

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: May 5, 2021

Mailed: August 4, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Trek Bicycle Corporation*

*v.*

*Christina Isaacs*  
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Opposition No. 91232164  
—

Mary Catherine Merz of Merz & Associates PC  
for Trek Bicycle Corporation.

David A. Lowe of Lowe Graham Jones PLLC  
for Christina Isaacs.  
—

Before Kuhlke, Greenbaum and English,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Christina Isaacs, seeks registration of the following marks on the

Principal Register:

RANGER TREK (in standard characters) for “Children’s activity books; Crayons; Decals; Markers; Pencils; Publications, namely, journals, newsletters and workbooks in the fields of national parks; Stickers” (International Class 16); “Backpacks; Hiking bags; Sports bags; Travel bags” (International Class 18); “Lunchboxes” (International Class 21); “Hats; Jackets; Shirts” (International Class 25); “Ornamental novelty badges” (International Class 26); “Stuffed dolls and animals”

(International Class 28); and “Providing information, news and commentary in the field of recreation and leisure activities; Provision of information in the field of recreational activities, namely, national parks” (International Class 41);<sup>1</sup>



(Outline of the map of the United States disclaimed; described as consisting of “the term ‘RANGER TREK’ in a shield design and above a U.S. map design and two children in uniform”) for “Backpacks; Hiking bags; Sports bags; Travel bags” (International Class 18); Lunchboxes (International Class 21); “Hats; Jackets; Shirts” (International Class 25); “Stuffed dolls and animals” (International Class 28); “Providing information, news and commentary in the field of recreation and leisure activities; Provision of information in the field of recreational activities, namely, national parks” (International Class 41);<sup>2</sup> and



(EXPEDITION JOURNALS and the outline of the map of the United States disclaimed; described as consisting of “the term ‘RANGER TREK EXPEDITION JOURNALS’ in a shield design and above a U.S. map design and two children in uniform”) for “Children’s activity books; Crayons; Decals; Markers; Pencils; Publications, namely, journals, newsletters and workbooks in the fields of national parks; Stickers” (International Class 16); and “Providing information, news and commentary in the field of recreation and leisure activities; Provision of information in the field of recreational

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<sup>1</sup> Serial No. 87123067, filed August 1, 2016, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>2</sup> Serial No. 87123091, filed August 1, 2016, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

activities, namely, national parks” (International Class 41).<sup>3</sup>

Opposer, Trek Bicycle Corporation, has opposed registration of Applicant’s marks on the ground that, as used in connection with Applicant’s goods and services, the marks so resemble Opposer’s previously used and registered TREK and TREK-formative marks and TREK trade name, for a variety of goods and services including backpacks, wind jackets, hats, shirts, stickers and providing news and information in the field of cycling, as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Amended Not. of Opp., 19 TTABVUE.<sup>4</sup> By her answer, Applicant denies the salient allegations.<sup>5</sup> 24 TTABVUE.

## I. Preliminary Issues

### A. Numerous evidentiary objections.

Applicant has asserted numerous objections and Opposer has also asserted objections. None of the evidence sought to be excluded is outcome determinative. Moreover, the Board is capable of weighing the relevance and strength or weakness

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<sup>3</sup> Serial No. 87123082, filed on August 1, 2016, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>4</sup> Opposer acknowledged it was not pursuing its claim that Applicant lacked a bona fide intention to use her marks in commerce when she filed the opposed applications, therefore, that claim is forfeited. Opp. Br., 123 TTABVUE 11 n.1. *Cf. Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived; respondent’s affirmative defense of failure to state a claim not argued in brief deemed waived), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.).

<sup>5</sup> The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading. *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010). Nonetheless, our consideration of the opposition illustrates that we find Opposer to have properly set forth a claim of likely confusion under Section 2(d). Applicant relies on her defense of “Trademark prosecution history estoppel” as an admission against interest for Opposer, discussed *infra*.

of the objected-to testimony and evidence, including any inherent limitations. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we have accorded whatever probative value the subject testimony and evidence merit.

B. Appendices A, C, D, and E to Applicant's brief

Opposer objects to the entirety of Applicant's Appendices A, C, D and E as "attempts to extend the length of Ms. Isaacs' brief beyond 55 pages, as they do not represent legitimate evidentiary objections." 125 TTABVUE 6. Opposer requests that the Board not consider Applicant's brief, but if chooses to consider the Appendices A, D and E, the Board should give the information therein no weight.

Applicant's brief stands separately and we have considered it. Appendix A is simply a compilation of Opposer's pleaded registrations which were made of record. Although convenient, the table is superfluous and the Board has relied on the registration printouts made of record. Appendix D is a table of the third-party registrations made of record during trial. Again, we have relied on the printouts made of record during trial. Appendix E is essentially further argument presented on specific materials or facts and we have not considered it. Appendix C-1 suffers from the same infirmity and has not been considered. Appendix C-2 essentially serves as an objection to evidence based on a timing issue that is not relevant in this proceeding brought under Section 2(d) based on a likelihood of confusion where fame may be

shown up through the time of trial, as such, this appendix has also not been considered.

