

This Opinion Is Not a
Precedent of the TTAB

Mailed: October 11, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Metal Jeans, Inc.

v.

Carrie Eskay

—
Opposition No. 91233741
—

Jeffrey A. Kobulnick and Michael A. Bernet of Brutzkus Gubner Rozansky Seror
Weber LLP for Metal Jeans, Inc.

Kenneth Avila, Esq. for Carrie Eskay.

—
Before Bergsman, Goodman and Coggins, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Carrie Eskay (Applicant) seeks registration on the Principal Register of the mark
I'M METAL (in standard character form) for the following products:

Novelty license plate frames, in Class 12;

Jewelry; Pins being jewelry, in Class 14;

Stickers, in Class 16; and

Bandanas; Belts for clothing; Sweatshirts; T-shirts;
Graphic T-shirts; Hooded sweatshirts; Infant and toddler

one piece clothing; Short-sleeved or long-sleeved t-shirts, in Class 25.¹

Metal Jeans, Inc. (Opposer) filed a Notice of Opposition against the 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 I'M METAL for the products listed in the description of goods so resembles Opposer's mark METAL for clothing, apparel accessories, key chains, and license plates as to be likely to cause confusion. Specifically, Opposer pleaded ownership of Registration No. 4299652 for the mark METAL (in standard character form) for "clothing, namely, ski jackets and snowboard jackets; clothing, namely, jeans and shirts," in Class 25.² In addition, Applicant alleged prior common law rights in apparel accessories, key chains, and license plates.

Further, Opposer alleged that Applicant's mark is likely to dilute the distinctive character of Opposer's mark. However, Opposer withdrew the dilution claim in its brief.³

Applicant, in her Answer, denied the salient allegations in the Notice of Opposition. In addition, Applicant pleaded purported affirmative defenses that were not affirmative defenses but amplifications of her denials.

¹ Application Serial No. 87215950 was filed on October 26, 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.

² Registered March 12, 2013; Sections 8 and 15 declarations accepted and acknowledged.

³ Opposer's Brief, p. 1 (20 TTABVUE 8).

I. Preliminary matters.

A. Opposer's motion to strike Applicant's Brief.

In the Board's April 25, 2018 order,⁴ the Board suspended proceedings through May 25, 2018, pending settlement negotiations but if the parties did not reach a settlement, proceedings would resume in accordance with the trial order set forth in the parties' stipulation.⁵ Pursuant to the trial order in the parties' stipulation and Trademark Rule 2.128(a)(1), 37 C.F.R. § 2.128(a)(1), Applicant's brief was due March 21, 2019. Applicant filed her brief on February 22, 2019.

Opposer, in its Reply Brief, contends that Applicant's brief was due February 19, 2019 based on the Board's August 22, 2017 trial order (8 TTABVUE).⁶ However, as noted in the preceding paragraph, the parties replaced the August 22, 2017 trial order in their stipulation to suspend proceedings.

Applicant timely filed her brief and, therefore, Opposer's motion to strike Applicant's brief is denied.

B. Opposer's objection to Applicant's third-party registration evidence.

Applicant, in her brief, contends, for the first time, that there are numerous third-party registrations for clothing incorporating the word "Metal" and, therefore, Opposer's mark METAL is a weak mark entitled only to a narrow scope of protection.

In searching through TESS, there has been nearly 100 registrations in International Class 25 that contain the term METAL (results obtained by the search pattern: metal[bi] and "025"[ic] and `RN > "0"). Thus, there exists

⁴ 12 TTABVUE.

⁵ 11 TTABVUE.

⁶ Opposer's Reply Brief, p. 2 (22 TTABVUE 3).

significant third-party registrations containing the term METAL in International Class 25. If these, 30 registrations not owned by Opposer are still live and have filed section 8 declarations (results obtained by the search pattern: metal[bi] and “025”[ic] and `RN > “0” and “8”[AF] and live[ld]). Thus, there exists significant use of the term METAL in International Class 25.

Therefore, as there has been significant third-party use and registration of the embedded term METAL, this term is weak and there is no likelihood of confusion.⁷

Opposer, in its Reply Brief, objects to Applicant’s third-party registration evidence.

