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

Proceeding	92055358
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>UNDER ARMOUR, INC.,</p> <p style="text-align:center">Petitioner,</p> <p style="text-align:center">v.</p> <p>URBAN ASPHALT SKATEWEAR,</p> <p style="text-align:center">Registrant.</p>	<p>Cancellation No.: 92055358</p> <p>Mark:</p> <div style="text-align:center"></div> <p>Registration No.: 3611357 Registration Date: April 28, 2009</p>
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**PETITIONER’S OPPOSITION TO
REGISTRANT’S MOTION FOR SUMMARY JUDGMENT**

Urban Asphalt Skatewear (“Registrant” or “Urban Asphalt”) is not entitled to summary judgment that its stylized UA URBAN ASPHALT mark, and the famous UA marks of Under Armour, Inc., can coexist in the marketplace without confusing consumers or diluting the widely used and widely seen UA marks. Indeed, whether presented in the ubiquitous UA logo or in block letters, “UA” has symbolized Under Armour’s identity since its inception in 1996. Since then, “UA” has been prominently featured across the extensive promotion and sale of virtually all of millions and millions of Under Armour products sold, worn, and used in the U.S.A., including many of the identical products identified in Urban Asphalt’s registration.

Numerous genuine disputed issues of material fact exist regarding Under Armour’s likelihood-of-confusion and dilution claims. When all reasonable inferences are drawn in Under Armour’s favor—as they must in deciding summary judgment—Urban Asphalt cannot meet its burden. Urban Asphalt’s motion ignores that fundamental principle and the dispositive inferences that flow from the distinctiveness, strength, and fame of Under Armour’s UA marks and the similarities between those marks and Urban Asphalt’s UA mark—a similarity the

Trademark Office has twice recognized in Office Actions issued by different Examining Attorneys. For these reasons and those discussed below, Urban Asphalt's Motion for Summary Judgment should be denied.

I. STANDARD FOR SUMMARY JUDGMENT

A party is entitled to summary judgment only when it has demonstrated that there are no genuine issues as to any material facts. Fed. R. Civ. P. 56(a), (c); see also *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Copelands' Enters., Inc. v. CNV, Inc.*, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991). A material fact is one that may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A genuine dispute exists if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. *Id.* The non-moving party is not required to present its entire case in response to a motion for summary judgment. *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) “[T]o defeat the motion the non-movant must present sufficient evidence to show an evidentiary conflict as to the material fact in dispute” *Id.* at 1472-73. The evidence submitted by the non-movant, in opposition to a motion for summary judgment, “is to be believed, and all justifiable inferences are to be drawn in [its] favor.” *Id.* at 255; see also *Cooper v. Ford Motor Co.*, 223 USPQ 1286, 1288 (Fed. Cir. 1984).

II. STATEMENT OF FACTS

A. Under Armour Has Numerous UA Registrations and Extensive Prior Use of the UA Marks

1. Under Armour Owns Numerous UA Registrations

Under Armour owns dozens of valid and subsisting registrations for mark UA in block letters and stylized form, which are individually and collectively referred to as the “UA Marks.”

(Declaration of Larry L. White (“White Decl.”) ¶2, Exhibit 1.) Notably, the filing of most of Under Armour’s registrations occurred *before* the filing of Urban Asphalt’s Registration No. 3611357.

2. Under Armour Has Extensive Prior Use

Since at least as early as 1996, Under Armour has continuously used the UA Marks. Beginning before Urban Asphalt’s filing date and first-use date, Under Armour has used and/or applied to register its UA Marks in connection with many of the identical products covered by Urban Asphalt’s registration and a wide range of closely related products and services, including but not limited to clothing, footwear, accessories, retail store services, sports equipment, stickers, decals, and hosting/sponsoring athletic events. Thus, Under Armour has established priority of use and registration as a matter of law.

III. URBAN ASPHALT’S MOTION FOR SUMMARY JUDGMENT ON UNDER ARMOUR’S LIKELIHOOD OF CONFUSION CLAIM SHOULD BE DENIED

Likelihood of confusion is determined by considering the factors set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). Only those factors that are most relevant in the instant case need be considered. *Han Beauty, Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). Here, there are genuine issues of material fact as to at least the following key *DuPont* factors: (1) the strength of Under Armour’s UA Marks; (2) the similarity of the parties’ marks, (3) the nature of the parties’ goods and services, and (4) the overlap of the parties’ channels of trade and consumers.

