

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
October 20, 2011

Mailed:
May 14, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

PRL USA Holdings, Inc.
v.
Thread Pit, Inc.

Cancellation No. 92047436

Scott Gelin, G. Roxanne Elings and Anna Dalla Val of
Greenberg Traurig, LLP for PRL USA Holdings, Inc.

Howard A. Caplan of Lewis Longman & Walker PA for Thread
Pit, Inc.

Before Kuhlke, Bergsman and Wolfson, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

PRL USA Holdings, Inc. (petitioner) has petitioned to
cancel Registration No. 3180680 owned by Thread Pit, Inc.
(respondent) for the mark shown below for goods identified
as "t-shirts and collared polo shirts," in International
Class 25.¹

¹ The registration issued on December 5, 2006 from the underlying
application filed on January 19, 2006.



As grounds for cancellation petitioner asserts the claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125. In connection with these claims, petitioner alleges that it owns several registrations for the Polo Player mark shown below and several marks incorporating the word POLO for a variety of clothing and accessory items and that its marks have become famous prior to respondent's use of its mark.



Respondent filed an answer by which it admitted to petitioner's ownership of the pleaded registrations, that its goods are "the same as some of the goods contained in [petitioner's pleaded] registrations" but otherwise denied the salient allegations. In addition, respondent asserted as an affirmative defense that its "use of its mark is a parody of certain of [respondent's] marks." The remaining

"affirmative defenses" simply serve to amplify its general defense that there is no likelihood of confusion.

THE RECORD

The evidence of record consists of the pleadings; the file of the subject registration; petitioner's testimony by declaration² with accompanying exhibits A-G of Ellen Brooks, Director, U.S. Trademark Enforcement for respondent's parent company Polo Ralph Lauren Corporation; petitioner's notices of reliance on respondent's responses to certain discovery requests, excerpts from the discovery deposition of Nicholas Lynn Moskowitz, printed publications, its pleaded registrations, and court decisions wherein the Polo Player design mark was found inherently distinctive and famous; respondent's testimony by declaration with accompanying exhibits A-D of Nicholas Moskowitz, respondent's President and owner; respondent's notices of reliance on its subject registration³ and certain of petitioner's discovery responses. Petitioner also submitted a rebuttal declaration from Ellen Brooks which is the subject of an objection from respondent addressed below.

² Upon stipulation of the parties, filed January 21, 2010, testimony was submitted by declaration.

³ For future reference, respondent is advised that this was unnecessary inasmuch as the subject registration "forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose." Trademark Rule 2.122(b).

In addition, the parties submitted under stipulation several documents including excerpts from petitioner's and respondent's websites, articles from printed publications, petitioner's advertising, and petitioner's annual reports.

Both parties filed briefs; however, respondent did not attend the oral hearing.

EVIDENTIARY ISSUE

As a preliminary matter, we take up for consideration respondent's objection, made in its main trial brief, to the rebuttal declaration of Ellen Brooks. Respondent states that it was never served with a copy of this declaration. The filing with the Board does not include a certificate of service. In addition, petitioner did not submit any argument in response; therefore, respondent's assertion that the declaration was not served stands unrebutted. Every paper filed with the Board must be served upon the other parties and proof of service must be made before a paper will be considered. Trademark Rule 2.119(a). In view thereof, the May 24, 2010, declaration of Ellen Brooks is hereby stricken from the record.

PRIORITY/STANDING

Because petitioner has made its pleaded registrations of record and has shown that the registrations are valid and subsisting and owned by petitioner, petitioner has established its standing to cancel respondent's registration

and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the question of likelihood of confusion.

LIKELIHOOD OF CONFUSION

Petitioner only made some of its pleaded registrations of record by notice of reliance.⁴ The most relevant are set forth as follows:

Registration No. 2823094 for the mark shown below for "tote bags" in International Class 18 and "wearing apparel, namely, sweaters and t-shirts" in International Class 25, issued March 16, 2004, Section 8 and 15 affidavit accepted and acknowledged;



Registration No. 3199839 for the mark shown below for "wearing apparel, namely, jackets,

⁴ The printouts of registrations from TESS, the USPTO electronic database, attached to the pleading are not sufficient to make the remaining registrations of record because the petition for cancellation was filed on April 25, 2007, prior to the November 1, 2007 Trademark Rules amendments. Moreover, respondent's answer only serves as an admission to petitioner's ownership and not to the status of the pleaded registrations. In addition, petitioner introduced into the record certain of its registrations that it did not plead. With regard to these registrations, we only consider them in connection with petitioner's allegation of fame and not for priority or reliance on other Section 7(b) presumptions.

sweatshirts, sweat pants, hats, scarves, jerseys, jeans, turtlenecks and bikinis" in International Class 25, issued January 16, 2007.