Applicant’s vague allegations regarding certain unidentified third party registrations lack evidentiary support and constitute inadmissible hearsay, and should therefore be stricken from the record, pursuant to TBMP § 707.01 and Federal Rules of Evidence 403, 802, and 901.⁸

Opposer’s objection is sustained. First, a party may not take testimony or present evidence outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a); *see also Baseball Am. Inc. v. Powerplay Sports*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (documentary evidence submitted outside assigned testimony period given no consideration); *M-Tek Inc. v. CVP Sys. Inc.*, 17 USPQ2d 1070, 1072 (TTAB 1990) (untimely deposition stricken).

Second, Applicant’s purported trademark search report is not credible evidence of the existence of the registrations listed in the report. *See Weyerhaeuser Co. v. Katz*,

⁷ Applicant’s Brief, pp. 3-4 (21 TTABVUE 7-8).

⁸ Opposer’s Reply Brief, p. 3 (22 TTABVUE 4).

24 USPQ2d 1230, 1232-33 (TTAB 1992); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1215 n.3 (TTAB 1990); *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Third party registrations may be made of record with a notice of reliance filed during the offering party's testimony period, but the notice must be accompanied by legible, soft copies of the registrations themselves, *see Kellogg*, 14 USPQ2d at 1549 (citing *In re Hub Distrib., Inc.*, 218 USPQ 284, 285 (TTAB 1983)), or the electronic equivalent thereof (i.e., printouts of the registrations from the USPTO's electronic databases).

II. The record

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application.⁹ The record also includes:

- A. Opposer's testimony and evidence.
 - 1. Notice of reliance on the following items:
 - a. Opposer's pleaded registration printed from the USPTO Trademark Status and Document Retrieval System (TSDR) showing the current status of and title to the registration;¹⁰
 - b. Applicant's responses to Opposer's requests for admission;¹¹ and
 - c. Applicant's responses to Opposer's interrogatories;¹² and

⁹ Because the application file is automatically of record, Applicant did not need to file a copy of the application. 17 TTABVUE 7-9.

¹⁰ 13 TTABVUE 11-23.

¹¹ 13 TTABVUE 25-40

¹² 13 TTABVUE 42-52.

2. Testimony Declaration of Grant Sawyer, Opposer's Chief Marketing Director.¹³
- B. Applicant's testimony and evidence.
 1. Notice of reliance on the following items:
 - a. Opposer's responses to Applicant's first set of interrogatories;¹⁴ and
 - b. Opposer's responses to Applicant's request for production of documents;¹⁵ and
 2. Testimony declaration of Kenneth Avila, Applicant's counsel, introducing Opposer's responses to Applicant's request for production of documents.¹⁶

¹³ 16 TTABVUE. The portions of the Sawyer declaration designated confidential are posted at 15 TTABVUE.

¹⁴ 17 TTABVUE 11-31.

¹⁵ 17 TTABVUE 33-69. Responses to a request for production of documents introduced through a notice of reliance are admissible solely for purposes of showing that a party has stated that there are no responsive documents; documents produced in response to the requests are generally not admissible by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii); *see also City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance); *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1217 n.8 (TTAB 2011); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011); *Spirits Int'l B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1547-48 n.5 (TTAB 2011); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 n.5 (TTAB 2008).

¹⁶ 18 TTABVUE 28-64. Generally, the requesting party may not introduce the documents produced through a notice of reliance unless the responding party has authenticated them by an admission or stipulation. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 704.11 (2019). However, the Board may consider the documents where, as here, Opposer, as the responding party, does not object to its responses to the document request. *See, e.g., Maids to Order of Oh. Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1901-02 (TTAB 2006); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (improper subject of notice of reliance but no objection raised); *Autac Inc. v. Viking Indus., Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978) (neither party objected to other's offering of Fed. R. Civ. P. 34 documents by notice alone); *Southwire Co. v. Kaiser Aluminum & Chem. Corp.*, 196 USPQ 566, 569 n.1 (TTAB 1977) (applicant did not object to documents produced and introduced by notice alone and referred to those documents in its brief); *Harvey Hubbell, Inc. v. Red Rope Indus., Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976) (no objection to notice of reliance).

III. 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).

Opposer has established its standing by properly introducing into evidence its pleaded registration. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff’s two prior registrations suffice to establish plaintiff’s direct commercial interest and its standing); *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in her brief, did not challenge Opposer’s standing.

IV. Priority.

Because Opposer’s pleaded registration is of record, priority in the opposition proceeding is not at issue with respect to the mark and goods identified therein (i.e., clothing in Class 25). *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)).

