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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/836,544
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

**OPPOSER'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT
AND OPPOSER'S RESPONSE TO APPLICANT'S CROSS-MOTION FOR SUMMARY
JUDGMENT**

On November 11, 2015, INTS It Is Not The Same, GmbH ("Opposer") moved under Rule 56 of the Federal Rules of Civil Procedure and T.B.M.P. § 528 for summary judgment on the basis of priority and likelihood of confusion. On December 15, 2015, Disidual Clothing, LLC ("Applicant") filed its Brief in Opposition to Opposer's Motion for Summary Judgment and Cross-Motion for Summary Judgment (hereinafter referred to as "Applicant's Response to Opposer's Motion for Summary Judgment"). Opposer now files this Reply in Support of its Motion for Summary Judgment and Response to Applicant's Cross-Motion for Summary Judgment pursuant to TBMP § 502.02(b).

I. Argument

A. Priority

Opposer's "DESIGUAL" Marks have been used since at least as early as 1995, and Opposer's trademark registrations all precede Applicant's January 30, 2013 filing date and June 1, 2010 alleged first use date of its "DISIDUAL" mark. Therefore, Opposer clearly has priority in this proceeding.

Furthermore, the Applicant concedes that Opposer has priority, because the Applicant has not submitted any arguments or evidence to contravene Opposer's priority.

B. Likelihood of Confusion

- i. *DuPont Factor One: The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.*

Applicant's "DISIDUAL" trademark application is confusingly similar to Opposer's "DESIGUAL" registrations, because of similarities in sound, appearance, connotation, and commercial impression. Applicant contends that the marks are dissimilar in appearance, because Opposer's Marks incorporate DESIGUAL "in a bolded or thick font with an inverted 'S' . . ." See Applicant's Response to Opposer's Motion for Summary Judgment, pg. 7. It is unclear why Applicant believes that the presence of an inverted "S" is a strong basis upon which to differentiate the marks. Consumers will inevitably recognize the inverted "S" as being the letter "S", and an inverted "S" will be pronounced the same as a standard "S." The reality remains that Applicant's Mark mirrors Opposer's Marks by presenting six identical letters in the same position and order as Opposer's Marks. Applicant's "DISIDUAL" Mark merely replaces two letters from Opposer's "DESIGUAL" Marks, which does little to change the appearance and sound of the respective marks.

Applicant's reliance on the case of *Autozone, Inc. v. Tandy Corp.* as evidence that Applicant's Mark is sufficiently dissimilar from Opposer's Marks is misplaced. See Applicant's Response to Opposer's Motion for Summary Judgment, pg. 8 (citing *Autozone, Inc. v. Tandy Corp.*, 373 F.3d 786, 796-797 (6th Cir. 2004)). The *Autozone, Inc. v. Tandy Corp.* case is not factually analogous to the present case. In *Autozone, Inc. v. Tandy Corp.*, the trademark "AUTOZONE" was held sufficiently different from the trademark "POWERZONE" because of differences in connotation and commercial impression that arose from the prefix terms "AUTO" and "POWER", in conjunction

with the weakness of the marks. In stark contrast to *Autozone, Inc. v. Tandy Corp.*, there is no prefix term to either Applicant's "DISIDUAL" Mark or Opposer's "DESIGUAL" Marks. Therefore, it is axiomatic that there can be no differences in connotation and commercial impression to the non-existent prefix terms of the parties' marks. Furthermore, Opposer's "DESIGUAL" Marks are not comprised of any weak terms.

