

This Opinion is Not a
Precedent of the TTAB

Mailed: November 1, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Metal Jeans, Inc.
v.
Destroyer Promotional Products, LLC
—————

Opposition No. 91252176
—————

Jessica Bromall Sparkman and Bernard R. Gans of Jeffer Mangels Butler &
Mitchell LLP for Metal Jeans, Inc.

Rexford Brabson, Alexandra Berkowitz and Jorge Franco of T-Rex Law, P.C.,
for Destroyer Promotional Products, LLC.

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Before Wellington, Lykos and Lebow,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Destroyer Promotional Products, LLC (“Applicant”) seeks to register on the
Principal Register the standard character mark METAL HEADS for the following
goods:¹

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¹ Application Serial No. 88503926, filed July 8, 2019, under Section 1(b) of the Trademark
Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

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).

Headwear, namely, headwear for adults, children and babies, caps, skullies being headwear, sun visors being headwear, visors being headwear, knit beanies, helmet liners being headwear, novelty headwear with attached wigs, leather headwear, do rags for use as headwear, bucket caps, paddy caps, cowboy hats, trapper hats, fedoras and swim caps in International Class 25.

Metal Jeans, Inc. (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) alleging prior common law rights in, and ownership, of the registered mark METAL in standard characters for “Clothing, namely, ski jackets and snowboard jackets; clothing, namely, jeans and shirts” in International Class 25.²

In its Answer to the amended Notice of Opposition, Applicant denied the salient allegations of the Notice of Opposition, and asserted various affirmative and putative defenses (i.e. amplifications of its denials).³

The case is fully briefed. Opposer, as plaintiff in this proceeding, bears the burden of establishing its entitlement to a statutory cause of action and substantive claim by

Citations to the prosecution file of the opposed application refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system.

² Notice of Opposition ¶¶ 2 and 7; 1 TTABVUE 3 and 5. Opposer’s Registration No. 4299652 issued March 12, 2013 on the Principal Register and has been renewed. Opposer’s attachment of a printout from TSDR of its pleaded registration to the Notice of Opposition showing current status and title suffices to make the registration of record for purposes of trial. *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

³ Answer at 7 TTABVUE. Insofar as Applicant’s First Affirmative Defense of failure to state a claim was not pursued during the interlocutory phase of this proceeding or argued in its brief, it is deemed waived. *See, e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (respondent’s affirmative defense of failure to state a claim not argued in brief deemed waived), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.). Applicant’s Third, Fourth, Fifth, Sixth and Seventh Affirmative Defenses of laches, estoppel, waiver, acquiescence, and unclean hands were not pursued are therefore waived. *See id.* Applicant’s Second and Eighth Affirmative Defenses are not true affirmative defenses but rather amplifications of Opposer’s denials.

a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). In reaching our decision, we have not considered any statements made by either party in their briefs that are unsupported by evidence properly in the record. *See, e.g., Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010).

I. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Applicant's application file. Neither party submitted testimony.

A. Opposer's Main Trial Period

During its main trial period, Opposer filed a notice of reliance ("Opposer's First Notice of Reliance") on certain documents, including printouts of third-party registrations from the USPTO's TSDR and Trademark Electronic Search System ("TESS")⁴ databases (Exhibits 1-54, 32 TTABVUE 1-147) as well as a copy of Opposer's First Request for Admissions (Exhibit 57, 32 TTABVUE 176-182).⁵

⁴ The USPTO will be retiring the TESS database on November 30, 2023.

⁵ Opposer also submitted Opposer's First Set of Requests for Production of Documents and Things and Opposer's First Set of Interrogatories without Applicant's responses Opposer's First Notice of Reliance, Exs. 55-56; 32 TTABVUE 149-184. *See* Trademark Rules 2.120(k)(3)(i) and (5), 37 C.F.R. § 2.120(k)(3)(i) and (5). Without the responses, these discovery requests lack probative value. Applicant's deemed admissions are addressed in Section II ("Evidentiary Matter") and throughout the opinion.

Opposer submitted a listing of search results from TESS of third-party registrations for the purpose of showing relatedness of the parties' goods. Opposer's First Notice of Reliance, Exs. 58-60; 32 TTABVUE 185-190. A party may not make a third-party registration of record simply by introducing a list of third-party registrations. *See, e.g., Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (listing of third-party marks downloaded from Office database does not make the registrations of record); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n.8 (TTAB 2012) (summary of search results from

B. Applicant's Trial Period

Applicant submitted a single notice of reliance on dictionary definitions of the words "metal" and "metalhead" (Exhibits A and B, 40 TTABVUE 5-85) and plain photocopies of third-party registrations (Exhibit C, 40 TTABVUE 86-293) and applications and portions of their file histories (Exhibit D, 293 TTABVUE 307).⁶

C. Opposer's Rebuttal Trial Period

To rebut Applicant's submission of plain photocopies of third-party registrations, Opposer submitted under notice of reliance ("Opposer's Rebuttal Notice of Reliance") printouts from the TESS database showing the current status and title of certain third-party registrations and applications submitted in Applicant's Notice of Reliance (Exhibits 61-62; 41 TTABVUE 4-101) and a copy of a "Judgment and Permanent Injunction" against Metal Sport, Inc., one of the third-party registrants in Applicant's Notice of Reliance (Exhibit 63; 41 TTABVUE 102-106).

II. Evidentiary Matter

Oppose relies in part on Applicant's admissions due to Applicant's failure to timely respond to Opposer's First Set of Admission Requests served during discovery on December 18, 2020 to prove its Section 2(d) claim.⁷ Applicant acknowledges that the

USPTO's electronic database is not an official record of the Office). For this reason, we consider the lists of third-party registrations only for what they show on their face.

