

This Opinion is not a
Precedent of the TTAB

Mailed: December 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Oakley, Inc.
v.
JMM Lee Properties, LLC
—

Opposition No. 91231865
—

Karen Kreider Gaunt of Dinsmore & Shohl LLP,
for Oakley, Inc.

JMM Lee Properties, LLC, pro se.
—

Before Kuhlke, Bergsman and Wellington,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

JMM Lee Properties, LLC (Applicant) filed an application on the Principal Register to register FROGSKINS (standard characters) for “protective covers and cases for cell phones, laptop computers, tablet computers and portable media players,” in Class 9.¹

¹ Application Serial No. 86962416, filed April 3, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s bona fide intent to use the mark in commerce.

Oakley, Inc. (Opposer) opposes registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles Opposer's registered mark FROGSKINS (standard characters) for "eyewear, namely sunglasses and accessories for sunglasses, namely, replacement lenses, ear stems and nose pieces," in Class 9, as to be likely to cause confusion.²

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.³

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the application file at issue.⁴ Opposer's testimony and evidence is listed below:

1. Testimony Declaration of Warren Modlin, Opposer's Vice President of Product & Strategy;⁵
2. Notice of reliance on the following:⁶

² Registration No. 4194197, registered August 21, 2012; Sections 8 and 15 declarations accepted and acknowledged.

Opposer also alleges that Applicant's mark will create "a false affiliation with Opposer and Opposer's FROGSKINS Mark," Section 43(a) of the Trademark Act, 15 U.S.C. § 1125(a), and that Applicant's mark will dilute Opposer's mark. Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Inasmuch as Opposer did not pursue these claims in its brief, they are waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

³ 4 TTABVUE.

⁴ Because Applicant's application is of record by operation of the rules, it was unnecessary for Opposer to introduce it through a notice of reliance. 12 TTABVUE 33.

⁵ 9 TTABVUE.

⁶ Opposer's Exhibit Nos. 3-5 (10 TTABVUE 41-117) "are responses produced by Applicant in response to Opposer's First Requests for the Production of Documents and Things." Opposer's

- a. Applicant's responses to Opposer's first set of interrogatories;⁷
- b. Applicant's responses to Opposer's first set of requests for admission;⁸
3. Notice of reliance on documents retrieved from the Internet;⁹
4. Notice of reliance on the following items:
 - a. A copy of Opposer's application Serial No. 85510248 which matured into Opposer's pleaded registration;¹⁰
 - b. A copy of Applicant's application Serial No. 77812182 for the mark FROGSKINS for "sunglasses, sunglass lenses, eyewear cases, sport goggles for use in skiing and snowboarding, eyewear accessories, namely straps, neck cords and head straps which restrain eyewear from movement on a wearer," in Class 9;¹¹
 - c. A copy of Applicant's canceled Registration No. 3858050 for the mark FROGSKINS for "sunglasses, sunglass lenses, eyewear cases, sport goggles for use in skiing and snowboarding, eyewear accessories, namely

Brief, p. 7 (14 TTABVUE 12). However, such documents are not admissible through a notice of reliance and have been given no consideration. Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii) ("A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.").

⁷ 10 TTABVUE 5-17.

⁸ 10 TTABVUE 19-21.

⁹ 11 TTABVUE. These documents were previously introduced through the Warren Modlin declaration.

¹⁰ 12 TTABVUE 5.

¹¹ 12 TTABVUE 15.

straps, neck cords and head straps which restrain eyewear from movement on a wearer,” in Class 9;¹²

d. A copy of Applicant’s “surrender of registration for cancellation” of Registration No. 3858050 for the mark FROGSKINS;¹³

e. A copy of Applicant’s Statement of Use in application Serial No. 77812182 for the mark FROGSKINS;¹⁴

5. Notice of reliance on Opposer’s pleaded registration printed from the USPTO electronic database showing the current status of and title to the registration.¹⁵

Applicant did not introduce any testimony or evidence, nor did it file a brief.

II. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a “real interest” in the proceeding and a “reasonable” basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

¹² 12 TTABVUE 21.

¹³ 12 TTABVUE 23.

¹⁴ 12 TTABVUE 26.

¹⁵ 13 TTABVUE.

Opposer has established its standing by properly introducing into evidence its pleaded registration. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.2d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015).

