

This Opinion is Not a
Precedent of the TTAB

Mailed: December 1, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Alfwear Inc.

v.

Shuff
—

Opposition No. 91224467
—

Trent Baker of Baker & Associates PLLC and S. Brandon Owen of Ray Quinney & Nebeker P.C., for Alfwear Inc.

Eric C. Wood and Thomas A. Kulick of Scheef & Stone, L.L.P.,
for Daniel Shuff.

—
Before Bergsman, Wellington and Larkin,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Daniel Shuff (“Applicant”) seeks registration on the Principal Register of the mark
KU:L (stylized), shown below, for “bicycles,” in Class 12.¹



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¹ Application Serial No. 86595716 was filed on April 13, 2005, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

Alfwear Inc. (“Opposer”) filed an opposition against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles Opposer’s federally registered trademarks KUHL, KÜHL, and KUUL for lip balm, clothing, bottled water, and fabrics, as to be likely to cause confusion. Specifically, Opposer pleaded ownership of the following registrations:

- Registration 1990375 for the mark KÜHL (stylized), shown below,



for the following goods:

Rugged outdoor clothing, namely, jackets, shirts, pants, shorts, t-shirts, and hats, in Class 25; and

Bottled water, in Class 32.²

The registration includes the following translation statement: “The English translation of the mark is ‘cool.’”

- Registration No. 3916866 for the mark KÜHL (standard characters) for “belts; bottoms; hats; pants; shirts; shorts; tops,” in Class 25.³ The registration includes the following translation statement: “The English translation of ‘Kühl’ is ‘cool.’”

- Registration No. 4441177 for the mark KUHL (standard characters) for the following goods:

Lip balm, in Class 3;

² Registered July 30, 1996; second renewal.

³ Registered February 8, 2011; Sections 8 and 15 declarations accepted and acknowledged.

Belts; bottoms; hats; jackets; pants; shirts; shorts; tops; fabric sold as an integral component of finished clothing, namely, belts, bottoms, hats, jackets, pants, shirts, shorts and tops, in Class 25; and

Bottled water, in Class 32.⁴

The registration includes the following translation statement: “The English translation of ‘Kühl’ in the mark is ‘cool.’”⁵

•Registration No. 4777532 for the mark KUUL (standard characters) for the following goods:

Textile fabrics for the manufacture of clothing, in Class 24; and

Belts; bottoms; hats; jackets; pants; shirts; shorts; tops, in Class 25.⁶

Opposer also pleaded that Applicant’s mark is likely to dilute the distinctiveness of Opposer’s marks pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

I. Preliminary Issues

A. Clarifying Opposer’s likelihood of confusion claim.

In its Notice of Opposition, Opposer pleaded that it has a family of “Kühl” marks,⁷ and that Applicant’s mark is likely to cause confusion with that family.⁸ Opposer did not allege that Applicant’s mark is likely to cause confusion with any of the marks in

⁴ Registered November 26, 2013.

⁵ We note that Opposer’s mark is KUHL not “Kühl.”

⁶ Registered July 21, 2015.

⁷ Notice of Opposition ¶¶7-10, 14-17, and 21-23 (1 TTABVUE 9-13).

⁸Notice of Opposition ¶21 (1 TTABVUE 12).

Opposer's pleaded registrations. However, in their briefs, both parties identified likelihood of confusion with the individual marks in Opposer's pleaded registrations as an issue and not likelihood of confusion with Opposer's alleged "KÜHL" family of marks.⁹ Accordingly, we deem the pleadings to be amended by the parties' express consent pursuant to Fed. R. Civ. P. 15(b)(2) to assert both a family of marks argument and arguments that Applicant's mark is confusingly similar to the marks in each of Opposer's pleaded registrations.

B. Whether Opposer has a family of "Kühl" marks?

The Federal Circuit, our primary reviewing court, defines a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods....

* * *

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). A family of marks is created by use, not registration. *See Polaroid*

⁹ Opposer's Brief, p. 6 (39 TTABVUE 7) and Applicant's Brief, p. 1 (43 TTABVUE 6).

Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419, 420-21 (CCPA 1965) (ownership and registration of a number of marks containing a common feature is not sufficient to create a family of marks); *Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160, 162 (TTAB 1983) (“Ownership of two registrations containing a common word is not sufficient per se to create the exclusivity under the ‘family of marks’ doctrine.”).

Opposer primarily uses KÜHL or KÜHL (stylized), as shown below:



Opposer uses the name KUHL to promote KÜHL products on social media but there is no evidence that Opposer uses KUHL on any products and the use of KUHL and KÜHL together is sporadic at best.¹⁰ There is no testimony or evidence showing the use of KUUL. Evan Shapiro, Opposer’s Vice President, and Melanie Webb, Opposer’s Marketing Director, testified regarding Opposer’s use of KÜHL. They did not refer to KUHL or KUUL.¹¹ The most that can be said is that Opposer uses both KUHL and KÜHL, but it does not have a family of marks. *See Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984) (“That Colony has a number of marks combining HOB0 with another word does not establish any rights of Colony in the word HOB0 as a ‘family’ name.”); *The Land-O-Nod Co. v. Paulison*, 220 USPQ

¹⁰ Webb Decl. Exhibit D, E, F, G, J and K (27 TTABVUE 143-147 and 28 TTABVUE 3-9, 54-58, 60, 63, 72, 74). *See also* REI.com advertising the sale of KUHL clothing (30 TTABVUE 51-55).

