

This Opinion is not a
Precedent of the TTAB

Mailed: April 23, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Derek A. Lopez

v.

Ted Wong JKD, LLC

Opposition Nos. 91216538
91216605
91216672¹

Jon M. Gibbs of Lowndes Drosdick Doster Kantor & Reed, PA
for Derek A. Lopez

Theodore J. Minch of Sovich Minch LLP
for Ted Wong JKD, LLC.

Before Goodman, Heasley, and Lynch,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Ted Wong JKD, LLC (“Applicant”) has filed three applications to register the

¹ On August 3, 2017 the Board ordered these three opposition proceedings consolidated, and designated Opposition No. 91216538 as the “parent” case. 21 TTABVUE. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system in that proceeding.



composite mark (with “JEET KUNE DO” disclaimed) on the Principal

Register for the following goods and services, respectively:

Licensing of intellectual property; Licensing of Lessons in Martial Arts in International Class 45;²

Training services in the field of Martial Arts in International Class 41;³ and

Clothing for athletic use, namely, padded elbow compression sleeves being part of an athletic garment; Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, namely, athletic sleeves; Clothing, namely, khakis; Headbands for clothing; Jackets; Jerseys; Leather belts; Perspiration absorbent underwear clothing; Short sets; Ties; Tops in International Class 25.⁴

Derek A. Lopez (“Opposer”) has opposed all three applications on the ground of

² Application Serial No. 85310186 was filed on May 2, 2011 based on Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 2011. The non-Latin characters in the mark transliterate to “Wong Kam Ming Jeet Kune Do” and this means “Ted Wong The Way of the Intercepting Fist” in English. The English translation of “JEET KUNE DO” in the mark is “The way of the intercepting fist”. The description of the mark reads: “The color(s) red, gold, black and white is/are claimed as a feature of the mark. The mark consists of the words ‘TED WONG’ above a square and ‘JEET KUNE DO’ in black letters below the square design with Chinese characters in black inside the square along with a yin and yang design with arrows on each side in the middle of the square where the yin and yang and arrows are in a gold and red outlined in black all on a white background....” The translations and description of the mark are the same in the other two applications.

³ Application Serial No. 85310210 was filed on May 2, 2011 based on Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 2011.

⁴ Application Serial No. 85310234 was filed on May 2, 2011 based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. § 1051(b).

likelihood of confusion with his common law mark:



In its Answer, Applicant admits that the mark in paragraph 1 of the notice of opposition is identical to its applied-for mark,⁶ but denies that Opposer owns the mark, and denies all other salient allegations in the notice of opposition. Applicant also interposed fourteen putative affirmative defenses, which are deemed waived, as it has submitted no brief. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1100-01 (TTAB 2018).

I. The Record

The record consists of the pleadings, Applicant's application files,⁷ and Opposer's testimonial declaration, with exhibits.⁸ Applicant has not introduced any evidence,

⁵ Notice of Opposition, 1 TTABVUE. The notice of opposition erroneously cites Section 43(a) of the Lanham Act, 15 U.S.C. § 1125. Notice of Opposition ¶ 10, 1 TTABVUE 4. The Board does not entertain claims for unfair competition under Section 43(a); it only determines the registrability of marks. *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (Board may not entertain any claim based on § 43(a) of the Trademark Act). The notice of opposition also erroneously cites "15 U.S.C. § 1025(a)." Notice of Opposition ¶ 10, 1 TTABVUE 4. Nonetheless, it claims that "Applicant's mark so resembles Opposer's Mark, previously used in the United States and not abandoned, as to be likely, when used on or in connection with Applicant's Services, to cause confusion, or to cause mistake, or to deceive, and is therefore unregistrable," which sufficiently states a ground for opposition under 15 U.S.C. §§ 1052(d), on which Opposer relies in his brief. See Opposer's brief, 25 TTABVUE 16. The notice of opposition also claims that Opposer owns copyright in the mark, and that Applicant abandoned the applied-for mark through naked licensing of third parties. Notice of opposition ¶¶ 13-15, 1 TTABVUE 4. We shall address these claims *infra*.

