

This Opinion is Not a
Precedent of the TTAB

Mailed: November 26, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Pure & Simple Concepts, Inc.

v.

I H W Management Limited DBA The Finchley Group

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Opposition No. 91234659
—

Thomas D. Rosenwein of Rosenwein Law Group
for Pure & Simple Concepts, Inc.

Arthur Sanft of Sanft Law
for I H W Management Limited DBA The Finchley Group.

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Before Bergsman, Lykos and Larkin,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On April 30, 2015, I H W Management Limited DBA The Finchley Group (“Applicant”) filed an application to register on the Principal Register the standard character mark BLUE INDUSTRY for

“Clothing, namely, pants, sweatpants, jeans, overalls, shirts, T-shirts, tank tops, blouses, jackets, blazers, vests, coats, rainwear, dresses, skirts, dress suits, t-shirts, sweatshirts, sweaters, pullovers, cardigans, shorts, belts, ties, gloves, scarves, shawls, bathing suits, sport bras, lingerie, socks and hosiery; Footwear; Headgear, namely, balaclavas, bandanas, beanies, berets, cagoules, caps, ear

muffs, hats, headbands, skull caps, toques, turbans and visors” in International Class 25.¹

Pure & Simple Concepts, Inc. (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), on the grounds of likelihood of confusion and likelihood of dilution by blurring based on Opposer’s previously used and registered family of INDUSTRY marks.² In the Notice of Opposition, Opposer pleaded ownership of the following eight registrations:

Registration No. 2118102 for the mark INDUSTRY BY WORK WEAR (typed form)³ (WORK WEAR disclaimed) on

¹ Application Serial No. 86615907, filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). As explained below, portions of the record have been designated confidential. With a few exceptions, the majority of citations to the record refer to the redacted, publicly available versions of each submission.

² Opposer, by failing to allege that any of its pleaded marks became famous prior to Applicant’s date of constructive use, failed to properly plead a claim of dilution by blurring. *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (dilution pleading legally insufficient where opposer failed to allege that its mark became famous before constructive use date of involved intent-to-use application). Nonetheless, because Opposer presented evidence regarding its dilution claim at trial, and because both parties argued this claim in their briefs, we deem the pleadings amended and Opposer’s dilution claim to be tried by implied consent under Fed. R. Civ. 15(b)(2), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a). *See Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-1721 (TTAB 2008); *Boise Cascade Corp. v. Cascade Coach Co.*, 168 USPQ 795, 797 (TTAB 1970) (“Generally speaking, there is an implied consent to contest an issue if there is no objection to the introduction of evidence on the unpleaded issue, as long as the adverse party was fairly informed that the evidence went to the unpleaded issue.”).

³ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings; the preferred nomenclature was changed to conform to the Madrid Protocol. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 807.03(i) (Oct. 2018).

the Principal Register for “all men’s, women’s, boys’ and girls’ wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats” in International Class 25;⁴

Registration No. 2326074 for the composite mark displayed below



(UNION MADE PRODUCT disclaimed) on the Principal Register for “All men’s, women’s, boys’ and girls’ wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats” in International Class 25;⁵

Registration No. 2403592 for the mark INDUSTRY GIRL (typed form) (GIRL disclaimed) on the Principal Register for “All Women’s and girls’ wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats” in International Class 25;⁶

Registration No. 2446522 for the composite mark displayed below (SUPPLY CO. disclaimed)

⁴ Registered December 2, 1997; renewed.

⁵ Registered March 7, 2000; renewed. Color is not claimed as a feature of the mark.

⁶ Registered November 14, 2000; renewed.



on the Principal Register for “All men’s, women’s, boys’, girls’ and children’s wearing apparel namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats” in International Class 25;⁷

Registration No. 2723120 for the mark displayed below



on the Principal Register for “men’s, women’s, boys’, girls’ and children’s wearing apparel namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing and lingerie, together with all accessories, namely, belts, socks, ties, caps and hats” in International Class 25;⁸

Registration No. 2859863 for the composite mark displayed below

⁷ Registered April 24, 2001; renewed. Color is not claimed as a feature of the mark.

