

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Hearing: January 21, 2010

Mailed: May 13, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Columbia Insurance Co.

v.

Eric J. Delfyette

Opposition No. 91177903
to application Serial No. 78903777

Gene S. Winter, Andy I. Corea and Amanda Greenspon of St. Onge Steward Johnston & Reens LLC for Columbia Insurance Co.

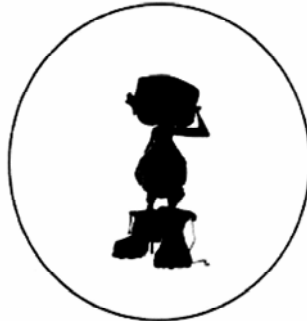
Erik M. Pelton of Pelton & Associates, PLLC for Eric J. Delfyette.

Before Quinn, Cataldo and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On June 8, 2006, applicant, Eric J. Delfyette, filed an application to register on the Principal Register the mark displayed below, based upon an allegation of his bona fide intent to use the mark in commerce for "men's, women's and children's sportswear, namely, woven and knit shorts,

shirts, t-shirts, pants, jogging suits, coats, jackets, sweaters, and footwear," in International Class 25.¹



BORN=OFFICIAL

Registration has been opposed by Columbia Insurance Co. ("opposer"). As grounds for opposition, opposer asserts that it is the owner of the following famous marks, previously used and registered on the Principal Register:

BØRN

for "footwear" in International Class 25;² and

Børn[®]

for "luggage, handbags, wallets, and small leather goods, namely, key cases, key rings, coin purses, bill-folds,

¹ Application Serial No. 78903777. Applicant submitted the following description of the mark: "The mark consists of a silhouette of an infant wearing men's working boots and the word Born=Official."

² Registration No. 1947333 issued on January 9, 1996. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

Opposition No. 91177903

business card cases, luggage tags" in International Class 18;³ that through its licensee, opposer has made use of these marks on the identified goods since prior to any date of use upon which applicant may rely; that applicant's mark, when used in connection with applicant's goods, so resembles opposer's previously used and registered marks for its recited goods as to be likely to cause confusion, to cause mistake, and to deceive; that opposer's marks became famous prior to the filing date of the involved application; that use and registration of applicant's involved mark will dilute the distinctive quality of opposer's marks; and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.

The Record

The record in this case consists of the pleadings and the file of the involved application. In addition, during its assigned testimony period opposer took the testimony deposition of Mr. Anthony Capozza, Director of Corporate Administration for opposer's licensee, with accompanying exhibits; and a notice of reliance upon status and title copies of its pleaded registrations; opposer's first set of requests for admission to applicant; and applicant's

³ Registration No. 3093916 issued on May 16, 2006 with the following description of the mark: "The mark consists of the stylized word BORN with a crown design inside of the letter O."

responses thereto. During his assigned testimony period, applicant filed a notice of reliance upon copies of third-party registrations for BORN-formative marks for a variety of, *inter alia*, clothing and leather goods.

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief. In addition, both parties were represented by counsel at an oral hearing held before the Board. Opposer submitted portions of the testimony deposition of Mr. Capozza and its brief on the case under seal as containing confidential information. We will refer in this decision to those portions of opposer's evidence and brief only in general terms.

Opposer's Standing and Priority of Use

Because opposer has properly made its pleaded registrations of record, and further has shown that it is not a mere intermeddler, we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks therein and goods covered thereby. *See*

King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Fame of Opposer's Marks

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's marks and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the DuPont factors," *Recot*, 214 F.3d

at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." Id. This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. Id. Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown."

Bose Corp. v. QSC Audio Products Inc., *supra*, 63 USPQ2d at 1305.

Upon careful review of the record in this case, we are not persuaded that opposer's marks are famous. It is the duty of a plaintiff asserting that its mark is famous to clearly prove it.

Opposer has testified under seal that it enjoys substantial annual sales of goods under its pleaded marks.⁴ Opposer further testified that it advertises its goods under its pleaded marks in magazines, newspapers, radio, television and over the internet.⁵ At the time of opposer's testimony period, advertisements for such goods appeared in Oprah, Life & Style, and Outside magazines.⁶ Editorials regarding these goods appeared in such magazines as Outside, Lucky, National Geographic, Esquire, InStyle, Real Simple, and Health magazines during the same time period.⁷

⁴ Capozza Testimony, p. 12-13.

⁵ Id. at 15.

⁶ Id. at 16-17; Exhibit 6.

⁷ Id. at 17-18; Exhibit 6.

