

Mailed: November 5, 2018

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

Diesel S.p.A.

v.

Misel Disel, LLC

Opposition No. 91225389

John C. Holman and Robert S. Pierce, Jacobson Holman, PLLC, for Diesel S.p.A.
Ron Wilson, *pro se*, for Misel Disel, LLC.¹

Before Mermelstein, Kuhlke, and Lynch, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Misel Disel, LLC, filed an application² seeking registration on the Principal Register of the standard-character mark **MISEL DIESEL** for “smooth shave enhancer, namely, pre-shave liquid” in International Class 3. Diesel, S.p.A. opposed registration on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c), in view of Opposer’s registrations and prior use of the mark **DIESEL** and several **DIESEL-**

¹ During trial, Misel Disel, LLC acted through its Managing Member/Partner Ron Wilson. See Patent and Trademark Office Rule 11.13(e)(3), 37 C.F.R. § 11.14(e)(3); TBMP § 114.01.

² Application Serial No. 86547178, filed February 26, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use and use of the mark in commerce on February 19, 2015.

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formative marks for clothing and personal care goods. Applicant filed an answer denying the salient allegations of the notice of opposition and asserting “affirmative defenses.”³ 5 TTABVUE.

We sustain the opposition.

I. The Record

The record comprises the pleadings and, pursuant to Trademark Rule 2.122(b), the file of the opposed application. In addition, the parties proffered the following items:

A. Opposer’s Evidence

- *Opposer’s Registrations:* Pursuant to Trademark Rule 2.122(d)(1), Opposer attached to its notice of opposition information from the electronic database records of the Office, showing the current status of and title to the following registrations.⁴

Reg. No.	Mark	Goods	Reg. Date
1498698	DIESEL	Men’s, & women’s apparel namely jeans, shirts, jackets and sweatshirts. IC 25.	Aug. 2, 1988
1564710	DIESEL	Trousers, pants, jeans, shorts, skirts, overcoats, raincoats, jackets, wind resistant jackets, cabans, Blazers, sweaters, jerseys, vests, cardigans, shirts, t-shirts, blouses, dresses, suits, track-suits, Sweatshirts, pullover, overalls. IC 25.	Nov. 7, 1989

³ Applicant’s second, third, and fourth affirmative defenses are essentially denials that confusion is likely for various reasons. Applicant’s first affirmative defense — that Applicant’s mark “has developed significant goodwill,” which “has caused [it] to acquire distinctiveness with respect to Applicant, and has caused the Mark to become a valuable asset of Applicant,” is irrelevant. Opposer has not questioned the distinctiveness of Applicant’s mark, and regardless, the distinctiveness of Applicant’s mark does not disprove, mitigate, or excuse any likelihood of confusion or dilution Opposer may prove.

⁴ For all listed registrations, required filings pursuant to Trademark Act §§ 8, 9, and 71 have been accepted or granted. Affidavits under Trademark Act § 15 have been acknowledged in the ’390, ’141, ’656, ’710, and ’698 Registrations. In several registrations, goods or classes have been deleted from the registrations as originally issued. The above-listed goods are those for which the marks are currently registered. *See Kellogg Co. v. W. Family Foods, Inc.*, 209 USPQ 440, 441–42 (TTAB 1980) (Board will take notice of change in status of properly-submitted registration during course of proceeding).

