

THIS DISPOSITION IS  
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UNITED STATES PATENT AND TRADEMARK  
OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Butler

**Mail date: March 8, 2005**

**Opposition No. 91159978**

**Pacific Sunwear of California,  
Inc.**

**v.**

**Pepperdine University**

**Before Quinn, Walters and Bottorff, Administrative Trademark  
Judges.**

**By the Board:**

Applicant seeks to register the following mark



for "clothing, namely, tee-shirts, sweatshirts, sweatpants, hats,  
caps, sweaters, jackets, boxer shorts, socks, tanktops, and  
shorts."<sup>1</sup>

As grounds for the opposition, opposer alleges that  
applicant's mark, when used on the identified goods, so resembles  
opposer's following mark

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<sup>1</sup> Application Serial No. 76523318, filed on June 17, 2003, claiming a  
*bona fide* intention to use the mark in commerce.



for a wide variety of clothing items<sup>2</sup> as to be likely to cause confusion, mistake or to deceive. (This mark may be referred to as KIRRA and wave design at times in this decision.)

In its answer, applicant denies the salient allegations of the notice of opposition.

Discovery was last set to close on December 17, 2004, per opposer's consented motion, filed September 7, 2004, to extend discovery and trial dates. Such motion to extend dates was granted by the Board in an order dated October 19, 2004. This case now comes up on the following matters and motions:

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<sup>2</sup> Such mark is the subject matter of application Serial No. 78234683, filed on April 7, 2003, claiming a *bona fide* intention to use the mark in commerce. The goods identified therein are "men's, women's and children's apparel, namely, hats, caps, visors, hoods, berets, head bands, sweat bands, ear muffs, gloves, mittens, wrist bands, suspenders, belts, socks, stockings, pantyhose, bodysuits, leotards, leggings, sweat socks, thermal socks, shoes, sneakers, galoshes, waders, boots, sandals, slippers, kerchiefs, scarves, mufflers, bandannas, neckerchiefs, vests, pajamas, robes, kimonos, caftans, smocks, aprons, boxer shorts, briefs, underpants, corsets, corselets, girdles, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees, peignoirs, shirts, blouses, knit tops, dresses, skirts, jumpsuits, pant suits, rompers, swimming trunks, wet suits, thermal underwear, undershirts, tunics, tank tops, cotton woven shirts, knit shirts, polo shirts, t-shirts, sweat shirts, crew neck sweaters, v-neck sweaters, turtleneck sweaters, cardigans, suits, jogging suits, shorts, sweat shorts, jeans, pants, slacks, trousers, sweat pants, ski suits, ski pants, ski bibs, capes, shawls, blazers, waistcoats, rain coats, overcoats, top coats, sport coats, parkas, bolero jackets, jackets, wind resistant jackets, outer jackets, leather jackets, ski jackets, flannel jackets, wool jackets, polyester woven shirts, rayon woven shirts, wool woven shirts, leather coats, elastic waist shorts, fixed waist shorts, denim shorts, and denim jackets."

Opposition No. 91159978

- 1) applicant's fully briefed motion, filed November 15, 2004, for summary judgment in its favor;<sup>3</sup>
- 2) opposer's fully briefed motion, filed November 22, 2004, to compel additional discovery depositions of applicant's witnesses on the ground that the single witness deposed was not able to answer questions in numerous areas;
- 3) opposer's fully briefed motion, filed December 13, 2004, for discovery pursuant to Fed. R. Civ. P. 56(f), seeking the same discovery as that sought by its November 22, 2004 motion to compel; and
- 4) opposer's fully briefed motion, filed November 19, 2004, for leave to file an amended notice of opposition to include reliance on opposer's following marks:



(This mark may be referred to as the wave in circle design at times in this decision.)<sup>4</sup>

and

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<sup>3</sup> Opposer responded by seeking Fed. R. Civ. P. 56(f) discovery and, alternatively, addressing the merits of applicant's summary judgment motion.

<sup>4</sup> Such mark is the subject matter of application Serial No. 78478221, filed on September 2, 2004, claiming use and use in commerce since December 31, 2003. The goods identified in the pending application are "men's, women's and children's apparel, namely, hats, caps, visors, belts, socks, shoes, sneakers, sandals, slippers, shirts, knit tops, swimming trunks, tank tops, cotton woven shirts, knit shirts, polo shirts, t-shirts, sweat shirts, crew neck sweaters, v-neck sweaters, shorts, jeans, pants, jackets, wind resistant jackets, outer jackets, leather jackets, fixed waist shorts."

