

THIS OPINION IS NOT A
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

FSW/rk

Mailed: January 15, 2010

Cancellation No. 92045101

Imagewear Apparel Corp.

v.

Wings Manufacturing
Corporation

**Before Grendel, Cataldo and Bergsman, Administrative
Trademark Judges.**

By the Board:

Petitioner, Imagewear Apparel Corp., filed a notice of opposition against registration of the mark RED SNAP¹ for various clothing items, alleging registration and priority of use of the mark RED KAP and marks incorporating the wording RED KAP² on various clothing items, and alleging a likelihood of

¹ Registration No. 2995193 for RED SNAP for "clothing, namely, men's and boy's shirts, trousers, shorts, jackets and tops; ladies and girl's blouses, pants, shorts, jackets, jeans and tops," issued on September 13, 2005, based on a date of first use in commerce of December 30, 2003.

² Petitioner pleads the following registrations:

Registration No. 1359300 for RED KAP INDUSTRIES and Design for "pants", issued September 10, 1985 and renewed August 9, 2006, based on a date of first use in commerce of October 1971.

Registration No. 1699854 for RED KAP IMAGE PLUS for "kitchen apparel, namely, chef's and cook's pants, jackets, and shirts and accessories, namely, scarves, gloves, caps, and aprons; professional cover-ups, namely, laboratory coats, counter coats, staff coats, butcher coats, shop coats, aprons, smocks, wraps and dresses; dress uniform shirts,"

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confusion between the marks and dilution of the distinctive quality of petitioner's marks. Respondent filed an answer denying the salient allegations of the complaint.

On June 22, 2009, respondent filed a motion for summary judgment, contending that there is no likelihood of confusion between the marks and further contending that its mark does not dilute petitioner's marks. Petitioner opposed the motion and cross-moved for summary judgment in its favor on both grounds. The motions are fully briefed.³

issued July 7, 1992 and renewed April 29, 2002, based on a date of first use in commerce of December 5, 1991.

Registration No. 1758476 for RED KAP for "*pants, coveralls, shirts, coats and jackets,*" issued March 16, 1993 and renewed June 16, 2003, based on a date of first use in commerce of October 1971.

Registration No. 2247947 for HIGHLAND COLLECTION BY RED KAP for "*shirts, blazers, blouses, skirts, dress slacks, sweaters and vests,*" issued May 25, 1999, based on a date of first use in commerce of October 1996.

Registration No. 2329473 for RED KAP and Design for "*shirts, pants, shorts, blouses, jackets, coveralls and jeans,*" issued March 14, 2000, based on a date of first use in commerce of April 16, 1998.

Registration No. 3058253 (originally pleaded as application Serial No. 78429415) for RED KAP for "*providing consumer product information via the Internet,*" issued February 7, 2006, based on a date of first use in commerce of January 30, 1988.

Registration No. 3150516 (originally pleaded as application Serial No. 78502114) for RED KAP SINCE 1923 and Design for "*sunlasses,*" "*backpacks, duffel bags and wallets,*" and "*aprons, bandanas, belts, pants, coats, coveralls, shirts, t-shirts, dresses, rainwear, gloves, jackets, jeans, lab coats, mittens, overalls, parkas, scarves, shorts, skirts, smocks, sweatsuits, sweaters, uniforms, visors, wind-resistant jackets, boots, shoes and slippers,*" issued October 3, 2006, based on a date of first use in commerce of June 10, 2004.

Pleaded Registration No. 1524612 was cancelled under Section 8 of the Trademark Act on September 19, 2009.

