

This Opinion is not a
Precedent of the TTAB

Mailed: March 10, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Retail Royalty Company

v.

The University of Houston System

Opposition No. 91217413

Charles H. Hooker, III of Kirkpatrick Townsend & Stockton LLP for
Retail Royalty Company.

Jennifer S. Sicker Thompson & Knight LLP for
The University of Houston System.

Before Bergsman, Wellington and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

The University of Houston System (“Applicant”) has filed an application seeking
to register the mark:



for the following goods and services:

Print materials, namely, magazines, technical publications in the nature of journals and articles, sports guides, teaching materials in the field of business, accounting, engineering, science, legal, medical, health science, literature, history, and math research, business, accounting, engineering, science, legal, medical, health science, literature, history, and math education and athletics, and course materials in the field of business, accounting, engineering, science, legal, medical, health science, literature, history, and math research, business, accounting, engineering, science, legal, medical, health science, literature, history, and math education and athletics; printed souvenir programs concerning sports, graduation, and academic events; pens; pen sets; pencils; erasers; pencil toppers, namely, decorative pencil-top ornaments; loose leaf binders; bookmarks; book covers; address books; appointment books; calendars; photographic albums; art photographs, namely, photographs that have been computer manipulated and enhanced to contain graphic elements; photographs; lithographs and prints in the nature of pictures, photographs, and artistic drawings; paper banners; paper pennants; printed paper handheld signs; paper bags; magnetic boards; billboards, namely, advertising signs of paper or cardboard; paper notepads; note pad holders; scrapbooks; catalogs in the field of academic and athletic courses and academic and athletic goods; series of nonfiction books in the field of business, accounting, engineering, science, legal, medical, health science, literature, history, and math research, business, accounting, engineering, science, legal, medical, health science, literature, history, and math education and athletics; newsletters in the field of business, accounting, engineering, science, legal, medical, health science, literature, history, and math research, business, accounting, engineering, science, legal, medical, health science, literature, history, and math education and athletics; notebooks; composition books; picture books; binders; stationery type portfolios; paper gift wrap; blank cards; paper gift cards; greeting cards; business cards; writing paper; note paper; postcards; decals; paper labels; bank checks; checkbook covers; rubber stamps; prepaid telephone calling cards, not magnetically encoded; credit cards without magnetic encoding; transferable temporary tattoos; bumper stickers; stickers; posters; party goods, namely, paper party favors, paper napkins and paper party decorations; desk accessories, namely, baskets for desk accessories, desk pads, file trays, desktop organizers, desktop planners, desktop revolving rotary card files, desktop business card holders, and desk calendars; paperweights; letter openers[;] and printed paper labels for bottled water; letter openers of precious metal; coasters of paper, in International Class 16;

Mugs, cups, cork coasters, souvenir plates, waste baskets, and bottle openers, in International Class 21;

Clothing, namely, shirts, pants, hats, scarves, sweat pants, sweat shirts, jackets, raincoats, sweaters, underwear, pajamas, socks, sandals, flip flops, shoes, and slippers, in International Class 25; and

Educational services, namely, providing college and graduate level courses of instruction, continuing education courses and seminars in [a variety of fields of learning]; educational services, namely, providing opportunities in the nature of internships and exchange programs for students to participate in educational research programs in [a variety of fields of learning]; entertainment services, namely, providing college athletic and sporting events in the fields of football, basketball, soccer, hockey, tennis, volleyball, track and field, and baseball; entertainment services, namely, live performances of dramatic works and live musical performances, in International Class 41.¹

Retail Royalty Company (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. Opposer pleads, *inter alia*, ownership of Registration No. 3878197 (hereinafter referred to as the “197 registration”) for the silhouette of a bird shown below:²



(hereinafter referred to as the “Flying Eagle Design Mark”) for the following goods and services:

¹ Application Ser. No. 86038277, filed on August 14, 2013, based upon Applicant’s allegation of first use anywhere and in commerce on November 1, 2012, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), for all classes of goods and services. The mark is described in the application as “consist[ing] of a stylized hawk above the letters ‘UHCL’, which are above the word ‘HAWKS’ in stylized font.”

² 1 TTABVUE 9.

Body cream, cologne, perfume, liquid soaps for body, in International Class 3;

Athletic bags, backpacks, barrel bags, beach bags, book bags, duffel bags, shoulder bags, tote bags, clutch purses, coin purses, drawstring pouches, handbags, purses, and wallets, in International Class 18;

Clothing and accessories, namely, blazers, vests, sweaters, turtleneck sweaters, skirts, pants, jeans, shorts, shirts, t-shirts, blouses, polo shirts, rugby shirts, sweatshirts, sweatpants; swimwear; sleepwear; underwear, namely, boxer shorts, shell bra tanks, and undershirts; outerwear, namely, jackets, vests, coats, pea coats, gloves, scarves; belts; footwear, namely, socks, shoes, slippers, leather boots, sandals, flipflops, sneakers, clogs and slides; canvas shoes, headwear, namely, hats, caps, baseball caps, [and] visors, in International Class 25;

Retail store services, computerized online retail store services, and phone order services all featuring a wide range of goods in the nature of fragrances, personal care goods; sunglasses; jewelry and wristwatches; a wide range of bags and wallets, handbags, purses, shoulder bags, school bags, backpacks, duffel bags; and wearing apparel and clothing accessories, namely, clothing, headwear and footwear, in International Class 35.

Opposer also pleads common law rights in its Flying Eagle Design Mark, as well as the marks AMERICAN EAGLE OUTFITTERS and an “AMERICAN EAGLE family of marks” for “a broad range of lifestyle products” and that it uses these marks “extensively on its products and in connection with its Internet and retail sales.”³ Specifically, Opposer pleads that: it first opened a retail store in 1977 and now “more than 850 of these retail stores are located in the United States”;⁴ its stores “prominently feature its [Flying Eagle Design Mark]”; Opposer “prominently features

³ *Id.* at 6-7.

