This Opinion Is a
Precedent of the TTAB

Hearing: September 18, 2014 Mailed: September 18, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The North Face Apparel Corp.

v.

Sanyang Industry Co., Ltd.

Opposition No. 91187593
to application Serial Nos. 77375588 and 77376388

Susan M. Kayser and Lucy Jewett Wheatley of Jones Day
for The North Face Apparel Corp.

Glenn J. Dickinson of LightGabler LLP
for Sanyang Industry Co., Ltd.

Before Seeherman, Shaw and Greenbaum,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sanyang Industry Co., Ltd. (Applicant) has filed two applications to register the S-design mark shown below.



Each application includes the following description: "The colors red, gray, black and white are claimed as a feature of the mark. The mark consists of a stylized GRAY and WHITE stylized 'S' outlined in part in BLACK on a RED circular background ringed by a WHITE ring within a GRAY ring."

The goods and services in Application Serial No. 77375588[1] are:

> Anti-dazzle headlights for vehicles; light bulbs for directional signals for vehicles; anti-glare headlights for vehicles; defrosting apparatus for vehicles; vehicle reflectors; vehicle headlights; air conditioners for vehicles; lights for vehicles; dashboard and door courtesy lights for vehicles (Class 11);
>
> Vehicles, namely, automobiles, motorcycles, motorized carts for personal transportation for senior citizens, electric motorcycles, sports motorcycles, electric scooters, electric bicycles, and all-terrain vehicles, and parts and fittings thereof namely, brake cables, clutch cables, fork bearings and races, fork dust boots, fork seals, handle bars, handle bar control levers, handle bar dampers, handle bar grips, brake calipers, brake pedals, brake rotors, front spacers, front dash panels, shift levers, headlight mounts, structural parts, pneumatic tires and inner tubes for motorcycles, engines for land vehicles, spoiler for vehicles, motors for automobiles, mudguards, automobile bodies, brake cylinder repair kits sold as a unit for land vehicles, brake cylinders, main brake cylinders, braking systems for vehicles and parts thereof; transmissions for land vehicles; wheels; land vehicles parts, namely, drive gears, drive belts, axles, rearview mirrors, shock absorbers (Class 12); and
>
> Automobile maintenance and repair; motorcycle maintenance and repair; automobile washing; motorcycle washing; automobile rustproofing; motorcycle rustproofing; automobile greasing; motorcycle greasing; automobile cleaning; motorcycle cleaning; automobile service station services; tire retreading; installation, maintenance and repair of machines in the field of automobile maintenance; installation, maintenance and repair of machines in the field of motorcycles maintenance (Class 37).

[1] This application was filed on January 18, 2008, based on Section 1(a) of the Trademark Act, asserting first use on September 29, 2004 and May 2005 as the date of first use in commerce.

The goods and services in Application Serial No. 77376388[2] are:

Lawnmowers; electrical lawnmowers; plows; tractor-towed fertilizer applicators; tractor towed agricultural implements, namely, harrows, rollers, mowers, reapers; internal combustion engines for machine operation and replacement parts therefor; engines not for land vehicles; transmissions for machines; transmission gears for machines; continuous variable transmission for machines; boat engines; jet engines other than for land vehicles; motors other than for land vehicles; generators of electricity; couplings for machines; shaft couplings, not for land vehicles; sleeve gear couplings; machine fly-wheels; vehicle parts, namely, cams; connecting rods for motors, engines and machines; pistons for machines or engines; piston rings; cylinder heads for engines; cylinder block; camshafts for vehicle engines; gear boxes other than for land vehicles; driving chains other than for land vehicles; brake linings for machines; machine parts, namely, work holding fixtures for precision machining applications; pulleys being parts of machines; air filters for mechanical purposes; oil filters; machines parts, namely, cylinders; fuel filters; gas filters for motors and engines; air cylinder; fuel injectors; fuel injection nozzles; clutches for machines; pistons for cylinders; exhaust manifold for engines; pistons for engines; cooling radiators for motors and engines; mufflers for motors and engines; catalytic converters for motors and engines; crank shafts for engines; shock absorbers for machines; power transmission belts for machines, motors and engines used in industrial applications; fan belts for motors and engines; machine parts, namely hoods (Class 7);

Stickers; envelopes; letter paper; note papers; books in the field of automobiles and motorcycles; notebooks; manuals in the field of automobiles and motorcycles; pictorial prints; calendars; photograph stands; paper bags; boxes of paper or cardboard; glue for stationery or household purposes; pens; pen cases; advertising boards of paper; flags of paper; blank cards (Class 16);

Swimsuits; shirts; beachwear; vests; Tee-shirts; coveralls; coats; liveries; footwear; scarves; neckties; headwear; earmuffs; socks; mittens; waistbands; clothing for bikers, namely shorts, shirts, hats and shoes (Class 25); and

[2] This application was filed on January 21, 2008, based on Section 1(a) of the Trademark Act, and asserting March 31, 2005 as the date of first use and January 31, 2006 as the date of first use in commerce.

