

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

Mailed: February 11, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Sjoklaedagerdin Hf.*

*v.*

*North 61 LLC*  
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Opposition No. 91237366  
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Michele S. Katz of Advitam IP, LLC,  
for Sjoklaedagerdin Hf.

Scott W. Johnston and Danielle I. Mattessich of Merchant & Gould P.C.,  
for North 61 LLC.

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Before Kuhlke, Lykos and Greenbaum,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

I. Background

North 61 LLC (“Applicant”) seeks registration on the Principal Register of the mark NORTH 61 (in standard characters) for

Posters; Stickers in International Class 16;

Bottoms; Hoodies; Shirts; Tank tops; Tops; T-shirts in International Class 25; and

On-line retail gift shops; On-line retail store services featuring clothing, sporting goods, novelty items, key

chains, mugs, posters and stickers; Retail gift shops; Retail store services featuring clothing, sporting goods, novelty items, key chains, mugs, posters and stickers in International Class 35.<sup>1</sup>

Sjoklaedagerdin Hf. (“Opposer”) opposes registration of Applicant’s mark on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), solely with the following six registered marks:

(1) 66° NORTH (in standard characters);<sup>2</sup>

(2) 66° NORTH in special form displayed as  (two registrations),<sup>3</sup> and  (one registration);<sup>4</sup>

(3) 66°N (in standard characters);<sup>5</sup> and

(4) 66° NORTH ICELAND in special form displayed as .<sup>6</sup>

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<sup>1</sup> Application Serial No. 87358942 was filed on March 5, 2017 by Paula K. Burns and Patrick B. Burns, based upon their 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 mark was assigned to North 61 LLC on June 24, 2017. The assignment was recorded in the USPTO Assignment Recordation Branch on September 20, 2017 at Reel/Frame 6157/0857.

<sup>2</sup> Reg. No. 5088873 (issued on November 29, 2016).

<sup>3</sup> Respectively, Reg. No. 2915717 (issued on January 4, 2005 with no color claim or description of the mark; renewed), and Reg. No. 5084208 (issued on November 22, 2016 with no color claim and the following description of the mark: “The mark consists of the stylized wording ‘66°’ in a box over the stylized wording ‘NORTH’”).

<sup>4</sup> Reg. No. 5075756 (issued on November 9, 2016 with the following description of the mark: “The mark consists of the wording ‘66°’ in white on a red square background; beneath this is the wording ‘NORTH’ in a smaller font on a white rectangular background.” The colors red, white and blue are claimed as a feature of the mark).

<sup>5</sup> Reg. No. 5075773 (issued on November 8, 2016).

<sup>6</sup> Reg. No. 5088874 (issued on November 29, 2016 with the following description of the mark: “The mark consists of the wording ‘66°’ in white stylized font within a red square. To the right is the stylized wording ‘NORTH ICELAND’ in the color blue, with the word “NORTH’ stacked above the word ‘ICELAND.’ All other white in the mark represents background or

Opposer submitted a TSDR printout for each registration with its Notice of Opposition, showing each registration is subsisting on the Principal Register and owned by Opposer, and that each identifies various clothing, including T-shirts, shirts and trousers in International Class 25 and, with the exception of Reg. No. 2915717

(special form 66° NORTH mark displayed as , various other goods and services including online and brick and mortar retail store services featuring clothing in International Class 35.<sup>7</sup>

In its Answer, Applicant denies the salient allegations in the Notice of Opposition.<sup>8</sup>

The opposition is fully briefed.

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transparent areas only and is not claimed as a feature of the mark.” The colors red, blue and white are claimed as a feature of the mark.).

<sup>7</sup> 1 TTABVUE 21-37. Opposer unnecessarily resubmitted the TSDR printouts under Notice of Reliance. 16 TTABVUE 6-27 (Exhibits 1-6). *See* Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d). Citations refer to TTABVUE, the Board’s online docketing system.

