

This Opinion is Not a
Precedent of the TTAB

Mailed: December 14, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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1724982 Alberta ULC

v.

Buffalo Jackson Trading Co, LLC

—
Opposition No. 91223331
to Application Serial No. 86453962
—

Theodore R. Remaklus of Wood, Herron & Evans, L.L.P.
for 1724982 Alberta ULC.

David Gulbransen of Law Office of David Gulbransen, Ltd.
for Buffalo Jackson Trading Co, LLC.

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Before Wellington, Wolfson, and Kuczma,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Buffalo Jackson Trading Co, LLC (“Applicant”) seeks registration on the
Principal Register of the mark **BUFFALO JAYNE** in standard characters for

Baseball caps and hats; Belts; Belts made of leather;
Blouses; Boots; Business wear, namely, suits, jackets,
trousers, blazers, blouses, shirts, skirts, dresses and
footwear; Button down shirts; Camp shirts; Dress shirts;
Dresses; Fishing shirts; Fleece pullovers; Fleece vests; Golf
shirts; Hats; Hooded sweat shirts; Hunting shirts; Jackets;

Knit shirts; Neckwear; Outer jackets; Padded jackets;
Pants; Polo shirts; Quilted vests; Sandals; Shirts; Shoes;
Shorts; Skirts; Suit coats; Sweat shirts; T-shirts; Vests;
Visors

in International Class 25.¹

1724982 Alberta ULC (“Opposer”) opposes registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), asserting a likelihood of confusion with its marks BUFFALO and BUFFALO DAVID BITTON, registered for a number of clothing items, including pants, shirts, skirts and dresses.

The parties stipulated that they would seek determination of the merits of this case through the Board’s Accelerated Case Resolution procedure (“ACR”). Following the Board’s order approving the use of ACR, the parties submitted their ACR briefs accompanied by declaration testimony and supporting evidence.² The Board’s final determination of this case is based on such declarations and exhibits, submitted to the Board as the trial record in the proceeding. The Board has decided all issues presented by the record in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence. *See generally* TBMP § 702.04 (June 2016) and authorities cited in that section.

¹ Application No. 86453962, filed on November 13, 2014, based on Applicant’s allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² *See* Stipulation dated June 7, 2016, at 6 TTABVUE, and Board order dated June 20, 2016, at 7 TTABVUE.

I. Record

The record includes the pleadings and the file of the involved application. Trademark Rule 2.122(b)(1).

In addition, Opposer made the following testimony and evidence of record:

- Declaration of Gabriel Bitton, Opposer's Director.
- Printouts from the Trademark Status & Document Retrieval ("TSDR") database of Opposer's pleaded registrations, showing current status and title of the following two registrations on the Principal Register:³
 - Reg. No. 1185897 for the mark BUFFALO (typed⁴) for "men's and women's pants."
 - Reg. No. 3561672 for the mark BUFFALO DAVID BITTON (in standard characters) for "Clothing, namely, jeans, pants, shorts, skirts, dresses, jackets, shirts, sweatshirts, T-shirts, sweaters, blouses, jumpers, cardigans, jackets, coats, scarves, socks, hosiery, pyjamas, [and] underwear."⁵

³ Opposer also asserted ownership of Registration No. 3623466 for the mark BUFFALO DAVID BITTON, which expired. Therefore, it "is evidence only of the fact that it previously existed." *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.2 (TTAB 2011). Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act, were lost when the registration expired. *See, e.g., Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

⁴ Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. *See* Trademark Rule 2.52 (a).