³ On August 11, 2009, respondent moved to strike petitioner's response to the motion for summary judgment as overlong, in violation of the twenty-five page limit for briefs imposed by Trademark Rule 2.127(a). Petitioner filed a combined response to the motion to strike and cross-moved for leave to refile its response brief in compliance with the

A motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The mere fact that each party has requested entry of judgment in its favor does not necessarily mean that there are no genuine issues of material fact and that entry of summary judgment is warranted. *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994). On the other hand, where, as here, each party argues that there are no factual issues in dispute and that entry of summary judgment in its favor is warranted, only if we determine that there are no issues of fact to be decided will we then determine which party is entitled to prevail under the applicable law. As a general rule, however, "the resolution of Board proceedings by means of summary judgment is to be

twenty-five page limit. Petitioner's newly filed brief complies with the page limit by removing the cover page, table of contents and table of authorities and by reducing the font size from 12 point to 11 point, all of which are acceptable changes that do not change the brief in substance. In view thereof, the resubmitted brief is accepted and the motion to strike is denied as moot.

encouraged. This is particularly true when both sides seek resolution of their dispute by means of summary judgment." *Univ. Book Store v. Univ. of Wisconsin*, 33 USPQ2d at 1389.

We first address the parties' motions for summary judgment on petitioner's pleaded claim of likelihood of confusion. After careful consideration of the parties' arguments and submissions in support of their motions, for the reasons discussed below we find no genuine issues as to any fact that would be material to the decision on the question of likelihood of confusion and that respondent is entitled to judgment on this question as a matter of law.⁴ *See Kellogg Co. v. Pack'em Enterprises*, 951 F.2d 330, 21 USPQ2d 1142, 1144 (Fed. Cir. 1991).

The question of likelihood of confusion between marks is resolved based on evidentiary factors enumerated in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), and any of these elements "may from case to case play a dominant role." *Id.* at 1362. Our task is to decide if, for purposes of the present motion and cross-motion, there are any factual issues in dispute regarding the *du Pont* factors that would need to be resolved at trial. In this case, the dominant factors are the similarity or dissimilarity of the marks, relatedness

⁴ Since we find for respondent on the question of likelihood of confusion, we need not consider the issues, if any, of petitioner's standing and priority of use.

of the goods, the number and nature of similar marks in use on similar goods, the nature and extent of any actual confusion and the fame of petitioner's marks.

We first note that both parties agree that the goods are related but disagree as to whether the marks are similar in their appearance, phonetic quality, meaning and commercial impression. There is no dispute that both marks begin with the term RED and end with a term that concludes with the "__AP" sound. Thus, there is some similarity of appearance and pronunciation. However, there is no genuine issue that the marks are dissimilar in meaning and commercial impression.

Petitioner argues that because the term RED "is highly distinctive if not arbitrary in connection with clothing," *Petitioner's Response and Cross-Motion (As Amended)*, pp.12-13, its marks are entitled to a greater scope of protection as relatively strong marks. Respondent, on the other hand, argues that "red" is not distinctive as a mark in connection with clothing and to this end, respondent has submitted the declaration of its counsel's legal assistant, together with "true and accurate copies of Internet web pages" that she indicates she downloaded and printed from the Internet, showing third-party uses of the term RED in connection with clothing, including:

- Red Hat clothing
- Red Hat Fashions 4 U

- Red Hat Society for hats and gloves
- RedHead clothing
- Redback boots
- Red Jacket Shop for shirts and tops
- Red Brand from Target
- Red brand from Gap
- Red label for men's clothing
- Chilli Red shirts
- Ecko Red clothing
- Red Dot clothing
- Red Ledge clothing
- Red Monkey Designs for shirts, hats, belts and vests
- Red Brick clothing
- Redspur clothing
- Red 21 Boys for boys clothing

See Declaration of Demetra Falto and attachments thereto.⁵

Based on the existence of these third-party marketplace uses of the term RED in connection with clothing, we cannot find that petitioner's marks are entitled to an elevated scope of protection. Moreover, the term KAP and its phonetic equivalent "cap" have entirely dissimilar meanings to that of the word SNAP;⁶ and viewing the marks overall as we must, we find the marks to be so dissimilar that as a matter of law there is no genuine

⁵ Respondent has also submitted evidence of third-party registrations of marks containing the term RED. While these may be relevant when evaluating likelihood of confusion, they are not evidence of actual use of similar marks for similar goods, or evidence of any descriptive meaning of the marks. See *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983) and *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975) (third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks); see also *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (third-party registrations are not entitled to any weight when evaluating the strength of petitioner's marks).