⁸ Registered June 10, 2003; renewed. Color is not claimed as a feature of the mark.



on the Principal Register for “All men’s, women’s, boys’, girls’ and children’s wearing apparel namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing, underwear, lingerie, brassieres, panties, hosiery, pantyhose, camisoles, sleepwear, and footwear, together with all accessories, namely, belts, socks, ties, caps and hats” in International Class 25;⁹

Registration No. 3407934 for the composite mark displayed below



on the Principal Register for “Wholesale store, [retail store,] on-line wholesale store and on-line retail store services featuring men’s, women’s, boys’, girls’ and children’s wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing, undergarments, underwear, lingerie, panties, hosiery, camisoles, sleepwear, and footwear,

⁹ Registered July 6, 2004; renewed. Color is not claimed as a feature of the mark.

together with all accessories, namely, belts, socks, ties, caps and hats” in International Class 35;¹⁰ and

Registration No. 5052618 for the composite mark displayed below



on the Principal Register for “Men’s, women’s, boys’ and girls’ clothing, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, t-shirts, underclothing, undergarments, underwear, lingerie, panties, hosiery, camisoles and sleepwear, together with all accessories, namely, belts, socks, ties, caps and hats” in International Class 25.¹¹

In its answer, Applicant denied the salient allegations in the Notice of Opposition and asserted various putative affirmative defenses that in fact are amplifications of its denials.¹²

¹⁰ Registered April 8, 2008; renewed. The mark consists of the word “INDUSTRY” and a design of a bird’s wing, with a body of a bird depicted as an “i.” Color is not claimed as a feature of the mark.

¹¹ Registered April 8, 2008; October 4, 2016. The mark consists of a stylized arrowhead design above the stylized wording “INDUSTRY”. Color is not claimed as a feature of the mark.

¹² Applicant asserts the affirmative defense of failure to state a claim upon which relief may be granted. Insofar as Applicant neither filed a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this defense in his main brief, the defense is deemed waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1752 n.6 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.).

The case is now fully briefed. Opposer, as plaintiff in this proceeding, bears the burden of establishing its standing and claims by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007).

I. The Record

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file.

Opposer introduced the testimony affidavit of Ted Rozenwald, Opposer's President ("Rozenwald Affidavit") with Exhibits A-F (confidential). Opposer also submitted a notice of reliance on the following documents:

Photocopies of Opposer's pleaded Registration Nos. 2118102, 2326074, 2403592, 2446522, 2723120, 2859863 and 5052618 showing current status and title as well as each registration's file history; and

A copy of the Canadian decision Registrar of Trade-marks In the Matter of an Opposition by Manhattan International Trade Inc. and Pure & Simple Concepts Inc. to application No. 1358556 for the trade-mark BLUE INDUSTRY DESIGN in the name of Cornelis B.V., Citation 2014 TMOB 216, dated October 6, 2014.

Applicant took no testimony but instead introduced under notice of reliance the following:

Copies of third-party registrations of INDUSTRY formative marks for clothing obtained from the USPTO Trademark Status and Document Retrieval ("TSDR") database (Exhibits 1-74);

Excerpts from Opposer's Facebook page accessed on January 3, 2019 (Exhibits 75a-75g);

A printout from Opposer's Instagram page accessed on October 17, 2017 (Exhibit 76);

Excerpts from Opposer's website industryclothing.com accessed on January 3, 2019 (Exhibit 77);

Excerpts from Opposer's website industryclothing.com accessed via web archive on May 20, 2017 (Exhibit 78);

The Board's final decision dated May 11, 2018 in Opposition No. 91216270, *Manhattan International Trade Inc. and Pure & Simple Concepts, Inc. v. Industrie IP Pty Limited* (Exhibit 79);

Applicant's First Set of Requests of Production of Documents and Things to Opposer (Exhibit 80);

Google search results for the word "Industry" (Exhibit 81);

Google search results for the word "Industry Clothing" (Exhibit 82);

Excerpts from third-party websites accessed on January 18, 2019 (Exhibit 83); and

Excerpts from Blue Industries website in the Netherlands (Exhibit 84).

II. Designation of Confidential Material and Briefing

Opposer improperly designated the entire affidavit of Mr. Rozenwald and exhibits confidential pursuant to the Board's stipulated protective order, hindering the Board's ability to issue an opinion in this case. "Confidentiality designations do not provide absolute immunity from the public disclosure of materials so designated." *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (internal citation omitted). The Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g). As explained in

Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC, 110 USPQ2d 1458, 1461 (TTAB 2014):

Board proceedings are designed to be transparent to the public and the contents of proceeding files publicly available. The improper designation of materials as confidential thwarts that intention. Moreover, it is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decision. Therefore, in rendering our decision, we will not be bound by petitioner's designations and in this opinion, we will treat only testimony and evidence that is clearly of a private nature or commercially sensitive as confidential.