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Reg. No.	Mark	Goods	Reg. Date
1605656		Trousers, pants, jeans, shorts, skirts, overcoats, raincoats, jackets, windresistant jackets, cabans, blazers, sweaters, jerseys, vests, cardigans, shirts, t-shirts, blouses, dresses, suits, track-suits, sweatshirts, pullovers, overalls. IC 25.	July 10, 1990
1989390	DIESEL	<p>Perfumes; cosmetics, namely, deodorants for personal use; lotions and oils for the face and the body; pre- and after shave creams and lotions; foam bath. IC 3.</p> <p>Spectacles, spectacle frames, spectacle cases, lenses. IC 9.</p> <p>Watches and parts therefor, watch chains, watches containing a gaming function, chronographs; rings, bracelets, necklaces, pendants, money clips, cufflinks, key-holders; all in metal precious or not. IC 14.</p> <p>Handbags, suitcases, knapsacks, travelling bags, vanity cases sold empty; purses, billfolds, attache cases, wallets, briefcases, key-cases, passport cases, business and credit card cases. IC 18.</p> <p>Pillow cases, bedsheets, bedspreads, blankets, towels. IC 24.</p> <p>Footwear, namely, shoes, boots, slippers and belts. IC 25.</p>	July 30, 1996
1939141		<p>Perfumes; lotions for the body; pre- and after shave creams and lotions; foam and oil bath; creams and lotions after-bath. IC 3.</p> <p>Spectacles, spectacle frames, spectacle cases, lenses. IC 9.</p> <p>Watches and parts therefor, chronographs; rings, bracelets, necklaces, pendants, cufflinks. IC 14.</p> <p>Handbags, suitcases, trunks for travel, knapsacks, travelling bags, vanity cases sold empty; purses, billfolds, attache cases, wallets, briefcases, key-cases, passport cases, business and credit card cases; umbrellas. IC 18.</p> <p>Textile fabrics for use in the manufacture of clothing and furnishings; curtains, pillow cases, bedsheets, bedspreads, blankets, comforters for beds, table clothes, textile napkins, towels, placemats of fabric, oven gloves. IC 24.</p> <p>Footwear; namely, shoes, boots and slippers, belts. IC 25.</p>	Dec. 5, 1995
3956724	DIESEL BLACK GOLD	<p>Spectacles; sunglasses; cases and chains for spectacles and sunglasses; frames for spectacles; eyeglass lenses; cases for MP3 players, cases for CD and DVD players. IC 9</p> <p>Jewelry and costume jewelry, rings being jewelry, bracelets, necklaces, tie-bars, scarf rings, pendants, ear clips, tie clips, earrings, brooches, watches, for use as watches, chronometers. IC 14.</p> <p>Trunks, travelling bags, umbrellas, handbags, suitcases, clutch bags, vanity cases sold empty, purses, billfolds, attaché cases,</p>	May 10, 2011

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Reg. No.	Mark	Goods	Reg. Date
		<p>wallets, briefcases, key cases, wallet for passports and business cards, credit card cases, business card cases and bank note cases made of leather or imitation leather. IC 18.</p> <p>Clothing, namely, coats, mantles, raincoats, dresses, suits, skirts, jackets, trousers, jeans, waistcoats, shirts, T-shirts, blouses, jerseys, sweaters, pullovers, blazers, cardigans, stockings, socks, tights, underwear, corsets, nightgowns, wedding gowns, women’s suits, pajamas, Bermuda shorts, bathrobes, bathing suits, swimming suits, sun suits, sport jackets, wind-resistant jackets, anoraks for exercises, anoraks not for exercises, sweat-suits, ties, neckties, scarves, shawls, foulards, hosiery, gloves, sashes, belts, footwear, boots, shoes, slippers; creepers, night-gowns, pajamas, sweatsuits; leather clothing, namely, leather jackets, leather pants, leather overcoats, leather coats, leather suits, leather skirts. IC 25.</p>	

- *Opposer’s First Notice of Reliance*: Documents offered “to show use of [Opposer’s] mark, its channels of commerce, stores in the United States, and its history.” 7 TTABVUE (Nov. 21, 2016);
- *Opposer’s Second Notice of Reliance*: Applicant’s Responses to Opposer’s Requests for Admissions; Applicant’s Responses to Opposer’s Interrogatories; and Applicant’s Responses to Opposer’s Requests for Production. 8 TTABVUE (Nov. 21, 2016);
- *Opposer’s Third Notice of Reliance*: Pages from Applicant’s website, TSDR records of third-party registrations, and Wikipedia entries for “shaving,” “aftershave,” and “shaving oil.” 9 TTABVUE (Nov. 21, 2016);
- *Opposer’s Fourth – Eighth Notices of Reliance*: The file history of Opposer’s Reg. Nos. 1498698, 1564710, 1605656, 1939141, and 1989390. 10–14 TTABVUE (Nov. 21, 2016);
- *Opposer’s Ninth – Seventeenth Notices of Reliance*: Clippings from various magazines and periodicals comprising advertisements of or articles about Opposer’s **DIESEL**-branded apparel. 15–23 TTABVUE (Nov. 21, 2016);
- *Opposer’s Eighteenth Notice of Reliance*: Documents purporting to evidence Opposer’s sales figures in units and dollar amounts and advertising expenditures in the United States from 2010 to 2015 (redacted). 24 TTABVUE (Nov. 21, 2016).
- *Opposer’s Nineteenth Notice of Reliance*: Web pages from www.miseldisel.com with instructions for use of Applicant’s product by men and women. 28 TTABVUE 2–7 (Mar. 6, 2017);

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- *Opposer’s Twentieth Notice of Reliance*: Web pages of sites “offering shaving products and fragrances bearing the **DIESEL** Marks.” 28 TTABVUE 8–28 (Mar. 6, 2017);
- *Opposer’s Twenty-First Notice of Reliance*: “[W]eb pages showing the same mark being used on shaving goods, other men’s grooming products, and fragrances. . . .” 28 TTABVUE 29–62 (Mar. 6, 2017);
- *Opposer’s Twenty-Second Notice of Reliance*: “third-party registrations showing the same mark being used on shaving goods, other men’s grooming products, and fragrances.” 28 TTABVUE 63–85 (Mar. 6, 2017).

