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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

New Millennium Sports, S.L.U.
v.
Jack Wolfskin Ausrüstung fur Draussen GmbH & Co. KGaA

Opposition No. 91195604

Philip R. Bautista of Taft Stettinius & Hollister LLP for New Millennium Sports, S.L.U.

Robert A. Becker and Richard Z. Lehv of Fross Zelnick Lehrman & Zissu, P.C. for Jack Wolfskin Ausrüstung fur Draussen GmbH & Co. KGaA.

Before Taylor, Ritchie and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Jack Wolfskin Ausrüstung fur Draussen GmbH & Co. KGaA (“applicant”) filed an application¹ to register the mark set forth below for a variety of goods in International Classes 9, 18, 20, 22, and 25:



¹ Application Serial No. 77823794, filed on September 10, 2009 under Trademark Act § 44(e), 15 U.S.C. § 1126(e) on the basis of German Registrations Nos. 1080617, 39403831, 39548615, and 1098932.

The application states, “The mark consists of a nonhuman paw print.” Color is not claimed as a feature of the mark.

New Millennium Sports, S.L.U. (“opposer”) opposed registration of the mark for the goods in International Class 25 only. Applicant’s goods in Class 25 are the following:

Clothing, namely, pullovers, sweaters, sweatshirts, shirts, blouses, t-shirts, polo shirts, jackets, parkas, anoraks, coats, wind cheaters, vests, pants, shorts, underwear, ski wear, ski pants, ski suits, swimwear and beachwear, scarves, gloves, belts, waterproof and weatherproof clothing, namely, windproof and waterproof jackets, down vests, down jackets, weatherproof jackets, waterproof pants, fleece jackets, fleece shorts, fleece pullovers, ski pants, fleece pants, fleece sweaters, waterproof hats, fleece mittens, boots lined with wool, waterproof snow boots, waterproof hiking shoes, weatherproof hiking boots, weatherproof trekking boots and waterproof shoes; footwear, namely, boots, shoes, sandals, sport shoes, slippers; headgear, namely, hats, headbands and caps.

Opposer brings its opposition under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant’s mark, as used in connection with those goods, so resembles opposer’s registered mark set forth below² as to be likely to cause confusion, mistake or deception.

KELME 

Opposer’s mark is registered for the following goods:

clothing; namely, track suits, trousers, shorts, vests, shirts, sweat shirts, stockings, socks, rainwear,

² Reg. No. 1856808 issued on October 4, 1994; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

waistcoats; footwear; namely, sport shoes, boots, and slippers; headgear; namely, caps and hats.

In answering the notice of opposition, applicant admitted that the earliest date of use of its mark that it can rely on is September 10, 2009,³ which is the filing date of the opposed application. Applicant denied the other salient allegations of the notice of opposition. Applicant also stated a counterclaim for cancellation of opposer's pleaded registration on the ground that opposer has abandoned use of the registered mark.⁴ Opposer denied all allegations of the counterclaim. The case has been fully briefed.

I. The record.

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for the opposed mark and the file history of the registration that is the subject of the counterclaim for cancellation.

The parties stipulated that "Any documents produced by the parties in response to requests for production of documents or interrogatories shall be deemed admissible and are made of record in this proceeding.... Objections to admissibility of such documents are hereby waived."⁵ The documents were identified by page numbers on a schedule attached to the stipulation, but they were not attached to the stipulation. Opposer filed some of the identified documents (consisting of a one-

³ Answer and Counterclaim, ¶ 5.

⁴ Applicant also stated affirmative defenses of waiver, estoppel, and failure to state a claim upon which relief can be granted. Applicant did not pursue those defenses and they are deemed waived.

⁵ Stipulation filed October 16, 2012, TTABvue # 43; stipulation accepted October 31, 2012, TTABvue # 44.

page affidavit of opposer's chief executive officer Carlos Garcia Cobaleda; and advertising and marketing materials of opposer) as an attachment to its main brief, which recited the terms of the stipulation in its description of the record. Applicant in its main brief, filed thereafter, also recited the terms of the stipulation and stated "Applicant does not dispute Opposer's description of the evidence of record" and "Neither party has raised any objections to the evidence of record."⁶ Even though the materials attached to opposer's brief should have been filed under a notice of reliance during opposer's testimony period, in view of the terms of the stipulation and the lack of any objection by applicant, we will consider them.