None of the registrations identify posters or stickers or any other goods in International Class 16, or retail store services (online or brick and mortar) featuring those items, and Opposer did not plead or prove at trial use of any of mark for goods in International Class 16.

To the extent Opposer argues in its brief that a likelihood of confusion exists for the goods and services identified in International Classes 25 and 35 based on Opposer’s prior use of its marks with those goods and services rather than on the pleaded registrations (*see, e.g.*, 21 TTABVUE 10, 15, 17), such common law claim is unnecessary and has not been considered.

Also, Opposer’s dilution claims were pleaded (1 TTABVUE 19, ¶ 19) but not tried, and therefore have been waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

<sup>8</sup> Applicant’s “affirmative defense” of failure to state a claim and their affirmative defense of unclean hands were not pursued at trial, and therefore are deemed waived. *See Alcatraz Media*, 107 USPQ2d at 1753 n.6. We construe Applicant’s second putative affirmative defense as a mere amplification of its general denials.

## II. Evidentiary Issues

Applicant raised objections to certain exhibits that Opposer submitted under Notice of Reliance. We need not and do not rule on these objections because none of the objected-to material is outcome determinative, and we have not relied on any of it in reaching our decision.<sup>9</sup> *See RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018) (“the Board is capable of weighing the relevance and strength or weakness of the objected to testimony and evidence, including any inherent limitations”).

## 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.

### A. Opposer’s Notice of Reliance

Opposer submitted under Notice of Reliance (16 TTABVUE, Exhibits 1-25) status and title copies of its pleaded registrations, a September 28, 2017 Cease and Desist Letter to Applicant, Opposer’s Initial Disclosures, discovery requests from both parties and the associated responses thereto, “Other Disclosures Regarding Channels

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<sup>9</sup> This includes Opposer’s submission of its Initial Disclosures. *See* Exhibit 8 to Opposer’s Notice of Reliance, 16 TTABVUE 32-37. We also note that Applicant submitted some of the objected-to material (Opposer’s Responses to Opposer’s First Sets of Interrogatories and Requests for Admission) under its own Notice of Reliance. *See* Exhibits 12 and 13 to Opposer’s Notice of Reliance, 16 TTABVUE 71-85, and Exhibits P and Q to Applicant’s Notice of Reliance, 19 TTABVUE 214-228. Both parties also submitted under their Notices of Reliance Opposer’s Supplemental Responses to these discovery requests. *See* Exhibits 21 and 22 to Opposer’s Notice of Reliance, 16 TTABVUE 171-192, and Exhibits R and S to Applicant’s Notice of Reliance, 19 TTABVUE 229-245. The Supplemental Responses are not the subject of Applicant’s objections.

of Trade” for Opposer’s pleaded marks, and as Exhibit 25 to 15 TTABVUE, the Confidential Testimony Affidavit<sup>10</sup> of Fannar Pall Aolsteinsson, Opposer’s Marketing Manager, with exhibits comprising Opposer’s customer list (Exhibit A), sales figures (Exhibit B), and examples of marketing, promotional materials, advertisements and channels of trade for Opposer’s 66° NORTH products (Exhibit C).<sup>11</sup>

#### B. Applicant’s Notice of Reliance

Applicant submitted a Notice of Reliance on the Testimony Declaration of Paula Burns, Applicant’s co-founder, with Exhibits A through H, consisting of excerpts from Applicant’s website, a Wikipedia excerpt on Minnesota State Highway 61, sample images and promotional materials for Applicant’s mark NORTH 61, excerpts from Applicant’s Facebook page, and TSDR printouts for the third-party registered marks 41° NORTH, 45NRTH, 45N and ROUTE 66, with examples of how those marks have

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<sup>10</sup> The submission of testimony affidavits or declarations under a notice of reliance, as both parties have done, is not the preferred approach, but it is harmless. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355 \*3 (TTAB 2019).