⁶ Answer ¶ 10, 4 TTABVUE 3.

⁷ Trademark Rule 2.122(b), 37 CFR § 2.122(b).

⁸ 24 TTABVUE.

nor has it filed a brief.

II. Standing and Priority

“Any person who believes that he would be damaged by the registration of a mark upon the principal register...may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor...” 15 U.S.C. § 1063. In order to meet the standing requirement under the statute, an opposer need only show that he has a real interest, *i.e.*, a personal stake, in the outcome of the proceeding and a reasonable basis for his belief that he will be damaged. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) cert. denied, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999).

In this case, Opposer testifies by declaration that he maintains an informational and educational website displaying the subject composite mark, as well as another very similar mark, and that Applicant’s applied-for mark is confusingly similar, if not identical, thereto.⁹ This testimony shows a personal stake in the outcome of the proceeding and a reasonable basis for Opposer’s belief that he will be damaged. *See Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark ..., and has thereby established his standing to bring this proceeding.”); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (in opposition proceeding under Section 2(d), testimony that opposer uses its mark “is sufficient to support opposer’s allegations of

⁹ Lopez decl. ¶¶ 10-15, 20, 27, 34, 49, 24 TTABVUE 6-8.

a reasonable belief that it would be damaged by registration of applicant's mark.”). He thus has standing to maintain this proceeding.

“In an opposition founded on section 2(d), the opposer must establish its own prior proprietary rights in the same or a confusingly similar designation in order to defeat the application.” *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). Section 2(d) challenges may be based either on ownership of a registered mark or prior use of an identical or similar mark. *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1302. n8 (TTAB 2015); *see also Herbko Int'l., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) *cited in Hunter Indus., Inc. v. The Toro Co.*, 110 USPQ2d 1651, 1658 (TTAB 2014). Here, because Opposer has not pleaded or submitted any registrations, he must rely on his asserted common law rights, which must precede Applicant's actual or constructive use of its mark. *WeaponXPerformance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040-41 (TTAB 2018).

Because Applicant has not introduced any evidence of actual use of its applied-for mark, it cannot rely upon the dates of first use alleged in its two use-based Applications. Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2) (“The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.”) *quoted in Central Garden & Pet Co. v. Doskocil Mfg. Co., Inc.*, 108 USPQ2d 1134, 1139 (TTAB 2013). The earliest date on which Applicant may rely for priority purposes is its filing date of May 2, 2011, which is its constructive use

date. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 (TTAB 2015); see also *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (“[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights”).

It is thus Opposer’s burden to demonstrate that he owns a mark that he used prior to Applicant’s May 2, 2011 constructive use date. *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (citing *Otto Roth & Co., Inc. v. Univ. Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981)). “That is, opposer must prove by a preponderance of the evidence that [his] common law rights were acquired before any date upon which applicant may rely.” *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013) (citing *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (The “decision as to priority is made in accordance with the preponderance of the evidence”)).

The testimony of a single witness with personal knowledge of the facts may be sufficient to prove first use if it is clear, convincing, consistent, uncontradicted, and sufficiently circumstantial to convince the Board of its probative value. See *Bass Pro Trademarks, LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1856 (TTAB 2008). In this case, Opposer is that witness. He testifies in pertinent part that:

2. I make this Testimony Affidavit in support of United States Trademark Opposition Nos.: 91216672, 91216605, and 91216538 opposing the

registrations of United States Trademark Applications Serial Nos.: 85/310,186; 85/310,210; and 85/310,234, each consisting of the following logo (“TWJKD Logo”):



10. I am also the author and owner of the original content of the website associated with the TWJKD Domain Name located at <http://www.twjkd.com> (“TWJKD Website”); I make no claim to the linked articles authored by others.