Applicant has attempted to create a weak term in Opposer's "DESIGUAL" Marks by improperly dissecting the mark into the incoherent terms "DESIG" and "UAL". Applicant's reasoning fails to consider that any such adjustment given to a portion of a mark must still be considered with respect to the "anti-dissection" rule. *See Shen Mfg. Co., Inc. v. The Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (explaining that "while there are often discrete terms in marks that are more dominant and, thus, more significant to the assessment of similarity, the law forbids the type of dissection proposed . . ."). "The ultimate conclusion of similarity or dissimilarity must rest on consideration of the marks in their entirety." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000). It is improper and arbitrary for Applicant to dissect the marks of both parties and suggest that "both parties' marks end in -UAL, this ending is commonly found in brand names in the apparel industry and on registered marks in Class 25 . . ." *See Applicant's Response to Opposer's Motion for Summary Judgment*, pg. 7. The term "UAL" has no meaning, consumers are unlikely to dissect the "DESIGUAL" and "DISIDUAL" marks, trademark law prohibits such a dissection, and the Applicant has provided no basis as to why the marks should be dissected at that point.

The Applicant next suggests that the parties' marks "generate different sounds and are phonetically distinct." *See Applicant's Response to Opposer's Motion for Summary Judgment*, pg. 7. This reasoning ignores settled law that merely requires the marks to be confusingly similar. In

determining likelihood of confusion, it is not essential that the marks be pronounced in an identical fashion. The fact that the marks elicit similar sounds supports a finding of likelihood of confusion. The Applicant states that its "DISIDUAL" mark is pronounced "de-SI-jew-ul." *See* Applicant's Response to Opposer's Motion for Summary Judgment, pg. 10. The Applicant then posits that Opposer's "DESIGUAL" Marks would be pronounced as "DES-ee-GWAL." *See* Applicant's Response to Opposer's Motion for Summary Judgment, pg. 10. It is unlikely that American consumers will pronounce Opposers Marks in the manner suggested by Applicant. From a phonetics standpoint, it is much more likely that consumers encountering the mark will simply pronounce the mark "de-sig-ū-uhl." Phonetically, Applicant's Mark should be pronounced "de-sid-ū-uhl." The pronunciation of Applicant's Mark, "de-si-jew-ul," is very similar in sound to that of Opposer's Marks, "de-sig-ū-uhl," particularly if the words are spoken quickly. The similarity in sound between Applicant's Mark and Opposer's Marks strongly supports a finding of likelihood of confusion.

Applicant's Mark and Opposer's Marks also likely impart a similar commercial impression to consumers, simply by failing to convey a specific meaning to consumers. The Applicant contends that "the term 'desigual' in Opposer's Marks has a commonly understood meaning." *See* Applicant's Response to Opposer's Motion for Summary Judgment, pg. 11. The Applicant has failed to establish that the term is indeed commonly understood by the relevant purchasers. Opposer readily recognizes that the doctrine of foreign equivalents applies when "it is likely that the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Palm Bay Imports, Inc. v. Vieve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005). Although Spanish itself may not be an obscure language, every single word in Spanish is not readily understood by the consuming public. Opposer believes it is a dubious proposition to

expect that merely because a word exists in Spanish that consumers will necessarily have the ability and inclination to stop and translate the word. In this case, it is unlikely that consumers will stop and translate Opposer's "DESIGUAL" Marks. With regard to the meaning of the "DISIDUAL" mark, the Applicant proffers an Interrogatory Response as evidence that "disidual" is meant to be a combination of the words "distinct" and "individual." See Applicant's Response to Opposer's Motion for Summary Judgment, pg. 11. This extrinsic evidence is of little probative value as to how consumers, particularly those who are unfamiliar with the mark, will view Applicant's Mark when they are confronted by the trademark. In the absence of a readily apparent meaning, consumers will be forced to rely more heavily on appearance and sound to interpret the Applicant's Mark and Opposer's Marks. As previously discussed, the slight modifications in spelling and sound are of little significance, and the slight variations between the marks are unlikely to be readily recognized and understood by consumers.

In contrast to the Applicant's position, the law governing likelihood of confusion dictates that the marks are to be compared in their entirety and in connection with the nature of the goods and services on which they are used. *In re National Data Corp.*, 224 USPQ 749, 750 (Fed. Cir. 1985). The reality remains that Applicant's "DISIDUAL" Mark is confusingly similar to Opposer's "DESIGUAL" Marks, because of the overarching similarities between the marks in terms of appearance, sound, connotation, and commercial impression.

