

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: November 19, 2024

Mailed: December 9, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Kuldisak, LLC

v.

*RASL Unlimited Inc.*¹

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Opposition No. 91276063
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Nicholas S. Lee of Bishop Diehl & Lee, Ltd., for Kuldisak, LLC.

John Holman of Dynasty Law PLC, for RASL Unlimited Inc.

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Before Goodman, Lebow and Elgin,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

¹ Throughout the opposition, Applicant has maintained that it erroneously identified itself in the application as “RASL *Enterprises Inc.*,” a non-existent entity, and that its name has, in fact, been “RASL *Unlimited Inc.*” since it filed its application. *See, e.g.*, Applicant’s Answer, 4 TTABVUE 2-3, 6 (¶ 4, and the attached Certificate of Existence from the State of South Carolina), and Applicant’s Brief, 24 TTABVUE 2. Section 303.05(d) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 303.05(d) (June 2024) states that “[i]f a notice of opposition is filed against a mark where the applicant has been inadvertently misidentified in the application, ... the real party in interest may be substituted for the named defendant during the opposition proceeding.” We therefore substitute the correct party for Applicant as shown in the case caption above.

Citations to the record are to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

Applicant, RASL Unlimited Inc., seeks a Principal Register registration for the standard-character mark SWAG GOLF (“GOLF” disclaimed) for “Clothing for athletic use, namely, padded shirts; Clothing, namely, khakis; Belts for clothing; Bottoms as clothing; Embroidered clothing, namely, shirts, hats; Hoodies; Jerseys; Tops as clothing; Wearable garments and clothing, namely, shirts” in International Class 25.²

Opposer, Kuldisak, LLC, opposes registration of Applicant’s proposed mark on the ground that, when used on or in connection with these goods, it is likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s previously-used and registered standard-character mark SWAG for goods in International Classes 18, 21, 26, and 28, including, as relevant to our analysis, “Belt buckles” in Class 25.³

² Application Serial No. 90852342 (“the Application”) was filed on July 28, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

³ 1 TTABVUE 12-13. Registration No. 6053739 (“Opposer’s Registration”), issued May 12, 2020, also identifies “Umbrellas; duffel bags; wallets; travel bags” in Class 18; “Water bottles sold empty” in Class 21; and “Golf clubs; golf balls; golf ball markers; golf divot repair tools; golf bags; golf tees; golf club covers; golf club grips; golf bag covers; golf gloves” in Class 25.

Opposer also alleged in the Notice of Opposition that Applicant, originally identified as “Ron Burnier,” did not have a bona fide intention to use the mark; that the Trademark Examining Attorney assigned to the application improperly issued an Examiner’s Amendment amending the application to identify Applicant as “RASL Enterprises Inc.,” which Opposer contends may only be done through an assignment; and that the application should therefore be found “void.” *Id.* at 10-12. Apart from waiving this claim by not arguing it in its brief, *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014), Opposer’s contentions are misplaced. Specifically, there was an inconsistency in the original application as to the owner’s name and entity type that allowed correction by the Examining Attorney, *see* TRADEMARK MANUAL OF EXAMINING PROCEDURE (Nov. 2024) § 1201.02(c), but that correction was to a non-existent entity, RASL Enterprises Inc. This misidentification allowed us to substitute the name of the correct party, as discussed above in note 1. When this issue was raised during the oral hearing with the parties, Opposer’s counsel indicated he had no objection to the substitution.

Applicant, in its answer, denied the salient allegations in the notice of opposition.⁴

For the reasons discussed below, we sustain the opposition.

I. The Record

The record includes the pleadings, the file of the Application by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).⁵ In addition, Opposer made of record the testimony declaration of its Chief Financial Officer, Scott Weber, with exhibits;⁶ and a notice of reliance on a certified copy of Opposer's pleaded registration showing both its current status and the current title;⁷ Applicant's responses to Opposer's interrogatories, requests for admissions, and document requests;⁸ and various Internet materials.⁹ Applicant did not introduce any evidence.