## II. RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the files of the applications subject to the notice of opposition. In addition the record includes:

- Opposer's 1-16 Notices of Reliance consisting of: 1) TESS printouts of Opposer's pleaded and other Registrations (Exhs. A-HH);<sup>6</sup> 2) excerpts of online and printed publications showing use of the TREK trade name and mark;<sup>7</sup> 3) copies of Board opinions in five other proceedings involving the TREK mark;<sup>8</sup> 4) Opposer's First Set of Requests for Admission and Applicant's Responses;<sup>9</sup> 5) Opposer's First Set of Interrogatories to Applicant and Applicant's Supplemental Responses thereto;<sup>10</sup> 6) online publications and promotional materials from 2017 and 2019 showing use and promotion of the TREK mark and trade name;<sup>11</sup> 7) excerpts from National Park Service websites showing the Junior Ranger cycling programs;<sup>12</sup> 8) excerpts from the National Park Service and Adventure Cycling Association showing promotion of cycling in national parks;<sup>13</sup> 9) excerpts from the websites of Opposer's dealers and bike rental shops located in close proximity to national parks which rent and/or sell TREK bicycles;<sup>14</sup> 10) excerpt from Applicant's website showing National Parks that have a Junior Ranger Program;<sup>15</sup> 11) excerpts of articles from online publications and promotional materials from 2018 about Trek and Trek products;<sup>16</sup> 12) screenshots from Opposer's Facebook page and third-party websites showing cyclists wearing backpacks;<sup>17</sup> 13) screenshots of third-party websites showing TREK children's bicycles;<sup>18</sup> 14) screenshots of

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<sup>6</sup> 25 TTABVUE.

<sup>7</sup> 26 TTABVUE.

<sup>8</sup> 27 TTABVUE.

<sup>9</sup> 29 TTABVUE.

<sup>10</sup> 30 TTABVUE.

<sup>11</sup> 31 TTABVUE.

<sup>12</sup> 32 TTABVUE.

<sup>13</sup> 33 TTABVUE.

<sup>14</sup> 34 TTABVUE.

<sup>15</sup> 35 TTABVUE.

<sup>16</sup> 36 TTABVUE.

<sup>17</sup> 37 TTABVUE.

<sup>18</sup> 38 TTABVUE.

websites showing clothing items bearing Opposer's design or TREK marks;<sup>19</sup> 15) screenshots of websites showing TREK TRAVEL tours in national parks;<sup>20</sup> 16) screenshots from Applicant's social media;<sup>21</sup>

- Testimony of Dean Gore (Opposer's Vice President of Marketing),<sup>22</sup> and Peter Kokko (Opposer's Global Finance Director);<sup>23</sup>
- Opposer's Rebuttal Notices of Reliance on 1) screenshots from the National Park Service websites for various parks and their onsite stores;<sup>24</sup> 2) screenshots from Opposer's websites;<sup>25</sup> 3) screenshots of Opposer's and third-party websites;<sup>26</sup> 4) additional registrations filed after the Opposition and issued to Opposer after the first trial period;<sup>27</sup> 5) screenshots from National Park Service websites and third-party website on the junior ranger program;<sup>28</sup> 6) screenshots from third-party websites about bike rentals near national parks;<sup>29</sup> 7) screenshots from the National Park Service and Federal Highway Administration websites showing guides for biking;<sup>30</sup> 8) screenshots from Bureau of Land Management and state park websites that involve bicycling;<sup>31</sup> 9) screenshots from Opposer's travel website;<sup>32</sup> 10) screenshots from third-party websites about bicycling in Dinosaur National Monument Park;<sup>33</sup> 11) screenshots from third-party websites about Opposer's ride sharing program generally and ride sharing station in the San Antonio Missions National Historic Park;<sup>34</sup>
- Rebuttal Declaration Testimony of Peter Kokko;<sup>35</sup>
- Applicant's Notices of Reliance 1-9 on: 1) several third party registrations that include the word TREK in various classes;<sup>36</sup> 2) printout of prosecution

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<sup>19</sup> 39 TTABVUE.

<sup>20</sup> 40 TTABVUE.

<sup>21</sup> 41 TTABVUE.

<sup>22</sup> 62-63 TTABVUE (public); 64 TTABVUE (confidential).

<sup>23</sup> 65 TTABVUE (public); 66 TTABVUE (confidential).

<sup>24</sup> 109 TTABVUE.

<sup>25</sup> 110 TTABVUE.

<sup>26</sup> 111 TTABVUE.

<sup>27</sup> 112 TTABVUE.

<sup>28</sup> 113 TTABVUE.

<sup>29</sup> 114 TTABVUE.

<sup>30</sup> 115 TTABVUE.

<sup>31</sup> 116 TTABVUE.

<sup>32</sup> 117 TTABVUE.

<sup>33</sup> 118 TTABVUE.

<sup>34</sup> 119 TTABVUE.

<sup>35</sup> 120 TTABVUE (public); 121 TTABVUE (confidential).

<sup>36</sup> 76 TTABVUE.

history for Opposer’s trademark application Serial No. 87565645 file;<sup>37</sup> 3) prior Board decisions;<sup>38</sup> 4) Opposer’s responses to Applicant’s First Set of Requests for Admission;<sup>39</sup> 5) Opposer’s responses to Applicant’s First set of Interrogatories;<sup>40</sup> 6) excerpts from Opposer’s website;<sup>41</sup> 7) dictionary definitions for the words “trek” and “ranger”;<sup>42</sup> 8) excerpts from Applicant’s website;<sup>43</sup> 9) printout of search results for Opposer’s proceedings before the Board;<sup>44</sup>

- Declaration Testimony and Opposer’s oral cross examination of Christina Isaacs (Applicant),<sup>45</sup> Eric Isaacs (Applicant’s Husband),<sup>46</sup> Caroline Ward (owner of Wildlife Artists, Inc.),<sup>47</sup> Ron Litton (Operations Manager and Buyer for the Dinosaur National Monument Cooperating Association),<sup>48</sup> Phyllis Bergland (Applicant’s Mother);<sup>49</sup> James Koenig (creator of Applicant’s logos),<sup>50</sup> Jennifer Dye (business advisor for Small Business Development Center).<sup>51</sup>

### III. SECTION 2(d) CLAIM

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a

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<sup>37</sup> 77 TTABVUE.

<sup>38</sup> 78 TTABVUE.

<sup>39</sup> 79 TTABVUE.

<sup>40</sup> 80 TTABVUE.

<sup>41</sup> 81 TTABVUE.

<sup>42</sup> 82 TTABVUE.

<sup>43</sup> 83 TTABVUE.

<sup>44</sup> 84 TTABVUE.