¹¹ 26 TTABVUE and 27 TTABVUE.

61, 66 (TTAB 1983) (opposer “had a ‘couple’ of marks, not a ‘family’”). In other words, Opposer is using a couple of variations of its KÜHL mark without promoting a KÜHL family of marks. *See, e.g., Int’l Diagnostic Tech., Inc. v. Miles Labs., Inc.*, 746 F.2d 798, 223 USPQ 977 (Fed. Cir. 1984) (Opposer proved its ownership of a family of marks ending with a “Stix” suffix comprising N-MULTISTIX-C, N-MULTISIX SG, CHEKSTIX, and C-STIX); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) (Opposer proved its ownership of a “fish” family of marks comprising SAILFISH SPORTABOUT, ALCORT SUNFISH, ALCORT CATFISH, and FLYING FISH); *Motorola, Inc. v. Griffiths Elec., Inc.*, 317 F.2d 397, 137 USPQ 551 (CCPA 1963) (Opposer proved its ownership of a family of “Golden” marks comprising GOLDEN VOICE, GOLDEN VIEW, GOLDEN BEAM, GOLDEN HEART, GOLDEN M, and GOLDEN SATELLITE).

In view of the foregoing, Opposer has not shown that it has a family of marks.

Because Opposer’s **kühl** mark for “rugged outdoor clothing, namely, jackets, shirts, pants, shorts, t-shirts, and hats” (Registration 1990375) is closer to Applicant’s mark **KU:L** for “bicycles” than any of the marks in Opposer’s other pleaded registrations, we concentrate our likelihood of confusion and dilution analysis on Opposer’s KÜHL (stylized) mark.¹² In other words, if we do not find a likelihood of confusion on the basis of Opposer’s KÜHL (stylized) mark, we would not

¹² There is no testimony or evidence regarding whether Opposer’s KÜHL bottled water is related to Applicant’s KU:L bicycles.

find a likelihood of confusion on the basis of the marks in Opposer's other pleaded registrations. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. The record also includes the following items:

A. Stipulation

The parties stipulated to the admissibility of the discovery depositions of the following people:¹³

1. Applicant;
2. Michael S. Pifer, Applicant's customer;
3. Eric Robert Lorentz, a freelance web developer;
4. Omar Mejia, an independent designer; and
5. JoAnne Lythgoe, Opposer's graphic designer.

B. Opposer's testimony and evidence.

1. Notice of reliance on Opposer's pleaded registrations printed from the USPTO electronic database showing their current status and title;¹⁴
2. Notice of reliance on twenty-four (24) third-party registrations showing the same mark registered for clothing and bicycles;¹⁵

¹³ 17 TTABVUE.

¹⁴ 18 TTABVUE 8-41.

¹⁵ 18 TTABVUE 54-116. This notice of reliance was filed a second time at 24 TTABVUE.

3. Notice of reliance on thirty (30) third-party websites showing the sale of bicycles and clothing by the same entity.¹⁶ Ten (10) of the third-party websites show the same mark used to identify clothing and bicycles.
4. Notice of reliance on excerpts from the discovery deposition of Applicant;¹⁷
5. Notice of reliance on excerpts from the discovery deposition of Michael Pifer, Applicant's customer;¹⁸
6. Notice of reliance on excerpts from the discovery deposition of Omar Mejia, an independent designer;¹⁹
7. Declaration of JoAnne Davidson, an individual who went into a REI store in New York City and photographed bicycles and messenger bags;²⁰
8. Declaration of Evan Shapiro, Opposer's Vice President;²¹
9. Declaration of Melanie Webb, Opposer's Marketing Director;²²
10. Notice of reliance on excerpts from the discovery deposition of JoAnne Lythgoe, Opposer's graphic designer;²³ and
11. Notice of reliance on the following items:
 - a. Excerpts from the REI websites (newsroom.rei.com and rei.com)

¹⁶ 19 TTABVUE.

¹⁷ 21 TTABVUE.

¹⁸ 22 TTABVUE.

¹⁹ 23 TTABVUE.

²⁰ 25 TTABVUE.

²¹ 26 TTABVUE.

²² 27-28 TTABVUE.

²³ 29 TTABVUE.

purportedly to provide information regarding Opposer's largest customer;²⁴

b. Excerpts from the Back Country website (backcountry.com), one of Opposer's customers;²⁵

c. Excerpts from Twitter.com purportedly to show "the number of Twitter followers of an individual who tagged Alfwear in one of his tweets";²⁶

d. Excerpts from Scheels.com, one of Opposer's customers;²⁷

e. Excerpts from Eastern Mount Sports website (ems.com), one of Opposer's customers;²⁸ and

f. Excerpts from GanderMountain.com, one of Opposer's customers.²⁹

C. Applicant's testimony and evidence.³⁰

1. Notice of reliance on excerpts from the discovery deposition of Eric Lorentz, a freelance web developer;³¹

²⁴ 30 TTABVUE 7-55.

²⁵ 30 TTABVUE 58-66.