⁵ Opposer's Director, Gabriel Bitton, also testified to ownership of (and Opposer filed a copy of the TSDR printout therefor) Reg. No. 2155119 for the mark BUFFALO (typed) for "sunglasses; watches, bracelets, earrings, anklet charms, necklaces; luggage, knapsacks; bed sheets, pillow cases, comforters, towels; clothing, namely men's and women's underwear, socks, hosiery, neckties, bathrobes, bathing suits," issued May 5, 1998; renewed. This registration was not pleaded in Opposer's notice of opposition. In cases brought under Trademark Act § 2(d), "the plaintiff must specifically plead any registrations on which it is relying and may not rely at trial on unpleaded registrations," unless "the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter." TBMP § 309.03(c) (June 2016); *see, e.g., B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007) ("In its brief, opposer listed a seventh registration, but it was not pleaded and a copy was not made of record by notice of reliance (NOR) or through

- Printouts from TSDR of seven pending applications for marks including the term BUFFALO, of which Opposer asserted ownership.⁶
- Printouts of advertisements placed by Opposer, showing use of the mark BUFFALO from 1993, 1994 and 1995.⁷
- Printouts of advertisements placed by Opposer, showing use of the marks BUFFALO⁸ and BUFFALO DAVID BITTON from 1996 to 2015, excluding 1998.⁹
- Printouts of third-party Internet websites offering clothing under the BUFFALO¹⁰ and BUFFALO DAVID BITTON marks in 2016.¹¹
- Printouts from Opposer's website <https://www.buffalojeans.com> showing use of the mark BUFFALO DAVID BITTON.¹²

testimony, so it has not been considered"). Here, the parties dispensed with the trial period *per se* and submitted their trial evidence concurrently with their legal arguments. Applicant did not object to Opposer's reliance on its unpleaded registration in its ACR brief but did not affirmatively treat it as being of record; in its brief, Applicant listed the pleaded marks, acknowledging that they are owned by Opposer, but did not include Reg. No. 2155119. *Cf. Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1583 n.3 (TTAB 2008) ("The notice of reliance also includes status and title copies of several registrations which were not pleaded in the notice of opposition. Because applicant has not objected to opposer's reliance on the unpleaded registrations, and moreover has, in effect, treated them as of record in his brief, we deem opposer's pleading amended to assert the registrations under Fed. R. Civ. P. 15(b)"). Accordingly, we have not considered Reg. No. 2155119.

⁶ Trademark application Serial Nos. 85378705, 85378778, 85391853, 85391915, 85480867, 85939620 and 85949131. These applications, while properly in the record, are evidence only of the fact of their filing and have no probative value. Accordingly, we do not rely on them in our likelihood of confusion determination. *See UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.2 (TTAB 2011) (pleaded applications pending at time of trial of "no probative value").

⁷ 11 TTABVUE 56-128, Exhibits 11-13.

⁸ Most of the advertisements placed during this time frame by Opposer show use of BUFFALO DAVID BITTON; however, the BUFFALO mark was used in a 2001 advertisement in FHM magazine, 12 TTABVUE 22, Exhibit 18, and in Opposer's summary of "Official Online Store" advertising at 13 TTABVUE 18, Exhibit 32 ("Introducing Buffalo Spring & Summer 2016").

⁹ 11 TTABVUE 129-212, Exhibits 14-17; 12 TTABVUE 2-342, Exhibits 18-30 and 13 TTABVUE 2-18, Exhibits 31 and 32.

¹⁰ The department store Bon-Ton offers Opposer's line of clothing under the designation: "Buffalo by David Bitton." 13 TTABVUE 25-45, Exhibit 33.

¹¹ 13 TTABVUE 19-69, Exhibits 33 through 38.

¹² 13 TTABVUE 70-82, Exhibit 39.

