

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: June 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Alfwear, Inc.*  
*v.*  
*IBKUL UBHOT Ltd.*  
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Opposition No. 91233985  
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Trent Baker of Baker & Associates PLLC,  
for Alfwear, Inc.

Darren J. Quinn of Law Offices of Darren J. Quinn,  
for IBKUL UBHOT Ltd.

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Before Zervas, Bergsman and Greenbaum,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

IBKUL UBHOT Ltd. (“Applicant”) seeks registration on the Principal Register of

the mark IBKÜL, stylized and displayed as , for

Clothing and activewear, namely, vests, jackets, shirts,  
tops, bottoms, hats, headbands, in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87188136 was filed on September 29, 2016, based upon Applicant’s 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). The application includes a description of the mark: “The mark consists of the word ‘IBKUL’ in capital letters with an umlaut over the letter ‘U’, and

Alfwear, Inc. (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s registrations for the marks KUHL, KÜHL and KUUL, for clothing, lip balm, bottled water and fabrics:

1. KUHL (stylized and displayed as ) , for “rugged outdoor clothing, namely, jackets, shirts, pants, shorts, T-shirts, and hats” in International Class 25;<sup>2</sup>
2. KÜHL (in standard characters) for “belts; bottoms; hats; jackets; pants; shirts; shorts; tops” in International Class 25;<sup>3</sup>
3. KUHL (in standard characters) for “belts; bottoms; hats; jackets; pants; shirts; shorts; tops; fabric sold as an integral component of finished clothing, namely, belts, bottoms, hats, jackets, pants, shirts, shorts and tops” in International Class 25;<sup>4</sup> and

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with the letters ‘IB’ and the umlaut in the color black and the letters ‘KUL’ in the color blue”; a color claim: “The colors black and blue are claimed as a feature of the mark”; and a translation statement: “The wording ‘IBKÜL has no meaning in a foreign language.”

<sup>2</sup> Reg. No. 1990375 issued on July 30, 1996; second renewal accepted. The registration also identifies “bottled spring water” in International Class 32, and includes the following translation statement: “The English translation of the mark is ‘cool.’”

<sup>3</sup> Reg. No. 3916866 issued on February 8, 2011; Section 8 and 15 combined declaration accepted and acknowledged. The registration includes the following translation statement: “The English translation of ‘KÜHL’ in the mark is ‘COOL.’”

<sup>4</sup> Reg. No. 4441177 issued on November 26, 2013; Section 8 declaration accepted, Section 15 declaration pending. The registration also identifies “lip balm” in International Class 3 and “bottled water” in International Class 32, and includes the following translation statement: “The English translation of ‘KÜHL’ in the mark is ‘COOL.’”

4. KUUL (in standard characters) for “belts; bottoms; hats; jackets; pants; shirts; shorts; tops” in International Class 25.<sup>5</sup>

As a second ground for opposition, Opposer asserts that Applicant’s mark is likely to dilute the distinctiveness of Opposer’s famous marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

In its Amended Answer (7 TTABVUE),<sup>6</sup> Applicant denies the salient allegations and asserts various affirmative defenses, of which only two were deemed viable by the Board.<sup>7</sup> See the discussion below.

The opposition is fully briefed.

## I. Preliminary Issues

### A. Applicant’s Proposed Alternative Section 18 Amendment to the Application and Purported “Counterclaims”

The Board, through its March 16, 2018 order (12 TTABVUE), sua sponte struck Applicant’s numerous other putative affirmative defenses for various reasons, and explained in detail the differences between a Section 18 affirmative defense pertaining to Applicant’s application, and proposed restrictions to the identifications of goods in Opposer’s pleaded registrations, because Applicant had conflated the two procedures. The Board’s explanation included an acknowledgement that “[i]t is

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<sup>5</sup> Reg. No. 4777532 issued on July 21, 2015, and also identifies “textile fabrics for the manufacture of clothing” in International Class 24.

<sup>6</sup> References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page or paragraph references, if applicable.

<sup>7</sup> 12 TTABVUE.

proper for Applicant, in its answer, to alternatively offer to amend the identification of goods in its application,” but added, “Applicant also should file a motion with the Board in order to bring the matter to the Board’s attention for consideration at trial.” (Internal citations omitted.) *Id.* at 5, n.2. The Board strongly prefers applicants to raise Section 18 affirmative defenses via motion, but such is not required. Thus, although Applicant did not follow the Board’s strong suggestion to file a motion, we consider the proposed alternative Section 18 amendment to the identification of Applicant’s goods to “specialty activewear for golf, tennis and English riding equestrian sports, namely shirts, tops, bottoms and headbands,” as set out in as Affirmative Defense No. 14 in Applicant’s Amended Answer. 7 TTABVUE 9 ¶ 14.

