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THE TTAB**

Mailed: May 8, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Trans World International, Inc.  
v.  
American Strongman Corporation

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Cancellation No. 92050860

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Stephen A. Hill of Rankin, Hill & Clark LLP

Sepehr Daghighian of the Law Offices of Sepehr Daghighian PC

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Before Zervas, Cataldo, and Shaw, Administrative Trademark  
Judges.

Opinion by Shaw, Administrative Trademark Judge:

Petitioner, Trans World International, Inc., filed a petition to cancel a registration owned by respondent, American Strongman Corporation, for the mark AMERICA'S STRONGEST MAN on the Supplemental Register for "entertainment in the nature of competitions in the field of strength athletics and strength entertainment" in International Class 41.<sup>1</sup>

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<sup>1</sup> Registration No. 3522878; issued October 21, 2008 from an application filed on February 4, 2008.

As its ground for cancellation, petitioner asserts likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Petitioner alleges that respondent's mark when used in connection with respondent's services so resembles petitioner's previously used and registered mark, WORLD'S STRONGEST MAN, as to be likely to cause confusion. Petitioner has pleaded ownership of Registration No. 2484106 registered on the Principal Register under Trademark Act Section 2(f), for the services of "entertainment in the nature of on-going television programs in the field of sports competitions," in International Class 41.<sup>2</sup>

Applicant, in its answer, denied the salient allegations in the petition. The case is fully briefed.

#### **The Record**

The evidence of record consists of the pleadings and the file of the involved registration. The only evidence introduced by Petitioner is the status and title copy of the pleaded registration submitted with the petition for cancellation. See Trademark Rule 2.122(d)(1). No other evidence was submitted by either party.

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<sup>2</sup> Issued September 4, 2001; renewed.

### **Standing**

Petitioner has shown through the TESS printouts made of record that petitioner is the owner of its pleaded registration and that the registration is valid and subsisting. Because petitioner's registration is of record, petitioner has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

### **Priority**

In a cancellation proceeding, where both parties own registrations, petitioner must prove priority of use. See *Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281 (TTAB 1998) and cases cited therein. Because petitioner's registration is of record, petitioner may rely on the registration as proof that the mark was in use as of the filing date of the underlying applications. See *J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965).

Petitioner's registration issued September 4, 2001 from an application filed on October 22, 1997. This is long prior to the February 4, 2008 filing date of respondent's underlying application, which is the earliest date on which respondent is

entitled to rely given the absence of any evidence of earlier use. Thus, petitioner has established its priority.

### **Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Moreover, petitioner has the burden to establish that there is a likelihood of confusion by a preponderance of the evidence.

In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). Inasmuch as the only evidence of record in this case is the pleaded registration and the file of the involved registration, our inquiry will focus primarily on these two factors. We turn first to the similarity of the services.

**A. Similarity or dissimilarity of the services**

Respondent's mark is registered for "entertainment in the nature of competitions in the field of strength athletics and strength entertainment." Petitioner's pleaded registration is for "entertainment in the nature of on-going television programs in the field of sports competitions." The services provided by both parties are closely related, if not overlapping. Both parties are providing entertainment in the nature of competitions featuring sports in petitioner's case, or the more specifically recited sporting events of "strength athletics and strength entertainment" in respondent's case. The only significant difference between the identified services appears to be that petitioner has limited its registration to the medium of television while respondent has no such limitation.

Respondent argues that its services do not overlap with petitioner's services because "strength athletics and competitions [are] not a sport." Respondent's Br. at 6. This argument is not well taken. The specimens of use submitted with respondent's application clearly indicate that the mark is used in connection with activities that most would consider to be a sport. Respondent's specimens show that it conducts a strongest man (and woman) "contest" featuring "the best athletes in the strength and fitness world" and that there has been an AMERICA'S STRONGEST MAN "championship" every year since 1997. Respondents

Response to Office Action, dated September 4, 2008. Further, the definition of "sport" precisely encompasses respondent's activities: "an athletic activity requiring skill or physical prowess and often of a competitive nature, as racing, baseball, tennis, golf, bowling, wrestling, boxing, hunting, fishing, etc."<sup>3</sup>

This *du Pont* factor weighs in favor of finding a likelihood of confusion.