A. The Fame of Under Armour’s UA Marks Raises a Genuine Issue of Material Fact Regarding the Similarity of the Parties’ Marks

Urban Asphalt acknowledges that the fame of Under Armour’s UA Marks is a “relevant factor” that “should be given its full measure of weight” in the likelihood of confusion analysis. It insists, however, that “even assuming” Under Armour can establish the fame of its UA Marks

“the stark dissimilarity between the [parties’] marks in their entirety . . . negates any possibility of likelihood of confusion.” (MSJ 13-14.) Urban Asphalt ignores not only the impact of “fame” on the likelihood-of-confusion analysis, but also the summary judgment standard that all reasonable inferences—including the inferences flowing from the fame of the UA Marks—must be drawn in Under Armour’s favor.

Contrary to Urban Asphalt’s assertions, the fame of a mark plays a “*dominant role in the process of balancing the DuPont factors.*” *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (emphasis added); *Recot, Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1897-98 (Fed. Cir. 2000). As the fame of a mark increases, the degree of similarity between the marks and goods and services necessary to support a likelihood of confusion *decreases*. *Bose Corp. v. QSC Audio Prods.*, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) (emphasis added).

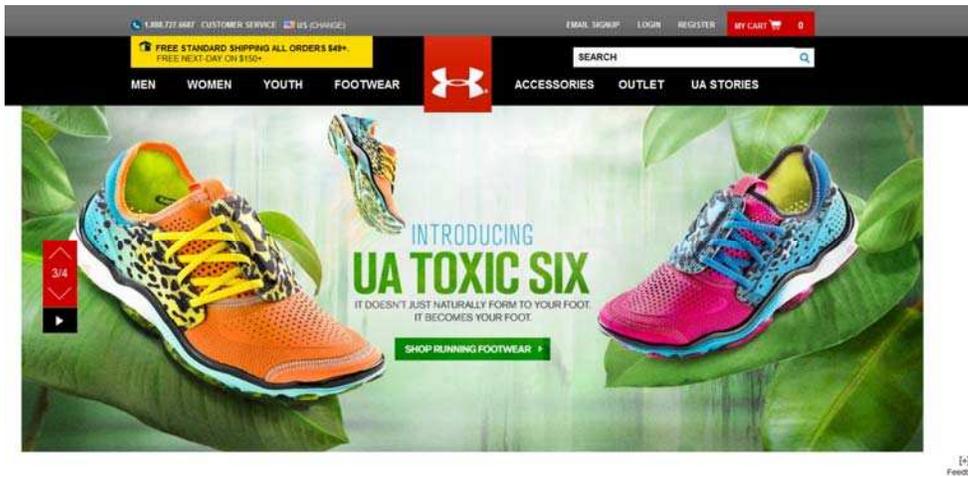
Here, the UA Marks symbolize Under Armour’s identity as a famous brand and are famous in their own right. As detailed below, the UA Marks have long been, and continue to be, an integral and inseparable part of how Under Armour presents itself and its products and services to the public and how the public has come to recognize Under Armour.

Substantial evidence supports the conclusion that the UA Marks are famous. As detailed below, Under Armour has sold billions of dollars worth of products in connection with the UA Marks in the U.S.A.; Under Armour spends tens of millions of dollars promoting the UA Marks through a range of media, including print publications, signage, television, and/or Internet advertising; the UA Marks have appeared in national television advertisements, movies, video games, national magazines, and newspapers; and Under Armour and its UA Marks have received substantial unsolicited media attention and publicity throughout the U.S.A.

1. Under Armour Has Sold Billions of Dollars Worth of Products under the UA Marks

Under Armour has achieved great commercial success under the UA Marks.

