

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
October 24, 2008

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January 12, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ironman Magazine

v.

World Triathlon Corporation

Opposition No. 91167894
to application Serial No. 76521771
filed on June 10, 2003

Joan Optican Herman and Cheryl L. Burbach of Hovey Williams
LLP for Ironman Magazine

Joseph J. Weissman of Johnson, Pope, Bokor, Ruppel & Burns,
LLP for World Triathlon Corp.

Before Sams, Chief Administrative Trademark Judge, Seeherman
and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Ironman Magazine, a California partnership, has opposed
the application of World Triathlon Corporation to register
IRONMAN and design, as shown below, as a trademark for the
following goods:

Adult nutritional supplements in powder,
liquid and bar form; food and vitamin
supplements; dressings, namely, wound
dressings and adhesive bandages; wound

treatment remedies, namely medical cleansers in the form of creams, sprays, antibiotics; corn creams, lotions and ointments; blister creams, lotions and ointments; callus creams, lotions and ointments; athletes' foot preparations including powder, lotions and creams.¹

The logo for IRONMAN, featuring the word "IRONMAN" in a bold, black, sans-serif font. Above the letter "I" is a solid black circle, which is the Iron Man helmet. The letters are closely spaced and have a slightly distressed or textured appearance.

Opposer has brought this proceeding on the ground of likelihood of confusion, alleging that opposer and its predecessor in interest have, since 1936, used the marks IRON MAN and IRONMAN in connection with the business of publishing and distributing a magazine directed to the bodybuilding and weight training industry; that since prior to applicant's claimed date of first use of September 1998, opposer has sold weight training equipment and accessories, bodybuilding equipment and accessories, weight training videos, booklets and other publications directed to nutrition, training and supplementation, and other health, fitness and nutritional products, marketed under opposer's marks; that opposer, through its IRON MAN magazines and its on-line retail business HOME GYM WAREHOUSE and its www.ironmanmagazine.com website, has used opposer's marks in connection with the sale of health and nutritional

¹ Application Serial No. 76521771, filed June 10, 2003, based on a claimed date of use and use in commerce as of September 1998.

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products and supplements, marketed under opposer's brand MUSCLE-LINC [*sic*]; that opposer has used the mark IRON MAN TRAINING AND RESEARCH CENTER for ten years as a column in its IRON MAN magazine and as a research facility directed to issues of training and nutrition; that opposer's marks are inherently distinctive; and that applicant has appropriated the whole of opposer's mark in the word portion of its mark.

In its answer applicant has admitted that opposer's IRONMAN mark consists of the same word as applicant's IRONMAN mark, and has otherwise denied the salient allegations of the notice of opposition.

The record includes the pleadings; the testimony, with exhibits, of John Balik, the managing partner of opposer and the publisher of its magazine and of Benjamin Fertic, president of applicant. During its main testimony period opposer made of record, by notices of reliance, various printed publications. Trademark Rule 2.122(e). During its rebuttal testimony period opposer also submitted, under a notice of reliance, applicant's responses to opposer's interrogatories and requests for production of documents. It should be noted that documents produced in response to document production requests cannot be made of record by notice of reliance, see Trademark Rule 2.120(j)(3)(ii). However, the responses submitted by opposer do not include any produced documents; rather, they merely contain

objections to particular document production requests, or statements that the documents will be produced. Further, applicant has specifically stated in its brief that the notice of reliance forms part of the record. Accordingly, we have treated the materials submitted with the notice of reliance as being of record. Applicant has submitted, under a notice of reliance, opposer's responses to applicant's first set of interrogatories, and status and title copies of certain of applicant's registrations, as set forth below:²



for

deodorants, antiperspirants, deodorant body sprays, non-medicated deodorant and antiperspirant wipes;³ watches and chronometers sold in association with contests consisting of running, biking and swimming;⁴ entertainment services, namely, presentation of athletic contests featuring running, swimming and biking;⁵

IRONMAN TRIATHLON

with "triathlon" disclaimed,
for

² Additional registrations were introduced during the testimony deposition of Benjamin Fertic.