⁶ Applications are of limited probative value. *See, e.g., Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1360 (TTAB 2014) (copies of applications are evidence only that applications were filed, thus incompetent to show common third-party use), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

⁷ *See* Opposer's First Notice of Reliance, Ex. 57; 32 TTABVUE 176-182.

requests are deemed admitted under Fed. R. Civ. P. 36(a), but asserts that none of the admissions are relevant to the determination of likelihood of confusion.

Any matter admitted due to a party's failure to timely respond under Fed. R. Civ. P. 36(a) is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission or the Board permits a reopening of the time for responding to the admission requests. *See* Fed. R. Civ. P. 36(b); Fed. R. Civ. P. 6(b)(1)(B). Applicant did not move to withdraw or reopen its time to respond to the admission requests, meaning that the requests are deemed admitted.

In making our factual determinations, we have considered the admissions in light of the totality of any additional evidence presented at trial. *See, e.g., Am. Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144-45 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend). "In form and substance a Rule 36 admission is comparable to an admission in pleadings or a stipulation drafted by counsel for use at trial, rather than to an evidentiary admission of a party." Advisory Committee's Note, 48 F.R.D. 487, 534 (1970). Consistent therewith, we have considered each admission for whatever probative value it may have, keeping in mind that Opposer must prove each element of its Section 2(d) claim by a preponderance of the evidence.

III. Entitlement to a Statutory Cause of Action

An opposer in any inter partes case before the Board must prove its entitlement to a statutory cause of action. *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). Section 13 of the Trademark Act, 15 U.S.C. § 1063(a), states:

Any person who believes that he would be damaged by the registration of a mark upon the principal register, ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.

To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, Opposer must demonstrate (1) that its claims fall within the zone of interests protected by the statute (i.e., has a “real interest” in the outcome of the proceeding); and (2) damage proximately caused by the proposed registration (i.e., a reasonable basis for its belief in damage). *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa*, 111 USPQ2d 1162; *see also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (defining a “real interest” as a “direct and personal stake” in the outcome of the proceeding).

Opposer has established its entitlement to a statutory cause of action by including with its Notice of Opposition a status and title copy printed from TSDR of its pleaded

Registration No. 4299652 showing that the registration is valid and subsisting.⁸ See Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). Therefore, Opposer has demonstrated a plausible Trademark Act Section 2(d) claim against the involved application for the standard character mark METAL HEADS for the headwear items identified therein. See *Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Based on this evidence, we find Opposer has an interest falling within the zone of interests protected by Section 13 of the Trademark Act and a reasonable believe in damage proximately caused by the proposed registration of Applicant's mark.

IV. Trademark Act 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.

We consider each element of this claim, priority and likelihood of confusion, below.

A. Priority

Because Opposer properly made of record its valid and subsisting pleaded registration, and Applicant did not counterclaim to cancel it, priority is not at issue

⁸ 1 TTABVUE 8-19.

for the mark and goods identified therein. See *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

B. Likelihood of Confusion

With Opposer having established its priority, we turn to the issue of 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*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered 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). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. 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.”).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. 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 *DuPont* factors argued by each party, are discussed below.

1. Strength or Weakness of the Cited Mark

Because it affects the scope of protection to which Opposer’s registered mark METAL is entitled, we first address the strength or weakness of this term under the sixth *DuPont* factor. See *Spireon Inc. v. Flex Ltd.*, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023) (citing *DuPont*, 117 USPQ at 557) (the sixth *DuPont* factor “is a measure of the extent to which other marks weaken the assessed mark”). “[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “The weaker [the cited] 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).

In determining the strength or weakness of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial or marketplace strength. *Spireon*, 2023 USPQ2d 737, at *7 (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”)); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark

is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). Conceptual or inherent strength is a measure of a mark's distinctiveness. *Chippendales*, 96 USPQ2d at 1686. Distinctiveness is "often classified in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753 (1992). "Commercial strength, on the other hand, is the marketplace recognition value of the mark." *Spireon*, 2023 USPQ2d 737, at *4 (internal citation and quotation marks omitted). Commercial strength is a question of "whether consumers in fact associate the . . . mark with a unique source." *Id.*

Applicant argues that Opposer's registered mark METAL is relatively weak, making it entitled to only a narrow scope of protection. Applicant did not introduce any evidence of third-party uses that would establish any diminished commercial or marketplace strength of the mark under the sixth *DuPont* factor. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) ("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."); *see also Jack Wolfskin Ausrustung 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*, 115 USPQ2d at 1675-76 (internal citations omitted). Instead, Applicant challenges the inherent or conceptual strength of Opposer's mark METAL.

First, Applicant argues that the mark METAL is merely descriptive of “jeans,” one of the items identified in Opposer’s registration, and not arbitrary as Opposer contends. This argument is based the premise that Opposer’s jeans incorporate a metal patch featuring trademark information near the rear right belt loop, making the word “metal” merely descriptive of a feature of Opposer’s jeans.⁹ As evidentiary support, Applicant points to dictionary definitions of “metal” as well as reproduced images in its brief of specimens of use submitted by Opposer during prosecution of its underlying application that matured to registration.¹⁰ The problem is that none of the specimens have been made of record. While Trademark Rule 2.122(b)(1) makes the entirety of Applicant’s application file automatically of record, this rule does not apply to the application file of Opposer’s pleaded registration. As a result, we have no evidence in the record to make this finding.


The next argument Applicant advances is that Opposer’s mark METAL is conceptually weak because it is a commonly registered term in connection with apparel. In support thereof, Applicant submitted approximately 130 third-party registrations. Opposer countered with evidence showing that nearly half of those registrations have been either cancelled or abandoned.¹¹ This leaves us with

⁹ Opposer’s Brief, p. 10; 47 TTABVUE 13.






¹⁰ Opposer’s Brief, p. 10; 47 TTABVUE 13.