With respect to the products for which Opposer is claiming prior common law rights, Grant Sawyer, Opposer’s Chief Marketing Director, testified that Opposer has

used the mark METAL to identify its apparel accessories, including key chains and license plates, since as early as 2006.¹⁷ Grant Sawyer's testimony is based on personal knowledge, it is clear, convincing, and it has not been contradicted. *See Nat'l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liquacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Servs., Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted). Further, Mr. Sawyer corroborated his testimony regarding priority by introducing Opposer's 2006 price list.¹⁸

In the absence of evidence establishing earlier use of its mark, a party may rely for priority purposes on the filing date of its application. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c); *see also Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013) ("for when an application or registration is of record, the party may rely on the filing date of the application for registration, i.e., its constructive use date."); *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 USPQ2d

¹⁷ Sawyer Testimony Decl. ¶5 and Exhibit 1 (16 TTABVUE 2-3 and 11-13).

¹⁸ Sawyer Testimony Declaration Exhibit 1 (16 TTABVUE 11-13).

1112, 1119 (“applicant may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority”). Because Applicant did not introduce any testimony or other evidence, the earliest date on which she may rely for priority is the October 26, 2016 filing date of her application.

Opposer has established prior use of its METAL mark for license plates and key chains. Applicant, in her brief, did not contest Opposer’s priority.

V. 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) (“*DuPont*”) 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 *DuPont* factor that is relevant or for which there is evidence of record. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *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.”). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). 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. Similarity or dissimilarity and nature of the goods.

Applicant is seeking to register her mark for the goods listed below:

Novelty license plate frames;

Jewelry; Pins being jewelry;

Stickers; and

Bandanas; Belts for clothing; Sweatshirts; T-shirts;
Graphic T-shirts; Hooded sweatshirts; Infant and toddler
one piece clothing; Short-sleeved or long-sleeved t-shirts.

Opposer has registered its mark for “clothing, namely, ski jackets and snowboard jackets; clothing, namely, jeans and shirts” and has used its mark on license plates and key chains.

Opposer’s broadly identified “shirts” encompass Applicant’s “short-sleeved or long-sleeved t-shirts.” *See Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (“Where an applicant identifies its services broadly, we must presume that the services encompass all services of the type identified.”); *In re Hughes*

Furniture Indus., Inc., 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Thus, with respect to the products in Class 25, the goods are in part identical.

Under this *DuPont* factor, Opposer need not prove, and we need not find, similarity as to each product listed in the description of goods for this class. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015).

With respect to Applicant’s “novelty license plate frames,” in Class 12, and Opposer’s license plates, Opposer contends, “[s]uch goods are closely related to novelty license plate frames since those goods are traditionally displayed and sold together.”¹⁹ Although there is no testimony or evidence to support Opposer’s contention, novelty license plate frames and license plates are complementary products because they may be used together. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1110 (TTAB 2007) (petitioner’s toilets and lavatories and respondent’s “metal hardware doors” may be viewed as complementary because some consumers, when buying a line of products for their bathroom, want their toilet, sink,

¹⁹ Opposer’s Brief, p. 12 (20 TTABVUE 19).

shower door, bathroom door and cabinet fixtures to all match or at least be coordinated); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (shoes bought to match style or color of clothes); *Visual Info. Inst., Inc. v. Vicon Indus., Inc.*, 209 USPQ 179, 190 (TTAB 1979) (“the products, although not interchangeable, are complementary in that they can be used together in the same close circuit television system”).

In this regard, a Facebook entry, reproduced below, displays a photograph of Opposer’s license plate.²⁰



²⁰ Sawyer Testimony Declaration Exhibit 11 (16 TTABVUE 276).

Opposer's license plates are essentially novelty license plates. The word "novelty" is defined, inter alia, as "an article of trade whose value is chiefly decorative, comic, or the like and whose appeal is often transitory: *a store catering to tourists who loaded up with souvenir pennants and other novelties.*"²¹ As displayed above, Opposer's license plates are products that are chiefly decorative and would work well with a novelty license plate frame. Accordingly, we find that Applicant's novelty license plate frames are related to Opposer's license plates.