B. Applicant’s Evidence

- *Applicant’s First Notice of Reliance*: Pages from Applicant’s website, social media pages, and e-commerce sites. 25 TTABVUE (Jan. 17, 2017);
- *Applicant’s Second Notice of Reliance*: Opposer’s responses to Applicant’s requests for admissions; Opposer’s responses to Applicant’s requests for production of documents. 26 TTABVUE (Jan. 17, 2017);
- *Applicant’s Third Notice of Reliance*: Notice of publication; the notice of opposition; a letter from Opposer’s counsel to Applicant’s counsel; photographs purporting to show “National Chain’s Shaving and Grooming Sections”; third-party registrations from the TSDR database. 27 TTABVUE (Jan. 17, 2017).

C. Evidentiary Issues

Trial in this case began on October 21, 2016, and closed on March 5, 2017. On October 7, 2016, the USPTO published a notice of final rulemaking, amending the rules applicable to proceedings before the TTAB. Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice, 81 Fed. Reg. 69,950 (Oct. 7, 2016). The new rules went into effect on January 14, 2017, in the midst of trial in this case. Although we have cited the amended rules where appropriate, the same result would have obtained under the previous rules and cases interpreting them.

Neither party filed testimony, but both seek to rely on documents, including internet materials and other printed publications. These documents are admissible for what they show “on their face,” but not to prove the truth of any matter asserted in

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them. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1467 n.30 (TTAB 2014). For that reason, a number of Opposer's submissions cannot be considered for the purposes for which they were submitted. For instance, web pages submitted explaining the history of Opposer's company, the number and location of Opposer's stores, information about ordering online, and the goods sold under the mark, *Opp. First NOR*, 7 TTABVUE, are not admissible for those purposes without supporting testimony.

Opposer also filed a notice of reliance on Applicant's discovery responses. *Opp. Second NOR*, 8 TTABVUE. Only *admissions* served in response to a request for admission may be filed under a notice of reliance. Trademark Rule 2.120(k)(3)(i). We have disregarded Applicant's denials. We note Opposer's submission of Applicant's responses to Opposer's request for the production of documents and the produced documents. *Id.*, 8 TTABVUE 38. Generally, neither responses to document requests⁵ nor produced documents may be filed under notice of reliance. However, Applicant's responses to Opposer's requests for admission show that Applicant admitted that these documents are genuine under the Federal Rules of Evidence, and that, to the extent applicable, they are Applicant's business records. *Opp. Second NOR*, 8 TTABVUE 5–6 (Requests 1–4). In light of Applicant's authentication of these documents, we will consider them. Trademark Rule 2.120(k)(3)(ii).

⁵ We note that Applicant submitted Opposer's responses to Applicant's document requests. *App. Second NOR*, 26 TTABVUE 10. Opposer's responses are admissible as evidence of Opposer's statements that it does not possess any responsive documents. *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013).

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Under several notices of reliance, Opposer submitted the file histories of four of its registrations, specifically pointing out the specimens of use. *Opp. Fourth – Eighth NOR*, 10–14 TTABVUE. The file histories are public records, and admissible as such, Trademark Rule 2.122(e)(1), but Opposer may not rely on the specimens in its registration file; “[s]pecimens . . . in the file of a registration[] are not evidence on behalf of the . . . registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.” Trademark Rule 2.122(b)(2).⁶

Finally, we note Opposer’s notice of reliance on its sales and advertising figures. *Opp. Eighteenth NOR*, 24 TTABVUE. This evidence consists of two pages purporting to show Opposer’s 2010–2016 sales receipts and advertising expenditures in tabular form, with what we presume to be the relevant numbers redacted. *Id.*, 24 TTABVUE 5–6. We can only presume because Opposer never filed a confidential, unredacted copy of this notice of reliance from which the relevant numbers could be read. Although Opposer filed a confidential copy of its trial brief purporting to rely on this evidence, *Opp. Br (Confidential)*., 29 TTABVUE 16, 28–29, 32, we cannot consider that evidence or Opposer’s arguments based on it because the evidence was not made of record during Opposer’s trial period. In any event, summaries of sales and advertising data are not among the types of documents which may be submitted under a notice of reliance. *See* Trademark Rule 2.122(g); *Life Zone Inc. v. Middleman Grp.*

⁶ In any event, the file histories appear to have been unnecessary. Opposer submitted copies of its pleaded registrations with its notice of opposition, 1 TTABVUE 13–56, and nothing further was required to make them of record. Trademark Rule 2.122(d)(1). Unless Opposer intended to rely on some particular event in the prosecution histories of the registrations, it was unnecessary to submit the full files.