¹¹ Applicant argues that the cancelled and abandoned marks are nevertheless probative of the historical and ongoing prevalence and popularity of the term METAL in association with apparel goods. We need not reach this question in light of the large number of relevant live third-party registrations in the record.




approximately 72 live third-party registered composite marks incorporating the word METAL for clothing:¹²




Trademark	Goods	Reg./Ser. No.
METAL MULISHA	Clothing, namely, shirts, blouses, tank tops, jackets, pants, shorts, underwear, [lingerie,] swim wear, sweat suits, sweaters, [suits,] hats, gloves, and foot wear in Class 025.	3105613
got metal?	Clothing, namely, hats, shirts, blouses, dresses, jeans, pants, polo shirts, t-shirts, sports shirts, sweatshirts, shorts, skirts, slacks, sweatpants, sweaters, tank tops, tops, trousers and vests in Class 025.	3145924
WESTERN METAL SUPPLY CO	Clothing, namely, shirts, caps, T-shirts, [visors,] hats in Class 025.	2998508
	Clothing, namely, [jackets], caps, [bandannas,] tank tops, and sweat shirts in Class 025.	2382319
THE METAL GOD	Shirts in Class 025.	2925499
GO FOR THE METAL	T-shirts, hats in Class 025.	2628508
METAL RODEO	Clothing, namely, shirts, T-shirts [, sweatshirts, hats, and jackets] in Class 025.	2132941
METALLICA	Clothing; namely, T-shirts, shorts, hats, [visors] and scarves in Class 025.	1819042
MCHENRY METALS	Golf shirts, golf hats in Class 025.	2832191
LIQUIDMETAL GOLF	Clothing, namely, hats, pants, shirts, shorts, sweaters, jackets, and footwear in Class 025.	2714787



¹² Chart reprinted from Applicant's Brief, pp. 12-18, 47 TTABVUE 15-21. We have not considered the third-party applications of record. Third-party applications are evidence only of the fact that they have been filed. *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).


SPEED METAL	Clothing, namely shirts, T-shirts, sweatshirts, and headwear, namely hats and caps in Class 025.	2679874
SCRAP METAL	Clothing, namely, baseball caps, t-shirts, sweatshirts, and jackets in Class 025.	3692925
	Clothing, namely t-shirts in Class 025.	1913445
	Clothing, namely, t-shirts, hooded shirts, crew shirts, ponchos, headwear, and baseball caps in Class 025.	2213592
	Clothing, namely, t-shirts, pullovers, coveralls, shirts, head-wear, namely, hats, baseball caps and stocking caps in Class 025.	2231065
	Clothing, namely, jackets, caps, bandannas, tank tops, and sweatshirts in Class 025.	2382319
METALLICA	Clothing, namely, shirts, sweatpants, hockey jerseys, soccer jerseys, sweatshirts, fashion knit shirts, button down shirts, basketball jerseys, long-sleeve t-shirts, tank tops, jackets, sweaters, baseball jerseys, baby doll t-shirts, polo shirts, wind breakers, muscle t-shirts, baby rompers, toddler t-shirts, allover, bandannas, mock turtlenecks, track pants, ponchos, and hooded shirts in Class 025.	2504291
	Clothing, namely t-shirts, shorts, pants, sweatpants, tank tops, baby doll t-shirts, sweatshirts, basketball jerseys, long sleeve t-shirts, muscle t-shirts, baby rompers, toddler t-shirts and track pants; headwear in Class 025.	3275659
WEAR YOUR METAL OUT	Clothing, namely, shirts, knit and woven shirts, blouses, jeans, pants, shorts, skirts, dresses, sweaters, sweatshirts, t-shirts, jackets, coats, hats, belts, caps, socks, footwear, and headwear in Class 025.	3785462
METALCALYPSE	T-shirts in Class 025.	3647480

METAL MAFIA	Clothing, namely, shirts, pants, dresses, coats, headwear, sweatshirts, jackets, and underwear in Class 025.	4003237
	Wearing apparel, namely, shirts, t-shirts, shorts, pants, sweatshirts, sweatpants, hats, visors, shoes, and belts in Class 025.	3230417
FULLMETAL ALCHEMIST	Clothing, namely, shoes, caps, hats, pajamas, shirts, t-shirts, shorts, sleepwear, slippers, pants and sweatsuits in Class 025.	3288616
	Clothing, namely, t-shirts, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, hats, caps, socks, polo shirts, and tops in Class 025.	3206704
	Short-sleeved or long-sleeved t-shirts in Class 025.	3453764
STAY METAL	Short-sleeved or long-sleeved t-shirts in Class 025.	3453765
METAL HAMMER	Clothing, namely, t-shirts, polo shirts, sweatshirts, sweatpants, track suits, lounge pants, hooded tops, jerseys, jackets, shirts, cardigans, leggings, jumpers, dresses, skirts, jackets, coats, trousers, jeans, vests, shorts, scarves, headgear, namely hats and caps, gloves, socks, belts being articles of clothing, underwear, pyjamas, dressing gowns... in Class 025.	4934592
	Clothing, namely, t-shirts, tank tops, hooded sweatshirts, jackets, wristbands as clothing; headgear for wear, namely, caps in Class 025.	4985879
METAL SLUG	Tee-shirts, polo shirts, jumper, dresses, hats and caps being headwear, visors being headwear, bandanas... clothing, namely pants and skirts... in Class 025.	5415139
METAL GOD	Clothing, namely t-shirts, sweatshirts, jackets... jeans... headgear, namely, caps, beanies, skull caps, skullies being headwear... in Class 025.	6297534
METAL SLUG COMMANDER	Tee-shirts, polo shirts, jumper, dresses, hats and caps being headwear, visors being	6848862