With respect to Applicant's "jewelry; pins being jewelry," in Class 14, and Opposer's key chains, Opposer argues that its "apparel accessories and key chains" are "sufficiently similar [to Applicant's jewelry] that this second *du Pont* factor therefore favors a likelihood of confusion, and rejection of Applicant's '950 Application in connection with the Class 14 goods listed therein."²² However, Opposer did not introduce evidence or testimony to establish any relationship between those products, and neither did it explain or demonstrate what an apparel accessory is. Nevertheless, key chains and jewelry serve similar purposes of adornment and decoration. See for example, Opposer's website featuring a photograph of Opposer's key chain reproduced below.²³

²¹ Dictionary.com based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2019), accessed on October 3, 2019. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

²² Applicant's Brief, p. 12 (20 TTABVUE 19).

²³ Sawyer Testimony Decl. Exhibit B (16 TTABVUE 115).



The key chain has decorative features and is more than just a functional product. Because of the similarity of the marks, consumers may perceive key chains and jewelry, including pins, as emanating from a single source and, therefore, we find that those products are related.

With respect to Applicant’s “stickers,” in Class 16, Opposer did not introduce any evidence or make any arguments. The lack of evidence favors a finding that there is no likelihood of confusion with respect to stickers.

In summary, (i) Applicant’s clothing is in part identical to Opposer’s clothing, and this favors finding that there is a likelihood of confusion for these goods;

(ii) Applicant’s novelty license plate frames are related to Opposer’s license plates and this favors finding that there is a likelihood of confusion for these goods;

(iii) Applicant’s “jewelry; pins being jewelry” are related to Opposer’s key chains, and this favors finding that there is a likelihood of confusion for these goods; and

(iv) Because Opposer did not introduce any evidence or make any arguments regarding Applicant’s “stickers,” Opposer failed to meet its burden of proving that Applicant’s stickers are related to any of Opposer’s goods. Therefore, the lack of

evidence supports finding that stickers are not related to any of Opposer's goods and favors a finding that there is no likelihood of confusion with respect to stickers.

B. Established, likely-to-continue channels of trade and classes of consumers.

Because Applicant's clothing is in part identical to Opposer's clothing, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd mem.* (No. 18-2236) (Fed. Cir. September 13, 2019) ("Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same."); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

With respect to the Classes 12 and 14 goods, Grant Sawyer testified as follows:

13. Opposer's METAL branded goods are sold through internet websites, retail stores, trade shows, and special events, including but not limited to music events such as metal concerts.

14. Opposer's METAL branded goods are promoted through internet websites, enewsletters, television commercials, magazines, trade shows, and special events, including but not limited to sporting events (including but not limited to college football, mixed martial arts, and

racecar driving events) and music events (including but not limited to metal concerts).²⁴

Likewise, Applicant stated that she “[i]ntend[s] to perform internet and display advertising.”²⁵ She intends to offer her goods for sale through the “internet, community events, and musical events,”²⁶ “self-managed website, Amazon, and booths at musical events and community fairs.”²⁷ Applicant intends to sell her products to “all ages, genders, and socioeconomic groups with a focus on those who enjoy heavy metal musical events.”²⁸

Thus, both parties sell or intend to sell their products at music events with an emphasis on heavy metal concerts. Further, because there are no restrictions or limitations as to channels of trade or classes of consumers in Applicant’s description of goods, we must presume that Applicant’s goods are offered in all channels of trade that would be normal for such goods, and that they would be purchased by all potential customers, including Opposer’s. *See Viterra*, 101 USPQ2d at 1908 (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

²⁴ Sawyer Testimony Decl. (16 TTABVUE 5).

²⁵ Applicant’s response to Opposer’s interrogatory No. 6 (13 TTABVUE 46-47).

²⁶ Applicant’s response to Opposer’s interrogatory No. 7 (13 TTABVUE 47).

²⁷ Applicant’s response to Opposer’s interrogatory No. 8 (13 TTABVUE 47).

²⁸ Applicant’s response to Opposer’s interrogatory No. 9 (13 TTABVUE 47).

We find that the goods of the parties in Classes 12 and 14 are offered in some of the same channels of trade and to some of the same classes of consumers and, therefore, the third *DuPont* factor favors a finding that there is a likelihood of confusion.

C. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “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); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). In comparing the marks, we are mindful that “[t]he 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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); see also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons*

Rests. Inc. v. Morrison Inc., 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). Because the goods at issue are clothing and other general consumer products, the average customer is an ordinary consumer.

