

This Opinion is Not a  
Precedent of the TTAB

Hearing: March 7, 2019

Mailed: March 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Fifty-Six Hope Road Music Limited*  
*v.*  
*Sandal Factory, Inc.*

—  
Opposition No. 91212582  
—

Jill M. Pietrini and Paul A. Bost of Sheppard Mullin Richter & Hampton LLP,  
for Fifty-Six Hope Road Music Limited.

Sandal Factory, Inc. through its President Shawn Tolley.<sup>1</sup>

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Before Taylor, Bergsman and Heasley,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Sandal Factory, Inc. (Applicant) filed an application to register the mark GNARLY

MARLEY'S (in standard characters) for the goods and services listed below:

Apparel, namely, t-shirts, shirts, pants, shorts, and  
dresses, in Class 25;

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<sup>1</sup> On March 4, 2019, Applicant's counsel filed a request to withdraw as counsel for Applicant because, inter alia, "Applicant determined that it would rest on its brief" and "it no longer wished to incur legal fees in connection with this matter." 94 TTABVUE 2. The request to withdraw is in compliance with the requirements of Trademark Rule 2.19(b) and Patent and Trademark Rule 11.116, and is accordingly granted. Also, we find that Applicant wishes to proceed pro se.

Souvenirs and novelty goods, namely, ornamental novelty buttons, badges, and pins, in Class 26; and

Retail store services featuring clothing, souvenirs, and novelty gift items, in Class 35.<sup>2</sup>

Fifty-Six Hope Road Music Limited (Opposer) filed an opposition under Sections 2(a), 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(a), (d), and 1125(c), on the grounds that Applicant's mark GNARLY MARLEY'S falsely suggests a connection with Opposer, that Applicant's mark GNARLY MARLEY'S is likely to cause confusion with various registered and common law marks containing the name "Marley" owned by Opposer, and that Applicant's mark GNARLY MARLEY'S is likely to dilute Opposer's MARLEY marks. Opposer pled ownership of, inter alia, the registration identified below:

- Registration No. 2349361 for the mark BOB MARLEY (typed drawing form)

for the goods listed below:

Incense, in Class 3;

Novelty license plate of nonprecious metal, in Class 6;

Plastic cases for beepers; magnets, in Class 9;

Jewelry; watches; medallions, in Class 14;

Greeting cards; stickers; stationery type portfolios; posters; postcards; postcard books; songbooks; decals; trading cards; calendars; novels; bookmarks, in Class 16;

Backpacks; fanny packs; wallets, tote bags, in Class 18;

Mugs, in Class 21;

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<sup>2</sup> Application Serial No. 85760798, filed October 23, 2012, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's claim of a bona fide intent to use its mark in commerce.

Textile wall hangings, in Class 24;

T-shirts; thermal shirts; jackets; hats; caps; sweatshirts;  
ties; bandanas, in Class 25; and

Ornamental cloth patches, in Class 26;<sup>3</sup> and

In addition, Opposer alleged that it used the mark MARLEY for shirts and headwear at least as early as February 2003.<sup>4</sup>

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

## I. Preliminary Issues

A. Whether Opposer may rely on the unpleaded registration for the mark MARLEY for clothing?

Opposer seeks to rely on its unpleaded Registration No. 4394278 for the mark MARLEY for “clothing, namely, shirts and headwear”<sup>5</sup> as a basis for its pleaded claims. The facts relating to this issue are set forth below:

1. Opposer alleges that it first used the mark MARLEY for clothing at least as early as February 2003;<sup>6</sup>
2. On April 14, 2009, Opposer filed application Serial No. 77713973 to register

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<sup>3</sup> Registered May 16, 2000; renewed. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks....”).

<sup>4</sup> Notice of Opposition ¶16 (1 TTABVUE 6).

<sup>5</sup> 26 TTABVUE 324.

<sup>6</sup> Notice of Opposition ¶6 (1 TTABVUE 6); *see also* Registration No. 4394278 claiming first use as February 2003 (26 TTABVUE 324).

the mark MARLEY for “clothing, namely, shirts and headwear”;<sup>7</sup>

3. On October 23, 2012, Applicant filed application Serial No. 85760798 for the mark GNARLY MARLEY’S;
4. On May 21, 2013, Applicant’s application for GNARLY MARLEY’S was published for opposition;
5. On May 23, 2013, Opposer filed an extension of time to oppose Applicant’s application for the mark GNARLY MARLEY’S;<sup>8</sup>
6. On June 18, 2013, Opposer’s application to register the mark MARLEY for “clothing, namely, shirts and headwear” was published for opposition;<sup>9</sup>
7. On September 3, 2013, Opposer’s application for the mark MARLEY for “clothing, namely, shirts and headwear” registered as Registration No. 4394278;<sup>10</sup>
8. On September 16, 2013, Opposer filed a notice of opposition against the registration of Applicant’s application for the mark GNARLY MARLEY’S.<sup>11</sup> Opposer did not plead ownership of Registration No. 4394278 even though it had issued on September 3, 2013, 13 days prior to the filing of the Notice of Opposition.

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<sup>7</sup> 26 TTABVUE 324.

<sup>8</sup> 1 TTABVUE 9.

<sup>9</sup> 26 TTABVUE 324.

<sup>10</sup> *Id.*

<sup>11</sup> 1 TTABVUE.

9. On January 6, 2014, Opposer served Applicant with Opposer's first set of requests for admission which referred to Registration No. 4394278;<sup>12</sup>
10. On May 1, 2015, Opposer filed a notice of reliance on Registrations owned by Opposer, including Registration No. 4394278 for the mark MARLEY for "clothing, namely, shirts and headwear" "and relies on them as grounds for its claims of likelihood of confusion, likelihood of dilution, and false suggestion of a connection;"<sup>13</sup>
11. On June 23, 2015, Applicant moves to strike various exhibits in Opposer's notice of reliance including "unpleaded registrations that were ostensibly the subject of pending applications ... when the notice of opposition was filed;"<sup>14</sup>
12. In opposition to Applicant's motion to strike, Opposer argues that Applicant has been aware of Opposer's intent to rely on its registration for the mark MARLEY for clothing since the filing of the Notice of Opposition because Opposer alleged that it first used the mark MARLEY on clothing at least as early as February 2003,<sup>15</sup> and that Opposer propounded numerous requests for admission specifically relating to this registration, and attached a copy of the TESS and TARR pages for this registration to the requests for admission;<sup>16</sup>

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<sup>12</sup> 26 TTABVUE 98-99, 121 and 139-144.