This testimony and evidence demonstrates that opposer has enjoyed considerable success in selling its goods under its pleaded marks. However, such evidence falls short of demonstrating the extent to which such success translates into widespread recognition of its marks among the general public. For example, opposer's evidence of media recognition consists merely of screenshots from its internet web page displaying copies of the covers of magazines assertedly containing advertisements and editorials regarding its products.⁸ Because the advertisements and editorials themselves are not of record, it is not clear which of opposer's marks and goods are featured or discussed therein. As a result, such testimony and evidence does not establish that opposer's marks are widely recognized by the consuming public.

With regard to opposer's annual sales, we note that opposer has not made of record any information regarding the percentage of such sales occurring in the United States versus other markets worldwide. We note in addition that while opposer has not made any advertising figures of record, based upon its annual sales figure opposer's advertising expenditures are much lower than annual advertising figures for other marks we have found to be famous. *See, for example, Motion Picture Association of*

⁸ Capozza Testimony, Exhibit 6.

America, Inc. v. Respect Sportswear Inc., 83 USPQ2d 1555 (TTAB 2007) (opposer's members annually spent 4 billion dollars on advertisements and promotion).

Finally, opposer provides no context for its annual sales figures such that we may ascertain opposer's market share vis a vis other manufacturers of the goods identified in its pleaded registrations. As a result, it is impossible to determine how its annual sales compare to those of its competitors such that we may conclude therefrom that opposer's pleaded marks are famous. See *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Accordingly, we find on this record that the evidence falls short of establishing that either of opposer's pleaded marks is famous for purposes of our likelihood of confusion determination. Nonetheless, the record supports a finding that opposer's marks are strong, to the extent we must recognize that they are inherently distinctive in view of their registration on the Principal Register, opposer's evidence of sales figures and examples of advertising and, as discussed more fully below, limited evidence of third-party uses of record.

Registration of Similar Marks

Applicant has made of record a number of third-party BORN-formative marks registered in connection with various

clothing and related goods, including shoes.⁹ We note, however, that most of these third-party registrations are for marks that are more dissimilar to opposer's pleaded marks than applicant's involved mark because they create a specific and different commercial impression. Such marks include the following: BORN INTO IT; BROOKLYN BORN; BORN IN THE BRONX; and BORN IN AMERICA. We further note that the remainder of the registrations recite various goods and services that are farther removed from the goods at issue herein. As a result, we cannot say that these registrations demonstrate that opposer's pleaded marks are weak marks that are entitled to a limited scope of protection. Because of the differences in the third-party marks and goods/services, we do not find that, because the Patent and Trademark Office determined that these marks can coexist, that there is no likelihood of confusion between applicant's mark and opposer's mark. We also point out that third-party registrations are not evidence that the marks shown therein are in use. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973). Thus, they have no probative value with respect to the *du Pont* factor of the number and nature of similar marks that are in use for similar goods and services.

⁹ Applicant's Notice of Reliance.

Opposer's Registration No. 1947333

We have determined above that opposer has failed to demonstrate that either of the marks in its pleaded registrations are famous. Furthermore, we note that opposer has neither pleaded nor proven that it owns a family of marks. In comparing its two pleaded registrations, we note that the mark in Registration No. 1947333 is more similar to the mark in the involved application than the mark in Registration No. 3093916. We further note that Registration No. 1947333 recites goods that are more similar to the goods in the involved application.

Accordingly, we will concentrate our discussion of the issue of likelihood of confusion on opposer's Registration No. 1947333 for the mark

BØRN

for "footwear" (hereinafter, the '333 Registration).

The Goods and Trade Channels

The goods in the involved application and opposer's '333 Registration are, in part, identical. Applicant's goods, identified as "men's, women's and children's sportswear, namely, woven and knit shorts, shirts, t-shirts, pants, jogging suits, coats, jackets, sweaters, and footwear," fully encompass the goods identified in the '333 Registration, namely "footwear." Applicant's goods also

include additional items of casual apparel, namely, various items of "men's, women's and children's sportswear," that are closely related to and generally understood to be worn with opposer's "footwear."

Because the goods are identical and/or closely related and there are no restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are, or will be, sold in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for applicant's and opposer's goods would be the same. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

It is clear that if these identical and closely related goods are offered under similar marks there would be a likelihood of confusion.

