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

Proceeding	91212768
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTS It Is Not The Same, GmbH,

Opposer,

v.

Disidual Clothing, LLC,

Applicant.

Serial No. 85/836,544

Opposition No. 91212768

Mark: DISIDUAL

**DISIDUAL CLOTHING’S REPLY IN SUPPORT OF ITS  
CROSS-MOTION FOR SUMMARY JUDGMENT**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 528, Applicant Disidual Clothing, LLC (“Disidual”) hereby submits its reply in support of its Cross-Motion for Summary Judgment (“Cross Motion”).

**I. THERE CAN BE NO LIKELIHOOD OF CONFUSION BETWEEN THE DISIDUAL MARK AND OPPOSER’S MARKS.**

As set forth below, the factors relating to the dissimilarities of the parties’ marks, the lack of actual confusion, and the lack of evidence to support the claim that Opposer INTS It Is Not The Same, GmbH’s (“Opposer”) alleged DEZIGUAL marks (“Opposer’s Marks”) are well known outweigh any other *DuPont* factors that purportedly weigh in Opposer’s favor.

**a. The parties’ marks impart a different overall commercial impression based on differences in sight, sound, and connotation.**

Opposer’s contention that the DISIDUAL Mark is confusingly similar to Opposer’s Marks in appearance, sound, connotation, and commercial impression is misplaced.

First, Opposer claims that Disidual improperly dissected the parties’ marks when analyzing the dissimilarities in appearance. *See* Opposer’s Reply in Support of its Motion for

Summary Judgment and Opposer's Response to Applicant's Cross-Motion for Summary Judgment, p. 3 ("Opposer's Response"). Disidual acknowledges that marks must be considered in their entirety for purposes of determining likelihood of confusion. 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 consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749 (Fed. Cir. 1985); *see also* Trademark Manual of Examining Procedure ("TMEP") § 1207.01(b).

Here, a comparison of the parties' marks highlights the dissimilar overall impressions made by the respective marks. Disidual's analysis of the features of the parties' marks and the appropriate weight that may be given to a particular feature was proper because the conclusion rested on a consideration of the entirety of the marks. In particular, Disidual submits that the parties' marks are dissimilar based on the foregoing: (1) the beginning and middle portions of the parties' marks are distinguishable (DE2IG vs. DISID); (2) Opposer's Marks incorporate a bolded or thick font with an inverted "S" and, in some instances, displayed vertically next to a mirror image of DE2IGUAL and two naked figures or a brightly-colored paint splatter design; and (3) the ending -UAL is commonly found in brand names in the apparel industry and on registered marks in Class 25, as evidenced by the chart of -UAL marks submitted with Disidual's Cross Motion. *See* Cross Motion, p. 8. When the various features of the parties' marks are considered in their entirety, it is evident that the parties' marks are dissimilar in appearance.

Contrary to Opposer's position, the case of *Autozone, Inc. v. Tandy Corp.* is, in fact, instructive and applicable in this case because it demonstrates an analysis of the various features of the marks at issue. Specifically, the court noted the differences in the beginning portions of

the parties' marks (AUTO vs. POWER) as well as the "ubiquity of ZONE" in concluding that the marks AUTOZONE and POWERZONE were dissimilar. 373 F.3d 786, 796, 71 U.S.P.Q.2d 1385 (6th Cir. 2004). Moreover, in *Horphag Research Ltd. v. FreeLife Int'l, LLC*, the Trademark Trial and Appeal Board ("Board") concluded that the differences in the prefixes "soy" and "pycno" outweighed the similarity in the common suffix "genol" in finding the marks SOYGENOL and PYCNOGENOL dissimilar. Opposition No. 102797, 1999 WL 651588, \*2 (TTAB Aug. 20, 1999); *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 U.S.P.Q.2d 1381, 2005 WL 3395187 (TTAB 2005) (finding marks CARTAGIO and ONFOLIO dissimilar despite the common suffix "io"). The conclusions reached by the Board in these cases support the same conclusion in this case, namely, that the differences between the beginning and middle portions of the parties' marks (DEZIG vs. DISID) outweighs the similarities in the common suffix UAL when considering the entireties of the marks.

Second, Opposer argues that the parties' marks "elicit similar sounds" and consumers are not likely to pronounce Opposer's Marks as "DES-ee-GWAL." Opposer's Response, pp. 3-4. Opposer provides no evidentiary support for its assertion that consumers will pronounce its marks as "de-sig-ū-uhl." Disidual, on the other hand, submitted evidence that Opposer, the media, and consumers pronounce Opposer's Marks as "DES-ee-GWAL," which comports with the pronunciation of the word in the Spanish language. See Cross Motion, p. 10. Opposer has not provided any support whatsoever to refute Disidual's evidence. Moreover, it is likely that the relevant consumers will pronounce Opposer's Marks the same way that they are pronounced by Opposer and the media. Thus, when the parties' marks are pronounced (de-SI-jew-ul vs. DES-ee-GWAL), the acoustic differences between the marks are significant and result in very different sounding terms.