⁴ *Id.*

its Flying Eagle Design in its advertising and on billboards”;⁵ “among the products [Opposer] has sold under ... the Flying Eagle Design Mark specifically, are clothing and accessories, including shirts, t-shirts, shorts, sweatshirts, outerwear, jackets, sleepwear, footwear, backpacks, purses, and book bags” and it “also uses the Flying Eagle Design Mark extensively in connection with its retail and online retail services selling these products”;⁶ it “offers numerous products that are affiliated with colleges and universities” and “also sponsors a variety of collegiate and university themed events”;⁷ “[i]n addition to featuring the Flying Eagle Design Mark prominently in its advertising, AEO regularly uses that mark on gift cards and packaging, including shopping bags.”⁸

Opposer pleaded that Applicant’s use of the applied-for mark is likely to cause confusion and that “there is no issue as to priority” because Opposer “began using its Flying Eagle Design Mark in commerce at least as early as August 2003, well prior to the August 14, 2013 filing date of Applicant’s Application and Applicant’s claimed first use date of November 1, 2012.”⁹

Applicant, in its answer, admits that Opposer is the “record owner” of its pleaded registration, but otherwise denies the remaining salient allegations in the Notice of Opposition. Applicant also pleads what it called “affirmative defenses.”¹⁰

⁵ *Id.*

⁶ *Id.* at 7.

⁷ *Id.* at 8.

⁸ *Id.*

⁹ *Id.* at 11.

¹⁰ 9 TTABVue. Several of these are not actual affirmative defenses. In any event, Applicant

Both parties filed briefs,¹¹ and Opposer filed a reply brief.

The Record

The record includes the pleadings and, by way of Rule 2.122, the file of the involved application.

The parties stipulated that “each party may submit declarations to authenticate documents they have produced in discovery through disclosure or under Fed. R. Civ. P. 34” and “submit trial testimony by declaration during their trial periods, provided the opposing party will have the opportunity to cross-examine any witness that provides a testimony declaration.”¹²

During its initial trial period, Opposer filed six notices of reliance introducing the following materials:¹³ copies of its pleaded ‘197 registration, including a copy from the Office’s TESS electronic database showing the current status of and title to the

did not pursue them at trial and we have not considered them further. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013).

¹¹ Opposer filed a main trial brief that was designated “confidential” in its entirety (56 TTABVUE). A redacted copy of the brief for public viewing, as required by Rule 2.126(c), was not filed. See also TBMP 810.03; *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); *Duke University v. Haggard Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000) (redacted copy deleting confidential matters must be filed). While in such cases the Board may require the party that does not file a redacted copy to do so, we exercise our discretion in this case and choose not to do this. Nevertheless, we will treat as confidential only such information as is truly confidential. *See Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (the Board will not be bound by improper confidentiality designations); Trademark Rule 2.116(g) (amended effective January 14, 2017 to codify the Board’s practice of treating as public material that cannot reasonably be considered confidential).

¹² 47 TTABVUE. Although the stipulation was not filed until April 27, 2016, during Applicant’s trial period, we construe it as pertaining to all trial periods. By its own terms, the stipulation allows testimony by declaration to be submitted “during their [the parties’] trial periods.”

¹³ 23-25 and 27-29 TTABVUE.

registration;¹⁴ copies of nineteen (19) other registrations owned by Opposer, including electronic copies from the TESS database;¹⁵ Internet printouts comprising copies of Opposer’s SEC filings;¹⁶ Internet printouts intended to show “public’s exposure to information about Opposer and [its] Flying Eagle Design marks and brand” as well as Opposer’s other marks general recognition, “particularly among teens and young adults”;¹⁷ Internet printouts intended to show “Opposer’s support of programs for high school and college students, and Opposer’s marketing efforts aimed at consumers 15–25 years of age”;¹⁸ and Internet printouts showing “representative examples of unsolicited print publications concerning” Opposer and its marks.¹⁹

Applicant, during its trial period, submitted two testimony declarations of Theresa Presswood, the Executive Director of Communications for the University of Houston – Clear Lake (UHCL), a “component” of Applicant.²⁰ Applicant also filed seven notices of reliance introducing the following materials:²¹ a copy of the involved application file;²² a copy of the registration file for Opposer’s pleaded ‘197

¹⁴ 23 TTABVUE.

¹⁵ 24 TTABVUE.

¹⁶ 25 TTABVUE.

¹⁷ 27 TTABVUE.

¹⁸ 28 TTABVUE.

¹⁹ 29 TTABVUE.

²⁰ 43-44 (Presswood declaration “regarding the business records of [Applicant]”), and 48 TTABVUE (second Presswood declaration).

²¹ 30-46 and 48 TTABVUE. Copies of materials from a notice of reliance (“number 5”) and designated “confidential” are found at 45-46 TTABVUE and are not accessible to the public.

²² 30-31 TTABVUE.

registration;²³ copies of one-hundred nineteen (119) third-party registration certificates for marks containing bird designs;²⁴ copies of thirty-four (34) applications from the Office’s TSDR electronic database for marks containing bird logos;²⁵ a Wikipedia excerpt with information about Applicant and copies of Internet printouts from various websites or online publications involving Opposer;²⁶ Internet printouts purportedly showing “representative examples of Opposer’s competitors who use bird silhouette logos as trademarks”;²⁷ and copies of Opposer’s responses to Applicant’s admission requests nos. 1-2, 13-14, 16-20, 24-25, 29, and 36-39, and to Applicant’s interrogatory nos. 4-5.²⁸

During its rebuttal trial period, Opposer introduced the testimony declaration of Steve Kubinski, Vice President of Marketing Operations at American Eagle Outfitters, Inc., Opposer’s parent company, with accompanying exhibits.²⁹

I. Background

Applicant is a university system in Texas comprising four universities, one of which is located on a nature reserve in the Clear Lake community and is identified as the University of Houston – Clear Lake or “UHCL” for short.³⁰ UHCL was

²³ 31 TTABVUE.

²⁴ 31-33 TTABVUE.

²⁵ 34 TTABVUE.

²⁶ 35-41 TTABVUE.

²⁷ 40 TTABVUE.

²⁸ 42 TTABVUE.

²⁹ 49-53 TTABVUE.

³⁰ Presswood Decl. (48 TTABVUE 6).

established in 1974 as an upper-level institution and in 2014 began offering “freshman/sophomore coursework, officially beginning its transition to a four-year institution.”³¹ UHCL currently has approximately 8,665 students.³² Applicant’s proposed mark is a “mascot logo” and was introduced in the spring of 2012 after a process that began in 2010 and was based on input from students, alumni, faculty, staff and the community.³³ Applicant contracted with an advertising agency to “develop art for the new HAWK mascot logo” and Applicant’s proposed mark has been in continuous use for the goods and services identified in the Application since November 1, 2012.³⁴

Opposer, through its affiliated companies which includes American Eagle Outfitters, Inc. (“AEO”), has used its Flying Eagle Design Mark in connection with retail store services featuring clothing and accessories, as well as on clothing. AEO opened its first retail store in 1977 and now operates over 800 retail stores in the United States, including 62 stores in Texas and 10 in the greater Houston area.³⁵ AEO has prominently advertised its Flying Eagle Design Mark by itself as well as with the wording “American Eagle”, in advertising its goods and services. Opposer began using its Flying Eagle Design Mark “at least as early as 2004.”³⁶ AEO uses its

³¹ *Id.* at 7.

