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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91237844 |
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**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Trademark Application Serial No. 87370054
Filed on March 14, 2017
For the mark “SANDRIVER & Design”
Published in the Official Gazette on July 18, 2017

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| SAND CPH A/S, |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No. 91237844 |
| |) | |
| GUO, XIULING, |) | |
| |) | |
| Applicant. |) | |
| |) | |

BRIEF FOR OPPOSER SAND CPH A/S IN OPPOSITION NO. 91237844

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DEFINED TERMS

1. **“Opposer”** Opposer Sand CPH A/S
2. **“Applicant”** Applicant, Xiuling Guo
3. **“Application”** U.S. Application No. 87/370,054
4. **“Board”** Trademark Trial and Appeal Board
5. **“Opp. First NOR”** Opposer’s First Notice of Reliance Dated August 1, 2019
6. **“Opp. Second NOR”** Opposer’s Second Notice of Reliance Dated August 1, 2019
7. **“Opp. Third NOR”** Opposer’s Third Notice of Reliance Dated August 1, 2019
8. **“App. NOR”** Applicant’s Notice of Reliance dated October 11, 2019
9. **“SAND Mark”** Opposer’s U.S. Registration No. 3,046,413 for SAND
10. **“Opposer’s Goods and Services”** goods and services listed in U.S. Registration No. 3,046,413 for SAND
11. **“SANDRIVER Mark”** Applicant’s mark as shown in U.S. Application No. 87/370,054

BRIEF ON MERITS

Opposer Sand CPH A/S (“Opposer”) submits its trial brief in Opposition No. 91237844 instituted against Applicant, Xiuling Guo (“Applicant”). Opposer requests that judgment be entered in its favor and registration of the mark in U.S. Trademark Application Serial No. 87/370,054 be refused.

I. DESCRIPTION OF THE RECORD

A. Statement of the Proceedings

Applicant filed Application No. 87/370,054 for “SANDRIVER & Design” on March 14, 2017, (the “Application”) with the U.S. Patent and Trademark Office on the basis of use in commerce for “clothing apparel, namely, scarves, mufflers, dresses, skirts, sweaters, coats, ponchos, jumpers, gloves, caps, blouses” in Class 25. The Application published for opposition on July 18, 2017. Opposer timely opposed Applicant’s Application on November 15, 2017. The Trademark Trial and Appeal Board (the “Board”) instituted these proceedings under Opposition No. 91237844 on the same day. Applicant filed her Answer on February 23, 2018. The parties exchanged discovery requests and responses through their respective counsel between April 23, 2018, and May 20, 2019.

B. Opposer’s Evidence

During its testimony period, Opposer submitted the following exhibits under Notices of Reliance, all without objection by Applicant.

Opposer’s First Notice of Reliance Dated August 1, 2019 (“Opp. First NOR” ttabvue-91237844-OPP-21):

1. Opposer’s Exhibit A – USPTO Trademark Status and Document Retrieval status printout for the SAND Mark, pursuant to TBMP § 704.03(b)(1)(A) (2019):

- a. Exhibit A.1: SAND, Registration No. 3046413
2. Opposer's Exhibit B – Applicant's discovery responses, pursuant to TBMP § 704.10 (2019):
 - a. Exhibit B.1: Applicant's Responses and Objections to Opposer's First Set of Interrogatories.
 - b. Exhibit B.2: Applicant's Supplemental Responses to Interrogatories Nos. 2, 9, 16, 18, 20, 23, 24, 25, 29, 30 and 31 to Opposer's First Set of Interrogatories.
 - c. Exhibit B.3: Applicant's Responses and Objections to Opposer's First Set of Requests for Admission.
 - d. Exhibit B.4: Applicant's Supplemental Responses and Objections to Opposer's First Set of Requests for Admission.
3. Opposer's Exhibit C – Copies of printed publications in the form of magazines of general circulation, pursuant to TBMP § 704.08(a) (2019):
 - a. Exhibit C.1: "Levy's" Spring and Summer 2016, pages 22-23 and 61.
 - b. Exhibit C.2: "Levy's" Spring 2014, cover and pages 2, 15, 18, and 46.