²⁶ 30 TTABVUE 68-73. We could find no reference to Opposer in this document.

²⁷ 30 TTABVUE 75-76.

²⁸ 30 TTABVUE 78-79.

²⁹ 30 TTABVUE 81-82.

³⁰ Excerpts from Applicant's discovery deposition and the Lythgoe, Mejia, and Pifer depositions were introduced by Opposer. Once testimony and evidence has been introduced, it may be relied upon by either party for any purpose permitted by the Federal Rules of Evidence. Trademark Rule 2.120(k)(7), 37 C.F.R. § 2.120(k)(7). It need not be introduced a second time.

³¹ 34 TTABVUE.

2. Notice of reliance on excerpts from the discovery deposition of JoAnne

Lythgoe;³²

3. Notice of reliance on excerpts from the discovery deposition of Omar Mejia;³³

4. Notice of reliance on excerpts from the discovery deposition of Michael

Pifer;³⁴ and

5. Notice of reliance on excerpts from the discovery deposition of Applicant.³⁵

III. Standing

Because Opposer's pleaded registrations have been made of record, Opposer has established its standing in this proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

IV. Priority

Because Opposer has properly made of record its pleaded registrations, and because Applicant has not filed a counterclaim to cancel any of Opposer's pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the marks and the goods covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

³² 35 TTABVUE.

³³ 36 TTABVUE.

³⁴ 37 TTABVUE.

³⁵ 38 TTABVUE.

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and

relatedness of the goods”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 303 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The strength and fame of Opposer’s KÜHL (stylized) mark.

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. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2017) (“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.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

1. The inherent strength of Opposer’s KÜHL trademark.

KÜHL is the German word for “cool.” Because KÜHL is likely to be pronounced as “Cool,” consumers are likely to associate KÜHL with the slang word “Cool.” *See* the discussion *infra*. The word “cool” is defined, *inter alia*, as a slang term for “great;

fine; excellent: *a real cool comic*,” or “acceptable; satisfactory; okay: *If you want to stay late, that’s cool.*”³⁶ Accordingly, when KÜHL is used in connection with clothing, it is suggestive and, therefore, inherently distinctive. As noted above, Opposer has made of record its pleaded KÜHL registrations which are not subject to any counterclaims for cancellation. The registrations are “prima facie evidence of the validity of the registered mark[s] and the mark[s], of owner’s ownership of the mark[s], and of the owner’s exclusive right to use the registered mark[s] in commerce on or in connection with the goods or services specified in the certificate.” Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

2. The commercial strength of Opposer’s KÜHL trademark.

Opposer alleges that its KÜHL mark has become “a unique and famous identifier of the Opposer’s goods”³⁷ and argues that the evidence supports finding that Opposer’s mark is famous.³⁸ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use.

A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker*

³⁶ *Dictionary.com* based on the **Random House Dictionary** (2017). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

³⁷ Notice of Opposition ¶¶10 and 13 (1 TTABVUE 10-11).

³⁸ Opposer’s Brief, pp. 28-34 (39 TTABVUE 29-35).

Toys, Inc. v. Rose Art Indus. Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

“[L]ikelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed Cir. 2017) (quoting *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003))). Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Although raw numbers of product sales and advertising expenses sometimes suffice to prove fame, raw numbers alone may be misleading. Some context in which to place raw numbers may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668

F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Opposer introduced the following evidence to prove that KÜHL is a famous mark:

1. Opposer has been using the KÜHL mark since 1993.³⁹ While long use of a mark is indicative of commercial success, it is not conclusive evidence of fame. *Cf. In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (applicant's use of the product designs ranging from seven to seventeen years is insufficient to bestow acquired distinctiveness); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (finding evidence submitted by applicant insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, *inter alia*, continuous and substantially exclusive use for sixteen years, deemed "a substantial period but not necessarily conclusive or persuasive").
2. Opposer has used the KÜHL mark on 300 styles of outdoor wear per season;⁴⁰
3. In 2012, Opposer had \$33 million dollars in retail sales.⁴¹ Opposer has not provided any context for this figure, so we cannot measure it against other brands. Because Opposer has provided sales figures for one year, we do not know whether the 2012 revenues were an outlier or part of a trend. Also, we

³⁹ Shapiro Decl. ¶13 (26 TTABVUE 6).

⁴⁰ Shapiro Decl. ¶¶14 and 22 (26 TTABVUE 6 and 7).

⁴¹ Shapiro Decl. ¶36 (26 TTABVUE 8). The Shapiro testimony did not expressly divide the sales between U.S. and international sales. For purposes of determining whether Opposer's mark is famous, we will give Opposer the benefit of the doubt and interpret the sales as being sales in the United States.

do not know how many units of clothing the revenues comprise or how many different customers purchased Opposer's KÜHL branded clothing.

