

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: May 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*University Athletic Association v. Incentive Marketing, Inc.*

—  
Opposition No. 91206761  
—

Rosaleen H. Chou of Kilpatrick Townsend & Stockton LLP,  
for University Athletic Association.

Sven W. Hanson, Esq.,  
for Incentive Marketing, Inc.

—

Before Wellington, Greenbaum and Adlin,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Incentive Marketing, Inc. (“Applicant”) seeks registration on the Principal Register of the mark GATOR SHOP (in standard characters, “SHOP” disclaimed) for

On-line retail store services featuring a wide variety of consumer goods of others; Retail shops featuring clothing, sports team clothing, and a wide range of consumer goods of others in International Class 35.<sup>1</sup>

---

<sup>1</sup> Application Serial No. 85480582 was filed on November 23, 2011, based upon applicant’s claim of first use anywhere and use in commerce since at least as early as March 1, 1984.

University Athletic Association (“Opposer”) has opposed registration of applicant’s mark on the following grounds: (1) as used with applicant’s services, applicant’s mark so resembles opposer’s numerous, previously-used and registered marks, all of which consist of or incorporate the word GATOR or GATORS, or the design of an alligator or the head of an alligator, for a variety of goods and services, including GATORS (in standard characters) for

retail [store] stores, distributorship services and mail order sales services, in the field of wearing apparel and accessories, novelty items and jewelry in International Class 42<sup>2</sup>

as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) false suggestion of a connection with opposer under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). In its answer to the notice of opposition, applicant denied the salient allegations.<sup>3</sup>

On August 2, 2013, Opposer filed a Consent Motion to Amend Notice of Opposition to plead six additional registrations. The Motion is granted, and the Amended Notice of Opposition is now the operative pleading herein.<sup>4</sup>

---

<sup>2</sup> Reg. No. 1222098, registered December 28, 1982, claiming a date of first use of 1955. Renewed. This registration also covers “entertainment services – namely, conducting intercollegiate athletic events for others” in International Class 41.

<sup>3</sup> Applicant raised several affirmative or putative “defenses” in its Answer, but did not pursue them at trial. We therefore deem the “defenses” waived, and have given them no further consideration.

<sup>4</sup> We deem applicant’s general denial, set forth in its Answer to the original Notice of Opposition, to apply equally to the Amended Notice of Opposition.

## I. The Record

By rule, the record includes the application file and the pleadings. Trademark Rule 2.122(b). In addition, opposer introduced the following testimony and evidence:

### A. Notice of Reliance

1. Printouts of opposer's 12 pleaded registrations from the USPTO TSDR database, which show that the registrations are valid, subsisting and owned by opposer (8 TTABVUE 7-126).<sup>5</sup>
2. Discovery deposition of applicant's Rule 30(b)(6) designee, Joseph Fincher, with associated Exhibits, submitted pursuant to the parties' stipulation (8 TTABVUE 127-525).<sup>6</sup>
3. Opposer's First Set of Requests for Admission ("RFA") and Applicant's Answers and Supplemental Answers thereto (8 TTABVUE 361-525).
4. Opposer's First Set of Interrogatories and Applicant's Responses and Supplemental Responses thereto (8 TTABVUE 526-544).

---

<sup>5</sup> In the Amended Notice of Opposition, Opposer pleads ownership of Reg. Nos. 1222098; 2206967; 2205439; 1228944; 2349246; 1225119; 3812440; 3232732; 2208807; 1970217; 1975079; and 3352139. Pleadings may be made of record by attaching "a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration." Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

<sup>6</sup> The parties are commended for agreeing to submit this deposition as if it had been taken as a testimonial deposition during Opposer's Testimony Period. The Board encourages parties to take advantage of such efficiencies. *See* TBMP § 705 (3d ed. rev.2 June 2013) ("Stipulated Evidence and Accelerated Case Resolution"). The parties' Joint Stipulation to this effect is approved. *See* 5 TTABVUE 2.

## B. Testimony Depositions

1. Testimony Deposition of Michael Drucker, Vice President and Associate General Counsel of Collegiate Licensing Company (“CLC”), with associated Exhibits (20-21 TTABVUE).<sup>7</sup>
2. Testimony Deposition of Debbie Gay, Licensing Manager at the University of Florida, with associated Exhibits (11-18 TTABVUE).

Applicant did not take testimony or offer any other evidence during its assigned testimony period. Only opposer filed a brief.