³ Registration No. 2787455, issued November 25, 2003.

⁴ Registration No. 2350149, issued May 16, 2000; Section 8 & 15 affidavits accepted and acknowledged.

⁵ Registration No. 1353313, issued August 6, 1985; Section 8 & 15 affidavits accepted and acknowledged; renewed.

sun block, perfumes, cologne, skin lotions, personal deodorant, body and massage oils, marketed in association with contests consisting of running, biking and swimming;⁶ clothing, namely, shirts, shorts, hats, shoes, headbands and wristbands, pants, pajamas, belts and sweatshirts marketed in association with contest consisting of running, biking and swimming;⁷ entertainment services namely arranging and conducting athletic competitions consisting of running, swimming and biking;⁸

IRONMAN TRIATHLON
(without disclaimer)
for

non-carbonated soft drinks, namely, bottled water⁹; and



(with "nutrition" disclaimed)
for

food and vitamin supplements.¹⁰

⁶ Registration No. 2384055, issued September 5, 2000; Section 8 & 15 affidavits accepted and acknowledged.

⁷ Registration No. 1705114, issued August 4, 1992; Section 8 & 15 affidavits accepted and acknowledged; renewed.

⁸ Registration No. 2869852, issued August 3, 2004.

⁹ Registration No. 2571690, issued May 21, 2002. Office records do not indicate that a Section 8 affidavit has been filed as yet. However, because the Office does not cancel registrations for failure to file a Section 8 affidavit until it can be determined that the affidavit was not filed within the grace period, which expired in this case on November 21, 2008, we have treated the registration as still being in effect. In any event, whether or not the registration is in effect does not affect our decision in this proceeding.

¹⁰ Registration No. 2325508, issued March 7, 2000; Section 8 & 15 affidavits accepted and acknowledged.

The proceeding has been fully briefed, and both parties were represented at an oral hearing before the Board.¹¹

IRON MAN Magazine was started in 1936 by Peary and Mabel Rader, and it is the oldest bodybuilding magazine in the world in continuous publication. In 1986 opposer became the owner of the magazine. Opposer's witness, John Balik, frequently used the word "I" when testifying about the transaction, so it is not entirely clear whether the transfer of the entire business was made to opposer, consisting of Mr. Balik and his partners, or to Mr. Balik himself. For example, Mr. Balik testified:

In 1986 on its 50th anniversary myself and partners purchased it [the magazine] from [Peary Rader] and 21 years later, here we are. p. 17

And in August of '86, I believe, I have to go back to the contract, I think it was August 4th of '86, I signed the contract, and we got our first issue out. The magazine was being created by my partner and I, the two of us, and one freelance art person.... p. 23

What I purchased [from the Raders] was the subscription list, all the copyrighted material within the magazine. There were a great deal of back issues, there was equipment. Iron Man placed all kinds of - they were very

¹¹ Both parties filed portions of their testimony and exhibits as confidential, and also filed confidential as well as redacted copies of their briefs. We note that some of the information that has been redacted from the briefs is not based on evidence that was submitted under seal. Because the parties were quite specific as to what portions of the testimony depositions and exhibits were filed under seal, we have treated as confidential only that specifically identified information.

big in the barbell and equipment
business at that point. And, of course,
good will. p. 23-24

Of record is an assignment document, executed on October 7, 1986, stating that pursuant to the agreement for the sale of business between Peary and Mabel Rader to John Balik and his wife, Stephanie Bier, the Raders assigned the trademark IRON MAN, along with the goodwill of the business. There is also an assignment from Mr. Balik and Ms. Bier assigning nunc pro tunc December 1, 1986 the trademark IRON MAN to the California partnership known as "Ironman Magazine." Thus, at the very least, the documents of record and testimony reflect that the trademark IRON MAN was transferred from the Raders, the original owners, and that it became the property of opposer, via Mr. Balik, the managing partner of opposer.