Opposer's Second Notice of Reliance Dated August 1, 2019 ("Opp. Second NOR" ttabvue-91237844-OPP-22):

1. Opposer's Exhibit C – Copies of printed publications in the form of magazines of general circulation, pursuant to TBMP § 704.08(a) (2019):
 - a. Exhibit C.3: "Levy's" Fall 2014, pages 5, 15, 18, and 46.
 - b. Exhibit C.4: "John Craig" Fall/Holiday 2018, pages 6, 23, 38-39, 40-41.

Opposer's Third Notice of Reliance Dated August 1, 2019 ("Opp. Third NOR" ttabvue-91237844-OPP-23):

1. Opposer's Exhibit D – Internet printouts from third-party websites, pursuant to TBMP § 704.08(b) (2019):
 - a. Exhibit D.1: Internet printout showing retailer that sells Opposer's products.
 - b. Exhibits D.2 to D.6: Internet printouts from Opposer's website showing the products sold under the SAND Mark and the nature of Opposer's use of the SAND Mark.
 - c. Exhibits D.7 to D.8: Internet printouts from Applicant's website showing Applicant's product and Applicant's use of the SANDRIVER Mark.
 - d. Exhibits D.9 to D.15: Internet printouts showing retailers that sell cashmere clothing products and suit coats, pants and shirts.
2. Opposer's Exhibit E – Internet articles and electronic publications pursuant to TBMP § 704.08(b) (2019):
 - a. Exhibits E.1 to E.4: Publications discussing or referring to the SAND Mark, Opposer's SAND products and/or fame of Opposer's SAND brand.

C. Applicant's Evidence

During her testimony period, Applicant submitted the following exhibits under Applicant's Notice of Reliance.

Applicant's Notice of Reliance dated October 11, 2019 ("App. NOR" ttabvue-91237844-OPP-24):

1. Applicant's Exhibit 1: Internet printout from a third-party website the word "SAND".
2. Applicant's Exhibits 2 to 21: Copies of third-party use-based trademark registrations issued by the USPTO along with internet printouts from the USPTO online database.
3. Applicant's Exhibits 22 to 34: Internet printouts from third-party websites that

- purportedly show third-party use of a SAND mark for brands.
4. Applicant's Exhibits 36 to 40: Internet printouts from third-party websites that purportedly show third-party use of a SAND mark for color.
 5. Applicant's Exhibit 41: Copy of Opposer's trademark registration and internet printouts from the USPTO online database.
 6. Applicant's Exhibit 42: Internet articles and electronic publications that show use of Applicant's mark.
 7. Applicant's Exhibit 43: Copy of a printed publication in the form of an article.
 8. Applicant's Exhibit 44: Internet printouts from the EUTM Trademark Electronic Search System that purportedly show Opposer was unsuccessful in an invalidation proceeding against Applicant.

II. RECITATION OF THE FACTS

A. Opposer's SAND Mark

Opposer is an international high-end fashion brand that has been selling quality clothing products since the 1980s under the trademark SAND (the "SAND Mark"). (Opp. Third NOR, Ex. D.4, **ttabvue-91237844-OPP-23 pg. 129-133**). Opposer is the owner of U.S. Trademark Registration No. 3,046,413 for SAND in standard characters, applied for July 16, 2004, and registered January 17, 2006, for the following goods in Class 25:

“footwear and headwear; men's, women's clothing, namely, beachwear and coverups; clothing belts; blazers; blouses; coats; culottes; peddle-pushers; dresses; gowns; dressing and night gowns; gloves; jackets; jeans; jerseys; jumpers; jumpsuits; leggings; mittens; overalls; overcoats; pants; pantsuits; pullovers; robes; scarves; shawls; suits; skirts; shorts; slacks; sleepwear; trousers; smocks; tuxedos; stockings; suit coats; suspenders; sweat suits, pants, shorts and shirts; sweaters; vests; shirts; t-shirts; tank tops; ties; tights; topcoats; tops; underclothes; undergarments; underwear; camisoles; undershirts, chemise; underpants; slippers; socks; neckties; neckerchiefs; bandanas; mufflers”,

and services in Class 35:

“retail store services, featuring footwear and headwear; men's, women's clothing, namely, beachwear and cover-ups; clothing belts; blazers; blouses; capes; coats; culottes; peddle-pushers; dresses; gowns; dressing and night gowns; gloves; jackets; jeans; jerseys; jumpers; jumpsuits; leggings; mittens; overalls; overcoats; pants; pantsuits; pullovers; robes; scarves; shawls; suits; skirts; shorts; slacks; sleepwear; trousers; smocks; tuxedos; stockings; suit coats; suspenders; sweat suits, pants, shorts and shirts; sweaters; vests; shirts; t-shirts; tank tops; ties; tights; topcoats; tops; underclothes; undergarments; underwear; camisoles; undershirts, chemise; underpants; slippers; socks; neckties; neckerchiefs; bandanas; mufflers”

(collectively, “Opposer’s Goods and Services”). (Opp. First NOR, Ex. A.1, **ttabvue-91237844-OPP-21 pg. 6-7**). Section 71 Declarations of Use were filed with and accepted by the U.S. Patent and Trademark Office in 2012 and 2016.

Opposer’s use of the SAND Mark on a variety of Opposer’s Goods and Services has been continuous and uninterrupted for over 30 years. (Opp. Third NOR, Ex. D.4, **ttabvue-91237844-OPP-23 pg. 132-133**). Opposer’s products prominently display the SAND Mark on the products themselves and on the exterior of its stores. Examples of such use of the SAND Mark are below:



(Opp. Third NOR, Ex. D.3, **ttabvue-91237844-OPP-23 pg. 75**).



(Opp. Third NOR, Ex. D.2, **ttabvue-91237844-OPP-23 pg. 17**). Opposer’s products are sold by several retailers throughout the United States and internationally, including but not limited to, Saks Fifth Avenue, Bloomingdales, and Nordstrom. (See Opp. Third NOR, Ex. D.3, **ttabvue-91237844-OPP-23 pg. 114-141**). Opposer’s SAND Mark is famous as demonstrated by the frequency with which the brand is mentioned in media publications and is the subject of popular culture articles regarding celebrity attire. (See Opp. Third NOR, Ex. E.1 through E.4, **ttabvue-91237844-OPP-23 pg. 342-350**).

B. Applicant’s Use of and Trademark Application for SANDRIVER & Design

Applicant states that she first conceived of using the name SANDRIVER for her products in July 2016 and did not use any mark including the phrase before that time. (Opp. First NOR, Ex. B.1 Interrog. Response No. 4, **ttabvue-91237844-OPP-21 pg. 21**). Applicant filed U.S. Trademark Application Serial No. 87/370,054 for “SANDRIVER & Design” in the USPTO on March 14, 2017, for “clothing apparel, namely, scarves, mufflers, dresses, skirts, sweaters, coats,

ponchos, jumpers, gloves, caps, blouses” in Class 25 (the “SANDRIVER Mark”). The Application was filed on the basis of use of the mark in commerce under Section 1(a), with an asserted first use date of August 2015 and first use in commerce date of August 5, 2016. (*See* File for U.S. App. No. 87/370,054, part of the record pursuant to 37 C.F.R. § 2.122).

III. STATEMENT OF THE ISSUES

A. Opposer has standing to pursue the Opposition as the owner of the SAND Mark.

B. Opposer has priority in this proceeding based upon its ownership of the SAND Mark.

C. Applicant’s use and registration of SANDRIVER Mark in Class 25 is likely to cause confusion, mistake or deception as to the source, origin or affiliation of Applicant’s clothing products because consumers are likely to be confused that the goods under Applicant’s SANDRIVER Mark are affiliated with or sponsored by Opposer.