<sup>11</sup> 15 TTABVUE and 16 TTABVUE are identical except 15 TTABVUE includes the Affidavit and exhibits, which Opposer has designated “confidential” in its entirety. While the Board is sensitive to the confidential nature of some of the information in the Affidavit and exhibits, it is the general policy of the Board that all papers in a proceeding be public. *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1476 n.19 (TTAB 2017). Opposer did not file a redacted copy of the Affidavit and exhibits in noncompliance with Trademark Rule 2.126(c), 37 C.F.R. § 2.126(c). That rule requires parties who file confidential filings to concurrently file a copy of the submission for public viewing with the confidential portions redacted. At the end of this Decision, the Board will allow Opposer time to submit a redacted version of Exhibit 25, failing which it will be made public. *See, e.g., Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1736 (TTAB 2012) (party submitted certain deposition testimony under seal, and was ordered to resubmit copies of testimony in which only truly confidential testimony was redacted).

been used, and associated Wikipedia excerpts about their geographic locations and, in the case of ROUTE 66, the meaning and history of the mark. Applicant also submitted under Notice of Reliance the Testimony Declaration of Liam Burns, Applicant's "Vice President of Snow and Skate," with Exhibits I through L, consisting of Wikipedia excerpts about "Geographic Coordinate Systems" and "66<sup>th</sup> parallel North," excerpts from Opposer's website describing the history of Opposer's brand, and sample images of designs used with Applicant's mark NORTH 61.<sup>12</sup>

In addition, Applicant submitted under Notice of Reliance a TSDR printout of the application for Applicant's NORTH 61 and Design mark, an excerpt from Opposer's website describing the origin of the 66 NORTH mark, TSDR printouts of third-party, use-based trademark registrations, and as noted above, Opposer's Responses and Supplemental Responses to Applicant's First Set of Interrogatories and Requests for Admission. 19 TTABVUE (Exhibits M-S).

### C. Opposer's Rebuttal Notice of Reliance

Opposer also submitted a Rebuttal Notice of Reliance (20 TTABVUE) on TSDR printouts of Applicant's application and a related application for NORTH 61 and

Design,<sup>13</sup> displayed as , a notice of opposition against Applicant's application by a third party, Applicant's logo, evidence of both parties' trademark use of their

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<sup>12</sup> The two declarations and associated exhibits are located at 18 TTABVUE.

<sup>13</sup> We discuss the related application, which has since registered, below, where we address the similarity/dissimilarity of the marks.

marks, and printouts from Opposer's website showing product images and Opposer's history.

#### 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. 16 TTABVUE 6-27 (Opposer's Notice of Reliance, Exhibits 1-6). *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 Applicant did not file a counterclaim against them, priority is not an issue as to the marks and goods or services 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").

As noted above, the registrations identify various goods and services including goods in International Class 25 and services in International Class 35 (i.e., two of the three opposed classes in the application). However, none of the registrations identify goods in International Class 16, and Opposer did not plead or prove common law usage of such goods. Accordingly, Opposer has not established priority and therefore cannot prevail in its Section 2(d) claim as to the goods identified in International Class 16 even if, as we find below, Opposer's and Applicant's marks are likely to cause confusion. *Cf. Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1036 (TTAB 2017) (“[E]ven though the pleaded and involved marks are likely to cause confusion, and Moreno has standing ..., Moreno has not established priority, and therefore cannot prevail in her Section 2(d) claim.”).

**The Section 2(d) claim is dismissed as to International Class 16.** The remainder of this decision will address the Section 2(d) claim only as to the two opposed classes for which priority is not an issue: the goods identified in International Class 25, and the services identified in International Class 35.