We do not consider any additional amendments to the identification of Applicant’s goods, proposed for the first time in the Testimony Declaration of Applicant’s President, Jamie Handler (35 TTABVUE 15 ¶ 27 (“Applicant IBKUL’s reference to ‘jackets’ in its trademark application can be clarified/changed to ‘coverups’”) and ¶ 28 (“Applicant IBKUL’s reference to ‘headbands’ and ‘hats’ in its trademark application can be deleted”)). The additional amendments are not part of the proposed alternative Section 18 amendment set forth in Affirmative Defense 14. Moreover, Opposer has objected to the additional amendments on grounds that it is procedurally improper to propose amendments to an application through a witness declaration (which is correct), and Applicant did not respond to this objection. 46 TTABVUE 65; 49 TTABVUE 29. Thus, we find that the parties have not tried by implied consent the additional amendments. *See Fed. R. Civ. P. 15.*

The March 16, 2018 Order stressed that unlike the proposed alternative Section 18 amendment to Applicant's application, Applicant must raise any proposed restrictions to Opposer's pleaded registrations by counterclaims. 12 TTABVUE 6-8. The Board allowed Applicant time to amend its pleadings to file counterclaims against Opposer's pleaded registrations, and allowed Opposer time to file an answer to the counterclaims. 12 TTABVUE 15-16.

Although Applicant filed a document titled "Counterclaim" (13 TTABVUE), and Opposer filed an answer thereto (14 TTABVUE), Applicant did not submit the requisite filing fees for the "counterclaims" and the Board did not institute the "counterclaims" or issue a new trial and briefing schedule accounting for them. In its Brief (46 TTABVUE 14) and Rebuttal Brief (49 TTABVUE 21-25), Opposer objects to the "counterclaims" for other reasons, making it clear that any proposed restrictions set out in the "counterclaims" were not tried by implied consent. *See* Fed. R. Civ. P. 15. We therefore do not consider the "counterclaims."

#### B. Opposer's Alleged Family Marks

Opposer alleges that it has a "KÜHL family of marks" consisting of KÜHL, KUHL and KUUL, and that Applicant's mark is likely to cause confusion with and dilute that family. The Federal Circuit, our primary reviewing court, defines a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a

family. There must be a recognition among the purchasing public that the common origin of the goods ....

\* \* \*

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). The trademark owner creates a family of marks through use, not registration. See *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419, 420-21 (CCPA 1965) (ownership and registration of a number of marks containing a common feature is not sufficient to create a family of marks); *Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160, 162 (TTAB 1983) (“Ownership of two registrations containing a common word is not sufficient per se to create the exclusivity under the ‘family of marks’ doctrine.”).

Opposer uses the KÜHL mark on its identified products, its website, and its various social media accounts, and Opposer uses the name KUHL to promote KÜHL products on social media and as part of its web address. But there is no evidence that Opposer uses KUHL on any products, and the use of KÜHL and KUHL together is sporadic at best. There is no testimony or evidence showing the use of KUUL. Nathan Fay, Opposer’s CEO, and Melanie Webb, Opposer’s PR Manager/Brand Manager and Rule 30(b)(6) witness, testified about Opposer’s use of the KÜHL mark. Mr. Fay did not refer to KUHL or KUUL. When asked about the KUHL mark, Ms. Webb testified that she “can’t think of a product that does not have the umlauts right now.” 36

TTABVUE 24. And when asked about the KUUL mark, she testified that “I’ve not seen that one.” 36 TTABVUE 25. The evidence reflects that Opposer uses both KÜHL and KUHL, but does not demonstrate that Opposer has a family of marks. *See Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984) (“That Colony has a number of marks combining HOB0 with another word does not establish any rights of Colony in the word HOB0 as a ‘family’ name.”); *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 66 (TTAB 1983) (opposer “had a ‘couple’ of marks, not a ‘family.’”). In other words, Opposer is using the KÜHL and KUHL marks, i.e., with and without an umlaut, without promoting a KÜHL (or KUHL) family of marks. *Cf.*, *e.g., Int’l Diagnostic Tech., Inc. v. Miles Labs., Inc.*, 746 F.2d 798, 223 USPQ 977 (Fed. Cir. 1984) (Opposer proved its ownership of a family of marks ending with a “Stix” suffix comprising N-MULTISTIX-C, N-MULTISIX SG, CHEKSTIX, and C-STIX); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) (Opposer proved its ownership of a “fish” family of marks comprising SAILFISH SPORTABOUT, ALCORT SUNFISH, ALCORT CATFISH, and FLYING FISH); *Motorola, Inc. v. Griffiths Elecs., Inc.*, 317 F.2d 397, 137 USPQ 551 (CCPA 1963) (Opposer proved its ownership of a family of “Golden” marks comprising GOLDEN VOICE, GOLDEN VIEW, GOLDEN BEAM, GOLDEN HEART, GOLDEN M, and GOLDEN SATELLITE).

We find that Opposer failed to prove that it has a family of marks.

## II. Evidentiary Issues

Applicant objects to all, or nearly all, of Opposer's testimony and documentary evidence (48 TTABVUE 10-14), and Opposer objects to much of Applicant's testimony (46 TTABVUE 61-69).<sup>8</sup>

### A. Applicant's Objections to Testimony Declaration of Nathan Fay

We overrule Applicant's various objections to the Testimony Declaration of Nathan Fay, Opposer's CEO ("Fay Test. Dec."), for the following reasons:

- 1) Applicant's objection that Opposer did not list Mr. Fay in Opposer's Initial Disclosures or any supplement thereto is untimely and thus has been waived. Opposer listed Mr. Fay as a potential trial witness in Opposer's Pretrial Disclosures and submitted Mr. Fay's Testimony and Rebuttal Testimony Declarations during its assigned testimony periods. If Applicant believed it was prejudiced because it did not take Mr. Fay's discovery deposition or seek discovery from Opposer about Mr. Fay during the discovery period, Applicant could and should have filed an appropriate pre-trial motion so the matter could have been resolved in a timely manner. Applicant also had the opportunity to request oral cross-examination of Mr.

