

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Opposition No. 91163307

Opposition No. 91163331

Samar, L.L.C., Sara Lee
Corporation and HBI Branded
Apparel Enterprises LLC

v.

Arcticshield, Inc.

**Before Quinn, Holtzman, and Walsh,
Administrative Trademark Judges.**

By the Board:

Arcticshield, Inc. ("applicant") seeks to register the
mark X SCENT¹ and X SCENT and design² in the following form:



both for "clothing, namely, gloves, mittens, footwear,
socks, neckwear, muffs, bib overalls, jackets and coveralls"
in International Class 25.

¹ Application Serial No. 76509381, filed April 25, 2003, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. 1051(b).

² Application Serial No. 76509382, filed April 25, 2003, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. 1051(b).

Saramar, L.L.C., Sara Lee Corporation, and HBI Branded Apparel Enterprises, L.L.C. ("opposers")³ have opposed registration on the ground that applicant's applied-for marks so resembles opposers' registered mark as to be likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act. In the notice of opposition, opposers pleaded ownership of the mark EX-SCENT⁴ for "thermal underwear, tops and bottoms, shirts, t-shirts, pants, turtlenecks, mock turtlenecks, underwear" in International Class 25.

Applicant, in its answers, denied the salient allegations of the notices of opposition and asserted affirmative defenses.

The case now comes up for consideration of opposers' second motion (filed July 18, 2007)⁵ for summary judgment in their favor on the grounds of priority and likelihood of confusion.⁶ The motion is fully briefed.

³ Opposers Sara Lee Corporation and HBI Branded Apparel Enterprises L.L.C. were joined as party plaintiffs with Saramar L.L.C. following successive assignments of the pleaded registration, which is now held by HBI.

⁴ Registration No. 2913784, issued December 21, 2004, alleging December 31, 2003 as the date of first use anywhere and in commerce.

⁵ The Board wishes to apologize for the delay in deciding this motion.

⁶ We note that opposers' first motion (filed March 29, 2005) for summary judgment was denied because, in view of the then-pending counterclaim to cancel opposers' registration, there was a genuine issue as to whether opposers had priority. In its order of March 28, 2007, the Board dismissed applicant's counterclaim to cancel opposers' registration. Opposer is no longer, therefore, precluded from relying on its registration.

In support of their motion, opposers argue that it is indisputable that their pleaded registration establishes its priority over applicant's subject applications; that applicant's marks are confusingly similar to opposers' registered mark in terms of sound, connotation, and spelling; and that the respective goods are nearly identical because they include "highly similar" types of clothing in International Class 25.

As evidentiary support for their motion, opposers have submitted: (1) a soft copy of their pleaded registration; (2) a copy of the contents of the application file for their involved registration, including a copy of the Notice of Revival of Application issued by the USPTO; and (3) a copy of the contents of the application files for each of applicant's involved marks.

In response to the motion, applicant asserts a genuine issue of material fact remains with regard to the issue of priority because opposers' application was in an abandoned status when applicant's marks were published for opposition, and that applicant became both the senior user of the marks in question and the holder of the earliest-filed "un-abandoned" applications; that a genuine issue remains as to the effective filing date to be accorded opposers' allegedly revived application; and that without the evidence produced

by discovery, any determination as to likelihood of confusion between the marks at issue is inappropriate at this stage of the proceedings. We note that applicant's response brief is not accompanied by any evidentiary support.

In their reply brief, opposers assert that applicant's arguments that it is the "senior applicant" are simply false; that opposers are clearly the "senior applicant" because of their earlier filing date; and that the Federal Circuit and this Board have consistently held that the question of likelihood of confusion can be determined on summary judgment.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 4 USPQ2d 1793 (Fed. Cir. 1987). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party

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is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial.