<sup>13</sup> 26 TTABVUE 5, 9, and 324.

<sup>14</sup> 30 TTABVUE 7. As noted above, the USPTO registered MARLEY (Registration No. 4394278) 13 days before Opposer filed the Notice of Opposition.

<sup>15</sup> 32 TTABVUE 7-8.

<sup>16</sup> 32 TTABVUE 8.

13. In an order dated November 10, 2015, the Board denied Applicant's motion to strike without addressing the fact that Opposer did not plead, nor move to amend its pleading, to include Registration No. 4394278.

Applicant also argues Opposer did not plead ownership of its Registrations attached as Exhibits 19-23, 26, 42 [the MARLEY registration at issue] and 53-58, and thus they are not admissible under Notice of Reliance. Pursuant to Trademark Rule 2.122(d)(2) "a registration owned by any party may be made of record in the proceeding by ... filing a notice of reliance." Unpleaded registrations, and registrations and applications not subject of the proceeding, may be considered for "whatever probative value" they may lend to Opposer's showing under the appropriate factors in its case, and whether they have probative value is left to final decision. *See FujiFilm SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014).<sup>17</sup>

14. Opposer, in its brief, treated Registration No. 4394278 as if it were a pleaded registration.

To establish priority, Opposer must prove "proprietary rights in its pleaded mark that are prior to defendant's rights in the challenged mark." TBMP § 309.03(c)(A); *Herbko International Inc. v. Kappa Books, Inc.*, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). Here, Opposer has pleaded and made of record, and Applicant has not contested the validity of, its ownership of numerous federal registrations including the term MARLEY predating the filing date of the Application and any date of first use on which Applicant can rely.<sup>18</sup>

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<sup>17</sup> 34 TTABVUE 12.

<sup>18</sup> Opposer's Brief, p. 13 (59 TTABVUE 22).

15. Applicant, in its brief, treated Registration No. 4394278 as if it were properly of record.<sup>19</sup>

Our case law is clear that an unpleaded registration may not be used as a basis for a party's opposition. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1576 n.4 (TTAB 2008) (opposer may not rely upon an unpleaded registration in support of its claims; it must seek leave to amend the petition for cancellation to rely on the registration); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (unpleaded registration given no consideration where applicant not given fair notice of opposer's reliance on registration that issued after filing of complaint); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1929 n. 18 (TTAB 2006) ("evidence regarding the unpleaded mark or registration . . . will not be considered.").

When Opposer filed its Notice of Opposition, it knew full well what registrations it owned. If it wished to rely on a likelihood of confusion claim based, in part, on a registration for MARLEY for "clothing, namely, shirts and headwear," it should have pled the registration in its original Notice of Opposition or, at a minimum, sought leave to amend its Notice of Opposition after it served its first set of requests for admission that referred to the registration. Just because Opposer pleaded common law use of the mark MARLEY for clothing and referred to it in requests for admission,

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<sup>19</sup> Applicant's Brief pp. 3-4 (67 TTABVUE 10-11) ("Opposer, between its pled registrations and Notice of Reliance, made of record the following 39 registrations for or including the term 'MARLEY.'").

Opposer's actions prior to trial gave Applicant no reason to believe that Opposer intended to rely on its MARLEY registration for "clothing, namely shirts and headwear," especially when Opposer pleaded numerous registrations containing the name "Marley." Applicant is not required to divine Opposer's intention.

The Board, in its November 10, 2015 order, denied Applicant's motion to strike Opposer's notice of reliance on Registration No. 4394278 because an unpleaded registration may be introduced through Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2) ("a registration owned by any party may be made of record in the proceeding by ... filing a notice of reliance.") and be considered for "whatever probative value" they may lend to Opposer's case.<sup>20</sup> The Board cited as authority *FujiFilm SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d at 1236. In *FujiFilm*, the Board held that "[w]hile an unpleaded registration cannot be used as a basis for the opposition, it, like third-party registrations, may be considered for 'whatever probative value' it may lend to opposer's showing under the *du Pont* factors in its case in chief," and did not strike the registration because the probative value of the registration would not be determined until trial. *Id.* (citing *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1035 (TTAB 2010)). In *Safer*, Applicant used Opposer's unpleaded registration for the mark DEER-OFF to show that Opposer disclaimed the exclusive right to use the word "Deer." Likewise, in this case, while Opposer's unpleaded registration may not be used as a basis for its claims, though not particularly probative, it may be used in the manner of a third-party registration

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<sup>20</sup> 34 TTABVUE 12.

(e.g., to show the strength of Opposer's marks or the scope of use of the MARLEY marks for dilution purposes, etc.). Thus, the Board did NOT admit Registration No. 4394278 for any purpose but in accordance with the holding in *FujiFilm* and *Safer*.

Finally, because Applicant objected to the introduction of Registration No. 4394278 on the ground that it was not a pleaded registration, we cannot find that the registration applied to the claims and was tried by implied consent pursuant to Fed. R. Civ. P. 15(b). Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *See Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009). The issue of whether an issue was tried by consent is basically one of fairness, *id.* at 1139, and based on the facts recounted above, we find that Opposer did not act fairly and that Applicant was not aware that Opposer intended to rely on Registration No. 4394278 until Opposer filed its notice of reliance. This is especially true in this case where Opposer pleaded ownership of numerous "Marley" registrations, had the ability to advise Applicant that it intended to rely on Registration No. 4394278 when it filed its Notice of Opposition, and it also had the opportunity to amend the Notice of Opposition before trial commenced.

We will not consider Registration No. 4394278 as basis for any of Opposer's claims and, therefore, Opposer must rely on its common law use of MARLEY for "clothing, namely, shirts and headwear."