## 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 by showing the relatedness of its own goods or services to any item within that class of goods or services in the opposed application. *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 on Opposer’s pleaded Reg. No. 5088873 (66° NORTH in standard characters). We consider this mark to be the most relevant of Opposer’s pleaded registrations for our *DuPont* analysis because this mark and Applicant’s mark NORTH 61 are in standard characters, and therefore 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 identical fonts or sizes that emphasize either the shared word NORTH or the numerical designation. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). Consequently, we

need not consider the marks in the five 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 Services and Channels of Trade

Under the second and third *DuPont* factors, we base our evaluation on the goods and services 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). The application and registration include identical T-shirts and shirts in International Class 25, and identical retail and online retail stores featuring clothing in International Class 35.

Applicant does not dispute the in-part identity of the identified goods and services,<sup>14</sup> but argues that they move in different channels of trade:

Applicant's goods are exclusively American made, with many made in Minnesota, and sold online and through pop-up store events executed in partnership with local small businesses located along the "North Shore," such as breweries and coffee shops. Applicant displays and sells its products outside or inside of a van, which operates as a mobile retail store for pop-up events in which Applicant participates. By contrast, Opposer provides no connection to Minnesota or the North Shore, and no aspect of

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<sup>14</sup> Applicant's arguments are limited to the goods identified in International Class 16. 22 TTABVUE 37-38. As discussed above, the opposition is dismissed as to that Class.

Opposer's sales and marketing strategy appears to embrace the concept of pop-up events. 22 TTABVUE 27.

This argument is unavailing. Given the in-part identity of the goods and services, and the lack of restrictions or limitations in the application or registration as to their nature, channels of trade, or classes of consumers, we must presume that the channels of trade and classes of purchasers for these goods and services 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 and services based on the goods and services 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 and services 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 and services identified in the application or pleaded registration by place of manufacture or method of sale.<sup>15</sup>

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

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

Next, we compare Applicant’s mark NORTH 61 and Opposer’s mark 66° NORTH, both in standard characters, “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 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).

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<sup>15</sup> Although Applicants have not yet filed an Allegation of Use, Applicant’s co-founder Paula Burns testified Applicant has sold some bags and clothing through local pop-up events and through its website, and she submitted evidence of use of their mark. Declaration of Paula Burns, 18 TTABVUE 10-11, ¶¶ 9-12, and Exhibit A thereto, 18 TTABVUE 19-34.

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 and services are legally identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quotation omitted).

The marks look and sound similar because each combines the word NORTH with a two digit number in the sixties. Although Opposer’s mark also includes the symbol °, which is verbalized as the word “degree”, consumers are less likely to focus on this portion of the mark because it is so small and appears in the middle of the mark. The marks thus are essentially “reverse combinations” of similar words or elements—a “transposition” of the elements that make up the marks. *See, e.g., In re Wine Soc’y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (affirming refusal to register THE WINE SOCIETY OF AMERICA & Design based on registration of AMERICAN WINE SOCIETY 1967 & Design, finding that “the transposition of words does not change the overall commercial impression”); *Bank of Am. Nat’l Trust and Sav. Ass’n v. The Am. Nat’l Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978) (“the words ‘BANKAMERICA’ and ‘BANK OF AMERICA’, on the one hand, and ‘AMERIBANC’,

on the other, convey the same meaning and create substantially similar commercial impressions”).

In *In re Nationwide Industries, Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988), affirming the refusal to register RUST BUSTER for rust-penetrating spray lubricant based on the mark BUST RUST for penetrating oil, the Board held that “the reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion only if the transposed marks create distinctly different commercial impressions.” Likelihood of confusion ordinarily is found where transposed marks do not convey different commercial impressions. See *Carlisle Chem. Works, Inc. v. Hardman & Holden*, 434 F.2d 1403, 168 USPQ 110 (CCPA 1970) (reversing dismissal of oppositions to registration of COZIRC based on use of ZIRCO for related goods, finding that the marks “are substantially similar, the difference being in a reversal of syllables which are essentially the same”); *In re Gen. Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982) (affirming refusal to register SPRINT STEEL RADIAL for pneumatic tires based on registration for RADIAL SPRINT for vehicle tires, finding that the marks “convey the same meaning, that is, a steel radial tire called ‘SPRINT’ or a radial tire called ‘SPRINT’ both of which could emanate from the same source”); *Plus Prods. v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978) (“... the use of identical terms in inverse order as we have in the present case is likely to cause confusion in trade when used on such closely related cosmetic products”); *Fisher Sci. Co. v. Ipco Hosp. Supply Corp.*, 165 USPQ 471, 472 (TTAB 1970) (sustaining opposition to MIX O THERM based on THERMIX used for

