

This Opinion is not a
Precedent of the TTAB

Mailed: January 5, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Trigon Turf Sciences LLC

v.

JRM, Inc.

Opposition No. 91255001
to Serial No. 88649876

Joseph A. Uradnik of Uradnik Law Firm PC for Opposer, Trigon Turf Sciences LLC.
Blake P. Hurt of Tuggle Duggins PA for Applicant, JRM, Inc.

Before Thurmon, Deputy Chief Administrative Trademark Judge, and
Kuczma and Heasley, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

JRM, Inc. (“Applicant”) filed an application to register the mark SAMURAI TINE
(in standard characters) for:

Metal turf aeration tines, in International Class 6.¹

¹ Application Serial No. 88649876 was filed on October 10, 2019, based on Applicant’s assertion of a bona fide intent to use the mark in commerce for the goods in International Class 6 under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). “TINE” is disclaimed.

Trigon Turf Sciences LLC (“Opposer”) opposes registration of Applicant’s mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its ownership of U.S. Registration No. 5600255 for the mark:



for:

Metal turf aeration tines, in Class 6.²

Because Applicant did not file a second amended answer and counterclaim in response to the Board’s August 18, 2020 order (12 TTABVUE 7), Applicant’s First Amended Answer (7 TTABVUE 2-3), denying the salient allegations, is its operative responsive pleading.³

² Registration No. 5600255 issued on November 6, 2018. “The mark consists of the words ‘NINJA TINES’ below a stylized image of a samurai.” “TINES” is disclaimed and color is not claimed as a feature of the mark. *See* Opposer’s Exhibit A: Declaration of Thomas N. Tremblay, Jr. (32 TTABVUE 23-26), Exhibit 2 (32 TTABVUE 44-50).

Citations to the prosecution record are to the Trademark Status & Document Retrieval (“TSDR”) system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board’s online docketing system available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

³ The September 22, 2020 Board order (15 TTABVUE) ruled Applicant’s First Amended Answer (7 TTABVUE 2-3) to be the operative pleading, dismissed without prejudice Applicant’s counterclaim in Applicant’s First Amended Answer and Affirmative Defenses to Notice of Opposition and Counterclaim for Cancellation (7 TTABVUE 4-11), and struck Applicant’s affirmative defenses (7 TTABVUE 3).

I. Accelerated Case Resolution

The parties agreed to resolve this proceeding by Accelerated Case Resolution (“ACR”) and filed a Stipulation as to Use of Accelerated Case Resolution (30 TTABVUE) that the Board approved (31 TTABVUE). The parties’ Stipulation sets forth the following ACR procedure for this case:

- in lieu of trial, the Board can resolve any issues of material fact that may be presented in making a final determination on the merits (paragraph No. 1);
- parties have: conducted Initial Discovery Conference and exchanged Initial Disclosures, propounded written discovery requests and no further discovery requests shall be propounded, and neither party shall take depositions of the other party or such party’s employees or agents, discovery to be completed by August 15, 2021; (paragraph Nos. 2-3, 9, 13);
- testimony may be presented by affidavit or declaration, and through any exhibits to which the affiants or declarants refer; parties may submit as exhibits to their affidavits, declarations or briefs any material that in a typical trial could be submitted by notice of reliance (paragraph No. 4);
- neither party will object to the authenticity of admissibility of the affidavits, declarations, documents, and exhibits so long as the declarant or affiant establishes that they have knowledge of the facts presented; the parties retain their rights to challenge admissibility based on hearsay (paragraph No. 5);
- discovery responses and documents produced in discovery may be submitted as exhibits without need for accompanying testimony, but parties may contest the relevancy, materiality or weight of the evidence; all documents produced in response to a request for production of documents are deemed authentic business records (paragraph No. 6);
- parties will not object to the expert status or to the admission of the expert testimony reports of Dr. Michael Wert, on behalf of Opposer, and Dr. Robert Hellyer, on behalf of Applicant (paragraph Nos. 7-8);



- opening briefs in the form of cross motions to summary judgment to be filed no later than September 1, 2021, and responsive briefing due no later than October 1, 2021, parties waive oral argument (paragraph Nos. 10-12).⁴

Opposer, as the party in the position of plaintiff, bears the burden of proving its case by a preponderance of the evidence. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015) (“The party opposing registration bears the burden of proof, see § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, see 15 U. S. C. §1063(b).”); *Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (plaintiff’s burden is to establish the case by a preponderance of the evidence).

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file history of Applicant’s Application Serial No. 88649876, which is the subject of this proceeding. Additionally, there is the following:

Opposer’s evidence:

1. Exhibit A: Declaration of Thomas N. Tremblay, Jr., majority owner and President of Opposer, Trigon Turf Sciences LLC, (32 TTABVUE 23-26), with the following Exhibits:
 - Exhibit 1: pages from Opposer’s website www.ninjatines.com (32 TTABVUE 27-43);
 - Exhibit 2: copy of Registration No. 5600255 for Opposer’s mark NINJA  TINES & Design, i.e., , for “metal turf aeration tines” and Trademark Status & Document Retrieval (TSDR) report for this Registration (32 TTABVUE 44-50);

⁴ See Stipulation as to Use of Accelerated Case Resolution (30 TTABVUE).