B. Exhibits attached to the briefs.

Both parties attached exhibits to their briefs. As we have often stated, exhibits or attachments to briefs are of little or no use in a Board proceeding. The Board sets trial periods during which the parties may submit evidence by filing notices of reliance or by taking testimony. Evidence submitted outside of the trial periods — including that attached to briefs — is untimely, and will not be considered. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 704.05(b) (2018) (and cases cited therein). Conversely, evidence that was timely filed during the parties’ trial periods need not and should not be resubmitted. *See ITC Entm’t Group Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021 (TTAB 1998). Thus, while exhibits to briefs are not explicitly prohibited by the Trademark Rules, the Board will usually ignore them, because they comprise either untimely evidence or unnecessary copies of timely evidence.

Parties to Board cases seem to be under the impression that attaching previously-filed evidence to a brief (and citing to the attachments, rather than to the original testimony or notices of reliance) is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether such attachments are properly of record, Trademark Rule 2.123(l), citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during trial, requiring more time and effort than would have

been necessary if citations were directly to the trial record. *See Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008).

The parties should instead cite to the record using the TTABVUE docket entry number and the electronic page number where the document or testimony appears. For material or testimony that has been designated confidential and that does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

C. Opposer's second set of requests for production of documents.

Opposer sought to introduce through a notice of reliance Opposer's second set of requests for production of documents, to which Applicant purportedly never responded.<sup>21</sup> Opposer argues that "the Board should enter an adverse inference against Applicant that if the requested documents were produced, they would not be favorable to Applicant."<sup>22</sup> We will not draw any adverse inferences from Applicant's purported failure to respond to Opposer's second set of requests for production of documents for two reasons. First, as Opposer noted in its notice of reliance, while documents produced in response to document production requests generally cannot be made of record via a notice of reliance, 37 C.F.R. § 2.120(k)(3)(ii) and TBMP § 704.11, written responses to document production requests indicating that no responsive documents exist may be submitted via a notice of reliance. *See*

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<sup>21</sup> 26 TTABVUE 5 and 263-270.

<sup>22</sup> 26 TTABVUE 5.

*ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1038, n.7 (TTAB 2012). Thus, a response to a request for production of documents may be submitted via a notice of reliance only for the limited purpose of proving that no documents exist.

Second, if a party fails to respond to a request for production of documents, the party seeking discovery may file a motion for an order to compel production. 37 C.F.R. § 2.120(f). A motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or reset. *Id.* Opposer elected not file a motion to compel discovery and, therefore, Opposer waived its right to complain that Applicant did not respond to Opposer's second set of requests for production of documents.

We will not draw any adverse inferences from Applicant's failure to respond to Opposer's second set of requests for production of documents.

## II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the application file at issue. The parties introduced the following testimony and evidence:

### A. Opposer's testimony and evidence.

#### 1. Notice of reliance on the following items:

- a. Applicant's responses to Opposer's interrogatory Nos. 1-7, 9, 11, 13, 15, 16, 18, 21, 22, and 27;<sup>23</sup>

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<sup>23</sup> 26 TTABVUE 30-46.

- b. Applicant's supplemental responses to Opposer's interrogatory Nos. 2, 3, 5, 7, 13, 16, 17, 19 and 27, including documents identified as APP 0001 through APP 0020 and APP 0023 through APP 0026 (designated confidential);<sup>24</sup>
- c. Applicant's further supplemental responses to Opposer's interrogatory Nos. 7, 16, and 17;<sup>25</sup>
- d. Applicant's responses to Opposer's second set of interrogatories Nos. 1-6;<sup>26</sup>
- e. Applicant's responses to Opposer's first set of requests for admission Nos. 59, 76, 79-81, 84, 87, 118, 119, and 127-130;<sup>27</sup>
- f. Applicant's supplemental responses to Opposer's first set of requests for admission Nos. 91, 95, 99, 171-172, 175-176, and 178-182;<sup>28</sup>
- g. Applicant's further supplemental responses to Opposer's first set of requests for admission Nos. 62-63;<sup>29</sup>
- h. Applicant's responses to Opposer's second set of requests for admission Nos. 1, 5, 8, 9, 10-13, 15, 17, 19, 22, 24, 26 and 27;<sup>30</sup>

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<sup>24</sup> 26 TTABVUE 48-76 and 25 TTABVUE.

<sup>25</sup> 26 TTABVUE 79-81.

<sup>26</sup> 26 TTABVUE 91-95.

<sup>27</sup> 26 TTABVUE 167-178.

<sup>28</sup> 26 TTABVUE 169-188.

<sup>29</sup> 26 TTABVUE 191-194.

<sup>30</sup> 26 TTABVUE 210-220.

- i. Applicant's responses to Opposer's first set of requests for production of documents Nos. 15, 28, 35-40, 42, 44, 46, 62, 63, and 74 for the purpose of indicating that no responsive documents exist. *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d at 1038 n.7;<sup>31</sup>
- j. Applicant's supplemental responses to Opposer's first set of requests for production of documents Nos. 9, 20, 41, 48, 49, 61 and 64, for the purpose of indicating that no responsive documents exist;<sup>32</sup>
- k. Copies of registrations owned by Opposer, pleaded and not pleaded, printed from the USPTO electronic database showing current status and title upon which Opposer intends to prove its claims of likelihood of confusion, likelihood of dilution, and false suggestion of a connection;<sup>33</sup>
- l. Copies of applications for marks containing the name "Marley" filed by Opposer which were not pleaded in the Notice of Opposition and upon which Opposer intends to prove its claims of likelihood of confusion, likelihood of dilution and false suggestion of a connection;<sup>34</sup> and
- m. Documents in Application Serial No. 85150251 for the mark ONE LOVE ONE OCEAN filed by Sunkissed Enterprises, Inc. purportedly to show Applicant's efforts to associate its goods and services with Opposer;<sup>35</sup>

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<sup>31</sup> 26 TTABVUE 239-255.

<sup>32</sup> 26 TTABVUE 257-261.

<sup>33</sup> 26 TTABVUE 272-360.

<sup>34</sup> 26 TTABVUE 362-400.

<sup>35</sup> 26 TTABVUE 402-421.