- Screenshots from Opposer’s Facebook “Wall” page.¹³
- Screenshots from Opposer’s Instagram page: “Buffalo David Bitton (@buffalojeans) Instagram photos and videos.”¹⁴
- Screenshots from Opposer’s Twitter account: “Buffalo David Bitton (@BuffaloJeans) | Twitter.”¹⁵
- Screenshots from Opposer’s YouTube page: “Buffalo David Bitton – YouTube.”¹⁶
- List of marks containing the term “BUFFALO” from Opposer’s search conducted August 8, 2016 of the Trademark Electronic Search System (“TESS”) database.¹⁷

Applicant introduced the following testimony and evidence:

- Copy of results from the Examining Attorney’s search conducted during the prosecution of trademark application Serial No. 86453962.¹⁸
- List of marks containing the term “BUFFALO” from Applicant’s search conducted August 14, 2016 of the TESS database.¹⁹
- Copies of twelve registrations for marks containing the word BUFFALO in International Class 25.²⁰

II. Evidentiary Objection

Opposer objects to statements Applicant made in its ACR brief regarding the reasons behind the selection of its mark and who its customers are, as being unsupported factual assertions. We sustain Opposer’s objection. Assertions made in a party’s briefs are not recognized as evidence. *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975); *In re Vesoyuzny Ordena Trudovogo*

¹³ 13 TTABVUE 83-222, Exhibit 40.

¹⁴ 13 TTABVUE 223-226, Exhibit 41.

¹⁵ 13 TTABVUE 227-240, Exhibit 42.

¹⁶ 13 TTABVUE 241-246, Exhibit 43.

¹⁷ 13 TTABVUE 247-250, Exhibit 44 (misnumbered as duplicate 43).

¹⁸ 8 TTABVUE 19-20, Exhibit A.

¹⁹ 8 TTABVUE 21-26, Exhibit B.

²⁰ 8 TTABVUE 27-38.

Krasnogo Znameni, 219 USPQ 69, 70 (TTAB 1983). *See also Spin Physics, Inc. v. Matsushita Electric Co.*, 168 USPQ 605, 607 (TTAB 1970) (the arguments and opinion of counsel are insufficient to overcome the facts).

III. Opposer's Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff 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), *cert. denied*, 135 S. Ct. 1401 (2015); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Opposer's standing to oppose registration of Applicant's mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012). In addition, because Opposer's pleaded registrations are of record, priority is not an issue with respect to the goods covered by Opposer's pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). Moreover, Applicant admits Opposer's ownership of the pleaded registrations and that "[s]ince [1996], Opposer and its predecessors-in-interest have used the BUFFALO and BUFFALO DAVID BITTON marks, as well as other 'Buffalo' bearing marks, in connection with a wide [sic] clothing and fashion products."²¹

²¹ Notice of Opposition, 1 TTABVUE 9, ¶ 1; Applicant's Answer, 5 TTABVUE 2.

IV. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, the first two *du Pont* factors encompass two key considerations: the similarities between the marks and the similarities between the goods or services. *See 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.”). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

Because we view Opposer’s mark BUFFALO as more similar to Applicant’s mark BUFFALO JAYNE, we focus our analysis on a consideration of likelihood of confusion with respect to that mark. If Applicant’s mark is found likely to cause confusion with Opposer’s mark BUFFALO, the opposition can be sustained on this basis, and it would be unnecessary to consider whether Applicant’s mark is likely to cause confusion with Opposer’s combination mark BUFFALO DAVID BITTON. Conversely, if we find that Applicant’s mark is not likely to cause confusion with Opposer’s BUFFALO mark, we would not find Applicant’s mark likely to cause confusion with Opposer’s combination mark. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We address in turn each of the *du Pont* factors for which the parties submitted evidence or argument. To the extent that any other *du Pont* factors for which no evidence was presented may be applicable, we treat them as neutral.

A. *Similarity of the Goods*

Applicant seeks to register its mark for various items of clothing, including “pants.” Opposer has registered the mark BUFFALO for “men’s and women’s pants.” It is sufficient for a finding of likelihood of confusion that we find confusion is likely with respect to use of Applicant’s mark on any item that comes within the description of goods in the pleaded registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Bond v. Taylor*, 119 USPQ2d 1049, 1052-53 (TTAB 2016). In other words, we may find that a likelihood of confusion exists on the basis of the overlap of this single clothing item. On the other hand, we also find that the “men’s and women’s pants” of Opposer’s BUFFALO registration are related to the other clothing items listed in Applicant’s application, particularly items that would be worn in conjunction with pants, such as belts, shirts and shoes. The fact that the goods have a common use and function supports a finding that they are related. Applicant concedes that the goods in Reg. No. 1185897 for the mark BUFFALO are “similar goods” to those set forth in its application.²² Moreover, the Board has held that for likelihood of confusion purposes, many different articles of clothing are related. *See Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549, 550 (CCPA 1961) (women’s boots related to men’s and boys’

