

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

WINTER

Mailed: December 22, 2016

Opposition No. 91211876

adidas AG and adidas America, Inc.

v.

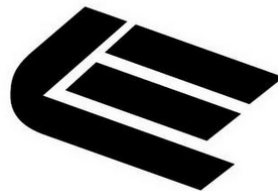
Etonic Holdings, LLC

**Before Zervas, Cataldo, and Hightower,
Administrative Trademark Judges.**

By the Board:

Background

Etonic Holdings, LLC (hereafter “Applicant”) seeks registration of the following design mark for use in connection with “Athletic footwear; Bowling shoes; Footwear; Footwear for track and field athletics; Golf shoes; Headwear; Jackets; Pants; Running shoes; Shirts.”¹



¹ Application Serial No. 85790175 filed November 29, 2012, under Section 1(b) of the Trademark Act, with the following description of the mark: “The mark consists of the letter ‘E’ facing diagonally down with a rounded lower left hand corner.”

adidas AG and adidas America, Inc. (hereafter “Opposers”) oppose registration of the mark on the following four grounds, namely, likelihood of confusion, dilution, lack of bona fide intent to use the mark in commerce, and that use and registration of the mark are barred by contract. In support of their claims, Opposer adidas America, Inc. asserts that it is the exclusive U.S. distributor of adidas products; and Opposer adidas AG pleads ownership of eight trademark registrations of the “3-Stripes” mark for placement on a variety of footwear,² three trademark registrations for its “3-Stripes” mark for headwear,³ and seven trademark registrations for its “3-Stripes” mark for a

² U.S. Reg. No. 961353 issued June 19, 1973, for the mark described as comprising “three white stripes extending across the blue background of the box container and the outline of the container box is made to appear in broken lines,” for use with “special purpose athletic shoes” and “general purpose sport shoes,” Sections 8 & 15 Affidavits accepted and renewed June 19, 2013; U.S. Reg. No. 1815956 under Section 2(f), issued January 11, 1994, for use with “athletic footwear,” Sections 8 & 15 Affidavits accepted and renewed January 11, 2014; U.S. Reg. No. 1833868 under Section 2(f), issued May 3, 1994, for use with “athletic footwear,” Sections 8 & 15 Affidavits accepted and renewed May 3, 2014; U.S. Reg. No. 2278589 under Section 2(f), issued September 21, 1999, for use with “athletic and leisure footwear,” Sections 8 & 15 Affidavits accepted and renewed September 21, 2009; U.S. Reg. No. 2909861 under Section 2(f), issued December 14, 2004, for the mark described as consisting of “three stripes positioned on the top part of a slide,” for “footwear, namely, slides,” Sections 8 & 15 Affidavits accepted and renewed December 14, 2014; U.S. Reg. No. 2999646 under Section 2(f), issued September 27, 2005, for “footwear, namely, slides,” Sections 8 & 15 Affidavits accepted and renewed September 27, 2015; U.S. Reg. No. 3029129 under Section 2(f), issued December 13, 2005, for the mark described as consisting of “three parallel stripes applied to footwear, the stripes are positioned on the footwear upper in the area between the laces and the sole,” for use with “footwear,” Sections 8 & 15 Affidavits accepted and renewed December 13, 2015; and U.S. Reg. No. 3029135 under Section 2(f), issued December 13, 2005, for the mark described as consisting of “three parallel stripes with serrated edges applied to footwear, the stripes are positioned on the footwear upper in the area between the laces and the sole,” for use with “footwear,” Sections 8 & 15 Affidavits accepted and renewed December 13, 2015.

³ U.S. Reg. No. 3236505 under Section 2(f), issued May 1, 2007, for the mark described as consisting of “three parallel stripes extending from the rear of the headwear to the top of the headwear,” for use with “headwear,” Section 8 accepted; U.S. Reg. No. 3183663 under Section 2(f), issued December 12, 2006, for the mark described as consisting of “three parallel stripes on a size adjusting bar at the rear of the headwear,” for use with “headwear,” Sections 8 & 15 Affidavits accepted and renewed December 12, 2016; and U.S. Reg. No. 3183656 under Section 2(f), issued December 12, 2006, for the mark described as consisting of “three parallel