When the Raders published the magazine, IRON MAN was depicted as two words. During the 20-plus years that opposer has been the publisher the mark has changed slightly, so that it appears sometimes as a single word, IRONMAN; sometimes with the elements IRON and MAN in slightly different sizes, so that it gives the impression of two words although there is no space between them; and sometimes as two words. Currently the magazine uses IRON MAN as two words on the front and as one word on the back. In our findings of fact we have attempted to reflect the usage shown on the exhibits for the relevant time.

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According to Mr. Balik, at the time opposer purchased the publication, IRON MAN had a worldwide reputation within the world of bodybuilding. Opposer increased the circulation from 3500 copies published bimonthly to a current monthly publication averaging 175,000 copies. The magazine's readership is primarily people who lift weights and train seriously. Opposer promotes IRON MAN magazine through trade shows, in particular the annual trade show associated with the International Federation of Bodybuilders' major event, the Iron Man Pro and Fit Expo, which draws bodybuilders from all over the world. Opposer has exhibited at this show for over 20 years. Opposer has licensed the mark Iron Man Naturally for bodybuilding events held around the country, and has been involved in contests, including its predecessor-in-interest's involvement with the Mr. Ironman contest starting in 1954. Opposer has also sponsored competitive bodybuilding television programs. Opposer has a website, www.ironmanmagazine.com. In addition, opposer advertises IRON MAN subscriptions and booklets through an affiliate program using 4000 websites. Opposer also advertises its books and videos, discussed below, in third-party bodybuilding magazines.

In addition to the magazine, opposer produces a weekly electronic newsletter, IRON MAN TRAINING E-ZINE, which is distributed to 40-50,000 people. Opposer also produces

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booklets or bulletins on training, e.g., "Ironman's 10-Minutes to Granite Abs," © 1996 (Balik Exhibit 7) and "Ironman Bulletin #1 10-Week Size Surge A Crash Course for Packing on Muscle Weight," © 1995 (Balik Exhibit 8). In addition, opposer sells IRONMAN Videos, e.g., "Ironman's Critical Chest & Delts," January 1996 (Balik Exhibit 9) and IRONMAN clothing such as jackets, muscle shirts, hooded fleece and denims. Opposer began selling videos and clothing at least as early as 1995 and still sells them.

During the Raders' ownership of the magazine they advertised and sold Iron Man Barbells and Iron Man training equipment such as gym benches, calf machines and squat racks. See Balik exhibit 5, IRON MAN magazine July 1968 issue.¹² They also used the mark on belts and straps. Opposer continued to sell training equipment, in particular, plates, after it took over the magazine. The ads clearly show that the items are being ordered from "Ironman Products." However, although opposer still has in stock barbells or weights with the IRON MAN logo on them, opposer had not sold any in the two-to-three years prior to Mr. Balik's deposition, and does not actively advertise them.

¹² The advertisement states that the equipment should be ordered from "Body Culture Equipment Co." in Alliance, Nebraska. Other ads on the same page show this same address for Iron Man Magazine. The ad copy says that these products are being presented to "readers of Iron Man."

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Opposer also sells and endorses nutritional supplements. The Raders began writing about the importance of nutrition in the 1950s, and opposer has continued to include articles about supplements and nutrition. It runs a feature in its magazine called Ironman Research and Training Center in which it reviews products, primarily food supplements, and also produces booklets or bulletins on nutrition. See Balik Exhibit 10, "IRONMAN Magazine Special Report Eat to Grow." Companies can and do advertise opposer's endorsements of their products by reprinting the magazine articles.

Opposer's predecessor sold protein supplements under the IRON MAN mark in the 1950s or early 1960s, but this stopped in 1963-64. Since at least 1995 opposer has sold supplements, but uses the mark MUSCLE-LINK rather than IRON MAN. Opposer did so in order not to offend companies that advertise their own nutritional supplements in IRONMAN magazine, since the magazine gets much of its revenue from supplement advertisements.