³² *Id.*, Exhibit 156.

³³ *Id.*

³⁴ *Id.* at 8.

³⁵ Kubinski Decl. (49 TTABVUE 11).

³⁶ *Id.* at 12.

Flying Eagle Design Mark on “gift cards and packaging, including shopping bags.”³⁷ AEO markets its goods and services through “back to school” promotions and other programs targeting college students, including its Flying Eagle Design Mark appearing “prominently on t-shirts and other materials distributed and used at ... colleges and universities.”³⁸

II. Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show “both a ‘real interest’ in the proceedings as well as a ‘reasonable basis’ for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing in Board proceedings. *Ritchie*, 50 USPQ2d at 1030. Here, the issue of Opposer’s standing is not in dispute; in any event, we find Opposer has demonstrated that it is more than a mere interloper and has a real interest in and standing to bring this proceeding. Particularly, we rely on the testimony by declaration of Mr. Kubinski regarding Opposer’s use of the Flying Eagle Design Mark through its affiliate, AEO,

³⁷ *Id.* at 14.

³⁸ *Id.* at 18.

and Opposer's ownership of the '197 registration for the Flying Eagle Design Mark, a copy of which has been properly introduced.³⁹

III. Priority

As demonstrated by the parties' arguments in their briefs, there appears to be some confusion whether priority is at issue in this proceeding.

Opposer's '197 Registration

With respect to Opposer's '197 registration and the goods and services identified in that registration, priority is not in issue. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). That is, Opposer need not prove prior use of its registered mark in connection with the goods and services identified in the registration vis-à-vis Applicant's use of its applied-for mark in connection with the goods and services described in the Application. *Id.*

Opposer's Pleaded Common Law Rights

In order for Opposer to rely on its pleaded common law rights in its Flying Eagle Design Mark for goods or services beyond the scope of its pleaded registration, it must prove use of its mark prior to any date that Applicant may rely upon. Applicant, for its part and for purposes of priority, may, at the very least, rely on the filing date of the involved application, *i.e.*, July 14, 2013. *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010); *see also, J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). Through the declaration of Ms. Presswood, Applicant has established that its proposed mark has been in continuous use for the

³⁹ 23 TTABVUE.

goods and services identified in the Application since November 1, 2012.⁴⁰ Opposer does not dispute this date of first use for Applicant's goods and services. Thus, in order for Opposer to prevail on its likelihood of confusion based on goods or services based on its common law rights, Opposer must establish it first used its mark on those goods or services prior to November 1, 2012. With this in mind, we now address Opposer's prior common law use of its Flying Eagle Design Mark. In doing so, we do not discuss the entirety of Opposer's alleged prior, common law use of its mark. Rather, we analyze Opposer's purported common law rights in connection with goods and services that are relevant to our likelihood of confusion analysis, namely, those that may have a relationship to Applicant's identified goods and services and possibly serve as a basis for finding a likelihood of confusion.

With this in mind, we address Opposer's alleged prior use, through its affiliate AEO, of the Flying Eagle Design Mark in connection with various goods that it asserts are the same or closely related to goods listed in Classes 16 and 21 of the involved application. Specifically, Opposer argues that the "hundreds of [AEO] retail stores and [AEO] ecommerce website long since have carried a broad range of paper goods under the Flying Eagle Design Mark, including stationery, notebooks, notepads, sticky notes, thank you notes, and journals" and that AEO "has used its Flying Eagle Design Mark on or in connection with paper bags, billboards, advertising signs of paper or cardboard, newsletters, paper labels, and credit cards, among other goods

⁴⁰ See Note 34.

listed in the Application.⁴¹ Opposer also argues that “AEO has used its Flying Eagle Design Mark on, *inter alia*, the very mugs, cups, and waste baskets that Applicant seeks to register in International Class 21, as well as related products such as bulletin boards, magazine racks, and picture frames.”⁴² In support, Opposer relies on the following averments of Steve Kubinski, AEO’s vice president for marketing operations:

7. While AEO has perhaps been best known as an apparel company for college-aged and young adults, its website and stores have carried a broad range of products, including paper goods such as stationery, notebooks, and journals, as well as other accessories one might find in a college bookstore such as bulletin boards, magazine racks, picture frames, mugs, cups, waste baskets, umbrellas, and iPhone cases. True and correct depictions of AEO retail store layouts showing such items are attached as Exhibit 4.

10. AEO also prominently features its Flying Eagle Design, which it began using at least as early as 2004, on billboards, including its widely publicized and well-known billboard above its flagship retail store in New York’s Times Square (as depicted below).



Further representative examples of AEO’s use of its Flying Eagle Design Mark in and on its retail stores and on out-of-home advertising platforms (such as billboards, bus sides, bus shelters, and subway cars) are attached as Exhibit 7.

⁴¹ 56 TTABVUE 43.

⁴² Id. at 43-44.

15. In addition to featuring the Flying Eagle Design Mark prominently in its advertising, AEO regularly uses that mark on gift cards and packaging, including shopping bags.



True and correct copies of representative examples of such use of the Flying Eagle Design Mark are attached as Exhibit 14.

A review of Mr. Kubinski's entire testimony, in conjunction with the referenced exhibits, does not show that Opposer uses its Flying Eagle Design Mark as a source identifier for the mentioned goods themselves. Rather, the evidence shows that Opposer's Flying Eagle Design Mark is being used to advertise Opposer's retail stores services. For example, Opposer's use of the mark on the Times Square billboard, shown above, is an advertisement for Opposer's retail store services, not to indicate the source of the billboard itself. Moreover, the referenced Kubinski Exhibit 4 contains photographs of "AEO retail store layouts" and merely shows accessories or other the types of goods, *e.g.*, mugs, books, notebooks, iPhone cases, etc., that may be found in Opposer's retail stores, aside from clothing. For example:⁴³

⁴³ 49 TTABVUE 474-476.