<sup>45</sup> 54 TTABVUE; 106 TTABVUE (Opposer’s oral cross examination).

<sup>46</sup> 55 TTABVUE; 107 TTABVUE (Opposer’s oral cross examination).

<sup>47</sup> 56 TTABVUE; 99 TTABVUE (Opposer’s oral cross examination).


<sup>48</sup> 57 and 61 TTABVUE; 100 TTABVUE (Opposer’s oral cross examination).

<sup>49</sup> 58 TTABVUE; 108 TTABVUE (Opposer’s oral cross examination).

<sup>50</sup> 59 TTABVUE; 98 TTABVUE (Opposer’s oral cross examination).

<sup>51</sup> 60 TTABVUE; 97 TTABVUE (Opposer’s oral cross examination).

preponderance of the evidence, that it is entitled to a statutory cause of action, has priority with respect to its previously used and registered TREK and TREK formative

marks and trade name vis-à-vis Applicant's marks RANGER TREK,  and



, and that Applicant's use of her marks in connection with her goods and services is likely to cause confusion, mistake, or deception as to the source or sponsorship of those goods. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).


Opposer pleaded and proved 34 registrations for TREK or TREK-formative marks.

Some of the more relevant registrations are summarized below.

- Registration No. 1168276 for the mark TREK for "Bicycles and Bicycle Frames," in International Class 12;
- Registration No. 2745442 for the mark TREK for "bicycling apparel, namely, bicycling jersey; form fitting and reinforced seat elastic shorts; ankle length socks; wind resistant jackets with enhanced visibility fabric, extra sleeve length, high collar and extended length back panel; vests with enhanced visibility fabric, high collar and extended length back panel," in International Class 25;
- Registration No. 2876977 for the mark TREKLITE for "orienteering equipment and clothing for outdoor sporting activities, namely, leggings, pants, gators, shirts, and jackets," International Class 25;
- Registration No. 3031210 for the mark TREK TRAVEL for "Arranging travel tours featuring hiking, river rafting, whale watching, kayaking, and bicycling; cultural tours, namely, conducting



sightseeing tours for others,” in International Class 39, “Sporting and cultural activities related to bicycling, namely, wine tastings and cultural tours, namely, guided tours of wineries,” in International Class 41 and “Services for providing food and drinks and temporary lodging for those participating in bicycling activities and cultural activities related to bicycling, namely, hiking, river rafting, cultural tours, wine tastings, whale watching and kayaking,” in International Class 43;

- Registration No. 3053077 for the mark TREK for “backpacks, textile tote bags, messenger bags, rack trunks, saddle bags, bicycle seat packs, all purpose sports bags,” in International Class 18;
- Registration No. 3516346 for the mark TREK for “On-line retail and wholesale store services featuring a wide range of consumer products except footwear all provided via the Internet,” in International Class 35;
- Registration No. 3709688 for the mark TREK for “Powders used in the preparation of sports drinks and energy drinks,” in International Class 32;
- Registration No. 37896682 for the mark TREK for “Charitable fund raising services by means of bicycle rides and entertainment events,” in International Class 36;
- Registration No. 3979036 for the mark  for “Cycling apparel, namely, jerseys and shorts, hats, tshirts,” in International Class 25;
- Registration No. 4690248 for the mark TREKMATES for “Headgear, namely, hats, caps, gloves; gaiters; clothing, namely, jackets,” in International Class 25; and
- Registration No. 5004800 for the mark TREK for “Streaming of audio material on the Internet; streaming of video material on the Internet; electronic delivery of images and photos via a global

computer network,” in International Class 38 and “Entertainment services, namely, providing a website featuring multimedia material in the nature of video recordings, video stream recordings and podcasts in the field of cycling; providing news and information in the nature of statistics and trivia in the field of cycling,” in International Class 41.

A. Entitlement to a Statutory Cause of Action and Priority<sup>52</sup>

Opposer’s entitlement to a statutory cause of action is a requirement that must be proven by the plaintiff in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, \*3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 2020 USPQ2d 11277, \*6-7.

As listed above, the record includes status and title copies of Opposer’s pleaded registrations. In view thereof, Opposer’s entitlement to a statutory cause of action to oppose registration of Applicant’s mark is established.

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<sup>52</sup> Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable as the tests “share a similar purpose and application.” *Corcamore LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*7 (Fed. Cir. 2020), *see also Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020).

In addition, because the pleaded registrations are not the subject of a counterclaim, priority is not in issue with respect to the marks and goods and services in the registrations. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, Opposer has established prior common law use of the TREK and TREK shield design marks in connection with stickers (Gore Dep., 62 TTABVUE 78-79, 99-100, 205; Gore Dep. Exhs. 35, 45, 64 TTABVUE (confidential) (includes pictures of TREK stickers for sale)).<sup>53</sup>

B. Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (*DuPont*). See also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* relevant factor for which there is evidence and argument). Two key considerations are the similarities between the marks and the similarities between the goods and services. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v.*

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<sup>53</sup> There is insufficient evidence to establish trade name or trademark rights with crayons, activity books or lunchboxes. Although there is a brief mention of lunchboxes in Mr. Gore's testimony ("we've done lunchboxes" and they were made "in the mid 2000's, 2004 or 2005 is my guess" Gore Dep., 62 TTABVUE 207, 210) it is too vague to establish trade name or trademark rights.

*Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *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 1340, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). The other factors for which there is argument and evidence are the strength of the mark TREK, channels of trade, conditions of marketing, no actual confusion, and other established facts comprising intent and admissions against interest.