identical goods, stating “they are in their essentials merely reverse combinations of the same words, and such being the case, would more than likely convey substantially the same commercial impressions”); *Royal Crown Cola Co. v. Bakers Franchise*, 150 USPQ 698, 700 (TTAB 1966), *aff’d*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969) (“... the applicant’s compound mark includes the same words which make up opposer’s mark, that is to say ‘RITE DIET’ is merely ‘DIET-RITE’ transposed. The marks of the parties create substantially the same commercial impressions ...”). *Cf. In re Akzona Inc.*, 219 USPQ 94, 96 (TTAB 1983) (“Applicant’s mark ‘SILKY TOUCH,’ conveys the impression that applicant’s synthetic yarns are silky to the touch. On the other hand, registrant’s mark ‘TOUCH O’ SILK,’ suggests that registrant’s clothing products contain a small amount of silk.”); *Murphy, Brill and Sahner, Inc. v. N.J. Rubber Co.*, 102 USPQ 420 (Commr. Pat. 1954) (finding that TOPFLITE for shoe soles conveys a different meaning than FLITE TOP for hosiery).

Applicant’s main argument is that the specific numbers and ordering of the terms in each mark results in marks with different meanings and different commercial impressions. Applicant asserts that Opposer’s mark connotes the geographic location in Iceland where Opposer is located,<sup>16</sup> while Applicant’s mark was inspired by Minnesota Highway 61, a scenic highway that runs through “the North Shore” region

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<sup>16</sup> “66° is the line of latitude that touches the town in Iceland where Opposer is located, and is highly touted in Opposer’s marketing materials and website. ... Specifically, ‘66°’ indicates a circle of latitude and ‘NORTH’ indicates a cardinal direction of the earlier-identified 66° parallel geographic boundary.” 22 TTABVUE 23 (citing selected pages from Exhibit 24 to Opposer’s Notice of Reliance, 16 TTABVUE 208 and 211-213 (screenshots from Opposer’s social media websites), and Exhibit J to Applicant’s Notice of Reliance, 18 TTABVUE 138-142 (screenshots from Opposer’s website)).

of northeast Minnesota.<sup>17</sup> However, other than the testimony of Applicant's own witnesses, Applicant submitted no evidence to demonstrate that consumers understand either mark in the manner Applicant posits. "[A]n applicant's or registrant's intended interpretation of the mark is not necessarily the same as the consumer's perception of it." *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1125 (TTAB 2008); *see also Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1465 (TTAB 2003) ("In short, it does not matter what applicant's intentions were in creating its mark or what its characterization of its mark is."). We find that in the context of apparel and retail stores featuring apparel, and taking into account the identity of the goods and services, 66° NORTH and NORTH 61 both have general geographic connotations, and thus create the same overall commercial impression.

In making this finding, we acknowledge that Applicant owns a registration for the



mark NORTH 61 and Design,<sup>18</sup> displayed as for bags (in Class 18) and clothing including T-shirts and shirts (in Class 25), which Opposer did not oppose. However, when viewed in its entirety, this registration has a distinct commercial impression of a Minnesota road sign, as Applicant apparently intended. The same

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<sup>17</sup> "61 in Applicant's mark, on the other hand, refers to Minnesota Highway 61, which is reinforced by Applicant's marketing materials, corporate motto, and logo." 22 TTABVUE 23 (citing Declaration of Liam Burns, 18 TTABVUE 15, 17, ¶¶ 9-11).