The USPTO status database indicates that the application has not yet been assigned to an Examining Attorney. The Board notes in passing that the status record for the application lists far fewer clothing items than opposer lists in its proposed amended notice of opposition, where opposer lists the same goods for this mark as it does for the originally pleaded KIRRA and wave design mark.



(This mark may be referred to as KIRRA and wave in circle design at times in this decision.)<sup>5</sup>

**Opposer's motion for leave to amend the notice of opposition**

In support of its motion to amend the notice of opposition to plead ownership of the two marks indicated above, opposer argues that it did not delay in moving to amend to include the marks (the applications being filed in September of 2004 and its motion being brought in November of 2004); that applicant will not be prejudiced because it previously had an opportunity to conduct discovery with respect to the marks, though chose not to, and because discovery had not yet closed at the time the motion was brought, thus allowing applicant future discovery opportunities with respect to the marks; and that, if opposer is

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<sup>5</sup> Such mark is the subject matter of application Serial No. 78478188, filed on September 2, 2004, claiming use and use in commerce since December 31, 2003. The goods identified in the application are "men's, women's and children's apparel, namely, hats, caps, visors, belts, socks, shoes, sneakers, sandals, slippers, shirts, knit tops, swimming trunks, tank tops, cotton woven shirts, knit shirts, polo shirts, t-shirts, sweat shirts, crew neck sweaters, v-neck sweaters, shorts, jeans, pants, jackets, wind resistant jackets, outer jackets, leather jackets, fixed waist shorts."

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**Opposition No. 91159978**

not allowed to amend its notice of opposition, it may be necessary to file separate proceedings against applicant's mark.

In response, applicant argues that opposer has delayed because the additional marks were alleged to be used by opposer prior to the commencement of this opposition. With respect to its mark, applicant argues that prejudice to it exists because it has not had an opportunity for discovery on the marks raised by the amended pleading; and because opposer's motion appears to be "a tactic to avoid Applicant's summary judgment motion." Applicant also contends that opposer's amendment is futile because the application filing dates for the marks opposer seeks to include are subsequent to the filing date of applicant's application, and because opposer does not claim to be the prior user of the marks it seeks now to plead.

Once a responsive pleading is served, a party may amend its pleading only with the written consent of the adverse party or by leave of the Board. The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See Fed. R. Civ. P. 15(a); and TBMP §507.02 (2<sup>nd</sup> ed. rev. 2004).

Opposer's motion for leave to amend its notice of opposition to include two additional marks is granted. In view of the Board's decision, *infra*, with respect to applicant's motion for

summary judgment, any prejudice to applicant in permitting the amendment to the notice of opposition is minimal.

**Applicant's motion for summary judgment**

In support of its motion for summary judgment (brought prior to opposer's motion for leave to amend its notice of opposition), applicant argues that, because of the dissimilarities in the parties' marks in sight, sound, connotation, and commercial impression, applicant is entitled to entry of judgment in its favor on the issue of likelihood of confusion. Applicant argues that its mark consists of three stacked and spaced, solid crescent shaped lines with the open portion facing right. With respect to opposer's mark, applicant argues that the design portion consists of a curved, nearly closed ellipse with a surfboard shaped silhouette at the top, and with the open portion of the curve facing left. In addition, opposer's mark includes the word KIRRA, displayed beneath the design. Applicant contends that the design portion of opposer's mark brings to mind surfing and a surfboard in the ocean, with the word KIRRA, while applicant's mark may bring to mind a wave, but just as easily may bring to mind the concepts of a forward moving force, wind, swirling, rolling, or a cyclone. Applicant also argues that the parties' respective goods travel in different channels of trade because applicant sells its goods through its campus bookstores, its athletic department, its university website, and campus

**Opposition No. 91159978**

events. In addition, applicant argues that its intended consumers primarily include its students, alumni and their family and friends.

Applicant's motion is accompanied by the declaration of its marketing director; and the declaration of its attorney introducing opposer's responses to applicant's first set of requests for admission and copies from the TARR database of fifteen registrations for clothing items where the marks consist, at least in part, of crescent shaped "wave" designs.