11. The TWJKD Website, intended to perpetuate and pay tribute to the Jeet Kune Do teachings of Ted Wong as taught to him by Bruce Lee, was authorized by Ted Wong, himself.

12. Jeet Kune Do is a style of martial arts founded and made popular by the late Bruce Lee.

13. The TWJKD Website comprises educational information relating to Ted Wong and Jeet Kune Do as well [as] information regarding Jeet Kune Do training and instruction. ...

14. I have never transferred the registration of the TWJKD Domain Name or the ownership of the original content of the TWJKD Website created by me to any other person or entity.

15. I published TWJKD Website at least as early as February 2009 and it has always comprised the following logo (“Sifu Ted Wong Logo”)¹⁰, also created by me:

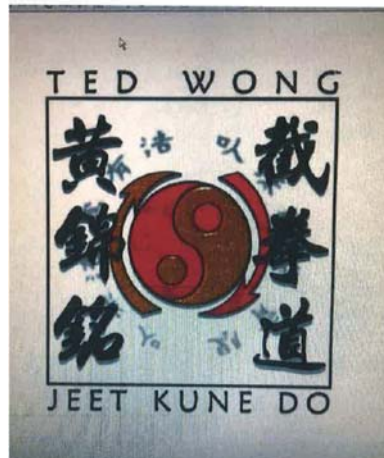
¹⁰ “Sifu,” a Chinese term, is the equivalent of the Japanese “Sensei,” an honorific for a skilled master or teacher of martial arts. Definitions.net, 4/12/2019. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).



19. The first image in each of Composite Exhibits A and B show the Sifu Ted Wong Logo that I created contemporaneously with the TWJKD Logo.

Exhibit A

Exhibit B



20. The Sifu Ted Wong Logo and the TWJKD Logo are substantially similar as they contain many common elements.

26. My use and ownership of the TWJKD Logo and Sifu Ted Wong Logo pre-dates the January 1, 2011 date of first use claimed by Applicant in the '186 Application.

27. I believe that [I] will be damaged by registration of the '186 Application because such registration would give Applicant ownership of, and exclusive rights to use, a mark that is confusingly similar to the Sifu Ted Wong Logo and identical to the TWJKD Logo for services which are related to mine inasmuch as they are contained in, and related to, the content of the

TWJKD Website, in derogation of my invaluable property rights in the Sifu Ted Wong Logo and TWJKD Logo.

33. My use and ownership of the TWJKD Logo and Sifu Ted Wong Logo pre-date the January 1, 2011 date of first use claimed by Applicant in the '210 Application.

34. I believe [I] that will be damaged by registration of the '210 Application because such registration would give Applicant ownership of, and the exclusive rights to use, a mark that is confusingly similar to the Sifu Ted Wong Logo and identical to the TWJKD Logo for services which are related to mine inasmuch as they are contained in, and related to, the content of the TWJKD Website, in derogation of my invaluable property rights in the Sifu Ted Wong Logo and TWJKD Logo.

48. My use and ownership of the TWJKD Logo and Sifu Ted Wong Logo pre-date the May 2, 2011 filing date for the '234 Application.

49. I believe that [I] will be damaged by registration of the '234 Application because such registration would give Applicant ownership of and the right to use, a mark that is confusingly similar to the Sifu Ted Wong Logo and identical to the TWJKD Logo for goods which are related to mine inasmuch as they are contained in, and related to, the content of the TWJKD Website and goods that I have had manufactured and sold with the express consent of Ted Wong, in derogation of my invaluable property rights in the Sifu Ted Wong Logo and TWJKD Logo.¹¹

On the basis of his testimony, we find that Opposer has established priority. Opposer's testimony is based on personal knowledge, is internally consistent, and is corroborated by documentary evidence. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108 (TTAB 2007). Although Opposer's registration of the TWJKD.com domain name did not constitute use of a mark, *see Stawski v. Lawson*,

¹¹ Lopez decl. ¶¶ 10-15, 26, 33, 48, ex. A, 24 TTABVUE 6-7, 11, 12.