4. In 2015, Opposer sold over one million pairs of pants.⁴² Opposer has not provided any context for this figure, so we cannot measure it against other brands. Also, because Opposer has provided the number of KÜHL branded pants that were sold for one year, we do not know whether the 2015 sales of pants were an outlier or part of a trend. Moreover, we cannot determine what percentage of Opposer's sales pants comprise.
5. From 2012 through 2016, Opposer spent nearly \$9 million on marketing and advertising.⁴³ Opposer has not provided any context for this figure, so we cannot measure it against other brands. Further, \$9 million over 5 years is approximately \$1,800,000 per year. While \$1,800,000 per year in advertising and marketing is not insignificant, it is not such an impressive figure as to corroborate Opposer's claim that its KÜHL mark is famous, especially because the only advertising referred to in Opposer's testimony is sponsoring a competitive bicycle team, a bicycle race and social media. *See* the discussion *infra*.
6. One of Opposer's promotional efforts is sponsoring a competitive bicycle team that, from 2011 through 2013, competed in California, Idaho, Pennsylvania,

⁴² Shapiro Decl. ¶37 (26 TTABVUE 8). The Shapiro testimony again did not expressly divide the sales between U.S. and international sales. For purposes of determining whether Opposer's mark is famous, we will again give Opposer the benefit of the doubt and interpret the sales as being sales in the United States.

⁴³ Webb Decl. ¶7 (27 TTABVUE 7).

Michigan, Wisconsin, Illinois, Colorado, Kentucky, Ohio, Iowa, and Utah.⁴⁴ The team wore jerseys that displayed the KÜHL trademark.⁴⁵ Since 2010, Opposer has been an official sponsor of the Larry H. Miller Tour of Utah and has supplied uniforms to competitors.⁴⁶ In 2016, that tour had 400,000 spectators, more than 28 hours of national television coverage, and almost 700,000 webpage visits.⁴⁷ The evidence that we are lacking with respect to Opposer's sponsorship programs is how many impressions its mark is making. Opposer's Exhibit L is not broken down by sponsor. It stretches credulity to argue that all 400,000 spectators and 700,000 webpage visitors saw the KÜHL trademark and we will not speculate as to the effectiveness of Opposer's marketing.

7. Opposer's KÜHL branded products are distributed throughout the United States by over 1,000 retailers, including REI, Scheels, Gander Mountain, and Eastern Mountain Sports, as well as online retailers;⁴⁸
8. In 2016, Opposer's website received 1,304,808 user visits.⁴⁹ Opposer has not provided any context for this figure, so we cannot measure it against how many website visits its competitors may have received. Also, because Opposer only

⁴⁴ Shapiro Decl. ¶¶17 (26 TTABVUE 7); Webb Decl. ¶¶69 and 72 (27 TTABVUE 14).

⁴⁵ Webb Decl. ¶71 (27 TTABVUE 14).

⁴⁶ Webb Decl. ¶¶58, 59, and 61 (27 TTABVUE 12-13).

⁴⁷ Webb Decl. ¶¶62 and Exhibit L (27 TTABVUE 13 and 28 TTABVUE 76).

⁴⁸ Shapiro Decl. ¶¶16, 26, 27, 33 and 34 (26 TTABVUE 6, 7, and 8).

⁴⁹ Webb Decl. ¶10 (27 TTABVUE 7).

provided the number of website visits for 2016, we cannot determine whether the number of website visits in 2016 was an outlier or part of a trend. Finally, the testimony does not indicate whether the number of user visits were from different individuals or multiple visits from the same individuals.

9. Opposer sends email blasts to 200,000 customers.⁵⁰ Opposer has not provided any further information, *e.g.*, regarding the number of recipients who opened Opposer's emails or deleted the emails without looking at them.
10. Opposer has an active social media presence on Facebook, Instagram, Twitter and YouTube. For example, Opposer's Facebook page had 31,129 "likes" and 30,558 followers; Opposer's Instagram account has 8,145 followers; and its YouTube channel had 342,838 views.⁵¹ Opposer has not provided any context for these figures, so we cannot measure them against other brands. We are simply without enough information to determine the degree to which Opposer's Facebook "likes" and followers, Instagram followers, and YouTube views are significant.
11. Opposer has been the subject of four online news articles.⁵² They are listed below:
 - a. "From Ski Bum to Ski Empire: Meet KÜHL founder Kevin Boyle and his amazing team," was posted on *UtahStories.com* December 14, 2016.⁵³ The

⁵⁰ Webb Decl. ¶14 (27 TTABVUE 8).

⁵¹ Webb Decl. ¶¶22-56 (27 TTABVUE 9-12).

⁵² Webb Decl. ¶93 and Exhibits GG (27 TTABVUE 18 and 28 TTABVUE 184-207).

⁵³ 28 TTABVUE 184.

author writes that KÜHL is one of the most successful outdoor retail brands in the world and that it is the second largest independently-owned outdoor clothing company anywhere.

- b. “Kühl continues to grow strong from its original roots,” was posted on June 14, 2016 on *GrassRootsOutdoors.com*.⁵⁴ The article is a profile about Opposer highlighting its status as an independently-owned company.
- c. “About Utah: Company founder has come a long way from living in a snow cave,” was posted on July 17, 2016 on *DesertNews.com*.⁵⁵ This is a profile about Mr. Boyle, Opposer’s founder. The author states that Opposer “is now one of the largest privately owned businesses in the outdoor industry.”
- d. “Marketplace: To elevate brand, Kühl turns to Main Street,” was posted September 2, 2016 on *ParkRecord.com*.⁵⁶ The article is a report regarding Opposer’s opening a retail store in Park City, Utah.