The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. Printouts of information from the electronic database records of the Patent and Trademark Office showing the current status and title of opposer's pleaded registration, filed with the notice of opposition. TTABvue # 1.
2. Testimony deposition of Duarte Da Silveira, president and chief executive officer of Kelme North America, LLC. TTABvue # 49.
3. Notice of reliance of January 13, 2013, including applicant's responses to certain interrogatories and USPTO records relating to applicant's cancelled U.S. Reg. No. 2760796. TTABvue # 46.
4. Rebuttal notice of reliance of June 13, 2013, including materials duplicative of those filed with the January 13, 2013 notice of reliance. TTABvue # 54.

B. Applicant's evidence.

1. Notice of reliance on opposer's written responses to selected interrogatories, document requests and requests for admission. TTABvue # 50.

⁶ Applicant's brief at 2. *See also id.*, fn1.

2. Notice of reliance on information relating to third-party registrations and applications. TTABvue # 51.
3. Notice of reliance on printouts of certain internet web pages. TTABvue ## 52-53.

II. Standing.

Opposer has properly made of record its pleaded registration and has demonstrated its use of a paw print design in connection with the sale of its goods.⁷ Opposer has thus shown that it is not a mere intermeddler and has established its standing to oppose registration of applicant's mark. *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).

Applicant has standing to bring its counterclaim for cancellation of opposer's registered mark on the basis of opposer's assertion of its mark and registration against applicant in the 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."). *See also Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007).

III. Applicant's counterclaim.

We begin by considering applicant's counterclaim for cancellation of opposer's pleaded registration.

⁷ Da Silveira Exhibits 3-12.

A claim for cancellation of a registration may be filed at any time if the registered mark has been abandoned. 15 U.S.C. § 1064(3). A mark is considered abandoned when “its use has been discontinued with intent not to resume such use”; and “nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” 15 U.S.C. § 1127. Because registrations are presumed valid under the law, the party seeking to cancel a registration on the ground of abandonment must rebut this presumption of validity by a preponderance of the evidence. *See On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); and *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). If the claimant makes a *prima facie* case of abandonment, the burden of production then shifts to the registration holder to rebut the *prima facie* showing with evidence. *Id.*

Applicant contends that opposer “ceased using the mark shown in [its pleaded registration] in 2004, nine years ago”;⁸ and that since 2004 opposer has used a different mark that is “materially different in character from” the registered mark,⁹ with no intention to resume use of the registered form of the mark. Opposer admits in its brief that since 2004 it has used its mark in the form shown below:¹⁰

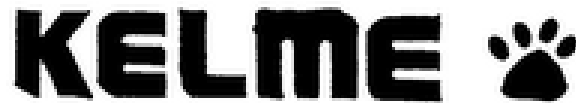


⁸ Applicant’s brief at 28.

⁹ *Id.* at 29.

¹⁰ Opposer’s brief at 8.

Opposer has also admitted that its use of this version of the mark has continued throughout the period of 2005 to 2011.¹¹ For purposes of comparison, we reproduce the registered form of the mark below:



A change in the form in which a registered mark is used, accompanied by cessation of use of the original form with no intent to resume use thereof, may constitute abandonment of the registered mark if the change constitutes a “material alteration.” *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1861 (TTAB 2007).¹² “A change in the form of a mark does not constitute abandonment or a break in continuous use if the change neither creates a new mark nor changes the commercial impression of the old mark.” *Id.*, citing J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §17:26 (4th ed. 2007). In order to avoid a finding of material alteration, “[t]he modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.” *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743 (TTAB 1983).

¹¹ Opposer’s responses to requests for admission Nos. 8-14, TTABvue # 50.

¹² *See also General Foods Corporation v. Ito Yokado Co., Ltd.*, 219 USPQ 822, 825 fn.10 (TTAB 1983) (stating, in *dicta*, “Abandonment may result from a material change in the registered mark, i.e., such that the mark being used is not the registered mark but a different mark.”).