IV. ARGUMENT

In order to succeed in an opposition, the opposer must prove (1) that it has standing to oppose the application; and (2) that there are valid grounds why the applicant is not entitled to registration of the mark. *See* § 20.3 *McCarthy on Trademarks and Unfair Competition*, Fifth Edition (November 2019); *Young v. AGB Corporation*, 152 F.3d 1377, 47 USPQ2d 1752 (Fed. Cir. 1998). An opposer “may raise any available statutory ground for opposition . . . that negates the defendant’s right to registration.” TBMP § 309.03(c)(1) (2019). To succeed on a likelihood of confusion claim, the opposer must establish, by a preponderance of the evidence, that “defendant’s mark, as applied to its goods or services, so resembles plaintiff’s previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception.” TBMP 309.03(c)(2) (2019); 15 U.S.C. § 1052(d); *see also Research in Motion Ltd. v. Defining Presence Marketing Group, Inc.*, 102 USPQ2d 1187, 1192 (TTAB 2012).

A. Opposer Has Standing in This Proceeding

The Lanham Act provides that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register” has standing to oppose an application to register such mark. *See* 15 U.S.C. § 1063(a); TBMP § 309.03 (2019). “A party may establish its standing to oppose . . . by showing that it has a ‘real interest’ in the case, that is, a legitimate personal interest in the outcome of the proceeding and a reasonable basis for its belief in damage.” TBMP § 303.03 (2019). *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) (finding sufficient showing of standing where petitioner in cancellation proceeding owned two earlier filed registrations for marks confusingly similar to marks owned by registrant). As the owner of the SAND Mark as reflected in U.S. Registration No. 3,046,413 in Class 25, made of record by Opposer’s First Notice of Reliance, Exhibit A.1, Opposer has sufficiently shown it has a real interest in challenging an application to register the nearly identical SANDRIVER Mark for goods in Class 25. Accordingly, Opposer has standing to pursue this Opposition.

B. Opposer Has Priority in This Proceeding

To establish priority in an opposition action, the opposer must show proprietary rights in the mark that produce a likelihood of confusion; “[p]roprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko Int’l. Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981)). Opposer introduced into evidence the trademark registration for the SAND Mark that predates, by over ten years, the filing date of the Application and Applicant’s claimed first use and

first use in commerce dates listed in the Application. Specifically, Opposer's U.S. Registration No. 3,046,413 was filed on July 16, 2004, and registered on January 17, 2006. Applicant filed the Application on March 14, 2017, and claims first use of the mark anywhere in August 2015 and first use in commerce in August 2016.

It is well-settled that if Opposer introduces its pleaded registration into evidence, priority is not an issue in such a case unless the Applicant brings a counterclaim to cancel Opposer's cited registration. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1653 (TTAB 2010). Applicant did not bring any counterclaims to cancel Opposer's U.S. Registration No. 3,046,413. Thus, Opposer's priority in this opposition has been established by Opposer's ownership of U.S. Registration No. 3,046,413.

C. Applicant's Registration of the SANDRIVER Mark is Likely to Cause Confusion with Opposer's SAND Mark

Section 2(d) of the Lanham Act prohibits the registration of "a mark which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). In determining whether there is a likelihood of confusion between two marks, the Board considers the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The relevance and weight to be given to the various *du Pont* factors differs from case to case, depending on the relevant facts. *See Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992); *Cunningham*, 55 USPQ at 1845. "Any doubts about likelihood of confusion, etc., under § 2(d) must be resolved against applicant as the newcomer." *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (citing *In re Pneumatiques, Caoutchouc Mfr.*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973); *see also* § 23.64 *McCarthy on Trademarks and Unfair*

Competition, Fifth Edition (November 2019). This principal is particularly applicable “[w]hen balancing the interest in a famous, established mark against the interests of a newcomer.” *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 674, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (reversing Board’s dismissal of opposition holding “we are compelled to resolve doubts on this point against the newcomer”).

In the instant action, the relevant *du Pont* factors are 1) the similarity and nature of the Applicant’s and Opposer’s goods; 2) the similarity of the marks as to appearance, sound, and connotation; 3) the similarity of established likely-to-continue trade channels; 4) the conditions under which and buyers to whom sales are made; and 5) the fame of Opposer’s SAND Mark. *See E.I. du Pont*, 476 F.2d 1357, 177 USPQ 563.

As discussed below, each of the relevant *du Pont* factors weigh in Opposer’s favor and demonstrate that consumers are likely to be confused by the registration and use of Applicant’s mark for clothing products.