The statements regarding the success and renown of Opposer are not accepted as proven to be true, but are only probative to the extent that they are perceptions of the authors. *See Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010) (news articles “are admissible only to show what has been printed, not the truth of what has been printed.”).

⁵⁴ 28 TTABVUE 195.

⁵⁵ 28 TTABVUE 202.

⁵⁶ 28 TTABVUE 206.

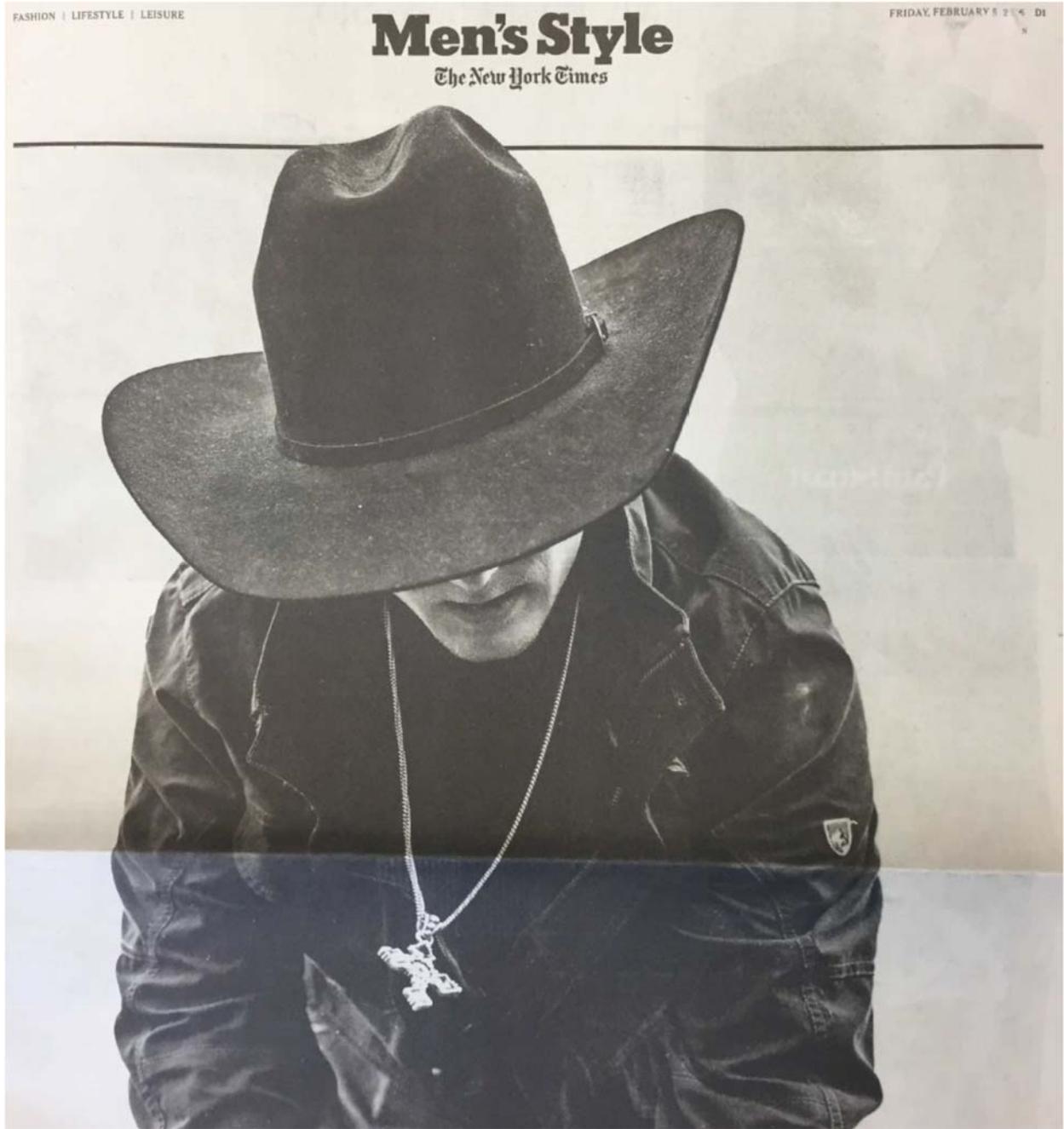
Because there is no information or testimony regarding the circulation of publications, we do not know how many people read the stories. However, *UtahStories.com*, *DesertNews.com*, and *ParkRecord.com* appear to be Utah-based publications as opposed to national publications.

These four news articles in publications of unknown circulation are not sufficient to demonstrate that Opposer's mark is famous. If Opposer's mark were famous, we would expect that there would be more than four articles in what appear to be local publications regarding Opposer and its KÜHL trademark.

12. Opposer's KÜHL branded products have been worn by celebrities appearing in national media.⁵⁷ However, the examples of such use are merely photographs of celebrities engaged in various activities, and the existence and visibility of the KÜHL trademark are not highlighted in any way. In fact, one would only be aware of the KÜHL mark if one were aware it was there and looked for it. Nor is there any information as to what exposure the photographs received. For example, a photograph from a *New York Times* article is reproduced below.⁵⁸ Opposer's logo is displayed on the subject's sleeve on the reader's right. The KÜHL mark is not visible.