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<sup>8</sup> We do not address Applicant's objections to the Testimony Declaration of Lori Gildea, the Rebuttal Testimony Declarations of Stephanie Chase and Mike Osten, Exhibit 62 to the Rebuttal Testimony Declaration of Nathan Fay, or Opposer's objection to Exhibit 4 to the Testimony Declaration of Jamie Handler, because the testimony and evidence is not outcome determinative, and because we have not considered that testimony or evidence in reaching our decision on the merits of this proceeding.

Fay, or to file a motion to strike his Testimony Declaration promptly after Opposer filed it, but Applicant did not do so.

- 2) Applicant's objection that Mr. Fay's testimony contradicts the testimony of Melanie Webb, Opposer's Rule 30(b)(6) witness, goes to the weight of the evidence rather than its admissibility. The objection also is vague because Applicant does not specify which portions of the testimony are contradictory.
- 3) Applicant's objection that Opposer "[i]mproperly switches Opposer's designated person most knowledgeable (Melanie Webb) with Nathan Fay" is not a basis for objection of a testimony witness. Rule 30(b)(6) provides a basis only for taking discovery depositions of an adverse party; the Trademark Rules of Practice do not provide for noticing or taking a testimony deposition of an adverse party under Rule 30(b)(6). *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). To the extent this objection is a variation of the first objection (failure to list Mr. Fay in Opposer's Initial Disclosures), it is untimely for the reasons discussed above.
- 4) Applicant's objection that Mr. Fay's testimony includes information not disclosed during discovery is vague. As with the second objection, Applicant does not specify the information that had not been disclosed, and does not identify the discovery request(s) to which the information is allegedly responsive.

- 5) Likewise, Applicant's objection that Mr. Fay lacks personal knowledge is vague because it is not tied to any specific testimony. Moreover, Mr. Fay expressly states that he has personal knowledge of the facts contained in his declaration. Fay Test. Dec., 25 TTABVUE 5 ¶ 5.
- 6) Applicant also objects to Mr. Fay's Rebuttal Testimony Declaration because his testimony is not proper rebuttal testimony. But, as with many of Applicant's objections, Applicant did not specify the purportedly objectionable testimony and, as Opposer points out, the testimony directly responds to the testimony of Applicant's witnesses, Jamie Handler.

#### B. Applicant's Objections to Opposer's Notices of Reliance

Applicant's objection to Opposer's First Notice of Reliance (Opposer's pleaded registrations) is as follows: "Presumption of validity rebutted by Opposer's failure to produce evidence sufficient to show use of marks for each good prior to application and/or use within last three (3) years sufficient to show no abandonment." 48 TTABVUE 10. Absent a counterclaim to cancel the pleaded registrations, Opposer's pleaded marks are entitled to a presumption of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). As discussed above, there are no counterclaims in this proceeding. The objection is overruled.

We overrule Applicant's relevancy objections to Opposer's Second, Third and Fourth Notices of Reliance because the objections lack detail (i.e., Applicant refers to "relevance" and does not explain anything more). Moreover, "the Board is capable of weighing the relevance and strength or weakness of the objected to ... evidence,

including any limitations.” *See RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018). We overrule Applicant’s related objection that the evidence submitted under Opposer’s Fourth Notice of Reliance does not independently establish that Opposer’s KÜHL mark is famous. As Opposer correctly points out, “evidence is, of course, still relevant even if it does not independently establish a fact at issue. All it must do is make the fact more likely to be true.” 49 TTABVUE 31. *See Fed. R. Evid.* 401.

Applicant objects to Opposer’s Fifth Notice of Reliance on grounds that the Opposer did not submit Applicant’s supplemental responses to certain Interrogatories. However, Applicant did not explain why consideration of the omitted responses would avoid an unfair interpretation of the responses made of record by Opposer, nor did Applicant make them of record under notice of reliance during its own testimony period. *See Trademark Rule 2.120(k)(5)*, 37 C.F.R. § 2.120(k)(5). The objection is overruled.

#### C. Opposer’s Objections to Testimony Declaration of Jamie Handler

Opposer objects to the Testimony Declaration of Jamie Handler, Applicant’s President, submitted as a “Percipient Expert,” and asks the Board to strike certain paragraphs thereof because the witness is not qualified as an expert, and on a variety of other grounds, including hearsay, lack of personal knowledge, speculation and irrelevance.<sup>9</sup> Applicant did not address the objections.

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<sup>9</sup> In light of our determinations above about the “counterclaims” and Applicant’s proposed additional amendments to its identification of goods via paragraphs 27 and 28 of the Testimony Declaration of Jamie Handler, Opposer’s related objections are moot.