W3C NESTING TABLE TOP

left side plexi bins (back to front, L-R)

cube 1

1718-400 notepad
1716-300 notepad

cube 2

1960-001 jimmy fallon thank you notes

cube 3

1717-200 notepad

cube 4

1815-400 notepad
1816-400 notepad *

cube 5

1974-001 iPhone case

cube 6

1817-400 notepad

cube 7

1794-600 iPhone case

cube 8

1974-900 iPhone case
1864-100 music branch

cube 9

1974-500 iPhone case

cube 10

2006-900 slang flash cards

cube 11

1818-800 sticky notes
1819-400 sticky notes
1822-700 sticky notes
1823-600 sticky notes
1820-395 sticky notes
1819-395 sticky notes
2007-600 sticky notes
2008-700 sticky notes

cube 12

2009-900 sticky notes
2010-900 sticky notes

rectangular accessory bin

1974-900 iPhone case
1974-001 iPhone case
1974-500 iPhone case
1974-600 iPhone case

1760-300 solar powered charger
1760-615 solar powered charger
1760-700 solar powered charger

place

1838-900 fantastic plastic cameras
1876-615 camera
2004-900 awkward family photos

right side plexi bins (back to front, L-R)

cube 13

1720-100 USB hub man

cube 14

1721-100 snap frame

cube 15

1865-100 USB hub dog

cube 16

1876-615 camera

cube 17

1879-001 camera

cube 18

1876-001 camera

cube 19

1877-900 film

cube 20

1768-100 camera

cube 21

1784-900 film

W3C NESTING TABLE - LEFT SIDE

wire basket (L-R)

8147-410 umbrella
8147-001 umbrella
8147-300 umbrella



W3C NESTING TABLE - RIGHT SIDE

wire basket (L-R)

8147-500 umbrella
8147-615 umbrella
8147-100 umbrella





W3C NESTING TABLE BOTTOM

rectangular accessory bin

- 1996-400 journal
- 1996-900 journal
- 1996-700 journal
- 1996-500 journal

white table tray

- 1830-800 ceramic mug
- 1830-100 ceramic mug
- 1830-400 ceramic mug
- 1830-300 ceramic mug

rectangular accessory bin

- 1859-900 notebook
- 1855-900 notebook
- 1859-900 notebook
- 1861-100 notebook

place

- 1994-400 journal
- 1992-100 30-day method
- 1994-900 journal

The photographs do not show the Flying Eagle Design Mark being used on the goods or in a manner consistent with use on the goods. At most, in reviewing Mr. Kubinski's testimony and related exhibits, the record demonstrates that Opposer uses its Flying Eagle Design Mark in connection with retail store services primarily in connection with clothing, but these stores also sell other goods, including some of those listed in Classes 16 and 21 of the opposed application. Opposer has prior use of the Flying Eagle Design Mark in connection retail store services, which include the

sale of the aforementioned accessory goods, inasmuch as it began using its Flying Eagle Design Mark for these services long before Applicant's first use date in 2012.

With respect to services, Opposer acknowledges that it is not an educational institution like Applicant, but asserts it has prior common law rights in its Flying Eagle Design Mark in connection with services that target the same collegiate community. Specifically, Opposer asserts that its affiliate AEO has "extensively has used its Flying Eagle Design Mark in connection with a variety of collegiate athletic events and scholarships and educational and community service programs offered to, and designed to resonate with, college students," and that AEO "sponsored collegiate athletic tournaments, given 'scholar-athlete' awards, and sponsored entertainment venues and services."⁴⁴ Again, because Opposer's '197 registration does not cover these services, Opposer must demonstrate use (prior to November 2012) of the Flying Eagle Design Mark in connection with these services.

On the record before us, however, the only service for which Opposer has demonstrated some prior use of its Flying Eagle Design Mark involves an agreement with a collegiate sports conference to assist in the promotion of that conference.⁴⁵ In

⁴⁴ 56 TTABVUE 45.

⁴⁵ Although Mr. Kubinski states in his declaration that Opposer's affiliate AEO has engaged in other services, *i.e.*, providing scholarships to student-athletes, organizing essay-writing contests, organizing community service events, and sponsoring entertainment events, including musical concerts, the record does not establish that the Flying Eagle Design Mark was used in connection with these services or, if it was, that the use occurred before November 2012. For example, in paragraph 38 of his declaration (49 TTABVUE 25), Mr. Kubinski avers that the Flying Eagle Design Mark is used prominently in connection with AEO's "naming rights" for the "Stage AE" in Pittsburgh (including a photograph); however, there is no testimony or additional evidence establishing this use began prior to November 2012. Likewise, although Kubinski Exhibit 33 contains information and references to Opposer's offering of scholarships to student-athletes in conjunction with its affiliation with

particular, Opposer entered into a “sponsorship” agreement with the Big East Conference of college sports teams in 2010.⁴⁶ The evidence of Opposer’s use of its flying eagle mark in connection with this activity, however, is limited. Indeed, the only evidence that appears to associate the flying eagle mark with the Big East Conference, before November 2012, is the following photograph of the billboard above AEO’s Times Square store in New York City:⁴⁷



the Big East Conference, there is no evidence showing the Flying Eagle Design Mark used in connection with these services. Thus, for these services, Opposer did not establish prior common law rights in its Flying Eagle Design Mark.

⁴⁶ 52 TTABVUE 292 (Kubinski Exhibit 33).

⁴⁷ *Id.* at 301.

Other photographs of the same billboard merely consist of recognition of the teams in the Big East Conference without the Flying Eagle Design Mark present, e.g.:⁴⁸



With respect to the nature of the service, the article containing the above image describes the relationship as “[t]he Big East maintains ad space on the American Eagle Outfitters store in Times Square” and that “this is the space typically used to

⁴⁸ *Id.* at 329.

congratulate the various Big East conference champions or other special conference events.”⁴⁹ In essence, the service involves Opposer assisting the conference in promoting the conference and its teams by placing advertisements on the billboard above its American Eagle store, and we find this was done before November 2012.

In sum, with respect to Opposer’s proven acquisition of common law rights in the Flying Eagle Design Mark prior to November 2012, we find that these include retail store services that, despite the primary focus on clothing, include selling accessory goods that include some of the same goods listed in Classes 16 and 21 of the involved application. In addition, Opposer acquired prior common law rights in its flying eagle mark in connection with a service that, as described above, involves assisting the Big East collegiate sports conference in promoting the conference and its teams through the placement of advertisements or congratulatory messages on the billboard above Opposer’s store in New York City.