III. Priority

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

IV. Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*") cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the

similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The strength and fame of Opposer’s FROGSKINS mark.

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

second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

1. The inherent strength of the FROGSKINS mark.

Opposer's FROGSKINS mark is inherently distinctive. As noted above, Opposer has made of record its pleaded FROGSKINS registration which is not subject to a counterclaim for cancellation. The registration is registered on the Principal Register without a claim of acquired distinctiveness. The registration is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.” Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

In assessing the inherent strength of Opposer's mark, we note that there is no testimony or evidence regarding the number and nature of similar marks in use on similar goods or services or third-party registrations consisting in whole, or in part, of FROGSKINS or variations thereof. Evidence that a mark, or an element of a mark, has been adopted by many different registrants may indicate that the common element has some non-source identifying significance that undermines its conceptual or inherent strength as an indicator of a single source. *Jack Wolfskin Austrang Fur Draussen GmbH & Co. KGAA v. New Millenium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is

relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (the extent of third-party use or registrations may indicate that a term carries a suggestive or descriptive connotation and is weak for that reason).

2. The commercial strength of Plaintiff’s mark.

Opposer alleges and argues that FROGSKINS is a famous mark.¹⁶ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

“[L]ikelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694

¹⁶ Notice of Opposition ¶¶1, 6 and 19 (1 TTABVUE 4, 5, and 7); Opposer’s Brief, pp. 1 and 10-13 (26 TTABVUE 9 and 16-18).

(Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003))).

Fame may be measured indirectly by the volume of sales and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice, by independent sources, of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06, 1309; *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014). Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Bose* at 1309. In other words, depending on the testimony and evidence, there may be the need to put the numbers in context so that the Board may arrive at a proper understanding of the extent to which consumers recognize the mark. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, ___ F.3d ___, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (citing *Bose* at 1309).

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer has introduced the testimony and evidence set forth below to show that FROGSKINS is a famous mark:

- Opposer “launched its FROGSKINS branded eyewear and accessories in 1985”;¹⁷
- “Since launching the brand in 1985, [Opposer] has sold in excess of an estimated five hundred million USD (\$500,000,000) worth of FROGSKINS eyewear product and related accessories within the United States of America”;¹⁸
- “Since launch, [Opposer] has spent in excess of two million USD (\$2,000,000) on marketing of FROGSKINS eyewear products and related accessories throughout the United States of America”;¹⁹
- “Since launch, [Opposer] has sold approximately five million (5,000,000) units of FROGSKINS eyewear and related accessories within the United States of America”;²⁰
- “[Opposer’s] FROGSKINS products are famously worn by many celebrities, such as Jessica Alba, Scarlett Johansson, Eva Mendes, Rihanna, Liv Tyler, Shaun White, Kiefer Sutherland, Kanye West, Mary-Kate Olsen, Reese Witherspoon, Ada Levine, and Lady GaGa.”;²¹

¹⁷ Modlin Decl. ¶5 (9 TTABVUE 4).

¹⁸ *Id.* at ¶6 (9 TTABVUE 5).

¹⁹ *Id.* at ¶7 (9 TTABVUE 5).

²⁰ *Id.* at ¶8 (9 TTABVUE 5).

²¹ *Id.* at ¶9 and Exhibit A (9 TTABVUE 5 and 8-19).

- Opposer’s FROGSKINS products are sold throughout the United States through Sunglass Hut retail stores and other distributors;²² and
- Opposer’s FROGSKINS products have received unsolicited media attention.²³

This evidence does not establish that FROGSKINS is a famous mark. Long use, without evidence of the extent of consumer exposure to or recognition of the mark over the years, is not sufficient by itself to prove fame. *Wet Seal Inc. v. FD Mgt. Inc.*, 82 USPQ2d 1629, 1635 (TTAB 2007); *compare Nina Ricci, S.A.R.L. v. ETF Enters., Inc.*, 203 USPQ 947, 951 (TTAB 1979) (“Not only has opposer enjoyed long use of its ‘RICCI’ marks, but the record shows the fame, prestige and reputation which the name ‘NINA RICCI’ has brought to opposer as evidenced by the numerous newspaper articles and reports of opposer’s activities in the ladies’ apparel fields, previously referred to.”).