Applicant argues:

[T]he design shown in Opposer's Mark [as registered], rather than being interpreted by consumers as a paw, might be interpreted by consumers in one of at least four other ways – as a mountain with the sun's rays, a volcano, a setting sun, or an abstract design. By contrast, both parties agree that the design shown in Opposer's Replacement Mark would be interpreted as a paw.¹³

Applicant argues, quoting TMEP § 1609.02(a), that “The general test of whether an alteration is material is whether, if the mark in an application for registration had been published, the change would require republication in order to present the mark fairly for purposes of opposition.”¹⁴ Applicant points out:

[In 2004] there were 7 registrations or applications for marks in Class 25 that included depictions of paws with nails or claws, and of those 7 registrations or applications, 2 consisted only of depictions of paws with nails or claws. It would have been perfectly rational for the owners of these 7 registrations and applications to have wanted to oppose registration of Opposer's Replacement Mark, even if they had not wanted to oppose registration of Opposer's Mark.¹⁵

Opposer argues that its modified mark “creates the same commercial impression as the Original Mark”.¹⁶

The Original Mark and the Modernized Mark both contain the word element KELME, with each letter being solid and capitalized. Both marks have paw print elements to the right of the KELME word element that are the same height as the capital letters of the KELME word elements and that are solid. Both marks have paw

¹³ Applicant's reply brief at 6.

¹⁴ Applicant's main brief at 29.

¹⁵ *Id.* at 30-31 (citations to the record omitted).

¹⁶ Opposer's rebuttal brief at 5.

print elements with top and bottom portions that begin and end on the same plane as the top and bottom portions of the KELME lettering. Both marks have solid, triangular-shaped palmar/plantar paw pads. Both marks have solid, four oval-shaped digital pads that are similarly oval-shaped, the same size, and that are similarly oriented around the palmar/plantar pad.¹⁷

Opposer also points out that when it submitted a combined affidavit of use and application for renewal of its registration,¹⁸ accompanied by specimens of use showing the mark in its modified form, the Patent and Trademark Office accepted the same and renewed the registration.¹⁹

After careful review, we find that the modified version of opposer's mark does not constitute a material alteration. With respect to the style of the lettering, we note that the style shown in the registration is relatively non-distinctive, and the style in which the letters are now presented is also highly conventional. The literal element of the mark, KELME, is far more distinctive than the lettering in which it is presented, and we find that the impression that it creates is not materially affected by a change in the style of the letters.

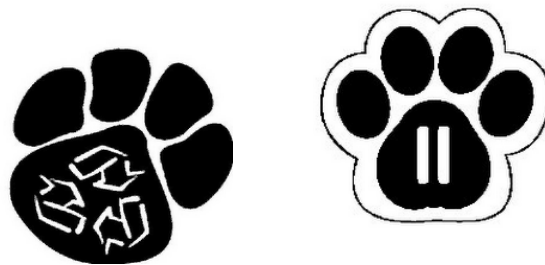
As the parties have noted, the primary change to the mark is the addition of nails or claws to the "paw" design to the right of the word KELME. We are not persuaded by applicant's claim that the design, as registered, would be interpreted as something other than a paw. If the design resembles in any way a mountain, a volcano, or a setting sun, it does so only in a very vague way. On the other hand,

¹⁷ *Id.*

¹⁸ Affidavit under § 8 and request for renewal under § 9, filed October 14, 2004.

¹⁹ Notice of acceptance and notice of renewal, issued November 16, 2004.

the design resembles a paw print with reasonable clarity and conforms to conventional concepts of what an animal's paw or paw print would look like. *See*, for example, the third-party registrations shown in applicant's Exhibits HH and KK, for marks that are described, respectively, as an "animal paw" and a "dog's paw," and both of which, like opposer's design, consist primarily of a rounded triangle with four irregular ovals:²⁰



We expect that customers would likely interpret opposer's design as a paw.