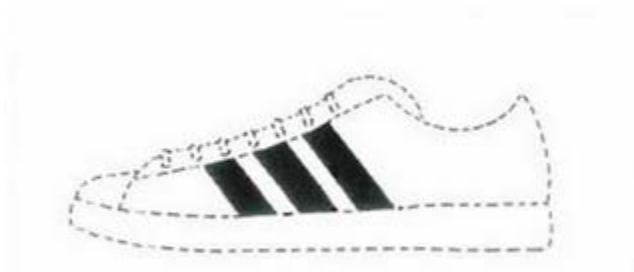
variety of apparel.⁴ Opposer adidas AG also pleads ownership of the slogan “THE BRAND WITH THE 3 STRIPES” (in typeset format) for use in connection with “boots, slippers, sandals; shoes, boots and after ski boots for hiking and trekking, athletic shoes and general-purpose sports shoes.”⁵ Both Opposers plead common law rights accrued in the “3-Stripes” mark in connection with apparel and footwear as a result of continuous use since 1967. The mark in asserted Reg. No. 3029129 (“129”) for

stripes extending around the headwear,” for use with “headwear,” Sections 8 & 15 Affidavits accepted and renewed December 12, 2016.

⁴ U.S. Reg. No. 870136 issued May 27, 1969 for the mark consisting of “three parallel bands extending along the length of each sleeve of the training suit and along the length of each leg of the trousers, the bands on the sleeves being of contrasting color to that of the remainder of the sleeve and the bands on the legs of the trousers being of contrasting color to that of the remainder of the trouser legs,” for use with “athletic training suits,” Sections 8 & 15 Affidavits accepted; renewed May 27, 2009; U.S. Reg. No. 2284308 issued October 12, 1999, for the mark consisting of “three parallel bands extending along the length of each leg of the pants, the bands being of contrasting color to that of the remainder of the pants,” for use with “sports and leisure wear, namely pants,” Sections 8 & 15 Affidavits accepted; renewed October 12, 2009; U.S. Reg. No. 2058619 under Section 2(f), issued May 6, 1997, for mark consisting of “three parallel bands positioned along the length of each sleeve of a shirt,” for use with “sports and leisure wear, namely shirts,” Sections 8 & 15 Affidavits accepted; renewed May 6, 2017; U.S. Reg. No. 3029127 under Section 2(f), issued December 13, 2005, for the mark consisting of “three parallel stripes running along the sleeve of a shirt, t-shirt, sweatshirt, jacket or coat,” for use with “Clothing, namely, T-Shirts, sweatshirts, jackets and coats,” Sections 8 & 15 Affidavits accepted; renewed December 13, 2015; U.S. Reg. No. 3087329 under Section 2(f), issued May 2, 2006, for mark consisting of “three parallel stripes running along the side of a shirt, t-shirt, sweatshirt, vest, jacket or coat,” for use with “Clothing, namely, shirts, t-shirts, sweatshirts, vests, jackets and coats,” Sections 8 & 15 Affidavits accepted; renewed May 2, 2016; U.S. Reg. No. 2016963 under Section 2(f), issued November 19, 1996, for mark consisting of “three parallel bands positioned along the length of each sleeve of a jacket,” for use with “sports and leisure wear, namely jackets,” Sections 8 & 15 Affidavits accepted; renewed November 19, 2016; and U.S. Reg. No. 2278591 under Section 2(f), issued September 21, 1999, for the mark consisting of “three parallel bands extending along the length of each leg of the shorts, the bands being of contrasting color to that of the remainder of the shorts,” for use with “sports and leisure wear, namely, shorts,” Sections 8 & 15 Affidavits accepted; renewed September 21, 2009.

⁵ U.S. Reg. No. 1674229 issued February 4, 1992, Sections 8 & 15 Affidavits accepted; renewed February 4, 2012.

“footwear,” which is closest of the marks in the registrations asserted by Opposers to Applicant’s mark, is shown below.



If confusion is likely between Applicant’s mark and the mark of the ‘129 registration, there is no need for us to consider the likelihood of confusion with Opposers’ other registrations that incorporate the 3-Stripes mark. On the other hand, if there is no likelihood of confusion between Applicant’s mark and the mark of the ‘129 registration, then there would be no likelihood of confusion with Opposers’ other 3-Stripe marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). Accordingly, we have focused our likelihood of confusion analysis under Section 2(d) on the mark of the ‘129 registration.

Applicant has either denied or claimed to have insufficient information to admit or deny the salient allegations in the notice of opposition.