1. Relatedness of the Goods and Services, Channels of Trade, Classes of Purchasers, and Conditions of Sale

We turn first to a consideration of the goods and services, channels of trade, classes of purchasers and conditions of sale. We must make our determinations under these factors based on the goods and services as they are recited in the registrations and applications. *See Octocom Sys. Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the 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.”); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

a. Goods and services in International Classes 16, 18, 25 and 41

The subject applications and Opposer's registrations contain identical and legally identical goods in International Classes 18 and 25. Specifically, Applicant's goods in International Class 18 include "backpacks" and "sports bags," and Opposer's Registration No. 3053077 for the mark TREK includes "backpacks" and "all purpose sports bags." Applicant's goods in International Class 25 are "hats, jackets, shirts," and Opposer's Registration No. 4690248 for the mark TREKMATES includes "hats" and "jackets." In addition, because Applicant's identification of clothing goods is not restricted it is broad enough to include Opposer's bicycling jersey and wind resistant jackets in Registration No. 2745442 for the mark TREK, the shirts and jackets for outdoor sporting activities in Registration No. 2876977 for the mark TREKLITE, and the cycling apparel jerseys, hats and tshirts in Registration No. 3979036 for the TREK and shield design mark, as such, these are legally identical goods.

With respect to International Class 16, Opposer has established trademark rights in the TREK and TREK shield design marks for stickers, which are identical to the stickers in Applicant's International Class 16 identification. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014). Thus, for the International Class 16 goods, it is sufficient to establish prior rights in only the stickers.

As to Applicant's information services in the field of recreation and leisure activities in International Class 41, there is some inherent relationship to the services in Opposer's Registration No. 5004800 for the TREK mark, namely, entertainment services in the nature of a website featuring video recordings in the field of cycling and providing news and information in the field of cycling, inasmuch as cycling is encompassed by Applicant's broadly worded identification "recreation and leisure activities." The first half of Applicant's Class 41 services is separated by a semi colon and therefore is not restricted by the wording "namely, national parks." *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013) (finding that, because a semicolon separated the two relevant clauses in registrant's identification, its "restaurant and bar services" is a discrete category of services that stands alone and independently as a basis for likelihood-of-confusion analysis, and is not connected to nor dependent on the services set out on the other side of the semicolon). In addition, Registration No. 3031210 for the mark TREK TRAVEL includes services that would be the subject matter of providing information about recreational and leisure services (e.g., arranging travel tours, conducting cultural tours).

Because some of the goods in Classes 16, 18 and 25 are identical and legally identical and there are no limitations as to channels of trade or classes of purchasers in the applications or Opposer's registrations, we must presume that Applicant's and Opposer's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (TTAB 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62

USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). With regard to the Class 41 services, both may be offered over the Internet.

Although there is some information in the record for Applicant's actual channels of trade (Applicant's website, National Parks, Amazon) and classes of consumers (adults and children interested in the National Park's Junior Ranger programs),<sup>54</sup> we may not limit the trade channels by this extrinsic evidence. *In re Elbaum*, 211 USPQ at 640. Opposer's and Applicant's arguments pertaining to trade channels based on extrinsic evidence are immaterial.

The same is true as to the conditions of sale and whether the goods and services are subject to more careful purchasing decisions. As explained above, the nature and scope of a party's goods and services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (Board must "give full sweep" to an identification of goods regardless of registrant's actual business). We must consider the goods and services as identified and base our determination on the least sophisticated consumer of the identified goods and services. *Stone Lion*, 110 USPQ2d at 1163 (cited in *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) ("Board precedent requires our decision to be based on the least sophisticated potential purchasers.")). Because the parties' respective identifications of goods are unrestricted, we must assume that these goods and

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<sup>54</sup> *See, e.g.,* Christina Isaacs Decl. Test., 54 TTABVUE 11-12.

services are sold to ordinary purchasers who exercise no more than ordinary care in their purchasing decisions. Here, the consumers for Applicant's and Opposer's goods and services comprise the general public. The relevant goods and services would not involve a particular or raised level of care in the purchasing decision, at least not one that would actively weigh against a likelihood of confusion.

In view of the above, the similarity of the goods and services, the channels of trade, classes of purchasers and conditions of sale favor a finding of likelihood of confusion for the goods and services identified in International Classes 16, 18, 25 and 41.

b. Goods in International Classes 21, 26, and 28

There is no evidence to establish trade name or trademark rights in or a relationship to Applicant's remaining goods in International Classes 21, 26 and 28. Accordingly, the nature of the goods, trade channels, classes of purchasers and conditions of sale do not favor a finding of likelihood of confusion for the goods in International Classes 21, 26, and 28.

2. Strength of Opposer's TREK marks

Opposer argues that its TREK mark is famous and thus the scope of protection is broad, expanding the types of marks that may be considered confusingly similar and the types of goods and services that may be considered related.

The strength of a mark is not "an all-or-nothing measure" in the context of likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir. 2017). Rather, it "varies along a spectrum from very strong to very weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal



citations omitted). “A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis,” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017), while a very weak mark receives a narrower scope of protection. A mark in the middle of the spectrum receives an intermediate scope of protection. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017) (finding opposer’s marks entitled to “the normal scope of protection to which inherently distinctive marks are entitled”). A famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In view of the extreme deference that is accorded to 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 prove it clearly.

In determining strength of a mark, we consider both conceptual strength, based on the nature of the mark itself, and commercial strength, based on marketplace recognition. *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.”). J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2021 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.”).

The record amply demonstrates the commercial strength of the TREK mark for bicycles.<sup>55</sup> TREK enjoys high volume of sales and has been listed by several online publications as having a high ranking or market share in the cycling industry, indicating a healthy share of the market.<sup>56</sup> The TREK mark, in connection with bicycles, receives broad media attention shown by the broad advertising campaigns and consumer impressions,<sup>57</sup> its social media presence and followers,<sup>58</sup> its sponsorship of cycling teams and other events involving cycling attracting well-known participants.<sup>59</sup>

We find that Opposer's TREK mark is famous for bicycles and bicycle accessories. The evidence does not support a finding that TREK is famous for the types of goods

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<sup>56</sup> Kokko Test. Depo., 66 TTABVUE (confidential); 62 TTABVUE 39-41, 43, 141-143, 343, 353-356, 362; 31 TTABVUE 94-116. Applicant objects to the testimony concerning market share as lacking foundation and constituting hearsay. We accord this evidence some probative value inasmuch as Mr. Kokko as Opposer's Global Finance Director and Mr. Gore as Opposer's Vice President of Marketing have personal knowledge about Opposer's finances and marketing which would include monitoring market share. The fact that they do not know the specifics of how the data was gathered and analyzed by third parties does tend to limit the probative value.