	headwear, bandanas... clothing, namely pants and skirts... in Class 025.	
AFFLICTION AMERICAN METAL	Clothing, namely, t-shirts, shirts...denim pants, denim shorts...beanies, hats, caps... in Class 025.	4560611
	Clothing, namely, shirts, pants, dresses, coats, headwear, sweatshirts, jackets, and underwear in Class 025.	4284634
	Clothing, namely, jackets, jerseys, shirts, sweatshirts, t-shirts, and headwear in Class 025.	4499189
SG LIQUID METAL	Belts, caps, dresses, hats, jackets, jeans, pants, skirts, tops, under-garments, and vests, all containing or integrating jewelry in their designs in Class 025.	4487381
LISTEN TO METAL	Clothing, namely, t-shirts and hoodies in Class 025.	4726033
METAL VENT TECH	Clothing, namely, t-shirts, shirts, tank tops, sweatshirts, sweaters, pants, underwear, tights; headwear, namely, headbands in Class 025.	5173215
HEAVY METAL GARAGE	Athletic uniforms, belts, coats, flip flops, footwear, headwear, hooded pullovers, hoods, hosiery, jeans, loungewear, neckwear, nightgowns, pajamas, pants, robes, sandals, scarves, shirts, sleepwear, slipper socks, slippers, suits, sweat shirts, vests, wind-jackets, wristbands in Class 025.	5125030
METAL KITTY CLOTHING COMPANY	Wearable garments and clothing, namely, shirts in Class 025.	5167018
	Clothing, namely, t-shirts, shirts, sweat shirts, tank tops; headgear, namely, hats and caps, all related to the automotive industry in Class 025.	5006215
METALPHANT	Bottoms, hats in Class 025.	5120581
THE HALL OF HEAVY METAL HISTORY	Clothing, namely, shirts, hats, jackets, sweatshirts in Class 025.	5282330

BRANDBLACK RARE METAL	Footwear in Class 025.	5302638
“THE METAL ROOF EXPERTS”	T-shirts in Class 025	5247680
METAL HEALTH	Headwear, shirts in Class 025.	5336608
MOUNTAINS2METAL	Hats; headwear; hoodies; shirts in Class 025.	5466071
MIKA METALS	Clothing, namely, shirts, sweatshirts, and hats; gloves in Class 025.	5533087
MOTOR CITY METAL	Hats; jackets; shirts in Class 025.	5552402
	Beanies; hats; shirts; baseball caps and hats; hooded sweat shirts; short sleeved or long sleeved t-shirts; sweat shirts; t-shirts in Class 025.	5776735
	Shirts and hats in Class 025.	5810221
	Belts for clothing, gloves, hats, jackets, pants, pyjamas, shirts, socks, sweatpants, sweatshirts, tops as clothing, baseball caps, hooded sweatshirts, knitted caps, skull caps, t-shirts, tank tops in Class 025.	5654073
MONTANA METAL CLOTHING COMPANY	Wearable garments and clothing, namely, shirts in Class 025.	5840735
METAL NECK	Hats, knitted caps, baseball caps, baseball caps and hats, graphic t-shirts, short-sleeved shirts, short sleeved or long sleeved t-shirts, sports caps and hats, sweat pants, sweat shirts, t-shirts, tee-shirts in Class 025.	5765393
TOO MUCH METAL FOR ONE HAND	T-shirts, clothing, namely bandanas, baseball caps, belts, berets, bib overalls, bikinis...gloves...jackets, jeans, jerseys...wristbands... in Class 025.	5708772
70000 TONS OF METAL	Bottoms as clothing; Headwear, namely, hats, baseball caps, stocking caps, bandanas; tops as clothing; wearable garments and clothing, namely, shirts; women’s clothing, namely, shirts, dresses, skirts, blouses in Class 025.	5850192

METALSMITH SOCIETY	Jackets, hats, t-shirts, tank tops, children's t-shirts, aprons, sweatshirts, hoodies, long sleeve and short sleeve t-shirts in Class 025.	6051727
METAL HALL OF FAME	Clothing, namely, shirts, hats, jackets, sweatshirts in Class 025.	6015520
BLACK METAL	Hoodies, shorts, t-shirts, board shorts, bomber jackets, camouflage jackets, fleece shorts, graphic t-shirts, heavy jackets in Class 025.	6122986
METALLICORE	Cleats for attachment to sports shoes containing in significant part metal in Class 025.	6049984
 Metal Fence Apparel	Athletic tops and bottoms for runners, jogger; hoodies; outerwear, namely, coats, hats, gloves; pants; shirts for adult, kids, women, men, babies; socks; sweatshirts; sweatshirts for runners, yoga; t-shirts; t-shirts for adults, kids, women, men, babies...baseball caps and hats... in Class 025.	6198685
	Caps being headwear, hats; Headwear; shirts; sweatshirts; t-shirts; hooded sweatshirts in Class 025.	6198718
	Clothing, namely, short sleeve t shirts, long sleeve t shirts, tank tops, sweatpants, basketball shorts, running shorts, hoodies, sweaters, sweatshirts, windbreaker jackets, raincoats; headwear, namely, hats and beanies in Class 025.	6269780
	Hats, shirts in Class 025.	6194296
FRIDAY BY FRIDAY METAL ATELIER	Bralettes, bras, dresses, gowns, shirts, skirts, halter tops, tube tops in Class 025.	6533904
FRIDAY BY FRIDAY METAL ATELIER	Handcrafted wearable art in the nature of clothing, namely, bralettes, bras, dresses, gowns, shirts, skirts, halter tops, tube tops made from noble metal; ornaments of precious metal in the nature of clothing, namely, shirts, pants, gowns and skirts; handcrafted wearable clothing and	6533955