At first blush, Opposer’s sales and advertising expenditures appear substantial but when they are averaged over 32 years (1985-2017), Opposer’s \$500,000,000 in sales averages \$15,625,000 per year; Opposer’s sale of 5,000,000 units averages 156,250 units per year; and Opposer’s \$2,000,000 in advertising averages \$62,500 per year. Because Opposer’s annual sales, revenues and advertising figures are not substantial in a vacuum and because Opposer’s evidence identified a number of competitors (e.g., Ray Bay, TOMS, Raen, Wild Soul, Smith Sidney, Julbo Megeve,

²² *Id.* at ¶¶10-11 (9 TTABVUE 5).

²³ *Id.* at ¶¶13-14 and 16 and Exhibits C, D, E and F (9 TTABVUE 5, 6 and 34-128).

Smith Optics, and Revo Crux N),²⁴ it is incumbent upon Opposer to provide some context to allow us to assess the meaning of Opposer's revenues, sales, and advertising expenditures. For example,

- There is no testimony or evidence as to Opposer's market share in the eyewear field;
- There is no testimony or evidence as to how Opposer's advertising and marketing expenditures compare to Opposer's competitors; and
- There is no testimony or evidence as to how many consumers have encountered or are familiar with Opposer's mark (i.e., the extent that Opposer's mark is recognized in marketplace).

Also, the FROGSKINS trademark does not appear without the OAKLEY house mark. For example,

- The COOLSPOTTERS.COM website on which Opposer relies to show that FROGSKINS are worn by celebrities reads, "[Insert celebrity name] and Oakley Frogskin Sunglasses";²⁵
- The OAKLEY house mark appears on the arm of the FROGSKIN sunglasses.²⁶ The only evidence of the FROGSKINS mark appearing on Opposer's sunglasses is one photograph the mark displayed on the inside arm of the glasses.²⁷

²⁴ 9 TTABVUE 45-59 and 83-97.

²⁵ Modlin Testimony Decl. Exhibit A (9 TTABVUE 8-19).

²⁶ Modlin Testimony Decl. Exhibits B and C (9 TTABVUE 32 and 38-40).

²⁷ Modlin Testimony Decl. Exhibit F (9 TTABVUE 120).

- The unsolicited publicity referring to FROGSKINS also refers to the OAKLEY house mark. For example,

Hypebeast.com posted a fashion feature by Opposer (September 21, 2017) entitled “Oakley Channels ‘90’s Nostalgia in Its Fall 2017 Frogskins-Inspired Collection.”²⁸

Velonomad.com posted a review (January 19, 2014) entitled “Oakley Holbrook and Frogskin Summit Review.”

It was truly serendipitous timing to receive two pairs of Oakleys for an Oakley Holbrook Review and Oakley Frogskin Summit Review sunglasses at this point of time.²⁹

Huffingtonpost.com posted a review (May 5, 2015) referring to Oakley Frogskins with a photo of sunglasses displaying the OAKLEY house mark;³⁰

Excellesports.com posted a review (Jun 22, 2017) referring to Oakley Frogskins Sunglasses;³¹

The High Snobiety website (highsnobiety.com) article featuring skateboarder Ryan Sheckler (October 7, 2017) entitled “Ryan Sheckler Front’s Oakley’s New Frogskins Collection,” features photographs of sunglasses displaying the OAKLEY house mark, not the FROGSKINS mark;³²

Unlike *Bose*, consumers of Opposer’s FROGSKINS do not receive information clearly identifying the FROGSKINS products separately marked. In nearly every piece of evidence, the OAKLEY house mark is prominent and there are only a few separate references to FROGSKINS. Consequently, we do not have a record that supports consumer identification of FROGSKINS separate and apart from OAKLEY.

²⁸ Modlin Testimony Decl. Exhibit C (9 TTABVUE 34).

²⁹ *Id.* at 9 TTABVUE 36.

³⁰ Modlin Testimony Decl. Exhibit D (9 TTABVUE 49-50).

³¹ *Id.* at 9 TTABVUE 58.

³² *Id.* at 9 TTABVUE 66-70.

Nevertheless, Opposer's testimony and evidence shows that Opposer's FROGSKINS is a successful and growing brand, but not that the FROGSKINS trademark is famous. The evidence establishes that FROGSKINS is a commercially strong mark entitled to a broad scope of protection or exclusivity of use in connection with sunglasses and related accessories, but it does not have the extensive public recognition and renown of a famous mark.