(Declaration of Kevin Haley (“Haley Decl.”) ¶ 7.) In 2011, Under Armour’s net revenues were nearly \$1.5 billion and rose to \$1.8 billion in 2012. (*Id.*) The vast majority of Under Armour’s revenues have been from sales in the U.S.A. (*Id.*) The UA Marks are used across Under Armour’s extensive product and service lines, and appear on, or are otherwise used in connection with the sale of, nearly every product Under Armour makes, including over one-thousand different products currently offered on Under Armour’s website, which is hosted at www.UA.com. (Haley Decl. ¶ 8.) As the screen shot from Under Armour’s home page shown below demonstrates, the UA Marks are prominently featured on www.UA.com (Haley Decl. ¶ 11):



Under Armour promotes and sells its products nationwide in over fifteen thousand retail stores, including national, regional, independent and specialty retailers such as *Nordstrom*, *Academy Sports + Outdoors*, *The Sports Authority*, *Dick’s Sporting Goods*, and *Modell’s*. (Haley Decl. ¶ 9.) The UA Marks figure prominently in those retail sales, as such marks appear

on products, product packaging, hang tags, labels, point of purchase signage, in product names, and on third party retailers' websites. (Haley Decl. ¶ 9; Exhibit 1.)

Under Armour also promotes and sells its products under the UA Marks through its catalogs (Haley Decl. ¶ 12; Exhibit 3.) The UA block letter mark has appeared prominently throughout Under Armour's catalogs before Urban Asphalt's filing date and alleged first-use date, as shown below on the cover of a 2006 catalog (*Id.*):

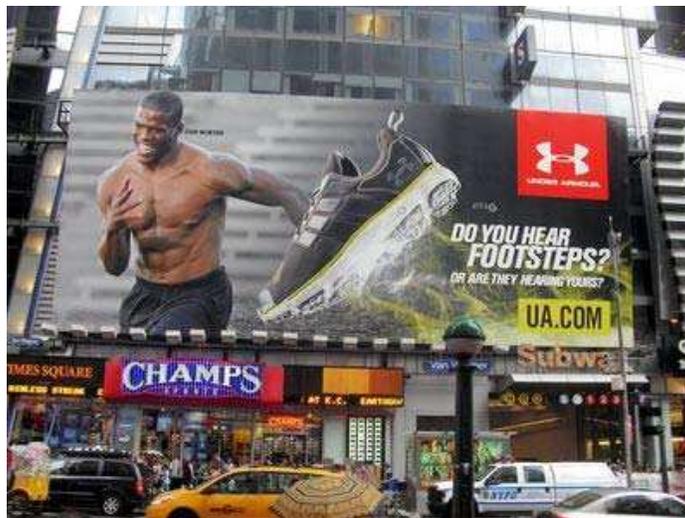


2. Under Armour Has Extensively Advertised and Promoted Its UA Marks

Under Armour spends tens of millions of dollars annually advertising and promoting its UA Marks and products to the general public. Under Armour has advertised and promoted its UA Marks and products through television commercials, including a television commercial that aired during the 2008 NFL Super Bowl, watched by tens of millions of consumers in the U.S.A. (Haley Decl. ¶ 14.) Under Armour has also advertised and promoted its UA Marks and products through product placement in popular movies, such as the conclusion of the latest Batman movie trilogy "The Dark Knight Rises"; "The Rookie," starring Dennis Quaid; "Any Given Sunday," starring Al Pacino and Jamie Foxx; "The Blind Side," starring Sandra Bullock; and "The

among other websites. (Haley Decl. ¶ 17; Exhibit 5.) In addition, Under Armour has advertised the UA Marks through e-mails sent regularly to over 2.6 million customers. (*Id.*)

Under Armour's UA Marks have been featured on billboards and other signage in various cities, including but not limited to Baltimore, Philadelphia, and Times Square in New York City, as shown in the image below. (Haley Decl. ¶ 18; Exhibit 6.)



Under Armour has made significant investments in promoting its products and marks through the sponsorship of professional sports leagues and athletes. (Haley Decl. ¶ 19.) Under Armour has served as an official supplier or sponsor to the National Football League, Major League Baseball, the National Hockey League, the US Ski Team, Major League Soccer, and Major League Lacrosse, among other professional leagues, and products bearing the UA Marks are worn by athletes in these leagues at practices, games and other events. (*Id.*) Professional athletes who are under contract to wear UA-branded clothing include or have included, among others, NFL players Cam Newton (Carolina Panthers), Tom Brady (New England Patriots), Ray Lewis (Baltimore Ravens), and Miles Austin (Dallas Cowboys); UFC fighter Georges St.-Pierre; Alpine skier Lindsey Vonn; 22-time Olympic gold medalist swimmer Michael Phelps; professional skateboarder Mitchie Brusco; professional snowboarders Kyle Clancy, Dylan Bidez,