In response, opposer argues that genuine issues of material fact exist with respect to the appearance, connotation, and commercial impressions of the parties' respective marks. Opposer contends that applicant impermissibly made a side-by-side comparison of the marks, and that the designs in both marks are waves, facing the opposite directions, with opposer's mark including the word KIRRA. According to opposer, the designs in the parties' mark are similar, each comprising three curved shapes along a longitudinal axis having the same angle, spaced the same width apart. Opposer, acknowledging again the word KIRRA in its mark, contends that the parties' marks in their entirety convey the same connotation, meaning and commercial impression of a wave. Concerning the parties' goods, opposer argues that they both offer clothing and many of the clothing items are identical. Opposer argues that the parties' clothing items, bearing their respective marks, will be encountered in the

**Opposition No. 91159978**

same channels of trade by the same classes of purchasers under the same conditions. Opposer also argues that, because of its prior and extensive use of its wave mark and its large investment therein, and because applicant has admitted it has not yet used its mark, an issue of fact exists with respect to the commercial notoriety of opposer's mark. Opposer argues that genuine issues of material fact exist with respect to applicant's intent in the conceptualization and adoption of its mark because applicant's deponent admitted to being aware of third parties who use a wave mark similar to opposer's wave mark.

Opposer's response is accompanied by the declarations of its president, director of design, and attorney, the latter introducing, in part, numerous exhibits, including: the discovery depositions of applicant's marketing director, opposer's president, and opposer's director of design; excerpts from opposer's website showing examples of the goods currently offered by opposer; and excerpts from applicant's website showing the goods currently offered by applicant.

In reply, applicant argues that it has not inadequately analyzed the likelihood of confusion factors<sup>6</sup> as opposer contends. Applicant maintains, assuming for purposes of its summary judgment motion only that the factual allegations in the notice of opposition are true, that there is no likelihood of

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<sup>6</sup> See *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 463 (CCPA 1973).



**Opposition No. 91159978**

confusion due to the dissimilarities of the marks. Applicant contends that opposer has not submitted any evidence showing that a genuine issue of material fact exists with respect to the similarities of the marks, including their respective commercial impressions. Applicant also argues that opposer has not offered any evidence that the parties' respective goods are competitive; and that opposer's claim of "commercial notoriety" lacks foundation.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine issue with respect to material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In the present case, the Board finds that applicant has established the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. The circumstances here are similar to those in *Champagne Louis*

**Opposition No. 91159978**

*Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) and *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in that the single *DuPont*<sup>7</sup> factor of the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion.

In coming to the conclusion that the dissimilarities of the marks are so great as to avoid likelihood of confusion, the Board finds or construes the remaining relevant, presented *Dupont* factors in opposer's favor.<sup>8</sup>

As to its pleaded KIRRA and wave design mark, opposer's constructive use date (application filing date of April 7, 2003) is prior to applicant's constructive use date (application filing date of June 17, 2003).<sup>9</sup>

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<sup>7</sup> *Id.*

<sup>8</sup> In presenting its motion, applicant urges the Board, for purposes of the motion for summary judgment, to assume the truth of the factual allegations of the notice of opposition. Applicant then advocates that no likelihood of confusion exists due to the complete dissimilarity of the marks at issue. Despite this apparent concession of the remaining *Dupont* factors, applicant nonetheless presents arguments with respect to the connotations of the marks, the channels of trade for the goods, and the classes of purchasers for the goods.

<sup>9</sup> It is true that, based on the status of applicant's application and the pending applications for opposer's wave in circle design mark and KIRRA and wave in circle design mark, priority cannot be found or construed in opposer's favor. That is, opposer's applications for these now pleaded marks have a filing date subsequent to applicant's filing date. In addition, opposer's alleged dates of use for these marks are also subsequent to applicant's filing date. See *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216 (TTAB 1992); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991). However, even if opposer's applications were to register, and opposer was able eventually to prove priority,

**Opposition No. 91159978**

Genuine issues of material fact are not found in the parties' arguments concerning the nature of the goods, channels of trade and consumer markets. The identification of goods in applicant's application and opposer's pending applications (as well as opposer's amended notice of opposition) are all for the same and related clothing items; and are unrestricted as to channels of trade, class of purchasers and method of distribution. The question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed. *See Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *Bongrain International (American) Corp. v. Moquet Ltd*, 230 USPQ 626 (TTAB 1986). Accordingly, the Board must presume that the goods identified by applicant and by opposer in its pleaded applications, and as pleaded in its complaint, encompass all goods of the type described, move in all normal channels of trade and under all normal methods of distribution, and are available to all classes of purchasers. *See also In re Diet Center, Inc.*, 4 USPQ2d 1975 (TTAB 1987); and *In re Americor Health Services*, 1 USPQ2d 1670 (TTAB 1986).