2. Testimony deposition of Shawn Tolley, Applicant's President;<sup>36</sup>
3. Testimony deposition of Robert A. Parks, President of Sunkissed Enterprises, Inc., a screen printing company;<sup>37</sup>
4. Testimony deposition of Doreen Crujeiras, an employee at Bob Marley Music, a management agent for Opposer;<sup>38</sup>
5. Testimony deposition of Pete A. D'Auria, Chief Financial Officer of Bravado International Group, an entertainment merchandising business and Opposer's licensee;<sup>39</sup>
6. Testimony deposition of Michael Conley, a former part owner of Zion Rootswear, a licensee of Opposer that sold t-shirts, head wear, hooded sweatshirts, decals, incense, tapestries, and other things that fit with music, musicians and entities;<sup>40</sup> and
7. Rebuttal notice of reliance on documents in other proceedings before the Board purporting to rebut Applicant's evidence of third-party use.<sup>41</sup>

B. Applicant's testimony and evidence.

1. Notice of reliance on the following items:

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<sup>36</sup> 75 TTABVUE. The portions of the Tolley deposition designated confidential are posted at 76 TTABVUE.

<sup>37</sup> 77 TTABVUE. The portions of the Parks deposition designated confidential are posted at 78 TTABVUE.

<sup>38</sup> 79-80 TTABVUE. The portions of the Crujeiras deposition designated confidential are posted at 86 and 87 TTABVUE.

<sup>39</sup> 83 TTABVUE. The portions of the D'Auria deposition designated confidential are posted at 84 TTABVUE.

<sup>40</sup> 85-87 TTABVUE.

<sup>41</sup> 55 TTABVUE.

- a. Copies of third-party registrations containing the name “Marley”;<sup>42</sup>
  - b. Excerpts from the prosecution history files of some of the third-party registrations;<sup>43</sup>
  - c. Copies of applications from U.S. Alcohol and Tobacco Tax and Trade Bureau online registry for alcoholic beverages label approvals containing the name “Marley”;<sup>44</sup>
  - d. Wikipedia entries for individuals or places with the name “Marley”;<sup>45</sup>
  - e. News articles referring to “Marley Station”;<sup>46</sup> and
  - f. Excerpts from websites showing third-party use of “Marley”;<sup>47</sup> and
2. Applicant’s revised notice of reliance on Applicant’s responses to Opposer’s written discovery introduced purportedly to make not misleading Applicant’s answers to Opposer’s written discovery.<sup>48</sup>

### III. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove

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<sup>42</sup> 38 TTABVUE 13-130.

<sup>43</sup> 38 TTABVUE 132-283 and 39 TTABVUE 2-328.

<sup>44</sup> 39 TTABVUE 330-337.

<sup>45</sup> 40 TTABVUE 4-61.

<sup>46</sup> 40 TTABVUE 63-78.

<sup>47</sup> 40 TTABVUE 79-157.

<sup>48</sup> 49 TTABVUE.

that it has “both a ‘real interest’ in the proceedings as well as a ‘reasonable’ basis for its belief of damage.” See *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Opposer has established its standing by properly introducing into evidence copies of its pleaded registrations.<sup>49</sup> See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in its brief, does not contest that Opposer has standing.

#### IV. Priority

Because Opposer’s pleaded registrations are of record, priority is not at issue with respect to the goods and services identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

We turn now to whether Opposer has proven that it has made prior use of MARLEY for clothing, a necessary element of any claim under Section 2(d). Opposer must establish proprietary rights in its pleaded common-law mark that precede Applicant’s actual or constructive use of its involved mark. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995). In other words, because unregistered marks are not entitled to the presumptions established under

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<sup>49</sup> 26 TTABVUE 272-360.

Sections 7(b)-(c) of the Trademark Act, 15 U.S.C. §§ 1057(b) and (c), it is Opposer's burden to demonstrate that it owns a trademark that was used prior to Applicant's first use of its mark and not abandoned. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

Applicant may rely on the filing date of its application, October 23, 2012, as its constructive date of first use or, in the alternative, an earlier date of actual use. In this regard, Opposer elicited testimony from Shawn Tolley, Applicant's President, that Applicant first used the mark GNARLY MARLEY'S in connection with the retail store services as early as October 15, 2011.<sup>50</sup> Accordingly, Applicant's priority date for its retail store services is October 15, 2011 and, in the absence of testimony, its priority date for the goods in Classes 25 and 26 is October 23, 2012.

Michael Conley, a former owner of Zion Rootswear, a licensee and partner of Opposer, testified that Zion Rootswear sold products bearing MARLEY standing alone since 2003.

Q. Did any of Zion Rootswear's licensed products include the name "Marley," standing alone?

A. Yes.

Q. Do you know when the first time was that Zion Rootswear offered a product bearing the name "Marley," standing alone?

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<sup>50</sup> Tolley Testimony Dep., pp. 75-78 and Exhibits 4 and 5 (75 TTABVUE 78 and 256-57). Although Mr. Tolley testified that he believed GNARLY MARLEY'S was first used October 20, 2011, Exhibit 5, a store receipt, is dated October 15, 2011. The precise date, October 15 or October 20, does not change our decision.

A. Yes. It would have been our spring and summer offering of 2003, which would have been mid to late February.

Q. And how do you know that?

A. Just from doing this throughout the years, and our catalogues came out pre-spring and summer and pre-holiday.<sup>51</sup>

Two examples of licensed products displaying MARLEY as a mark from the 2003 Zion Rootswear catalog are reproduced below:

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<sup>51</sup> Conley Testimony Dep., pp. 17-18 and Exhibit 84 (85 TTABVUE 18-19 and 125-152).

<sup>52</sup> Conley Testimony Dep. Exhibit 84 (85 TTABVUE 131).

<sup>53</sup> Conley Testimony Dep. Exhibit 84 (85 TTABVUE 134).

Opposer has used MARLEY on t-shirts and hats since 2003 and, therefore, has priority for those goods.

#### V. Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record

evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1380).

A. Similarity or dissimilarity and nature of the goods and services.

As noted above, Applicant is seeking to register its mark for the goods and services listed below:

Apparel, namely, t-shirts, shirts, pants, shorts, and dresses, in Class 25;

Souvenirs and novelty goods, namely, ornamental novelty buttons, badges, and pins, in Class 26; and

Retail store services featuring clothing, souvenirs, and novelty gift items, in Class 35.

