

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: January 21, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Retail Royalty Company

v.

Michael R. Longshore

—
Opposition No. 91192917

—
Laura C. Miller and Lisa Pearson for Kilpatrick Townsend & Stockton LLP for
Retail Royalty Company.

Michael R. Longshore *pro se*.

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Before Bucher, Bergsman and Hightower, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Michael R. Longshore (“applicant”) filed an intent-to-use application to register
the mark shown below



for the goods set forth below:

A-shirts; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Dress shirts; Hooded sweat shirts; Knit shirts; Long-sleeved shirts; Night shirts; Open-necked shirts; Polo shirts; Shirts; Shirts for suits; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleep shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Turtle neck shirts; Wearable garments and clothing, namely, shirts, in Class 25.

Retail Royalty Company (“opposer”) opposed the registration of applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant’s mark so resembles the registered marks shown below for a variety of goods and services, including clothing, as to be likely to cause confusion, and on the ground that applicant did not have a *bona fide* intent to use his mark when he filed his application.



2 and



¹ Registration No. 3539007, registered November 25, 2008; and Registration No. 3662110, registered July 28, 2009.

² Registration No. 3596446 registered March 24, 2009; and Registration No. 3600044, registered March 31, 2009.

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

Opposer's first mark listed above, , has been registered for the goods set forth below.

Wearing apparel, clothing, and clothing accessories, namely, beachwear, jackets, leg warmers, loungewear, robes, scarves," in Class 25 (Registration No. 3662110); and

Wearing apparel, clothing, and clothing accessories, namely, bottoms, gym suits, tops, lingerie, pants, shirts, shorts, skirts, sleep wear, sweaters, swim wear, underwear, footwear, and headwear," in Class 25 (Registration No. 3539007).

We will focus our likelihood of confusion analysis on the mark in those registrations because when that mark is considered vis-à-vis the applied-for mark and identified goods, it is that mark that is most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant's application file. In addition, the parties introduced the following testimony and evidence:

³ Registration No. 3878197, registered on November 16, 2010.

A. Opposer's evidence and testimony.

1. Notice of reliance on copies of opposer's pleaded registrations printed from the electronic database records of the USPTO showing the current status and title of the registrations;

2. Notice of reliance on the discovery deposition of applicant with attached exhibits;

3. Notice of reliance on copies of decisions of the Trademark Trial and Appeal Board sustaining eight oppositions in favor of opposer involving other bird designs;

4. Notice of reliance on unsolicited print publications available to the general public to show the public's exposure to information about opposer; and

5. The testimony deposition of Steve Kubinski, opposer's Vice President of Marketing, with attached exhibits.

B. Applicant's evidence.

Applicant submitted a notice of reliance on the following items:

1. An excerpt from a third-party website purporting to show a dove used in connection with clothing;⁴

2. A third-party application for a mark featuring a bird silhouette for clothing and an excerpt from the website showing use of that mark;⁵

⁴ Applicant introduced into the record an excerpt from the Selena Gomez Dream Out Loud website (<http://www.selenagomezdreamoutloud.webs.com/>) purporting to show a dove as part of her trade name or trade dress. However, the excerpt made of record did not show the use of a bird design.

⁵ Applicant submitted a copy of the HOLLISTER and design application (Serial No. 85193900). Pending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Doctors &*

3. An excerpt from a website explaining the significance of doves in the Bible;
and 4. Copies of documents previously filed in this proceeding.

We note that opposer has objected to most of the exhibits introduced by applicant through his notice of reliance. The Board is capable of weighing the relevance and strength or weakness of the objected-to evidence in this specific case, including any inherent limitations, and this precludes the need to strike the evidence. Given the circumstances herein, we choose not to make specific rulings on each and every objection. As necessary and appropriate, we will point out in this decision any limitations applied to the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. While we have considered all the evidence and arguments of the parties, we do not rely on evidence not discussed herein.

Standing and Priority

Because opposer has properly made its pleaded registrations of record, 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). In addition, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the pleaded registrations made of record. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Thiede, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003); *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

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 goods. *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.

A. The similarity or dissimilarity and nature of the goods, the likely-to-continue channels of trade and classes of consumers.