	accessories, namely, bralettes, bras, dresses, gowns, shirts, skirts, halter tops, and tube tops made from noble metal in Class 025.	
METAL UMBRELLA	Leggings, shorts, socks, sweatpants, vests, bralettes, hats, hoodies, jackets, long-sleeved shirts, long sleeve pullovers, sweatshirts, t-shirts, tank tops, ankle socks, graphic t-shirts, gym shorts, hooded sweatshirts, muscle tops, polo knit tops, short-sleeved or long-sleeved t-shirts, sports jackets, wind-jackets in Class 025.	6805105
METAL EDGE	Headwear; shirts; sweatshirts in Class 025.	6547839
	Shirts; sweatshirts; t-shirts; baseball caps; hoodies; tank tops; graphic t-shirts; hooded sweatshirts; short-sleeved or long-sleeved t-shirts in Class 025.	6885907
MILITARY METAL	Shirts; sweatshirts; t-shirts; baseball caps; hoodies; tank tops; graphic t-shirts; hooded sweatshirts; short-sleeved or long-sleeved t-shirts in Class 025.	6885908
JERSEY METAL	Footwear, headwear, pants, shirts, shorts, sweatshirts, underwear, jackets in Class 025.	6743207
FIBRE-METAL	Safety hats and caps, winter liners for safety hats and caps, and caps for guarding the scalp against laceration in Class 025.	811008
METAL MADE EASY	Clothing, namely, cloth bibs, gloves, jackets, caps being headwear, and shirts in Class 025.	88431478 NOA issued

Evidence of third-party registrations for the same or similar goods can bear on a mark's conceptual strength. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1695 (Fed. Cir. 2018) (citing *Juice Generation*, 115 USPQ2d at 1675). Properly made of record, third-party registrations may be relevant, in the manner of dictionary definitions, "to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Juice Generation*, 115 USPQ2d at 1675 (internal citation quotation marks omitted); *see also Jack Wolfskin*, 116 USPQ2d at 1136. Even if "there is no evidence of actual use" of "third-party registrations," such registrations "may be given some weight to show the meaning of a mark in the same way that dictionaries are used." *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

None of these Principal Register registrations show that METAL has been disclaimed or include a claim of acquired distinctiveness in part under Trademark Act Section 2(f) as to this term. Nonetheless, such a large number of third-party registered marks incorporating METAL in connection with clothing demonstrates that the term has been weakened by third-party registrations to the extent that consumers are capable of differentiating similar marks based on slight distinctions. In other words, the USPTO recognizes that marks containing METAL for clothing may be distinguished by additional elements in the marks. *See In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012) (seven registrations incorporating "Grand Hotel" show that the Patent Trademark Office views the marks

“as being sufficiently different from the cited registrant’s mark, and from each other, such as not to cause confusion” and “we presume that the owner of the cited registration did not have a problem with the registration of these third-party marks, as they all issued after the registration of the cited registrant’s registration without challenge by the registrant”); *Plus Prods. v. Nat. Organics, Inc.*, 204 USPQ 773, 779 (TTAB 1979) (numerous PLUS marks on the trademark register for vitamins reflect the Office’s belief, trademark owners’ belief, and plaintiff’s belief that PLUS marks can be registered side by side for vitamins without confusion provided there are minimal differences between the marks); *Jerrold Elecs. Corp. v. Magnavox Co.*, 199 USPQ 751, 758 (TTAB 1978) (third-party registrations “reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can coexist provided that there is a difference.”).

Thus, the scope of protection of Opposer’s registered mark METAL falls on the more limited end of the spectrum, meaning that the sixth *DuPont* factor weighs against finding a likelihood of confusion.

2. The Similarity or Dissimilarity of the Marks

Next we consider the first *DuPont* factor which involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay*, 73 USPQ2d at 1692 (citing *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 1742, 1746 (TTAB 2018), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *accord Krim-Ko Corp. v. Coca-*

Cola Bottling Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“Similarity is not a binary factor but is a matter of degree.” *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). “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) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). Further, the marks “must be considered ... in light of the fallibility of memory ...” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Nat’l Data Corp.*, 753

F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *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.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 224 USPQ at 751.

We now compare Opposer’s mark METAL with Applicant’s mark METAL HEADS, both in standard characters. At the outset, we address Opposer’s reliance on Applicant’s admission “that Applicant’s Mark is similar to the mark METAL.”¹³ We cannot find from this admission alone that the first *DuPont* factor weighs in favor of a likelihood of confusion. This is because the request did not ask Applicant to admit to each component of the analysis as set forth under *DuPont* (appearance, sound, connotation and commercial impression). While we agree that Applicant has conceded

¹³ *See* Opposer’s First Notice of Reliance Ex. 57, Opposer’s First Set of Requests for Admissions, No. 37; 32 TTABVUE 177-78, 183-84.

that the marks are “similar,” this concession is only the beginning of our analysis. Two marks can be “similar” in some respects but quite different in others.

Opposer argues that both marks are nearly identical in sight, sound, and meaning because Applicant’s mark commences with the word “metal.” There is no question that the parties’ marks are similar in appearance and sound insofar as Applicant’s mark commences with the word METAL, the entirety of Opposer’s mark. While both marks share the conceptually weak term “metal,” the similarities stop there.

First, we disagree with Opposer’s contention that consumers are likely to focus on the first word METAL in Applicant’s METAL HEADS. There is no mechanical test to select the dominant element of a mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017). While the first term in a mark generally is considered to be the feature which will be called for, and so remembered, by consumers, this is not invariably the case. *See Stone Lion*, 110 USPQ2d at 1161 (“the Board did not err in finding that ‘STONE LION CAPITAL’ is ‘similar in sight, sound, meaning, and overall commercial impression’ to ‘LION CAPITAL’ and ‘LION.’”); *In re Chatam Int’l*, 71 USPQ2d at 1946 (“Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”). Here the evidence shows that Applicant’s mark METAL HEADS is well-recognized unitary term with a very different meaning from the singular term METAL. Three different dictionaries

define the noun “metalhead” as “a fan or performer of heavy metal.”¹⁴ The fact that this term appears in multiple dictionary entries reflects that it is firmly entrenched in the U.S. English language lexicon. The combination of the individual words “metal” and “heads” in Applicant’s mark creates a unique commercial impression that is very different from the meanings or connotations of each individual word. “Metalhead” (and its plural noun form) is so well recognized by consumers that the two words “metal” and “head” cannot be regarded as separable. *See In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). As a result, METAL HEADS is a unitary mark and must be considered as such.