Opposer has used its MARLEY mark in connection with t-shirts and has registered BOB MARLEY for t-shirts, thermal shirts, and sweatshirts.<sup>54</sup> Thus, the clothing products are in part identical.<sup>55</sup>

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<sup>54</sup> “Shirts,” as identified in Applicant’s application, is broad enough to encompass Opposer’s identified “thermal shirts” and “sweatshirts.” See *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

<sup>55</sup> Under this *du Pont* factor, Opposer need not prove, and we need not find, similarity as to each and every product listed in the description of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014).

Opposer has registered BOB MARLEY for ornamental cloth patches, which Shawn Tolley, Applicant's President, has testified are the same thing as ornamental novelty badges.

Q. What's an ornamental badge - - or ornamental novelty badge?

\* \* \*

A. A patch, a patch that you attach to a bomber jacket or if you played sports in high school and you lettered that patch that you sew on. Or if you're in the Boy Scouts, or Cub Scouts or Girl Scouts, those are the patches that are sewn on to the garments.

Q. Okay. And is the material that the patch is made out of, fabric?

A. Yes - - if you are asking what I am thinking of, yes.<sup>56</sup>

An example of Opposer's BOB MARLEY patches displayed in the 2003 Zion Rootswear catalog are reproduced below:<sup>57</sup>



<sup>56</sup> Tolley Testimony Dep., pp. 87-88 (75 TTABVUE 87-88).

<sup>57</sup> Conley Testimony Dep. Exhibit 84 (85 TTABVUE 133).

Thus, Applicant's ornamental novelty badges and Opposer's ornamental cloth patches are the same.

Applicant's retail store services in the field of clothing, souvenirs, and novelty gift items include many of Opposer's products. In this regard, Shawn Tolley, Applicant's President, testified that it is not uncommon for a company to use a name for a retail store and sell products under that same name.<sup>58</sup> Likelihood of confusion may result from the use by different parties of the same or similar marks for goods, on the one hand, and in connection with services that deal with those goods on the other. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (applicant's general merchandise store services includes the sale of furniture which applicant does, in fact, sell); *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (jewelry and jewelry store services are inherently related goods and services); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) ("there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion."). In fact, Applicant has purchased BOB MARLEY licensed products from Opposer's licensee, Zion Rootswear, including clothing products, wristbands, stickers, patches, necklaces.<sup>59</sup>

We find that Applicant's goods are identical to Opposer's goods and that Applicant's services are related to Opposer's goods.

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<sup>58</sup> Tolley Testimony Dep., p. 114 (75 TTABVUE 114).

<sup>59</sup> D'Auria Testimony Dep., pp. 82-83, 84-87 (confidential), and 90-97 (Confidential) and Exhibit 78 (Confidential) (83 TTABVUE 74-75 and 84 TTABVUE 4-11 and 51-67); Tolley Testimony Dep., pp. 110-111 (75 TTABVUE 110-111).

B. Established, likely-to-continue channels of trade and buyers to whom sales are made.

Because Applicant's "apparel, namely, t-shirts, shirts, pants, shorts, and dresses" and "souvenirs and novelty goods, namely, ornamental novelty buttons, badges, and pins" are in part identical to Opposer's BOB MARLEY t-shirts and shirts and ornamental cloth patches, we presume that the channels of trade and classes of purchasers are the same. *See Viterra*, 101 USPQ2d at 1908 (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

With respect to the channels of trade and classes of consumers for Applicant's retail store services, Opposer sells its products through its licensees to retail stores such as Applicant's retail store.

Q. Where does Bravado sell its licensed Bob Marley products, through what channels?

A. We sell it through the retail channel, and that retail channel is what we would consider our marts, mass market, Walmart K-Mart. We also sell it mid-tier, which would be Target, Kohl's. We sell it at independent specialty shops, which would be in your malls, Hot Topic, Spencer Gifts, and then we sell it to mo[m] and pop accounts, and we also sell it to a bunch of what we would call direct to consumer outlets similar to ourselves, so Amazon, there is a company called Old Glory that does online sales to

consumers, and then obviously direct to consumers through our website.

Q. And included in the mom-and-pop stores are any surf-related or beach-related stores included in that?

A. Yes.

Q. And what about gift stores that sell more touristy type items?

A. Yes.<sup>60</sup>

As previously noted, Applicant purchases BOB MARLEY licensed products from Opposer's licensee, Zion Rootswear, including clothing products, wristbands, stickers, patches, necklaces.<sup>61</sup> Accordingly, Opposer's products are offered through the same channels of trade and to the same classes of consumers as Applicant's retail store services.

C. The conditions under which purchases are made.

Because neither Opposer's identifications of goods, nor Applicant's identifications of goods or services, have any restrictions or limitations as to channels of trade, classes of consumers, quality, or price, we must treat the goods and services as including inexpensive as well as more costly products, and the retail stores as including "mom and pop" shops as well as prestigious, exclusive stores, and therefore presume that purchasers for these goods and services include ordinary consumers who may buy inexpensive clothing, souvenirs, and novelties on impulse. *See Stone*

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<sup>60</sup> D'Auria Testimony Dep., pp. 75-76 (83 TTABVUE 71-72).

<sup>61</sup> D'Auria Testimony Dep., pp. 82-83, 84-87 (confidential), and 90-97 (Confidential) and Exhibit 78 (Confidential) (83 TTABVUE 74-75 and 84 TTABVUE 4-11 and 51-67); Tolley Testimony Dep., pp. 110-111 (75 TTABVUE 110-111).

*Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014) (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”). *See also In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that not all purchasers of wine may be discriminating because while some may have preferred brands, “there are just as likely to be purchasers who delight in trying new taste treats.”).

D. Strength of Opposer’s MARLEY and BOB MARLEY marks, including the number and nature of similar marks in use on similar goods and services.