- Exhibit 3: annual sales reports for Opposer's metal turf aeration tines from March 2018 to March 2020 (32 TTABVUE 51-53);
 - Exhibit 4: TSDR report for Applicant's Application Serial No. 88649876 for SAMURAI TINE mark for "metal turf aeration tines" (32 TTABVUE 54-60).
2. Exhibit B: Declaration of Oscar Tenorio, an independent contractor serving as Opposer's social media consultant, (32 TTABVUE 62-64), with the following Exhibits:
- Exhibit 1: copy of Mr. Tenorio's discussion on Twitter with Mr. Craig Harris, Director of Agronomy at Greenville Country Club's Chanticleer and Riverside courses in Greenville, South Carolina, on April 22, 2020 (32 TTABVUE 65);
 - Exhibit 2: copy of Mr. Tenorio's discussion on Twitter with Mr. Graham Wieja, Golf Course Superintendent at Anderson Creek Golf Club, the week of May 18, 2020 (32 TTABVUE 66);
3. Exhibit C: Testimony Report of Michael Wert, PHD prepared for Joseph A. Uradnik of Uradnik Law Firm PC with a copy of his curriculum vitae (32 TTABVUE 67-76);
4. Exhibit D: Declaration of Joseph A. Uradnik, Opposer's counsel in this Opposition (32 TTABVUE 77-79), with the following Exhibits:
- Exhibit 1: annotated images from the webpages in Exhibit 2 (32 TTABVUE 80-85);
 - Exhibit 2: various Internet articles and images regarding samurai (32 TTABVUE 86-150).

The record also includes the following evidence submitted by Applicant:

1. Declaration of James R. Merritt, President of Applicant, in Support of Applicant's Cross-Motion for Summary Judgment,⁵ (34 TTABVUE 31-35) with:

⁵ The Declaration of James R. Merritt in Support of Applicant's Cross-Motion for Summary Judgment (34 TTABVUE 31-35, Confidential 33 TTABVUE 31-35) does not bear the date of execution, i.e., indicating it was executed "This the ___ day of September, 2021." Inasmuch as Opposer has not objected to the admission of this Declaration, it has been admitted into evidence.

- Exhibit 1: copy of TSDR record for Applicant's Application No. 88649876 (34 TTABVUE 36-62);
2. Declaration of Blake P. Hurt, counsel for Applicant,⁶ in Support of Applicant's Motion for Summary Judgment (34 TTABVUE 63-65), with the following Exhibits:
- Exhibit 1: copy of Opposer's Responses to Applicant's First Set of Interrogatories, Requests for the Production of Documents and Requests for Admissions (34 TTABVUE 67-77) (Confidential 33 TTABVUE 68);
 - Exhibit 2: copy of the TSDR record for SAMURAI 360 and Registration No. 5282525 and the TSDR record for SAMURAI 360 issued to Jordan Drew Corporation (34 TTABVUE 78-123);
 - Exhibit 3: copy of the TSDR record for NINJA KNIFE and Registration No. 4679095 issued to Dynamite Marketing Inc. (34 TTABVUE 124-167);
 - Exhibit 4: copy of the TSDR record for SAMURAI and Registration No. 3507038 issued to Great Divide Brewing Company (34 TTABVUE 168-251);
 - Exhibit 5: copy of the TSDR record for NINJA and Registration No. 3753805 issued to Asheville Pizza and Brewing Company (34 TTABVUE 252-354);
 - Exhibit 6: copy of the TSDR record for SAMURAI and Registration No. 4883210 issued to AUSA Premium Cigar Holdings Inc. (34 TTABVUE 355-403);

Additionally, it is noted that Applicant's summary judgment brief is entitled "Applicant's Motion for Summary Judgment" while the accompanying Merritt Declaration is entitled "Declaration of James R. Merritt in Support of Applicant's Cross-Motion for Summary Judgment." Both Applicant's brief and the Merritt Declaration are filed in connection with Applicant's summary judgment motion filed September 1, 2021.

⁶ Applicant's Motion for Summary Judgment pp. 16-17 (34 TTABVUE 22-23) also cited to a previously-filed Declaration of Blake P. Hurt in Support of Applicant's Response in Opposition to Opposer's Motion for Summary Judgment at 21 TTABVUE. Opposer did not object to Applicant's reference to this Hurt Declaration (and Exhibit) (*see* Opposer's Response to Applicant's Motion for Summary Judgment at 36 TTABVUE 5).

- Exhibit 7: copy of the TSDR record for NINJA and Registration No. 3644492 issued to K. Hansotia & Co. (34 TTABVUE 404-502).

In accordance with their Stipulation, both parties filed ACR briefs⁷ and filed responses to each other's ACR brief.⁸

III. Entitlement to a Statutory Cause of Action

Opposer's entitlement to bring a statutory cause of action, formerly referred to as "standing," is a threshold issue that must be proven by the plaintiff in every inter partes case. To determine whether a party has established entitlement to a statutory cause of action, we consider whether it has demonstrated a real interest in the proceeding and a reasonable belief of damage. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020) (discussing the application of the zone-of-interests and proximate causation test under *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 US 118 (2014)), *cert. denied*, ___ U.S. ___, 141 S. Ct. 2671 (Mem.) (2021); *see also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020) (discussing entitlement to bring a cause of action), *reh'g en banc denied*, 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *cert. denied*, __ U.S. ___, 142 S. Ct. 82, (Mem.) (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 of the Trademark Act, 15 U.S.C.

⁷ Opposer's Motion for Summary Judgment (32 TTABVUE); Applicant's Motion for Summary Judgment (34 TTABVUE, Confidential 33 TTABVUE).


⁸ Opposer's Response to Applicant's Motion for Summary Judgment (36 TTABVUE); Applicant's Response to Opposer's Motion for Summary Judgment (35 TTABVUE).

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§§ 1063, 1064, remain applicable as the tests “share a similar purpose and application.” *Corcamore*, 2020 USPQ2d 11277, at *7; *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388 at *1 (TTAB 2020).