On November 15, 1986, shortly after the transfer of the Raders's business to Mr. Balik and Ms. Bier, Mr. Balik and Ms. Bier entered into an agreement with the Hawaiian Triathlon Corporation, applicant's predecessor-in-interest, in order to settle an opposition brought by Peary Rader and a cancellation proceeding brought by Balik and Bier against,

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respectively, an application and a registration owned by Hawaiian Triathlon Corporation. By this agreement Balik and Bier agreed to withdraw their petition to cancel Registration No. 1353313, which registration is for the same mark at issue herein, for presentation of athletic contests featuring running, swimming and biking, and Hawaiian Triathlon Corporation agreed to abandon its application for this mark for items of clothing. The agreement further provided that

each party can market sportswear and other goods relating respectively to body building on the one hand and [applicant's] triathlon events on the other under the respective marks IRON MAN accompanied by the words "The World of Body Building" or IRON MAN MAGAZINE and IRONMAN TRIATHLON and that each party has the right to register its said mark for such goods.

¶3.

Applicant runs triathlon competitions. The triathlon competition started in 1978 in Hawaii, and has been held on an annual basis since then. In 2007 there were 1700 participants, and the event is so popular that there are qualifying races which draw a total of 60,000 participants.

The championship race has been broadcast on television since 1980, first on ABC and then NBC, and since the early 1990s the various races are also shown on cable networks such as ESPN, as well as on local stations and through the Internet. In addition, since 2005 NBC has broadcast a

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second triathlon held in Clearwater, FL. Millions of viewers have seen the events. The triathlons have also received publicity in print media such as "Sports Illustrated," "The New York Times" and "USA Today," and through applicant's own website and the websites of others.

Applicant has licensed its IRONMAN marks for numerous items, including watches, bicycles, fitness equipment and nutritional supplements. Since 2003 it has entered into agreements with approximately 30 licensees. Other companies are sponsors of the race, and advertise this fact; for example, Nabisco puts this information on its Fig Newton packages. As of April 1996 one of applicant's licensees sold PR IRONMAN TRIATHLON energy bars, and in 1998 its licensee Twinlab first shipped TWINLAB IRONMAN TRIATHLON nutrition products.

Applicant has existing registrations for the "M-Dot IRONMAN" mark, which is the way applicant refers to the mark that is the subject of the instant application, for various goods.

Before turning to the question of likelihood of confusion there are some preliminary matters we must address. In its brief applicant has contended that the chain of title for IRON MAN MAGAZINE is "murky." P. 11. Although applicant states that "there is no dispute that Peary and Mabel Rader were the creators and original owners

of *Iron Man Magazine*, ... [and] that the Raders assigned Mr. Balik and his wife Stephanie Bier the trademark "Iron Man"... on October 7, 1986," brief, pp. 10-11, and notes Mr. Balik's testimony that Mr. Balik and his partners Michael Neveux, Irving Bier, Sydney Bier and Mario Gambetta bought *Iron Man Magazine* in 1986, applicant suggests that Mr. Balik and his wife never transferred title of *Iron Man Magazine* to opposer. Applicant bases this claim on the fact that Mr. Balik and his wife executed a nunc pro tunc assignment of the mark to opposer effective December 1, 1986. As a result, applicant appears to contend that the business was sold to opposer in October 1986, but the trademark was not assigned to opposer until December 1986, so that there was a gap of two months during which the business and the trademark were separated. Applicant also suggests another scenario, that although Balik and Bier assigned the mark to opposer, because no document is of record in which they assigned the *business*, the business and the mark have been "separated" since 1986. Applicant also contends that there is no evidence that opposer, a partnership, exists at all.

We point out that applicant never raised these issues in its answer. Although opposer clearly has the burden to prove its prior use of the unregistered trademark IRON MAN in order to succeed on its claim of likelihood of confusion, opposer has met this burden by its testimony and exhibits

that the magazine IRON MAN was published by opposer prior to applicant's claimed first use. By waiting until its brief to raise questions about opposer's reliance on the Raders' prior use, applicant has denied opposer the opportunity to present evidence to respond to these questions. We note that during the cross-examination of opposer's witness, John Balik, applicant's counsel questioned Mr. Balik about the nunc pro tunc assignment, but these questions were not sufficient to put opposer on notice that applicant was suggesting that there was an assignment in gross because opposer was publishing the magazine when the trademark was owned by Mr. Balik and his wife. Nor did applicant's counsel's questions about when various partners left the partnership put opposer on notice that the existence of this partnership or opposer's ownership of the business was being called into question. Thus, we do not consider the issue of an assignment in gross or ownership of the mark to have been tried.¹³