⁵⁷ Webb Decl. ¶82-95 and Exhibits V, W, X, Y, Z, AA, BB, CC, DD, EE, FF, and HH (27 TTABVUE 16-18 and 28 TTABVUE 134-182 and 209).

⁵⁸ 28 TTABVUE 209.



While we have noted some shortcomings as to the probative value of the individual pieces of evidence, we must look at the evidence as a whole to determine whether Opposer has proven the fame of its mark. *Cf. West Florida Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (in analyzing priority, “whether a particular piece of evidence by itself establishes prior use is not

necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.”).

Opposer is a successful 24 year old, independently-owned company specializing in a full line of outdoor wear sold through 1,000 retailers nationwide. However, Opposer’s commercial success does not equate to the fame of its mark. Because there is no context for Opposer’s advertising and sales figures, we cannot gauge the relative level of success or the degree of exposure the general public has had to the KÜHL trademark. The extent to which consumers have been exposed to Opposer’s clothing products, bottle water, lip balm, *etc.* vis-à-vis competitors is unknown and, thus, it is not possible to determine the renown of Opposer’s mark. Ultimately, and considered as a whole, Opposer’s evidence falls short of clearly establishing that its KÜHL trademark is famous. *See Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Nevertheless, the evidence establishes that the KÜHL trademark has achieved recognition, and in view of the distinctive nature of Opposer’s mark, we find Opposer’s mark to be a commercially strong trademark.

The *du Pont* factor of fame is neutral. The distinctiveness of Opposer’s mark, however, weighs in Opposer’s favor. *See L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1888 (TTAB 2008) (opposer’s mark held to be strong but not famous).

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild*, 82 USPQ2d at 1905; see also *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are bicycles and “rugged outdoor clothing,” the average customer includes ordinary consumers in the general public.

For ease of reference in following our analysis of the similarities between the marks, we display them together below:

Opposer's Mark



Applicant's Mark



The marks are similar in appearance because they both have four characters, begin with the letter “K,” end with the letter “L,” and the “ü” in Opposer’s mark is similar to the letter “u” followed by the colon (“u:”) in Applicant’s mark.

While there is no one correct pronunciation for a mark, especially where both marks have unusual spellings, in this case, however, we find that both marks are likely to be pronounced as “Cool.”⁵⁹ Any other possible pronunciation of the marks would likewise be extremely similar, if not the same, given the marks share the same first letter (“K”), the sole vowel (“U”) and last letter (“L”).

Because both marks are likely to be pronounced “Cool,” consumers are likely to perceive that the marks have similar meanings and engender similar commercial impressions (*i.e.*, great, fine, or excellent). Likewise, because the marks are used in connection with “rugged outdoor clothing” and “bicycles,” the marks could also mean and engender the commercial impression of cool or cold weather products. In either event, the meaning and commercial impressions are similar.

⁵⁹ Shuff Dep., p. 13 (21 TTABVUE 14) (Applicant’s mark is pronounced “cool.”); Evans Decl. ¶8 (26 TTABVUE 6) (Opposer’s mark KÜHL is pronounced “Cool.”); Mejia Dep., p. 11 (23 TTABVUE 12); Lorentz Dep., p. 13 (34 TTABVUE 13); Applicant’s Brief, p. 14 (43 TTABVUE 19) (“Although Shuff’s Mark and Alfwear’s Marks are both pronounced ‘cool,’ the similarities end there.”).

We find that the marks are similar in their entireties as to their appearances, sound, connotation and commercial impression.

C. The similarity or dissimilarity and nature of the goods.

Opposer contends that the goods at issue, clothing and bicycles, are related “because (1) the goods are used together and appeal to the same purchasers, (2) the goods are sold by the same manufacturers and dealers, (3) use-based registrations list both bicycles and clothing, and (4) [Opposer] has marketed its products and brand in connection with bicycles.”⁶⁰ That “outdoor clothing and bicycles “can be used together and appeal to the same purchasers,”⁶¹ is not dispositive because consumers generally wear clothing in connection with most activities.

That two products are used together does not, in itself, justify finding that they are related. “[T]he test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue ... can be related in the mind of the consuming public as to the origin of the goods.” *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355-56 (Fed. Cir. 2004) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 227 F.3d 1352, 56 USPQ2d 1351, 1355 (Fed. Cir. 2002)). Conversely, goods that are neither used together nor related to one another in kind may still “be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” *Shen Mfg. Co.*, 73

⁶⁰ Opposer’s Brief, p. 37 (39 TTABVUE 38).

⁶¹ Opposer’s Brief, p. 37 (39 TTABVUE 38).

USPQ2d at 1356 (quoting *Recot, Inc. v. Becton*, 54 USPQ2d at 1898 (comparing FRITO-LAY for snack foods to FIDO LAY for dog treats)). Therefore, although a purchaser of Applicant’s bicycles would undoubtedly wear clothing, it does not necessarily follow, from that fact alone, that relevant purchasers would understand that those products have originated from the same source.

Opposer made of record 24 use-based, third-party registrations for marks covering both bicycles and various items of clothing, including several of the items identified in the registration of Opposer. Third-party registrations based on use in commerce that individually cover a number of different goods may have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source.⁶² *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Representative registrations, with relevant portions of the identifications, are listed below.