129 USPQ2d 1036, 1045 (TTAB 2018), his maintenance of an informational or educational website displaying his mark does constitute the rendition of a service in commerce. *See, e.g., Am. Lebanese Syrian Associated Charities, Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1027-28 (TTAB 2011) (“In addition, opposer’s CURE4KIDS website offers educational content...”); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (registration for inter alia “providing audio-visual information in the fields of beauty care and health, online via a global computer network...”); *Nat’l Pork Bd. & Nat’l Pork Producers Council v. Co.*, 96 USPQ2d 1479, 1482 n. 4 (TTAB 2010) (registration for inter alia “providing an Internet website featuring food preparation/cooking information regarding pork and accompanying recipes”); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1402.11(a)(ii) (Oct. 2018) (“The service of providing information via the Internet is classified in the class of the service-related subject matter of the information. Entities that provide these services by computer are considered to be ‘content providers,’ that is, they provide the informational or substantive content of a website and/or home page.”). Opposer’s testimony of prior use is uncontradicted by Applicant. *See Quirk v. Village Car*, 120 USPQ2d 1146, 1150 n. 20 (TTAB 2016) (petitioner introduced no evidence to cast doubt on accuracy of respondent’s evidence of prior use). Consequently, Opposer has established his standing and priority.

III. Applicable Law

“Once standing is established, in order to state a claim, an opposer must base its ground of opposition on a statutory claim found in the Lanham Act.” *Enter. Rent-A-*

Car Co. v. Advantage Rent-A-Car, Inc., 330 F.3d 1333, 66 USPQ2d 1811, 1820 (Fed. Cir. 2003). Before addressing Opposer’s claim under Section 2(d), we address three other putative claims he has raised.

In his notice of opposition, as well as his testimonial declaration, Opposer avers that he is the owner of his claimed logo under the Copyright Act, 17 U.S.C. § 101 et seq.¹² An allegation of copyright infringement, standing alone, is not a statutory claim found in the Lanham Act. The Board has no jurisdiction to determine copyright infringement, as that authority is reposed in the federal courts. *Carano v. Vina Concha y Toro S.A.*, 67 USPQ2d 1149, 1151 (TTAB 2003) (citing *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) and *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417 (CCPA 1972)). These averments thus fail to state a ground for opposition under the Lanham Act.

In his brief, Opposer claims that Applicant committed fraud on the USPTO in two ways. First, according to Opposer, Applicant falsely declared in all three applications that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive” even though Applicant was well aware of Opposer’s ownership and prior use of the TWJKD Logo and Sifu Ted Wong Logo. Second, Opposer claims Applicant submitted as its specimens of use screen captures that were

¹² Notice of opposition ¶ 4, 1 TTABVUE 4; Lopez decl. ¶¶ 5-7, 24 TTABVUE 5.

taken from Opposer's website.¹³ Opposer's testimonial declaration describes these claimed transgressions in greater detail.¹⁴

It is well-settled, however, that a plaintiff may not rely upon an unpleaded claim. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 314 (2018) and authorities cited therein. Because Opposer did not plead fraud as a ground for opposition, we do not consider this claim. *Syngenta Crop Protection v. Bio-Chek*, 90 USPQ2d at 1115 n.3. Nor do we regard this claim as tried by implied consent under Fed. R. Civ. P. 15(a)(2). 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. Fairness considerations are paramount in assessing whether an issue has been tried by implied consent — there must be an absence of doubt that the non-offering party is aware that the issue is being tried. *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011), *aff'd*, Civ. No. 11-1623 (D.D.C. Mar. 30, 2017); see TBMP § 507.03(b). Here, Opposer did not move to amend his notice of opposition to plead fraud, and gave no indication that this evidence would be used in support of a fraud claim until he submitted his brief. For these reasons, we do not address the unpleaded fraud claim.