We also clarify that the issue of whether applicant had the right to file the subject application, or was precluded by contract from doing so, is not before us. Although, as

¹³ We also point out that Mr. Balik has at all times been the managing partner of opposer. Thus, even if there were a gap between Mr. Balik and his wife obtaining the trademark from the Raders and then transferring it to opposer, Mr. Balik was clearly exercising control over the use of the trademark since the business and trademark were assigned by the Raders.

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noted above, there was a 1986 agreement between the parties which specifically provided applicant with the right to market sportswear and other goods relating to its triathlon events under the mark IRONMAN TRIATHLON and the right to register its mark for such goods, opposer did not raise as a ground for opposition that the agreement prevents applicant from using or registering the applied-for mark for goods or services other than the presentation of athletic contests featuring running, swimming and biking. Nor, despite questions directed to Mr. Balik regarding opposer's knowledge of applicant's use of IRONMAN for energy bars and weight training equipment, and applicant's submission of registrations for IRONMAN marks for such goods, is there any issue of laches. This defense was not raised; further, since this proceeding was brought during the opposition period, laches would not apply. See *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

Thus, the sole ground we consider here is that of priority and likelihood of confusion.

First, we find that opposer has demonstrated its standing by its evidence regarding its use of the trademark IRON MAN and variations thereof. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

As for priority, as noted above, there is some testimony that opposer's predecessor used the mark IRON MAN for nutritional supplements in the 1950s and early 1960s. However, this use ended substantially before opposer took over the business in 1986, and any rights that might have accrued with respect to these goods were long ago abandoned. Thus, opposer's rights in terms of establishing its priority rest on its use of the mark for publications. There is no question that opposer, through its predecessor-in-interest, has used the mark IRON MAN since 1936 for a magazine. This is substantially earlier than any date on which applicant can rely for the use of its applied-for mark for its identified goods.

With respect to the issue of likelihood of confusion, this case presents a somewhat unusual situation in that the parties involved have both used similar marks for a number of years. In the early years of their coexistence, their activities were devoted to somewhat different audiences, and were somewhat limited, and in 1986 they entered into a coexistence agreement, presumably in recognition of that fact. However, through the years both parties, and in particular applicant, have expanded the goods and services in connection with which they use their marks, and the marks themselves have undergone some changes. We must therefore consider whether the mark applicant now seeks to register,

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as used on the goods that are the subject of its involved application, is likely to cause confusion with the mark and goods for which opposer has rights. In reaching this decision, we must consider the evidence that is relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Turning first to the goods, opposer has shown that it has prior rights in the mark IRON MAN for a magazine devoted to bodybuilding. There are, obviously, differences between magazines and the nutritional and medicinal products that are identified in applicant's application. However, it is not necessary that the goods or services of applicant and the registrant be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Opposer has focused its claim of likelihood of confusion on applicant's use of its mark for nutritional

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supplements. Because likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application, see *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981), we too limit our discussion of applicant's goods to nutritional supplements. Opposer has shown that nutritional supplements are related to bodybuilding magazines. The readers of bodybuilding magazines are interested in nutrition and nutritional supplements, and opposer's magazine and ancillary publications contain articles on or are devoted to nutrition, including discussing and endorsing nutritional supplements. Many of the advertisements in the magazine are for nutrition products. Thus, the magazine and nutritional supplements are complementary in nature, and the purchasers are the same.