Spencer Shaw, and Serena Shaw; professional freestyle skiers Sean Jordan, Bobby Brown, Ahmet Dadali, Justin Dorey, and Dash Longe; and professional surfers Knox Harris, Dillon Harrington, and Maddie Peterson. (*Id.*) Under Armour is currently an official supplier to 120 college athletic teams, including football programs at the University of Maryland, Auburn University, and the University of Hawaii, and provides uniforms, sideline apparel, and fan gear to these teams and their schools. (Haley Decl. ¶ 20.)

In addition, Under Armour heavily advertises at various sporting events, and maintains or has maintained billboard advertisements that feature the UA Marks in stadiums such as Camden Yards, Fenway Park, Wrigley Field, and on Jumbotron or video board advertising at NFL football games including the home games of the Baltimore Ravens, Denver Broncos, New York Jets, New England Patriots, Seattle Seahawks, and Atlanta Falcons. (Haley Decl. ¶ 21.)

As a result of Under Armour's substantial efforts to advertise and promote the UA Marks, the public understands "UA" to be synonymous with Under Armour. (Haley Decl. ¶ 22.) Indeed, "UA" serves as Under Armour's stock ticker symbol on the New York Stock Exchange. (Haley Decl. ¶ 6.) A Google query for "UA logo" and "Under Armour" produces 14,200 hits, and the first 30 pages of search results demonstrate that the Internet is filled with websites that make reference to the UA Marks as synonymous with Under Armour. (Haley Decl. ¶ 22; Exhibit 7.)

3. The UA Marks Have Received Extensive Unsolicited Media Attention

Under Armour's significant investment in advertising and promoting its UA Marks, and the company's corresponding growth and achievements, have attracted considerable unsolicited media attention.

Under Armour's products have been featured in newspaper and magazine articles in the nation's most widely circulated publications, such as *Forbes*, *The New York Times*, *USA Today*,

CNN Money, The Washington Post, The Boston Globe, and CNBC.com, among others. (Haley Decl. ¶ 23; Exhibit 8.) As shown in the examples below, the UA Marks are specifically referenced in these articles.

EXCERPT, AUTHOR, ARTICLE TITLE, PUBLICATION NAME, DATE
<p>“The 8,000 square foot “Brand House”--Under Armour’s first full-price store in Baltimore--includes themed merchandise showcasing local neighborhoods. . . Above the shoes, a 7-by-9 foot video board with 330,000 LED lights hangs high. Behind the checkout area a 700-pound Under Armour logo is pasted to the wall.” Ryan Sharrow, “Under Armour Debuts Harbor East ‘Brand House’ Store,” <i>Baltimore Business Journal</i>, February 15, 2013.</p>
<p>“In a chic art space on Mulberry Street in New York City’s Little Italy—amongst a gaggle of journalists, PR folks and a handful of Under Armour “suits” wearing the UA logo lapel pins just where presidential candidates place their American flags . . .” Monte Burke, “Under Armour Unveils its New Products for 2013, with a Little Help from Arian Foster and Gina Carano,” <i>Forbes</i>, February 12, 2013.</p>
<p>“There’s something about President Obama and athletic sportswear maker Under Armour. On Monday night, July 16, the President and First Lady Michelle Obama--along with Vice President Joe Biden--showed up at the Verizon Center in Washington D.C. to watch the USA Olympic men’s basketball team beat Brazil. Obama was wearing a dark blue Under Armour zip-up jacket . . . when a sitting president semi-regularly wears a company’s logo, its bound to get attention.” Scott Van Camp, “President’s Choice of Jacket a B-Ball Game Sparks Buzz,” <i>PRNewsOnline.com</i>, July 17, 2012.</p>
<p>“. . . Under Armour’s logo, an interlocking ‘U’ and ‘A’, is becoming as recognizable as the Nike swoosh.” Daniel Roberts, “Under Armour Gets Serious,” <i>CNNMoney.com</i>, October 26, 2011.</p>
<p>“. . . For its part, Under Armour has nabbed an international sports and style icon. The company is banking that the NFL’s biggest celebrity [Tom Brady] will build awareness of the brand . . . People say they like Under Armour’s high-performance fabrics for summer and winter than can wick sweat or lock in heat. At the same time, the clothing is stylish. The attractive interlocking ‘U’ and ‘A’ logo says, ‘I’m ahead of the swoosh.’ The company says its clothing has been worn by such luminaries as Kim Kardashian, Jennifer Aniston, and Halle Berry . . .” Beth Teitell, “Big Gain for Brady, Straight from the Retailing Playbook,” <i>The Boston Globe</i>, November 16, 2010.</p>
<p>“The Under Armour logo was visible on Tom Brady’s shoes for the matchup against the Dolphins. . .” Darren Rovell, “Tom Brady Steps into Under Armour,” <i>cnbc.com</i>, October 6, 2010.</p>
<p>“Dressed in brown slacks and a white Under Armour shirt, Plank feverishly pounds away on his cell phone, sending text messages and photos from the practice field back to headquarters in Baltimore. He has spotted a big problem with the Auburn team’s practice shorts: The UA Logo is at the top of the hip, obscured by the oversized shirts the players wear untucked. ‘You can NOT see any logo--I would move it to the bottom in the future!’ he types. Then: ‘Let’s get out and see this stuff.’” Thomas Heath, “Taking on the Giants: How Under Armour Founder Kevin Plank is Going Head-to-Head with the Industry’s Biggest Players,” <i>The Washington Post</i>,</p>