Opposer also alleges in the notice of opposition that “the naked licenses granted by Applicant to third-parties resulted in the abandonment of any rights that

¹³ Opposer's brief, 25 TTABVUE 24-27.

¹⁴ Lopez decl. ¶¶ 22-25, 29-32, 37-47, 24 TTABVUE 7-8.

Applicant may have established in Opposer’s Mark.”¹⁵ Abandonment of a mark via naked licensing is a viable ground for opposition in some cases. 15 U.S.C. § 1127; *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 (TTAB 2007). However, “[w]hether, in fact, sufficient control is exercised is a question of fact in each case and the burden of proving lack of control or insufficient control is in the party claiming the abandonment.” *Nestle Co. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1089 (TTAB 1987). In his declaration, Opposer asserts in pertinent part that “I have learned that Ted Wong and Applicant have granted use of the TWJKD Logo and Sifu Ted Wong Logo to third parties without restriction and without any quality control requirements” and “I believe that Applicant’s grant of usage of the TWJKD Logo and Sifu Ted Wong Logo without restriction amounts to a naked license of both logos.”¹⁶ Opposer’s conclusory assertions—which fail to provide the source of his information, or the number and identity of the third parties, much less the extent, duration, and nature of their alleged use of the subject logos—fail to establish a prima facie case of abandonment. *See West Fla. Seafood Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1666 (Fed. Cir. 1994) (“The party asserting abandonment bears at a minimum a burden of coming forth with some evidence of abandonment.”). This claim is therefore dismissed.

We turn our attention, then, to Opposer’s sole remaining ground for opposition, likelihood of confusion. We base our determination of likelihood of confusion under

¹⁵ Notice of opposition ¶ 13, 1 TTABVUE 4.

¹⁶ Lopez decl. ¶¶ 51-52, 24 TTABVUE 9.

Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. ___, 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). In the course of applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent confusion as to sources and relationships, and to protect mark owners from damage caused by registration of confusingly similar marks. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *DuPont*, 177 USPQ at 566. We have considered each *DuPont* factor that is relevant, and have treated any other factors as neutral. 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.”). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods and services. See *Federated Foods, Inc. v. Fort Howard*

Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016).

A. The Parties' Marks.

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Opposer's marks as compared in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Opposer avers in his testimonial declaration that Applicant's applied-for mark is identical to his TWJKD Logo, and substantially similar to his Sifu Ted Wong Logo.¹⁷ Applicant admits that the mark depicted in paragraph 1 of the notice of opposition [the TWJKD Logo] is identical to its applied-for mark.¹⁸ And Applicant does not controvert the averments in Opposer's declaration. Based on our review of the evidence, we find that the applied-for marks are identical to Opposer's TWJKD Logo and substantially similar to Opposer's Sifu Ted Wong Logo, which differs only in its addition of small blue Chinese characters encircling the curved arrows surrounding the yin-yang symbol.

¹⁷ Lopez decl. ¶¶ 2, 15, 26, 27, 34, 49, 24 TTABVUE 5-9.

¹⁸ Answer ¶ 10, 4 TTABVUE 3.

Consequently, the first *DuPont* factor weighs heavily against Applicant. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (“This factor weighs heavily against applicant, as the two word marks are identical....”).

B. The Parties' Goods and Services

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1159. “This factor considers whether ‘the consuming public may perceive [the respective goods and services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

The issue is not whether purchasers would confuse the parties' goods and services, but rather whether there is a likelihood of confusion as to the source of these goods and services. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). The parties' goods and services do not need to be identical or even competitive to find a likelihood of confusion. Rather, it is sufficient that the goods and services are related in some manner such that a reasonably prudent consumer would believe that they were from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner. *In re Save Venice New York, Inc.*, 259 F.3d

1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods [or services] within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