Further, the record shows that through the years opposer has sold goods connected with bodybuilding, thus showing the related nature of such goods and the publication. For example, opposer has sold, under the mark IRON MAN or IRONMAN, weight plates and bodybuilding/weightlifting videos. Moreover, opposer produces both magazines and nutritional supplements, thereby showing that both products can emanate from a single entity. It is true that opposer does not use the same mark for its supplements

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as it does for its magazine, but this is not because customers would not associate both types of products with a single source. On the contrary, it is because the mark IRON MAN for supplements is likely to cause people to view the goods as emanating from the publisher of IRON MAN magazine that opposer has chosen to use a different mark for its supplements, in order not to jeopardize its advertising revenue from third-party supplement manufacturers. In this sense, opposer has not merely asserted a theoretical belief in confusion in order to succeed in this opposition proceeding. Rather, many years prior to bringing this proceeding, opposer's adoption of a different mark from its IRON MAN magazine mark for its nutritional supplements manifested its belief that consumers would view bodybuilding magazines and nutritional supplements marketed under the same mark as coming from a single source.

In *The Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579 (TTAB 1979), which involved the question of whether VOGUE for travel agency services was likely to cause confusion with VOGUE for magazines, the Board identified four types of situations in which magazines and goods and services were found to be related. One such situation exists when the goods or services of the defendant are of a type normally featured in the plaintiff's magazine and/or there is some type of advertising tie-in between

goods or services of this type and the magazine. That is certainly the situation here. See also *In re Cruising World, Inc.*, 219 USPQ 757 (TTAB 1983), in which CRUISING WORLD for outlet services for yachts and marine accessories was found likely to cause confusion with CRUISING WORLD for magazines. Applicant attempts to distinguish the VOGUE case on the basis that the plaintiff's mark therein was well-known. First, although we do not find opposer's mark to be famous, as discussed infra, the evidence is sufficient to show that it is well-known in the bodybuilding world. Second, the same result obtained in the Cruising World case, and there was clearly no evidence in that ex parte decision with respect to sales or advertising of the registrant's mark. Applicant tries to distinguish the latter case on the basis that applicant's goods appeal to a different audience than does opposer's magazine. However, applicant's goods are nutritional supplements, and it is clear from the articles and advertisements in opposer's publications that nutritional supplements are of interest to opposer's customers.

The du Pont factor of the relatedness of the goods favors a finding of likelihood of confusion.

The next du Pont factor we consider is the strength of opposer's mark. Opposer and/or its predecessors have used the mark IRON MAN for a bodybuilding magazine for over 70

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years, and the testimony is that this mark is well-known in the world of bodybuilding. While we conclude from this evidence that the mark is strong and well known in this limited area, we find that the mark has not achieved the notoriety of a famous mark. In reaching this conclusion we recognize that the proper legal standard for evaluating the fame of a mark under the fifth du Pont factor is the class of customers and potential customers of a product or service, and not the general public. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). However, because the record does not give us any context for opposer's circulation figures, or otherwise provide objective evidence of the recognition of the mark, we cannot conclude that the mark is famous. In saying this, we are mindful of the great weight to which a famous mark is entitled, and therefore the requirement that fame be clearly proven.

Applicant has submitted substantial evidence as to the fame of its various IRONMAN marks. This evidence is not relevant to the du Pont factor of fame, since that factor refers to "the fame of the prior [i.e., opposer's] mark."¹⁴

¹⁴ Despite applicant's assertion that it is the prior user because it is the first user of an IRONMAN mark on nutritional supplements, it is clear that opposer is the first user of the mark IRON MAN, with such use being for magazines.

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Great weight is given to a famous mark of the senior user in order to discourage junior users from adopting a similar mark and getting a free ride on the efforts that the senior user has expended.

A competitor can quickly calculate the economic advantages of selling a similar product in an established market without advertising costs. These incentives encourage competitors to snuggle as close as possible to a famous mark. This court's predecessor recognized that a mark's fame creates an incentive for competitors "to tread closely on the heels of [a] very successful trademark."

Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (citation omitted). However, applicant has not pointed to any case law where the fame of the junior user's mark plays a similar role. Thus, we consider applicant's evidence of fame in terms of the factor of the similarity of the marks, since it is essentially applicant's position that its mark is so well-known that consumers who view the IRONMAN and M Dot mark on nutritional supplements will associate it with applicant rather than opposer.