<p>January 24, 2010.</p> <p>“Started with savings and credit cards in the basement of his grandmother’s Washington, D.C. townhouse, Under Armour is now a business whose products fly off display racks faster than anything comparable offered by Nike or Reebok, despite their premium prices, retailers say. Boding well for the future: Under Armour has buzz at youth sports venues across the USA, stoked by crafty marketing and endorsements from high-profile athletes. Fickle teens crave the understated ‘UA’ logo and cool styles.” Barbara De Lollis, “No Sweat: Idea for Athletic Gear Takes Him to Top,” <i>USA Today</i>, December 12, 2004.</p>
<p>“It’s not breaking news that Under Armour is the industry’s darling. The brand has been lauded as a shining star for several years running now. And deservedly so. . . Under Armour built on the success, increasing brand awareness by supplying the apparel, with its distinctive logo and tight-fitting look, to college and pro football teams before expanding into the NHL and MLB as well.” Cara Griffin, “David and Goliath: Under Armour Bedevils the Big Boys,” <i>SGB</i>, September 2004.</p>
<p>“The compression-apparel market, which has grown 60 percent in the past year to \$130 million, was essentially created by Under Armour, said Neil Schwartz of the market research firm SportScanInfo . . . ‘If you walk around the high schools and ask the jocks, they say they want Under Armour,’ Schwartz said. ‘It has a cooler logo, and everybody who wears it raves about it.’” Charles Duhigg, “Refusing to Sweat it: U-Md. Football Player’s Quest for Dry Apparel Builds a \$100 Million Market for Under Armour,” <i>The Washington Post</i>, August 18, 2003.</p>
<p>“The company’s big break came when director Oliver Stone used Under Armour in his football movie, <i>Any Given Sunday</i>. Stone called for a futuristic-looking jock strap for Jamie Foxx to wear in a locker room scene with Cameron Diaz. Plank had it stitched up, and seized the chance to plaster an Under Armour logo front and center. When the movie premiered in December 1999, Plank gambled his working capital to buy his first ad, a half page in <i>ESPN Magazine</i>. That and the buzz about Foxx’s eye-popping jock brought \$500,000 in sales almost overnight and boosted the year’s revenues to \$1.35 million.” Elaine Shannon, “Tight Skivvies,” <i>Time</i>, January 2003.</p>

Additionally, many of the athletes, teams, and sporting events sponsored by Under Armour appear on nationally broadcasted television programs and in widely circulated publications, exposing tens of millions of consumers to the UA Marks. (Haley Decl. ¶ 21.)

In short, with millions and millions of Americans, including President Obama and former President Bush, wearing shirts, shoes, jackets, and other items bearing the UA Marks, and with Under Armour instantly associated as the source of those products, fame cannot seriously be disputed.