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

1. The inherent strength of the registered BOB MARLEY and MARLEY marks.

Wikipedia.org describes “Marley” as “an English-language surname.”<sup>62</sup> Opposer proffered no countervailing meaning. Accordingly, “Marley” is primarily merely surname and Opposer’s common law MARLEY trademark is not inherently distinctive.<sup>63</sup> See *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985):

The statute in Section 2(e)(3) (15 U.S.C. §1052(e)(3))<sup>64</sup> reflects the common law that exclusive rights in a surname per se cannot be established without evidence of long and exclusive use which changes its significance to the public from a surname of an individual to a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business, and by the requirement for evidence of distinctiveness, in effect, delays appropriation of exclusive rights in the name. See 1 J. Gilson, *Trademark Protection and Practice* §2.08 (1982). The statute, thus, provides a period of time, as under the common law, to accommodate the competing interests of others. An analysis of similar considerations in connection with geographic terms can be found in *In re Nantucket, Inc.*, 677 F.2d 95, 102-04, 213 USPQ 889, 895-96 (CCPA 1982) (Nies, J., concurring).

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<sup>62</sup> 40 TTABVUE 4. Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) defines “Marley” as “Robert Nesta (“Bob”), 1945-81, Jamaican reggae singer, guitarist, and songwriter: popularizer of Rastafarianism.” See also Merriam-Webster.com (“Definition of Marley: Bob 1945-81 Robert Nesta Marley Jamaican singer and songwriter”); ENCYCLOPAEDIA BRITANNICA (listing Bob Marley and Jacob Marley, a fictional character who is the deceased business partner of Ebenezer Scrooge in “A Christmas Carol,” by Charles Dickens). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format, *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016), and information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”).

<sup>63</sup> We note Applicant’s third-party registrations including the name “Marley” and evidence of third-party use of the name “Marley.”

<sup>64</sup> Now Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 2(e)(4).

On the other hand, Opposer's BOB MARLEY mark is registered on the Principal Register without a claim of acquired distinctiveness. Because BOB MARLEY has been registered, it is entitled to a presumption of validity by Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), and "moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods." *Tea Bd. of India*, 80 USPQ2d at 1899.

2. The commercial strength of Opposer's BOB MARLEY and MARLEY marks.

Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India*, 80 USPQ2d at 1899.

There is no dispute that Bob Marley is famous.<sup>65</sup>

**Bob Marley**, in full **Robert Nesta Marley**, (born February 6, 1945, Nine Miles, St. Ann, Jamaica—died May 11, 1981, Miami, Florida, U.S.), Jamaican singer-songwriter whose thoughtful ongoing distillation of early ska, rock steady, and reggae musical forms blossomed in the 1970s into an electrifying rock-influenced hybrid that made him an international superstar.

\* \* \*

Although his songs were some of the best-liked and most critically acclaimed music in the popular canon, Marley was far more renowned in death than he had been in life. *Legend* (1984), a retrospective of his work, became the best-selling reggae album ever, with international sales of more than 12 million copies.<sup>66</sup>

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<sup>65</sup> Applicant's response to Opposer's request for admission Nos. 38, 42, and 87 (26 TTABVue 173, 181, and 183).

<sup>66</sup> Robert Nesta Marley, ENCYCLOPAEDIA BRITANNICA (2018) (britannica.com).

Bob Marley's fame as a musician positively affects the sale of BOB MARLEY and MARLEY branded merchandise.

Q. What is your understanding of why consumers buy apparel related to Bob Marley?

A. They love Bob Marley. They love his music. It's a great fit.

Q. And Zion Rootswear also produces and sells T-shirts and other apparel bearing the image of other musicians; correct?

A. Yes.

Q. In your experience, is there a connection between one's fame as a musician and the popularity of the products associated with that musician?

A. Yes.

Q. And what is that connection?

A. People love their music icons, their bands, and they kind of want to advertise and let other people know that they like them.<sup>67</sup>

The licenses for the sale of BOB MARLEY and MARLEY branded products have been profitable.

Q. And was the license, Zion Rootswear, obtained from Fifty-Six Hope Road a good property for Zion Rootswear?

A. Fantastic property for Zions Rootswear. Yes.

Q. And how so?

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<sup>67</sup> Conley Testimony Dep., p. 49-50 (85 TTABVUE 50-51); *see also* D'Auria Testimony Dep., pp. 74-75 (83 TTABVUE 70-71) ("It's a way for a fan, in this case consumer, to express their like for Bob Marley, their association with his lifestyle. You know, it's a way for a consumer to relate back to the musician.").

A. Hugely recognizable. Everybody knows who Bob Marley is, and being the exclusive person for that was very good for our reputation and for the company.

Q. And in your experience as part owner of Zion Rootswear, how would you characterize the demand for Bob Marley related goods?

A. Huge.

Q. And how did the demand for Bob Marley related goods compare to your other licensed properties; for example, Johnny Cash, Jimi Hendrix, Miles Davis?

A. I would say Bob Marley was about probably 70 percent of Zion Rootswear business. It was one of those what we call evergreen licenses. It was timeless. He would have fans from 12 to 70 years old.<sup>68</sup>

Bob Marley related products are the largest selling products for Zion Rootswear in terms of dollars and units.<sup>69</sup> For purposes of perspective, Zion Rootswear also represents Willie Nelson, the Grateful Dead, Elvis Presley, and James Brown.<sup>70</sup>

Michael Conley testified that when he owned Zion Rootswear, it never sold less than \$1 million of “Bob Marley related goods” per year and there were some years where the gross revenue of “Bob Marley related goods” was significantly higher for example in excess of \$10,000,000.<sup>71</sup> Revenues for 2013 and 2014 have exceeded

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<sup>68</sup> Conley Testimony Dep., p. 48 (85 TTABVUE 49); *See also* Conley Testimony Dep., p. 13 (85 TTABVUE 14); D’Auria Testimony Dep., p. 37 (84 TTABVUE 18) (“we have made, you know, a couple million dollars each on those properties”).

<sup>69</sup> D’Auria Testimony Dep., p. 126 (83 TTABVUE 102).

<sup>70</sup> Conley Testimony Dep., p. 9 (85 TTABVUE 10).

<sup>71</sup> Conley Testimony Dep., p. 49 (85 TTABVUE 50). Conley formed Zion Rootswear with his brothers and Opposer in 1999 and the Conleys sold their share in 2012. Conley Testimony

\$10,000,000.<sup>72</sup> The advertising expenditures for Opposer's MARLEY branded products in 2013 and 2014 are not impressive.<sup>73</sup> In assessing the probative value of this testimony, we take into consideration that Mr. Conley did not testify that the revenues and advertising expense were limited to sales and advertising in the United States.

The evidence establishes that Opposer's MARLEY trademarks are commercially strong marks.