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every Board opposition proceeding. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *5 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing

⁴ 5 TTABVUE.

⁵ For this reason, it was unnecessary for Opposer to introduce under notice of reliance the prosecution history for the Application. 22 TTABVUE 207-210 (Exhibits 75).

⁶ 20 TTABVUE ("Weber Test. Decl.").

⁷ 21 TTABVUE 15-18 (Opposer's Notice of Reliance, Exhibit 1).

⁸ *Id.* at 19-38 (Exhibits 2-4). Responses to requests for production of documents introduced through a notice of reliance are admissible solely for the purpose of showing that a party has stated that there are no responsive documents, as Applicant has done in certain of its responses. *See McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559, at *5 n.6 (TTAB 2021).

⁹ *Id.* at 39-336 (Exhibits 5-55); 22 TTABVUE 2-206 (Exhibits 56-74).

Lexmark Int'l, Inc. v. Static Control Components, Inc., 572 U.S. 118, 134 S. Ct. 1377, 188 L. Ed. 2d 392, 109 USPQ2d 2061, 2067 n.4 (2014)), *cert. denied*, 142 S. Ct. 82, 211 L. Ed. 2d 16 (2021). A party in the position of plaintiff may oppose registration of a mark where the opposition is within the zone of interests protected by statute and the party has a reasonable belief in damage proximately caused by registration of the mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, *3-4 (Fed. Cir. 2022); *Corcamore*, 2020 USPQ2d 11277, at *6-7, *cited in NPG Records, LLC v. JHO Intell. Prop. Holdings LLC*, 2022 USPQ2d 770, at *12 (TTAB 2022).

Because Opposer did not introduce evidence establishing its common law rights, we focus on its pleaded registration.¹⁰ As set forth above, the record includes a status and title copy of Opposer's pleaded registration. That registration supports a colorable claim for likelihood of confusion. *Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (reasonable belief in damage may be established by "assert[ing] a likelihood of confusion which is not wholly without merit"). Opposer's entitlement to a statutory cause of action to oppose registration of Applicant's mark therefore is established. *Advance Magazine Publishers, Inc. v. Fashion Elecs., Inc.*, 2023 USPQ2d 753, *2 (TTAB 2023); *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, *11-12 (TTAB 2023) (pleaded registrations establish direct commercial interest).

¹⁰ "Use in commerce" for trademarks means a sale or transportation of the goods in the United States interstate commerce or in commerce with foreign nations. Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127. Although Opposer provided evidence of the time periods during which it "offered" various goods for sale under the mark SWAG, *see e.g.*, 20 TTABVE 2-5 (Weber Test. Decl., ¶¶ 6-10, 12-14, 18-22), it did not introduce evidence of any actual sale or transportation of the goods in commerce.

III. Trademark Act Section 2(d)

Section 2(d) of the Trademark Act prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

15 U.S.C. § 1052(d).

A. Priority

Because Opposer's pleaded registration is of record, and Applicant has not counterclaimed to cancel it, priority is not at issue as to the SWAG mark and goods covered by the registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Shenzhen Ltd. v. Fancy Pants*, 2022 USPQ2d 1035, at *20-21 (TTAB 2022).

B. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts of record. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). In assessing likelihood of confusion, we consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). "Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)).

Varying weights may be assigned to each *DuPont* factor depending on the evidence

presented in a particular case. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004), *cited in Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, *5 (TTAB 2019).

Opposer bears the burden of proving a likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

1. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (internal quotation omitted) *quoted in Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021). Here, all of the elements favor a finding of similarity.

The respective standard character marks are, again, Applicant’s SWAG GOLF (with “GOLF” disclaimed” and Opposer’s SWAG. The marks’ key commonality, SWAG, forms the entirety of Opposer’s mark and the first part of Applicant’s mark,

where it is the most prominent and dominant element—the first word consumers would notice, remember, and use to seek Opposer’s goods. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018)); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because VEUVE “remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”).