## II. Standing and Priority

Because opposer has made the pleaded registrations properly 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). Moreover, because the registrations are properly of record, priority is not at issue as to the goods and services identified therein. *King Candy Co., Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

## III. Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) 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

---

<sup>7</sup> CLC is an independent licensing agency that represents college properties including those owned by [or related to] the University of Florida. Drucker Test., p.7 (20 TTABVUE 10). According to Mr. Drucker, the Notice of Opposition was filed on behalf of the University of Florida. *Id.*, p. 25 (20 TTABVUE 28).

1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We focus our discussion on the mark and services in Registration No. 1222098 because it is for a mark and covers services that make it 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).

We begin with the *du Pont* factors of the relatedness of the services, channels of trade and class of purchasers. We base our evaluation on the services as they are identified in the involved application and pleaded Registration No. 1222098. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, \_\_ F.3d \_\_, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

In this case, the “retail stores ... in the field of wearing apparel” identified in the registration and the “retail shops featuring clothing [and] sports team clothing” identified in the application are legally identical.<sup>8</sup> It is sufficient for a finding of likelihood of confusion if the relatedness is established for any service encompassed by the identification of services within a particular class in the application or

---

<sup>8</sup> We note that until 2012, Applicant operated a retail store under the GATOR SHOP moniker within one mile from University of Florida campus, and Applicant continues to operate temporary tents near the campus during football season. Fincher Dep. at 11:1-12:15 (8 TTABVUE 138-139); App. Ans. to RFA 49 (8 TTABVUE 513).

registration. *Tuxedo Monopoly, Inc., v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). Further, because neither identification of services is restricted as to channels of trade or classes of purchasers, it is presumed that the services travel in all normal channels of trade and target the same class(es) of consumers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in an application and/or registration, the identified goods are “presumed to travel in the same channels of trade to the same class of purchasers”) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The 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. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal citation omitted). In comparing the marks we are mindful that where the marks would be used in connection with legally identical services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Max Capital*, 93 USPQ2d at 1248. In addition, while

marks must be compared in their entireties, it is settled that one feature of a mark may have more significance than another, and there is nothing improper in giving greater weight to the more significant feature. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, GATOR is the dominant and most significant feature of applicant's mark, not only because it appears first in applicant's mark (*see Palm Bay*, 73 USPQ2d at 1692), but also because it has stronger source-identifying significance than the other elements of the mark. In fact, "SHOP" is a generic term for applicant's services, which include a "retail shop," and the word appropriately has been disclaimed. Descriptive or disclaimed matter typically is less significant or less dominant when comparing marks. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846, *quoting National Data*, 224 USPQ at 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.").

GATOR is the singular form of the entirety of opposer's mark GATORS. In this case, there is no material difference between the singular and plural forms of the term GATOR, and applicant does not argue to the contrary. *See, e.g., In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). Thus, the dominant portion of applicant's mark, GATOR, is nearly identical to the entirety of opposer's mark, GATORS.

We further find that the marks have identical connotations, and that they create the same commercial impression. There is no evidence that opposer's GATORS

mark is anything other than arbitrary for the services at issue. However, to the extent GATORS may be considered somehow suggestive of the University of Florida, its students, alumni, athletics teams, fans or mascot, this term has the same meaning with respect to the retail shops associated with opposer's GATORS mark and applicant's GATOR SHOP mark.<sup>9</sup>

Because of the overall similarities of the marks, consumers are likely to view applicant's GATOR SHOP mark as a variation of opposer's GATORS mark, with both marks indicating the same, single source for the services. Therefore, we find that the parties' marks are substantially similar in sound, appearance, connotation and commercial impression.

When we consider the record and the relevant likelihood of confusion factors, we conclude that in view of the substantial similarity between applicant's mark GATOR SHOP and opposer's mark GATORS, their contemporaneous use on the legally identical services involved in this case is likely to cause confusion as to the source or sponsorship of such services. In view thereof, opposer has proven its Section 2(d) claim.

---

<sup>9</sup> There is no dispute that "Gators" is the University of Florida mascot (see Fincher Dep. at 23:20-22 (8 TTABVUE 150)); Gay Test. at 33:4-36:1 (11 TTABVUE 36-39). Further, Mr. Fincher testified that "Gator merchandise" means "University of Florida merchandise" (*id.* at 16:2-4 (8 TTABVUE 143)), "Gator sportswear" refers to the University of Florida (*id.* at 56:7-10 (8 TTABVUE 183)) and "Gator fan" refers to the University of Florida Gator fans. *Id.* at 81:1-3 (8 TTABVUE 208).

**Decision:** The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.<sup>10</sup>

---

<sup>10</sup> Because we have sustained the opposition on the 2(d) claim, we need not and do not reach opposer's false suggestion of a connection claim under Section 2(a) of the Trademark Act. *See Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1572 (TTAB 2007).