Opposer has made of record its Registration No. 5600255 for the mark NINJA



TINES & Design, i.e., , for “metal turf aeration tines” in International Class 6.⁹

Accordingly, Opposer is within the zone-of-interests protected by § 2(d) of the Trademark Act and has shown the requisite proximate causation between Applicant’s application and Opposer’s claim. Therefore, it possesses a real interest in the proceeding, is not an intermeddler, and has established a reasonable belief of damage to oppose registration of Applicant’s mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (“[P]rior registrations ... and the products sold under the mark they register suffice to establish . . . [a] direct commercial interest and its . . . [entitlement to bring and maintain a statutory cause of action].”).

IV. Grounds of Opposition

To prevail on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), it is Opposer’s burden to prove by a preponderance of the evidence priority of use and likelihood of confusion.

⁹ See Exhibit 2, a copy of Registration No. 5600255 for Opposer’s mark NINJA TINES & Design and the TSDR report for said Registration (32 TTABVUE 44-50) attached to Opposer’s Exhibit A, and the Tremblay Declaration (32 TTABVUE 23-26). The Board has previously acknowledged Opposer’s entitlement to bring a cause of action and priority. *See* April 28, 2021 Board order at 29 TTABVUE 3-4.

Cunningham v. Laser Golf, 55 USPQ2d at 1848; *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

A. Priority

Because Opposer's pleaded Registration is of record, and Applicant has not counterclaimed for cancellation of the Registration, priority is not at issue in this proceeding, with respect to the goods identified in Opposer's Registration. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). Thus, Opposer has priority due to its registration of the mark NINJA TINES & Design, which Applicant does not dispute.

B. Likelihood of Confusion

In determining the likelihood of confusion, we must analyze all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (*DuPont* "articulated thirteen factors to consider when determining likelihood of confusion"). We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344,

98 USPQ2d 1253, 1261 (Fed. Cir. 2011). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong*, 127 USPQ2d at 1800 (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); *M2 Software v. M2 Commc’ns*, 78 USPQ2d at 1947 (even within *DuPont* list, only factors that are “relevant and of record” need be considered).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We have also considered other *DuPont* factors for which the parties have submitted evidence and argument. *DuPont*, 177 USPQ at 567.

1. Similarity of the Goods, Trade Channels and Class(es) of Customers

The second *DuPont* factor involves consideration of the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The goods in Applicant’s application, metal turf aeration tines, are identical to the goods in Opposer’s Registration No. 5600255.¹⁰

¹⁰ Applicant acknowledges that “[l]ike Applicant, Opposer sells turf aeration tines,” Applicant’s Summary Judgment Brief p. 4 (34 TTABVUE 10); Applicant “does not contest

Because Applicant’s and Opposer’s identification of goods are identical without any restrictions, we presume that they move in the same customary trade channels for such goods, and target the same potential customers for such goods. *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....’”) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012)); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (“absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers” citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983)).

Applicant’s argument that Applicant and Opposer provide their identical goods in different trade channels to different classes of customers has little merit. Although Applicant may offer its goods to a wider cross-section of purchasers than Opposer,¹¹ both of their products are marketed and sold to golf course maintenance personnel,

that the goods and services sold under the two marks are substantially similar and that the second (2nd) factor, when viewed in isolation, falls in Opposer’s favor.” *Id.* at p. 9 (34 TTABVUE 15); and “. . . Applicant concedes that the goods at issue are similar, with both being metal aerification tines used in landscaping purposes” Applicant’s Response to Opposer’s Motion for Summary Judgment p. 16 (35 TTABVUE 21).

¹¹ See Merritt Declaration, ¶¶ 4-5 (34 TTABVUE 31) (Applicant provides its products to those responsible for “the care and maintenance of golf courses,” and “has expanded its product offerings to a wider group of turf-grass management industries and industries beyond turf-grass management...”).

including golf course superintendents.¹² In any event, the Board, may not read limitations or restrictions as to trade channels or classes of purchasers into Applicant's unrestricted application or Opposer's unrestricted registration, nor may the Board resort to the use of extrinsic evidence to restrict them. *Cai v. Diamond Hong*, 127 USPQ2d at 1801; *Stone Lion v. Lion Capital*, 110 USPQ2d at 1162; *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *17 (TTAB 2020). Thus, contrary to Applicant's argument that the trade channels do not overlap,¹³ Applicant's and Opposer's trade channels and classes of purchasers are considered to be the same.

Therefore, the identity of the goods, which travel in the same channels of trade to the same classes of customers, supports a likelihood of confusion under the second and third *DuPont* factors.

2. Customer Sophistication

We move to the fourth *DuPont* factor which considers “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Sophistication under the fourth *DuPont* factor is important because sophisticated purchasers may be expected to exercise greater care avoiding a likelihood of confusion.

¹² See Declaration of Thomas N. Tremblay, Jr., ¶ 12 (32 TTABVUE 26); Merritt Declaration, ¶¶ 16, 28 (34 TTABVUE 33-35); and Declaration of Blake P. Hurt in Support of Applicant's Motion for Summary Judgment, Exhibit 1, Opposer's Response to Applicant's Interrogatory No. 5 (34 TTABVUE 70).

¹³ See Applicant's Response to Opposer's Motion for Summary Judgment pp. 16-17 (35 TTABVUE 21-22).

Applicant maintains that the relevant customers of Applicant's and Opposer's goods are sophisticated, which supports a lack of likelihood of confusion.¹⁴ The testimony shows that the parties' customers include golf course managers and other similar turf professionals.¹⁵ The purchasing public in this case resemble those in the *Astra* and *Electronic Design* cases, where the relevant customers were technical personnel having specialized knowledge about the goods and services, resulting in findings that their sophistication would be sufficient to render confusion less likely. *See Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983) (court held that purchasers of local anesthetic preparations, cardiovascular medicines, and prefilled syringes, on the one hand, and purchasers of computerized blood analysis machines, on the other hand, are distinct professionals and unlikely to be confused); *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (purchasers of the applicant's battery chargers or power supplies for electronic devices, and purchasers of the opposer's computer service systems, were mostly sophisticated consumers of these goods and thus, confusion was not likely).