<sup>57</sup> 26 TTABVUE 1-103; 31 TTABVUE 77-82; 62 TTABVUE 31-33, 311-312, 314-315; 62 TTABVUE 284-286, 290, 292-293. Applicant's objections to the exhibits in 26 TTABVUE and 31 TTABVUE are overruled to the extent that they are proper subject matter for introduction under notice of reliance and we only consider them for what they show on their face and not for the truth of the matter asserted.

<sup>58</sup> 62 TTABVUE 57-58.

<sup>59</sup> 62 TTABVUE 20-21, 45, 121, 245-253, 281-182, 284-286, 290, 292-293, 312-320.

identified in the subject applications. Although it is correct that fame increases the scope of protection, extending to goods other than those for which fame is found, and the fame of Opposer's TREK mark must be accorded great weight in a likelihood of confusion analysis, "fame alone cannot overwhelm the other *DuPont* factors as a matter of law." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); *see also Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983) ("The fame of the [plaintiff's] name is insufficient in itself to establish likelihood of confusion under §2(d).").

Applicant seeks to restrict the scope of protection to be accorded to Opposer's TREK marks by arguing that TREK is conceptually weak. In determining the conceptual strength of Opposer's TREK mark, "we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum...." *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014).

Applicant points to the dictionary definitions of TREK as "a trip or movement especially when involving difficulties or complex organization : an arduous journey"<sup>60</sup> and "a slow or difficult journey, hike or trip."<sup>61</sup> In addition, Applicant submitted 65 third-party registrations that incorporate the word TREK, some of which are for clothing, bags, or recreation-related information services. To be clear, this evidence does not have probative value as to commercial strength as there is no evidence of

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<sup>60</sup> App. Not. of Reliance, 82 TTABVUE 7 (Merriam-Webster Dictionary).


<sup>61</sup> Dictionary.com based on the Random House Unabridged Dictionary (2021). We grant Applicant's request for judicial notice of this dictionary definition. *In re Cordua Rests. L.P.*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

use in the market. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“Applicant’s citation of third-party registrations as evidence of market weakness is unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.”). However, while “[t]he existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them....,” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), “evidence 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...” *Jack Wolfskin Austrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation*, 115 USPQ2d at 1675) (internal punctuation omitted).


Opposer is correct that most of these third-party registrations are not for the same or similar goods and services at issue in this case. However, a few are directly relevant and overall they do tend to show the common adoption of the word TREK by third parties to carry the suggestion the goods or services may be appropriate for “trekking” or simply to evoke the idea of hiking in connection with the goods or services. While these third-party registrations do not diminish the commercial strength of Opposer’s




TREK mark, they do underscore the somewhat suggestive nature of the word TREK in connection with clothing, bags and recreation-related information services. In that sense they serve to corroborate the relevance of the dictionary definition of the word TREK in connection with bags, clothing and recreation-related information services.



A few examples are listed below.<sup>62</sup>

Exh.	Reg. No.	Mark	Goods/Services	Owner
1	2194881	TREK TIPS	Printed publications, namely, brochures providing information for travelers on vacation to North and Central America regarding security, insurance, health issues, climate, drinking, places to stay and other issues of interest to travelers on vacation	Trek America Travel Limited
2	2553403	TREK FLEX	Footwear	C. & J. Clark International Limited
3, 17	2606424		Summer sports and recreation camp services for youths, offering activities in the areas of backcountry camping, backpacking, rock climbing, mountaineering, canoeing, sea-kayaking, and whitewater rafting	Adventure Treks
4	2673351	TREK SAFELY	Printed materials, namely, brochures, guides, training outlines and pocket certificates in the field of safety procedures for outdoor activities, namely, hiking, backpacking, canoeing, horseback riding,	Boy Scouts of America


<sup>62</sup> 76 TTABVUE.

Exh.	Reg. No.	Mark	Goods/Services	Owner
			caving, skiing, mountain climbing	
5	2726270		Printed materials, namely, brochures, guides, training outlines and pocket certificates in the field of safety procedures for outdoor activities, namely, hiking, backpacking, canoeing, horseback riding, caving, skiing, mountain climbing	Boy Scouts of America
6	2529499	TEAM TREK	Educational services, namely, leadership training and team-building seminars	Team Trek, Inc.
7	2999456	DESERT TREK	Footwear	C. & J. Clark International Limited
8	2677413	TIME TREK	Producing and providing news stories and year-in-review news content for the school yearbooks of others	Inter-State Studio & Publishing Co.
9	2748478	TREK SAFELY	Cloth patches for clothing	Boy Scouts of America
11	2845837	GREENTREKS	Educational and entertainment services, namely providing on-line information and news in the field of environmental education; educational and entertainment services, namely, interactive exhibits in the field of environmental issues, and providing television and radio programs in the field of environmental issues; production of radio and television programs; publication of magazines and newspapers in the field of environmental issues;	Greentreks Network, Inc.