The identification of goods in the application and opposer’s registrations include, *inter alia*, jackets, shirts, pants, footwear and headwear. Therefore, the goods of the parties are in part identical. It is not necessary that all of the goods listed in the application and registrations be related. In the context of likelihood of confusion, it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Because the goods described in the application and opposer's registrations are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). *See also In re Viterro 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).

Applicant argues that because his clothing line is "inspirational wear," the trade channels and classes of consumers are different.

[Applicant] produces "inspirational wear" at this time with plans to expand the line to other items in the future. The main focus is T-shirt at this time. All of the shirts carry a message. The trade channel may not be similar, nor the consumers that purchase the products, but Applicant wanted the opportunity to have availability in the marketplace for purchases by consumers without limitations or restrictions. Restrictions of whom to sell and where (groups and organizations) unfair [sic] limitations.⁶

The problem with applicant's argument is that his identification of goods is not limited to "inspirational wear" and there are no restrictions or limitations as to channels of trade and classes of consumers in his identification of goods. Because the scope of the registration applicant seeks is defined by its application (and not by

⁶ Applicant's Brief, p. 5.

its actual use) it is the application (and not actual use) that we must look to in determining applicant's right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Likewise, because there are no limitations as to channels of trade or classes of purchasers in the identification of goods in opposer's registrations, we must presume that opposer's goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods, including purchasers of "inspirational wear." 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).

In view of the foregoing, we find that the goods are in part identical and that there is a presumption that the goods move in the same channels of trade and are sold to the same classes of consumers.

B. The strength of opposer's mark.

Applicant argues, in essence, that there are numerous bird marks in use on clothing and, therefore, opposer's mark is a weak mark entitled to only a narrow

scope of protection or exclusivity of use.⁷ To support this argument, applicant submitted a copy of an excerpt from a third-party website displaying the mark HOLLISTER and a bird design shown below for clothing.



The probative value of the website is limited because there is no evidence regarding the extent of public exposure to the HOLLISTER and design mark. There is no evidence regarding how many prospective customers have seen the website, the number of customers the company has or the trading area for this company. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 n.5 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 n.16 (TTAB 1996). Moreover, one third-party use of a mark that is arguably not as similar in appearance to applicant's mark as opposer's mark is not sufficient for us to find that consumers are so used to seeing marks containing the silhouettes of birds for clothing that consumers can distinguish between them.

We find that opposer's mark comprising the silhouette of a bird when used in connection with clothing is an arbitrary mark and inherently strong.

C. The similarity of the marks in their entirety in terms of appearance, 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

⁷ Applicant's Brief, p. 5.

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 where, as here, the goods are in part 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).

Also, 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. *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 clothing, the average customer is an ordinary consumer.

When, as here, the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity. *E.g., In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990). As indicated above, consideration must be given to the fact that the marks usually will not be viewed side-by-side in the marketplace and a purchaser's recollection of design marks is often of a general, rather than specific, nature; thus the marks may be confusingly similar despite differences between them. *See, e.g., In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding mark consisting of a design featuring silhouettes of a man and woman, used in connection with distributorship services in the field of health and beauty aids, and mark consisting of a design featuring silhouettes of a man and woman, used in connection with skin cream, likely to cause confusion).

Applicant's Mark



Opposer's Mark



When the marks are placed side-by-side for comparison, specific differences in them are detectable. However, that is not the test. Notwithstanding the differences in the marks when viewed side-by-side, they engender similar commercial impressions. Both marks depict the silhouette of a dove in flight with wings spread. As indicated in the previous section, we note the strong arbitrary character of the

marks when used in connection with clothing. In view thereof, we find that the marks are similar in terms of appearance and commercial impression.

D. Balancing the factors.

Because the marks are strong arbitrary marks engendering similar overall commercial impressions and because the goods are in part identical with a presumption that they move in the same channels of trade and are sold to the same classes of consumers, we find that applicant's mark so resembles opposer's mark as to be likely to cause confusion.

Because we find that applicant's mark is likely to cause confusion with opposer's mark and registration to applicant is refused, we do not need to decide whether applicant had a *bona fide* intent to use his mark when he filed his application.

Decision: The opposition is sustained and registration to applicant is refused.