The parties' metal aeration tines are not obtained as a result of impulse purchases made by members of the general public. As supported by the testimony of Applicant's President, James Merritt, a former golf course superintendent who also has

¹⁴ Applicant's Response to Opposer's Motion for Summary Judgment p. 18 (35 TTABVUE 23).

¹⁵ Tremblay Declaration at ¶ 12 (32 TTABVUE 26); Opposer's response to Applicant's Interrogatory No. 5 (34 TTABVUE 70); Merritt Declaration at ¶¶ 16, 28 (34 TTABVUE 33, 35).

experience with “other similar turf professionals,” such “professionals are extremely discerning when it comes to the purchase of hard equipment, including mower blades and aerification tines, which will be used on the turf they manage.” According to Mr. Merritt, the “primary responsibility [of such professionals] is the care and maintenance of turf under their management.” “[T]hey understand that using the wrong product on their turf could damage their turf.” Thus, they “carefully research such purchases and scrutinize available options because they understand that using the wrong product on their turf can damage their turf.” In fact, “turf damage can lead to their employment termination and can have far-reaching effects on their long term career.”¹⁶

Given the nature of the parties’ goods and the necessary skills required to care for and maintain the turf on golf courses, the customers who purchase Applicant’s and Opposer’s goods would undoubtedly exercise a degree of care in their purchasing decisions for products used to maintain the turf on their respective golf courses. The purchaser sophistication and the standard of purchasing care in this case are higher than cases where the primary consumers are members of the general public. *See The Toro Company v. ToroHead, Inc.*, 61 USPQ2d 1164, 1169 (TTAB 2001) where the Board found that the opposer’s goods were sold to professionals including “golf course superintendents, golf course architects, sports field groundskeepers, municipal facility managers of large resorts and office buildings, and landscape contractors,” *id.* at 1169, supporting the Board’s finding that both applicant’s and opposer’s customers

¹⁶ Merritt Declaration at ¶¶ 28-31 (34 TTABVUE 35).

were sophisticated and neither party's goods or services would be considered an impulse purchase, resolving this factor in favor of applicant.

“Where the relevant buyer class is composed solely of professional or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers. Where the relevant buyer class is composed only of professionals or commercial buyers familiar with the field, they are usually knowledgeable enough to be less likely to be confused by trademarks that are similar.” J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (“MCCARTHY”) § 23:101 (5th ed. 2021); *Elec. Design v. Elec. Data*, 21 USPQ2d at 1392 (No likelihood of confusion where plaintiff sold “E.D.S.” computer services to “experienced corporate officials after significant study and contractual negotiation” while defendant sold “EDS” power supplies and battery chargers to OEMs. Both parties’ goods and services “are usually purchased after careful consideration by persons who are highly knowledgeable.”); *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 USPQ 649 (Fed. Cir. 1983) (No likely confusion found in sale of industrial parts “to large corporations and government agencies, whose purchasing agents have sufficient expertise to distinguish between the sources of the goods.”).

Thus, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. See TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1207.01(d)(vii) (July 2021) citing, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood

of confusion due to the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding “even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily”); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1383 (TTAB 2006) (notwithstanding the identity of the goods, considering the narrow scope of protection to which registrant’s mark is entitled and the relative sophistication of the purchasers for the goods, the marks are sufficiently dissimilar to avoid a likelihood of confusion).

However, we bear in mind that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (indicating that “even sophisticated purchasers can be confused by very similar marks”); *see, e.g., Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163-64; *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Here, the sophisticated purchasers of Applicant’s and Opposer’s identical goods are somewhat less likely to be confused between the sources of the goods offered under their respective marks.

Thus, we find that the fourth *DuPont* factor favors Applicant.

3. Commercial Fame of Opposer’s Mark

The factor of fame “plays a ‘dominant role’ in the process of balancing the *du Pont* factors.” *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Applicant argues that “Opposer has not produced any information to establish that

its Ninja Tines Mark is commercially strong or famous, and, accordingly, this factor weighs in Applicant's favor."¹⁷ While it is the duty of the party asserting that its mark is famous to clearly prove it, *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) citing *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007), Opposer does not contend that its mark is famous.¹⁸ Therefore, the fifth *DuPont* factor is neutral.

4. Conceptual Strength of Opposer's Mark

The sixth *DuPont* factor considers "[t]he number and nature of similar marks in use on similar goods," and "addresses marks similar to an opposer's registered mark to demonstrate the strength or weakness of that mark." *Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (addressing significance of evidence of third-party use of marks similar to a registered mark to assess the strength of that mark); *DuPont*, 177 USPQ at 56.

Applicant argues that the sixth *DuPont* factor weighs against a likelihood of confusion because "given the relative size of the potential user base for Applicant's and Opposer's aerification tine products, the Ninja Mark and Samurai Mark exist in

¹⁷ Applicant's Motion for Summary Judgment at pp. 14-16 (34 TTABVue 20-22).

¹⁸ Opposer's Response to Applicant's Motion for Summary Judgment at p. 3 (36 TTABVue 4).

a crowded field with many competitors selling metal aerification tines under various registered and unregistered marks.”¹⁹

The extensive presence of third-party registered marks can be “powerful on its face” to show the descriptiveness and/or suggestiveness of a mark and its related weakness. *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) citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Thus, evidence of third-party registrations is relevant to show that “some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 quoting *Juice Generation v. GS Enters.*, 115 USPQ2d at 1675. “The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674.

Unlike *Juice Generation* and *Jack Wolfskin*, in this case, there is no evidence of third-party uses of marks containing the term “NINJA” (or the term “SAMURAI”) for similar goods. Applicant submits only one third-party registration for the mark

¹⁹ Applicant’s Motion for Summary Judgment p. 16 (34 TTABVUE 22) citing to Merritt Declaration p. 32 (34 TTABVUE 35) “It is my understanding that there are many competitors in the metal aerification tine marketplace, with many different brands competing for market share.”