Exh.	Reg. No.	Mark	Goods/Services	Owner
			production and distribution of motion pictures	
14	3820076		Educational services, namely, providing classes in the field of nature and the outdoors; recreational services in the nature of hiking, arts and crafts, story telling; and recreational camps; all of the aforementioned services excluding bicycle or bicycling related services	Worth, Pamela Sue
16	3625940	DOLPHIN TREK	educational and entertainment services in the nature of aquatic programs by which guests can view aquatic life and habitats and interact with mammals	Sub Sea Systems
23	4163070		Footwear, namely, shoes, rubbers, pumps, boots, canvas shoes, heels, hiking boots, sandals, slippers, sneakers, sporting shoes, shoe-pads in the nature of insoles, running pads that strap onto shoes, shoe-insoles and shoe soles, all sold as components of shoes; none of the foregoing goods being intended for use while bicycling	Tiong Liang Industrial Co., Ltd.
24	4134348	VERSATREX	Shorts	Eddie Bauer Licensing Services LLC
28	4300740		Hiking poles	Cutler, Thomas
31	4790987	TREKPAK	Divider system consisting primarily of padded dividers and coated pins for	Pelican Products, Inc.

Exh.	Reg. No.	Mark	Goods/Services	Owner
			connecting the padded dividers for use in bags, hard and soft sided cases, rucksacks, backpacks, carrying bags, hand bags, tote bags, shoulder bags, cases and luggage with rolling wheels, cases and luggage without rolling wheels	
33	4700585	STAR TREK SKELE-TREKS	Clothing, namely, t-shirts, shirts, sweatshirts	CBS Studios, Inc.
39	4976636		Providing a website on the Internet featuring information in the field of travel	The Wild Trek Experience, LLC
43	5143664	THE TREK	Interactive online web journals featuring backpacking and hiking; On-line journals, namely, blogs featuring backpacking and hiking; Providing on-line non-downloadable articles in the field of backpacking and hiking	Appalachian Trials LLC
45	5204400	PET-TREK	Folding trolley carts specially adapted for animal carriers and luggage	DBA A Pet With Paws
46	5703814	GLADIATOR TREK	Organizing, arranging and conducting mountain adventure excursions in the nature of guided hiking, mountain climbing, mountaineering, backpacking and camping activities	Bonaldi, Jeffrey
47, 55	5483779		Traveling bags	Boioglu Adrian



Exh.	Reg. No.	Mark	Goods/Services	Owner
48, 49	5854156		<p>Retail store and mail order services featuring recreational and outdoor clothing, equipment and supplies; Arranging and conducting the transport of persons for outdoor and recreational tours and trips, and wilderness adventure trips, excursions, and expeditions; outdoor travel guide services and naturalist services in the nature of travel information services; outfitter and rental services, namely, canoe, kayak, and vehicle roof rack rental;</p> <p>Educational and recreational services, namely, providing and conducting courses in the nature of seminars and workshops, classes, field trips and social outings for learning about, enjoying, appreciating and interpreting the outdoors, nature, wildlife, wilderness, geography, native cultures, outdoor activities, fishing, camping, hiking, skiing, snowshoeing, canoeing, and kayaking; instruction in outdoor survival skills; arranging and conducting guided outdoor and recreational tours and trips, and guided wilderness adventure trips, excursions, and expeditions for recreational purposes;</p>	KR Kayaking LLC

Exh.	Reg. No.	Mark	Goods/Services	Owner
			outfitter and rental services, namely, the rental of sports equipment in the nature of snowshoes; Outfitter and rental services, namely, rental of protective clothing and accessories in the nature of protective equipment for safety purposes	
50	5350308	HIGH TREK	Hiking poles	Mountain Snow LLC
57	5631474	QUADTREK	Traction attachments for footwear, all of the aforementioned goods not intended for use while cycling	Audy Global Enterprises, Inc.
60	5744070	PURTREK	Hiking poles with integrated water filtration system	6112 Breeze Circle
62	5787827	ELDERTREKS	Travel services, namely, arranging and conducting walking, hiking, helicopter, horseback, boat, and motorized vehicle guided tours of geographic locations	Passages Exotic Expeditions Ltd.
63	5823490	TREK SCRATCHER	Globes; Map pins; Map tacks; Maps; Notebook covers; Notebook paper; Notebooks; Paper; Paper notebooks; Scratch pads; Blank journal books; Blank journals; Blank note cards; Blank paper notebooks; Blank writing journals; Celestial globes; Customizable journal books; Geographical maps; Geophysical maps; Holiday	Newverest LLC

Exh.	Reg. No.	Mark	Goods/Services	Owner
			<p>cards; Letterhead paper; Motivational cards; Note cards; Personalized writing journals; Picture cards; Post cards; Postcard paper; Reporters' notebooks; Road maps; Score-cards; Scratch cards; Spiral-bound notebooks; Stenographers' notebooks; Terrestrial globes; Visiting cards; Wall maps; Writing journal sheets</p>	
65	959469		<p>Casual footwear of leather, suede or synthetic materials</p>	<p>C. &amp; J. Clark International Limited</p>
66	4801750		<p>Brochures in the field of travel and tourism; printed matter, namely, books, booklets, guidebooks, maps and charts in the field of travel and tourism; printed guides in the field of travel and tourism; maps; Clothing, namely, t-shirts, shirts, shorts, trousers, uniforms and bathrobes, footwear; headgear, namely, hats, caps, sun visors, headwear; Arranging and conducting seminars, conferences, symposiums and workshops in the field of travel and tourism; holiday camp services; educational services, namely, providing classes in the field of team building; entertainment services, in the nature of concert booking, booking of seats for</p>	<p>Trek America Travel Limited</p>

Exh.	Reg. No.	Mark	Goods/Services	Owner
			shows and booking of theatre tickets, arranging for ticket reservations for shows, cultural and artist events, motion pictures, music concerts and other live entertainment events, organizing exhibitions of cultural, sporting and entertainment purposes; publication of books, event programmes and text other than publicity text	

Thus, conceptually the mark TREK appears to be somewhat suggestive in connection with backpacks, clothing, and recreation-related information services and the commercial strength for bicycles and bicycle accessories has not been shown to apply to these goods and services. We accord Opposer’s TREK marks the scope of protection to which somewhat suggestive marks are entitled, keeping in mind the mark’s wider scope of protection in the bicycle industry.