Graphically, the newly added claws are a very small component of the overall design, relative to the other elements of the design. Moreover, inasmuch as it is common knowledge that an animal's paws are accompanied by claws, the addition of a visual indication of the claws does not materially alter the impression conveyed by the design. It appeared to be a paw before, and now it still appears to be a paw. In other ways – the size and position of the paw relative to the wording – the mark is essentially unchanged. The fact that the shapes that compose the paw design have been made somewhat more regular and symmetrical makes little overall

²⁰ U.S. Reg. Nos. 3614300 and 3894401, applicant's notice of reliance TTABVue #51, Exhibits HH and KK. Numerous other similar examples can be seen in the same notice of reliance.

impression. The original paw design was reasonably close to symmetrical and the modified form of the mark is only slightly more balanced.

The rule of thumb invoked by applicant – the hypothetical question of whether a proposed amendment to a mark that had already been published would warrant republication in order to present the mark fairly for purposes of opposition – reflects policy concerns that are relevant to the question before us. In this case, we do not find that the changes to opposer’s mark would warrant republication. The publication of the original mark would have put interested persons on notice that the mark included a representation of an animal’s paw. The changes in the modified version of the mark are typical of the variations to be reasonably expected in representations of animals’ paws.²¹

We have given no weight to the fact that the Post-Registration Division of the Patent and Trademark Office granted the request for renewal of opposer’s registration. That renewal did not deprive applicant of its right to petition for cancellation of the registration on grounds of abandonment and to have its claim determined by the Board.

We find that the essence of the original mark is present in the mark as modified; that the modified mark creates the impression of being essentially the same mark; and that the commercial impression of the old mark has not been changed. Accordingly, we find that the differences between the mark that opposer currently uses and the mark that appears in its registration do not constitute a

²¹ See, for example, the various representations of paws used by third parties shown in applicant’s notice of reliance at TTABVue ## 52 and 53.

material alteration of the registered mark. Accordingly, applicant has not shown that opposer has abandoned use of its registered mark. Applicant's counterclaim for cancellation is dismissed.

IV. Opposer's claim under Section 2(d).

We turn now to opposer's claim under Trademark Act § 2(d) on the ground of priority and likelihood of confusion.

In view of opposer's ownership of a valid and subsisting registration of its pleaded mark, priority is not in issue with respect to the mark and goods identified in that registration. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

A. The parties' goods.

Turning first to the similarity or dissimilarity of the goods at issue, we find that the parties' goods are, in part, identical. Opposer's registration and the opposed application both cover sweatshirts; shirts; vests; shorts; footwear, namely, boots, sport shoes, and slippers; and headgear, namely, hats and caps. Moreover, the goods identified as "trousers" and "rainwear" in opposer's registration are at least closely related in nature to the goods identified in the application as "pants"

and “waterproof and weatherproof clothing, namely, windproof and waterproof jackets, ... weatherproof jackets, [and] waterproof pants.”

We need not address the similarity between opposer’s goods and each and every one of applicant’s identified goods. 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 a given International Class 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). Accordingly, the *du Pont* factor relating to the similarity of the goods favors a finding of likelihood of confusion.

B. The parties’ channels of trade.

We next consider the parties’ established and likely-to-continue trade channels. To the extent that the parties’ goods are identical (*i.e.*, sweatshirts; shirts; vests; shorts; boots, sport shoes, and slippers; hats and caps), we must presume that the parties’ goods move through the same channels of trade. *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); *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).²² As there are no limitations as to channels of trade in the identifications of goods in the registration and application, we presume that the parties’ goods move in all channels of trade normal for such goods. *See Octocom*

²² Applicant admits as much in its brief at 26 (“[A]s a matter of law the parties’ trade channels ... will be presumed to be the same or similar....”)

Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Opposer's witness testified that its trade channels included casual wear retailers, sporting goods retailers, wholesalers, secondary distribution vendors, and the internet.²³ Applicant has stated that its potential trade channels are stores operated by applicant, shop-in-shop systems, third-party stores, and online stores.²⁴

Applicant contends, however, that the similarity of trade channels "does not mean that this factor weighs in Opposer's favor."²⁵ Applicant argues that "consumers understand that clothing stores sell clothing from many manufacturers. Consumers who go to a clothing store and see numerous brands are not going to believe that they come from the same source."²⁶ We are not persuaded. If two marks are confusingly similar, the fact that they may be found in the same channels of trade would increase the likelihood of customer confusion. Accordingly, this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

C. Customers; Conditions of sale.

We next consider "the conditions under which and the buyers to whom sales are made." *du Pont* at 567. Because the parties' goods are in part identical, we must presume that the classes of customers at issue are the same. *See In re Viterra*

²³ Da Silveira 40:23-41:21.

²⁴ Applicant's response to interrogatory No. 2, opposer's notice of reliance at TTABvue # 46.

²⁵ Applicant's brief at 26.

²⁶ *Id.* at 26-27.

Inc., 101 USPQ2d at 1908. Opposer describes the customers of both parties as “average purchasers” who “are unlikely to exercise a great deal of care” in purchasing the goods.²⁷ Clearly the universe of customers for the parties’ goods is very broad and includes all members of the general public having an interest in purchasing goods such as sweatshirts, sport shoes, and hats. In addition, nothing in the record suggests that purchasers of such goods have any special degree of sophistication. However, applicant argues:

[The goods at issue] are mostly articles of clothing that constitute important purchases, not merely because they often cost more than \$100, but also because they are the types of goods that consumers do not soon replace by purchasing similar items. And they are the types of products that consumers know they will have to take the time to return if they do not fit. ... These simply are not casual impulse purchases.²⁸

[The goods] feature a variety of footwear, outerwear, and trousers that must fit and are expensive, often purchased with the help of a salesman, often expressions of the wearer’s personal style, and purchased infrequently. They are not “casual, everyday items,” and must be purchased with care, not on impulse.²⁹

To buy either party’s products, a consumer will usually interact with a salesperson and take the time to try on the item, particularly if the item is a pair of athletic shoes. Usually the consumer does not just go into a store aisle, pick up a product, and bring it to the cash register. The general sales model often entails assistance, and this assistance minimizes confusion.³⁰

²⁷ Opposer’s brief at 18-19.

²⁸ Applicant’s brief at 19.

²⁹ *Id.* at 21.

³⁰ *Id.* at 26.

We are not persuaded by applicant's characterization of the conditions of purchase. It is true that some of the parties' goods, such as footwear, may cost more than \$100 and require some deliberation in order to select the correct size and fit. However, other goods of applicant, such as t-shirts, caps, and headbands are relatively inexpensive and may well be selected without special care. Neither are we persuaded that the assistance of a salesperson would be an inevitable aspect of a sale of the goods.

Considering that the relevant customers would include ordinary consumers using an average degree of care, and that the conditions of sale would not necessarily entail increased deliberation or the assistance of sales personnel, we find this *du Pont* factor to be neutral or slightly favoring a finding of likelihood of confusion.

D. The marks at issue.

We next consider the similarity or dissimilarity of the marks at issue in terms of appearance, sound, meaning, and overall commercial impression. We base our determination on a consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981). However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re*

National Data Corp., 224 USPQ at 751; *see also Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955).

Applicant points out that opposer's registered mark includes the "fanciful" term KELME; that this term constitutes the dominant portion of opposer's mark; and that this dominant portion is absent from applicant's mark.³¹ Applicant points out that its mark consists only of a design that would be immediately recognizable as a paw (including claws), while the design in opposer's mark could be perceived as something else, in part because it is rendered in less detail and lacks any representation of claws. Applicant contends that opposer's design looks like something drawn by a child; that if it is perceived to be a paw, it would be the paw of a harmless pet, whereas applicant's design depicts the paw of "an animal that ... has not been domesticated." Applicant points out that its design is oriented at an angle, that it is generally "realistic," as opposed to the "schematic" quality of opposer's design, and that it is "obviously not symmetrical," as opposed to the symmetry of opposer's design.³²

It is clear that the KELME component of opposer's mark creates a visual and phonetic impression that is absent from applicant's mark. However, even if we assume that KELME constitutes the dominant portion of the mark, the design component standing to the right of the term KELME is a salient, distinctive feature of the mark which must be given due consideration. Opposer contends that

³¹ Applicant's brief at 5-7.