Urban Asphalt tries to downplay the impact of this evidence, stating that despite the plethora of unsolicited media attention featuring the UA Marks, “the stark dissimilarity between the [parties’] marks in their entireties . . . negates any possibility of likelihood of confusion.” (MSJ 13-14.) But the summary judgment standard requires that the evidence of fame be accentuated, not downplayed. Indeed, all justifiable inferences must be drawn in Under Armour’s favor, not in favor of the movant Urban Asphalt. And concluding that the UA Marks enjoy “game-changing” fame is the reasonable inference from Under Armour’s billions of dollars in sales, tens of millions spent on advertising, and widespread acclaim and recognition of its UA Marks. At minimum, this evidence of fame raises a genuine issue of material fact precluding summary judgment.

B. The Similarity of the Parties’ Marks in Sound, Appearance, Connotation, and Overall Commercial Impression Raises a Genuine Issue of Material Fact

The “similarity or dissimilarity of the marks in their entireties” is a predominant likelihood-of-confusion factor. *DuPont*, 177 USPQ at 567. Similarity as to one element (i.e., sight, sound, or connotation) may be sufficient to find the marks similar. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (TTAB 2000). As stated above, however, the degree of similarity required to support a conclusion of likelihood of confusion declines in relation to the fame of a mark. *Bose Corp.*, 63 USPQ2d at 1309.

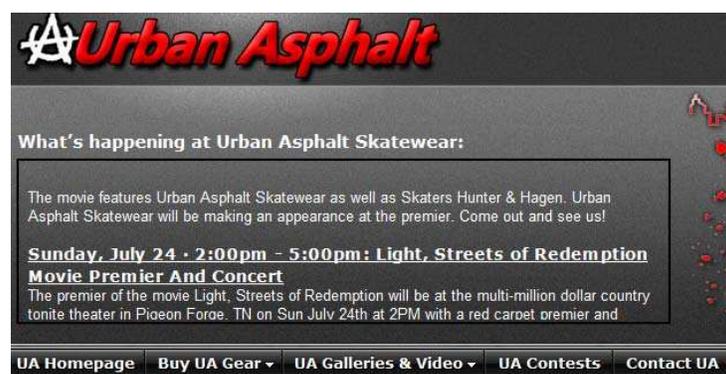
Moreover, it is well settled trademark law that where, as here, the marks appear on “virtually identical goods or services, the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Here, the stylized UA URBAN ASPHALT mark and Under Armour’s UA Marks contain the identical literal component “UA.” Moreover, the stylized UA URBAN ASPHALT mark

presents the letters “UA” in the same format as Under Armour’s stylized UA Mark, i.e., the letter “U” vertically overlaps the letter “A.” Thus, the parties’ marks are similar, particularly considering the fame of Under Armour’s UA Marks and the identical and closely related nature of the parties’ products.

The PTO has already found that the parties’ marks are confusingly similar. Specifically, two Examining Attorneys at the PTO issued Office Actions refusing registration of Under Armour’s Application Serial No. 85209107 for the mark UA in block letters for “stickers” in Class 16 and Application Serial No. 77819895 for the mark UA in block letters for various goods in Classes 9 and 28 based upon a likelihood of confusion with Urban Asphalt’s stylized UA URBAN ASPHALT mark, finding that “the applied-for mark, UA, is confusingly similar in commercial impression to the registered mark, UA URBAN ASPHALT (with design).” (White Decl. ¶ 3, Exhibit 2.)

In addition, Urban Asphalt has used the block letter form of the mark “UA”—identical to Under Armour’s UA mark in block letters—to refer to Urban Asphalt on its Facebook page and website, www.urbanasphaltskatewear.com, as shown below. (White Decl. ¶ 5, Exhibits 3-4.)



The PTO’s finding of similarity between the parties’ UA marks and the use of UA in block letters in some instances by both parties, underscore that at the very least, a genuine issue of material fact exists that precludes summary judgment in Urban Asphalt’s favor.

C. The Parties' Goods and Services Are Identical and/or Closely Related and the Channels of Trade and Consumers Overlap, Making Summary Judgment in Urban Asphalt's Favor Inappropriate

The similarity or relationship between the goods and services of the parties must be made on the basis of the goods and services identified in respective applications and registrations. *See Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octomom Sys., Inc. v. Houston Computer Servs., Inc.*, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990). The goods and services at issue need only be sufficiently related in the minds of the public to find confusion. *Recot*, 54 USPQ2d at 1898.