The meaning of Applicant’s mark as signifying a “fan or performer of heavy metal” stands in contrast to the dictionary definition of “metal” as “any of the various opaque, fusible, ductile, and typically lustrous substances that are good conductors of electricity and heat, form cations by loss of electrons, and yield basic oxides and hydroxides; especially: one that is a chemical element as distinguished from an alloy.”¹⁵ While Applicant’s mark does incorporate the entirety of Opposer’s mark, it engenders a different connotation and commercial impression (i.e., a fan or performer

¹⁴ Applicant’s Notice of Reliance, Ex. B, 40 TTABVUE 58-59 (online version of THE MERRIAM-WEBSTER DICTIONARY <https://www.merriam-webster.com/dictionary/metalhead> accessed on December 16, 2022. *See also* THE FREE DICTIONARY and DICTIONARY.COM defining “metalhead” as slang for “a fan of heavy metal music” accessed on December 16, 2022. Applicant’s Notice of Reliance Ex. B, 40 TTABVUE 70 and 76.

¹⁵ Applicant’s Notice of Reliance, Ex. B, 40 TTABVUE 58-59 (online version of THE MERRIAM-WEBSTER DICTIONARY <https://www.merriam-webster.com/dictionary/metalhead> accessed on December 16, 2022).

of heavy metal music). Thus, the marks have their own unique connotations that project separate meanings and distinct commercial impressions.

We have compared the marks METAL and METAL HEADS in their entireties. *See Jack Wolfskin*, 116 USPQ2d at 1134 (acknowledging the fundamental rule that the marks must be considered in their entireties). When compared overall, despite the similarity in sound and appearance, the marks are more dissimilar than similar in connotation and commercial impression. In other words, consumers will readily distinguish Applicant's mark METAL from Opposer's unitary mark METAL HEADS. The first *DuPont* factor therefore weighs against a finding of likelihood of confusion.

3. The Goods

Next we compare the goods as they are identified in the involved application and Opposer's registration, the second *DuPont* factor. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Comput. 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). *See also B&B Hardware*, 135 S. Ct. at 1300 (recognizing that an "applicant's right to *register* must be made on the basis of the goods described in the application"). It is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective goods need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that goods emanate from the same source." *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7- Eleven Inc. v. Wechsler*, 83 USPQ2d

1715, 1724 (TTAB 2007)). *See also In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Opposer need not prove, and we need not find, similarity as to each good listed in the pleaded registration or challenged application. "It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application." *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

To show that the parties' goods are related, Opposer submitted printouts from the TESS database of over fifty (50) use-based third-party registrations listing either ski jackets, snowboard jackets, jeans and shirts on one hand and headwear on the other in International Class 25. Below is a representative sample:¹⁶

Registration No. 2380188 for the mark GUESS? and Design, for in relevant part "men's, women's, children's and infants' clothing, namely, ... headwear, ...jeans, ... jackets, shirts, ..."

Registration No. 2234261 for the mark CATERPILLAR and Design, for in relevant part "Work, sport and casual clothing namely, caps, ... headwear, ... jackets, men's and women's shirts and jeans"

Registration No. 2348674 for the stylized mark JUICY COUTURE, for in relevant part "Clothing, namely, ... headwear, ... shirts, ... caps, ... jackets, ... jeans, ... shirts, ..."

Third-party registrations based on use in commerce that individually cover a number of different goods may have probative value to the extent that they serve to suggest that the listed goods are a type that may emanate from the same source.¹⁷ *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *8 (TTAB 2019); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988).

¹⁶ Opposer's First Notice of Reliance, Exs. 2-4, 32 TTABVUE 20-26.

¹⁷ We may assume that the third-party registrations listing "jackets" and "headwear" without any further specification as to type encompass Opposer's and Applicant's "ski jackets," "snowboarding jackets" and headwear items. *See Country Oven*, at *9 ("Just as we must consider the full scope of the goods and services as set forth in the application and registration under consideration, we must consider the full scope of the goods and services described in a third-party registration.").

This evidence, along with the following admissions by Applicant, support a finding of relatedness:¹⁸

REQUEST FOR ADMISSION NO. 29:

Admit that the goods identified in Applicant's U.S. App. Serial No. 88503926 are similar to the goods in connection with which Opposer uses the METAL Mark.

REQUEST FOR ADMISSION NO. 30:

Admit that the goods identified in Applicant's U.S. App. Serial No 88503926 are similar to the good in Opposer's U.S. Reg. No. 4299652.

Opposer also relies on Applicant's admissions to argue that the parties items are complementary in nature since skiers and snowboarders will frequently wear ski or snowboard jackets along with knit beanies, skullies, and helmet liners while skiing and snowboarding.¹⁹ The relevant admissions are as follows:²⁰

REQUEST FOR ADMISSION NO. 1:

Admit that headwear is used by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 2:

Admit that headwear is purchased by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 3:

Admit that caps are used by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 4:

¹⁸ Opposer's First Notice of Reliance, Ex. 57; 32 TTABVUE 180-181.

¹⁹ Opposer's Brief, p. 9; 46 TTABVUE 15.

²⁰ Opposer's First Notice of Reliance, Ex. 57; 32 TTABVUE 177-180.