B. The similarity or dissimilarity of the marks.

The marks are identical.

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

Applicant's "protective covers and cases for cell phones, laptop computers, tablet computers and portable media players" are clearly not the same as Opposer's "eyewear, namely sunglasses and accessories for sunglasses, namely, replacement lenses, ear stems and nose pieces." The test here is not, however, whether the goods are likely to be confused. Rather, the test is whether purchasers are likely to be confused as to source, connection or sponsorship between the providers of the products. As often stated, it is not necessary that the goods be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarities of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same

producer. *See Hilson Research Inc. v. Soc’y for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993); *Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1213, 1215 (TTAB 1990). “The crux of the issue before us is whether the respective goods sold ... under the marks are sufficiently related in the minds of the common purchasers to result in a likelihood of confusion.” *Berghoff Rest. Co. v. Washington Forge, Inc.*, 225 USPQ 603, 608 (TTAB 1985). In this regard, where, as here, the marks are identical, the goods need not be as similar to find that they are related. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (“even when 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”); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) (“the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion.”).

Opposer argues that the goods are related because Opposer sells “goods that compete with the goods identified in Applicant’s Application, under its house brand. ... Through its website, Opposer currently offers for sale various computer, tablet and/or laptop bags, and ‘wristlets’ that are able to hold cell phones and similar portable media players, and those goods are offered in close proximity of Opposer’s eyewear and eyewear accessories.”³³ In support of this argument, Opposer refers to the Modlin Testimony Declaration.

³³ Applicant’s Brief, p. 13 (14 TTABVUE 29).

12.) [Opposer's] eyewear accessory products include computer briefcases, laptop bags, suitcases, tech bags, backpacks, wristlets, and similar containers for personal electronics including cellular phones. Attached hereto as Exhibit B are photographs of several examples of such accessory products.³⁴

That Opposer sells the same goods as Applicant, even under a different mark, is relevant for purposes of establishing that the parties' products are related. *See TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) ("where the goods of the parties differ, information from which it may be learned whether the parties market some goods of the same type is relevant to establishing the relationship between the goods of the parties.") (citing *Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649, 652 (CCPA 1975) (the fact that products are made by the same manufacturers has a bearing on the likelihood that the public will think that they have the same source when they appear on under the same mark); *see also Dan Robbins & Assoc., Inc. v. Questor Corp.*, 599 F.2d 1008 (CCPA 1979) ("The marks need not be used on directly competing goods, any relation likely to lead purchasers into assuming a common source being sufficient."). However, there is no testimony or evidence that any other third party manufactures or sells eyewear and eyewear accessories and "protective covers and cases for cell phones, laptop computers, tablet computers and portable media players."

In addition, Opposer introduced a copy of Applicant's cancelled Registration No. 3858050 for the mark FROGSKINS for "sunglasses, sunglass lenses, eyewear cases,

³⁴ Modlin Testimony Decl. ¶12 and Exhibit B (9 TTABVUE 5 and 21-32). Exhibit B is an excerpt from Opposer's website displaying the OAKLEY trademark on products.

sport goggles for use in skiing and snowboarding, eyewear accessories, namely, straps, neck cords and head straps which restrain eyewear from movement on a wearer.”³⁵ Opposer included Applicant’s Statement of Use with a specimen of use displaying FROGSKINS on an eyewear case.³⁶ A cancelled or expired registration has no probative value other than to show that it once issued. *See In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011) (“‘dead’ or cancelled registrations have no probative value at all.”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007). Also, “[s]pecimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for taking the taking of testimony.” Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2). Accordingly, the evidence referring to Applicant’s cancelled registration has no probative value in this proceeding.

Finally, Opposer intends to expand its FROGSKINS mark to include cases, bags, and backpacks for sunglasses, phones, and computers.

21.) [Opposer] plans to expand its offering of FROGSKINS branded products to include cases, bags and backpacks for sunglasses, phones, computers, and similar goods.³⁷

Opposer contends that because Opposer already sells the products in Applicant’s description of goods, Opposer’s planned expansion of its FROGSKINS line to those products lends support that Applicant’s “protective covers and cases for cell phones,

³⁵ 12 TTABVUE 21. Applicant voluntarily surrendered the registration. 12 TTABVUE 23.

³⁶ 12 TTABVUE 26-30.