For our determination of likelihood of confusion in this cancellation, we focus our decision on Reg. No. 2823094 for the Polo Player mark and above-noted clothing items, specifically, t-shirts. If we do not find likelihood of confusion with respect to the mark in this registration for in part identical goods, then there would be no likelihood of confusion with respect to the marks and goods in petitioner's other registrations. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Petitioner presented evidence and argument on the factors of the relatedness of the goods, channels of trade

and classes of purchasers, the similarity of the marks, respondent's intent, and the fame of its mark.

We begin with the factor of fame because 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). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

The record shows that petitioner owns seven registrations that include the Polo Player mark, and has been using the Polo Player mark in connection with clothing items, including t-shirts, for over forty years since 1967. *Brooks Test.* p. 2. Petitioner expends a substantial sum "in promoting the sale of Polo Player products in a wide variety of media and its products are regularly featured in" widely-distributed magazines such as *Vogue*, *Elle*, *GQ*, *Fortune*, *Sports Illustrated*, *Vanity Fair*, *Town & Country*, *Travel & Leisure*, *Maxim*, *Rolling Stone*, *Cosmopolitan*, *Entertainment Weekly*, *Oprah* and *Golf Digest*. *Id.* p. 3. Petitioner is or has been the official sponsor of the following sporting events: Wimbledon, the US Open, and the 2008 and 2010

Olympics. Id. Petitioner also sponsors many individual sports figures including Tom Watson, Davis Love III, Jeff Sluman and Luke Donald. Id. p. 4. Petitioner uses its Polo Player mark in connection with these sponsorships. Id. Petitioner sells its Polo Player products at 200 of its stores, in many department and fine retail stores across the United States (e.g., Macy's, Nordstrom's, Saks, Bloomingdales), and online at its website and those of other online retailers such as Macys.com and Nordstrom.com. Id. Petitioner's sales have also been substantial. Id. and Stip. Exh. 58-68.⁵

On this record, we find that petitioner has shown that its Polo Player mark is famous in the field of clothing and, indeed, respondent concedes this factor. Resp. Br. p. 9. See also Pet. Notice of Reliance Exh. B Responses to Petitioner's Second Set of Requests for Admissions No. 23. In view thereof, petitioner's mark is entitled to broad protection. Recot, 54 USPQ at 1897. Respondent's argument that the fame of petitioner's mark serves to lessen the likelihood of confusion is counter to legal precedent of the Board and the Board's primary reviewing court, the Court of

⁵ We note that the sales figures are not broken down specifically as to the Polo Player mark; however, viewed in the context of the record as a whole the Polo Player design is ubiquitous on petitioner's goods and in petitioner's advertising and sponsorships. In view thereof, we infer from this that a substantial portion of the sales figures are attributable to products with which the Polo Player mark is used.

Appeals for the Federal Circuit. As stated by the Federal Circuit:

While scholars might debate as a factual proposition whether fame heightens or dulls the public's awareness of variances in marks, the legal proposition is beyond debate. The driving designs and origins of the Lanham Act demand the standard consistently applied by this court - namely, more protection against confusion for famous marks.

Kenner Parker Toys v. Rose Art Indus., Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

This brings us then to our consideration of the similarities between petitioner's and respondent's goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in the respective registrations. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

Petitioner's and respondent's registrations both include t-shirts; thus the goods are in part identical. It

is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the subject registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004). Respondent argues that its registration covers only t-shirts and collared polo shirts whereas petitioner's various registrations cover a wide variety of clothing goods such that "the scope of goods on which the parties marks appear is so vastly different." We first note that petitioner's Registration No. 2823094 only includes sweaters, t-shirts and tote bags. However, even considering petitioner's other registrations and evidence of use for a wide variety of clothing goods, this does not mitigate the fact that there is an overlap with the identical goods, namely, t-shirts.

Moreover, with regard to the channels of trade and classes of purchasers, because the goods are in part identical and there are no restrictions in the identifications as to trade channels and purchasers, we must presume that the parties' goods would be sold in the same channels of trade and to the same relevant purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

In addition, respondent's arguments regarding the actual conditions of sale are not relevant to our determination. As noted above, we make our determination based on the listed goods in the registrations. Thus, the arguments that petitioner's goods are expensive and limited to the high end of the market, and the relevant consumers are sophisticated purchasers are not persuasive. Because of the absence of such limitations from the identifications set forth in the registrations we must consider any ordinary channel of trade for t-shirts. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (applicant may not restrict scope of the identified goods by extrinsic evidence). Further, we must make our determination based on the least sophisticated consumer for the identified goods, namely, t-shirts. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1027 (TTAB 2009) (citing *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004)). In sum, we find that the similarities between petitioner's and respondent's goods, channels of trade and classes of purchasers favors a finding of likelihood of confusion.

We turn now to a consideration of the first du Pont factor, i.e., whether the parties' respective Polo Player

marks  and  are similar or dissimilar when compared in their entirety in terms of appearance,

connotation and commercial impression.⁶ We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Further, in view of the fame of petitioner's mark we keep in mind that a famous mark enjoys a wide scope of protection and "[T]here is no 'excuse for even approaching the well-known trademark of a competitor.'" *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962). Finally, we are cognizant of the principle that the more closely related the goods are, the less similarity in the marks is required to support a conclusion of likelihood of confusion. Century 21

⁶ We do not consider the element of sound as we are making our determination only on petitioner's design mark.

Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

With regard to appearance, we find them to be very similar. The horses are in identical positions with the left front leg curling back and crossing the right rear legs, the reins drape in the same manner, and the mallet extends from the rider at the same angle. In addition, the horses and riders are similarly portrayed in silhouette. Moreover, both marks contain no other elements, either design or words. The only difference in the appearance of the marks is the position of the rider, which in both marks appears as a polo player, where he is depicted as falling off the horse in respondent's mark. While there may be some difference in commercial impression between the two depictions, as respondent posits, i.e., "a competent in control rider versus a completely out of control rider," we find the overall commercial impression of the polo player to be very similar. In particular, with regard to such goods where the mark is frequently applied as a small logo in the upper corner of the t-shirt, it requires close inspection to distinguish the different attributes of the rider. Given the fame of petitioner's mark, the points of similarities in appearance, connotation and commercial impression outweigh the dissimilarities. In view thereof, we find the marks to be similar.

Respondent argues that there is no evidence of actual confusion. However, we cannot determine on this record that there has been any meaningful opportunity for actual confusion to have occurred in the marketplace, and accordingly, we cannot conclude that the alleged absence of actual confusion is entitled to much weight in our likelihood of confusion analysis. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Moreover, evidence of actual confusion is not a prerequisite to finding likelihood of confusion and this factor is neutral as to both parties. *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (“[A] showing of actual confusion is not necessary to establish a likelihood of confusion.”)

Petitioner argues that respondent was aware of petitioner’s mark before adopting its mark and in fact designed its mark “with the intention to be similar to the Polo Player Mark.” Pet. Br. p. 24. Respondent argues that while it was aware of petitioner’s mark “[t]he creative process did not include copying and pasting any horse or rider image [and] [t]he intent of the design of Registrant’s mark was to parody the elite in society as embodied by the sport of polo.” Resp. Br. p. 2; Moskowitz Decl. p.2. With regard to the parody argument, respondent argues that it falls under the last du Pont factor namely “[a]ny other

established fact probative of the effect of use," du Pont, at 177 USPQ at 567, contending:

One factor is the satiric, parodic nature of Registrant's mark. . . . Numerous visitors to the Thread Pit website placed satiric, humorous comments about Registrant's mark. . . . These and other comments clearly demonstrate that Registrant's mark communicates an element of satire, ridicule, joking, or amusement.

Resp. Br. pp. 10-11.

Parody is not a defense if the marks are otherwise confusingly similar. Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581, 1592 (TTAB 2008);⁷ Starbucks U.S. Brands, LLC and Starbucks Corporation D.B.A. Starbucks Coffee Company v. Marshall S. Ruben, 78 USPQ2d 1741, 1754 (TTAB 2006); Columbia Pictures Industries, Inc. v. Miller, 211 USPQ 816, 820 (TTAB 1981) ("The right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of the substantially same mark by another.")

Respondent has stated that its mark is "a parody of the societal elite as embodied by the sport of polo, which is

⁷ Respondent's statement that the Board "held that SEX ROD was a parody" is incorrect. In that case, the Board stated that "[e]ven assuming for the sake of argument that SEX ROD is a parody of opposer's "RED SOX" marks, as applicant asserts, there is nothing in the parody itself which changes or detracts from the vulgar meaning inherent in the term." Boston Red Sox, 88 USPQ2d at 1589. Clearly, the Board did not hold that the mark in that case was a parody, but merely stated that if were it would not be a defense to the Section 2(a) claim.

perceived to be a sport reserved for the elite. The rider falling off the horse is the parody of that elite, luxury lifestyle. And of the humor in seeing someone fall off a horse, somewhat like in slapstick comedy." Moskowitz Decl. p. 2 ¶8. This is similar to the circumstances in Nike, Inc. v. Peter Maher and Patricia Hoyt Maher, 100 USPQ2d 1018, 1023 (TTAB 2011). In that case, the Board found that where "a defendant appropriates a trademarked symbol such as a word or picture, not to parody the product or company symbolized by the trademark, but only as a prominent means to promote, satirize or poke fun at religion or religious themes, this is not 'parody' of a trademark." Similarly, here, parodying a lifestyle is not a parody of a trademark. See also Elvis Presley Enterprises Inc. v. Capece, 141 F.3d 188, 46 USPQ2d 1737, 174-46 (5th Cir. 1998).

In view of the above, respondent's assertion of parody does not provide it with a defense to petitioner's claim under Section 2(d).

Considering the similarity of the marks in their entirety, the fame of petitioner's mark, the identical nature of the goods and the overlap in trade channels and purchasers, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a likelihood of confusion between petitioner's Polo Player mark and respondent's Polo Player mark.

Cancellation No. 92047436

In view of our decision on likelihood of confusion we do not reach the claim of dilution.

Decision: The petition for cancellation is granted.