³² *Id.* at 7-9.

applicant's mark is confusingly similar to this design and, for that reason, is likely to cause confusion as to the source of applicant's goods.

We give relatively little weight to the fact that in applicant's mark, the paw is presented at an angle, in contrast to the vertical presentation of opposer's design element. Even though the owner of a trademark may intend that the mark be displayed only at one approved angle, in the marketplace customers may encounter marked materials such as labels, packages, hangtags and even signs in a variety of orientations. This fact would tend to reduce the impact on customers of the "approved" angle of the mark.

Considering other purely visual aspects of the two designs, we note that opposer's design includes a large, rounded, triangular shape surmounted by four smaller, slightly irregular ovals. In applicant's mark there is a corresponding rounded triangular shape that is more irregular and less symmetrical than the triangle in opposer's mark. In opposer's mark the long axes of the four small ovals are in a radiating pattern. The ovals in applicant's mark are roughly parallel to each other. In each case the middle two ovals are positioned farther from the base line of the triangle than are the outer two ovals. Applicant's mark, unlike opposer's design, has four smaller shapes at the outer tips of the four ovals. These features of applicant's mark are completely absent from opposer's design. Despite the differences that we note here, and giving due regard to the differences noted by applicant in its brief at 5-9, the two designs have substantial visual similarities.

With respect to the significance or connotation of the two designs, applicant has described its mark as “a nonhuman paw print”;³³ and has stated that it is “immediately recognizable as a paw.”³⁴ As we discussed above in Section III, we find that opposer’s design, also, would be perceived as a paw or paw print. Applicant’s alternative interpretations of opposer’s design (volcano, setting sun, mountain) are not persuasive. Overall, we find the two designs to be similar in meaning or connotation, as both of them would be interpreted as a paw or paw print.

With respect to sound, it is obvious that neither design has any phonetic element.

We must, of course, compare the overall commercial impression of opposer’s mark in its entirety, including the appearance, sound and meaning of the term KELME, with the commercial impression created by applicant’s mark. We find that applicant’s mark creates a commercial impression that is substantially similar to that of opposer’s mark, as it resembles in many respects the design component of opposer’s mark. Companies that use marks consisting of a word plus a logo often display their logos alone, unaccompanied by the literal portions of their trademarks. Indeed, opposer has demonstrated that it sometimes displays its paw design (in its modified form) separate and apart from the KELME designation.³⁵ Applicant’s mark could therefore be interpreted by customers as a display of opposer’s design,

³³ Application, description of the mark.

³⁴ Applicant’s brief at 7.

³⁵ Da Silveira Exhibit 3 (top of shoe box); Exhibit 7 (cover of 2007 “soccer” catalogue); Exhibit 8 (cover of 2007 “indoor” catalogue).

apart from opposer's word element. *See In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) ("Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark."). Accordingly, we find that the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

E. Similar marks in use.

In accordance with *du Pont*, we consider any evidence of record regarding "the number and nature of similar marks in use on similar goods." *du Pont* at 567. Applicant has submitted substantial evidence relating to "paw" trademarks that have been registered³⁶ and used³⁷ in connection with clothing. Applicant argues:

[C]onsumers are aware that the presence of a paw as or in a mark is not sufficient to allow them to determine the origin of the product sold under those marks. Consumers realize that in order to determine the origin of the products, they must look to differences between the paws and additional indicia of origin, both in the marks and elsewhere, on the products. ... This dilution of paws in marks in Class 25 in the U.S. thus substantially lessens the likelihood of confusion.³⁸

For purposes of demonstrating the weakness of a mark, we generally give little weight to third-party registrations, because they are not evidence that the marks are in use. *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). In this case, we note that applicant has demonstrated through internet evidence that many of the registered

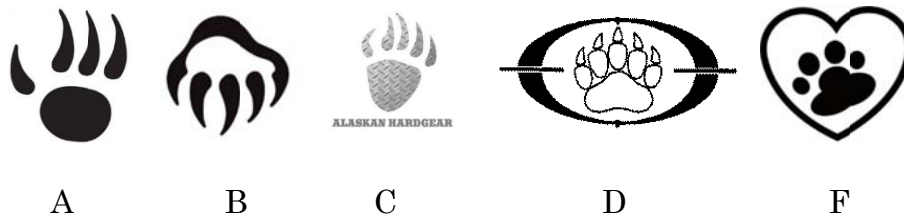
³⁶ Applicant's notice of reliance at TTABvue # 51.