3. The number and nature of similar marks in use on similar goods and services.

Although Applicant did not introduce evidence of third-party use, it introduced third-party registrations containing the name "Marley."<sup>74</sup> The Federal Circuit has held that "extensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established." *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). However, in this case, the third-party registrations do not persuade us that MARLEY is a weak mark.

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Dep., pp. 7, 10, 51 (85 TTABVUE 8, 11, 52); D'Auria Testimony Dep., pp. 99-100 (83 TTABVUE 79-80).

<sup>72</sup> D'Auria Testimony Dep., p. 79-80 (84 TTABVUE 24-25) (confidential). The number of units of Marley branded products sold have been commensurate with the revenues. D'Auria Testimony Dep., p. 79 (84 TTABVUE 24) (confidential).

<sup>73</sup> D'Auria Testimony Dep., p. 78 (84 TTABVUE 23).

<sup>74</sup> 38 TTABVUE 13-130.

First, many of the third party registrations include registrations for the names of “CEDELLA MARLEY” owned by Cedella Marley, an individual, “ZIGGY MARLEY” owned by David Nesta Marley aka Ziggy Marley, an individual, “THE MARLEY BROTHERS” owned by Ky-Mani Ronald Marley, Damien Robert Nesta Marley, Julian Ricardo Marley, Stephen Robert Nesta Marley, and David Nesta Marley, all individuals who Applicant concedes are “members” of Opposer, but who are not Opposer itself.<sup>75</sup> At a minimum, the third-party registrations owned by Opposer’s members have been registered with Opposer’s knowledge and consent.

Second, the remainder of the registrations are for marks that are distinguishable or for marks registered for goods or services unrelated to Opposer’s goods and services. For example:

- Registration No. 4190574 for the mark CHRISTOPHER MARLEY for “art galleries”;<sup>76</sup>
- Registration No. 3137677 for the mark MARLEY STATION and design for “shopping center services”;<sup>77</sup> and

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<sup>75</sup> Applicant’s Brief, pp. 17-18 (67 TTABVUE 24-25).

<sup>76</sup> 38 TTABVUE 54.

<sup>77</sup> 38 TTABVUE 63. This registration was cancelled effective April 7, 2017. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007); *see also Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”).

- Registration No. 1075173 for the mark MARLEYS for “fresh apples.”<sup>78</sup>

*See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue); *see also Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) (“None of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other.”); *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word “KEY”. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here”); *SBS Products Inc. v. Sterling Plastic & Rubber Products Inc.*, 8 USPQ2d 1147, 1149 n.6 (TTAB 1988) (“[E]ven if evidence of such third-party use were submitted, it would be of no aid to respondent herein where the third-party usage was for goods unrelated to either petitioner’s skin care products or respondent’s stuffing box sealant”).

Considering the record as a whole, including evidence pertaining to both inherent and commercial strength, we find that Opposer’s marks are appropriately placed on the “strong” side of the “spectrum from very strong to very weak.” *Joseph Phelps*

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<sup>78</sup> 38 TTABVUE 69.

*Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017) (“The commercial strength of Petitioner’s TAO mark outweighs any conceptual weakness.”). Opposer’s MARLEY trademarks are entitled to a broad scope of protection.

E. Similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); see also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

Applicant's mark is GNARLY MARLEY'S. The word "Gnarly" is an adjective defined, *inter alia*, as a slang term for "cool, good."<sup>79</sup> Notwithstanding Shawn Tolley's testimony to the contrary,<sup>80</sup> the adjectival "Gnarly" modifies "Marley's."<sup>81</sup> Thus, the name "Marley" is the dominant part of Applicant's mark because "Gnarly" describes a quality of "Marley's," as adjectives are designed to do. There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Viterra*, 101 USPQ2d at 1908). We focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). Because the goods and services are at issue are clothing, souvenir and novelty goods, and retail store services

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<sup>79</sup> Merriam-Webster.com. *See also* ROGET'S 21ST CENTURY THESAURUS (3<sup>rd</sup> ed. 2013) (adjective for cool, excellent).

<sup>80</sup> Tolley Testimony Dep., p. 45 (75 TTABVUE 45).

<sup>81</sup> An "adjective" is defined as

any member of a class of words that modify nouns and pronouns, primarily by describing a particular quality of the word they are modifying, as wise in a *wise grandmother*, or perfect in a *perfect score*, or handsome in *He is extremely handsome*. Other terms, as numbers (one cup; twelve months), certain demonstrative pronouns (this magazine; those questions), and terms that impose limits (each person; no mercy) can also function adjectivally, as can some nouns that are found chiefly in fixed phrases where they immediately precede the noun they modify, as bottle in bottle cap and bus in bus station.

Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019).

in the field of clothing and souvenir and novelty goods, the average purchaser is an ordinary consumer.

In this regard, consumers are apt to shorten GNARLY MARLEY'S to MARLEY'S.

For example,

- In a January 26, 2015 email from Applicant to Zion Rootswear, Applicant's employee transmitted an order for "marley's";<sup>82</sup> and
- In an invoice dated October 12, 2011, Key Largo Canvas Products referred to GNARLY MARLEY'S as "Marley's."

Fabricate and install New Backlit type awning over the new Marley's Store front.<sup>83</sup>

"[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station." *In re Abcor Dev. Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring).

[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdales.

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<sup>82</sup> D'Auria Testimony Dep. Exhibit 82 (84 TTABVUE 79). This exhibit is improperly designated confidential because it does not contain any trade secret or commercially sensitive information. Accordingly we disregard the confidential designation. Trademark Rule 2.116, 37 C.F.R. § 2.116(g), ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

<sup>83</sup> 25 TTABVUE 4. This invoice was improperly designated confidential because it does not contain any trade secret or commercially sensitive information.

*Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992). See also *Big M Inc. v. The U.S. Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) (“we cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the ‘T.H.’ in referring to registrant’s stores [T.H. MANDY].”).

The significance of the shared name “Marley” is significant because Applicant, intentionally or unintentionally, has associated itself with Bob Marley. As noted above, Applicant has purchased BOB MARLEY licensed products from Opposer’s licensee, Zion Rootswear, including clothing products, wristbands, stickers, patches, and necklaces.<sup>84</sup> It stretches credulity to contend that at least some consumers in GNARLY MARLEY’S retail store purchasing MARLEY t-shirts or BOB MARLEY products are not going to believe that there is an affiliation, connection or association as to the origin, sponsorship, or approval of the goods and services.