1. Opposer and Applicant’s Goods are Identical

A first relevant *du Pont* factor is the identical nature of the Applicant and Opposer’s goods. A “key consideration” in a likelihood of confusion analysis is “the similarities between the goods.” *See L’Oreal S.A.*, 102 USPQ2d at 1436. When the goods are identical or virtually identical, the degree of similarity between the marks necessary to support a likelihood of confusion declines. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1477 (TTAB 2007).

The Applicant applied for the SANDRIVER Mark in Class 25 for “clothing apparel, namely, scarves, mufflers, dresses, skirts, sweaters, coats, ponchos, jumpers, gloves, caps, blouses”. Opposer’s federal registration for the SAND Mark includes the following goods in Class

25: scarves, mufflers, dresses, skirts, sweaters, coats, shawls, jumpers, gloves, headwear, blouses. (Opp. First NOR, Ex. A.1, **ttabvue-91237844-OPP-21 pg. 6-7**). Thus Opposer’s SAND Mark encompasses all of the goods identified in the SANDRIVER Application. The goods of the Opposer and the Applicant are identical and so related that consumers will encounter the marks under similar circumstances which is likely to create the mistaken belief that the goods originate from the same source. In view of this fact, this *du Pont* factor weighs heavily in Opposer’s favor.

2. Applicant’s Mark is Confusingly Similar to Opposer’s Mark in appearance, sound, connotation, and commercial impression

The second relevant *du Pont* factor is the similarity of the marks because Applicant’s SANDRIVER Mark is highly similar to Opposer’s SAND Mark. The “similarities between the marks” is a “key consideration” in any likelihood of confusion analysis. *See L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012); *see also Herbko Int’l, Inc.*, 64 USPQ at 1380 (“the similarity . . . of the marks in their entireties is a predominant inquiry”) (internal citations omitted). The test is not whether the marks can be distinguished in a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018). “[W]here . . . the goods at issue are identical, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Id.* (quoting *In re Viterra*, 671 F.3d 1358, 1362 (Fed. Cir. 2012)).

Moreover, if the dominant portion of both marks is the same, then the marks may still be confusingly similar notwithstanding other distinctive matter. *See In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (where a newcomer has appropriated the entire mark of a registrant and added to it a non-distinctive term, the marks are generally considered to be confusingly similar).

Here, Applicant seeks to register the SANDRIVER Mark which is nearly identical to

Opposer's SAND Mark. Applicant's SANDRIVER Mark wholly incorporates Opposer's SAND Mark and SAND is the dominant portion of both marks. (Opp. First NOR, Ex. B.3 Admission Response No. 32, **ttabvue-91237844-OPP-21 pg. 49**). Additionally, the additional the non-distinctive term "RIVER" to Applicant's SANDRIVER Mark does not aid to distinguish between the marks. Finally, the design element in Applicant's SANDRIVER Mark also does not aid to distinguish between the marks and in fact, the word portion SANDRIVER is the dominant element. *See In re Aquitaine Wine USA, LLC*, 814 F. Supp. 791, 126 USPQ2d 1181 (TTAB 2018) (noting that when a mark consists of words and design, words are often given greater weight because they make a greater impression upon purchasers); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (that the design element of a pillar in applicant's mark MAX does not convey a different source for identical services from registrant's mark MAX).

In view of the fact that the marks are sufficiently similar as to create a likelihood of confusion as to the source of the goods or services, this *du Pont* factor weighs heavily in Opposer's favor.

3. Opposer's and Applicant's Goods Travel in the Same Trade Channels

The third relevant *du Pont* factor is the overlapping trade channels in which the goods of Applicant and Opposer travel. First, neither Applicant's nor Opposer's recited goods are restricted or limited in any way regarding intended recipient or channels of trade. When there is no limitation on the channels of trade contained in the identification of goods, the Board must presume the identified goods move in all channels of trade normal for such goods. *See Citigroup Inc.* 98 USPQ2d at 1261. Internet evidence showing the normal trade channels for Applicant's and Opposer's respective goods may be accepted by the Board as probative evidence of the types trade channels the parties' goods may be sold through. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d

1198, 1203-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009). Goods in the nature of those offered by Applicant and Opposer, namely, high-end clothing products, can be purchased from a wide range of retailers. Opposer identified several retailers that sell goods in the nature of Opposer and Applicant's goods, namely, cashmere products, suit coats, pants, and shirts, such as Nordstrom, Neiman Marcus, Barney's New York, Lord and Taylor, Saks Fifth Avenue, Bloomingdales, and Bergdorf Goodman. (*See* Opp. Third NOR, Ex. D.9 - D.15, **ttabvue-91237844-OPP-23 pg. 197-341**).