“[T]he Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing.” *Bd. of Regents v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014) (citations omitted). We therefore overrule the objections but will weigh the relevance and strength or weakness of the objected-to testimony, including any inherent limitations therein. For example, we have disregarded any opinion testimony regarding the conclusions of law in this case. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

As for Applicant’s presentation of Jamie Handler as a “Peripient Expert,” we need not treat the witness as an expert, but as a fact witness with experience in the apparel industry. However, “[w]e have also weighed the probative value of [the] testimony against any potential bias,” *Alcatraz Media*, 107 USPQ2d at 1755, including taking into account the witness’ potential bias based on their position as President of Applicant. *See Tao Licensing, LLC, v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017).

### III. 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 involved application. The record also includes:

A. Opposer's Testimony and Evidence

- Testimony Declaration of Nathan Fay ("Fay Dec."), Opposer's CEO, with exhibits (25-30 TTABVUE/Confidential Version 31-21 TTABVUE);
- First Notice of Reliance on TSDR printouts showing the current status and title of Opposer's pleaded registrations (20 TTABVUE);
- Second Notice of Reliance on TSDR printouts of third-party use-based registrations covering both outdoor clothing items and golf, tennis or equestrian clothing (21 TTABVUE);
- Third Notice of Reliance on printouts from third-party websites that offer for sale both outdoor clothing items and golf, tennis or equestrian clothing (22 TTABVUE);
- Fourth Notice of Reliance on printouts from third-party websites of information related to Opposer's distributors, the "fame" of Opposer's marks, and dictionary definitions of "activewear" and "sportswear" (23 TTABVUE);  
and
- Fifth Notice of Reliance on Applicant's Responses to Opposer's First and Second Sets of Interrogatories and Applicant's Responses to Opposer's First Set of Requests for Admissions (24 TABVUE).<sup>10</sup>

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<sup>10</sup> Applicant's responses include admissions and denials. Requests that have been denied have no probative value and, in fact, the rules do not provide for submission of such denials by Notice of Reliance. *See* Trademark Rule 2.120(k)(3)(i), 15 U.S.C. § 2.120(k)(3)(1); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 (TTAB 2008). Thus, we have only considered the admissions.

B. Applicant's Testimony and Evidence

- Testimony Declaration of "Percipient Expert" Jamie Handler ("Handler Dec."), with Exhibits (35 TTABVUE);
- Excerpts of Rule 30(b)(6) Deposition of Opposer through Melanie Webb with Exhibits (36 TTABVUE).
- Notice of Reliance on TESS printouts and registration certificates of third-party registrations that begin with KUL, KUHL, KOOL or COOL (37 TTABVUE); and
- Notice of Reliance on TESS printouts and registrations certificates of third-party registrations that include KUL, KOOL or COOL (38 TTABVUE).

C. Opposer's Rebuttal Testimony and Evidence

- Testimony Declaration of Lori Gildea, an individual ("Gildea Dec.") (41 TTABVUE); and Rebuttal Testimony Declarations of Nathan Fay ("Fay Reb. Dec.") with Exhibits (44 TTABVUE/Confidential Version 45 TTABVUE), and Opposer's employees Stephanie Chase ("Chase Reb. Dec.") (42 TTABVUE) and Mike Osten ("Osten Dec.") (43 TTABVUE).

IV. Standing

Opposer must prove its standing by showing a real interest in the outcome of the proceeding and a reasonable basis for believing that it would suffer damage if the mark is registered. *See* 15 U.S.C. § 1063; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Opposer has done so by properly introducing into evidence current status and title copies of its pleaded

registrations. 20 TTABVUE 6-68 (Exh. 1-4 to Opposer's First Notice of Reliance). *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

## V. Priority

Because Opposer properly made its pleaded registrations of record and, as discussed above, Applicant did not file a counterclaim against them, priority is not an issue as to the marks and goods covered by the registrations. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *see also Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) ("prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation"); *Itell Corp. v. Ainslie*, 8 USPQ2d 1168, 1169 (TTAB 1988) ("because of the existence of opposer's valid and subsisting registration, it need not prove prior use as to the services recited therein").

## VI. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as "DuPont factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We must consider each DuPont factor for which there is evidence and argument. *See In re Guild Mortg.*

Co., 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (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.”). These factors and others are discussed below.

Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. Opposer may establish likelihood of confusion as to a class of goods or services in an opposed application by showing the relatedness of its own goods or services to any item within that class of goods or services. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

In our likelihood of confusion analysis, we focus, as Opposer did in its brief, on Opposer’s pleaded Reg. No. 3916866 (KÜHL in standard characters). We consider this mark to be the most relevant of Opposer’s pleaded registrations for our *DuPont* analysis because it most closely resembles Applicant’s IBKÜL mark (displayed as **IBKÜL**) due to the umlaut over the letter “U” in both marks. Consequently, we do not consider the marks in the three other pleaded registrations, which include additional visual differences or are limited to particular depictions. *See, e.g., Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Relatedness of the Goods and Channels of Trade

Under the second and third *DuPont* factors, we base our evaluation on the goods as they are identified in the application and Opposer's registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

1. Analysis Based on Goods Identified in Registration and Application

The application and registration include identical bottoms, hats, jackets, shirts and tops in International Class 25. The "pants" and "shorts" identified in the registration are encompassed by the broadly worded "bottoms" identified in the application, and thus are legally identical to them. *See, e.g., 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.'"); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Given the in-part identity of the goods as described in the application and registration, we must presume that the channels of trade and classes of purchasers for these goods are the same. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd*, Slip Op. No. 18-2236 (Fed. Cir. Sept. 13, 2019) (mem) (identical services are presumed to travel in the same channels of trade to the same class of purchasers); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed.