Admit that caps are purchased by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 5:

Admit that skullies are used by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 6:

Admit that skullies are purchased by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 7:

Admit that knit beanies are used by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 8:

Admit that knit beanies are purchased by skiers and snowboarders.

REQUEST FOR ADMISSION NO. 9:

Admit that skiers and snowboarders wear helmets while skiing or snowboarding.

REQUEST FOR ADMISSION NO. 10:

Admit that skiers and snowboarders wear hats while skiing or snowboarding.

....

REQUEST FOR ADMISSION NO. 28:

Admit that the consumers for the goods in connection with which Applicant's Mark is used are similar to the consumers for the goods in connection with which the METAL Marks is used.

Applicant's admissions establish that some of Applicant's and Opposer's goods are complementary. *See, e.g., In re Davia*, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the

same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). While Opposer's jackets are restricted to particular use (skiing and snowboarding), Applicant's "Headwear, namely, headwear for adults, children and babies, caps, skullies being headwear, ... knit beanies, helmet liners being headwear, ..." contain no limitations. In short, we find that these goods are complementary products that could be purchased and used for the same general purposes and used together. *See Martin's Famous Pastry Shoppe*, 223 USPQ at 1290 ("[C]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.")

The evidence shows that the parties goods are related and complementary in nature. As a result, the second *DuPont* factor weighs in favor of finding a likelihood of confusion.

4. The Established, Likely-to-Continue Channels of Trade and Classes of Consumers

This brings us to the third *DuPont* factor, the established, likely-to-continue channels of trade and classes of consumers as delineated in the identifications. *See Detroit Athletic Co.*, 128 USPQ2d at 1051. Because the identified goods in the application are unrestricted as to trade channels and classes of purchasers, we must presume that they travel in the ordinary trade and distribution channels for the

goods. *See Cai v. Diamond Hong*, 127 USPQ2d at 1801.

Applicant's admissions establish that the parties' trade channels and classes of consumers overlap:²¹

REQUEST FOR ADMISSION NO. 11:

Admit that the types of stores that sell ski or snowboard jackets also sell hats.

REQUEST FOR ADMISSION NO. 12:

Admit that the types of stores that sell ski or snowboard jackets also sell knit beanies.

REQUEST FOR ADMISSION NO. 13:

Admit that the types of stores that sell ski or snowboard jackets also sell skullies.

REQUEST FOR ADMISSION NO. 14:

Admit that ski jackets and knit beanies are both sold in ski shops.

REQUEST FOR ADMISSION NO. 15:

Admit that ski jackets and skullies are both sold in ski shops.

REQUEST FOR ADMISSION NO. 16:

Admit that ski jackets and knit beanies are both sold in sporting goods stores.

REQUEST FOR ADMISSION NO. 17:

Admit that ski jackets and skullies are both sold in sporting goods stores.

REQUEST FOR ADMISSION NO. 18:

²¹ *See* Opposer's First Notice of Reliance Ex. 57; 32 TTABVUE 177-84 (RFA Nos. 1-19, 22-23, 27-30).

Admit that ski jackets and snowboard jackets are sold in the same channels of trade as knit beanies.

REQUEST FOR ADMISSION NO. 19:

Admit that ski jackets and snowboard jackets are sold in the same channels of trade as skullies.

REQUEST FOR ADMISSION NO. 20:

Admit that Applicant's U.S. App. Serial No. 88503926 places no restrictions on the channels of trade for the goods identified therein.

REQUEST FOR ADMISSION NO. 21:

Admit that Opposer's U.S. Reg. No. 4299652 places no restrictions on the channels of trade for the goods identified therein.

REQUEST FOR ADMISSION NO. 22:

Admit that the trade channels for the goods in U.S. App. Serial No. 88503926 are similar to the trade channels for the goods in Opposer's U.S. Reg. No. U.S. 4299652.

REQUEST FOR ADMISSION NO. 23:

Admit that the trade channels for the goods in connection with which Applicant's Mark is to be used are similar to the trade channels for the goods in connection with which the METAL Mark is used.

REQUEST FOR ADMISSION NO. 24:

Admit that jeans and shirts, on the one hand, and Applicant's Goods on the other hand, are both sold to the general public.

REQUEST FOR ADMISSION NO. 25:

Admit that Applicant's U.S. App. Serial No. 88503926 places no restrictions on the consumers for the goods identified therein.

REQUEST FOR ADMISSION NO. 26:

Admit that Opposer's U.S. Reg. No. 4299652 places no restrictions on the consumers for the goods identified therein.

REQUEST FOR ADMISSION NO. 27:

Admit that the consumers for the goods in U.S. App. Serial No. 88503926 are similar to the consumers for the goods in Opposer's U.S. Reg. No. U.S. 4299652.

Applicant has admitted that the trade channels overlap because ski and snowboard equipment stores sell both ski and snowboard jackets and beanies, skullies, or helmet liners. Applicant has also admitted that the overlapping classes of consumers includes members of the general public seeking ski or snowboarding apparel and headwear. Thus based on Applicant's admissions, the third *DuPont* factor also weighs in favor of finding a likelihood of confusion.

5. Purchasing Conditions

"The fourth *DuPont* factor considers '[t]he conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.'" *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73

USPQ2d at 1695.

Applicant argues that because it is a wholesaler, it caters to a sophisticated, knowledgeable consumer base. However, the identifications in the application and registration contain no specified price point. Nor is Applicant's identification limited to wholesalers and Opposer's limited to retailers. We cannot assume, as Applicant urges, that these items are rendered to different classes of buyers in different marketing contexts at different prices. Rather, we must assume that the types of buyers overlap to include wholesale and retail purchasers, expert skiers and snowboarders seeking high performance jackets who carefully scrutinizes each item before purchase, the sophisticated fashionista seeking a designer look as well as the less informed bargain hunter or novice skier and snowboarder. Ordinary consumers are likely to exercise only ordinary care, and given the lack of price restrictions in the identifications, may even buy inexpensive clothing items on impulse. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) ("When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.").