³⁷ Applicant's notice of reliance at TTABvue ## 52-53.

³⁸ Applicant's brief at 16.

marks are in use at least in internet advertisements. Accordingly, we will focus on this internet evidence, which has been marked as applicant's Exhibits A through BB.³⁹

The most relevant examples of third-party use are Exhibits A-D and F, as these appear to show "paw" trademarks in the parties' fields of footwear, sportswear, outer wear, and casual wear. Of these, only the mark in Exhibit F resembles opposer's design, although the paw is enclosed in a stylized heart. The marks in Exhibits A-D are quite different, in that four of them have five digits and all of them have very prominent claws:



The differences in style and detail in these marks limits the extent to which they would have a diluting impact on the distinctiveness of opposer's mark.

The great majority of the internet evidence relates to apparel bearing paw designs that are associated with universities, high schools and their athletic teams. Exhibits J through BB. The evidence shows at least 19 of these designs, some of which quite closely resemble opposer's design. *See, e.g.*, Exhibits K (Clemson University), M (Bates College), Q (Ohio University), V (Eastern Illinois University), and Z (Princeton High School).

³⁹ Applicant's notice of reliance at TTABVue ## 52-53.



Clemson U.



Bates College



Ohio U.



Princeton High School

Others among these marks are quite different from opposer's design. *See, e.g.*, Exhibits N (University of Maine – five digits, prominent claws); R (University of Montana – five long digits, long claws, M design on palm); S (University of South Dakota – SD monogram in center of one-piece paw); U (St. Vincent College – vertical claw marks across the pad of the paw); Y (Towson University – tiger stripes across paw); AA (Barron Collier High School – two paws); and BB (Palmetto Ridge High School – five digits, prominent claws, PR monogram on palm).

We find it significant that the marks in Exhibits J-BB are displayed on apparel primarily in an ornamental fashion: that is, they are emblazoned on the apparel in large format and in prominent placement such as on the chest of a shirt or on the side of the leg of a pair of pants. Moreover, it is clear that these marks are displayed for the purpose of showing an association with particular colleges, high schools, and their sports teams, rather than to identify an apparel company or a sporting goods company. In other words, these marks “tell[] the purchasing public ... not the source of manufacture but the secondary source” of the goods, *In re Paramount Pictures Corporation*, 213 USPQ 1111, 1112 (TTAB 1982) (in the present case the secondary sources being educational institutions or athletic teams). This is most apparent on those college or high school websites that, in offering apparel marked with the school or team mark, also identify the actual

manufacturers of the goods. *See, e.g.*, Exhibits L (Under Armour hat, U-Trau boxers, Jansport sweatpants); N (Jansport and Russell t-shirts, U-Trau boxers, Boxercraft capris pants, *etc.*); P (Hurley board short); Q (Champion t-shirts, sweatshirts, pants, Nike t-shirt); S (Adidas hoops short, Russell t-shirt, Jansport sweatshirt, *etc.*); T (Champion t-shirts and sweatshirts, Cutter & Buck polos, *etc.*); U (Jansport t-shirts, *etc.*); W (Champion and Under Armour t-shirts, Jansport pants); Z (sweatshirts by Jerzees, Independent Trading Co., and Bella+Canvas); BB (District Threads sweatshirt, Port & Company t-shirt). Inasmuch as the college, high school and athletic team marks perform the function of secondary source indicators rather than conventional marks of apparel companies, their impact on the distinctiveness of opposer's apparel trademark is somewhat reduced.

Similarly, the marks shown on apparel in Exhibits E, G, H and I appear to be used primarily as secondary source indicators for businesses offering pet-related goods and services.