SHOGUN TINE for “tine heads for turf aerating machines” which are the same as, or similar to, the goods of Opposer (and Applicant).²⁰ This single registration does not show the descriptiveness or suggestiveness of “NINJA.” While evidence of third-party registrations could be relevant to show that the “NINJA” segment of Opposer’s mark “may have a ‘normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak,’ ...” *Jack Wolfskin*, 116 USPQ2d at 1136, (at least fourteen examples of third-party registered marks used in commerce) quoting *Juice Generation*, 115 USPQ2d at 1675 (at least twenty-six relevant third party uses or registrations of record), here, there is no such evidence. On this record, it can hardly be said that customers of metal turf aeration tines have become conditioned by a plethora of similar marks for similar goods, resulting in a narrow scope of protection for Opposer’s Mark. *See Palm Bay Imports v. Veuve Clicquot*, 73 USPQ2d at 1694.

In view of the foregoing, the sixth *DuPont* factor is neutral.

²⁰ *See Applicant’s Motion for Summary Judgment* pp. 16-17 (34 TTABVUE 22-23) identifying Registration No. 6211893 for the mark SHOGUN TINE for “tine heads for turf aerating machines” issued on December 1, 2020, citing to the Declaration of Blake P. Hurt in Support of Applicant’s Response in Opposition to Opposer’s Motion for Summary Judgment¶ 5 and Exhibit 1 (21 TTABVUE 61-68). As noted in The Record above, Opposer did not object to the re-submission of this Hurt Declaration in the current Motion for Summary Judgment (36 TTABVUE 5).

Applicant notes that Opposer did not oppose the registration of the SHOGUN TINE mark. Applicant argues while recognizing that SHOGUN TINE is “fundamentally dissimilar to NINJA TINES or SAMURAI TINE, to the extent Opposer believes a likelihood of confusion exists as to the Samurai Tine Mark and the Ninja Tines Mark, Opposer’s failure to defend its mark by opposing the SHOGUN TINE mark should weigh against a finding that there is a likelihood of confusion between the two marks at issue in this matter.” 34 TTABVUE 22-23. Opposer responded that it filed this Opposition proceeding on April 1, 2020 while the SHOGUN TINE mark did not register until December 1, 2020. Opposer’s Response to Applicant’s Motion for Summary Judgment p. 4 (36 TTABVUE 5).

5. Similarity of the Marks

We next consider the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *see also Stone Lion v. Lion Capital*, 110 USPQ2d at 1160 (citing *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1691). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *See Cai v. Diamond Hong*, 127 USPQ2d at 1800.

Looking at Opposer's NINJA TINES & Design, and Applicant's SAMURAI TINE, marks, the word "tine(s)" found in each mark is defined²¹ as:

1: a slender pointed projecting part:

Merriam-Webster.com Dictionary, Merriam-Webster, <<https://www.merriam-webster.com/dictionary/tine>> © 2021 Merriam-Webster, Incorporated 1/4/2022;

Thus, "tine(s)" is generic when used in connection with the goods of the parties, i.e., metal aeration tines, as evinced by the disclaimer of this term by each party.²²

When a mark consists of two or more words, some of which are disclaimed, as is the generic word "TINE(S)" in the parties' marks, the words not disclaimed are generally regarded as the dominant terms. *See Citigroup v. Capital City Bank*, 98 USPQ2d at 1257; *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34

²¹ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *See, e.g., In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *36 n.72 (TTAB 2021).

²² *See* Opposer's Exhibit A, Tremblay Declaration ¶¶ 5, 10 (32 TTABVUE 25-26) citing Exhibit 2 (32 TTABVUE 44-50) TSDR for Registration No. 5600255; and Exhibit 4 (32 TTABVUE 54-60) TSDR for Application Serial No. 88649876.

(Fed. Cir. 1997) (finding “delta” the dominant part of the mark THE DELTA CAFÉ because the generic word CAFÉ was disclaimed). The generic word “TINE(S),” coming at the end of both marks, has no source-identifying significance, rendering NINJA and SAMURAI as the dominant first terms of each mark.

Inasmuch as Opposer’s mark NINJA TINES & Design and Applicant’s proposed mark SAMURAI TINE are to be used on identical goods, we look to whether the marks connote the same or similar meaning or commercial impression.

The definitions²³ of the terms “ninja” and “samurai” used in the marks are:

Ninja:

: a person trained in ancient Japanese martial arts and employed especially for espionage and assassinations.

Merriam-Webster, <<https://www.merriam-webster.com/dictionary/ninja>>, © 2021 Merriam-Webster, Incorporated 1/4/2022.

1. (often initial capital letter) a member of a feudal Japanese society of mercenary agents highly trained in martial arts and stealth (ninjutsu), who were hired for covert purposes ranging from espionage to sabotage and assassination.
2. a person who is expert or highly skilled in a specified field or activity (often used attributively): marketing ninjas; ninja programmers.

Dictionary.com Unabridged, <dictionary.com/browse/ninja>. Based on The Random House Unabridged Dictionary © 2021 Random House, Inc. 1/4/2022.

Samurai:

1. : a military retainer of a Japanese daimyo practicing the code of conduct of Bushido [code of honor]; 2. : the warrior aristocracy of Japan.

²³ Judicial notice has been taken of the definitions of “ninja” and “samurai.”

Merriam-Webster, <<https://www.merriam-webster.com/dictionary/samurai>> © 2021 Merriam-Webster, Incorporated 1/4/2022.

1. a member of the hereditary warrior class in feudal Japan.