See also Gen. Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 USPQ2d 1179, 1182 (TTAB 2008); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 703.01(p) (2019) ("Confidential or Trade Secret Material"). We see no reason not to follow the Board's practice noted above. Nonetheless, we are mindful of the Opposer's concerns, and accordingly we have not disclosed any truly confidential information such as customer names or financial data.

In addition, both parties failed to follow the Board's well-established practice of including the TTABVUE docket entries and page numbers in their briefs when citing to publicly available evidence in the record and the TTABVUE entry number for matter designated as confidential. This added unnecessarily to the length of time for the Board to render an opinion in this case. We therefore direct the parties to the guidance set forth in *Turdin v. Trilobite, Ltd.*, 109 USPQ2d at 1476 n.6, and TBMP

§§ 106.03, 801.01, 803.03, and urge both parties to adhere to this practice in future cases with the Board.

III. Standing

Standing is a threshold issue that must be proven by the plaintiff 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), *cert. denied*, 135 S. Ct. 1401 (2015); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). 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.*, 111 USPQ2d at 1062. A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

Opposer’s pleaded registrations for INDUSTRY formative marks for clothing which are of record establish its standing to bring a Section 2(d) claim. *See Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Once a plaintiff has shown standing on one ground, it has the right to assert any other ground in an opposition which in this case includes Opposer’s dilution by blurring claim. *See, e.g., Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment).

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), 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.

A. Priority

To prevail on a Section 2(d) claim, a party must first prove priority. Because, as noted above, Opposer properly made of record its valid and subsisting pleaded registrations and Applicant did not counterclaim to cancel them, priority is not at issue for the marks and the goods and services identified therein. *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). *See also Coach Servs.*, 101 USPQ2d at 1727-28.

B. Likelihood of Confusion

The second element of a Section 2(d) claim is likelihood of confusion. Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each relevant *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the

evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *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.”). These factors, and the other relevant *DuPont* factors, are discussed below.

1. Opposer’s Alleged Family of Marks¹³

Opposer argues that it owns a family of six INDUSTRY formative marks for clothing items¹⁴ that are promoted together when offered for sale on Opposer’s licensee website:¹⁵ *See* Rozenwald Affidavit ¶15 and Exhibit F (excerpts from

¹³ Opposer was a co-plaintiff in prior litigation before the Board, *Manhattan International Trade Inc. and Pure & Simple Concepts Inc. v. Industrie IP Pty Limited*, Opposition No. 91216270 (TTAB May 11, 2018) (non-precedential). In that opposition proceeding, Opposers alleged prior use and registration of a purported family of marks for clothing which all share the term INDUSTRY. In dismissing both the Section 2(d) and dilution by blurring claims, the Board found that Opposers failed to establish a family INDUSTRY of marks for clothing. Applicant’s Notice of Reliance, 19 TTABVUE 354-358. The Board also found, based on the sheer volume of third-party registrations and third-party uses for INDUSTRY formative marks in connection with clothing, that the term INDUSTRY was both conceptually and commercially weak. *Id.*

¹⁴ Registration Nos. 2118102, 2403592, 2446522, 2723120, 3407934 and 5052618.

¹⁵ Opposer licenses its trademarks to companies in the Manhattan Group which include Manhattan International Trade, Inc. and Manhattan International Concepts, Inc. Rozenwald Affidavit ¶ 5; 20 TTABVUE (marked confidential).

publically available website www.manhattaninc.com/industry); 20 TTABVUE (marked confidential).

The seminal case defining a family of marks is *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

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 characteristic is indicative of a 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.

Neither the mere intention to create a family of marks, nor ownership of multiple registrations containing the family term, are sufficient in and of themselves to establish that a party owns a family of marks. *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978); *Consol. Foods Corp. v. Sherwood Med. Indus. Inc.*, 177 USPQ 279, 282 (TTAB 1973); *Witco Chem. Co., Inc. v. Chemische Werke Witten GmbH.*, 158 USPQ 157, 160 (TTAB 1968). In order to prove ownership of a family of marks, a party must establish:

[F]irst, that prior to the entry into the field of the opponent's mark, the marks containing the claimed 'family' feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature; and second, that the 'family' feature is distinctive (i.e. not

descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark). Emphasis added.