IV. Likelihood of confusion

Our determination of the issue of likelihood of confusion under Section 2(d) of the Trademark Act 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, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

Strength/ Weakness of Opposer’s Flying Eagle mark

⁴⁹ *Id.*

Opposer does not specifically argue that its Flying Eagle Design Mark is famous, but does assert that the mark is “strong and entitled to broad protection,” as a result of “widespread use, extensive advertising, and strong sales.”⁵⁰ In support, Opposer has presented impressive evidence regarding the extent to which Opposer, through its affiliate AEO, has advertised its brands, including AMERICAN EAGLE, AMERICAN EAGLE OUTFITTERS, and the Flying Eagle Design Mark (presented either in conjunction with the other marks or by itself). Opposer’s net U.S. sales figures have gradually increased in the years 2010-2015 and are substantial (over \$3 Billion in 2015). Although there is ample evidence of use of the Flying Eagle Design Mark and that AEO stores sell goods other than clothing, it clear from the record that the focus of AEO’s business is on the brand name AMERICAN EAGLE or AMERICAN EAGLE OUTFITTERS in connection with retail clothing. For example, evidence regarding “Most Valuable U.S. Retail Brands [for 2011]” lists “AMERICAN EAGLE OUTFITTERS” in 38th position and describes the company as a “retailer [that] offers high quality ‘American prep meets current fashion.’”⁵¹ A couple more references include, “Although teen apparel brand American Eagle Outfitters fell a bit in the ranking this year ...”⁵² and as “a retailer of casual wear.”⁵³ On the other hand, AEO has a very strong presence in social media advertising, including “over 11 million followers on Facebook, over 700,000 on Twitter, and over 2 million on

⁵⁰ 56 TTABVUE 33-35.

⁵¹ 51 TTABVUE 459.

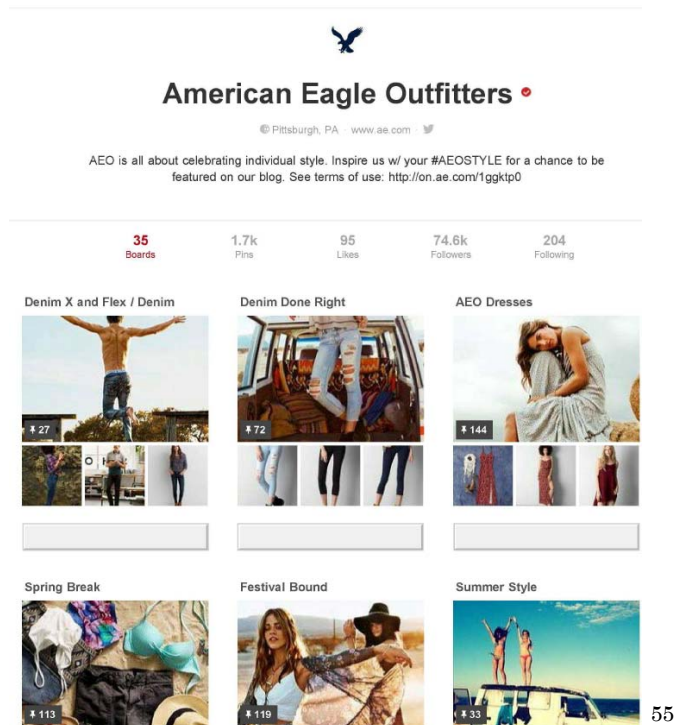
⁵² *Id.* at 520.

⁵³ *Id.* at 536

Instagram” and the flying eagle mark is prominently displayed in many of the messages that AEO sends. For example:



and



⁵⁴ 50 TTABVUE 112.

⁵⁵ *Id.* at 130.

Again, however, although the Flying Eagle Design Mark is displayed in AEO's social media advertising, it is being used and viewed almost exclusively in the context of AEO's apparel or retail apparel services. The evidence, including the testimony of Opposer's witness, does not show that Opposer's Flying Eagle Design Mark has a strong commercial presence or consumer recognition outside the field of retail clothing goods and services.

Applicant, on the other hand, argues that “[a]ny rights that [Opposer] may claim in its eagle design mark are dramatically weakened by its coexistence in the marketplace with numerous third party bird design marks,” referencing the evidence it submitted showing third-party registrations of marks with bird logos covering apparel goods.⁵⁶ Applicant also relies on website printouts it submitted for clothing retailers Hollister (owned by Abercrombie & Fitch) and Eddie Bauer “as representative examples of [Opposer's] competitors that are large retailers who use bird silhouette marks for general retail, including clothing.”⁵⁷ Applicant asserts “[c]ustomers have become so conditioned to numerous bird marks in the marketplace that they have been educated to distinguish between such marks on the basis of small distinctions.”⁵⁸

Evidence of the extensive registration and use of similar marks by others can be “powerful” evidence of a mark's weakness. *Cf. Jack Wolfskin Ausrüstung Fur*

⁵⁶ 57 TTABVUE 24.

⁵⁷ *Id.*

⁵⁸ *Id.* at 25.