Dictionary.com Unabridged, <dictionary.com/browse/samurai>. Based on The Random House Unabridged Dictionary © 2021 Random House, Inc. 1/4/2022.

Based on the foregoing definitions, “ninja” refers to mercenary agents in Japan that were trained in martial arts or a person trained in such Japanese martial arts; “samurai” refers to aristocratic warriors belonging to noble classes of Japanese society. While “ninja” and “samurai” are not similar in appearance or sound, they have similar connotations. Both are Japanese terms identifying types of warriors that lived in ancient Japan.

Applicant disagrees with the description of Opposer’s mark which reads:

The mark consists of the words “NINJA TINES” below a stylized image of a samurai.

According to Applicant, Opposer’s mark includes a “highly stylized image” of a “samurai helmet” not of “an image of an actual samurai.”²⁴ However, Opposer’s expert, Michael Wert, PhD, tenured associate professor of East Asian History at Marquette University in Milwaukee, Wisconsin, who has been active “as an expert in Japanese history, particularly premodern history since 2007,” testified that Opposer’s mark “clearly depicts a samurai.”²⁵

²⁴ Applicant’s Response to Opposer’s Motion for Summary Judgment p. 8 (35 TTABVUE 13).

²⁵ See Testimony Report Prepared for Joseph A. Uradnik Uradnik Law Firm PC Prepared by Michael Wert, Phd, (32 TTABVUE 68) attached as Exhibit C (32 TTABVUE 67-76) to Opposer’s Motion for Summary Judgment (32 TTABVUE).

Applicant's expert, Robert Hellyer, Ph.D., associate professor of history and Director of the East Asian Studies Interdisciplinary Minor since October 2013, at Wake Forest University in Winston-Salem, North Carolina, was retained by Applicant to provide a rebuttal opinion to Opposer's Testimony Report of Michael Wert, Ph.D.²⁶ Professor Hellyer provides additional historical information regarding samurais, explaining that in "Japanese history the samurai were defined through a broad range of attributes, of which battle armor and masks were only small determining factors" ²⁷ After the year 1600, Japan entered "a time of extended peace, armor and helmets became relics, stored away in boxes and brought out to display in homes on holidays and worn only during occasional parades to the lord's castle."²⁸ Professor Hellyer testifies that the design portion of Opposer's mark "is not synonymous with a samurai. . . . the ornamental trappings of the samurai headpiece is but a small part of the overall historical understanding of the samurai, and the fractional representation displayed in the Ninja Mark is insufficient to harken the rich and full historical understanding of the samurai."²⁹

In concluding, Professor Hellyer testifies:

Additionally, or in the alternative, the inclusion of the "Ninja" text in [Opposer's] Ninja Mark is in jarring contrast to not only the military and cultural tenets that the samurai stood for during their ascendancy, but also how historians of today generally interpret the samurai. In my

²⁶ See Declaration of Robert Hellyer, Ph.D., Exhibit 1 to Applicant's Response to Opposer's Motion for Summary Judgment (35 TTABVUE 28-49).


²⁷ *Id.* at ¶ 12 (35 TTABVUE 32).


²⁸ *Id.* at ¶ 15 (35 TTABVUE 33-34).


²⁹ *Id.* at ¶ 19 (35 TTABVUE 35).

professional opinion, this creates a strange and problematic misappropriation of Japanese culture that has the great potential to confuse anyone with even a passing familiarity with Japanese history.

Focusing on the testimony in the last sentence above, Professor Hellyer recognizes

that Opposer's mark  has the potential to confuse "anyone with even a passing familiarity with Japanese history." However, because there is no evidence supporting the level of familiarity of Opposer's relevant customers with Japanese history, it is difficult to draw any determinative conclusions from the testimony of Professors Wert

and Hellyer. Whether the design element of Opposer's mark  is perceived as a stylized image of a samurai or of the helmet design worn by a samurai, it is reminiscent of historical Japanese warriors. Inasmuch as both "NINJA" and "SAMURAI" connote historical Japanese warriors, Opposer's samurai helmet design brings the marks even closer in commercial impression.

Opposer contends that its mark , i.e., NINJA TINES & Design, is an arbitrary mark since it does not "directly describe the qualities of [its] metal turf aeration tines" and has no connection to the goods of the parties rather, it "overall connotes and gives the impression of a Japanese warrior" rendering it inherently distinctive.³⁰ In response, Applicant argues that Opposer's mark "is more appropriately classified as a descriptive mark as the word NINJA . . . can describe the quality or characteristic

³⁰ Opposer's Motion for Summary Judgment at pp. 8-9 (32 TTABVUE 9-10) citing to Tremblay Declaration ¶ 4 (32 TTABVUE 24).

of the goods—the sharp and piercing nature of the tine products.” If “ninja” is not found to directly describe aspects of the goods at issue, Applicant asserts that Opposer’s mark is, at best, merely suggestive since the connotation of “ninja” needs little imagination to reach quality conclusions about the goods themselves.³¹

According to Applicant’s expert, Professor Hellyer:

There is little evidence to explain the exact origins of the term ninja A person who today might be termed a ninja would have been most prevalent during the sixteenth-century warring states period when lords sought means to gain advantages during a period of near constant battles. A lord probably employed men with special skills of espionage or the ability to covertly enter buildings as means to gain an edge over an opponent who might otherwise be evenly matched on the battlefield. Because such tasks required stealth, we can conclude that a person who might be termed a ninja today would not have worn armor, including a helmet, to accomplish covert tasks for his lord.

Hellyer Declaration ¶ 15 (35 TTABVUE 34).

The question is not whether someone presented only with Opposer’s mark could guess the goods listed in its registration. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). Inasmuch as there is no evidence showing that the term “NINJA” with the stylized helmet design immediately conveys information

³¹ Applicant’s Response to Opposer’s Motion for Summary Judgment at p. 4 (35 TTABVUE 9).

concerning a feature, quality, or characteristic of Opposer's metal turf aeration tines it is not descriptive of Opposer's goods. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)).