Mark	Reg. No.	Goods
GUERCIOTTI	1367504	Bicycles; sportswear, namely, vests, sweaters, pullovers, shirts, blouses, skirts, trousers, shorts, jackets, coats, hats, gloves, socks and shoes
SPEEDPLAY	2039206	Bicycles; clothing for use in connection with cycling, namely, pants, shirts, jackets, sweaters, vests, footwear, caps, hats and visors

⁶² 18 TTABVUE 43-116.

Mark	Reg. No.	Goods
DE ROSA	1813617	Racing bicycles; sports clothing and shoes, namely, socks, head bands, bib tights, jerseys, shorts, gloves, caps, jackets, t-shirts, and shoes
BONTRAGER	1994941	Bicycles; t-shirts, sweatshirts, and hats
LITESPEED	2821238	Bicycles; clothing, namely, jackets, t-shirts, shirts, jerseys, socks, pants, shorts, bib shorts, biking shorts, hats, and shoe covers for cycling

Opposer also introduced 30 third-party websites “relevant to the relatedness of goods factor because the website[s] offers both clothing and bicycles for sale.” Of those 30 websites, nine of the third parties advertise the sale of both clothing and bicycles under the same marks.⁶³ Those third parties are listed below:

- FELT BICYCLES (feltbicycles.com);⁶⁴
- FOFFA (foffawear.com and foffabikes.com);⁶⁵
- GUCCI (gucci.com);⁶⁶
- JAMIS (jamisbikes.com);⁶⁷

⁶³ 19 TTABVUE 2. That the same entity offers both clothing and bicycles for sale is more probative of the channels of trade than the relatedness of the goods unless the goods are offered under the same mark.

⁶⁴ 19 TTABVUE 134-139.

⁶⁵ 19 TTABVUE 140-148. This is an English company as indicated by the use of the pound symbol for pricing. Nevertheless, the website indicates that this entity ships worldwide through UPS. (19 TTABVUE 140 and 144). Accordingly, we include this website as part of our analysis.

⁶⁶ 19 TTABVUE 156-160.

⁶⁷ 19 TTABVUE 162-165.

- LL BEAN (llbean.com);⁶⁸
- SHINOLOA (shinoloa.com);⁶⁹
- SPECIALIZED (specialized.com);⁷⁰
- SPOT (spotbrand.com);⁷¹
- STATE BICYCLE CO. (statebicycle.com);⁷² and
- TREK (trekbikes.com).⁷³

As discussed above, since 2010, Opposer has been an official sponsor of the Larry H. Miller Tour of Utah as the “Official Uniform Provider.”⁷⁴ The Larry H. Miller Tour of Utah is a week-long, professional cycling stage race.⁷⁵ As an official sponsor, Opposer received media exposure (including television, radio, print, website and social media) and on-site exposure through signage.⁷⁶

Also, since 2010, Opposer has sponsored a competitive bicycle team that competes in mountain bike, cycle cross, road race, and single-speed bicycle competitions.⁷⁷ The team wears KÜHL jerseys.⁷⁸ From 2011 through 2013, the KÜHL team competed in

⁶⁸ 19 TTABVUE 167-177.

⁶⁹ 19 TTABVUE 236-240.

⁷⁰ 19 TTABVUE 242-252.

⁷¹ 19 TTABVUE 271-274.

⁷² 19 TTABVUE 276-308.

⁷³ 19 TTABVUE 313-333.

⁷⁴ Webb Decl. ¶58 (27 TTABVUE 12).

⁷⁵ Webb Decl. ¶61 (27 TTABVUE 13); Lythgoe Dep., pp. 64-66 (29 TTABVUE 70-72).

⁷⁶ Webb Decl. ¶¶63 and 66-67 and Exhibit P (27 TTABVUE 13-14 and 102).

⁷⁷ Webb Decl. ¶¶69-70 (27 TTABVUE 14); Lythgoe Dep., pp. 48-49 and 78-79 (29 TTABVUE 54-55 and 84-85).

⁷⁸ Webb Decl. ¶71 (27 TTABVUE 14); Lythgoe Dep., pp. 68-70 (29 TTABVUE 74-76).

California, Idaho, Pennsylvania, Michigan, Wisconsin, Illinois, Colorado, Kentucky, Ohio, Iowa, and Utah.⁷⁹

Because the description of goods in Opposer's KÜHL (stylized) registration is "rugged outdoor clothing, namely, jackets, shirts, pants, shorts, t-shirts, and hats," because Opposer's KÜHL (stylized) mark is a unique, strong mark, and because Opposer sponsors bicycle races and a competitive bicycle team, Opposer's third-party registration evidence and third-party use of similar marks used for both bicycles and clothing are probative of the relatedness of the goods, and we find, on this record, that the Opposer's "rugged outdoor clothing, namely, jackets, shirts, pants, shorts, t-shirts, and hats" and bicycles are related products.