This case now comes up for consideration of Opposers’ contested motion (filed June 2, 2016) for partial summary judgment on its claims of likelihood of confusion and dilution,⁶ and on Applicant’s cross-motion for summary judgment on all four of

⁶ Opposers failed to allege a sufficient claim of dilution. Specifically, Opposers have not alleged that their registered “3-Stripe Mark” became famous prior to the filing date of the opposed application. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001). Normally, the Board will not consider summary judgment motions on an unpleaded claim. *See Fed. R. Civ. P. 56(a); Asian and Western Classics B.V. v. Lynne Selkow*, 92

Opposers' claims, namely, likelihood of confusion, dilution, lack of bona fide intent to use the mark in commerce, and that use and registration of the mark is barred by contract.

Cross-Motions for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c)(1). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the

USPQ2d 1478, 1480 (TTAB 2009) (citing *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 503 n.2 (TTAB 1977)); *see also* TBMP § 528.07(a) and cases cited therein. However, insofar as Applicant did not contest the sufficiency of Opposers' pleading, for purposes of our review of the parties' cross-motions, we deem Opposers' amended notice of opposition to be amended to comprise a sufficient claim of dilution. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim) (*aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997)); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 81 n.3 (TTAB 1984) (pleading deemed amended where nonmoving party did not object to motion on unpleaded claim and treated it on its merits).

non-moving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. Further, in considering whether summary judgment is appropriate, the Board may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the opposition. Rather, the Board may only ascertain whether any material fact cannot be disputed or is genuinely disputed. *See Lloyd's Food Products*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

The mere fact that cross-motions for summary judgment on a claim have been filed does not necessarily mean that there is no genuine dispute as to a material fact, and that trial is unnecessary. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994). Each party has the initial burden of demonstrating the absence of any genuine disputes as to any material fact with respect to its own motion. *See Celotex Corp. v. Catrett*, 477 U.S. at 323; *Sweats Fashions Inc. v. Pannill Knitting Co.*, 4 USPQ2d at 1795-96; *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

- *Cross-Motions on Opposers' Claim of Likelihood of Confusion*

We consider first Opposers' motion. To prevail on summary judgment on their claim of likelihood of confusion, Opposers must establish that there is no genuine dispute that they have standing to maintain this proceeding; that they have priority

of use (or that priority is not an issue due to the assertion of trademark registrations); and that contemporaneous use of the parties' marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. *See* 15 U.S.C. § 1052(d); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

o *Standing*

We first consider whether Opposers have standing to bring this opposition proceeding. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Opposers submitted with their amended notice of opposition printouts from the USPTO TSDR⁷ electronic database of all of their pleaded registrations, which show that the pleaded registrations are valid and subsisting. Opposer adidas AG's standing to bring this opposition proceeding is established by the TSDR printouts. *See* Trademark Rule 2.122(d)(1); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010) (pleaded registration made of record establishes standing); *see also* *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189-90 (CCPA 1982); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing). Opposer adidas America, Inc. has standing by virtue of the fact that it is the exclusive distributor of adidas AG's products in the

⁷ "TSDR" refers to the Trademark Status & Document Retrieval database.

United States.⁸ See *Yasutomo & Co. v. Commercial Ball Pen Co., Inc.*, 184 USPQ 60, 61 (TTAB 1974). In addition, Applicant does not dispute Opposers' standing. Accordingly, we find no genuine dispute of material fact regarding Opposers' standing.

○ *Priority*

There is no genuine dispute of material fact regarding Opposers' priority in this case because Opposers submitted TSDR reports of all of Opposers' pleaded registrations showing that the registrations are extant and owned by Opposer adidas AG. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (priority is not an issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark); see also TBMP § 309.03(c).

○ *Likelihood of Confusion*

We turn next to Opposer's claim of likelihood of confusion under Trademark Section 2(d), 15 U.S.C. § 1052(d). "We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the applicant's [goods or services] originate from the same source as, or are associated with [opposer's goods or services]." *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the question on Opposers' motion for summary judgment, we analyze the probative facts in evidence that are relevant to five of the thirteen factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357,

⁸ Declaration of Chris Murphy (¶ 9), discussed *infra*.

177 USPQ 563 (CCPA 1973), as well as whether there are genuine disputes as to any of these five factors which would be material to a decision on the merits. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992) (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). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *see also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We also consider the channels of trade of the parties' respective goods, as well as evidence concerning the fame of Opposers' marks and conditions under which sales of footwear are made, which Opposers have introduced.