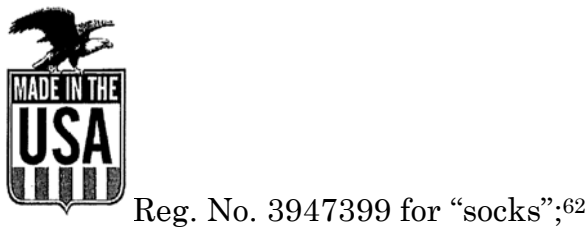
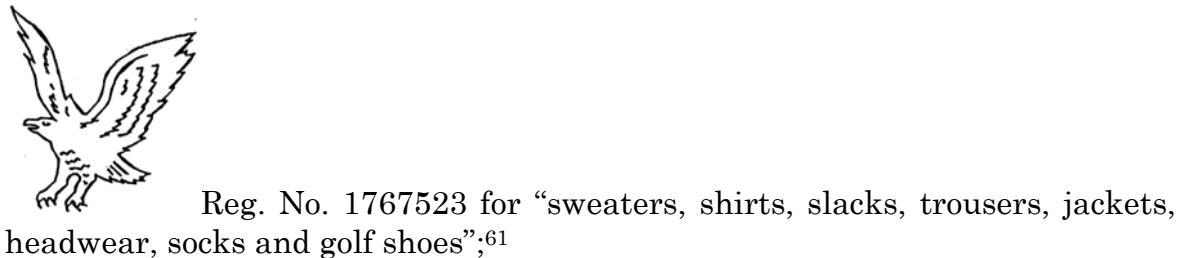
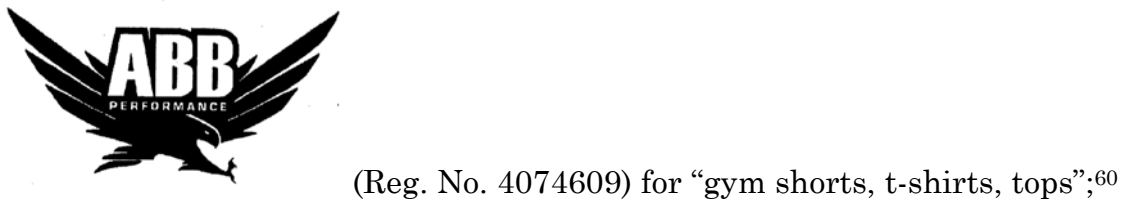
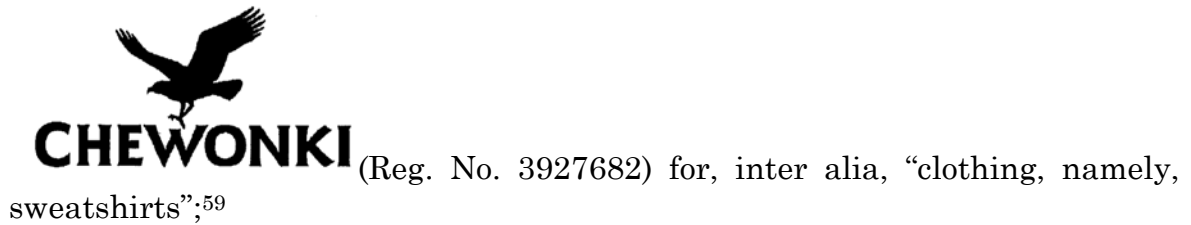
Draussen GmbH & Co. v. Millennium Sports, S.L.U., 116 USPQ2d at 1136; *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). However, third-party registrations such as those offered by Applicant are not evidence of actual *use* of the marks. *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). As the Federal Circuit pointed out in *Juice Generation*, “the strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). “The weaker [the Registrant's] mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted); *see also Palm Bay*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”).

“In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.”

American Lebanese Syrian, 101 USPQ2d at 1028 (citing *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) and *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2011) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates

the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”)).

Of the numerous third-party registrations for marks containing a bird logo submitted by Applicant, we find the following as bearing the closest resemblance to Opposer’s (or Applicant’s) bird logo:



⁵⁹ 32 TTABVUE 9.

⁶⁰ *Id.* at 11.

⁶¹ *Id.* at 36.

⁶² 33 TTABVUE 31.



Reg. No. 4552764 for, inter alia, “shirts, tops, shorts, pants, [and] jeans”;⁶³



Reg. No. 4487134 for “clothing, namely, t-shirts and shirts”;⁶⁴



Reg. No. 4548481 for “men’s, women’s and children’s clothing, namely, hats ... shirts”;⁶⁵



Reg. No. 4382221 for “baseball caps and hats”;⁶⁶

⁶³ *Id.* at 35.

⁶⁴ *Id.* at 49

⁶⁵ *Id.* at 53.

⁶⁶ *Id.* at 71.



Reg. No. 4271697 for, inter alia, “clothing, namely, shirts”;⁶⁷



Reg. No. 4291319 for, inter alia, “boxer briefs ... jackets ... polo shirts, shorts, sweat pants, t-shirts tank tops”;⁶⁸



Reg. No. 4337318 for “clothing, namely, ... shirts, sweat shirts, ... hats ... t-shirts, shorts, pants, sweaters, sleepwear, boxer shorts, socks, women’s blouses, skirts and dresses”;⁶⁹ and



Reg. No. 4235047 for “hunting apparel, namely, ... pants, shirts, jackets and vests.”⁷⁰

With respect to the evidence of actual third-party use of bird logos in connection with retail clothing, Applicant submitted only two such uses:

⁶⁷ *Id.* at 73.

⁶⁸ *Id.* at 79.

⁶⁹ *Id.* at 81.

⁷⁰ *Id.* at 87.



[from the Hollister website www.hollister.com];⁷¹

and



[from the Eddie Bauer website www.eddiebauer.com].⁷²

Upon review of the record before us, we are not persuaded that Opposer's Flying Eagle Design Mark is commercially weak based on third-party registration and use of similar bird logo marks. Although Applicant submitted approximately 120 third-party registrations for marks containing bird logos, we have identified the twelve that we believe come the closest to Opposer's mark and, as is evident, only a few of these can be characterized as bearing a strong resemblance to either Opposer's or Applicant's bird logo. The registrations obviously show that it is not uncommon for others to seek to adopt a mark containing a bird design in connection with clothing; however, the registrations further reflect the availability of an array of bird designs that can be used in marks and do not necessarily bear a resemblance to each other. Indeed, with the exception of a few, we find none of the registered marks bear a strong

⁷¹ 41 TTABVUE 2.

⁷² *Id.* at 5.

resemblance to either Opposer's or Applicant's mark. With respect to the website printouts showing actual use, we note that the Hollister bird appears to be a seagull in flight and the Eddie Bauer logo appears to be a duck in flight. These two uses thus have little in common with the involved bird logos. The record, here, may be distinguished from the third-party registration and use evidence in *Juice Generation*, where there were at least twenty-six *relevant* third-party uses or registrations of record, *see* 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, where there were at least fourteen, 116 USPQ2d at 1136 n. 2.

In sum, with respect to the argued strength and weakness of Opposer's Flying Eagle Design Mark, we find that Opposer has demonstrated that this mark has had significant exposure in connection with retail clothing. Moreover, we find no measurable weakness with respect to Opposer's particular bird logo, the Flying Eagle Design Mark. There are simply too few registered marks, and no evidence of third-party use of marks, that are significantly similar to Opposer's Flying Eagle Design Mark. At best, a showing has been made that it is not uncommon to adopt a bird logo in connection with clothing.