Marion Labs. Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215, 1218-19 (TTAB 1988) (quoting *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)). See also *TPI Holdings Inc. v. Trailertrader.comLLC*, 126 USPQ2d 1409, 1420 (TTAB 2018).

The record shows that a significant number of third parties have registered or used INDUSTRY formative marks in connection with clothing and apparel. Applicant made of record 74 third-party registrations comprised of this shared element as well as 12 examples of advertised use. Examples of registered INDUSTRY formative marks in the record for clothing include the word marks COTTAGE INDUSTRY, INDUSTRY WHORE, 305 INDUSTRY, INDUSTRY 9, INDUSTRY HORROR, CHALC INDUSTRY, REPLICA INDUSTRY, LAUNDRY INDUSTRY, STARK INDUSTRIES, MISLED INDUSTRIES, HOMEGROWN INDUSTRIES, CHAMBER INDUSTRIES, CARE APPAREL INDUSTRIES, ALPHA INDUSTRIES, BENT INDUSTRIES, CHAMBER INDUSTRIES, ADDICTED INDUSTRIES, BLOCK INDUSTRIES, GENERATION INDUSTRIES, IMPERFUCT INDUSTRIES, LUCKY PUNK INDUSTRIES, GET SOME INDUSTRIES, and AWAKEN INDUSTRIES. Applicant's Notice of Reliance, Exhibits 1-74; 22 TTABVUE 19-228. Third-party uses of INDUSTRY formative marks in connection with clothing include CRWWND INDUSTRIES, LAUNDRY INDUSTRY, LUCKY PUNK INDUSTRIES, UH-OH INDUSTRIES, and YELL! INDUSTRY. Applicant's Notice of Reliance, Exhibits 83(a)-(l); 22 TTABVUE 417-461. Thus, the alleged family term, INDUSTRY, or the

plural thereof, has been ubiquitously registered and used to identify clothing and apparel, making it both conceptually and commercially weak. This precludes a finding that Opposer owns a family of marks for the shared INDUSTRY element. *See, e.g., TPI Holdings*, 126 USPQ2d at 1428 (“we find –TRADER formative marks are so commonly used by others that the shared –TRADER element in Petitioner’s marks does not constitute a distinguishing feature. Petitioner cannot lay claim to a family of marks based on the common trait in its marks, despite the evidence showing Petitioner’s efforts to establish such a family of marks”); *see also Land-O-Nod Co. v. Paulison*, 220 USPQ at 66 (denying claim of family of CHIRO formative marks, while also noting the inherent weakness of CHIRO and that “[t]he evidence further establishes that the term CHIRO has been commonly used and/or registered by third parties”).

2. The Number and Nature of Similar Marks in Use on Similar Goods

We will now consider the number and nature of similar marks in use on similar goods, the sixth *DuPont* factor. As noted above, the record shows that numerous third parties have registered or used INDUSTRY formative marks in connection with clothing items. “The purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). *See also Jack Wolfskin Ausrüstung Fur*

Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). In addition, third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., Jack Wolfskin*, 116 USPQ2d at 1136. Extensive evidence of third-party use and registrations as we have before us is “powerful on its face.”¹⁶ *Jack Wolfskin*, 116 USPQ2d at 1136. Given the sheer volume of third-party registrations and examples of third-party use, consumers are conditioned to look for differences between INDUSTRY formative marks to determine the source of a given product and are therefore less likely to be confused.

“[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). “The weaker [Opposer’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted). *See also Palm Bay*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”). The record shows that Opposer’s

¹⁶ In *Jack Wolfskin*, there were at least 14 third-party registrations and uses, 116 USPQ2d at 1136 n.2, and in *Juice Generation*, there were at least 26. 115 USPQ2d at 1673 n.1.

INDUSTRY formative marks all fall on the weak side of the spectrum, meaning that their scope of protection is limited. This sixth *DuPont* factor therefore weighs against finding a likelihood of confusion.

3. The Similarity or Dissimilarity of the Marks

This *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 577). “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.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild, Inc. v. LJOH Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975)). Our analysis cannot be predicated on dissection of the involved marks. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Rather, we are obliged to consider the marks in their entireties. *Id.* See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, 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 a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161.