- ii. *DuPont Factor Two: The similarity or dissimilarity and nature of the goods or services as described in the application or registration in connection with which a prior mark is in use.*

The goods sold under Applicant's Mark are legally identical to the goods sold under Opposer's Marks, which strongly supports a finding of likelihood of confusion. Furthermore, the Applicant concedes that the goods are commercially related and essentially identical, because the

Applicant's Response to Opposer's Motion for Summary Judgment is wholly devoid of any law, arguments, or evidence, whatsoever, that would contradict Opposer's position that the goods are commercially related and essentially identical. Applicant's "DISIDUAL" Mark is confusingly similar to Opposer's "DESGIUAL" Marks, because of the vast similarities between the marks combined with the fact that both parties sell clothing under their respective marks.

iii. *DuPont Factor Three: The similarity or dissimilarity of established, likely-to-continue trade channels.*

Goods sold under Opposer's "DESIGUAL" Marks and goods sold under Applicant's "DISIDUAL" mark are presumed to move in the same channels of trade, which strongly supports a finding of likelihood of confusion. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (holding that where there are no explicit restrictions as to trade channels and classes of consumers, it is presumed that goods move in all normal channels of trade and to all normal classes of purchasers).

Applicant seeks to differentiate the relevant consumers by introducing extrinsic evidence regarding the use of Applicant's Mark. *See, e.g.*, Opposer's Response to Applicant's Motion for Summary Judgment, pg. 15 and Exhibits B, E. However, it is well-settled, hornbook law that "the scope of the registration applicant seeks is defined by the identification of services in its application and not by its actual use." *In re Tropicana Las Vegas, Inc.*, Serial No. 85450247 (TTAB 2013) (quoting *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Similarly, in considering the scope of the registration, the TTAB will look to the registration itself and not to extrinsic evidence about the registrant's goods and services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958)). The inescapable reality is that the potential consumers of Applicant's clothing are the same set of customers that buy Opposer's clothing. The relevant purchasers of the parties'

marks and the channels of trade for goods under the parties' marks are the same, which supports a finding of likelihood of confusion between Opposer's "DESIGUAL" Marks and Applicant's "DISIDUAL" trademark application.

- iv. *DuPont Factor Four: The conditions under which sales are made and to whom sales are made.*

The goods listed in Applicant's trademark application and Opposer's registrations are marketed and sold to all consumers seeking the goods contained within the respective identification of goods, which supports a finding of likelihood of confusion. Consumers who encounter the clothing sold by the Applicant and Opposer are unsophisticated, the consumers will not tend to exercise a high level of care in acquiring those goods, and the consumers are prone to making impulse purchases. In addition, Applicant's Response to Opposer's Motion for Summary Judgment provides no law, evidence, or arguments to support the proposition that the relevant consumers are sophisticated. The fact that customers will not tend to be sophisticated purchasers weighs in favor of a likelihood of confusion between Opposer's "NATUREX" Marks and Applicant's "NATURX" trademark application.

- v. *DuPont Factor Five: Opposer's "DESIGUAL" Marks are well-known.*

Opposer's marks are well-known to consumers, which supports a finding of likelihood of confusion. Opposer's "DESIGUAL" Marks have been in use in U.S. commerce for approximately twenty years. *See* [Opposer's Notice of Opposition]. Opposer's "DESIGUAL" Marks are widely distributed and consumed across the United States and throughout the world. Applicant postulates that "Opposer [] only provides sales information for a single year, and '[s]uch figures for a single year are not meaningful.'" *See* Applicant's Response to Opposer's Motion for Summary Judgment, pg. 16. In Opposer's Motion for Summary Judgment, Opposer may have merely cited sales

information for one year. However, it is disingenuous to suggest that Opposer only provided sales information for one year. *See* [Wilson Decl. Ex. I: Print out from Opposer's website]. As illuminated by Opposer's website, Opposer sustained annual growth of over 50% between 2007-2010. *Id.* In 2007, Opposer sold 86 million Euros worth of clothing under the "DESIGUAL" trademark. *Id.* That number grew to 162 million Euros in 2008. By 2009, Opposer sold 300 million Euros worth of clothing. And in 2010, goods sold under Opposer's "DESIGUAL" Marks resulted in an annual turnover of 450 million Euros and over 15,000,000 garments sold at over 8,800 points of sale in 72 different countries, including the U.S., as Opposer espoused in its Motion for Summary Judgment. *See* [Opposer's Motion for Summary Judgment, pg. 13].