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applicant's mark and opposer's marks are so dissimilar that proof of any such priority would not result in raising a genuine issue of material fact as to the similarities of the parties' respective marks.

**Opposition No. 91159978**

The Board understands opposer's arguments concerning the "commercial notoriety" of its marks to amount to a claim of fame, and, for purposes of applicant's summary judgment motion, has construed this factor in opposer's favor.

To the extent that a genuine issue of material fact with respect to applicant's intent in the conceptualization and adoption of its mark may have been raised by applicant's knowledge of opposer's mark,<sup>10</sup> this fact is not material to the Board's decision because the same conclusion on likelihood of confusion is warranted in view of the dissimilarities of the parties' respective marks. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988). That is, a factor listed in *DuPont* is not made material by submission of evidence on the point; rather, the factor must be shown to be material or relevant in the particular case before any evidence offered on the factor should be considered. See *Octocom Systems Inc. v.*

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<sup>10</sup> In support of this factor, opposer's directs the Board to p. 13:1-2 of applicant's Rule 30(b)(6) witness, Mr. Hardman, in support of opposer's position that the witness "... did not know how the mark was designed, and whether the designer used Pac Sun's mark or other third party marks as a basis for his design." However, a review of that portion of the deposition, including several preceding and subsequent pages, indicates that the witness described a development process resulting in the subject mark, in which he participated. In addition, it does not appear that the witness was asked specifically about this information of which opposer argues the witness had no knowledge.

Opposer also directs the Board to p. 42:14-21 of the deposition in support of its position that the witness "... did admit being aware of third party marks who use a wave similar to Pac Sun's Wave Mark." A review of that page of the deposition indicates that the witness admitted being familiar with the wave mark of a single third party (O'Neill), but there is no statement or admission that this single third party wave mark is similar to opposer's wave mark.

**Opposition No. 91159978**

*Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

The Board now turns to the marks in this case, looking first at applicant's mark and opposer's wave in circle design,<sup>11</sup> and considering the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's wave design consists of three, stacked, crescent shapes, opening to the right as one views the mark, forming a C-shape angled slightly downward. The middle crescent is separated by a space from the upper and lower crescent.

Opposer's wave in circle design consists of two stacked, elliptical waves, opening to the left as one views the mark. The lower swing of the top wave merges into the elliptical border that encloses the design element. The lower part of the bottom wave almost closes an ellipse by nearly touching the upper swing of the top wave. In addition, the surfboard element is readily apparent in opposer's wave in circle design.

Similarity of appearance between marks is really nothing more than a subjective "eyeball" test; and similarity of appearance is controlling where designs are involved. See 3 McCarthy on Trademarks and Unfair Competition § 23:25 (4th ed.

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<sup>11</sup> In viewing all inferences in favor of opposer, the parties' respective designs have been considered "waves."

**Opposition No. 91159978**

2004), and cases cited therein. Each party has expended considerable energy discussing their respective designs, and making comparisons to the designs of its adversary. The issue of the similarity of these design marks focuses primarily on the visual similarity of the parties' respective marks. In this case, although the designs in question may be characterized as waves, they are vastly different visually. The suggestive connotation of the different involved wave designs may be common in a broad sense, but this is quite different from concluding that they are the same or similar wave designs. *See, for example, Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988) where the parties' respective house designs were found to be dissimilar.

The inclusion of the term KIRRA in both opposer's KIRRA and wave design and KIRRA and wave in circle design contributes a significant audio-literal component to these mark and, in view of the dissimilarity of the parties' respective wave designs, further serves to emphasize the differences in the involved marks. The absence of the elliptical carrier in opposer's KIRRA and wave design does not negate the dissimilarities of the parties' marks. The elliptical carrier encloses the distinguishing wave design in opposer's KIRRA and wave in circle design mark and the wave floats free in opposer's KIRRA and wave design mark. Applicant's design mark is not enclosed in a carrier. The parties' respective wave designs are so dissimilar

**Opposition No. 91159978**

in appearance, connotation and commercial impression that the presence or absence of a carrier does not result in applicant's mark and the design portion of opposer's KIRRA and wave design mark being suddenly similar such that a genuine issue of material fact exists with respect to the similarities of said marks.

Accordingly, applicant's motion for summary judgment is granted, and the opposition is dismissed with prejudice.<sup>12</sup>

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<sup>12</sup> In view of the disposition rendered in this case, opposer's motion to compel and opposer's motion for discovery pursuant to Fed. R. Civ. P. 56(f) are deemed moot.