finally, 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. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer introduced the evidence below to demonstrate the fame of its mark:

1. Over the last 20 years, opposer has “probably sold eighteen million bagged [in bulk] mouth guards,” throughout the United States and internationally;<sup>78</sup>

2. Over the last 20 years, opposer has sold over 50 million mouth guards in individual units in a blister pack through retail distribution;<sup>79</sup>

3. Since 1961, opposer has sold approximately 150,000,000 mouth guards;<sup>80</sup>

4. “I think soon after we came out with mouth guards we certainly had in dollars, forty or fifty percent of that [the domestic] market”;<sup>81</sup>

5. Through 2010, Robert Berghash estimated that opposer had forty percent of the domestic market in terms of dollars and “sixty percent of the unit market or more”;<sup>82</sup>

6. Robert Berghash estimated that in 2010, opposer sold close to 3,000,000 mouth guards.<sup>83</sup> Similarly, David Berghash estimated that in 2011, opposer sold over 3,000,000 mouth guards domestically;<sup>84</sup>

7. David Berghash estimated that since the late 1980’s, opposer has been selling somewhere between two million and three million units per year;<sup>85</sup>

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<sup>78</sup> Geraci Dep., pp. 62-63 (69 TTABVue 66-67).

<sup>79</sup> Geraci Dep., pp. 63-64 (69 TTABVue 67-68).

<sup>80</sup> R. Berghash Dep., pp. 14-15 (70 TTABVue 18-19).

<sup>81</sup> R. Berghash Dep., p. 18 (70 TTABVue 22).

<sup>82</sup> R. Berghash Dep., p. 18 (70 TTABVue 22).

<sup>83</sup> R. Berghash Dep., p. 19 (70 TTABVue 23) (Mr. Berghash did not specify whether that number included international sales).

<sup>84</sup> D. Berghash Dep., pp. 17-18 (71 TTABVue 20-21).

8. Opposer introduced several news articles from Buffalo and Western New York newspapers reporting on opposer and its business. The articles were profiles about a local Buffalo business;<sup>86</sup>

9. Opposer signed a contract with the National Football League to place the NFL logo on opposer's packaging;<sup>87</sup>

10. Opposer's products are sold through many well-known retailers such as Wal-Mart, Walgreen's, Rite-Aid, CVS, Target, Dick's sporting goods, and Modell's sporting goods;<sup>88</sup> and

11. Mr. Geraci testified that because he has traveled all over the United States selling SHIELD mouth guards, people identify him with the company. Some people refer to him as "Mr. Mouth Guard."<sup>89</sup>

We readily acknowledge that opposer has enjoyed success with its SHIELD mouth guards. Given this market success, and the long use of the SHIELD mark, we find opposer's mark to be entitled to protection against applicant's mark.<sup>90</sup> We also find, however, that the evidence falls short of establishing fame as

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<sup>85</sup> D. Berghash Dep., p. 18 (71 TTABVue 21).

<sup>86</sup> R. Berghash Dep., pp. 19-25 (70 TTABVue 23-29); Opposer's Exhibits 36- 38(72 TTABVue 130- 135).

<sup>87</sup> R. Berghash Dep., pp. 31-32 (70 TTABVue 35-36).

<sup>88</sup> D. Berghash Dep., p. 20 (71 TTABVue 23), Geraci Dep., pp. 50-51 (690 TTABVue 54-55).

<sup>89</sup> Geraci Dep., p. 135 (69 TTABVue 139). David Berghash testified that he is known as the "shield guy." However, because that testimony was elicited by a leading question ("Q: Does anyone ever refer to you as the Shield guy or something like that? A: It's more than you would think"), we do not find it to be very probative. D. Berghash Dep., p. 27 (71 TTABVue 30).

<sup>90</sup> While we acknowledge that opposer's mark is conceptually weak, its registration is over five years old and no longer subject to challenge as merely descriptive.

contemplated by the case law cited above. For example, the newspaper articles that were introduced into evidence profile opposer as an important business in the Buffalo metropolitan area but they do not reference the SHIELD mark in any significant way. In sum, the fame factor is neutral, however, opposer has demonstrated significant marketplace strength.