Opposer's IRON MAN mark, whether it is viewed as one or two words, is extremely similar to applicant's mark. The marks are identical in pronunciation and connotation. As for appearance, the presence or absence of a space between IRON and MAN does not serve to distinguish the marks. First, there is evidence that opposer used the mark as one

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word before applicant's adoption of its applied-for mark for nutritional supplements. More importantly, even if we consider opposer to have rights only in the two word form of its mark, consumers are not likely to note or remember that applicant's mark is one word or differentiate the marks on this basis.

Applicant's mark also contains a dot over the "M" in IRONMAN. Although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, it is clearly the word IRONMAN which is the dominant feature of applicant's mark. Many customers are likely not to notice the dot over the M in applicant's mark, or will see the dot only as a meaningless shape, and will view the "M" as just a letter, rather than a human figure, such that the mark as a whole will be perceived only as IRONMAN in block letters. Although consumers who compare the marks side-by-side are likely to note that there are differences between them, that is not the test. Rather, the question is whether the marks are sufficiently similar in their entireties such that confusion as to the source of the goods offered under the

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respective marks is likely to result. Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang, 84 USPQ2d 1323 (TTAB 2007). Further, even if some consumers recognize the combination of the M and the dot as forming an abstract design of a human figure, the design merely reinforces the meaning of the word IRONMAN, a significance that is equally applicable to opposer's mark IRON MAN for a magazine for bodybuilders. Therefore, the marks convey the same commercial impression, and the design element in applicant's mark does not serve to distinguish the marks.

In this connection, the evidence of record is insufficient for us to conclude that the dot with the M design is so well-recognized by the consuming public that they will distinguish applicant's mark from opposer's essentially by the dot alone. In its brief applicant quotes its witness's testimony that applicant has "spent millions of dollars advertising not only just the [M-Dot IRONMAN logo] but the M-Dot as well, separately and together." Brief, p. 26. The quoted language was in response to the question, "Do you see any confusion with any Ironman-branded product, as the Ironman mark appears [in the drawing of the subject application] and Ironman Magazine?" and the response was made as part of the expression of a general opinion on the issue of likelihood of confusion. The response does not provide any details regarding applicant's advertising of the

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M Dot alone, nor do the exhibits of record show such usage of the M Dot per se in advertising that we can conclude that the M Dot alone is a recognized mark for any of opposer's products and services, let alone nutritional supplements.

Further, although applicant has certainly received a great deal of publicity for its triathlon events, the newspaper and magazine articles that have been submitted show the mark as IRONMAN, without any special font and without the dot design. We acknowledge that many of applicant's licensed products use IRONMAN with the dot, but we cannot determine the sales numbers for the products using this form of the mark. We note that applicant's witness testified that in 1996 retail sales of its products were over \$150 million, and are currently more than \$300 million, but these figures are not broken down by the specific form of the IRONMAN mark used on the products. We also note that applicant's witness testified that the marks used on particular products were the same mark as that applied for herein, but there are several instances in which those marks are not the same. See, for example, Fertic Exhibit 12, Bates 3960; Mr. Fertic testified that the mark shown in the exhibit was the same as the IRONMAN mark that is the subject of this opposition, but in fact the mark is IRONMAN TRIATHLON NUTRITION (with a dot above the M). As a result, we cannot accept Mr. Fertic's statements that the sales

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figures show use of the mark which is the subject of the present application. Moreover, we cannot determine to what extent these sales figures represent goods with which the consumers of nutritional supplements would come into contact and thereby see the mark. For example, applicant has registered its marks for such items as machine parts, namely linear ball and roller bearing slides (Reg. No. 2261283); gear boxes and gear motors for use in connection with electric motors and use in machines and with industrial machinery (Reg. No. 2811990); power-operated master/slave manipulator arm used in industry (Reg. No. 3300397); and safety protection apparel and products used during welding or construction (Reg. No. 2644971).

Further, the record does not show that the IRONMAN with Dot design is well-known for nutritional supplements, and it is for nutritional supplements that applicant is attempting to register its mark. Applicant's witness "guessed" that in the 11-year period starting in 1996 sales of IRONMAN-branded nutritional supplements were \$60-70 million. However, many of the exhibits depict the mark variously as the IRONMAN and Dot design with the word TRIATHLON or with the words SPORTS NUTRITION SYSTEM.