> Design of advertising materials for others; advertising services, namely, creating corporate and brand identity for others; import and export agencies; merchandise packaging; retail department stores; mail order catalog services featuring automobiles, motorcycles and their accessories; providing home shopping services in the fields of automobiles, motorcycles and their accessories by means of television; on-line retail store services featuring automobiles, motorcycles and their accessories; retail stores featuring clothing, textiles, and clothing accessories; retail furniture stores; retail store services in the field of eyeglasses; retail store services featuring electronic appliances and electronic materials; automobile dealerships; retail automobile parts and accessories stores; vending in the fields of jewelry and precious stones; bicycle dealerships; retail bicycle parts and accessories stores; retail store services featuring machinery; motorcycle dealerships; retail motorcycle parts and accessories stores; preparing promotional and merchandising materials for others (Class 35).

The North Face Apparel Corp. (Opposer) has opposed the registration of the mark in both applications on the ground of likelihood of confusion, alleging that it, through its predecessors-in-interest and licensee, has been engaged in the manufacture and sale of outdoor and athletic clothing, gear, accessories and equipment; that it is the owner of registrations for an S-design mark for, *inter alia*, footwear, backpacks, sleeping bags, tents and tent accessories, and clothing, including t-shirts, shirts, tops, mittens and bib overalls; and for SUMMIT SERIES with the same S-design for, *inter alia*, footwear, sunglasses, tents and tent accessories, backpacks, sleeping bags and various clothing items[3]; that it has used these marks in commerce in the United States continuously since at least July 2000 in connection with

[3] Opposer's S-design mark and SUMMIT SERIES with S-design mark are reproduced here for ease of reference.

apparel and since at least July 2002 in connection with footwear; that it has used its S-design mark and its SUMMIT SERIES with S-design mark since prior to the first use dates claimed by Applicant in its applications; and that Applicant's mark is substantially similar to Opposer's S-design mark and its SUMMIT SERIES with S-design mark.[4]

In its answer, Applicant denied the salient allegations in the notice of opposition, made certain "further allegations" which are in the nature of explanations of its denials, and asserted certain affirmative defenses.[5]

Preliminary Matters

Motion to Amend

On November 6, 2013, after the close of its testimony period, Applicant filed a motion to amend its answer to the notice of opposition in order to assert an additional affirmative defense, specifically, to assert that, if the Board should find Applicant is not entitled to registration of the opposed mark with respect to some but not all of the goods or services listed in the applications, then Applicant should be allowed to amend the applications to conform to the Board's findings. Opposer has opposed this motion, and the Board, in an order mailed April 3, 2014, stated that the motion would be decided as part of the Board's final decision.

[4] Opposer also pleaded the ground of dilution in its notice of opposition, but withdrew this ground in its brief. 79 TTABVUE 14.

[5] Applicant did not address these affirmative defenses in its brief. We therefore consider them to have been waived.

In support of its motion, and as reiterated in its trial brief, Applicant states that Opposer has known of Applicant's intentions in this regard since at least 2009, when Applicant filed a motion to amend one of its applications. The actual history, as shown by the papers in this proceeding, is that on November 10, 2009, 13 TTABVUE, Applicant filed an unconsented motion to amend its application Serial No. 77376388 to delete certain goods and services in Classes 16 and 35, and all goods in Class 25, contingent on the Board's finding its mark unregistrable without the amendment. After a December 14, 2009 telephone conference between a Board attorney and the parties, Applicant removed the contingency and stated that the proposed deletions would serve to avoid any likelihood of confusion. However, in the Board order mailed June 11, 2010, 24 TTABVUE, the Board stated that Applicant had not complied with all of the requirements for an unconsented amendment to its application, and in particular it had not consented to entry of judgment against it with respect to the goods proposed to be deleted. As a result, the Board denied Applicant's motion to amend the application.

The opposition then proceeded to trial, with nothing more being said about an amendment of the application(s). Then, one week before the close of Opposer's rebuttal testimony period, Applicant filed its November 6, 2013 motion to amend.