Cir. 2012) (legally identical goods are presumed to travel in same trade channels to same class of purchasers); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014).

Moreover, we must make our determination regarding the similarity between the goods based on the goods as they are identified in the application and pleaded registration, respectively, not on any extrinsic evidence of actual use. *Stone Lion*, 110 USPQ2d at 1162. In other words, an applicant may not restrict the scope of the goods covered in its application or the pleaded registration by argument or extrinsic evidence. *Octocom Sys., Inc. v. Hous. 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 the sales of goods are directed.”). We therefore cannot limit or restrict the goods identified in the application or pleaded registration by place of manufacture, method of sale, or any other fact that the parties do not refer to in the descriptions of goods.

2. Analysis Based on Goods Identified in Registration and Proposed Alternative Section 18 Amendment to Application

We also consider the proposed alternative Section 18 amendment to Applicant’s identification of goods, which would limit Applicant’s goods to “specialty activewear for golf, tennis and English riding equestrian sports, namely shirts, tops, bottoms and headbands.” Such a restriction, however, does not aid Applicant because the resulting

narrower identification of goods would still be subsumed by, and thus legally identical to, the broadly worded identification of goods in the registration, which includes “shirts,” “tops” and “bottoms.” *See, e.g., Hughes Furniture*, 114 USPQ2d at 1137. Moreover, without parallel restrictions on Opposer’s goods, the proposed alternative Section 18 amendment to Applicant’s goods would not differentiate the nature and channels of trade of the goods. In other words, even if we were to accept Applicant’s proposed alternative Section 18 amendment to its goods, we cannot limit or restrict Opposer’s goods which, as identified, would remain legally identical to, and thus would be presumed to still move in the same channels of trade as, Applicant’s restricted goods. Consequently, the proposed alternative Section 18 amendment is futile and will be given no further consideration.<sup>11</sup> *Cf., Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825 (TTAB 2013) (successful use of Section 18 as an affirmative defense to a claim of likelihood of confusion in an opposition; amended applications allowed to proceed to registration).

These *DuPont* factors weigh heavily in favor of likelihood of confusion.

#### B. Conditions of Sale

Next, we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. “Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchasers of inexpensive items may

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<sup>11</sup> It is therefore unnecessary for us to consider Opposer’s voluminous evidence establishing that Opposer uses its KÜHL mark on the clothing items if they were restricted by Applicant’s proposed alternative Section 18 amendment.

tend to have the opposite effect.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691, 1695 (Fed. Cir. 2005). Again, because we are bound by the identifications of goods in the application and pleaded registration, and because neither identification is restricted as to price, quality, use or style, we must presume that Applicant’s goods and Opposer’s goods are marketed to all ordinary consumers of clothing, including the general public, and to all price points, qualities, uses or styles. It is commonly known that “shirts” and “tops” such as t-shirts and tank tops are relatively inexpensive items that may be purchased on impulse.<sup>12</sup> *See Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1640-41 (TTAB 2007) (“Given the relatively low cost and the nature of the goods, the parties’ clothing and fragrances may be subject to impulse purchase and frequent replacement. It has often been stated that purchasers of such products are held to a lesser standard of purchasing care and, thus, are more likely to be confused as to the source of the goods. *See, e.g., Specialty Brands, Inc.*, 748 F.2d 669, 223, USPQ2d 1281 (Fed. Cir. 1984).”). We find that some of the goods identified in the application and pleaded registration may be purchased on impulse without a high degree of purchaser care.

Accordingly, this factor favors a finding of a likelihood of confusion.

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<sup>12</sup> As noted supra, the application and pleaded registration identify “shirts” and “tops.” Such broad wording includes all types of shirts and tops, including t-shirts and tank tops. *See, e.g., Hughes Furniture*, 114 USPQ2d at 1137.

### C. Strength of Opposer's Mark<sup>13</sup>

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning.)”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India*, 80 USPQ2d at 1899.

#### 1. Inherent or Conceptual Strength

Opposer’s standard character mark KÜHL is registered on the Principal Register without a showing of acquired distinctiveness, and therefore is presumed to be inherently distinctive under Section 7(b) of the Trademark Act. *See Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Although there is no correct pronunciation of a mark that is not a recognized word, *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014); *Viterra*, 10 USPQ2d at 1912, Mr. Fay’s uncontradicted testimony persuades us that KÜHL is likely to be pronounced as “cool.” 25 TTABVUE 6 ¶ 9

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<sup>13</sup> As to *DuPont* factors eleven and twelve, Opposer summarily states that “[t]he extent of potential confusion here is substantial,” and that it has “a right to exclude others from using its mark.” Opp. Br., 46 TTABVUE 52-53. We consider these arguments, including any enforcement actions by Opposer, as part of our analysis on the purported “fame” of Opposer’s KÜHL mark. In so doing, we keep in mind that the eleventh *DuPont* factor is “[t]he extent to which **applicant** has a right to exclude others from use of its mark on its goods.” (Emphasis supplied.).