Applicant argues that the "obvious differences in the products must also be taken into account."⁸⁰ As the preceding discussion shows, we have noted the differences between the products at issue and taken into account what Opposer needs to do to prove that bicycles and clothing are related products. Moreover, the issue is not

⁷⁹ Webb Decl. ¶72 (27 TTABVUE 14). Applicant contends that Opposer's evidence regarding its racing sponsorships is irrelevant because the events are "elite-level races for the top professional cyclists in the country" and directed to "people with an 'outdoor lifestyle' who like to 'ski, mountain and road bike, backpack, camp, mountaineer, and travel worldwide'" while conversely Applicant's bicycles are single-speed cruisers specifically designed for and marketed to 'urban commuters looking for recreational transportation and not something for sport.'" Applicant's Brief, pp. 16-17 (43 TTABVUE 21-22). Applicant's description of goods is "bicycles" without any limitations or restrictions as to the type of bicycles, channels of trade or classes of consumers and must be deemed to include all types of bicycles. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). We may not limit, by resort to extrinsic evidence, the scope of the goods as identified in Opposer's registration or Applicant's application. *E.g.*, *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Fisher Scientific Co.*, 440 F.2d 43, 169 USPQ 436, 437 (CCPA 1971); *In re La Peregrina Ltd.*, 86 SPQ2d 1645, 1646 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

⁸⁰ Applicant's Brief, p. 16 (43 TTABVUE 22).

whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *See Hydra Mac, Inc. v. Mack Trucks, Inc.*, 507 F.2d 1399, 184 USPQ 351 (CCPA 1975) (“the confusion found to be likely is not as to the products but as to their source”); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2 1464, 1471 (TTAB 2016). Here, the evidence shows that the goods of the parties are such as might reasonably be expected to emanate from the same source.

D. Established, likely-to-continue channels of trade.

In addition to the websites of the 10 third parties advertising the sale of both clothing and bicycles under the same marks, Opposer made of record 20 websites of third parties advertising the sale of both clothing and bicycles identified by different marks.⁸¹ Bicycle shops, sporting goods stores, and general online retailers sell both rugged outdoor clothing and bicycles. Consumers shopping for bicycles may also purchase clothing for use in connection with bicycling at the same time.

Representative websites are listed below:

- Academy Sports Outdoors (academy.com) advertising the sale of Under Armour, Columbia, Carhartt, Magellan, and Nike clothing and Airwalk, Allen Sports, Bell, Diamondback, GMC, Giordano, Hot Wheels, Huffy and Kent bicycles;⁸²
- BackCountry.com advertising the sale of Patagonia and The North Face clothing and Charge and Diamond Back bicycles;⁸³ and

⁸¹ 19 TTABVUE 2-333. See also Shapiro Decl. ¶16 (26 TTABVUE 5) (Opposer sells its clothing to bicycle shops).

⁸² 19 TTABVUE 12-28.

⁸³ 19 TTABVUE 33-45.

•Bicycle World (bicycleworld.com) advertising the sale of, *inter alia*, The North Face and Patagonia clothing and Trek, Giant, and Cannondale bicycles.⁸⁴

Accordingly, clothing and bicycles move in some of the same channels of trade.

Applicant argues that the “crux” of his business is the customization of bicycles. “By definition, this is a unique channel of trade that is singular to KUL Bikes and not [Opposer].”⁸⁵ We reiterate that Applicant’s description of goods is “bicycles,” not customized bicycles and, as noted in the previous section, we may not limit by extrinsic evidence the scope of the goods as identified in Opposer’s registration or Applicant’s application.

E. The conditions under which and buyers to whom sales are made, *i.e.*, ‘impulse’ vs. careful, sophisticated purchasing.

Applicant argues that consumers of Opposer’s clothing are more likely to be impulse buyers because Opposer’s products “are sold in brick and mortar stores like REI, where a browsing customer roaming through the store could very easily sport a t-shirt or pair of pants manufactured by [Opposer] and make an impulse purchase in a matter of seconds.”⁸⁶ Assuming this to be true, then a browsing customer may mistakenly believe that Opposer’s KÜHL brand clothing emanates from the same source as a KU:L bicycle with which the customer is familiar because of the similarity

⁸⁴ 19 TTABVUE 47-51.

⁸⁵ Applicant’s Brief, p. 18 (43 TTABVUE 23).

⁸⁶ Applicant’s Brief, p. 19 (43 TTABVUE 24).

of the marks. Accordingly, we find that this *du Pont* factor weighs in favor of finding that there is a likelihood of confusion.⁸⁷

F. Analyzing the factors.

Because the marks are similar, and the goods are related and move in the same channels of trade, and Opposer's "rugged outdoor clothing" may be purchased by consumers exercising a low degree of purchasing care, we find that Applicant's mark KU:L (stylized) for "bicycles" is likely to cause confusion with Opposer's mark KÜHL (stylized) for "rugged outdoor clothing, namely, jackets, shirts, pants, shorts, t-shirts, and hats."

VI. Dilution

Having determined that Applicant is not entitled to registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), it is unnecessary to consider Opposer's dilution claim. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) ("Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . [T]he Board's determination of registrability does not require, in every instance, decision on every pleaded claim.").

⁸⁷ Again, we cannot take into consideration Applicant's assertions that his bicycles are not sold in stores and each is custom made because those limitations, restrictions, or characteristics are not present in his description of goods.

Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), and registration to Applicant is refused.