Similarity or Dissimilarity of the Parties' Marks

We turn now to the *du Pont* factor of the similarity or dissimilarity of the marks in terms of their appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The proper test is not based on consumers having the luxury of a side-by-side comparison of the marks, as they appear below,

but “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) (citation omitted).

The obvious similarity in the marks is Applicant’s incorporation of a bird logo in its mark which bears a resemblance to Opposer’s Flying Eagle Design Mark. Both marks depict a bird that is landing or attacking in the same direction (from right to left) with its talons out and wings outstretched. There are, however, noticeable differences between the bird logo in Applicant’s mark and Opposer’s Flying Eagle Design Mark. Opposer’s mark is presented purely as a silhouette with few details whereas Applicant’s bird logo has several discernable characteristics – it is possible to view the outlines of the feathers, head and talons. It is also possible to identify an ‘angry’ or menacing look in the bird’s eye and the beak is open in Applicant’s mark.

The more obvious and significant distinguishing feature of Applicant’s composite mark is the presence of the literal terms, UHCL HAWKS. Although these terms appear beneath the bird logo, we have long found that when evaluating a composite mark containing both words and a design, the verbal portion of the mark often is the one most likely to indicate the origin of the goods to which it is affixed because it is the portion of the mark that consumers would use to refer to or request the goods or services. *In re Viterra Inc.*, 101 USPQ2d, 1905, 1908 (Fed. Cir. 2012). In contrast to Opposer’s mark, consumers viewing Applicant’s mark will have an initialism and word that they can use to help identify the source of the goods and services.

As far as the commercial impressions and connotations of the marks, we note each mark depicts a strong bird and thus may be suggestive of the bird's independence or freedom. However, we cannot ignore the presence of the literal terms UHCL HAWKS in Applicant's mark which, for consumers aware that Applicant is an affiliate of the University of Houston or for consumers viewing this mark in connection with education services, will likely be understood as identifying the school's abbreviated name and its mascot.⁷³ Even for consumers who are unaware of Applicant's status as an institute of higher learning and viewing the mark not in the context of the educational services, the terms UHCL HAWKS will impart a meaning that is not present in Opposer's mark. Consumers may perceive UHCL as an arbitrary abbreviation identifying the source of the goods and HAWKS as identifying the bird depicted in the mark.

In sum, we find that the marks are overall more dissimilar than they are similar. We hasten to add, however, that the issue of similarity of the marks is not a binary question. As Professor McCarthy explains:

The degree of similarity of the marks needed to prove likely confusion will vary with the difference in the goods and services of the parties. Where the goods and services are directly competitive, the degree of similarity required to prove a likelihood of confusion is less than in the case of dissimilar products.

⁷³ It is certainly not unheard of for universities to have bird mascot logos; to wit, Opposer's own evidence includes the following example (52 TTABVUE 313):



McCarthy on Trademarks and Unfair Competition § 23:20.50 (4th ed. 2017), citing to *In re Viterra Inc.*, 101 USPQ2d at 1912 (“It is also well established that, when the goods at issue are identical, the degree of similarity necessary to support a conclusion of likely confusion declines”) (internal citation omitted); *In re Mighty Leaf Tea*, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (noting Board’s recognition that when conflicting marks appear on virtually identical goods, less similarity is needed for confusion to occur, and affirming Board’s decision finding confusion likely between applicant’s ML for personal care products and the cited registration for ML MARK LEES for a competitive skin care product), as well as other Federal Circuit and Board decisions.

Here, we do not find the marks to be so different that confusion is unlikely under any circumstances, including when their use is on identical goods.

Relatedness of the Goods and Services

We now consider the *du Pont* factor involving “the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.” *Du Pont*, 177 USPQ at 567. Moreover, “it is not necessary that the goods or services be identical or even competitive in nature in order to support a finding of likelihood of confusion, it being sufficient that the goods or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks employed thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.” *In re Home Builders Ass’n of Greenville*, 18

USPQ2d 1313, 1317 (TTAB 1990). The issue is not whether consumers will confuse the goods, but whether they will confuse the source of the goods. *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015); *Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1189 (TTAB 2014) (“The issue, of course, is not whether purchasers would confuse the goods or services, but rather whether there is a likelihood of confusion as to the source thereof.”).

Opposer need not demonstrate a relationship between its goods and services with all of the goods or services listed in the involved application to support a finding of likelihood of confusion. Rather, we may find confusion is likely for each class of goods and services in the Application based on any item that comes listed in that class. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Bond v. Taylor*, 119 USPQ2d 1049, 1052-53 (TTAB 2016). With this point in mind, we address the Application’s classes of goods and services individually.

Classes 16 and 21

Applicant’s goods in Class 16 consist of a variety of print materials, such as magazines, as well as other various goods like pens, book covers, billboards, and different types of books. Applicant’s goods in Class 21 are “mugs, cups, cork coasters, souvenir plates, waste baskets, and bottle openers.”

As described in the priority section, Opposer uses its Flying Eagle Design Mark in connection with retail store services primarily featuring clothing, but also involving the sale of certain goods like those listed in Classes 16 and 21 of the application, such as certain stationary-type goods, as well as mugs, cups and waste

baskets. However, the record before us in this case does not demonstrate that it is common for a single entity to provide retail clothing store services and offer goods, like Applicant's in Classes 16 and 21, under the same mark. We therefore find no obvious or demonstrated relationship between Opposer's retail store services and Applicant's goods listed in Classes 16 and 21. Accordingly, the factor involving the relatedness of the Applicant's goods and Opposer's services weighs in favor of finding no likelihood of confusion for these classes.

Class 25

There is no dispute that many, if not all, of Applicant's clothing goods in Class 25 of the Application are identical to goods covered by Opposer's '197 registration. Accordingly, the factor involving the relatedness of the goods weighs strongly in favor of a finding of likelihood of confusion for Class 25. We also keep in mind, as discussed with cited authority *supra*, that when marks would appear on identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. See also, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Moreover, because the goods described in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. See *In re Viterra Inc.*, 101 USPQ2d at 1908 (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and

classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese*, 101 USPQ2d at 1028.

Class 41

With respect to Applicant's educational and entertainment services, these include "entertainment services, namely, providing college athletic and sporting events in the fields of football, basketball, soccer, hockey, tennis, volleyball, track and field, and baseball ... [and] live performances of dramatic works and live musical performances." Opposer's services, on the other hand and as described in the section involving priority, involve placing advertisements or congratulatory messages for the Big East collegiate sports conference on the billboard above its retail store in New York City.