(“The company’s name is pronounced ‘cool.’”); *id.* at 31 ¶ 91 (“KÜHL’s Marks are pronounced C-O-O-L.”). Consequently, consumers likely will associate KÜHL with both the ordinary adjective and the slang word “cool.” *See* discussion *infra*. The word “cool” is defined, *inter alia*, as an adjective meaning “feeling comfortably or moderately cold: **I’m perfectly cool, but open the window if you feel hot**” or “imparting a sensation of moderate coldness or comfortable freedom from heat: **a cool breeze,**” and as a slang term “used to express approval, admiration, etc.: **He got the job? Cool!**”<sup>14</sup> Accordingly, when KÜHL is used in connection with clothing, it is suggestive. Applicant’s extensive evidence of third-party registrations for clothing for marks that begin with or include COOL, KOOL or variants provide further support for this finding.<sup>15</sup> 37 and 38 TTABVUE (Applicant’s Second and Third Notices of Reliance).<sup>16</sup>

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<sup>14</sup> Dictionary.com based on the RANDOM HOUSE DICTIONARY (2020). 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). Original emphasis in italics. We do so here.

<sup>15</sup> Applicant has not submitted any evidence of third-party use of the terms COOL, KOOL, KUL, KUHL or KÜHL, but rather focuses its argument on the effect of the third-party registrations. Applicant therefore has not invoked the sixth *DuPont* factor, i.e., the “number and nature of similar marks in use on similar goods.” *See In re Guild Mortg. Co.*, 2020 USPQ2d 120829 at \*3 fn.7 (TTAB 2020). A registration is not evidence of use of a mark. *Hilson Research Inc. v. Soc. For Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993).

<sup>16</sup> We have considered all of the third-party registrations, including the few that are not based on use of the mark in commerce. Even where the record lacks proof of actual third-party use and the extent of third-party use, third-party registration evidence may show that a term carries a descriptive or suggestive connotation in the relevant industry and therefore may be considered somewhat weak. *Juice Generation, Inc. v. GS Enters LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

Consequently, although KÜHL is inherently distinctive, it is not a conceptually strong mark.

2. Commercial Strength or Fame of Opposer's Mark

As noted above, Opposer contends that its KÜHL mark is a famous mark. Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India*, 80 USPQ2d at 1899. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use.

A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

The commercial strength or fame of a mark is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (“The TTAB applied a legally incorrect standard in applying an all-or-nothing measure of ‘fame,’ more akin to dilution analysis.”). Rather, likelihood of confusion fame “varies along a

spectrum from very strong to very weak.” *Palm Bay*, 73 USPQ2d at 1694 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)). Famous marks “enjoy wide latitude of legal protection” and are “more attractive as targets for would-be copyists.” *Id.* Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Id.*

Commercial strength or fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *see also Bose*, 63 USPQ2d at 1308 (recognizing indirect evidence as appropriate proof of strength).

Opposer introduced the following evidence to prove that KÜHL is a famous mark:

1. Opposer has used the KÜHL mark since 1993. Fay Test. Dec., 25 TTABVUE 7, ¶ 14. While long use of a mark is indicative of commercial success, it is not conclusive evidence of fame. *Cf., e.g., In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (applicant’s use of the product designs ranging from seven to seventeen years is insufficient to bestow acquired distinctiveness).

2. Opposer has used the KÜHL mark on 300 styles of outdoor wear per season. Fay Test. Dec., 25 TTABVUE 8, ¶ 28.
3. Opposer's confidential annual U.S. sales figures for 2013-2018 show a steady increase each year and are in the millions of dollars. Fay Test. Dec. (Confidential), 31 TTABVUE 30 ¶ 84. Opposer also provided a single confidential figure representing the "units of product" shipped from 2013-2017 which are in the millions. *Id.* at 30, ¶ 86. However, Opposer has not provided any context for the figures, so we cannot measure them against other brands. Also, we do not know what percentage of sales or "units of product" are attributable to Opposer's KÜHL branded clothing versus the other products identified in the pleaded registrations (e.g., fabrics, lip balm, bottles of water), how many "units of product," and particularly KÜHL branded clothing, were sold each year, how many different customers purchased Opposer's KÜHL branded clothing per year, or what percentage of the "units of product" were sold in the U.S.
4. Opposer also provided a single confidential figure in the millions representing its total expenditures on marketing/sponsorships since July 2010, and a single confidential figure over a million representing its total expenditures on fees and licenses related to trade shows since July 2010. *Id.* at 32, ¶ 100. In addition to not providing these figures by year or by product type, or specifying whether and to what extent the figures include foreign expenditures, Opposer has provided no context for either figure, so

we cannot measure them against other brands. Further, when spread out over nine years, the lump sum figures are far less impressive than at first glance, and not sufficiently notable as to corroborate Opposer's claim that its KÜHL mark is famous.