²² 8 TTABVUE 14.

underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-399 (TTAB 1982) (TTAB 1982) (hosiery related to trousers).

We find that Applicant's goods, namely "pants" encompass and are legally identical to Opposer's "men's and women's pants," and that the remaining goods in Applicant's application are closely related to Opposer's goods. The second *du Pont* factor strongly supports a finding of likely confusion.

B. Channels of Trade; Classes of Consumers; Conditions of Sale

Because the goods are unrestricted as to trade channels or classes of consumers, we presume they move in all channels of trade normal for those goods and are available to all potential classes of ordinary consumers. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). Moreover, because Applicant's goods are legally identical in part to those identified in the cited registration, we must presume that those goods move in the same channels of trade and are available to the same classes of customers for such goods. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this presumption).

Applicant argues that the "products at issue in the instant case are of a substantially higher potential value, and therefore the purchaser standard of care is

higher.”²³ Nothing in the record supports Applicant’s contention that buyers are sophisticated or more discerning than the ordinary shopper of wearing apparel seeking clothes for work or leisure. The goods are not luxury items nor have they been shown to be expensive. No price points for Applicant’s goods have been supplied and the application is filed on an intent-to-use basis. The identification in Applicant’s application and that in Opposer’s registration include clothing of all types. Therefore, we must assume that Applicant’s and Opposer’s identifications comprise the full range of the identified goods, whether inexpensive or costly. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“[B]ecause neither Applicant nor Registrant has limited its products to any particular style, type of consumer, or price point, we must assume that both identifications include ‘residential and commercial furniture’ of all types, styles, and price levels offered to the full range of usual consumers for such goods.”).

The third and fourth *du Pont* factors support a finding of likely confusion.

C. Similarity of the Marks

We turn next to the first *du Pont* factor, the similarity of the parties’ marks. In a likelihood of confusion analysis, we compare the marks in their entirety for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are

²³ 15 TTABVue 3.

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*, 101 USPQ2d at 1721 (citation omitted). Where, as here, the parties use their marks in connection with goods that are identical in part, the similarity needed to support a determination that confusion is likely declines. *See Bridgestone Ams. Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

Applicant seeks to register the mark BUFFALO JAYNE. Opposer’s mark is BUFFALO. The only difference between the marks is the second term in Applicant’s mark, JAYNE. Because the term BUFFALO is the first word in Applicant’s mark, it “is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word). Moreover, Applicant’s mark incorporates Opposer’s entire mark. A likelihood of confusion has often been found where, as here, an applicant’s mark incorporates the opposer’s entire mark. *See Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant’s mark BENGAL LANCER for club soda, quinine water and ginger ale likely to cause confusion with BENGAL for gin); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (applicant’s mark EBONY DRUM for hairdressing and conditioner likely to cause confusion with

EBONY for cosmetics); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (applicant's mark HEAD START COSVETIC for vitamins for hair conditioners and shampoo likely to cause confusion with HEAD START for men's hair lotion and aftershave lotion). Given the shared term BUFFALO, the marks are similar in appearance and pronunciation.