The word portions of Applicant's and Opposer's marks begin with the arbitrary terms "SAMURAI" and "NINJA," followed by the generic word "TINE(S)." While "NINJA" and "SAMURAI" differ in appearance and sound, they render a similar commercial impression as both are Japanese terms identifying warriors that lived during the historical Japanese feudal society. The inclusion of a stylized samurai helmet design in Opposer's mark further enhances the marks' similar commercial impressions. Thus, when seeing Applicant's SAMURAI mark, tine customers would likely associate that mark with Opposer's NINJA & Design mark, believing it to identify another line of tines offered by Opposer.

Accordingly, this *DuPont* factor supports a finding of a likelihood of confusion.

6. Actual Confusion

The seventh and eighth *DuPont* factors consider the nature and extent of any actual confusion, and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. A showing of actual confusion may be highly probative, if not conclusive, of a likelihood of confusion. However, proof of actual confusion is not necessary to show a likelihood of confusion. *See Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1843 (Fed. Cir. 1990).

Opposer offers the testimony of Oscar Tenorio, an independent contractor serving as Opposer's social media consultant, in support of two instances of actual confusion with Applicant's mark occurring on the social media network Twitter.³² Opposer contends that Mr. Tenorio's testimony supports that two of its "customers" "mistook Applicant as the source of Opposer's Ninja brand metal turf aeration tines."³³

Applicant objects to the consideration of the Twitter communications with two unauthenticated and unverified Twitter users³⁴ whose "actual identities" cannot be confirmed on the ground that they contain inadmissible hearsay under Rule 802 of the Federal Rules of Evidence. Applicant contends that Opposer is offering the statements of the Twitter users to prove the truth of the matter asserted, i.e., that they were actually confused. According to Applicant, Opposer should have submitted declarations of the Twitter users under the penalty of perjury.³⁵

"As a general matter, we do not treat testimony as to third-party out-of-court statements as proof of the truth of the matter asserted. . . . However, such materials are frequently competent to show, on their face, matters relevant to trademark claims

³² Citing Declaration of Oscar Tenorio, ¶¶ 4-9 and Exhibit 1 (32 TTABVUE 62-63, 65); and ¶¶ 10-15 and Exhibit 2 (32 TTABVUE 63, 66).

³³ Opposer's Motion for Summary Judgment at p. 18 (32 TTABVUE 19). According to Mr. Tenorio, the second instance involves a Twitter communication with Graham Wieja, "the Golf Course Superintendent at Andersons Creek Golf Club," where Mr. Wieja, referring to himself as "a Canadian," ordered "JRM" tines from a place in Bedford, Nova Scotia. *See* Tenorio Declaration ¶¶ 10-15 and Exhibit 2 thereto (32 TTABVUE 63, 66). Although there is no testimony by Mr. Tenorio confirming that Andersons Creek Golf Club is located in the United States, Applicant made no objection on this basis so the testimony is accepted for what it says on its face.

³⁴ *See* Tenorio Exhibits 1-2 (32 TTABVUE 65-66).

³⁵ Applicant's Motion for Summary Judgment at pp. 19-21 (34 TTABVUE 25-26).

(such as public perception), regardless of whether the statements are true or false. Accordingly, they will not be excluded outright, but considered for what they show on their face.” *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1427-28 (TTAB 2014). Statements by witnesses regarding third-party communications to them, in the form of e-mail or telephone calls, or via Twitter, may not be offered for the truth thereof, but rather simply for the fact that they were made, as evidence that the communications were made to them. In view of the similar nature of Twitter communications to e-mail and telephone calls, Applicant’s objection is overruled and the statements regarding the Twitter communications have been considered for what they are worth. *See, e.g., Corporate Fitness Programs, Inc. v. Weider Health and Fitness, Inc.*, 2 USPQ2d 1682, 1690-91 (TTAB 1987) set aside on other grounds by *Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 7 USPQ2d 1828 (TTAB 1988); *Toys “R” Us, Inc. v. Lamps R Us*, 219 USPQ 340, 346 (TTAB 1983) (out-of-court statements admissible to show “that people have, in fact, made an association” between the parties); *Finance Co. of Am. v. BankAmerica Corp.*, 205 USPQ 1016, 1035 (TTAB 1979, as amended 1980) (employees’ testimony regarding receipt of misdirected mail or telephone calls not hearsay), *aff’d in unpub’d opinion*, Appeal No. 80-558 (CCPA February 12, 1981).

Because this type of evidence is competent to show, on its face, matters of relevance to Opposer’s claim of actual confusion, *see Harry Winston v. Bruce Winston*, 111 USPQ2d at 1428, we overrule Applicant’s hearsay objection to the Twitter communications. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020

USPQ2d 48324, at *2, *11 (TTAB 2020) (“[S]uch materials are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false;” third-party documentary evidence corroborates pervasive use by others in the industry).

However, the testimony of Opposer’s witness is of less probative value in the absence of testimony from the third parties themselves “as to whether they were confused and, if so, what caused their confusion. To the extent that this testimony has any probative value, however, it serves to buttress our conclusion of likelihood of confusion.” *Edom Labs., Inc. v. Glenn Lichter*, 102 USPQ2d 1546, 1552-53 (TTAB 2012) (citing *Corporate Fitness v. Weider Health and Fitness*, 2 USPQ2d at 1691 (finding third-party testimony as to alleged incidents of actual confusion of “little probative value”)). Although Applicant’s objections are overruled, we are cognizant of its objections, and the inherent limitations of the evidence submitted, and accord it an appropriate probative weight.