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Inc., 87 USPQ2d 1953, 1955–56 (TTAB 2008). Such evidence can only be made of record through the testimony (or testimonial declaration) of a competent witness.

Applicant submitted the notice of publication from its application file, *App. Third NOR*, 27 TTABVUE 7, and Opposer’s notice of opposition, 27 TTABVUE 9. Both submissions were unnecessary; as noted above, the pleadings and the file of the opposed application are automatically part of the record. More importantly, Applicant states that it submitted the notice of publication as “indicating identification of entitlement to registration.” To the contrary, “[t]he Examining Attorney’s decision to publish the mark for opposition does not preclude an opposition . . . and is in no way binding on the Board’s determination of the claim.” *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 n.5 (TTAB 2017).

Applicant also submitted a letter from Opposer’s counsel to Applicant’s counsel. *App. Third NOR*, 27 TTABVUE 15–16. The letter does not belong to one of the categories of documents which may be submitted under a notice of reliance, Trademark Rule 2.122(g), and we have not considered it.

II. Standing

To establish its standing, Opposer must show a real interest in the outcome of the proceeding and a reasonable basis for its belief of damage. See 15 U.S.C. §§ 1063; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). With respect to its pleaded ground of likelihood of confusion, Opposer’s submission of its pleaded registrations for **DIESEL** and **DIESEL**-formative marks adequately

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establish its interest in this proceeding and a reasonable basis for its belief that damage would result from registration of Applicant's mark. Having established its standing with respect to its likelihood of confusion claim, Opposer need not separately show its standing to assert its claim of dilution. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012) ("once an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052."); *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983).

III. Likelihood of Confusion

We confine our analysis to the issue of likelihood of confusion between Applicant's mark and the mark in Opposer's '390 Registration of the "typed"⁷ mark **DIESEL** for use on "pre- and after shave creams and lotions." Of the marks and goods in Opposer's pleaded registrations, those in the '390 Registration are the most similar to Applicant's. If the opposition cannot be sustained on the basis of this registration, it could not be sustained on the basis of Opposer's other pleaded registrations. *See N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015) (citing *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010)). Although Opposer's '390 Registration (and others) include a variety of items, we need not consider

⁷ A "typed" or "standard character" mark is one registered or sought to be registered "without claim to any particular font style, size, or color," Trademark Rule 2.52(a), and is not limited to "reasonable manners" in which the mark may be displayed. *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258–59 (Fed. Cir. 2011). Prior to November 2, 2003, "standard character" marks were known as "typed" marks. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012); TRADEMARK MANUAL OF EXAMINING PROCEDURE § 807.03(i) (Oct. 2017).

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whether confusion would be likely with respect to the full range of goods identified in Opposer's registrations; Applicant must be refused registration if confusion would be likely with respect to any of Opposer's goods. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

A. Priority

Because Opposer has established its ownership of the '390 Registration, priority is not an issue with respect to the registered mark and the goods identified in it. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).⁸

B. Relevant *du Pont* Factors

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203–04 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA

⁸ In discussing priority, Opposer notes that its registrations “have dates of first use in commerce . . . or application filing dates . . . that precede [Applicant's] application filing date . . . or the date of first use in commerce. . . .” *Opp. Br.* 30 TTABVUE 19. This argument misses the point established by *King Candy* and the cases that preceded it. An Opposer's ownership of a registration does not *prove* priority; it eliminates the *need* to prove priority. “The question of priority *does not arise* against a registered trademark in an opposition proceeding.” *David Crystal, Inc. v. Shelburne Shirt Co.*, 465 F.2d 926, 175 USPQ 112, 112–13 (CCPA 1972) (emphasis added). Even if Opposer's applications that matured into registrations were later-filed and based on later use, their proof would remove priority as an issue — unless Applicant counterclaimed for cancellation.

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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 v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

i. The similarity or dissimilarity of the marks.

As to the first *du Pont* factor, “similarity or dissimilarity of the marks,” we analyze “the marks in their entirety as to appearance, sound, connotation and commercial impression.” *In re Viterra Inc.*, 101 USPQ2d at 1908 (quoting *du Pont*, 177 USPQ at 567). See also *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “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.*, 101 USPQ2d at 1721 (cleaned up). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant seeks to register **MISEL DIESEL** in standard characters. The mark in Opposer’s ’390 Registration is the typed mark **DIESEL**. The marks are similar in some aspects and different in others: Applicant’s mark includes the term **DIESEL**, which is

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similar — but not identical — to Opposer’s mark, **DIESEL**, but Applicant’s mark includes the first word **MISEL**, which is absent from Opposer’s mark.