2. The similarity or dissimilarity and nature of the goods.

The goods are identical. Applicant identified its products as “boil and bite mouthguards” that are known as mouth guards.<sup>91</sup>

3. The established, likely-to-continue channels of trade and classes of consumers.

Because the goods described in the application and opposer’s registration are identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Moreover, the evidence clearly establishes that the channels of trade and classes of consumers are the same. As indicated above, mouth guards are used by

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<sup>91</sup> Lovat Dep., p. 8 (64 TTABVue 9).

athletes.<sup>92</sup> Mouth guards are sold or distributed to athletes through trainers and coaches,<sup>93</sup> retailers,<sup>94</sup> people who run leagues, team dealers, school dealers,<sup>95</sup> and dentists.<sup>96</sup>

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

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v.*

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<sup>92</sup> Geraci Dep., pp. 9, 11-12 (69 TTABVue 13, 15-16); D. Berghash Dep., p. 17 (71 TTABVue 19); Lovat Dep., p. 47 (64 TTABVue 48) (“They are either going to be bought by those who play the sport or parents of those that play the sport.”).

<sup>93</sup> Geraci Dep., pp. 37-38 (69 TTABVue 41-42); R. Berghash Dep., p. 13 (70 TTABVue 17); Lovat Dep., p. 48 (64 TTABVue 49) (“These are typically sold into the athletic trainer or school market where the schools or trainers which to keep a reserve bag of gum shields for athletes that turn up and have not got their gum shields with them. ... It’s a bulk sale into a school, typically, environment.”).

<sup>94</sup> Geraci Dep., p. 38 (69 TTABVue 42); D. Berghash Dep., pp. 15, 19 (71 TTABVue 18, 220); Lovat Dep., pp. 47, 48-49 (64 TTABVue 48, 49-50) (“Typically I would say a retail end be it a high street retailer, as we call it, or in a shop at some sort of sports club.”).

<sup>95</sup> Geraci Dep., p. 53 (69 TTABVue 57); D. Berghash Dep., p. 22 (71 TTABVue 25). School dealers are distributors who sell to schools. *Id.* See also Lovat Dep., p. 48 (64 TTABVue 49) (the academic pack).

<sup>96</sup> Geraci Dep., p. 62 (69 TTABVue 66).

*Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). See also *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are mouth guards, the average consumer is an athlete, the athlete's parent or coach.

We also note that where, as here, the goods are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Opposer's mark is SHIELD. Applicant is seeking to register the mark OPROSHIELD. OPRO is the house mark that applicant applies to all of its products (e.g., OPROcustom, OPROwhite, OPRONight, etc.).<sup>97</sup> The marks are similar because they share the word "shield." While there is no explicit rule that

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<sup>97</sup> Lovat Dep., p. 9 (64 TTABVue 10).

likelihood of confusion automatically applies where a junior user's mark contains the whole of another mark, the fact that opposer's mark is subsumed by applicant's mark increases the similarity between the two. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN confusingly similar to TITAN for medical diagnostic apparatus); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO COMBOS confusingly similar to MACHO for restaurant entrees); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." 229 USPQ at 709. In this case, we find that that SHIELD is likely to be perceived as a shortened version of OPROSHIELD when used on the same products.

Applicant argues, in essence, that because the term "shield" is descriptive when used in connection with mouth guards, opposer's SHIELD mark is entitled to only a narrow scope of protection and that applicant's addition of the OPRO house mark is sufficient to distinguish the marks.<sup>98</sup> We disagree. As discussed above, the evidence of record shows that opposer's SHIELD mark has developed significant marketplace strength, or acquired distinctiveness, and is entitled to a broad scope of protection. Thus, consumers encountering applicant's OPROSHIELD mark may

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<sup>98</sup> Applicant's Brief, p. 14 (79 TTABVue 23).



mistakenly believe that it is the OPRO line of the SHIELD mouth guards with which they are familiar.

The marks have similar meanings and similar commercial impressions because the shared term “shield” suggests the meaning of a protective object or barrier and a mouth guard protects one’s teeth and gums.

In view of the foregoing, we find that the marks are similar in terms of appearance, sound, connotation and commercial impression.

5. Balancing the factors.

In view of the similarity of the marks and the identity of the products, channels of trade and classes of consumers, we find that applicant’s mark OPROSHIELD for “gum shields for protecting the mouth from injury” is likely to cause confusion with opposer’s mark SHIELD for mouth guards.

Because we have found that there is a likelihood of confusion, we will not decide the dilution claim. However, we note that opposer’s dilution claim would fail because if opposer’s mark is not famous for purposes of likelihood of confusion, it would not be famous for purposes of dilution. Fame for likelihood of confusion purposes and for dilution are not the same, and fame for dilution purposes requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001).

**Decision:** The counterclaim to cancel opposer’s pleaded registration is denied.

Opposition No. 91190276

The opposition is sustained and registration to applicant is refused.