While a strong showing of actual confusion would be highly probative of a likelihood of confusion, the opposite is not true. The lack of evidence of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). Thus, evidence of actual confusion is not necessary to establish a likelihood of confusion. *Herbko v. Kappa Books*, 64 USPQ2d at 1380; *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1560-61 (Fed. Cir. 2001). In situations like the one before us, where there is little or no evidence which would lead us to conclude that the opportunity for confusion has

existed to any significant extent, the assertion by Applicant that it is not aware of any incidents of actual confusion carries little weight. *Fiserv, Inc. v. Electronic Transaction Sys. Corp.*, 113 USPQ2d 1913, 1922 (TTAB 2015) (record is unclear as to the amount of meaningful opportunities for confusion to have occurred among purchasers); *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527, 1530 (TTAB 2000) (“the assertion by one party that it is not aware of any incidents of actual confusion carries little weight”). Applicant has only used its SAMURAI TINE mark for its turf aeration tines since January 2020.³⁶ There is no evidence that the parties’ goods have been sold together in the same locality for a significant period of time so that, if confusion were likely to occur, circumstances have been such that it could be expected to have happened.

Therefore, the factors of the nature and extent of any actual confusion minimally favor Opposer, while the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion, is neutral.

7. Extent of Potential Confusion

Applicant asserts that the twelfth factor, whether the extent of potential confusion is de minimis or substantial, *DuPont*, 177 USPQ at 567, weighs strongly in favor of Applicant and a finding of no likelihood of confusion. In support, Applicant refers to the dissimilarity of Applicant’s and Opposer’s marks coupled with the sophistication

³⁶ Merritt Declaration, ¶¶ 8-9 (34 TTABVUE 32).

of the purchasers and the expense of the goods,³⁷ which essentially is a reargument of the first, third and fourth *DuPont* factors.

Additionally, Applicant argues that the distinctive portion of both marks, SAMURAI and NINJA, “are extremely common marks which exist side-by-side in numerous other international classes, seemingly without confusion” citing three pairs of registrations for SAMURAI and NINJA each pair for virtually identical goods, none of which are related to the goods of Opposer and Applicant.³⁸

Unlike *Juice Generation*, where the third-party evidence involved the very same restaurant services covered by the marks at issue, and *Jack Wolfskin*, where the third-party evidence involved the very same clothing covered by the marks in question, here the third-party registration evidence Applicant submits covers goods in unrelated industries. Thus, the evidence Applicant submits does not show that the goods in the third-party registrations are similar to the goods involved in this case, or that they are directed to the relevant public that comprises the ordinary customers of Applicant’s and Opposer’s goods. *See Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *In re i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-

³⁷ Applicant’s Motion for Summary Judgment p. 21 (34 TTABVUE 27).

³⁸ Applicant’s Motion for Summary Judgment p. 22 (34 TTABVUE 28) citing to the Declaration of Blake P. Hurt, Exhibits 2-7 identifying Registration Nos. 5282525 for SAMURAI 360 and 4679095 for NINJA KNIFE, both marks registered for kitchen or household knives; Registration Nos. 3507038 for SAMURAI and 3753805 for NINJA, both marks registered for beer; and Registration Nos. 4883210 for SAMURAI and 3644492 for NINJA, both marks registered for cigars.

party registrations for goods in other classes where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, . . . support[s] a finding that registrants’ marks are weak with respect to the goods identified in their registrations”).

Even if the third-party registrations could be considered relevant to conceptual weakness it falls far short of the volume of evidence the Federal Circuit found convincing in *Jack Wolfskin* and *Juice Generation*. See also *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1735 (TTAB 2018) (three third-party uses are “well short of the volume of evidence found convincing in *Jack Wolfskin* and *Juice Generation*”); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745-46 (TTAB 2018) (two third-party registrations for related but not identical services and two registrations for identical services with a non-identical but similar mark were not sufficient to prove registrant’s mark was conceptually or inherently weak).

Opposer contends that Applicant’s analysis of *DuPont* factor twelve is “a simple rehash of Applicant’s arguments raised for the other *du Pont* factors.” More importantly, as noted by Opposer, “[n]either party addressed the specific issue of the extent of potential confusion in its argument or in its evidentiary submissions.”³⁹


In view of the foregoing, this *DuPont* factor is neutral.

³⁹ Opposer’s Response to Applicant’s Motion for Summary Judgment p. 5 (36 TTABVUE 6).


V. Conclusion

The parties' goods are identical and sold in the same channels of trade to the same types of sophisticated customers. Since the goods of Applicant and Opposer are identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods. *Shen v. Ritz Hotel*, 73 USPQ2d at 1354.



Opposer's registered mark  is different in appearance and sound from Applicant's SAMURAI TINE mark. However, when the marks of Opposer and Applicant, each relating to Japanese warriors and containing references to historical Japanese Samurai characters, are considered in their entirety, they convey similar commercial impressions. The legal identity of the goods and the similar commercial impressions of the marks outweigh any sophistication or care in customers' purchasing decisions. Customers familiar with Opposer's tine products offered for



sale under the  mark, upon encountering Applicant's tine products under the mark SAMURAI, are likely to believe that such goods are affiliated with or sponsored by Opposer. *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014) ("Even accepting that the goods may be marketed to more careful purchasers, ... we note that with in-part identical goods and similar marks, even a careful, sophisticated consumer of these goods is not likely to note the differences in the marks. ... Furthermore, careful purchasers who do notice the difference in the marks

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will not necessarily conclude that there are different sources for the goods, but will see the marks as variations of each other, pointing to a single source.”). Therefore,

Applicant’s mark SAMURAI for use on the identical goods that Opposer’s mark
is registered for is likely to cause confusion.



Decision: The opposition to registration of Applicant’s mark SAMURAI TINE shown in Serial No. 88649876 is sustained and registration is refused.