### 3. Similarity of the Marks

We now consider the similarity or dissimilarity of the parties’ marks and compare them in their entirety in terms of appearance, sound, connotation and commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018); *see also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d

1534, 1535 (TTAB 1988)). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). The marks must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Ms. Isaacs testifies as follows:

[T]he primary word in [my mark] is ranger. That really gives the – the whole meaning to what my mark means is really the word ranger. And trek is just a common word that’s found in the dictionary, it just means to go on a journey. So ranger really is the – the primary and the most important word, and it’s the first word. Because you’re going on a ranger trek, you’re going on a journey to try to find parks that have the Junior Ranger program, participate in them, become a junior ranger at as many parks as you possibly can.

Christina Isaac’s Test., 106 TTABVUE 84.

With regard to the TREK shield design and Applicant’s shield design, Christina Isaacs testifies:

Like, I mean, one’s a shield, ... Trek’s is a shield, mine’s a badge. Those are two completely different shapes that have different meanings. Also, I have two characters on mine. And the girl character is holding a Ranger Trek expedition

journal, and the – the boy is holding a – a walking stick. So I mean, it's clear that they're going on a trek that's by foot, which when – I believe that the definition of trek even says that it's a – it's a trek by foot. So mine is very colorful. There's many, many colors in mine. I – the one – when I looked up to see what yours even – Trek's look like, I just saw the black and white. So I don't believe that it comes like in a rainbow of colors, you know, all in the same design. I don't – I don't know. I mean, there's so many differences. It's like I have a little picture of the United States because I wanted to make sure that people knew that I'm – that Ranger Trek is – pertains to the national parks of the United States – US national parks because other countries now have national parks as well. But this – this has to do with the United States.

Christina Isaacs Test., 106 TTABVUE 86-87.

Opposer argues that:

[The] marks are similar in appearance, pronunciation, connotation and commercial impression due to the presence in each of the identical term TREK. This term forms the entirety of Trek's mark and is the dominant portion of Ms. Isaacs' marks, because RANGER is merely a modifier for the TREK element; that is, Trek's mark is TREK and Mrs. Isaacs' marks suggests TREK which somehow involves a RANGER. The consumer will associate RANGER TREK with Trek's TREK just as the consumer associates Trek's registered TREK Formative Marks PRO TREK, ETREK and TACO TREK with Trek's TREK.<sup>63</sup>

123 TTABVUE 45.

With regard to the RANGER TREK design marks and the TREK and TREK design marks, Opposer adds that the verbal portion of a mark is “the one most likely to indicate the origin of the goods to which it is affixed.” 123 TTABVUE 45 (quoting *In re Viterra Inc.*, 101 USPQ2d at 1908). In addition, Opposer argues that the design

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<sup>63</sup> We note that TACO TREK is not a pleaded mark, and may not be relied on for presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 7(b).

elements in the marks are similar in that both position the wording in the uppermost portion of a shield design. *Id.* at 46.

In comparing the marks, we begin with Applicant's standard character mark RANGER TREK. The rights associated with a standard character mark reside in its wording, and not in any particular display and we must consider Applicant's mark "regardless of font style, size, or color." *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011); *In re RSI Sys., LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); Trademark Manual of Examining Procedure (TMEP) § 1207.01(c)(iii) (Oct. 2018).

In making their arguments, the parties presented case law that sets out various guidelines in determining similarity in marks. For example, that the first part of a mark is often the more prominent or likely to be remembered, *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (the first part of a mark "is most likely to be impressed upon the mind of a purchaser and remembered")); *Palm Bay Imps.*, 73 USPQ2d at 1692), but also, where one party's mark incorporates the entirety of the other's mark, confusing similarity may be found, *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (Opposer's mark PRECISION DISTRIBUTION CONTROL contains the entirety of Applicant's mark PRECISION). We add that if a junior user takes the entire mark of another and adds a generic, descriptive or highly suggestive term, it is generally not sufficient to avoid confusion. *See Stone Lion*

*Capital Partners*, 110 USPQ2d at 1161 (Applicant's STONE LION mark for financial planning was confusingly similar to Opposer's LION CAPITAL mark for competitive services); *Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1189 (TTAB 2014) ("Likelihood of confusion is often found where the entirety of one mark is incorporated within another." The mark MINERS, both alone and with image of a miner and the words "Southern Illinois," found confusingly similar to opposer's MINERS mark, both for college sports teams).

Although there is no mechanical test to select a "dominant" element of a mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB's finding that "DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE). If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation*, 115 USPQ2d at 1674-75 (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB's holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion,



because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar).

While Applicant's and Opposer's marks include the identical word TREK, in connection with these goods and services it is somewhat suggestive. Although the word RANGER is also somewhat suggestive in connection with these goods and services, it is more dominant, placed at the beginning of Applicant's mark, and presents a different overall commercial impression, sufficient to avoid likely confusion. TREK by itself simply references a journey or hike. RANGER TREK evokes a person on a journey or hike and not any person but a specific type of person with a mission on a RANGER TREK. We note that in the prior decisions submitted under Notice of Reliance at 27 TTABVUE 7-136 where the Board found confusing similarity the literal elements of the marks were identical, the additional material appears after the word TREK, or, in one case, the additional first word was merely descriptive:

Opp. No. 91094948 TREKNOLOGY and design where "the design feature separates the TREK portion of applicant's mark for a NOLOGY portion of applicant's mark...the TREK portion of applicant's mark clearly stands out by itself";

Opp. No. 91164982 TREK;

Opp. No. 91174085 TREKEASE;

Opp. Nos. 91213696 91213957 91213962 TREKGUIDE  
THERMOTREK TREKCEL;

Opp. No. 91221706 TREK and design

We recognize that “when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines,” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); but given the dissimilarities in appearance, sound, connotation and commercial impression, even ignoring the somewhat conceptually weak nature of the word TREK in connection with the various Class 18 and 25 goods and Class 41 services to the extent it suggests they are for trekking or simply evokes the idea of trekking, we find the marks are not confusingly similar when used on the goods or services for which Opposer has established priority.