It is Applicant's contention that the connotation of the marks are sufficiently different to avoid a likelihood of confusion. Applicant argues that Opposer's marks "have the connotation of the bison"²⁴ Applicant argues that its mark, on the other hand, "evokes the images of a woman, bearing the moniker 'Buffalo Jayne.'"²⁵ The fact that purchasers are likely to perceive Applicant's mark as identifying a woman does not assist in distinguishing the marks. Purchasers familiar with Opposer's mark are likely to perceive Applicant's mark as a new line of "Buffalo" clothing, perhaps designed for the intended purpose of identifying a line of women's clothing. Conversely, upon encountering Opposer's mark, purchasers familiar with Applicant's mark would likely consider Opposer's mark to be a shortened form of Applicant's mark. *See, e.g., In re Abcor Development Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring) ("[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words."); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985).

²⁴ 8 TTABVUE 11.

²⁵ 8 TTABVUE 11.

Applicant further argues that Opposer's mark is not unique in that consumers associate Opposer's mark BUFFALO "with the connotations of ... ruggedness, outdoors, wild, western."²⁶ To the extent the term evokes these connotations, the same connotations will be perceived by Applicant's consumers when encountering the mark BUFFALO JAYNE; clothing designed for a cowboy has now met its counterpart in a cowgirl named Jayne. We find the marks, considered in their entireties, convey similar overall commercial impressions.

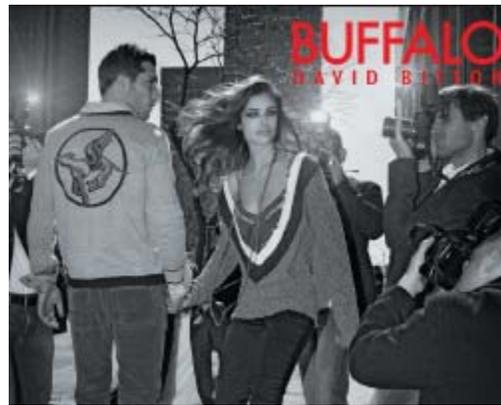
Because we find the marks are similar in sight, sound, meaning and commercial impression, the first *du Pont* factor favors a finding that confusion between the marks is likely, particularly in light of the lesser similarity required because the respective goods are legally identical in part.

D. Strength of Opposer's Mark; Similar Marks in Use

Opposer contends that its BUFFALO mark is a well-known, strong mark. Opposer submitted evidence that the BUFFALO mark has been continuously used in connection with men's and women's pants since 1993. Use of the mark BUFFALO was shown by way of advertising dating from 1993-1995. After that date the mark was used primarily as part of the composite mark BUFFALO DAVID BITTON. However, Opposer uses the composite mark in such a way as to emphasize the separate commercial impression created by the term BUFFALO; as in the following depiction of two billboards from 2001,²⁷

²⁶ 15 TTABVUE 3.

²⁷ 12 TTABVUE 4, Exhibit 18.



print advertising from 2007,²⁸



and Opposer's 2009 Lookbook.²⁹

Opposer's Director, Gabriel Bitton, testified by declaration that Opposer's predecessors-in-interest began using the BUFFALO mark in the United States in 1979 in connection with the sale of clothing;³⁰ that Opposer's clothing has been sold

²⁸ 12 TTABVUE 101, Exhibit 23.

²⁹ 12 TTABVUE 191, Exhibit 26.

³⁰ 10 TTABVUE 2. ¶ 3.

in a wide range of department stores “including Bloomingdales, Lord & Taylor, Bon Ton, Belk, Dillard’s, and Macy’s”³¹ and has been extensively advertised in printed publications, “including in magazines (such as Marie Claire, Hamptons, In-Style, Seventeen, Elle, Cosmo Girl, and FHM),”³² and on billboards and in-store promotional materials.³³ Sales of Opposer’s products have been increasing since at least 2008, with sales of goods in the United States generating nearly \$123 million dollars in 2014.³⁴ Opposer operates a website that since 2002 has offered its goods for sale and since 2009 has promoted its goods on social media platforms: Facebook, Instagram, Twitter and YouTube.³⁵ We find that Opposer’s BUFFALO mark, while not famous, is well-known for men’s and women’s pants.