As explained above, a mark comprising the term INDUSTRY in whole or in part in connection with clothing items is entitled only to a “restricted scope of protection,” and as such will only bar the registration of marks “as to which the resemblance ... is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.” *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff’d*, 415 Fed. Appx. (Fed. Cir. 2010). We find that due to the addition of the word BLUE to INDUSTRY in Applicant’s applied-for mark BLUE INDUSTRY, the mark as a whole does not bear a “striking” resemblance in appearance, sound, meaning or commercial impression to any of Opposer’s pleaded registered marks. None of Opposer’s marks include the word BLUE or a synonym therefor, or any other color, when used as an adjective,¹⁷ such that consumers would perceive Applicant’s mark as a product

¹⁷ According to THE MERRIAM-WEBSTER DICTIONARY (www.merriam-webster.com), the word “blue” in adjectival form is:

1 : of the color whose hue is that of the clear sky : of the color blue (see blue entry 2 sense 1) a blue jacket; her bright blue eyes; The house is blue with white shutters.

2a : bluish the blue haze of tobacco smoke

b : discolored by or as if by bruising blue with cold

c : bluish gray a blue cat

3a : low in spirits : melancholy has been feeling blue

b : marked by low spirits : depressing a blue funk; things looked blue

4 : wearing blue the blue team

5 of a woman : learned, intellectual ... the ladies were very blue and well-informed ...— W. M. Thackeray

extension of Opposer's line of clothing. Furthermore, BLUE, as the first term in Applicant's mark "is most likely to be impressed upon the mind of a purchaser and remembered." See *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[It is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."); see also, *Palm Bay*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE."). Consumers are therefore more likely to attribute source identifying features to the initial word BLUE in Applicant's mark BLUE INDUSTRY.

Overall, the marks are dissimilar in sound, appearance, connotation and commercial impression. Accordingly, this *DuPont* factor weighs against finding a

6 : puritanical ... a blue Sunday city ...— James Street

7a : profane, indecent a blue movie

b : off-color, risqué blue jokes

8 music : of, relating to, or used in blues (see blues sense 3) a blue song

9 US politics : tending to support Democratic candidates or policies. As has become increasingly clear over the past few general elections, with their red states and blue states, an American Presidential campaign is no longer truly national.— Hendrik Hertzberg — compare purple sense 3, red sense 5

The Board may take judicial notice of online dictionary definitions. Fed. R. Evid. 201 (Judicial Notice of Adjudicative Facts). See, e.g., *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (online dictionary definition where resource was also available in book form - yes); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) (dictionary definitions judicially noticed although not made of record by either party).

likelihood of confusion.

4. The Similarity or Dissimilarity of the Goods and Services and the Established, Likely-to-Continue Channels of Trade and Classes of Consumers

Next, we compare the goods and services as they are identified in the involved application and Opposer's registrations. *See Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). As noted above, both the application and seven out of eight of Opposer's pleaded registrations include pants, jeans, shirts, t-shirts, jackets, blazers, vests, sweaters, shorts, belts, socks and hats. Thus, on their face, Applicant's and Opposer's goods are in-part identical. Because the goods are in-part identical and unrestricted as to trade channels, we must also presume that these particular goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *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); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

We now turn to a comparison of the goods identified in the involved application to the wholesale store, on-line wholesale store and on-line retail store services featuring apparel listed in Opposer's Registration No. 3407934. Because the

identification in the application has no restrictions on channels of trade, we must presume that Applicant's clothing travel in all channels of trade appropriate for such goods, which would include the wholesale store, on-line wholesale store and on-line retail store services featuring apparel. These services are therefore related to Applicant's goods as well. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (affirming Board's finding that retail apparel stores and clothing were related). Accordingly, these *DuPont* factors favor a finding of likelihood of confusion.

5. Balancing the Factors

We must balance our findings that the goods are in-part identical and are marketed in the same established, likely-to-continue channels of trade to the same classes of consumers, and that the services are related, against the limited scope of protection Opposer's INDUSTRY formative marks are due, and their dissimilarity when compared in their entirety to Applicant's BLUE INDUSTRY mark in its entirety. Weighing these factors, we find confusion unlikely. In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *DuPont* factors, as well as all of the parties' arguments with respect thereto. "We are not concerned with the mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (quoting *Witco Chem. Co. v. Whitfield Chem. Co., Inc.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969)).

Accordingly, we find that although Opposer has proved its standing and priority, it has failed to prove likelihood of confusion by a preponderance of the evidence. Opposer's Section 2(d) claim is therefore dismissed.