<sup>18</sup> Reg. No. 5764235 issued on May 28, 2019. The registration includes the following description of the mark: "The mark consists of the State of Minnesota with shading in the northeast, upper corner and the term 'NORTH' under the State design, with the '61' against a shaded, speckled background under the term 'NORTH', all encompassed by a circle with an outer circle band." The design of the State of Minnesota is disclaimed. Color is not claimed as a feature of the mark.

cannot be said for Applicant's standard character mark NORTH 61, which has no design elements or stylization to help distinguish it from Opposer's mark 66° NORTH. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017) ("To the extent that Symbolic is advocating that we consider another mark, will.i.am, that is not part of the applied-for mark in analyzing the similarity of the marks, we decline to do so. The correct inquiry requires comparison of the applied-for mark, which only includes the words 'I AM,' to the registrants' marks.").

We find that when viewed in their entirety, the marks 66° NORTH and NORTH 61 are similar in sound, appearance, meaning and overall commercial impression. To the extent the degree symbol in Opposer's mark creates any difference in connotation and commercial impression, the other similarities between the marks outweigh the differences. This *DuPont* factor also weighs in favor of a finding of likelihood of confusion.

### C. Strength of Opposer's Mark

Opposer's standard character mark 66° NORTH 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, 15 U.S.C. § 1057(b). *See Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Applicant contends that Opposer's mark 66° NORTH is entitled to a narrow scope of protection because 66° NORTH "describes the geographic origin of [Opposer's] goods – Iceland – which is located at the 66<sup>th</sup> parallel north ... and is about as unique

as a quart of salt water in the midst of the Atlantic Ocean,” and that it is common in the apparel industry to use the terms “NORTH,” “66” and “DEGREES (or the symbol ‘°’ meaning ‘degrees’)” as well as other geographic indicators. 22 TTABVUE 30. As evidence, Applicant submitted as Exhibit O to its Notice of Reliance printouts from TSDR of a number of third-party marks that incorporate one of the three elements of Opposer’s mark (e.g., NORTH COAST, NORTH COUNTRY, NORTHWOODS, 66, ROUTE 66, .66 CALIBER, 90 DEGREES SOUTH, NINETY FIVE°, and 32° NORTH), ten third-party registrations for marks that Applicant asserts “cannot[e] the geographic coordinates where the goods originate” (e.g., LATITUDE 40° NORTH, 45NRTH, and NORTH 56° 4), and nine third-party registrations comprising a “combination of a directional indication coupled with a number” (e.g., N68, NORTH 40 OUTFITTERS, 32 NORTH and 180 SOUTH).<sup>19</sup>

Third-party registrations are not evidence of use or what happens in the market place. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). However, they may be relevant to show the sense in which a mark is used in ordinary parlance; that is, an element common to both parties’ marks may have a

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<sup>19</sup> Applicant summarized this evidence in charts in its brief. 22 TTABVUE 30-36. Some of the registrations have expired because their owners did not file the required maintenance documents (e.g., Reg. Nos. 2370177 (NORTH SPORTIF and Design), 351949 (NORTH COAST), 4143843 (ANGEL OF THE NORTH), 4311323 (20NORTH)). The existence of a cancelled registration--particularly one cancelled for failure to provide a declaration of continued use--does not tend to show that the cited mark is weak due to third-party use. A cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). See *Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011) (“‘dead’ or cancelled registrations have no probative value at all.”).

normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the segment is inherently relatively weak. *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); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“[T]hird-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.”). Applicant’s evidence shows that several third parties have registered marks that incorporate one or more of the elements of Opposer’s mark 66° NORTH for apparel and retail stores featuring apparel. None of the third-party registrations include 66° or 66 DEGREES and the word NORTH as elements of their marks. The third-party registration evidence therefore does not show that the combination of terms 66° or 66 DEGREES with the term NORTH is weak.