Here, the goods offered by the parties include products that are identical. Urban Asphalt's registration for the stylized UA URBAN ASPHALT mark covers "decals, paper banners, printed paper signs, stickers" in Class 16 as well as "hats, pants, shoes, t-shirts" in Class 25, among other things. Under Armour's Registration No. 3880683 for its stylized UA mark and Application Serial No. 85209107 for the block letter UA mark covers identical goods in Class 16, namely, stickers. In addition, the remaining goods included in Urban Asphalt's registration, specifically, "hats, pants, shoes, t-shirts" in Class 25 are identical to or directly overlap with Under Armour's clothing products offered under the UA Marks.

The determination of similarity or relationship between the parties' goods must be made based on the goods identified in the opposed application. *Octocom Systems*, 16 USPQ2d at 1787. Where, as here, the identification of goods in the application is not limited to any particular trade channel or class of consumer, the Board presumes that the applied-for goods are offered in the same channels of trade and to the same class of consumers as the opposer's goods. *Packard Press*, 62 USPQ2d at 1005.

Moreover, the record evidence establishes that the parties' channels of trade and class of consumers overlap. Under Armour products are promoted, offered, and sold nationwide,

including at large retailers such as Dick’s Sporting Goods and specialty stores, such as skateboarding store Fishbone—both of which sell Under Armour’s UA-branded products as well as the skateboarding equipment and other products covered by Urban Asphalt’s registration. (Haley Decl. ¶ 10.) Over 15,000 retailers carry Under Armour products, with the vast majority promoting and displaying the UA Marks at point of purchase and in print or online advertising. (Haley Decl. ¶ 9.)

Accordingly, because the parties’ registrations do not restrict the trade channels through which the parties’ goods will be distributed, because the goods are identical, and because Urban Asphalt has stated that its products are promoted through similar means as Under Armour (e.g., social media, television, the Internet), this factor strongly weighs against summary judgment.

D. Lack of Evidence of Actual Confusion Does Not Support a Grant of Summary Judgment

Urban Asphalt alleges that there has been “ample opportunity for confusion to arise in the marketplace” between Urban Asphalt’s mark and the UA Marks, but that Urban Asphalt is “unaware of any instances of action confusion.” (MSJ 16.) Urban Asphalt claims that the lack of actual confusion “weighs strongly against a finding of likelihood of confusion.” (Id.)

But actual confusion is not required to establish likelihood of confusion. *See Herbko International Inc. v. Kappa Books Inc.*, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Weiss Associates, Inc. v. HRL Associates, Inc.*, 14 USPQ2d 1840, 1843 (Fed. Cir. 1990). Indeed, actual confusion is notoriously difficult to document. Even when consumers are confused, they may not voice their confusion. *See, e.g., General Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1604 (TTAB 2011) (“ . . . it is not clear from the record that, even if actual confusion did occur, consumers would report such confusion, making evidence of actual confusion difficult to obtain.”). Accordingly, the lack of evidence of actual confusion does not

dictate a finding of no likelihood of confusion, and does not support Urban Asphalt's Motion for Summary Judgment.

IV. URBAN ASPHALT'S MOTION FOR SUMMARY JUDGMENT ON UNDER ARMOUR'S DILUTION CLAIM MUST BE DENIED

Dilution is defined as the "lessening of the capacity of a famous mark to identify and distinguish goods and services." 15 U.S.C. § 1125; *NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1733 (TTAB 2003). To prevail on its likelihood of dilution claim, Under Armour must show (1) its mark is distinctive; (2) its mark is famous; (3) its mark had become famous prior to the filing date of the involved registration and any date of use established by registrant; and (4) the capacity of its UA Marks to identify its goods and services is likely to be lessened by registrant's mark. *See Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001).