Even if we could say that the IRONMAN with Dot design had achieved fame for triathlon contest exhibitions, and while the fame of a mark may give it a greater scope of

protection against later users, a later user may not build up its mark in order to take away rights from an earlier user, or use the fame the later user has built up in one area to expand into goods that are related to those of an earlier user, thereby limiting the scope of protection to which that earlier user is entitled.

After considering the marks as a whole, we find that the slight differences in appearance do not outweigh the identical sound, connotation and commercial impression of the marks. This du Pont factor favors a finding of likelihood of confusion.

The next du Pont factor discussed by the parties is the similarity of channels of trade. Because opposer is relying on its common law rights, we cannot assume that its goods travel in all appropriate channels of trade for such goods, as we would if opposer were relying on a registration. Thus, we must look at the evidence as to the channels of trade through which opposer distributes its magazines. That evidence is limited to the testimony about the circulation of the magazines, as well as the electronic distribution of its newsletters and its websites. There is no evidence that the magazines are sold in drugstores or supermarkets where nutritional supplements might be sold. However, there is evidence that opposer advertises nutritional supplements in its magazines, and therefore the customers for both products

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are not only the same, but they are exposed to both products at the same time. As a result, they are likely to make a connection between opposer's magazine and nutritional supplements sold under a confusingly similar mark, even though the nutritional supplements and the magazines are not sold together. Accordingly, we find that this du Pont factor favors opposer, but only slightly.

With respect to the conditions of purchase, applicant points out, and we agree, that much of opposer's arguments are based on speculation rather than evidence.

There is no evidence in the record as to whether the goods at issue here are expensive or inexpensive. Nor is there any evidence as to the care given by consumers of nutritional supplements to their choice of products.

Applicant's brief, p. 29. In view thereof, we treat this du Pont factor as neutral.

There is no evidence of third-party use of IRON MAN/IRONMAN marks. The existence of third-party uses normally favors the defendant; therefore in the absence of such evidence we treat this du Pont factor as neutral.

With respect to the factors of actual confusion or the lack of evidence of actual confusion, we give no probative value to the anecdotal testimony of opposer's witness about misdirected telephone calls. As for applicant's argument that the lack of evidence of actual confusion is highly probative, we are not persuaded by this argument. Applicant

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points to the fact that its IRONMAN-branded products have been sold since 1996 at major retail outlets such as Wal-Mart and GNC, and that it has made significant sales. However, as noted above, many of the nutritional supplements do not bear the mark IRONMAN and Dot design per se, but include other wording, including the word TRIATHLON. As shown by the 1986 agreement between the parties, applicant was permitted to use IRONMAN for non-triathlon goods and services if the word TRIATHLON were included in the mark; therefore, it is clear that the parties believed that the presence of this word would avoid confusion. We also note that many of the exhibits show additional source marks on the nutritional supplements, such as TWINLAB IRONMAN TRIATHLON and PR'S IRONMAN TRIATHLON, which may also have avoided any instances of confusion. As a result, we cannot conclude that the lack of evidence of actual confusion shows that confusion is not likely if applicant were to use the applied-for IRONMAN and Dot design without additional source indicia.

The only other point discussed by the parties is opposer's concern that applicant's use of the mark could result in safety issues that are outside opposer's control. Safety issues normally arise in connection with pharmaceuticals because of the harm that can occur if the incorrect medication is taken as a result of confusion of

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trademarks. We do not consider nutritional supplements to be in this category. Opposer's concerns about the negative effect of applicant's use on its reputation or sales is no greater than that of any other trademark owner.

After considering all of the relevant evidence and arguments, we find that applicant's use of its applied-for IRONMAN and Dot design for nutritional supplements is likely to cause confusion with opposer's mark IRON MAN for bodybuilding publications. In reaching this conclusion we have resolved any doubts, as we must, in favor of opposer, which began using its mark approximately 70 years prior to applicant's use of its mark on the identified goods.

Squirtco v. Tomy Corporation, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

Decision: The opposition is sustained.