The word **DISEL** in Applicant’s mark is highly similar to the word **DIESEL**, which comprises the entirety of Opposer’s ’390 Registration, differing only in the omission of an internal vowel. The words look similar; each begins with the letters **DI-** and ends with **-SEL**. And both being in standard-character or typed form, we must assume that Applicant’s mark could be displayed in the same font style, size, or color as that used by Opposer. Further, while we recognize that “[t]here is no correct pronunciation of a trademark that is not a recognized word,” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014) (citing *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969)), we think the word **DISEL** in Applicant’s mark is likely to be pronounced the same as **DIESEL** in Opposer’s mark, because it looks like a mere misspelling of the common word “diesel.”

The initial word **MISEL** in Applicant’s mark provides a point of distinction from the mark in Opposer’s ’390 Registration. It is also the initial word in Applicant’s mark, which is significant “because consumers typically notice those words first.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (citing *Palm Bay*, 73 USPQ2d at 1692). Nonetheless, it must be recognized that the presence of **MISEL** in Applicant’s mark does not thoroughly distinguish it from Opposer’s mark. **MISEL** is itself similar to **DIESEL** in appearance and pronunciation. It ends with **-SEL** and combining **MISEL** with **DISEL** invites a rhyming pronunciation of **MISEL** similar to the common pronunciation of “diesel,” *i.e.*, *mee-zul dee-zul*. And because it rhymes with

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DISEL, it does not create a separate commercial impression from that term. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“Because of the alliteration with **SQUIRT**, **SQUAD** is an apt choice to combine with **SQUIRT** to suggest a line or group of toys from the same source as **SQUIRT** balloons. Thus, the marks do not create different commercial impressions.”).

Considering the marks in their entireties, although we recognize that Applicant’s mark is not identical to Opposer’s, we find that it nonetheless is substantially similar to Opposer’s.

This *du Pont* factor thus favors a finding that confusion is likely.

ii. The similarity or dissimilarity and nature of the goods.

We evaluate the relatedness of Applicant’s and Opposer’s goods and services based on the identification of goods and services as set forth in the involved application, compared with the identification of goods and services contained in Opposer’s registration. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computs. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The issue is not whether purchasers would confuse the goods or services but whether there is a likelihood of confusion as to the source of the goods or services. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Applicant’s goods are identified as “smooth shave enhancer, namely, pre-shave liquid.” The precise nature and use of Applicant’s actual product is not clear from the

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record. There is no indication that “smooth shave enhancer” is a term of art for shaving products.⁹ Under a notice of reliance, Applicant submitted what are purported to be images from “its website home pages, social Media pages, and multiple e-commerce channels” featuring advertisements of Applicant’s goods. *App. First NOR*, 25 TTABVUE 2. These exhibits do not include the relevant URLs and dates, Trademark Rule 2.122(e)(2), and in any event, they are not available to prove the truth of anything asserted on the webpages. *Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031 (TTAB 2010).

Applicant states in its brief that

Smooth shave enhancers absolutely do not overlap with Diesel’s pre and after shave creams and lotions. Misel Diesel is the only shave enhancer currently existing in today’s marketplace. Misel Diesel is used as an alternative to shaving creams and gels, that just so happens to be so versatile that one can shave with it, use it for an aftershave, apply for dry skin, perform massages and many other skin related uses.

App. Br., 31 TTABVUE 7.

To be clear, statements of fact in a brief are entitled to no consideration unless they are supported by evidence in the record or subject to judicial notice. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (“Except to the extent they may be considered admissions, unsupported statements will be given no consideration.”).

⁹ We were unable to locate “smooth shave enhancer” in any of several online dictionaries. Collins English Dictionary, www.collinsdictionary.com/us/; Dictionary.com, Based on the Random House Unabridged Dictionary, www.dictionary.com; Merriam-Webster Dictionary, www.merriam-webster.com; Urban Dictionary, www.urbandictionary.com (these and all other websites cited in this decision last visited Nov. 1, 2018).

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But even if we could consider Applicant's statement, we would learn only that, although "smooth shave enhancers . . . do not *overlap* with . . . pre and after shave creams and lotions," they can be used "as an *alternative* to shaving creams and gels" for the same purpose. *Id.* (emphasis added).

The goods in Opposer's '390 Registration include "pre- and after shave creams and lotions." We construe Opposer's identification to include any cream or lotion that might be applied before or after shaving including, but not limited to, products commonly known as "shaving cream" and "aftershave lotion."¹⁰

Although Applicant's goods are described as being used for a specific purpose, *i.e.*, as a "shave enhancer," Opposer's goods are not limited to any particular purpose, and must therefore be construed to encompass shave creams and lotions of all types, including a "smooth shave enhancer." See *Elbaum*, 211 USPQ at 640 (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)) (unless expressly limited, goods identified in an application or registration must be considered to include all goods of the type described). And although Applicant's goods are described as a "liquid" and Opposer's as "creams and lotions," creams and lotions are, in fact, liquids.¹¹ We conclude that Applicant's "smooth shave enhancer, namely, pre-

¹⁰ We take judicial notice of the definitions of *shaving cream*: "a preparation, as of soap and free fatty acid, that is lathered and applied to the face to soften and condition the beard for shaving," and *aftershave*: "a scented, astringent lotion for applying to the face after shaving." Dictionary.com. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹¹ We take judicial notice of the definition of *lotion*: "2. a liquid cosmetic, usually containing agents for soothing or softening the skin, especially that of the face or hands," and *cream*: "2.