- *Fame*

We turn first to the factor of fame, because the fame of the prior mark, if it exists, plays a “dominant role in the process of balancing the *du Pont* factors.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). A famous mark has extensive public recognition and renown and enjoys a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *see also Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (a strong mark “casts a long shadow which competitors must avoid”). Fame may be measured indirectly in a number of ways: by the volume of sales and advertising expenditures

of the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06, 1309; *see also Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983).

In support of Opposers’ assertion that the 3-Stripes mark is famous, Opposers have submitted four declarations and the following evidence attached thereto.

(1) Chris Murphy, the Senior Director and Managing Editor (Portland Newsroom) at adidas America, Inc., attests to the following (43 TTABVUE 121-34):⁹

- Opposers have used the 3-Stripes mark on footwear since 1952 (¶ 11) and on other goods since 1967 (¶ 12).
- Opposers’ products bearing the 3-Stripes mark are sold through Opposers’ own outlet stores and by its customers through more than 300 retailers nationwide (¶ 13).
- Sales of Opposers’ footwear, the vast majority of which bears the 3-Stripes mark, from 2006 to 2013, total billions of dollars in the United States; likewise, millions of pairs of footwear bearing the mark have been sold in the United States (¶ 14 confidential) (43 TTABVUE 124). Opposers’ specific sales numbers of footwear in the United States for their wholesale, retail and

⁹ Insofar as Opposers’ information on sales and advertising was submitted by Opposers under seal, we will not state the specific numbers therefor.

ecommerce divisions are quite substantial (¶ 15, confidential Exh. A) (43 TTABVUE 135-36).

- With respect to advertising, Opposers' 3-Stripes mark branded footwear and apparel are advertised by Opposers and its trade customers by print media (national magazines, local newspapers and flyers), e-commerce marketing, including its own and customer websites, on television and on radio spots, in retail store displays and via adidas catalogs (¶ 16) and the total advertising expenditures regarding footwear from December 29, 2008 through December 29, 2013 are very substantial (¶ 17 confidential) (43 TTABVUE 124). The 3-Stripes mark for footwear has consistently been advertised in adidas catalogs from 1970 through 2014 and said catalogs are available online (¶ 28, Exh. D) (43 TTABVUE 321-849; 44 TTABVUE 2-124).
- Opposers are an official sponsor of sports events and, in particular, have been a sponsor of the FIFA World Cup Soccer Tournament since at least as early as 1970, and have been the official sponsor of the Boston Marathon for over twenty-five years (¶ 21). Opposers outfit official race apparel and race gear for the marathon which bears the 3-Stripes mark, including the race jacket (*Id.* and Exh. E) (44 TTABVUE 125-27). Opposers are also the "Official Outfitter" for the National Basketball Association (¶ 22) and the 3-Stripes mark is used extensively with college sports teams, such as the University of California at Los Angeles, Mississippi State University, the University of Miami and others (¶ 23).

- The 3-Stripes mark for footwear has been advertised by sports and music stars, such as Justin Bieber, Katy Perry, and David Beckham (§ 25(e)-(f), Exh. I, K & L) (44 TTABVUE 138-40, 152-57).
- The 3-Stripes mark has been used on tennis shoes (called the “Stan Smith tennis shoe”) for over forty years and, after a short hiatus, new models were rolled out again in 2014, which shoe was identified as “Shoe of the Year” by *Footwear News Magazine* (§ 25(g), Exh. M) (44 TTABVUE 161-64).
- The 3-Stripes mark is cobranded with other high profile brands, e.g., Star Wars and Marvel Avengers (§ 26(a)-(b)), Porsche Design (*id.* at (c)) and Stella McCartney (*id.* at (h), Exh. N) (44 TTABVUE 167).
- The 3-Stripes mark has been noted in third-party media coverage (§ 33, Exh. Q-Z) (44 TTABVUE 176-206).
- adidas is ranked among the 100 Best Global Brands by Interbrand (§ 34).

(2) Peter Bucci, one of Opposers’ attorneys, submitted two opinions by federal district courts, which recognized the strength and fame of the 3-Stripes mark (§§ 6-7, Exh. C-D) (42 TTABVUE 55-56, 69-93; 43 TTABVUE 64-65, 104).¹⁰ Additionally, attached to Mr. Bucci’s declaration is an excerpt from the deposition of Bruce

¹⁰ Opposers also point out the Board’s decision in *In re Dassler*, 134 USPQ 265 (TTAB 1962), in which the Board recognized the widespread use of Opposers’ 3-Stripes mark.