This motion is problematic on many levels. For example, Applicant has not specified particular goods or services that it would delete from its

applications. Thus, Applicant's motion would essentially impose on Opposer the requirement to prove likelihood of confusion with respect to each of the numerous goods and services identified in the seven classes of Applicant's applications, as opposed to showing likelihood of confusion with respect to one or more (but not necessarily all) goods or services in each class of the applications. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group,* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item that comes within the identification of goods or services in that class). This would also require the Board to decide the issue of likelihood of confusion with respect to each of the hundreds of goods and services, a decision that Applicant would then effectively obviate as far as the goods or services for which likelihood of confusion was found.[6] We note Applicant's statement in the motion that it had contacted Opposer's counsel five months earlier, on June 18, 2013, and requested a stipulation that if the Board determined there was a likelihood of confusion, Applicant would have the right to amend Application Serial No. 77376388 to delete all of Class 25 and "bicycle

[6] We note that Section 18 of the Trademark Act, 15 U.S.C. § 1068, gives the Board authority to, *inter alia*, modify an application by limiting the goods or services specified therein. However, the motion by Applicant does not involve the type of situation that Section 18 was designed to address. The primary purpose of a Section 18 modification is to avoid a likelihood of confusion by restricting a broad identification to the specific type of goods or services for which the mark is actually used, or by restricting the channels of trade to those in which the goods or services actually travel. *See Eurostar Inc. v. "Euro-Star" reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994). Moreover, an amendment proposed as part of a Section 18 defense must be stated with precision. *See Proquest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353-54 (TTAB 2007).

dealerships; retail bicycle parts and accessories stores" from Class 35. Even if we were to treat this statement as part of the proposed affirmative defense, it would not have been sufficient to put Opposer on notice that it would have to prove likelihood of confusion with respect to each of the services in Class 35.[7] Although this contact took place during Opposer's main testimony period, a proposed stipulation that was never accepted did not put Opposer on notice that Applicant was seeking to conditionally delete the goods and services from its application. And certainly Applicant's motion, filed November 10, 2009, to amend Application Serial No. 77376388 by deleting certain goods and services, a motion that was denied on June 11, 2010, did not put Opposer on notice that the proposed restriction was still at issue five years later.

Accordingly, Applicant's Motion to Amend filed November 6, 2013, is denied.[8]

Applicant's Supplemental Notice of Reliance

At the same time it filed its trial brief, Applicant filed a Supplemental Notice of Reliance showing current information for some of Opposer's pleaded

[7] The purpose of the proposed stipulation regarding Class 25 is unclear, since, if we were to find likelihood of confusion with respect to any of the goods in this class, the opposition would be sustained as to the entire class, and there would be no need for Applicant to delete Class 25 from the application as this class would automatically be deleted.

[8] We add that even if this motion were granted, it would have no effect on our decision. We have already discussed the deletion of Class 25 (see footnote 6). As for the proposed deletion of "bicycle dealerships; retail bicycle parts and accessories stores" from the Class 35 services, because, as discussed *infra,* we find likelihood of confusion based on "retail stores featuring clothing, textiles and clothing accessories," the deletion of "bicycle dealerships; retail bicycle parts and accessories stores" would not result in a registration for the remaining services in the class. *See Tuxedo Monopoly, Inc.*, 209 USPQ at 988.

registrations. This was well after the close of Applicant's testimony period, and is therefore untimely as a notice of reliance. *See* Trademark Rule 2.122(d)(2) ("The notice of reliance shall be filed during the testimony period of the party that files the notice."). However, Applicant has submitted the notice in order to show that certain of Opposer's pleaded registrations were amended after the close of trial, as a result of the filing of Section 8 affidavits, to delete certain goods. As noted *infra*, it is Board policy to ascertain the status of registrations in such circumstances, and therefore we consider Applicant's filing as merely informational, rather than as an attempt to untimely make evidence of record.

Objections

The parties have raised many objections to specific testimony or documents, amounting to some 54 pages that discuss evidence and objections thereto. The objections, for the most part, are based on relevance, and go to the probative value to be accorded the testimony or evidence; in many cases the objecting party merely asserts that the exhibit does not support what the submitting party contends that it is submitted to show. We will not burden this opinion with a discussion of each objection, but merely state that we have accorded the testimony and evidence the weight to which it is entitled. To the extent the probative value of testimony or evidence is significant to our determination, we have addressed it in our analysis.