Third, Opposer claims that the parties' marks fail to convey a specific meaning to consumers because consumers will not stop and translate DEZIGUAL in Opposer's Marks. *See* Opposer's Response, pp. 4-5. Opposer provides no evidence or case law to support its position. The doctrine of foreign equivalents applies where the evidence shows that the relevant English translation is literal and direct. *See In re Eisner*, Serial No. 85/593,854, 2015 WL 6166639 (TTAB Oct. 2, 2015) (applying doctrine of foreign equivalents where "[t]he literal and direct translation of 'su abogado' from Spanish to English is 'your lawyer.'"); *In re Accelerate s.a.l.*, 101 U.S.P.Q.2d 2047, 2012 WL 684459 (TTAB 2012) (applying doctrine of foreign equivalents where "Colombiano" was a direct Spanish translation of the English term "Colombian"); TMEP § 1207.01(b)(vi) ("If the evidence shows that the relevant English translation is literal and direct, and no contradicting evidence of shades of meaning or other relevant meanings exists, the doctrine generally should be applied...").

Here, Disidual submitted dictionary definitions, Opposer's translation statement for its registrations for Opposer's Marks, and Opposer's interrogatory responses to show that the term "desigual" is a direct and literal translation of "unequal" in Spanish. *See* Cross Motion, p. 11. Opposer has not presented any evidence to refute Disidual's assertion nor has it submitted evidence of other relevant meanings. Consequently, Disidual's uncontradicted evidence establishes that the ordinary American purchaser who is knowledgeable in Spanish would stop and translate the term "desigual" to "unequal." *See, e.g., Tatuaje Cigars, Inc. v. Nicaragua Tobacco Imps., Inc.*, Opposition No. 91185180, 2011 WL 6099693, \*3 (TTAB Nov. 22, 2011) (held that consumers would stop and translate "tatuaje" to mean "tattoo" based, in part, on dictionary entries where "tattoo" translated into "tatuaje"); *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d 1645, 2008 WL 695794, \*4 (TTAB 2008) ("The dictionary evidence shows that

‘pilgrim’ is an exact translation of ‘peregrina’. There is no dictionary evidence to the contrary.”). As a result, consumers will tend to distinguish between the parties’ marks because the term DE2IGUAL in Opposer’s Marks has a commonly-understood meaning (*i.e.*, “unequal”) whereas the DISIDUAL Mark is a coined term. *See* Cross Motion, pp. 12-13.

In light of the differences in sight, sound, and connotation, the DISIDUAL Mark and Opposer’s Marks impart different overall commercial impressions, and this factor weighs heavily in Disidual’s favor.

**b. The lack of actual confusion supports a finding of no likelihood of confusion.**

Opposer argues that “[t]he actual confusion factor should be considered neutral, because the law does not require Opposer to submit evidence of actual confusion.” Opposer’s Response, p. 8. While Opposer is correct that evidence of actual confusion is not required, the Board has considered lack of actual confusion as a factor supporting no likelihood of confusion where the parties’ marks have coexisted in the marketplace for a number of years without any instances of actual confusion and where there was ample opportunity for confusion to occur. *See, e.g., Top Tobacco LP v. N. Atl. Operating Co.*, 101 U.S.P.Q.2d 1163, 2011 WL 6099691, \*12 (TTAB 2011) (“Indeed, on this record, we can find that there has been a significant period of time and reasonable opportunity for confusion to have existed. Under such circumstances, the absence of any actual confusion may be probative.”); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 U.S.P.Q. 37, 1981 WL 40439, \*10 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”); *Harry Fischer Corp. v. Keneth Knits, Inc.*, 207 U.S.P.Q. 1019, 1980 WL 30160, \*6-7 (TTAB 1980) (lack of actual confusion supported finding of no likelihood of confusion where both parties operated in the apparel industry).

In this case, the evidence shows that the parties' marks have coexisted since 2010, Opposer admitted that it was not aware of any instances of actual confusion, and the parties sell their products to retailers and consumers in the same geographic areas. *See* Cross Motion, p. 13. Specifically, both Disidual and Opposer sell to consumers or retailers in at least the following cities: San Francisco, California; Los Angeles, California; Truckee, California; Portland, Oregon; and Seattle, Washington. *See id.* at p. 14. Further, Opposer stated that "potential consumers of Applicant's clothing are the same set of customers that buy Opposer's clothing" and "[t]he relevant purchasers of the parties' marks and the channels of trade for goods under the parties' marks are the same." *See* Opposer's Response, pp. 6-7. Disidual's evidence and Opposer's statements support the conclusion that there was ample opportunity for confusion to occur.

In light of the above, the lack of actual confusion is relevant in this case and this factor weighs in Disidual's favor.