Applicant argues that Opposer’s mark is entitled to only a narrow scope of protection because of the existence of prior registrations for marks containing the term BUFFALO. Applicant has submitted copies of 12 registration certificates and two lists from the TESS database of marks that contain the term BUFFALO. By introducing the third-party registrations as exhibits to its ACR Brief, Applicant has made the 12 registrations of record. *See* 37 CFR § 2.122(e); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011) (not necessary to submit title and status copies of third-party registrations prepared by Office; plain

³¹ 10 TTABVUE 4, ¶ 8.

³² 10 TTABVUE 4, ¶ 7.

³³ 10 TTABVUE 4, ¶ 7.

³⁴ 10 TTABVUE 5, ¶ 11.

³⁵ 10 TTABVUE 5, ¶¶ 9, 10.

copies from the USPTO's electronic database would have sufficed); TBMP § 704.03(b)(1)(B). While properly made of record however, because the third-party registrations were submitted without a showing that the marks therein are in use, they "are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth *du Pont* factor." *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009). In other words, their probative value on the issue of likelihood of confusion is limited. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (may not be given any weight in determining strength of a mark); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 n.12 (CCPA 1977) (little evidentiary value in determining scope of protection); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (not evidence of what happens in the market place or consumer familiarity).

On the other hand, the registrations may be of use "if they tend to demonstrate that [BUFFALO] is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection." *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1029 (TTAB 2011) (may indicate that a mark, or portion of a mark, is descriptive or suggestive); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (probative to show that a term is adopted to convey a particular suggestive meaning). Here, the registrations do not demonstrate that the term BUFFALO has a commonly understood meaning

that is suggestive or descriptive of “men’s and women’s pants.” The marks are: BUFFALO HEAD LEATHER and design, BUFFALO WORK GLOVES, ONE BUFFALO, BOUNTY HUNTER BUFFALO, BIG EMPTY BUFFALO LEATHER, AMERICAN BUFFALO COLLECTION, BUFFALO EXCHANGE and design, THE BUFFALO CLUB, BUFFALO TRACE and design, BUFFALO BAY, LIGHTNING BUFFALO and design, and BUFFALO (stylized).³⁶ To the extent the term BUFFALO has a commonly understood meaning as a type of range animal, the marks share such common reference, but the registrations do not show that the word has any special meaning in relation to clothing except to the limited extent that consumers may perceive that some of the leather goods could be made from buffalo hide. Such a connotation would apply, if at all, equally to Applicant’s goods as Opposer’s.

As for the TESS listings, they are of no probative value. The Board does not take judicial notice of registrations residing in the Office and the mere listing of registrations is not sufficient to make the registrations of record. *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010). *See also In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006). While the lists themselves are of record, they provide no useful information as to the scope or type of goods or services for which the marks are registered, the nature of the marks involved, whether a showing of use was required prior to registration, or whether any of the holders of the registrations are related companies or have otherwise entered into agreements regarding concurrent use of

³⁶ Printouts of the registration certificates for these marks are at 8 TTABVUE 27-38.

the marks. Simply put, the evidence does not show that the term BUFFALO has a suggestive or descriptive meaning in connection with clothing, or that Opposer's mark is weak.

The fifth and sixth *du Pont* factors are neutral.

V. Conclusion

In sum, we have found that the parties' goods are identical in part, moving in the same channels of trade to the same customers; that the customers are ordinary consumers whose purchasing decisions are made with average care; that the marks in their entirety are similar in appearance, pronunciation, connotation and commercial impression; and that there is no record evidence of third-party use of similar marks for similar goods. The first, second, third and fourth *du Pont* factors weigh in favor of a likelihood of confusion, while the remaining factors are neutral. Considering the record as a whole, we find that Opposer has carried its burden to establish by a preponderance of the evidence that Applicant's mark BUFFALO JAYNE is likely to cause confusion with Opposer's mark BUFFALO.

Decision: The opposition is sustained pursuant to Trademark Act Section 2(d).