The Court’s findings, as well as those of this tribunal, however, are no substitute for Opposers to build their own record in the present proceeding. “The decision by another court based upon a different record is not evidence in this proceeding...Th[e] duty [to decide the right to registration in an inter partes proceeding] may not be delegated by the adoption of conclusions reached by another court on a different record. Suffice it to say that an [inter partes proceeding] must be decided on the evidence of record.” *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1665-66 (TTAB 2010).

Weisfeld, President of and one of Applicant's owners, who acknowledges that Opposers' 3-Stripes mark is "one of the most widely recognized trademarks for athletic footwear" (Bucci dec. ¶ 4; 43 TTABVUE 26, 38).

(3) John Zaccaria, one of Opposers' attorneys, attests that Opposers have filed numerous oppositions based on their 3-Stripes mark against applications for footwear and/or clothing in class 25, and that the Board has entered judgments sustaining the oppositions as a result of abandonments of the opposed applications (Zaccaria dec. ¶ 6, Exh. A-J) (42 TTABVUE 29-54).

(4) Sara Vanderhoff, Associate General Counsel, Global Brands & Trademarks of adidas International, Inc., attests that since 1995, adidas has pursued over 550 infringements involving the 3-Stripes mark (¶ 7), that adidas has commenced more than 85 separate lawsuits in federal district courts for infringement of said mark (¶ 8), and that adidas has entered into more than 245 settlements with companies selling footwear infringing on the 3-Stripes mark (42 TTABVUE 26-27).

Based on the foregoing evidence, Opposers have established that their promotional efforts related to the 3-Stripes mark and extensive sales of footwear bearing the 3-Stripes mark have resulted in longstanding, widespread awareness and recognition of that mark for footwear. Additionally, Opposers' aggressive trademark enforcement activities reinforce the strength of the 3-Stripes mark. Moreover, Applicant has acknowledged the strength of the 3-Stripes mark and does not dispute that the 3-Stripes mark is famous. In view thereof, we find that there is

no genuine dispute that Opposers' 3-Stripes mark is famous as used in connection with Opposers' footwear, and is entitled to a broad scope of protection.

- *Similarity of Goods*

With respect to the similarity of the parties' goods, we must compare the goods identified in the opposed application to those identified in Opposers' pleaded registrations. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Additionally, we may find that there is a likelihood of confusion when only one item in a class of goods is commercially similar to the other party's goods. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (stating that it is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application); *see also Research in Motion Limited v. Defining Presence Marketing Group, Inc.*, 102 USPQ2d 1187 (TTAB 2012) ("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."); *Hewlett-Packard Development Co. v. Vudu, Inc.*, 92 USPQ2d 1630, 1633 n.4 (TTAB 2009) ("it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration") (internal citations omitted).

As noted *supra*, Applicant's goods are identified as "Athletic footwear; Bowling shoes; Footwear; Footwear for track and field athletics; Golf shoes; Headwear; Jackets; Pants; Running shoes; Shirts." Opposers' goods are identified in U.S. Reg.

No. 3029129 as “footwear.” Therefore, there is no genuine dispute that Applicant’s identified shoes and footwear are encompassed by, and therefore are identical to, Opposers’ goods.

- *Similarity of Marks*

Opposers argue that Applicant’s mark closely resembles Opposers’ 3-Stripe mark insofar as they both comprise three parallel stripes that are equidistant from one another. Opposers also point out that insofar as Applicant’s mark can be used in any color or color combination, or without any color, if the single stripe that is perpendicular to the three parallel stripes is placed close to the lacing reinforcement strip of the footwear and no color is used on the perpendicular stripe, that stripe will be barely visible and there will be very little left to distinguish Applicant’s mark from the 3-Stripe mark (see 43 TTABVue 19). Opposers also emphasize that Applicant is not limited to placing its applied-for mark in a certain orientation and that the general public will not be aware of the mark’s description.