Next, Applicant claims that her goods are sold via her website and on other online platforms and claims she currently has no plans on expanding. (Opp. First NOR, Ex. B.2 Interrog. Response No. 18, **ttabvue-91237844-OPP-21 pg. 33-34**). However, this assertion is not a significant or persuasive factor in this likelihood of confusion analysis. "Present sales and methods of distribution are not conclusive and do not, in our judgment, form a proper basis for finding lack of likelihood of confusion or mistake when the identical trademarks are used on the respective goods of the parties." *J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965) (citing *Meyer Chemical Co. v. Anahist Co., Inc.*, 263 F.2d 344, 46 CCPA 784 and *Daggett & Ramsdell, Inc. v. I. Posner, Inc.*, 277 F.2d 952, 47 CCPA 952).

4. The Target Consumers for Opposer's and Applicant's Goods Overlap

The fourth relevant *du Pont* factor is overlap in Opposer's and Applicant's target consumers. An overlap in the "class of purchasers [for the applicant's and opposer's goods] bolsters the likelihood of confusion." *Herbko Int'l Inc.*, 64 USPQ2d at 1381 (finding that where the parties sold their products to a similar class of consumers at similar department stores, confusion was likely). If there are no restrictions in the registration and application, "it is presumed that [the parties' goods] are available to all potential consumers for such goods." *See L'Oreal S.A.*,

102 USPQ2d at 1441.

Both Opposer and Applicant sell high end clothing and therefore the same consumers are likely to encounter both Applicant's and Opposer's goods. Applicant's goods are targeted primarily towards people with strong purchasing power, namely, people who can afford the average purchase price of Applicant's products. (Opp. First NOR, Ex. B.2 Interrog. Response No. 16, **ttabvue-91237844-OPP-21 pg. 33**). Exhibits show the average price of Applicant's goods is typically several hundred to a few thousand dollars, ranging from \$89 for hats and as high as \$3169 for coats. (Opp. Third NOR, Ex. D.7, **ttabvue-91237844-OPP-23 pg. 183-190**). Opposer's goods similarly target high end consumers with a "Red Carpet" line, "Black Label" line of formal wear, and "Pink Label" line of preppy European designs. (Opp. Third NOR, Ex. D.2, **ttabvue-91237844-OPP-23 pg. 22**; *see also* Opp. Third NOR, Ex. D.3, **ttabvue-91237844-OPP-23 pg. 24-113**). This consumer and market overlap is also demonstrated by the high-end retailers that sell cashmere products, suit coats, pants, and shirts, such as Nordstrom, Neiman Marcus, Barney's New York, Lord and Taylor, Saks Fifth Avenue, Bloomingdales, and Bergdorf Goodman. (Opp. Third NOR, Ex. D.9 - D.15, **ttabvue-91237844-OPP-23 pg. 197-341**). Such websites are probative in a likelihood of confusion analysis to the extent they show a relationship between the parties' goods and the consumer for such goods.

5. Opposer's SAND Mark is Famous

The fifth relevant *du Pont* factor is the fame of Opposer's SAND Mark. "[F]ame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *du Pont* factors." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[E]xtreme deference is accorded to a famous mark in terms of the wide latitude of legal protection it receives." *L'Oreal* 102 USPQ2d at 1438; *see also* *Bridgestone Tire Operations LLC v. Federal*

Corp., 673 F.3d 1330, 102 USPQ2d 1061 (Fed. Cir. 2012).