Record

The parties stipulated that testimony could be submitted by declaration (61 TTABVUE).[9] Accordingly, the record includes the pleadings; the files of the opposed applications; the declaration testimony, with exhibits, of Opposer's witnesses Christopher M. Turk, its Assistant General Counsel, (62 TTABVUE) and Neil Munro, the Product Director, Summit Series of The North Face, Inc., Opposer's sister company (65 and 66 TTABVUE), and of Applicant's witness, Stella Tsai, Applicant's Manager of its Overseas Marketing and Planning Department (71 TTABVUE); and Opposer's rebuttal witness, Mr. Munro (75 TTABVUE). Opposer has also submitted, under notice of reliance, (67, 68 TTABVUE[10]), portions of the registration file of a cancelled registration owned by Applicant; Internet materials; portions of the discovery deposition, with exhibits, of Stella Tsai, Applicant's Fed. R. Civ. P. 30(b)(6) designated witness; and Applicant's responses to certain of Opposer's requests for admission and one interrogatory.[11] Applicant has submitted,

[9] The parties are commended for stipulating to the introduction of testimony by declaration, as this generally focuses and improves the clarity of the evidence and conserves the Board's time.

[10] Some of the exhibits to Stella Tsai's discovery deposition that were part of the notice of reliance were submitted under seal. Because the exhibits do not appear in the public TTABVUE database, we have cited only to the TTABVUE entry number.

[11] Opposer submitted with its notice of reliance on portions of Ms. Tsai's discovery deposition certain exhibits to that deposition, including the entirety of Applicant's responses to Opposer's first set of interrogatories; however, in its notice of reliance Opposer states that it was introducing Applicant's response to interrogatory No. 4, and we therefore treat only the enumerated response as being of record. We add that, even if all the interrogatory responses were considered, they would not change the result herein.

under notice of reliance (73 TTABVUE), a copy of one of its registrations; excerpts, with exhibits, from the discovery deposition of Neil Munro; Internet materials; and excerpts from Ms. Tsai's discovery deposition, submitted to make not misleading the excerpts Opposer submitted. *See* Trademark Rule 2.120(j)(4). Opposer submitted, under a rebuttal notice of reliance, a portion of Mr. Munro's discovery deposition to make not misleading the portion Applicant submitted.[12]

Facts

Opposer is the owner of various trademarks, and licenses them to its sister company, The North Face, Inc. Munro dec. ¶ 1.[13] Opposer was founded in the 1960s as a mountaineering retail store. Munro dec. ¶ 6. Opposer has a SUMMIT SERIES line of products, in connection with which it uses the pleaded S-design and SUMMIT SERIES with S-design trademarks. Munro dec. ¶¶ 3, 4. Opposer has used the S-design trademark since 2000 for various goods, including general purpose clothing, outerwear, gloves and hats, as well as equipment such as backpacks, tents and sleeping bags. Munro dec. ¶ 7. The clothing and equipment are designed to be used in a variety of outdoor weather conditions, and to withstand the elements. Munro dec. ¶ 12.

Applicant is a foreign company whose primary product line in the United States is motorized scooters, which are generally sold through motor sports dealerships. Tsai dec., ¶¶ 2, 3.

[12] Both parties have erroneously identified this deposition as a testimony deposition.

[13] Hereafter, references to Opposer will include activities by The North Face, Inc.

Standing

Opposer has made of record, through the declaration of its Assistant General Counsel, Christopher M. Turk, its registrations for marks consisting of or containing the "S-design":

Registration No.	Mark	Goods/Services
3418103[14]		Footwear (Class 25)
3373851[15]		Backpacks, internal and external frame packs (Class 18); sleeping bags (Class 20); tents and tent accessories, namely, rain flies, ground cloths, and gear loft platforms used for storage (Class 22); clothing and footwear, namely, t-shirts, shirts, tops, pants, side zip pants, shorts, vests, parkas, anoraks, coats, jackets, wind-resistant jackets, pullovers, sweaters, overalls, thermal underwear, hosiery, socks, tights, gloves, mittens, shells, one-piece shell suits, ski wear, ski suits, ski vests, ski jackets, ski bibs, bib overalls, bib pants, snowboard wear, snow pants, snow suits, rainwear, rain jackets, rain pants (Class 25)

[14] Issued April 29, 2008; Section 8 affidavit accepted; Section 15 affidavit acknowledged. The registration information was printed on June 28, 2013, and made of record on July 30, 2013, prior to the filing of the Section 8 and 15 affidavits. In accordance with Board policy, we have ascertained the current status of the registration.