In this case, the relationship between the parties’ services is fairly apparent. Opposer’s website provides educational information relating to Ted Wong and Jeet Kune Do martial arts training and instruction.¹⁹ Applicant’s identified services comprise licensing of lessons and training in martial arts, offered under the same or highly similar TED WONG JEET KUNE DO composite mark. Where, as here, the parties’ marks are identical or highly similar, even less relatedness between the goods and services will suffice to support a finding of likelihood of confusion. *In re Shell Oil*, 26 USPQ2d at 1689 (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”). It is only necessary that there be a “viable relationship” between the goods and services to support a finding of likelihood of confusion. *L’Oreal v. Marcon*, 102 USPQ2d at 1439. There is clearly a viable relationship between the parties’ services, both of which involve martial arts education.

A natural offshoot of martial arts training and education is Applicant’s athletic apparel. It is well recognized that confusion in trade is likely to occur from the use of the same or similar marks for goods on the one hand and for services related to those

¹⁹ Opposer’s brief, 25 TTABVUE 11, Lopez decl. ¶ 13.

goods on the other. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018); *Wet Seal Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1639-40 (TTAB 2007) (likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services related to those goods, on the other). Customers familiar with martial arts education services offered under Opposer’s mark would be likely to believe that athletic clothing offered under the same or highly similar mark is simply a line extension that is affiliated with, connected with, or sponsored by the same trademark owner. *See Save Venice New York*, 59 USPQ2d at 1784. Indeed, Opposer avers that he has made arrangements to have the TWJKD and Sifu Ted Wong Logos printed on T-shirts, and claims, albeit vaguely, that Applicant’s identified athletic apparel is related to “goods that I have had manufactured and sold with the express consent of Ted Wong....”²⁰ Although Opposer does not elaborate on the precise nature of goods he has offered for sale under the marks, his testimony is uncontroverted, and serves at the very least to demonstrate how his provision of educational and informational services under the marks could expand to encompass athletic clothing goods of the sort Applicant identifies.

For these reasons, the second *DuPont* factor also weighs in favor of Opposer.

C. Channels of Trade, Classes of Customers, and Conditions of Sale

The third and fourth *DuPont* factors concern “[t]he similarity or dissimilarity of established, likely-to-continue trade channels,” and “[t]he conditions under which

²⁰ Lopez decl. ¶¶ 40, 44, 49, 24 TTABVUE 8.

and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Since Applicant’s identified goods and services are related to Opposer’s provision of education and information in the field of martial arts, and since the applications’ identifications do not restrict their channels of trade, we must presume that they will flow through all normal and usual channels of trade—online and retail stores—and be offered to the same general class of consumers, that is, those interested in martial arts. *See In re Detroit Athletic*, 128 USPQ2d at 1052; *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1750 (Fed. Cir. 2017); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“since the identification is unrestricted as to channels of distribution, we must consider the [clothing] goods to travel in all channels appropriate for goods of this type.”). Since the parties’ marks contain the same literal wording, TED WONG JEET KUNE DO, consumer searches and word-of-mouth referrals would tend to lead to either or both parties’ goods or services. And since the parties have not placed restrictions on the price or quality of their goods or services, there is no reason to infer that their customers will be particularly sophisticated, discriminating, or careful in making their purchases. *See generally Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163; *Primrose Ret. Cmty. v. Edward Rose Senior Living*, 122 USPQ2d at 1039.

Hence, the third *DuPont* factor favors a finding of likelihood of confusion, and the fourth *DuPont* factor is neutral.

IV. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *DuPont* factors. Because we have found that the marks at issue are identical or highly similar; that Applicant's identified goods and services are related to Opposer's services; that they would move in the same or overlapping trade channels; and that they would be offered to the same class of purchasers, who cannot necessarily be expected to exercise sophistication and care in their purchases, we conclude that Applicant's applied-for mark, as used in connection with the goods and services identified in its three applications, so resembles Opposer's marks as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The oppositions to registration of Applicant's applied-for mark are sustained, and all three applications are refused registration.