5. One of Opposer's promotional efforts is sponsoring a competitive bicycle team that, from 2011 through 2013, competed in California, Idaho, Pennsylvania, Michigan, Wisconsin, Illinois, Colorado, Kentucky, Ohio, Iowa and Utah. *Fay Test. Dec.*, 25 TTABVUE 37 ¶¶ 128 and 131, and 53 ¶ 223. The team wore jerseys that displayed the KÜHL trademark. *Id.* at 37 ¶ 130. Since 2010, Opposer has been an official sponsor of the Larry H. Miller Tour of Utah and has supplied uniforms to competitors. *Id.* at 35 ¶ 119, and 54 ¶ 225. In 2016, that tour had 400,000 spectators, more than 28 hours of national television coverage, and almost 700,000 webpage visits. *Id.* at 54 ¶ 225. Opposer also has sponsored other athletic competitions, such as the Oakley Rodeo in Utah, which sold approximately 30,000 tickets over four days, and the National Park Race Series, which has approximately 37,000 runners and more than 1.5 million unique annual website visits. *Id.* at 53 ¶ 222, and 54 ¶ 227.
6. Opposer's KÜHL branded products are distributed throughout the United States by over 1,000 retailers at about 3,500 locations, including REI, Scheels, and Eastern Mountain Sports, as well as online retailers. *Id.* at 27-28 ¶¶ 60, 62, 63, 65, 68, 70 and 72.

7. Opposer provided the confidential total number of page views, sessions and new visitors to its website from January 1, 2013 to April 23, 2018, but did not further break down what appear to be impressive figures. 31 TTABVUE 38 ¶ 137. Nor has Opposer provided any context for the figures, so we cannot measure them against how many page views, sessions and new visitors its competitors might have received. Finally, the testimony does not indicate whether the number of user visits were from different individuals or multiple visits from the same individuals, or from individuals residing in countries other than the U.S.
8. Mr. Fay testified that “[a]s of February 2017, [Opposer] sends an email blast to 200,000 customers.” 25 TTABVUE 38 ¶ 141. Opposer provided the confidential total number of emails that recipients opened during the years 2013-2017. 31 TTABVUE 38 ¶ 141. While the number of emails that were opened appears to be a substantial figure, Opposer has not provided any further information regarding, e.g., the number of times Opposer sent an email blast each year, whether the blast was sent to the same 200,000 recipients each time, or a breakdown of the total number of emails that were opened per email blast vs. how many were deleted unopened.
9. Opposer has an active social media presence on Facebook, Instagram, Twitter and YouTube. For example, as of December 8, 2017, Opposer’s Facebook page had 49,000 “likes” and almost 49,000 followers (25 TTABVUE 42 ¶ 154); as of January 24, 2019, Opposer’s Instagram account

had 996 posts and approximately 62,000 followers (*id.* at 42 ¶ 147); and as of December 1, 2017, its YouTube channel had over 375,000 views (*id.* at 43 ¶ 161). Opposer has not provided any context for these figures, so we cannot measure them against other brands. We are simply without enough information to determine the degree to which Opposer’s Facebook “likes” and followers, Instagram followers, and YouTube views are significant.

10. Opposer and its founder have been the subject of four online news articles.

25 TTABVUE 48-49 ¶ 195, and 51 ¶ 209. They are listed below:

- a. “From Ski Bum to Ski Empire: Meet KÜHL founder Kevin Boyle and his amazing team,” was posted on UtahStories.com on December 14, 2016. The author writes that KÜHL is one of the most successful outdoor retail brands in the world and that it is the second largest independently-owned outdoor clothing company anywhere.
- b. “Kühl continues to grow strong from its original roots,” was posted on June 14, 2016 on GrassRootsOutdoors.com. The article is a profile about Opposer highlighting its status as an independently-owned company.
- c. “About Utah: Company founder has come a long way from living in a snow care,” was posted on July 17, 2016 on DesertNews.com. This is a profile about Mr. Boyle, Opposer’s founder. The author states that Opposer “is now one of the largest privately owned businesses in the outdoor industry.”

- d. “Marketplace: To elevate brand, Kühl turns to Main Street,” was posted on September 2, 2016 on ParkRecord.com. The article is a report regarding Opposer’s opening a retail store in Park City, Utah.

The statements regarding the success and renown of Opposer are not accepted as proven to be true. *See Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010) (news articles “are admissible only to show what has been printed, not the truth of what has been printed.”). While they are probative of the perceptions of the authors and of the impressions they create to readers, their probative value is quite limited because three of the four articles were published in what appear to be Utah-based publications as opposed to national publications, and there is no information or testimony about the circulation of any of the four publications. The articles therefore do not assist Opposer in demonstrating that Opposer’s mark is famous. If Opposer’s mark were famous, we would expect that there would be more than four articles in what appear to be local publications regarding Opposer and its KÜHL trademark.

11. Some of Opposer’s clothing products have been shown in a few magazines and other printed publications, in online reviews (including reviews in HuffPost, Backpacker Magazine Buyer’s Guide and Off Grid Magazine) and as part of social media giveaways. *Id.* at 52-53 ¶ 213-216 and 219. Opposer also promotes its KÜHL brand through influencers and some brand promotions. *Id.* at 52 ¶ 218. However, as with much of Opposer’s evidence, this evidence lacks context, such as the number of readers or viewers, and thus is not particularly probative of whether the KÜHL mark is famous.

12. Opposer's KÜHL branded products have been worn by celebrities appearing in national media. However, the examples of such use are merely photographs of celebrities engaged in various activities, and the KÜHL trademark is not highlighted in any way. In fact, one would only be aware of the KÜHL mark if one were aware it was there and looked for it. Nor is there any information as to what exposure the photographs received.<sup>17</sup> For example, a photograph from a New York Times article is reproduced below. A logo is displayed on the subject's sleeve on the reader's right, but the KÜHL mark is not visible.