SWAG is also dominant in Applicant’s mark because it has stronger source-identifying significance than GOLF, which describes a purpose or use of Applicant’s apparel. Descriptive matter typically is less significant or less dominant when comparing marks. *See Cunningham*, 55 USPQ2d at 1846, quoting *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.”). *Cf. Palm Bay Imps.*, 73 USPQ2d at 1692 (“The presence of this strong distinctive term [VEUVE] as the first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence nonsource identifying) significance of ROYALE.”).

The marks’ similarity is further enhanced because SWAG GOLF encompasses

SWAG. *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660-61 (TTAB 2014) (Opposer's mark PRECISION DISTRIBUTION CONTROL contains the entirety of Applicant's mark PRECISION), *cited in Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *20 (TTAB 2019). And, if Applicant were to obtain registration, it could display its standard character mark SWAG GOLF with emphasis on SWAG, as shown below, which would also enhance the marks' similarity:

SWAG
Golf

See In re Mr. Recipe, LLC, 118 USPQ2d 1084, 1090 (TTAB 2016).

“Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products.” *In re Great Lakes Canning, Inc.*, 227 USPQ2d 483, 485 (TTAB 1985). “In this case, the peripheral differences fail to distinguish the marks.” *In re Dare Foods Inc.*, 2022 USPQ2d 291, at *12 (TTAB 2022).

We find, accordingly, that the marks are confusingly similar, and that the first *DuPont* factor weighs in favor of a likelihood of confusion.

2. Similarity or Dissimilarity of the Goods

Under the second *DuPont* factor, we consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567. “This factor considers whether 'the consuming public may perceive [the respective goods] as related enough to cause confusion about the[ir] source or origin,” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014)

(quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)), and is based on the identification of goods in the Application and Opposer’s Registration. *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567); *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in an application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

Here, Applicant’s one-class application includes several goods including “belts for clothing,” and Opposer’s Registration identifies, among other goods, “belt buckles.” We agree with Opposer’s contention that these goods “are obviously closely related ... as one would be useless without the other,”¹¹ and we take judicial notice of THE AMERICAN HERITAGE Dictionary’s definition of “buckle”: “[a] clasp for fastening two ends, as of straps **or a belt**, in which a device attached to one of the ends is fitted our coupled to the other.”¹²

Based on the identifications of goods themselves and the above-noted dictionary definition, we find that Applicant’s identified “belts for clothing” and Opposer’s “belt

¹¹ 23 TTABVUE 13 (Opposer’s Brief).

¹² <https://www.ahdictionary.com/word/search.html?q=buckle> (accessed December 4, 2024) (emphasis added). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *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); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *2 n.17 (TTAB 2019).

buckles” are inherently related and complementary.¹³ See *Hewlett-Packard*, 62 USPQ2d at 1004-06 (discussing the relationship of various goods and services based solely on the identifications in the application and registration, without additional evidence). Indeed, these goods work together to make a belt functional. See also *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (finding bread and cheese to be related because they are often used in combination, and stating: “Such complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010) (finding likelihood of confusion where “based on the identifications themselves” the goods are “complementary in function and purpose”).

We, accordingly, find that Applicant’s and Opposer’s goods are related, and that the second *DuPont* factor weighs in favor of a likelihood of confusion.

C. Conclusion

Having found that the respective marks and goods are similar, and that the first and second *DuPont* factors therefore favor a finding a finding of likelihood of

¹³ Opposer asserts that it “also submitted evidence of third-party registrations in connection with its renewed summary judgment motion showing that golf equipment companies frequently sell apparel.” 23 TTABVUE 20 (Opposer’s Brief). However, as explained in its orders regarding both Opposer’s original and renewed motions for summary judgment, “evidence Also, evidence submitted with a summary judgment motion is of record only for consideration of the motion. To be considered at final, **such evidence must be properly introduced during the appropriate trial period**, see *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) (emphasis added), which was not done in this case. 10 TTABVUE 4 n.4; 17 TTABVUE 8 n.21.

confusion, with no other factors being relevant, we find that Opposer has carried its burden in establishing a likelihood of confusion.

Decision: The opposition is sustained.