Further, many of the marks listed contain substantial additional matter which affect their commercial impression and thus further reduce their probative value. For example, 11°, NINETY FIVE°, 96DEGREE, NINETY-NINE°, 32° DEGREES and 22 DEGREES all connote temperature rather than geography, NORTH COAST, NORTHEASTERN, NORTHERN, and NORTHSIDE all connote specific regions, and ROUTE 66 brings to mind the historic highway and the popular R&B song “(Get Your Kicks on) Route 66.”

Considering the record as a whole, Opposer's mark is inherently distinctive. We find no evidence that Opposer's mark has a suggestive or descriptive meaning in association with apparel or retail stores featuring apparel. In short, Applicant has not shown that Opposer's mark 66 NORTH is either conceptually or commercially weak and thus entitled only to a narrow scope of protection.

We accord Opposer's mark the normal scope of protection afforded to inherently distinctive marks.

#### D. Actual Confusion/Length of Time of Concurrent Use

Finally, Applicant argues that there has been no actual confusion between the marks although it has offered its goods under the mark NORTH 61 since June 15, 2017. Declaration of Paula Burns, 18 TTABVue 10, 12 ¶¶ 9, 17. According to Ms. Burns (and as mentioned above in our discussion of channels of trade), Applicant has sold clothing and bags through its website and "in pop-up store events that are often executed in partnership with local small businesses located along the North Shore, such as breweries and coffee shops," where Applicant "displays its products outside or inside of a van, which operates as a mobile retail store for these events." *Id.*, at 10-11, ¶ 11. Applicant's argument falls under the eighth *DuPont* factor, "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion."

While Ms. Burns might not be aware of any instances of actual confusion between Applicant's and Opposer's marks since Applicant's first use of its mark on June 15, 2017, Applicant's use has been for only a short period of time and in an extremely

limited environment. This suggests that there have not been meaningful opportunities for actual confusion to have occurred in the marketplace. See *Cunningham*, 55 USPQ2d at 1847. Moreover, “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *Majestic Distilling*, 65 USPQ2d at 1205. See also *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). Cf. *Guild Mortg. Co.*, 129 USPQ2d at 1163-66 (requiring the Board to consider the applicant’s “evidence of concurrent use of the two marks for a particularly long period of time—over 40 years—in which the two business operated in the same geographic market—southern California—without any evidence of actual confusion.”).

“A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion.” *Majestic Distilling*, 65 USPQ2d at 1205. However, evidence of actual confusion is difficult to obtain, and is not necessary to show a likelihood of confusion. See *i.am.symbolic*, 123 USPQ2d at 1747; *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1843 (Fed. Cir. 1990). The eighth *DuPont* factor is neutral.

## VII. Conclusion

Based on the overall similarity between Opposer’s mark 66° NORTH and Applicant’s mark NORTH 61 for identical clothing items in Class 25 and identical retail store services (both online and brick and mortar) featuring clothing in Class 35

that travel in some of the same channels of trade to at least some of the same classes of purchasers, we conclude that a likelihood of confusion exists.

**Decision:** The opposition is dismissed in International Class 16, and sustained in both International Classes 25 and 35.<sup>20</sup> The application will proceed for issuance of a Notice of Allowance in Class 16 only.

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<sup>20</sup> Opposer is allowed until thirty (30) days from the mailing date of this Decision to comply with Trademark Rule 2.126(c) by filing a redacted version of Exhibit 25 to 15 TTABVUE, the Confidential Affidavit of Fannar Pall Aolsteinsson, Opposer's Marketing Manager, with Exhibits A-C, failing which the entirety of Exhibit 25 will be treated as part of the public record. *Kohler Co.*, 125 USPQ2d at 1476 n.19 (TTAB 2017) (quoting *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016)). The parties are reminded that the Board may treat as not confidential that 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).