Opposer has sold high-quality clothing under its SAND mark internationally for over 30 years. (*See* Opp. Third NOR, Ex. D.4, **ttabvue-91237844-OPP-23 pg. 132-133**). As a result, Opposer is widely recognized as a leader in the fashion industry and its SAND Mark is famous. Seasonal collections of the SAND brand are showcased at international high-end fashion shows such as “Project New York”, “Chicago Collective”, “CIFF”, and “Panorama Berlin”. (Opp. Third NOR, Ex. D.2, **ttabvue-91237844-OPP-23 pg. 15-16**). Opposer’s clothing products sold under the SAND mark are also featured in fashion magazines such as *Levy’s* and *John Craig*. (Opp. First NOR, Ex. C.1 - C.2, **ttabvue-91237844-OPP-21 pg. 84-85, 123, 132 (describing image on 129), 145, 148, 176-177**; Opp. Second NOR, Ex. C.3 - C.4, **ttabvue-91237844-OPP-22 pg. 11, 96, 113, 128-131**).

The fame of Opposer’s products is also evident by the frequent unsolicited media coverage mentioning or focusing on the brand. (*See* Opp. Third NOR, Ex. E.1 – E.4, **ttabvue-91237844-OPP-23 pg. 342-350**). For example an article in *Flaunt* magazine entitled “Flaunt celebrates the release of The Grind Issue with SAND Copenhagen and Benedict Cumberbatch at Soho’s Blacks Club” touted a celebrity gathering featuring Opposer’s brand. (Opp. Third NOR, Ex. E.4, **ttabvue-91237844-OPP-23 pg. 347-350**). Additionally, the Opposer’s goods are often referenced in articles detailing the clothing worn by celebrities at movie premieres, award shows and similar venues. To illustrate, *Us Weekly* reported that “[Chris Pratt] looked fit in a Sand Copenhagen grey suit with a light pink shirt and navy tie”. (Opp. Third NOR, Ex. E.2, **ttabvue-91237844-OPP-23 pg. 342-344**). Articles in *E News* reporting on the 2014 and 2015 Grammy’s award show noted the clothing of well-known celebrities wearing SAND clothing products: “Feelin’ the blues, Aloe Blacc? The rapper knows how to rock a royal blue Sand Copenhagen by Soren Sand Suit on the

red carpet!” and “Neil Patrick Harris: The actor looked stylish in a leather trimmed suit jacket by Sand Copenhagen”. (Opp. Third NOR, Ex. E.2 and E.3, **ttabvue-91237844-OPP-23 pg. 345-346**).

Opposer’s decades of longstanding and continuous use of the SAND Mark, its U.S. Registration for the SAND Mark, and the evidence of the general public’s association of the name with Opposer and recognition of the brand’s quality lead to the conclusion that the SAND Mark is famous, and this factor weighs in Opposer’s favor.

V. CONCLUSION

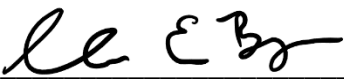
Each of the relevant *du Pont* factors, analyzed in points 1-5 *supra*, weigh in favor of Opposer. Applicant’s goods are identical to Opposer’s goods and the SANDRIVER Mark is highly similar to Opposer’s SAND Mark as it incorporates the entirety of Opposer’s SAND Mark. In addition, there is significant overlap between the trade channels and the target consumers of the clothing products. A likelihood of consumer confusion is even more likely where, as here, the marks are highly similar and the senior user’s mark is well-established and famous. Furthermore, any doubt regarding whether there is a likelihood of confusion must be resolved in Opposer’s favor as the senior user. Overall, application of the *du Pont* factors leads to the conclusion that the Application should be refused and this opposition sustained.

The preponderance of the evidence in this proceeding leads to the conclusion that consumer confusion of Opposer’s famous SAND Mark would be likely to result from the registration of Applicant’s SANDRIVER Mark. Therefore, Opposer requests that judgment be entered in its favor and that registration of Application Serial No. 87/370,054 be refused.

Respectfully Submitted,

Date: January 29, 2020

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing **BRIEF FOR OPPOSER SAND CPH A/S IN OPPOSITION NO. 91237844** was served by e-mail, as prescribed in 37 C.F.R. § 2.119, on this January 29, 2020, upon Applicant's current attorney of record:

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