The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Systems Inc. v. Houston Computer Services Inc.*, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990), citing *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 221 USPQ 561, 564 (Fed. Cir. 1984). A dispute as to a material fact is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. See Fed. R. Civ. P. 56(c), *Celotex Corp.*, 477 U.S. at 322-323. Finally, in deciding a

motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant, and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

As an initial matter, applicant admits in its brief that opposer Saramar L.L.C. owned the application which issued into Registration No. 2913784. (Brief p. 1). Thus, opposers' standing, that is, its real interest in this proceeding, has been established. See *Lipton Industries Inc. v. Ralston Purina Co.*, 213 USPQ 185 (CCPA 1982).

Turning first to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In this particular case, the two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective goods. See *Federated Foods,*

Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). There is no genuine issue of material fact that the marks at issue are similar. Opposers' mark EX SCENT is identical in sound to applicant's two marks X SCENT. "EX" and "X" are phonetic equivalents and the second element of each mark, SCENT, is the same. The marks are similar in appearance. The structure of the wording in each mark is the same. The only visual difference is the deletion of the letter "E" from applicant's first element. The marks also share a common meaning. The identical term SCENT, preceded by "X" or "EX", conveys the same connotation, i.e., masking scents or inhibiting scents. Moreover, it is important to note that the design feature of one of applicant's involved marks contributes little if anything to the connotation of the mark, and does not suffice to distinguish the mark in terms of connotation.

With regard to the similarity of the goods at issue, we find the goods identified in applicant's involved applications, "clothing, namely gloves, mittens, footwear, socks, neckwear, muffs, bib overalls, jackets and coveralls" are closely related to the goods recited in opposers' registration - "thermal underwear, tops, bottoms, shirts, t-shirts, pants, turtlenecks, mock turtlenecks, underwear." While we recognize that the respective goods are, for the most part, specifically different items of apparel, it is

nonetheless the case that most, if not all, of the goods are complementary, cold weather apparel. Applicant's gloves and muffs would be worn with opposers' thermal underwear and turtlenecks. Moreover, applicant's "bib overalls" and opposers' "pants" are virtually identical in that they serve the same function, and "pants" may be construed to include "bib overalls." Additionally, the purchasers for such goods are identical, namely, ordinary consumers, who would purchase the goods with nothing more than ordinary care.⁷ Hence, the circumstances are thus such that if the goods at issue were to be marketed under the same or similar marks, confusion as to the source or affiliation of such goods would be likely to occur.

We conclude that consumers familiar with opposers' clothing items sold under the EX-SCENT mark would be likely to believe, upon encountering applicant's apparel sold under the mark X SCENT and X SCENT and design, that the goods

⁷ We note that in the absence of any limitations in the parties' identifications of goods, we must presume that the goods move through all reasonable trade channels for such goods to all usual classes of consumers for such goods. *Schieffelin & Co. v. Molson Companies Ltd.* 9 USPQ2d 2069, 2073 (TTAB 1989); *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) ["[W]here the goods in a cited registration are broadly described and there are no limitations in the identifications of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers."].

originate with or are associated with or sponsored by the same entity.

Accordingly, based on the foregoing, we find that there is no genuine issue of material fact for trial with regard to the claim of likelihood of confusion.

Turning next to the issue of priority, we note that generally priority is not an issue in an opposition proceeding in which the opposer relies on an unchallenged pleaded registration. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Here, opposers rely on their Registration No. 2913784.

The copy of the registration submitted with opposers' motion, however, was not prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. Nor did opposers submit a status and title copy or any other proof of the status and title of their pleaded registration with their prior motion for summary judgment or their notice of opposition. Accordingly, opposer has not as yet demonstrated the absence of a genuine issue of material fact regarding its priority. See TBMP Section 704.03(b)(1)(A) (2d ed. rev. 2004).

In view of the foregoing, opposers' motion for summary judgment on the likelihood of confusion claim is well-taken. Nevertheless, since opposers have failed to submit a status

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and title copy of Registration No. 2913784, there exist genuine issues of fact as to the validity and ownership thereof. Accordingly, opposers are allowed until **30 days** from the mailing date set forth in the above caption to submit a status and title copy of Registration No. 2913784, failing which this case will go forward to trial on the issue of priority.

Proceedings herein are otherwise suspended.