In evaluating fame and distinctiveness, the Federal Trademark Dilution Act sets forth eight non-exclusive factors. 15 U.S.C. § 1125(c)(1); *Toro*, 61 USPQ2d at 1175-76. These factors are the degree of inherent or acquired distinctiveness of the mark; duration and extent of use of the mark in connection with the goods or services with which the mark is used; duration and extent of advertising and publicity of the mark; geographical extent of the trading area in which the mark is used; channels of trade; degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner; nature and extent of use of the same or similar marks by third parties; and whether the mark is registered on the Principal Register. As explained below, an analysis of the relevant factors dictates that there are genuine issues of material fact regarding the fame and distinctiveness of Under Armour's UA Marks. Accordingly, summary judgment on Under Armour's dilution claim in favor of Urban Asphalt is improper.

A. The UA Marks Are Inherently Distinctive

The UA Marks are registered on the Principal Register, without any claim of acquired distinctiveness. These registrations are conclusive evidence of the distinctiveness of the UA Marks. 15 U.S.C. §§ 1057, 1115(b).

B. The UA Marks Have Achieved Widespread Fame

A mark is famous for purposes of dilution if there is evidence of widespread recognition of the mark. *Toro*, 61 USPQ2d at 1180-81. As described above, substantial evidence points to the fame of Under Armour's UA Marks and supports the reasonable inference that Under Armour's UA Marks are famous and merit protection against dilution.

C. There Is No Evidence that the UA Marks Have Been Diluted by Third Parties

Under Armour has been diligent in protecting the UA Marks against likelihood of confusion and dilution. For example, Under Armour has filed notices of opposition and taken other legal actions against third parties using and seeking registration of marks confusingly similar to or dilutive of the UA Marks. (White Decl. ¶ 4.) While Urban Asphalt argues that “there are at least 92 live marks, including the Urban Asphalt Mark, that utilize the letters ‘UA’ together within the respective mark” and that the “acronym ‘UA’ is also synonymous with other well-known brands,” it presents no evidence that any of these alleged marks have been used or promoted at all, much less to an extent that they have made any meaningful marketplace impact or affect the fame and strength of Under Armour's UA Marks. Without such evidence, the Board cannot assess whether there has been any third-party use, let alone whether such use has been so widespread as to have had any impact on consumers. *7-Eleven v. Wechsler*, 83 USPQ2d 1715, 1729 (TTAB 2007); *See Palm Bay Imports*, 396 F.3d at 1374 (requiring evidence that third-party trademarks were well-promoted and recognized by consumers because “[t]he purpose

of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions’”) (citation omitted); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:89 (4th ed. 2012) (“The mere citation of third party registrations is not proof of third party uses for the purpose of showing a crowded field and relative weakness.”). Accordingly, the only reasonable inference to be drawn is that no such uses have impaired the distinctiveness, strength, and fame of Under Armour’s UA Marks.

D. Genuine Issues of Material Fact Exist Regarding Whether Registrant’s UA URBAN ASPHALT Mark Is Likely to Lessen the Capacity of the UA Marks to Identify Under Armour’s Goods and Services

In determining whether dilution is likely to occur, the Board considers a variety of factors: (1) the renown of the senior party; (2) the similarities of the marks; and (3) whether the target customers are likely to associate the underlying products with the mark even if they are not confused as to the origins of these products. *Toro*, 61 USPQ2d at 1193.

For the reasons discussed above, the UA URBAN ASPHALT Mark and the UA Marks are substantially similar. Further, the evidence at the very least supports the reasonable inference that members of the general public, familiar with Under Armour and the UA Marks, are likely to associate Registrant’s stylized UA URBAN ASPHALT mark and products with the UA Marks when they see Registrant’s mark in commerce. Accordingly, Under Armour has established that genuine issues of material fact exist regarding the likelihood that Registrant’s UA URBAN ASPHALT Mark will dilute the UA Marks. Urban Asphalt’s motion for summary judgment of Under Armour’s dilution claim must be denied.

CERTIFICATE OF FILING

This will certify that a copy of the foregoing OPPOSITION TO MOTION FOR SUMMARY JUDGMENT has been filed electronically using the Trademark Trial and Appeal Board's ESSTA online filing system on this 14th day of March 2013. The Declaration of Larry L. White and the Declaration of Kevin Haley, with accompanying exhibits, have been filed by hand at the TTAB.

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing Opposition to Motion for Summary Judgment, with the accompanying declarations and exhibits, was served on March 14, 2013 by first-class mail, postage prepaid, to counsel for Urban Asphalt Skatewear LLC at the following address of record:

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