V. Dilution by Blurring

The Trademark Act provides a cause of action for the dilution of famous marks. Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c) provide as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Opposer contends that Applicant's BLUE INDUSTRY mark will "blur" the distinctiveness of Opposer's INDUSTRY marks. The Trademark Act defines dilution by blurring as the "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B). It "occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, are immediately reminded of the famous mark and associate the junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner." *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1509 (TTAB 2015). "Dilution diminishes the 'selling power that a

distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public.” *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1182 (TTAB 2001) (internal citation omitted). The concern is that “the gradual whittling away of distinctiveness will cause the trademark holder to suffer ‘death by a thousand cuts.’” *Nat’l Pork Bd. v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). In deciding Opposer’s dilution claim, we consider the following factors:

- 1 Whether Opposer’s marks are distinctive;
2. Whether Opposer’s marks are famous;
3. Whether Opposer’s marks became famous prior to applicant’s date of constructive use; and
4. Whether Applicant’s mark is likely to cause dilution by blurring the distinctiveness of Opposer’s mark.

See Coach Servs., 101 USPQ2d at 1723-24 (test for use-based application) and *Nat’l Pork Bd. v. Supreme Lobster and Seafood Co.*, 96 USPQ2d at 1494-95 (test for intent-to-use application). Turning to the second requirement, a mark is defined under §1125(c)(2)(A) as “famous” for dilution purposes —

... if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Opposer has the burden of establishing that its mark has become famous. “It is well-established that dilution fame is difficult to prove.” *Coach Servs.*, 101 USPQ2d at 1724 (quoting *Toro*, 61 USPQ2d at 1180). As noted in the statute, fame for dilution requires “widespread recognition by the general public.” *Id.* at 1725 (citing 15 U.S.C. § 1125(c)(2)(A)). Opposer must show that, when the general public encounters the mark “in almost any context, it associates the term, at least initially, with the mark’s owner.” *Id.*, (quoting *Toro*, 61 USPQ2d at 1180). A famous mark is one that has become a “household name.” *Id.* (internal citations omitted).

According to the testimony of Opposer’s CEO Mr. Rozenwald, “five of Opposer’s marks have been in use for 20 years or more, another for 15 years and yet another for 12 years (only the most recent mark has been in use for less than 5 years).” Rozenwald Affidavit ¶ 14; 20 TTABVUE (marked confidential). The trade channels for Opposer’s apparel products are: a) independent sales representatives located across the United States; b) third-party showrooms; c) a company showroom in New York City (which city is central hub for the fashion trade in the United States); d) online offerings through company and third party websites; e) displays via social media on Instagram, Facebook, etc.; f) participation in annual and semi-annual trade shows; g) sales to third-party intermediaries who then sell the goods to retailers; and h) sales to retailers. *Id.* at ¶9. Opposer’s clothing items have been featured in publications such as WOMEN’S HEALTH, SHAPE, MUSCLE MEMORY and MUSCLE & FITNESS. *Id.* at ¶11

and Exhibit C. From 2004 through 2017, apparel offered for sale in connection with one of more of Opposer's INDUSTRY marks has generated sales in in excess of \$10 million in the United States (or an average of \$769,231 per year) and there is "significant inventory" for 2018 sales. *Id.* at ¶12 and Exhibit D.

We find that this evidence falls far short of proving that Opposer's marks are famous for dilution purposes. *Compare Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc. and Axel Ltd. Co.*, 102 USPQ2d 1187 (TTAB 2012) ("we are convinced that the BLACKBERRY mark is famous based upon the ground breaking role of this device in shaping the culture and technology of the early twenty-first century, the incredible volume of sales, opposer's extensive promotional and advertising expenditures within the United States, and evidence of widespread media attention); *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011) ("the mark JUST DO IT is one of the most famous advertising slogans created, and has been communicated 'to wide demographic segments, across gender, age and lifestyle categories.'"). As noted above, we did not find that Opposer owns a family of INDUSTRY formative marks for clothing. Opposer's testimony fails to break down by each individual mark the number of years of use and sales figures for clothing items sold under each mark. And even if Opposer's testimony had attributed these figures to one or more particular marks, we would still find no fame for dilution purposes since there is no evidence that any of Opposer's marks have risen to the level of consumer recognition as a household name.

Since Opposer has failed to establish the critical element of fame, we need not consider the other factors. Accordingly, Opposer's dilution by blurring claim is dismissed.

Decision: The opposition is dismissed.