[15] Issued January 22, 2008; Section 8 affidavit accepted; Section 15 affidavit acknowledged. As with Registration No. 3418103, the registration information was printed on June 28, 2013, and made of record on July 30, 2013, prior to the filing of the Section 8 and 15 affidavits. Again, we have ascertained the current status of the registration. Some of the goods that were originally in the registration were deleted as a result of the filing of the Section 8 affidavit; our opinion reflects the current identification.

Registration No.	Mark	Goods/Services
3479423[16]	 (SERIES disclaimed)	Footwear (Class 25)
3349240[17]	 (SERIES disclaimed)	Backpacks, internal and external frame packs (Class 18); sleeping bags (Class 20); tents and tent accessories, namely, rain flies and gear loft platforms used for storage (Class 22); clothing, namely, jackets, parkas, coats, pants, bib overall pants, vests, one-piece shell suits, shells, mittens, gloves, rainwear, wind resistant jackets, shorts, shirts, t-shirts, thermal underwear; boots, namely, hiking and trekking boots; shoes, namely, climbing, hiking, trail running, athletic, sneakers (Class 25)

In view thereof, Opposer has shown that it has a real interest in this proceeding, and has therefore established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (standing requires only that the plaintiff believes it is likely to be damaged, can be shown by establishing a direct commercial interest; ownership of registrations and products sold under the marks in the registrations establish such direct commercial interest); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

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[16] Issued August 5, 2008. As with the previous registrations, we have ascertained that a Section 8 affidavit was accepted, and a Section 15 affidavit was acknowledged.

[17] Issued December 4, 2007. As with the previous registrations, we have ascertained that a Section 8 affidavit was accepted, and a Section 15 affidavit was acknowledged. Certain goods were deleted from the original identification upon the filing of the Section 8 affidavit, the listing in this opinion reflects the current identification.

Likelihood of Confusion Ground

There are two elements which must be proved to succeed on the ground of likelihood of confusion: priority and likelihood of confusion.

Priority

In view of Opposer's registrations which are of record, priority is not in issue for the goods listed therein. *See King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, the record shows that Opposer's sister company, The North Face, Inc., has used Opposer's "S-design" trademark since 2000 for various goods, including general purpose clothing, outerwear and gloves, and equipment such as backpacks, tents and sleeping bags. Munro dec. ¶ 7.[18] The earliest use of Applicant's applied-for mark in the United States that is of record occurred in 2006, and was in connection with motorcycles. Exhibit 30 to Tsai disc. dep. (confidential), submitted under Opposer's notice of reliance, 67 TTABVUE. Thus, at least for clothing, backpacks, tents and sleeping bags, Opposer has demonstrated prior use of its S-design mark.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the

[18] The declaration includes "hats" in the list of goods for which Opposer's sister company has used the mark since 2000, but "headgear" was specifically deleted from the identification in Registration No. 3373851 for the S-design mark. Whether or not the mark has been used since 2000 to the present for hats/headgear has no effect on our decision.

factors set forth in *In re E. I. du Pont de Nemours & 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).

Because Opposer's S-design mark is closer to Applicant's mark than is Opposer's SUMMIT SERIES with S-design mark, in that the latter has an additional point of difference due to the words SUMMIT SERIES, we concentrate our analysis on the likelihood of confusion between Applicant's mark and Opposer's S-design mark. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We begin with the *du Pont* factor of fame, because when fame is present, it plays a dominant role in the likelihood of confusion analysis. *See Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Opposer's evidence of fame is largely based on its sales and advertising figures. This information was submitted under seal, so we will refer to it only generally. Annual sales in the United States of Opposer's "Summit Series" items are in the millions of dollars. However, Opposer has not provided any context for these figures, so that we can measure them against other brands. What we do know is that they represent only eight to ten per cent of Opposer's total sales. Munro disc. dep., 73 TTABVUE 30. Further, the figures do not reflect what amount is for goods on which the S-design mark is used without SUMMIT SERIES, nor do they indicate how the sales are broken down by goods. For example, we cannot determine from

these figures whether the bulk of the sales are for tents, or backpacks, or sleeping bags, or particular clothing items. The advertising figures are even less probative, as they are the total expenditures for marketing all of Opposer's brands, and they do not reflect the advertising expenditures for goods bearing the S-design mark. Also, the figures are not limited to advertising in the United States.