Thus, we turn to the marks, keeping in mind that when marks would appear on identical goods, as they do here, the degree of similarity between the marks necessary to support a finding of likely confusion declines. *See Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The Marks

We turn then to the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark in its '333 Registration are similar or dissimilar when viewed in their entireties in

terms of appearance, sound, connotation and overall commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot, supra.*

In this case, we find that applicant's mark,



BORN=OFFICIAL

is similar to the mark in opposer's '333 Registration,

BØRN

in that the term BORN in applicant's mark is highly similar to the term BØRN in opposer's mark. The terms are not identical; BORN in applicant's mark appears to be a common English word whereas BØRN in opposer's mark gives the appearance of an English word with a novel spelling or possibly a word in a foreign language. In that regard, we grant applicant's request to take judicial notice of the excerpts from dictionaries and language instruction reference works indicating that BØRN is a Danish language word meaning "children."¹⁰ While there is no evidence of

¹⁰ The Board may take judicial notice of dictionary definitions and other reference works. *See University of Notre Dame du Lac*

Opposition No. 91177903

record regarding the percentage of consumers in the United States who read, speak, or otherwise would recognize BØRN as a Danish language term, the presence of "Ø" as the second letter of the term BØRN in opposer's mark is sufficient to impart a slightly different appearance and connotation than the term BORN in applicant's mark, and further suggests differences in sound.

However, even if we recognize that the term BORN in applicant's mark and BØRN in the mark in opposer's '333 Registration are highly similar, the similarities between the marks ends there. The wording in applicant's mark consists of the term BORN=OFFICIAL which clearly is different in appearance and sound from BØRN in opposer's '333 Registration. As for connotation, whether we view opposer's mark as a novel spelling of BORN or a foreign language term, the wording BORN=OFFICIAL in applicant's mark appears to suggest a somewhat different meaning even if that meaning is unclear. We do not agree with opposer that the wording in applicant's mark suggests that its goods are "an authorized or 'official' BORN product - originating from or authorized by the same source."¹¹ Whether we view the wording in applicant's mark as meaning "born is official," "born equals official," or some other meaning, we find

v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹¹ Brief, p. 7.

Opposition No. 91177903

opposer's suggested meaning of "official BØRN product" to be highly speculative, especially in the absence of any evidence regarding the manner in which applicant's mark is intended to be used in connection with its goods.

In addition, applicant's mark includes a prominent design of a highly stylized silhouette of a child or infant wearing oversized work or combat boots inside a large circular carrier. The design is larger in size than the wording BORN=OFFICIAL and serves as a visual focal point for the mark. The presence of this design results in a substantial difference between applicant's mark and the mark in opposer's '333 Registration. As for connotation, the design in applicant's mark, much like the wording, does not project a clear meaning. Nonetheless, the presence of the stylized and curious design serves to further distinguish applicant's mark from the mark in opposer's '333 Registration.

While it is true that generally the literal portion of a mark may dominate the design portion because it is by the words that the consumer will call for the goods and descriptive elements are often given less weight, we still must consider the marks in their entirety. In view of the visually prominent design element in applicant's mark and the differences in appearance, sound and connotation of the literal portions of the marks in the context of the parties'

Opposition No. 91177903

goods, we find that, despite both marks including the highly similar wording BORN versus BØRN, the differences are sufficient to distinguish applicant's mark from the mark in opposer's '333 Registration; overall they convey dissimilar commercial impressions.

Thus, the *du Pont* factor of the similarity of the marks does not weigh in favor of a finding of likelihood of confusion, but rather favors applicant.

Further, in this case, we find that even if used on goods that are in part identical, the marks are so dissimilar in appearance, sound, connotation and overall commercial impression that consumers are unlikely to experience confusion as to their source. In other words, the dissimilarity of the marks is dispositive in this case. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive"). In addition, because we have found that confusion is unlikely between applicant's mark and the mark in opposer's '333 Registration as applied to identical goods, we find for the reasons articulated above that confusion is unlikely between applicant's mark and the more dissimilar mark shown below

Børn[®]

in opposer's pleaded Registration No. 3093916 for its various recited leather goods.

Dilution

We note that fame for likelihood of confusion purposes and for dilution are not the same, and that fame for dilution purposes requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame "varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition - sufficient fame for dilution either exists or does not exist. *Id.* See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of confusion "Fame is relative . . . not absolute"). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, *supra*, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1st Cir. 1998) ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection").

Because, as discussed above, opposer has not shown on this record that its marks have achieved fame for purposes of likelihood of confusion, it follows that opposer has not shown the requisite level of fame for purposes of dilution.

Conclusion

We have carefully considered all of the evidence pertaining to opposer's claims of priority of use and likelihood of confusion and dilution, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion.

We conclude that opposer has established its standing and priority of use; however, the marks in opposer's pleaded registrations are simply too dissimilar from applicant's mark to support a finding of likelihood of confusion. In addition, because opposer failed to establish that its marks are famous for purposes of likelihood of confusion, opposer cannot prevail upon its claim of dilution which requires a more stringent showing of fame.

DECISION: The opposition is dismissed as to the claim of priority and likelihood of confusion as well as to the claim of dilution.