³⁷ Modlin Testimony Decl. ¶21 (9 TTABVUE 6).

laptop computers, tablet computers and portable media players” are within Opposer’s natural scope of expansion for “eyewear, namely sunglasses and accessories for sunglasses, namely, replacement lenses, ear stems and nose pieces.”³⁸

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods or services, but also as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark. *See. The May Department Stores Co. v. Prince*, 200 USPQ 803 (TTAB 1978). ... Among the factors to be considered in determining whether an expansion, either actual or potential, is natural are: (1) whether the second area of business (that is, the subsequent user’s area of business, into which the first user has or potentially may expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business; (2) the nature and purpose of the goods or services in each area; (3) whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the second area; and (4) whether other companies have expanded from one area to the other. *See: Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37 (TTAB 1981), and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977).

Mason Eng’g & Design Corp. v. Mateson Chem. Corp., 225 USPQ 956, 962 (TTAB 1985).

Opposer has shown that it is already selling computer briefcases, laptop bags, suitcases, tech bags, backpacks, wristlets, and similar containers for personal

³⁸ Opposer’s Brief, p. 15 (14 TTABVUE 20).

electronics including cellular phones; however, these are different from Applicant's "protective covers and cases for cell phones, laptop computers, tablet computers and portable media players" and there is no evidence from which to determine if Applicant's goods are or are not a distinct departure from Opposer's eyewear and eyewear accessories.

There is no testimony or evidence establishing that the nature or purpose of Opposer's eyewear and eyewear accessories is related to Applicant's protective covers.

There is no testimony or evidence establishing that the channels of trade for Opposer's eyewear and eyewear accessories are similar to Applicant's protective covers.

There is no testimony or evidence establishing that other companies sell both eyewear and eyewear accessories and protective covers.

Opposer has failed to prove that Applicant's protective covers are within the natural scope of expansion for its eyewear and eyewear accessories and that Applicant's protective covers are related to Opposer's eyewear and eyewear accessories.

Thus, the second *du Pont* factor does not favor a finding of likelihood of confusion.

D. Established, likely-to-continue channels of trade and purchasers to whom sales are made.

Opposer contends that because both Opposer and Applicant intend to sell their products through brick and mortar stores and through online retail vendors, the

channels of trade are the same.³⁹ Opposer's contention is based on the false premise that brick and mortar stores and online retail vendors are one monolithic entity such that any product sold through brick and mortar stores or online "would or could be encountered the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer." *In re Binion*, 93 USPQ2d 1531, 1534-35 (TTAB 2009) (citing *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991)). There simply is no testimony or evidence referring to how and to whom eyewear and eyewear accessories and protective covers are sold, how and why those products would be encountered by the same consumers in the same marketing milieu, or how the market efforts employed by each party converge to reach overlapping consumers. In other words, we are left to speculate as to whether the goods are offered to the same target consumers.

Opposer failed to meet its burden of proving that the products of the parties are offered in the same channels of trade to the same classes of consumers.

E. Applicant's bad faith.

Under the thirteenth du Pont factor, evidence of applicant's bad faith adoption of his mark is relevant to our likelihood of confusion analysis. *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). Opposer asserts that Applicant has a business model of trading on the well-known brands of others.⁴⁰ To support this argument, Opposer relies on documents that Applicant produced in response to

³⁹ Opposer's Brief, pp. 15-16 (14 TTABVUE 20-21).

⁴⁰ Applicant's Brief, p. 16 (14 TTABVUE 21).

Opposer's request for production of documents and introduced through a notice of reliance.⁴¹ As noted above in footnote 6, such documents are not admissible through a notice of reliance. Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii) (A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents."). Because we do not consider these documents, Opposer's arguments regarding Applicant's bad faith are not supported by any evidence and this *du Pont* factor is neutral.

F. Balancing the factors.

Despite the fact that Opposer's mark is both inherently and commercially strong and the marks are identical, because Opposer failed to meet its burden of proving that the goods are related and that they are offered in the same channels of trade to the same classes of consumers, we find that the mark FROGSKINS for "protective covers and cases for cell phones, laptop computers, tablet computers and portable media players" is not likely to cause confusion with the registered mark FROGSKINS for "eyewear, namely sunglasses and accessories for sunglasses, namely, replacement lenses, ear stems and nose pieces."

Decision: The opposition is dismissed.

⁴¹ 10 TTABVUE 90.