Opposer has asserted that many celebrities wear Opposer's products. However, the examples of such use, Exhibit H to the Munro declaration, 65 TTABVUE 107-112, are merely five photographs of five celebrities engaged in various activities, and the existence of the S-design mark is not highlighted in any way. Nor is there any information as to where or when these photographs appeared, or what exposure they may have received. Also, in three of the photographs (Jennifer Garner, Renee Zellweger and Sebastian Vettel), the S-design mark is so distorted by being on the side of a sleeve that one would know it was the mark only if one were aware it would be there and was looking for it.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1438 (TTAB 2014); *see also, Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d

1713, 1720 (Fed. Cir. 2012); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Opposer has not met its burden of proving that its S-design mark is famous.

Turning next to the *du Pont* factor of the similarity of the marks, there are both similarities and differences in the marks, which we reproduce below.



Applicant's mark



Opposer's mark

Opposer contends that Applicant's mark is merely Opposer's mark turned on its side, and points to the description Applicant provided in its application that its mark is a stylized "S".[19] Opposer also points out that Opposer's mark is not limited to any particular color, and therefore may appear in the same colors in which Applicant's mark is shown, and be shaded to convey the same "texture."

Applicant, on the other hand, notes that Opposer uses its mark with its "Summit Series" products, and that the wording SUMMIT SERIES is usually included below the S-design, and is actually part of some of Opposer's pleaded marks. Because of this, and the fact that Opposer's goods can be used on mountains and in the wilderness, Applicant argues that the design would be perceived as an abstract image of a mountain. Applicant also asserts that its

[19] As noted previously, the description statement is "The mark consists of a stylized GRAY and WHITE stylized 'S' outlined in part in BLACK on a RED circular background ringed by a WHITE ring within a GRAY ring."

mark has a textured or three-dimensional effect, while Opposer's mark does not, and that the rotation of the orientation used in Opposer's mark changes the visual impression, such that the mark does not appear as a letter, but as a forward-moving arrow, or a wheel over which an arrow is superimposed, to suggest a wheel in motion.

Both parties have discussed at length the significance or lack of significance of the orientation of the marks. Opposer points to the fact that Applicant had earlier obtained a registration, No. 3195524, for a version of the present mark, but with the arrow pointed upward, and argues that Applicant "apparently did not believe that the difference in orientation made a difference in the overall impression." Brief, 79 TTABVUE 25. Applicant has explained that this registration was obtained in error, Tsai dec. ¶ 11, and that Applicant surrendered the registration for cancellation in 2009.

We give no probative weight to the fact that Applicant obtained a registration for a mark in a different orientation, which is shown below.



Applicant has explained that this orientation was done in error, and there is no evidence that Applicant advertises or uses its mark in this orientation.

As for Opposer's claim that its mark may appear in different orientations depending on the position of the product on which it is placed (so that it may

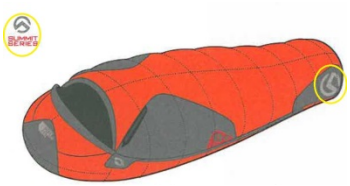
appear in the same orientation as Applicant's mark), the three examples given by Opposer are not particularly persuasive. See Exhibit C to Munro declaration. The gloves shown in Photo 1 (65 TTABVUE 35) are on their side, so that the S-design mark is at a 90 degree angle, but THE NORTH FACE logo also appears on the glove at this angle, so consumers would understand the correct orientation of the S-design mark. The same is true for the backpack shown in Photo 2 (65 TTABVUE 36), which has the words SUMMIT SERIES directly below the S-design. The third example, in Photo 3 (65 TTABVUE 33), is from "The North Face Workbook,"[20] on a page listing various sleeping bags and their specifications. The sleeping bags are shown in a horizontal position, as they would be utilized, and the S-design appears at a 90 degree angle. However, immediately above each sleeping bag is the mark SUMMIT SERIES with the S-design (*see* Registration No. 3349240), so again, consumers will immediately understand the correct orientation of the mark.