⁶ Indeed, petitioner admits, in its responses to respondent's first admission requests Nos. 22 and 23, that "'Cap' and 'snap' do not have the same meanings" and that "'Cap' and 'snap' have different meanings."

issue of material fact that RED KAP and RED SNAP are not confusingly similar and that respondent is entitled to entry of summary judgment in its favor. "We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive." *Kellogg v. Pack'em*, 21 USPQ2d at 1145; *see also Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 USPQ2d 1459 (Fed. Cir. 1998). Here, despite the overlap in goods, because the marks are so dissimilar, there are no genuine issues of material fact that confusion is unlikely.

To complete our analysis, we turn to petitioner's assertion that its RED KAP-formative marks have become famous. While we have conducted a complete analysis of the sales, marketing and advertising figures provided, in deference to the fact that they have been filed under seal, we will only generally discuss the figures. Petitioner claims: (1) sales of RED KAP products since 1927,⁷ including extensive domestic sales of RED KAP products from 2000 to 2008,⁸ (2) expenditures in promoting and marketing the RED KAP brand during the same period,⁹ and (3) evidence of unsolicited publicity.¹⁰

⁷ *Declaration of Stan Jewell* (hereinafter "*Jewell Decl.*"), para. 25.

⁸ *Jewell Decl.*, para. 26.

⁹ *Jewell Decl.*, para. 23.

¹⁰ *Declaration of J. Anthony Lovensheimer* and exhibits thereto.

Although petitioner's sales figures suggest that it has experienced success marketing products under its RED CAP marks, the relatively small advertising expenditures and the limited number of unsolicited articles (most of which are in specialized trade publications) concerning petitioner's RED KAP mark undercut petitioner's claim of fame. Petitioner has, therefore, failed to carry its burden to show the absence of genuine issues that its mark is famous.

Even were we to hold that petitioner's marks may be considered famous, we find no genuine issue of material fact that would compel a different decision on the question of likelihood of confusion. The marks RED KAP and RED SNAP are so dissimilar in their entireties "that the first *du Pont* factor simply outweighs all of the others that might be pertinent to this case." *Kellogg v. Pack'em*, 21 USPQ2d at 1145.

Therefore, since there is no genuine issue regarding any material fact that the term RED is weak in the field of clothing or that petitioner's marks are not famous on the record presented, and given that the marks are so dissimilar in sight, sound, meaning and commercial impression, we find as a matter of law that the marks are unlikely to cause confusion in the marketplace.

Turning now to the claim of dilution, our cases require that for purposes of dilution the marks be substantially similar. See *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715, 1729 (TTAB 2007); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005) ("For purposes of dilution, a party must prove more than confusing similarity; it must show that the marks are 'identical or very substantially similar.'"), quoting *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1183 (TTAB 2001). As the Board explained in *Toro v. Torohead*:

The test for blurring is not the same as for determining whether two marks are confusingly similar for likelihood of confusion purposes. "To support an action for dilution by blurring, 'the marks must be similar enough that a significant segment of the target group sees the two marks as essentially the same.'" *Luigino's, Inc.*, 170 F.3d at 832, 50 USPQ2d at 1051 (8th Cir. 1999) (quoting *2 McCarthy on Trademarks and Unfair Competition*, §24:90.1 (4th ed. 1998)). Therefore, differences between the marks are often significant.

Toro v. ToroHead, 61 USPQ2d at 1183 (TORO and ToroMR and Design are not substantially similar for dilution purposes). Since we have found that the marks are not similar for purposes of likelihood of confusion, they are not similar for purposes of dilution.

Accordingly, respondent's motion for summary judgment on petitioner's pleaded claims of likelihood of confusion

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and dilution is **GRANTED** and petitioner's cross-motion for summary judgment on the claims is **DENIED**.

The petition for cancellation is denied.

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