The differences presented by the RANGER TREK and design marks provide further distinction from Opposer’s TREK and TREK-formative marks and Opposer’s TREK shield design mark. The design amplifies the RANGER connotation, depicting children heading out on a hike in ranger outfits, and the badge or shield design is a very different shape from Applicant’s shield design.

This factor weighs against finding likely confusion.

#### 4. Absence of Actual Confusion

Ms. Isaacs argues that there has been no actual confusion despite concurrent use for five years. “The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by [Applicant] ... of its mark for a significant period of time in the same markets as those served by [Opposer] ... under its mark[.]” *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). In other

words, for the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred).

Here, Applicant has been using her mark in commerce since 2016 for only a few of the applied-for goods at National Parks gift shops, [www.rangertrek.us](http://www.rangertrek.us) and [www.amazon.com](http://www.amazon.com). The record reveals nominal sales. Overall, the record does not reveal a meaningful opportunity for confusion to occur. We therefore find the absence of any actual confusion does not weigh in Applicant's favor. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("The absence of any showing of actual confusion is of very little, if any, probative value" where evidence as to the use of Applicant's merchandise during the time in question was not presented). In any event, "it is unnecessary to show actual confusion in establishing likelihood of confusion." *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). We therefore find the absence of actual confusion neutral regarding a finding on likelihood of confusion.

#### 5. No Wrongful Intent

Applicant argues that she had no knowledge of Opposer or its marks prior to creating and adopting her RANGER TREK marks and this weighs in her favor. We agree that the record does not show any bad faith on the part of Applicant. However, while the existence of bad faith weighs in favor of likely confusion, the reverse is not

necessarily true. We find the absence of bad faith is neutral or at most has minimal weight as a factor.

6. Other Established Facts

Finally, Applicant submitted the file contents of one of Opposer's more recent applications for the mark TREK wherein Opposer successfully argued against likely confusion with the marks in the cited registrations. Applicant asserts these statements serve as admissions against interest.

Such statements constitute admissions and may be considered as evidence, albeit not conclusive evidence, of the truth of the assertions therein. *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 599 (TTAB 1982), *aff'd*, 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983) (citing *Bakers Franchise Corp. v. Royal Crown Cola Co.*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969); *Maremont Corp. v. Airlift Corp.*, 463 F.2d 1114, 174 USPQ 395, 396 (CCPA 1972)). *See also Daniel J. Quirk Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent's Office action response constitute admissions against interest and fall within hearsay exception under Fed. R. Evid. 801(d)(2)).

Opposer's prior application Serial No. 87565645 for the standard character mark TREK for "apparel, namely, pants, shorts, t-shirts, shirts, vests, jackets, socks, gloves, beanies, caps, hats, hoodies" was approved for publication and eventually issued into a Registration after Opposer successfully argued against likely confusion with the marks in the cited registrations. The cited registered marks were:

TREK (stylized) for “casual footwear of leather, suede or synthetic materials”; DESERT TREK for “footwear”; TREK FLEX for “footwear,” all owned by C. & J. Clark International Limited;

TREK AMERICA and design for “clothing, namely, t-shirts, shirts, shorts, trousers, uniforms and bathrobes, footwear; headgear, namely, hats, caps, sun visors, headwear,” owned by Trek America Travel Limited;

TREK DRY FUNCTIONAL FABRIC QUICK DRYING + MOISTURE WICKING for, among other things, “footwear, namely, shoes, rubbers, pumps, boots, canvas shoes, heels, hiking boots, sandals, slippers, sneakers, sporting shoes, shoe-pads in the nature of insoles, running pads that strap onto shoes, shoe-insoles and shoe soles, all sold as components of shoes; none of the foregoing goods being intended for use while bicycling” owned by Tiong Liong Industrial Co., Ltd.

Opposer responded by submitting a consent agreement with C. & J. Clark. In addition, Opposer argued that the class 25 goods in the application for the TREKAMERICA mark will be associated with the travel services. With regard to the TREK DRY mark, Opposer argued that it is for footwear and in fact is being used for fabric used to make shoes. Finally, Opposer argued that “[i]f the cited registration for TREK AMERICA and Design for clothing items, headwear and footwear can coexist with C&J Clark’s three cited registrations TREK, TREK FLEX and DESERT TREK for footwear, then the mark in the proposed TREK application should be allowed to coexist, as well, for clothing items and headwear.”<sup>64</sup> Opposer repeats this argument for the TREK DRY FUNCTIONAL FABRIC QUICK DRYING+MOISTURE WICKING and Design mark.<sup>65</sup>

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<sup>64</sup> App. Not. of Reliance, 77 TTABVUE 19-20.

<sup>65</sup> *Id.* at 21.

Overall, we do not find these statements to be in full conflict with Opposer's position in this proceeding involving a different mark. However, we agree that given the various "trek" marks registered for similar or related goods, it would seem Applicant's marks, where the addition of "RANGER" creates a sufficient distinction, may coexist as well.

#### 7. Balancing of the Factors

We have considered all of the evidence pertaining to the relevant *DuPont* factors, as well as the parties' arguments with respect thereto. In balancing the relevant factors, we find the differences between the marks sufficient to avoid likely confusion despite the identical goods and trade channels and the fame of Opposer's marks for bicycles, in particular given the differences in overall commercial impression. "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (citing *Century 21 v. Century Life*, 23 USPQ2d at 1698)); *see also Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (MAYA not confusingly similar to MAYARI) (quoting *Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive"))).

#### IV. Conclusion

Because Opposer has not shown, by a preponderance of the evidence, the existence of a likelihood of confusion, Opposer has not established its claim under Section 2(d).

Opposition No. 91232164

**Decision:** The opposition is dismissed.