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shave liquid” is legally identical, at least in part, to Opposer’s “pre- and after shave creams and lotions.”

We acknowledge Applicant’s statement that its “smooth shave enhancers absolutely do not overlap with . . . pre and after shave creams and lotions.” *App. Br.*, 31 TTABVue 7. Nonetheless, our analysis is based on the parties’ goods as they are identified in the subject application and the pleaded registration. That the parties’ actual goods in trade may in fact be different, or more limited is irrelevant:

[T]he question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys., 16 USPQ2d at 1787.

It may be that the product Applicant actually sells under its **MISEL DIESEL** mark is different in some respects from the product Opposer sells under its brand. But we must consider the goods in an application and pleaded registration to encompass all goods of the type identified, even if they are different or more limited in reality. *See M2 Software Inc. v. M2 Commc’ns Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (“we consider the applicant’s goods as set forth in its application, and the opposer’s goods as set forth in its registration”). So construed, the goods in the subject application are identical, at least in part, with goods in Opposer’s ’390 Registration.

a soft solid or thick liquid containing medicaments or other specific ingredients, applied externally for a prophylactic, therapeutic, or cosmetic purpose.” Dictionary.com.

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Nor does it matter that, as Applicant points out, Opposer does not “produce, manufacture, distribute, or sell any products identified as ‘smooth shave enhancers,’ or a ‘smooth shave enhancer.’” *App. Br.* 31 TTABVUE 8. The issue is the nature of the goods identified in the application and registration at issue, not the words used to describe them.

But even if we were to agree with Applicant that its goods do not “overlap” with Opposer’s, Applicant’s admission that “Misel Diesel is used as an alternative to shaving creams and gels,” *id.* would be dispositive. A product that is a commercial alternative to another is clearly closely related to it under the second *du Pont* factor, even if it is different in kind. The issue is not whether consumers would confuse the goods, but whether they are likely to be confused as to the *source* of the goods. *See Miss Universe L.P. v. Community Mktg. Inc.*, 82 USPQ2d 1562, 1568 (TTAB 2007); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). If — as Applicant states — its product is an alternative to shaving cream, a consumer shopping for shaving cream might purchase Applicant’s “smooth shave enhancer” instead (or vice versa). Such competitive goods are closely related for purposes of a likelihood-of-confusion analysis.

While we conclude that Applicant’s goods are identical, at least in part, to Opposer’s based on the descriptions of them in the application and registration, even if we were to consider the unsupported statements in Applicant’s brief, we would conclude that they are at least closely related. This factor favors a finding that confusion is likely.

iii. Channels of trade.

The fact that the goods are in part identical also means that we must assume that

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purchasers and channels of trade are also identical. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith & Me-haffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”); see *In re Viterra Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

And even if the goods are not identical, we agree with Opposer that neither Opposer’s ’390 Registration nor the subject application “recites any meaningful restriction.” *Opp. Br.*, 30 TTABVUE 26. In the absence of such restrictions, we must presume that the identified goods are sold in all usual channels of trade for such goods to all usual customers for them. *Elbaum*, 211 USPQ at 640. Because both Applicant’s and Opposer’s goods are shaving products, they would both be available in stores and online wherever shaving products are normally sold.

In a rebuttal notice of reliance, Opposer submitted pages from the websites of five retailers “offering shaving products and fragrances bearing the **DIESEL** Marks.” *Opp. Twentieth NOR*, 28 TTABVUE 8. In its Brief, Applicant states that it visited the web-

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sites — after the close of trial — and found that Opposer’s products were only available at two of them. *App. Br.*, 31 TTABVUE 11. Applicant’s evidence is untimely, although Opposer’s notice of reliance was arguably improper rebuttal. But in the end, neither Opposer’s nor Applicant’s evidence on this point is helpful. As noted, we must consider the parties’ goods to travel in all usual channels of trade for goods of the type identified. Whether in fact Opposer’s or Applicant’s goods are available at any particular retailer’s website or brick-and-mortar store on any particular date is of little or no consequence.

We find that the channels of trade overlap, and that this factor supports a conclusion that confusion is likely.

iv. Conditions of sale and purchasers to whom sales are made.