In an effort to diminish the significance of Opposer's sales, Applicant next cites *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, for the proposition that "evidence of use since 1892, \$5 million in annual sales, and hundreds of thousands of dollars in advertising did not establish fame of RITZ mark." *See* Applicant's Response to Opposer's Motion for Summary Judgment, pg. 16. Applicant fails to recognize that Opposer's sales of 86 million Euros in 2007, 162 million Euros in 2008, 300 million Euros in 2009, and 450 million Euros in 2010 far exceeds the \$5 million annual sales of "RITZ" that were deemed insufficient to prove fame. The fact that Opposer's "DESIGUAL" Marks have significant sales, and goods bearing the mark are widely sold across the United States and throughout the world, bolsters a finding of likelihood of confusion between Opposer's "DESIGUAL" Marks and Applicant's "DISIDUAL" trademark application.

vi. DuPont Factor Six: Actual Confusion.

The actual confusion factor should be considered neutral, because the law does not require Opposer to submit evidence of actual confusion. Applicant seeks to obfuscate issues germane to this proceeding by placing heavy emphasis on the fact that Opposer has not provided evidence of

actual confusion between Applicant's Mark and Opposer's Marks. However, as recognized by the Applicant, the law is clear that "evidence of actual confusion is not necessary to establish a likelihood of confusion." *See* Applicant's Response to Opposer's Motion for Summary Judgment, pg. 14. Moreover, the Board's reviewing court and numerous other circuit courts of appeal hold that not submitting evidence of actual confusion carries very little weight in the likelihood of confusion analysis. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003) ("The lack of evidence of actual confusion carries little weight."); *Audi AG v. D'Amato*, 469 F.3d 534, 543 (6th Cir. 2006) ("[A]lthough such evidence is the best indicator of likelihood of confusion, the absence of actual confusion evidence is inconsequential."); *GMC v. Keystone Auto. Indus.*, 453 F.3d 351, 356-57 (6th Cir. 2006) ("Due to the rarity of this type of evidence ... this factor is weighed heavily only when such evidence exists."); *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1077 (9th Cir. 2006) (holding that "difficulties in gathering evidence of actual confusion make its absence generally unnoteworthy" and that this factor is "in equipoise" when no such evidence is produced). Accordingly, this factor is neutral in terms of a likelihood of confusion analysis.

II. Conclusion

For the foregoing reasons, Opposer's Motion for Summary Judgment should be granted. No genuine issues of material fact have been raised by the Applicant in this proceeding in relation to the issues of priority and likelihood of confusion. Applicant's "DISIDUAL" Mark is confusingly similar to Opposer's "DESIGUAL" Marks in terms of appearance, sound, and commercial impression. Moreover, the goods sold under the respective marks are essentially identical and travel in the same channels of trade. Opposer's "DESIGUAL" Marks have significant sales, and goods bearing the mark are widely sold across the United States and throughout the world. Finally, the consumers who encounter Applicant's Mark and Opposer's Marks are likely to be unsophisticated

and less likely to differentiate between the parties' marks. All of these factors mandate a finding that confusion is likely between Applicant's "DISIDUAL" Mark and Opposer's "DESIGUAL" Marks. Therefore, Opposer respectfully requests that registration of Applicant's "DISIDUAL" mark be denied.

Respectfully submitted,

January 19, 2016

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document is being sent by first class mail on January 19, 2016, to the attorney of record for Applicant at the following address:

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