Photo 1



Photo 2


Photo 3

With respect to the connotation and commercial impression of the marks, Opposer's advertising shows that Opposer has advertised its S-design mark

[20] In his discovery deposition Mr. Munro explained that Opposer's sales force uses the dealer workbooks to sell the product line to Opposer's wholesale accounts. 73 TTABVUE 16.

in connection with the words SUMMIT SERIES, and has also used the S-design as part of a mark that includes these words. As a result, consumers may well view the design element as not merely an abstract "S" but an "S" that is also an abstract design of a mountain peak. We recognize that Opposer has also registered the S-design alone, and therefore it is not limited to displaying it with the words SUMMIT SERIES. However, to the extent that the S-design mark has recognition through Opposer's advertising efforts, promotion of the design in conjunction with the words reinforces the mountain imagery. *Cf. In re MBNA America Bank, N.A.*, 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003) (in a descriptiveness case, the Court said, "emphasis on the regional theme through marketing promotions and picture designs provides circumstantial evidence of how the relevant public perceives the marks"); *Specialty Brands v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (trade dress may provide evidence of whether word mark projects a confusingly similar commercial impression). Although the Munro declaration provides six examples in which the S-design mark appears on goods without the words SUMMIT SERIES (Exhibit C), three of them are photographs of the same or highly similar ski mittens,[21] and the remaining three include the words SUMMIT SERIES or the mark SUMMIT SERIES with S-design in close proximity to the goods.[22]

[21] 65 TTABVUE at 29-31, 35.

[22] 65 TTABVUE at 32-34.

As for Applicant's mark, we acknowledge that Applicant considers it to be an arrow or represents "motion." Well before this proceeding commenced, in a 2006 paper describing the development of its mark, the specific design was described as an arrow. Exhibit 3 (confidential) to Tsai discovery dep., submitted under Opposer's notice of reliance. However, it can also be viewed as an S design, as shown by the fact that in its initial application Applicant identified the literal element of the mark as an "S," (the Examining Attorney suggested that the mark be described as a stylized "S," which description was then adopted by Applicant).[23] At the same time, the forward facing angle and the interior circle emphasizing the angle create some visual differences between the marks. As a result, although there are some similarities in connotation and commercial impression of the marks, there are also some differences.



In comparing the marks, we keep in mind that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *See, e.g.*, *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) ("The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are

[23] To be clear, we do not treat Applicant's description as an admission that the design is an "S," but only as "illuminative of shade and tone" in reaching our conclusion as to the meaning and commercial impression of Applicant's mark. *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978).

sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties.") (citation omitted); *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2-3 (CCPA 1977) (marks "must be considered as wholes, and not on the basis of side-by-side comparison, and in the light of the fallibility of memory."). Accordingly, the fact that there are specific differences between the marks, e.g., "the line segment and partial circle are themselves enclosed in a complete circle" in Applicant's mark, Applicant's Brief, 82 TTABVUE 18, is not determinative. The question is whether the overall impression of the marks is so similar that consumers will believe that they identify goods or services emanating from a single source.

There are, as we and the parties have discussed, some similarities and some differences. On the whole, we find that the similarities outweigh the dissimilarities. In this connection, we note that there is no evidence of third-party use of S design marks that would make the differences in the marks more significant. Therefore, we find in Opposer's favor on the factor of the similarity of the marks. However, we also note "that similarity is not a binary factor but is a matter of degree." *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003). When "there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two

marks had been identical in design or nearly indistinguishable to a casual observer." *Id.* On the other hand, when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We keep this in mind as we consider the parties' goods and services. Because each class in Applicant's multi-class application is, in effect, a separate application, we consider each class separately, and determine whether Opposer has shown a likelihood of confusion with respect to each.

Class 25 (Application Serial No. 77376388):

Applicant's identified goods are:

> Swimsuits, shirts, beachwear, vests, Tee-shirts, coveralls, coats, liveries, footwear, scarves, neckties, headwear, earmuffs, socks, mittens, waistbands, and clothing for bikers, namely shorts, shirts, hats and shoes.

Opposer's goods in Class 25 in its Registration No. 3373851 for its S-design mark include t-shirts, shirts, vests, overalls, coats, socks, and mittens, while its Registration No. 3418103 for the S-design mark is for footwear. Thus, the goods are, in part, identical. Further, because the identifications in the registrations and application contain no restrictions as to trade channels, these legally identical goods are deemed to be sold in the same channels of trade. *See e.g., In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same

channels of trade to same class of purchasers); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014).

Although admitting that "Opposer's Clothing Lines Overlap With Some Clothing Items In One Of The Subject Applications," brief, 82 TTABVUE 27, Applicant argues that not all of its clothing items are covered by the goods in Opposer's registrations, e.g., swimsuits and beachwear. As discussed above, it is not necessary that Opposer prove that there is a likelihood of confusion with each item identified in Class 25 of Applicant's application in order for us to sustain the opposition with respect to this class. *See Tuxedo Monopoly, Inc.*, 209 USPQ at 988.