Opposer argues that “[p]ersonal care products are not always purchased with a great deal of care and do not require purchaser sophistication.” *Opp. Br.*, 30 TTABVUE 27. Opposer notes that “a gift set of [Opposer’s] shower gel, eau de toilette, and after shave balm costs \$57.00,” and that Applicant’s “smooth shave enhancer costs between \$6.95 and \$13.95.” *Id.*, 30 TTABVUE 27. But again, because we must construe the parties’ goods as they are identified, the actual price of their branded products is illustrative, but not determinative. Instead, we must consider the registration and application at issue to cover items sold at all usual price points for goods of the type identified. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 n.4 (TTAB 2016) (“Because the respective identifications include ‘beer’ without any limit regarding a particular price point, we must treat the goods as including inexpensive as well

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as more costly beers, and therefore presume that purchasers for “beer” include ordinary consumers who may buy inexpensive beer on impulse.”). Because we have found the parties’ goods to be identical, or at least closely related, we also assume that Opposer’s goods might be sold as cheaply as Applicant’s, *i.e.*, \$6.95 or less, if such shaving products normally include less expensive items.

We find that a price of around \$7.00 (or lower) would make these items relatively inexpensive. Such products might be purchased on impulse, or at least without such careful consideration as would alleviate confusion, if confusion were otherwise likely. Applicant calls that idea “an insult to consumers,” arguing that “[p]eople take great pride in the procurement of their personal care products.” *App. Br.*, 31 TTABVUE 12. Applicant is no doubt correct with respect to some consumers and some products. But our precedent requires consideration of the “least sophisticated consumers in the class.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014). There is no indication that purchasers of the involved goods are, as a class, particularly sophisticated, or somehow immune from source confusion. It is well-recognized that “[w]hen products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

We find that the goods at issue include relatively inexpensive items which may be purchased by ordinary consumers without careful consideration. This factor favors a finding that confusion is likely.

v. The fame of Opposer’s mark.

Opposer argues that its **DIESEL** mark is famous, but much of the evidence it relies

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on is problematic. Opposer maintains that “[i]t has used the mark in commerce in the United States on clothing since 1979,” citing its registrations attached as Exhibit A to the notice of opposition. *Opp. Br.*, 30 TTABVUE 28. We assume Opposer is referring to its ’710 Registration, which recites a date of first use in commerce of April 5, 1979. However, “[t]he allegation . . . in a registration[] of a date of use is not evidence on behalf of the . . . registrant; a date of use of a mark must be established by competent evidence.” Trademark Rule 2.122(b)(2). Opposer also touts its sales receipts and advertising expenditures, *id.*, but as discussed above, they are not in evidence. Nor can Applicant’s internet evidence be used to prove that it owns a “nationwide chain of **DIESEL** stores,” *id.*, or anything else stated on the submitted webpages, such as that “Diesel’s Creative Director, Nicola Formichetti, was Lady Gaga’s stylist,” *id.*, 30 TTABVUE 29. Opposer’s webpages are evidence only that such pages appeared; they are not evidence that anything appearing there is true.

On the other hand, Opposer submitted a number of advertisements of or articles about its **DIESEL**-branded apparel. *Opp. Ninth – Seventeenth NOR*, 15–23 TTABVUE. Although not all of this evidence meets the requirements of Trademark Rule 2.122(e)(1)–(2) (requiring identification of the printed publication and date of publication, and identification of the URL and date accessed for internet materials), there is enough good evidence to demonstrate the substantial exposure of Opposer’s marks to the public. Opposer also notes that its **DIESEL** marks are arbitrary. *Opp. Br.*, 30 TTABVUE 35. We agree, and consider them conceptually strong.

Applicant does not seriously dispute the renown of Opposer’s **DIESEL** mark for

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clothing, but argues (1) that renown in the field of apparel is not relevant to a dispute over shaving products, *App. Br.*, 31 TTABVUE 9 (“Not once have they stated how famous they are for perfumes and shaving products.”); and (2) that Opposer’s renown actually works against it, *App. Br.*, 31 TTABVUE 4 (“With such a profound presence, recognition, and distinctiveness in the marketplace it is unfathomable to comprehend that Diesel’s customers would confuse such a famous mark with a totally different multi-word mark. . . .”).

Applicant’s second argument is incorrect. The fame or renown of a senior mark is never a negative factor; no mark is too famous to be confused. To the contrary, the more well-known the prior user’s mark, the easier it will be to find a likelihood of confusion in the balancing of the *du Pont* factors. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

But we agree, at least in part, with Applicant’s first point. The renown of Opposer’s **DIESEL** mark for apparel does not strongly suggest that purchasers are more likely to believe Opposer to be the source of shaving products sold under similar marks. But Opposer’s evidence is not irrelevant and is entitled to some consideration.