In response, Applicant contends that its applied-for mark is clearly a stylized letter “E” and that the parties’ marks are highly dissimilar because they convey different commercial impressions and are pronounced differently. Applicant points out that none of the stripes in Opposers’ mark are connected and that the parties’ marks are placed in different positions. Applicant also argues that the consuming public is accustomed to seeing letters representing other trademarks on athletic shoes and, in view thereof, consumers will associate Applicant’s “E” mark with Applicant’s mark ETONIC. In support thereof, Applicant has submitted the declaration of Bruce

Weisfeld, an owner and officer of Applicant, to which is attached several third-party registrations of trademarks comprising letters, specifically, “S” (for SKECHERS), “N” (for NEW BALANCE) and “FJ” (for FOOT-JOY), as well as photographs¹¹ of athletic shoes bearing those letter marks (Weisfeld dec. ¶ 7, 49 TTABVUE 24, 35-74).

With respect to the similarity of the marks, we look to the marks in their entireties as to appearance, sound, meaning or connotation, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these bases for comparison may be critical in finding marks to be similar. Further, it is a well-established principle that, as the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1310 (“when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark”). Additionally, when the respective goods of the parties are identical, as in this case, it has been held that the degree of

¹¹ Applicant states that the photographs are from the Internet. However, the photographs are not admissible insofar as the source of and date the materials were retrieved are not shown. See *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Accordingly, the photographs have not been considered. See *Kaplan v. Brady*, 98 USPQ2d 1830, 1834 n.10 (TTAB 2011) (nonprecedential) (if a printout of information from a website includes date of publication or date that it was accessed and printed, and its source (e.g., the URL), a party may submit that printout in connection with a motion for summary judgment in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e)). However, even if the photographs had been considered, they do not raise a genuine dispute as to whether Applicant’s mark would be viewed as a letter “E” insofar as there is no information in the record as to consumers’ perceptions of letter marks on footwear.

similarity between the marks need not be as great to support a finding of likelihood of confusion. *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). We also keep in mind that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *North Face Apparel Corp. v. Sanyang Industry Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.”) (citation omitted); *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2-3 (CCPA 1977) (marks “must be considered as wholes, and not on the basis of side-by-side comparison, and in the light of the fallibility of memory”). Accordingly, the fact that there are specific differences between the marks is not determinative. The question is whether the overall impression of the marks is so similar that consumers will believe that they identify goods emanating from a single source.

In comparing Applicant’s mark with Opposers’ 3-Stripes mark, we note that each mark is comprised of three thick parallel stripes. Further, Applicant’s mark can be used anywear on footwear, including where Opposers’ place the 3-Stripes mark on the sides of footwear. Applicant’s design includes three parallel stripes, which may be juxtaposed at the same direction and angle as the stripes in Opposer’s 3-Stripe

mark, with one of the stripes connected to a perpendicular element. Because two of the stripes are not connected to the perpendicular element of Applicant's mark, as would be the case with the letter "E," the overall impression of Applicant's mark is one of three stripes, rather than the letter "E," as Opposers argue. The perpendicular element does not distinguish the parties' respective marks in a significant manner. The subtle distinctions in the marks are not likely to be recalled by purchasers seeing the marks at different times. As noted, under actual marketing conditions, consumers may not compare marks side-by-side, and moreover, we must consider the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. *See In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, insofar as there is no genuine dispute as to the fame of Opposers' 3-Stripes mark on footwear, when viewing Applicant's mark, the average consumer is likely to think of Opposers' mark. Additionally, we find that the third-party registrations of stylized letters marks, the only evidence Applicant submitted which arguably pertains to the *du Pont* factor regarding the similarity of the marks and supporting Applicant's cross-motion as it pertains to this factor, do not raise a genuine dispute as to whether consumers will view Applicant's mark as a letter "E." The probative value of this evidence is very limited because Applicant presented no evidence concerning the extent to which these third-party design marks are used in commerce or the consumers' perception of the registered designs. *See Palm Bay Imports Inc.*, 73 USPQ2d at 1693 (evidence does not rise to the level of demonstrating that the single

third-party use was so widespread as to “condition” the consuming public). Moreover, there is no evidence of record indicating that consumers will associate the applied-for mark with the mark ETONIC, as Applicant maintains. In view of the foregoing, we find that there is no genuine dispute that the overall commercial impression created by Applicant’s mark is highly similar to Opposers’ mark.