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<sup>17</sup> One exception is the video of Bill Goldberg, at two-time world champion professional wrestler and actor, discussed in 25 TTABVUE 49 ¶¶ 197-199. Mr. Fay states: "According to YouTube, as of January 16, 2017, the video had over 1.7 million views."



13. Opposer maintains an active and ongoing enforcement program to protect its trademark rights. *Id.* at 55-56 ¶¶ 235-242.

While we have noted some shortcomings as to the probative value of the individual pieces of evidence, we must look at the evidence as a whole to determine whether Opposer has proven the fame of its mark. *Cf. West Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (in analyzing priority, “whether

a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.”).

Opposer is a successful 27 year old, independently-owned company specializing in a full line of outdoor wear sold through 1,000 retailers nationwide. However, Opposer’s commercial success does not equate to the fame of its mark. Because there is no context for Opposer’s advertising and sales figures, we cannot gauge the relative level of success or the degree of exposure the general public has had to the KÜHL trademark. *Cf. Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d, 1315, 128 USPQ2d 1686, 1689-92; *Bose*, 63 USPQ2d at 1309. The extent to which consumers have been exposed to Opposer’s clothing products, bottled water, lip balm, etc. vis a vis competitors’ products is unknown and, thus, it is not possible to determine the renown of Opposer’s mark. Ultimately, and considered as a whole, Opposer’s evidence establishes that the KÜHL trademark for clothing has achieved moderate commercial strength, but the evidence falls short of clearly establishing that the mark is famous. *See Leading Jewelers Guild*, 82 USPQ2d at 1904.

Given our findings that the KÜHL mark is not conceptually strong but has moderate commercial strength, we place the mark slightly on the stronger side of the spectrum, and accord it a somewhat broader scope of protection than would be applicable to a mark with less recognition. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734. This *DuPont* factor weighs slightly in favor of a finding of likelihood of

confusion. *Cf. L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1888 (TTAB 2008) (opposer’s mark held to be strong but not famous).

#### D. Similarity or Dissimilarity of the Marks

Next, we compare Applicant’s mark IBKÜL (displayed as **IBKÜL**) and Opposer’s mark KÜHL (in standard characters) “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d at 1746 (citation omitted). *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). “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quotation omitted).

Further, the marks “must be considered ... in light of the fallibility of memory ....” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted). We focus on the recollection of the average consumer – here, an ordinary consumer of clothing – who normally retains a general rather than a specific impression of trademarks. *See id.* at 1085; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). And we bear in mind that where,

as here, goods are identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Coach Servs.*, 101 USPQ2d at 1722 (quotation omitted).

Additionally, because Opposer’s KÜHL mark is in standard characters, it must be considered “regardless of font style, size, or color” *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011), including, for example, iterations that appear in black and blue with a black umlaut over the letter “U,” as in Applicant’s mark. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018).

The marks are similar in appearance because they share the letters “K,” “Ü” (with an umlaut) and “L,” in the same order. While Applicant’s mark begins with the letters “IB,” the term “KÜL” stands out as the most prominent portion of the mark because it appears in the color blue, and because it includes an umlaut over the letter “u,” which is not used in the ordinary English language.

Although there is no one correct pronunciation for a mark, especially where both marks have unusual spellings, we agree with Opposer’s CEO Nathan Fay that Opposer’s mark likely will be pronounced as “cool” (Fay. Test. Dec., 25 TTABVUE 31 ¶ 91), and with Applicant’s President Jamie Handler that Applicant’s mark likely will be pronounced as “I” “be” “cool” (Handler Test. Dec., 35 TTABVUE ¶ 17(b)). Any other possible pronunciation of the marks would likewise be extremely similar because the marks share the same three letters in the same order, and those letters collectively comprise a single syllable in each mark.

Because of the aforementioned similarities in appearance and sound, consumers are likely to perceive that the marks have similar meanings and engender similar commercial impressions (i.e., expressing approval or admiration).

We find that the marks are similar in their entireties as to their appearances, sound, connotation and commercial impression.

#### E. Conclusion as to Likelihood of Confusion

Having considered all the evidence and arguments bearing on the relevant *DuPont* factors, we conclude that Opposer has established, by a preponderance of the evidence, that when used on identical or legally identical clothing products that move through the same channels of trade to the same classes of consumers, Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion, mistake or deception. The commercial strength of Opposer's KÜHL mark provide further support for this finding. Further, our finding that Opposer's mark is not conceptually strong does not outweigh the other factors.

#### VII. Dilution

Given our determination above that Opposer has failed to prove the fame of its KÜHL mark for purposes of its likelihood of confusion claim, Opposer cannot show that its KÜHL mark is famous for dilution purposes and thus cannot meet its burden of proving dilution.<sup>18</sup> See *Palm Bay*, 73 USPQ2d at 1694; *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1610 (TTAB 2010) ("Fame for likelihood of confusion

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<sup>18</sup> We focus, as Opposer did in its brief, solely on the standard character KÜHL mark in Reg. No. 3916866. 46 TTABVUE 56-57.

and dilution is not the same. Fame for dilution requires a more stringent showing.”).

Opposer’s dilution claim is therefore dismissed.

**Decision:** The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.