We conclude that Applicant’s **DIESEL** mark enjoys some renown, particularly with respect to apparel. This factor supports a finding that confusion is likely, although we add that its absence would not change the result we reach.

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

Applicant submitted three registrations of **DIESEL**-formative marks. *App. Third NOR*, 27 TTABVUE 21–24:

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Reg. No.	Mark	Goods	Reg. Date
4865376		Business brokerage services and related consulting pertaining to the procurement, buying, selling, and tendering of information and opportunities in the field of renewable fuels. IC 36	Dec. 8, 2015
4873126	DIESEL DESTRUCTION	[Wide variety of goods in IC 7 & IC 12]	Dec. 22, 2015
4855327	DIRTYDIESELS	On-line wholesale and retail store services featuring auto parts and related apparel and accessories. IC 35	July 10, 1990

Opposer points out that these registrations are not for use “with personal care products . . . let alone shaving products,” and that the registrations are not evidence of use. *Opp. Br.*, 30 TTABVUE 30. In response, “Applicant finds it very interesting” that Opposer opposed one of the applications, but now claims it is not relevant in this proceeding. *App. Br.*, 31 TTABVUE 15.

We agree with Opposer.

Third party registrations are often cited in an effort to prove that, because the marks appearing in those registrations are similar to the mark in use by an applicant, an opposer, or cancellation petitioner, the public has learned to distinguish among them and would not be confused by the addition to the marketplace of the mark sought to be registered or by continued use of the mark sought to be maintained on a register. Whether the public has been so conditioned turns on whether it has been actually exposed to the similar third party marks in the marketplace, and on the extent and intensity of that exposure. A registration does not *inherently* evidence that exposure, and the presumption that registered marks of third parties are in use does not clothe the cited registrations with that evidentiary effect.

In re Clorox Co., 578 F.2d 305, 198 USPQ 337, 343 (CCPA 1978) (Markey, C.J., concurring) (footnote omitted); *In re Helene Curtis Indus., Inc.*, 305 F.2d 492, 134 USPQ 501, 503–04 (CCPA 1962) (“We will not assume any knowledge on the part of the

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purchasing public of mere registrations . . . and neither will we assume that marks are in continuing use, so as to have had any effect on the mind of the purchasing public, merely because they have been registered.”).

Applicant has provided no evidence of the nature and extent of the use of these registered marks, so we cannot conclude that they have been in use to such an extent as to affect consumer perception. The registrations themselves are not evidence of such use. But even if we were to assume that the registered marks are in significant use in the marketplace, they would have no relevance to this proceeding because none of the registrations is for use of a **DIESEL**-formative mark on or in connection with goods or services even remotely related to those at issue in this case.¹² *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration). Finally, the quantity of evidence is so small that we would not find it persuasive, regardless. *Cf. Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033-36 (TTAB 2016) (weakness of term **ROSE** in opposer’s mark **PRIMROSE** found based on at least 85 actual uses of **ROSE**-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence

¹² As for Opposer’s opposition to the application that eventually became the ’376 Registration, that proceeding was terminated after the applicant amended its goods — with Opposer’s consent — to delete clothing in Class 25 and to restrict its brokerage services to the field of renewable fuels. Opp. No. 91222029, 10 TTABVUE 3 (Oct. 27, 2015). There is nothing inconsistent in Opposer’s current position that this registration is now inconsequential.

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regarding the common nature of **ROSE**-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

We conclude that there is no evidence of relevant, third-party use. This factor is neutral.

C. Balancing the Factors

We have considered all the evidence of record, including that which we have not specifically mentioned. As discussed, we find Applicant's **MISEL DIESEL** mark similar to the **DIESEL** mark in Opposer's '390 Registration. While we recognize that the marks are not identical, we believe that consumers would consider them substantially similar, particularly when they are used on identical or closely related goods. "[W]here . . . the goods at issue are identical, 'the degree of similarity necessary to support a conclusion of likely confusion declines.'" *In re Viterra Inc.*, 101 USPQ2d at 1908 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

We further find that Applicant's and Opposer's goods move in the same channels of trade, are sold to the same class of purchasers, including ordinary, unsophisticated purchasers, and are relatively inexpensive, and therefore subject to impulse purchases, or those made without extensive and careful consideration. We also find that Opposer's **DIESEL** mark is known to the public, at least with respect to Opposer's apparel goods, and that there are no third-party uses of similar marks on similar goods.

We conclude that Opposer has established a likelihood of confusion by a preponderance of the evidence.

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IV. Dilution

In light of our finding on the likelihood of confusion, we do not reach Opposer's dilution claim.

Conclusion

Decision: The opposition is sustained under Trademark Act § 2(d).