▪ *Trade Channels; Purchasers and Conditions of Sale*

We next consider the parties’ trade channels and the conditions under which the parties’ footwear sales are made (or will be made), including whether purchasers of footwear are careful and sophisticated or whether purchases are made on impulse. Purchaser sophistication or a high degree of care may tend to reduce a likelihood of confusion; whereas impulse purchases of inexpensive items or a low degree of care may increase the likelihood of confusion. *See Palm Bay Imports Inc.*, 73 USPQ2d at 1695; *see also Uncle Ben’s Inc. v. Stubenberg Int’l Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998) (“the fact that we are here dealing with relatively inexpensive ... products means that the average purchaser may exercise less care in the purchasing decision”).

When the identifications of goods in an applicant’s application and in an opposer’s registration include no limitations or restrictions as to trade channels or classes of purchasers, we must presume that both parties’ goods are or can be marketed in all normal trade channels and to all normal classes of purchasers for such goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As there are no restrictions in the classes of purchasers or trade channels for the parties’ footwear in their respective

identifications of goods, there is no genuine dispute as to the material fact that both parties' purchasers encompass the same, ordinary purchasers for footwear and travel in the same trade channels. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *Tea Board of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2008) ("Because the goods are identical and there are no restrictions in the identification of goods, the channels of trade as well as the purchasers for such goods are deemed identical" and include the same purchasers.); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (where goods in applicant's application were in-part identical to those in registrant's registration, lack of restrictions as to trade channels or purchasers gives rise to presumption that goods "could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

With regard to the conditions of sale, "[w]hen products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1899 (citations omitted); *see also Eveready Battery Company, Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009) ("Generally, purchasers of casual, low cost ordinary consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods.") (citing *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984)).

The parties' identifications of goods do not include any restrictions or limitations as to cost. In view thereof, we must also presume that the parties' goods include footwear at all price points, including relatively inexpensive footwear that would be subject to impulse purchase without significant deliberation. Further, the record shows footwear is relatively inexpensive. Specifically, Opposers' sandals sell for \$30 (42 TTABVUE 173-77) and their running shoes start at \$60 (42 TTABVUE 167, 183). In view of the foregoing, there is no genuine dispute that the parties' footwear may be purchased by consumers casually and on impulse, without great care. *See Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1944 (TTAB 1996) (finding no genuine issues of material fact including that "goods [including clothing] are relatively inexpensive, subject to impulse purchase").

- *Decision*

With respect to Opposers' motion, having considered the evidence and arguments submitted by the parties, and viewing the evidence in the light most favorable to Applicant and drawing all justifiable inferences in favor of Applicant, we find each of the relevant *du Pont* factors favor a finding of likelihood of confusion and that Opposers have satisfied their burden of setting forth a *prima facie* case showing that there is no genuine dispute as to any material fact remaining for trial in regard to their likelihood of confusion claim; that Applicant has failed to demonstrate the existence of a genuine dispute regarding at least one material fact which requires resolution by trial; and that Opposers are entitled to judgment as a matter of law as to their claim of priority and likelihood of confusion based on Registration No.

3029129. Regarding Applicant's motion, viewing the evidence in the light most favorable to Opposers and drawing all justifiable inferences in favor of Opposers, we find that Applicant has failed to show the absence of a genuine dispute that the parties' marks are so dissimilar in commercial impression as to preclude a finding of likelihood of confusion. Accordingly, Opposers' motion for summary judgment is **GRANTED**, the opposition is sustained, and registration is refused. Applicant's motion for partial summary judgment on Opposer's Section 2(d) claim is **denied**.

Opposers' Other Claims

Having determined that Opposers are entitled to prevail in this proceeding based upon their Section 2(d) claim, we need not reach the parties' summary judgment motions addressing the issues related to Opposers' dilution, lack of bona fide intent or contract claims. *See American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd unpublished*, 932 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) ("Having determined that petitioner is entitled to the relief it seeks based upon its claim pursuant to Section 2(d) of the Lanham Act, we need not address petitioner's claim that registrant has abandoned its rights in the mark AMERICAN MOBILPHONE PAGING and design."). *Accord Venture Out Props. LLC. v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007) ("In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution."); *Interglo AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862, 1864 (TTAB 2002) ("Having found that there exists a likelihood of confusion, we elect to sustain the opposition on this basis alone.").



NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE WILL BE EFFECTIVE JANUARY 14, 2017.

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 F.R. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings.

For complete information, the parties are referred to:

- The Board’s home page on the uspto.gov website:
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- A chart summarizing the affected rules and changes:
http://www.uspto.gov/sites/default/files/documents/RulesChart_01_14_17.pdf

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by mail. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.

- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.101 and 2.111.

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.