On their face, the parties' services may appear to be related in that they involve collegiate sports. However, that is where the relationship ends. It has not been shown that Opposer's mark will be encountered at the actual athletic competitions or how consumers would otherwise be exposed to the marks in a manner whereby confusion as to source could actually occur. Although a consumer interested in these collegiate games would naturally be attracted to advertisements placed on Opposer's Times Square billboard, without more, the consumer would necessarily believe Opposer was involved with the service of providing entertainment. There is no evidence indicating that a single entity would render these two types of services. Accordingly, the factor involving the relatedness of the Applicant's educational and entertainment services

with Opposer's service weighs in favor of finding no likelihood of confusion for this class.

Trade Channels and Relevant Consumers

As discussed, *supra*, Opposer's clothing is identical to Applicant's goods in Class 25 and we must presume the trade channels for those goods will be the same.

We cannot, however, make the same trade channel assumption with respect to the parties' other goods and services because they are not identical; any assertion that the trade channels are similar for these goods and services must be supported with evidence. In this regard, Opposer submitted evidence showing that it has made serious efforts to market its clothing and retail clothing store services on college campuses. Opposer argues that these "extensive marketing efforts that AEO makes on college and university campuses—and toward college students generally—are seen by graduate students as well," and these are the "same demographic characteristics of UHCL's students."⁷⁴

The record does not show that Opposer's clothing or retail store services will be marketed in the same trade channels as Applicant's goods in Classes 16 and 21, or its entertainment and educational services in Class 41. Thus, we cannot find a similarity in trade channels favors a finding of likelihood of confusion with respect to these classes of goods and services. On the other hand, there is relevant evidence showing that Opposer's retail clothing store services and Applicant's goods and services are aimed at a same single class of consumers, namely, college students. To

⁷⁴ 56 TTABVUE 47.

the extent that both parties' goods and services have a focus on the same class of purchasers, this favors a finding of a likelihood of confusion.

Relative Sophistication of Consumers

Opposer argues that "consumers in the market for the parties' goods are unlikely to devote the time and effort necessary to remedy the confusion resulting from the similarity of the marks, substantially increasing the likelihood of such confusion."⁷⁵ We agree with Opposer to the extent that many of Applicant's listed goods in Classes 16 (*e.g.*, stationary items), 21 (*e.g.*, mugs) and 25 (*e.g.*, socks) may be relatively inexpensive and we can assume consumers will not make their purchasing decisions with a higher level of care. To the contrary, these goods may be the subject of impulse purchases and this increases the likelihood of confusion. The record does not support a finding in this regard in connection with Applicant's Class 41 services and this factor remains neutral in connection with these services.

Balancing of the Factors - Conclusions

Upon consideration of all relevant *du Pont* factors, we make the following conclusions.

With respect to Classes 16 and 21 of the involved application, Opposer has not demonstrated that Applicant's continued use of its mark on the goods listed in these classes causes a likelihood of confusion with any goods or services for which Opposer has prior rights in its Flying Eagle Design Mark. We make this conclusion based primarily on our findings involving the differences in the marks and there being no

⁷⁵ *Id.*

demonstrated tangible relationship between the involved goods and services other than Opposer's stores carrying some of the same goods that are identified in the Application. We make this finding in spite of the relatively inexpensive nature of the goods in these classes and the possibility that impulse purchasing may take place.

As to Class 25, we find that although the marks are overall more dissimilar than similar, when they are used on the identical apparel goods, like those listed in the involved application and Opposer's '197 registration, there is a likelihood of confusion. We make this decision keeping in mind these same goods will be found in the same trade channels and offered to the same classes of consumers.

With respect to Class 41, we find no likelihood of confusion between Applicant's continued use of its mark in connection with educational and entertainment services and Opposer's use of its Flying Eagle Design Mark in connection with its service of assisting a collegiate conference in promoting itself and the teams within the conference by placing advertisements on a billboard above its store. We make this conclusion based primarily on our findings involving the differences in the marks and there being no demonstrated connection between these services other than each involving collegiate sports. Particularly, the evidence does not support a finding that consumers would be inclined to believe that a single entity would provide the same services under the same mark.

Decision: The opposition is sustained with respect to Class 25. The opposition is dismissed with respect to Classes 16, 21 and 41. Applicant's application will proceed

to issuance of a registration solely in connection with the goods and services identified in Classes 16, 21, and 41.

Dissent By:

Bergsman, J., dissenting.

I respectfully dissent from the majority's decision to sustain the opposition with respect to Class 25.

The majority found that the marks are more dissimilar than similar expressly stating that there are "noticeable differences between the bird logo in Applicant's mark and Opposer's Flying Eagle Design Mark." Without a threshold similarity of the marks, it is unnecessary to even consider the other factors. *See Kellogg Co. v. Pack'em Enter. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed Cir. 1991) ("We know of no reason, why, in a particular case, a single *DuPont* factor may not be dispositive."). In *Kellogg Co. v. Pack'em Enter. Inc.*, the Board held that the dissimilarity of the marks made it unlikely that confusion would occur from the simultaneous use of the marks. *Id.* Likewise, in this case, if the marks are not similar, there cannot be a likelihood of confusion.

To the extent that the majority is finding that the marks are dissimilar when used in connection with the goods in Classes 16, 21, and 41, but similar when used in connection with the goods in Class 25, I still dissent because I find that the marks are dissimilar. Applicant's mark bears no more resemblance to Opposer's Eagle Design Mark than any of the other bird designs discussed in the analysis of the strength of Opposer's Eagle Design Mark. As the majority noted, Applicant is part of

the university system of Texas. It is common knowledge that so many universities and colleges use bird names and mascots (*e.g.*, Boston College, American University, and Emory University Eagles; U.S. Air Force Academy and Bowling Green Falcons; Marquette and Oral Roberts University Golden Eagles; Iowa Hawkeyes; Monmouth, St. Joseph's and SUNY New Paltz Hawks; Kansas Jayhawks; Temple and Rice Owls; Miami University Red Hawks; and Ball State, Catholic, Louisville (see footnote 75), and SUNY Plattsburgh Cardinals, etc.) printed on Class 25 clothing items that Applicant's mark would be understood as identifying Applicant and not Opposer.

Accordingly, I would dismiss the opposition with respect to the goods in Class 25.