Applicant's mark is I'M METAL and Opposer's mark is METAL. The marks are similar in appearance, sound, connotation and commercial impression. With respect to connotation and commercial impression, the marks mean and engender a relationship with heavy metal music. Applicant's addition of the term I'M before METAL does not distinguish the marks because I'M (the contraction I AM) reinforces the relationship with the word METAL because the mark means the individual making the statement is METAL and thus, highlighting an association with heavy metal music.

We find that Applicant's mark I'M METAL is similar to Opposer's mark METAL in terms of appearance, sound, connotation and commercial impression.

D. The conditions under which sales are made.

Applicant's description of goods include novelty license plate frames, jewelry, pins being jewelry, stickers, bandanas, belts for clothing, sweatshirts, t-shirts, graphic t-shirts, hooded sweatshirts, infant and toddler one piece clothing, short-sleeved or

long-sleeved t-shirts. Opposer's goods are key chains, license plates, ski jackets, snowboard jackets, jeans and shirts.

Grant Sawyer testified, "Opposer's products are relatively inexpensive. The buyers of Opposer's products sold under or in connection with the METAL mark tend to be impulse buyers, often purchasing said products in retail stores or at special events, including but not limited to musical events."²⁹ Applicant stated that she intends to sell her product to "[a]ll ages, genders, and socioeconomic groups with a focus on those who enjoy heavy metal musical events."³⁰

Because Applicant's description of goods and Opposer's description of goods in its registration for clothing, in Class 25, do not include any limitations or restrictions regarding a particular price point, channel of trade, or class of consumer, we may not resort to extrinsic evidence to restrict the prices of Applicant's goods or Opposer's clothing. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Further, we must treat Applicant's goods and Opposer's clothing as including inexpensive as well as more costly products and, therefore, presume that purchasers for these products include ordinary consumers who may buy them on impulse. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014) (recognizing Board precedent requiring

²⁹ Sawyer Testimony Decl. ¶6 (16 TTABVUE 3).

³⁰ Applicant's Response to Opposer's Interrogatory No. 9 (13 TTABVUE 47).

consideration of the “least sophisticated consumer in the class”). *See also In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that all purchasers of wine may not be discriminating because while some may have preferred brands, “there are just as likely to be purchasers who delight in trying new taste treats.”).

Further, with respect to Opposer’s license plates, Opposer’s Facebook entry displayed above lists the price of Opposer’s license plate as \$15, including a free key chain, and Opposer’s website advertises the sale of key chains for \$5. Accordingly, Opposer’s license plates and key chains are inexpensive products that may be bought on impulse, rather than after careful study.

We find that the conditions under which sales are made weighs in favor of finding that there is a likelihood of confusion.

E. Conclusion

With respect to clothing, in Class 25, because the marks are similar, the goods are in part identical, the presumption that the goods are offered in the same channels of trade and to the same classes of consumers, and that the consumers do not exercise a high degree of care when making their purchasing decisions, we find that Applicant’s I’M METAL for “Bandanas; Belts for clothing; Sweatshirts; T-shirts; Graphic T-shirts; Hooded sweatshirts; Infant and toddler one piece clothing; Short-sleeved or long-sleeved t-shirts” is likely to cause confusion with Opposer’s registered mark METAL for “clothing, namely, ski jackets and snowboard jackets; clothing, namely, jeans and shirts.”

With respect to “novelty license plate frames,” in Class 12, because the marks are similar, the goods are related and are offered in the same channels of trade to the same class of consumers, we find that Applicant’s mark I’M METAL for “novelty license plate frames” is likely to cause confusion with Opposer’s mark METAL for “license plates.”

With respect to “jewelry; pins being jewelry,” in Class 14, because the marks are similar, the goods are related and are offered in the same channels of trade to the same classes of consumer, and the consumers do not exercise a high degree of care when making their purchasing decisions, we find that Applicant’s mark I’M METAL for those products is likely to cause confusion with Opposer’s previously used mark METAL for license plates and key chains.

Finally, with respect to Applicant’s “stickers,” in Class 16, because there is no evidence regarding the relationship between Opposer’s goods, channels of trade, classes of consumers, and conditions under which sales are made, we find that Opposer failed to meet its burden of proof and, therefore, we find that Applicant’s “stickers” are not likely to cause confusion with Opposer’s mark METAL.

Decision: The opposition is sustained as to the goods in Classes 12, 14 and 25.

The opposition is dismissed as to the goods in Class 16.