We note also that, while many of the paw designs in Exhibits A through BB consist of variations of the "pad plus four digits" format that is seen in opposer's design, they are displayed together with other distinguishing matter, such as college names or acronyms, monograms, and distinctive graphic details. In this regard, these designs, as actually presented to the marketplace, are substantially more distinct from opposer's mark than is the mark that applicant wishes to register, which has no wording and only very subtle graphic details to distinguish it from opposer's design.

In view of the foregoing, we find that the *du Pont* factor of the number and nature of similar marks in use on similar goods is neutral.

F. The fame of opposer's mark.

Opposer maintains that its mark is “well-known and famous.”⁴⁰ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. 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). 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).

For purposes of a claim of likelihood of confusion, fame arises if 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). Fame for likelihood of confusion purposes may be measured indirectly by the volume of sales of the goods or services sold under the mark, advertising expenditures, and other factors such as

⁴⁰ Opposer's brief at 20.

length of time of use of the mark; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services. *Bose Corp.*, 63 USPQ2d at 1308.

Opposer argues that for more than a decade it has advertised and sold its goods to “thousands of retail sellers of athletic apparel and footwear,” including “major retail sellers”; and that “annual sales of goods bearing the Mark have historically been robust.”⁴¹ Opposer has made of record select information relating to the dollar value of sales of goods under the mark.⁴² The information disclosed is very limited and shows opposer’s sales to be very modest. There is testimony indicating that opposer’s goods have had some degree of exposure at the Wimbledon tennis tournament and the Olympics, and to have been worn by the Spanish national soccer team, Real Madrid Soccer Club, and some well-known soccer players.⁴³ However, that testimony is quite vague and lacking in essential detail. Opposer has submitted no evidence regarding its advertising expenditures.

After careful consideration, we find that opposer has not demonstrated fame for purposes of a likelihood of confusion analysis. Accordingly, we find the *du Pont* factor of fame to be neutral.

G. Absence of actual confusion.

Opposer has admitted that it has no knowledge of any instance of actual confusion involving the parties’ marks. On the other hand, applicant has admitted

⁴¹ *Id.* See also *id.* at 10-11; and applicant’s rebuttal brief at 7-9.

⁴² Da Silveira 39:5-12. See also Cobaleda affidavit, filed with opposer’s brief on the case.

⁴³ Da Silveira 45:15-46:16.

that it “does not sell goods under Applicant’s Mark in the U.S.”;⁴⁴ and that it has “no current channels of trade for goods sold under Applicant’s Mark in the U.S.”⁴⁵ Although applicant’s responses to interrogatories indicate that it formerly did business in the United States, the extent of that business is not apparent on this record. Thus, there is no indication that there has been a meaningful opportunity for confusion to occur. Under the circumstances, we find the lack of evidence of actual confusion to be a neutral factor in our analysis of likelihood of confusion. *Cf. Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

H. Balancing the factors.

The record indicates that the parties’ respective marks are substantially similar; that their goods are identical in part; and that both parties offer or intend to offer their goods through similar trade channels to ordinary consumers who exercise an ordinary degree of care. Applicant has shown that there is some presence in the marketplace of other paw marks. Opposer has not shown its mark to be famous. There are no known instances of actual confusion.

We have considered all of the evidence of record and all arguments of the parties relevant to the issues before us, including those not specifically discussed herein. Our analysis of the *du Pont* factors leads us to find that applicant’s mark, as used in connection with the identified goods, so closely resembles opposer’s

⁴⁴ Opposer’s notice of reliance at TTABVue # 46, applicant’s response to interrogatory No. 1.

⁴⁵ *Id.*, applicant’s response to interrogatory No. 2.

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registered mark as to be likely to cause confusion, mistake or deception as to the source of applicant's goods.

Decision:

The opposition is sustained as to applicant's goods in International Class 25 and registration is refused as to those goods. After expiration of the applicable appeal period, the application will be permitted to proceed with respect to the goods in International Classes 9, 18, 20, and 22.

Applicant's counterclaim for cancellation is dismissed.