In addition, Applicant has sold its own t-shirts featuring the caricature of an individual with dreadlocks and smoking marijuana in close connection with its GNARLY MARLEY trademark. The t-shirt design is reproduced below:<sup>85</sup>

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<sup>84</sup> D’Auria Testimony Dep., pp. 82-83, 84-87 (confidential), and 90-97 (Confidential) and Exhibit 78 (Confidential) (83 TTABVUE 74-75 and 84 TTABVUE 4-11 and 51-67); Tolley Testimony Dep., pp. 110-111 (75 TTABVUE 110-111).

<sup>85</sup> Applicant’s supplemental response to Opposer’s interrogatory No. 2 (26 TTABVUE 48 and 57).



Bob Marley, a Rastafarian,<sup>86</sup> is known for, inter alia, his dreadlocks and for smoking marijuana.<sup>87</sup> The combination of GNARLY MARLEY'S and the Rastafarian indicia, including smoking marijuana, emphasize the reference to Bob Marley. Trade dress may provide evidence of whether a word mark projects a confusingly similar commercial impression. *See Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Accordingly, some consumers are likely to mistakenly believe that GNARLY MARLEY'S is an addition to already extensive BOB MARLEY product line.

We find that Applicant's mark GNARLY MARLEY'S is similar to Opposer's BOB MARLEY and MARLEY marks in their entirety in terms of appearance, sound, meaning, and commercial impression.

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<sup>86</sup> Crujeiras Testimony Dep., p. 59 (79 TTABVUE 60). Dreadlocks are an important part of the Rastafarian culture because Rastafarians do not believe in cutting their hair. *Id.* at p. 64 (70 TTABVUE 65).

<sup>87</sup> Parks Testimony Dep., pp. 67-68 (77 TTABVUE 68-69); Tolley Testimony Dep. pp. 120-121 (75 TTABVUE 120-121); Crujeiras Testimony Dep., pp. 64-65, 77, 79 (79 TTABVUE 65-66, 78, 79); D'Auria Testimony Dep., pp. 15-16 (83 TTABVUE 16-17).

F. The nature and extent of any actual confusion.

As noted above, Applicant began using its mark in October 2011. Thus, by the end of trial, there had been five years of concurrent use of the parties' marks. Neither party introduced any testimony or evidence regarding any reported instances of confusion. However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its marks. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring").

“Applicant’s only retail store is located at 1913 Overseas Hwy., Islamorada, Florida.”<sup>88</sup> The GNARLY MARLEY’S retail store is approximately 1200 square feet.<sup>89</sup> “The GNARLY MARLEY’S Goods are offered for sale and/or will be offered for sale at Applicant’s GNARLY MARLEY’S retail stores.”<sup>90</sup> Applicant does not have a GNARLEY MARLEY website, nor does in advertise its GNARLY MARLEY’S goods or services on its Sandal Factory website.<sup>91</sup> Applicant’s GNARLY MARLEY’S customers are tourists that shop at the GNARLY MARLEY’S retail store while visiting the Florida Keys.<sup>92</sup>

Because Applicant’s GNARLY MARLEY’S goods are sold primarily to tourists who visit its one retail GNARLY MARLEY’S store located in Islamorda in the Florida Keys, there has not been a reasonable opportunity for confusion to have occurred. This is especially true because Applicant’s GNARLY MARLEY’S goods, clothing, souvenirs, and novelty gift items, are not the type of products consumers are going to complain about if there is a problem.

We find the nature and extent of any actual confusion to be a neutral factor.

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<sup>88</sup> Applicant’s supplemental response to Opposer’s interrogatory No. 16 (26 TTABVUE 80).

<sup>89</sup> Tolley Testimony Dep., p. 43 (TTABVUE 43).

<sup>90</sup> Applicant’s response to Opposer’s interrogatory No. 16 (26 TTABVUE 52); Tolley Testimony Dep., p. 108 (75 TTABVUE 108) (“Q. Are the Gnarly Marley T-shirts sold at any retail outlet other than the Gnarly Marley store? A. No.”).

<sup>91</sup> Tolley Testimony Dep., p. 109 (75 TTABVUE 109).

<sup>92</sup> Tolley Testimony Dep., p. 104 (75 TTABVUE 104).

G. Analyzing the factors.

We have concentrated our analysis on the *du Pont* factors of the similarity or dissimilarity of the marks, the similarity or dissimilarity and nature of the goods or service, the established, likely-to-continue channels of trade and purchasers to whom sales have been made, the strength of Opposer's marks, and the nature and extent of any reported instances of actual confusion. That is not to say that we have ignored the evidence and argument with respect to any other factors. On the contrary, we have considered all the arguments and evidence that pertain to all the *du Pont* factors. However, in reaching our findings of fact and conclusion of law, the factors that we have not expressly discussed do not outweigh the factors that we have discussed. Each factor may, from case to case, play a dominant role. *du Pont*, 177 USPQ at 567. As noted above, "[t]he likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but 'may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.'" *In re i.am.symbolic, LLC*, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1380).

Because the marks are similar, the goods are in part identical and Applicant's services are related to Opposer's products, the goods and services are offered in the same channels of trade to the same classes of consumers, we find that Applicant's mark GNARLY MARLEY for the identified goods and services is likely to cause confusion with Opposer's registered mark BOB MARLEY for, inter alia, t-shirts,

thermal shirts, sweatshirts, and ornamental cloth patches and Opposer's common law mark MARLEY for shirts.

Accordingly, the opposition is sustained under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion.

Because we have sustained the opposition on the ground of likelihood of confusion, we need not decide the dilution and false suggestion of a connection claims. We have "discretion to decide only those claims necessary to enter judgment and dispose of the case," as our "determination of registrability does not require, in every instance, decision on every pleaded claim." *Multisorb Tech., Inc. v. Pactive Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013) (citing *Am. Paging Inc. v. Am. Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989)), *aff'd*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) (non-precedential).

**Decision:** The opposition is sustained under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).