**B. Similarity of the marks**

We next consider the similarity of the marks as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). 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 impression that confusion as to the source of the services 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

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<sup>3</sup> <http://dictionary.reference.com/browse/sport>, *Collins English Dictionary - Complete & Unabridged 10th Edition* (2012). The Board may take judicial notice of dictionary definitions. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood 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. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We keep in mind, however, that when a mark, or a portion of a mark, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use that descriptive term. *Milwaukee Nut Co. v. Brewster Food Serv.*, 277 F.2d 190, 125 USPQ 399, 401 (CCPA 1960) (opposer acted at its peril in choosing a highly suggestive mark). See also *Sure-Fit Prods. Co. v. Saltzon Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 296 (CCPA 1958) ("Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.").

We begin by noting that both marks are comprised of descriptive terms and that during examination both marks were held to be descriptive by the USPTO. Petitioner's mark registered under Section 2(f) of the Trademark Act, a concession

that the mark was merely descriptive of the identified services, at least at the time of application. 15 U.S.C. § 1052(f); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Similarly, respondent's mark is registered on the Supplemental Register which also is a concession that the mark was merely descriptive of the identified services. *Quaker State Oil Ref. Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *In re Cent. Soya Co., Inc.*, 220 USPQ 914, 916 (TTAB 1984).

Petitioner's mark is WORLD'S STRONGEST MAN and respondent's mark is AMERICA'S STRONGEST MAN. We find that the parties' marks, unlike their contestants, are weak. Both marks consist in part of the laudatory wording "strongest man" which is presumed to be the title given to the winner of the respective competitions. Moreover, the wording "America's" and "world's" in the marks merely describes the geographic scope of these contests of strength. When these terms are combined, respectively, the result is two weak marks which merely tell prospective consumers that the competitions will seek out the strongest man in two different geographic regions.

Petitioner argues that "strongest man" is the dominant portion and that prospective consumers "would not place any distinguishing weight or importance on the difference between the words "WORLD'S" and "AMERICA'S" to presume that the services



originated from different sources, because these words are merely generic geographic identifiers." Petitioner's Br. at 15. We disagree. Given that "strongest man" is descriptive of the nature of the competition and given the different geographic scope of the competitions, we see no reason why prospective consumers would not be able to distinguish between the competitions using the first terms in each mark. Purchasers in general are inclined to focus on the first word or portion in a trademark. *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered"); *See Palm Bay*, 73 USPQ2d at 1692. While these marks both include geographic terms, we find they nevertheless have different connotations. Petitioner has not submitted any evidence to suggest otherwise. The mere fact that both marks include the descriptive wording "strongest man" is not enough to find a likelihood of confusion. *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) ("[T]he mere presence of a common, highly suggestive portion [of a mark] is usually insufficient to support a finding of likelihood of confusion."); *Alpha Indus., Inc. v. Alpha Microsystems*, 227 USPQ 67, 71 (TTAB 1983) ("Since the testimony and other evidence establishes to our satisfaction that the term "micro" has descriptive or highly suggestive significance in the

computer field, this part of applicant's mark is entitled to less significance since potential purchasers are likely to look to the remainder of the mark for origin-indicating significance."). Accordingly, we find that these marks have different connotations or commercial impressions and the dissimilarities outweigh the similarities.

In conclusion, based on this very sparse record, we find that petitioner has not carried its burden of proof and respondent's mark is sufficiently dissimilar to petitioner's mark so as to make confusion unlikely. This *du Pont* factor alone is dispositive. *Kellogg Co. v. Pack'em Enter. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive").

**Decision:** Cancellation No. 92050860 is dismissed.