**c. Opposer failed to submit sufficient evidence to prove that Opposer's Marks are well known.**

Opposer has not met its burden of clearly proving that Opposer's Marks are well known. "It is the duty of a party asserting that its mark is famous to clearly prove it." *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 2007 WL 749713, \*5 (TTAB 2007). The party must submit evidence to prove that its marks are well known or famous rather than provide mere unsubstantiated allegations. Opposer's evidence presented to the Board consists of the following:

- One-page printout from Opposer's website listing its retail locations in the United States (Opposer's INTS It Is Not The Same, GmbH's Motion for Summary Judgment (Opposer's Motion), Wilson Decl. Exh. J);
- One-page printout from Opposer's website stating that Opposer's goods sold under Opposer's Marks in 2010 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 countries, including the US (Opposer's Motion, Wilson Decl. Exh. I); and

- One-page printout from Opposer's website listing global sales between 2007-2010 (Opposer's Motion, Wilson Decl. Exh. I).

As demonstrated above, the only evidence that Opposer submitted is self-serving printouts from its website. Moreover, Opposer does not indicate what fraction of its sales occurred in the U.S. The fact that Opposer had a certain amount of annual sales is meaningless without any indication as to how these sales impacted consumer recognition of Opposer's Marks in the U.S.

In the case of *The North Face Apparel Corp. v. Sanyang Industry Co., Ltd.*, the opposer's evidence of fame was largely based on its sales and advertising figures. 116 U.S.P.Q.2d 1217, 2015 WL 6467820 (TTAB 2015). Although the annual sales were in the millions of dollars, the Board concluded that the opposer failed to establish that its marks were famous because the sales figures did not provide any context, they did not reflect how the sales were broken down by goods, and the figures were not limited to advertising in the United States. *Id.* at \*7-8; *see also The Crazy Horse Mem'l Found. v. Spencer*, Opposition No. 91204980, 2014 WL 976890, \*11-13 (TTAB Feb. 26, 2014) (evidence of sales in 2012, use for over 60 years, and more than 1.3 million visitors each year was insufficient to establish fame because the Board was unable to gauge the degree of exposure of the mark and any consequential recognition).

Opposer's purported evidence suffers from the same deficiencies experienced by the opposer in the *The North Face Apparel Corp.* case. Specifically, the raw sales figures simply are not enough to establish any context for consumer recognition of Opposer's Marks in the U.S. Consequently, this factor is at most neutral but should weigh against Opposer.

**d. The remaining *DuPont* factors are not enough to outweigh the dissimilarities between the parties' marks and the lack of actual confusion.**

Opposer claims that the goods sold under the DISIDUAL Mark and Opposer's Marks are commercially related, the parties' goods travel in the same channels of trade, and the relevant consumers are unsophisticated. Opposer's Response, pp. 5-7. Assuming *arguendo* that these factors lean in Opposer's favor, they are still insufficient to overcome the factors weighing in Disidual's favor, namely, the dissimilarities between the parties' marks and the lack of actual confusion. Even if the Board were to assume that the "remaining *DuPont* factors" favored Opposer, the lack of actual confusion becomes more significant and probative. It would stand to reason that if the parties offered the same products within the same channels of trade and to the same, unsophisticated consumers under (according to Opposer) similar marks for years, there would have been instances of actual confusion in the marketplace. The fact that there have been no such instances of confusion strongly suggests that there is no likelihood of confusion between the parties' marks.

Under similar circumstances, the Board has concluded that notwithstanding that the goods at issue were related and traveled in the same channels of trade, the differences in the parties' marks were sufficient to find no likelihood of confusion. *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (affirming dismissal of opposition and concluding that the dissimilarity of the marks alone precluded any reasonable likelihood of confusion); *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (affirming finding of no likelihood of confusion based on dissimilarity of the marks FROOT LOOPS and FROOTEE ICE & Design). In light of Disidual's arguments and evidence proving the dissimilarities of the parties' marks and the lack

of actual confusion, Disidual submits that these dispositive factors are enough to support a finding of no likelihood of confusion.

## **II. CONCLUSION**

There is no likelihood of confusion between the DISIDUAL Mark and Opposer's Marks based on the dissimilarities between the parties' marks and the lack of any actual confusion. These factors outweigh any factors that purportedly weigh in Opposer's favor. Consequently, Disidual respectfully requests that the Board grant Disidual's Cross Motion, dismiss Opposer's Notice of Opposition, and grant such further relief as this Honorable Board deems appropriate.

Respectfully submitted,

Dated: February 8, 2016

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**CERTIFICATE OF SERVICE**

The undersigned affirms that DISIDUAL CLOTHING'S REPLY IN SUPPORT OF ITS CROSS-MOTION FOR SUMMARY JUDGMENT was served by first class mail, postage prepaid, on the date set forth below upon the following:

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Dated: February 8, 2016

/Craig A. Beaker/  
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