Focusing on the least sophisticated potential customers which in this case consists of members of the general public, we find that the fourth *DuPont* factor weighs in favor of a likelihood of confusion. *See Stone Lion*, 110 USPQ2d at 1163 ("Although the services recited in the application also encompass sophisticated investors, Board

precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”).

6. Actual Confusion and Contemporaneous Use

We now address the seventh *DuPont* factor, the nature and extent of any actual confusion, and the related eighth *DuPont* factor, the extent of the opportunity for actual confusion as argued by Opposer. In assessing these *DuPont* factors, we are required “to look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020). *See also In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

Opposer asserts that these *DuPont* factors are neutral. We agree. The involved application is based on an intent to use, and Applicant has not introduced evidence showing that it has commenced use in commerce. As a result, there has been no opportunity for confusion to occur. *See, e.g., Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion is of very little, if any, probative value here because ... no evidence was presented as to the extent of ETF’s use of the VITTORIO RICCI mark on the merchandise in question in prior years ...”).

7. Variety of Goods

The ninth *DuPont* factor considers “[t]he variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark).” *DuPont*, 177 USPQ at 567. “If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant’s related good under a similar mark as an extension of the plaintiff’s line.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *15

(TTAB 2020) (citing *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014)). On the other hand, if the plaintiff’s “uses are insufficient to persuade us that [plaintiff] has used ... [its] mark on a variety of goods ...[,] [w]e ... [would] find the ninth *DuPont* factor to be neutral with respect to a finding of likelihood of confusion.” *Id.* at *15.²² “This factor may favor a finding that confusion is likely if the goods or services are not obviously related, but has less impact if the parties goods or services in issue are identical or closely related.” *Monster Energy Co. v. Chun Hua Lo*, 2023 USPQ2d 87, at *39 (TTAB 2023) (citing *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (TTAB 2003)).²³

Opposer argues that because it owns a registration for the mark METAL in connection with four items of clothing (ski jackets, snowboard jackets, shirts, and jeans) it uses its mark on a variety of goods. Opposer’s argument reflects a misunderstanding of the ninth *DuPont* factor. Nothing in the record suggests that beyond the four clothing items in the pleaded registration, Opposer uses its METAL mark on products outside the realm of clothing. Indeed, because Opposer presented no testimony in this case, it has not made of record any evidence of actual use in commerce of its products. We therefore deem the ninth *DuPont* factor neutral.

²² Applicant, for its part, asserts arguments that do not fall under the ninth *DuPont* because they apply to its intended use of its applied-for mark, not Opposer’s. We have considered Applicant’s arguments under the thirteenth *DuPont* factor.

²³ To be clear, Opposer did not plead or argue that it owns a family of METAL marks.

8. The Extent of Potential Confusion

The twelfth *DuPont* factor examines “the extent of potential confusion, i.e., whether de minimis or substantial.” *DuPont*, 177 USPQ at 567.

Opposer asserts that the potential for confusion between METAL and METAL HEADS is “substantial” because “both parties offer similar goods in the same or similar trade channels to the same consumers” and because “the parties’ marks look and sound nearly identical.”²⁴ Not surprisingly, Applicant counters that the potential for confusion is de minimus given the differences in the parties’ marks and goods.

Both Opposer’s and Applicant’s arguments pertain to the first and second *DuPont* factors which we have already discussed. Neither Opposer nor Applicant provide any further explanation for their positions or evidentiary support. We therefore find the twelfth *DuPont* factor neutral.

9. Any Other Established Fact Probative of the Effect of Use

The thirteenth *DuPont* factor allows for a consideration of “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. Under this factor we consider Applicant’s arguments that “as the producer of promotional products, Applicant asserts that its marks are not the primary trademark that consumers will encounter or associate with its goods” since “Applicant’s goods are created with the specific intent that the branding and trademarks of others be placed upon them.”²⁵ As Applicant further explains, the brand names of these third-parties, not Applicant’s

²⁴ Opposer’s Brief, p. 13; 46 TTABVUE 19.

²⁵ Applicant’s Brief, p. 34; 47 TTABVUE 37.

METAL HEADS Mark, will “receive primary billing on the goods, and due to their size and placement, will draw the attention of the consumer, leading purchasers to believe that the promoted mark holder, rather than Applicant, is the source of the goods.”²⁶

Applicant’s arguments do not mitigate the likelihood of confusion. This is because we compare the marks as set forth in the applied-for application and Opposer’s registration and do not consider the presence of third-party marks on the items. The Board is an administrative tribunal tasked to determine only the right to register. *See, e.g., General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (Board lacks authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief). We therefore deem this factor neutral.

C. Balancing of the *DuPont* Factors

“No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

We weigh the *DuPont* factors for which there has been evidence and argument. *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). While the second, third, and fourth *DuPont* factors favor of finding a likelihood of

²⁶ *Id.*

confusion, the first and sixth factors show otherwise. The remaining *DuPont* factors discussed above are neutral.

Weighing these factors, and keeping in mind the relative conceptual weakness of Opposer's mark METAL under the sixth *DuPont* factor, we find confusion unlikely. Opposer's mark METAL has a more limited scope of protection due to the large number of registered composite marks for clothing incorporating METAL. As a result, consumers will be able to distinguish the parties' marks by virtue of the presence of HEADS in Applicant's mark, METAL HEADS, and attribute a different connotation and meaning to Applicant's mark.

Accordingly, while Opposer has proved its entitlement to a statutory cause of action and priority, it has failed to prove likelihood of confusion by a preponderance of the evidence.

Decision: Opposer's Section 2(d) claim is dismissed.