Given the identity of some of the goods, we find that Opposer's S-design mark is sufficiently similar to Applicant's mark that confusion is likely. Further supporting this conclusion is the conditions of purchase *du Pont* factor, since the clothing items are purchased by the general public, and certain of the identified goods, such as socks and tee shirts, would encompass inexpensive items that would be purchased on impulse and without care.

Class 35 (Application Serial No. 77376388):

Applicant's services in this class are identified as follows:

> Design of advertising materials for others; advertising services, namely, creating corporate and brand identity for others; import and export agencies; merchandise packaging; retail department stores; mail order catalog services featuring automobiles, motorcycles and their accessories; providing home shopping services in the fields of automobiles, motorcycles and their accessories by means of television; on-line retail store services featuring automobiles, motorcycles and their accessories; retail stores featuring clothing, textiles, and clothing accessories;

> retail furniture stores; retail store services in the field of eyeglasses; retail store services featuring electronic appliances and electronic materials; automobile dealerships; retail automobile parts and accessories stores; vending in the fields of jewelry and precious stones; bicycle dealerships; retail bicycle parts and accessories stores; retail store services featuring machinery; motorcycle dealerships; retail motorcycle parts and accessories stores; preparing promotional and merchandising materials for others.

Of these services, Applicant acknowledges that retail stores featuring clothing, textiles, and clothing accessories "are related to [Opposer's] class 25 goods." Brief, 82 TTABVUE 28. In view of this acknowledged relatedness, with which we agree, we find that Opposer's S-design mark is sufficiently similar to Applicant's mark that confusion is likely. As indicated, our finding of likelihood of confusion with respect to one of the services listed in Applicant's application in Class 35 is sufficient for us to sustain the opposition as to the entire class.

The relatedness of the goods and services in the remaining classes and Opposer's goods is less clear. Opposer contends that the goods identified in Opposer's registrations for the S-design mark "are either directly related or complimentary [sic] to goods and services listed in [Applicant's] applications…." Brief, 79 TTABVUE 27. When it comes to the particular goods that are asserted to be either directly related or complementary, however, Opposer's arguments are not very specific. Opposer claims that consumers would typically associate Opposer and its S-design mark "with outdoor apparel, equipment, and accessories for an active, sporting lifestyle,"

and that "Consumers would thus naturally associate the goods and services in [Applicant's] applications – such as retail stores featuring clothing and clothing accessories, electrical bicycles, scooters, bicycle stores, and related accessories and services" – with Opposer's S-design mark and Opposer. *Id*. With respect to the goods and services being complementary, Opposer asserts that Opposer's clothing and equipment are designed for use in outdoor activities, including biking or riding a scooter, and that scooter and bike riders are likely to wear clothing designed for outdoor activities, or carry backpacks and duffel bags (Opposer's goods) while they are traveling on a scooter. Opposer also points out that it sponsors biking events. Finally, Opposer invokes the "reasonable expansion" of its business to other goods, and asserts that Opposer sells clothing accessories designed specifically for biking, sells clothing used for riding on a motorcycle or scooter, has licensed its marks for use on bikes and motor vehicles, and currently has or has had trademark registrations in connection with bicycles, bike frames and bike parts, and therefore consumers are likely to assume that bikes or scooters bearing Applicant's mark represent an expansion of Opposer's "Summit Series" product line to other outdoor activities.[24]

Although, as we have said, each class of each application is essentially a separate application for which Opposer has the burden to prove likelihood of

[24] We point out that, although Opposer makes reference to a connection between its goods and bicycles, Applicant's identification of goods does not, in fact, include bicycles.

confusion, Opposer has not directly addressed which goods or services in each class it claims to be related to its goods. We think it will be helpful to the analysis if we consider each class in turn.

Class 7 (Application Serial No. 77376388):

The goods are identified as:

> Lawnmowers; electrical lawnmowers; plows; tractor-towed fertilizer applicators; tractor towed agricultural implements, namely, harrows, rollers, mowers, reapers; internal combustion engines for machine operation and replacement parts therefor; engines not for land vehicles; transmissions for machines; transmission gears for machines; continuous variable transmission for machines; boat engines; jet engines other than for land vehicles; motors other than for land vehicles; generators of electricity; couplings for machines; shaft couplings, not for land vehicles; sleeve gear couplings; machine fly-wheels; vehicle parts, namely, cams; connecting rods for motors, engines and machines; pistons for machines or engines; piston rings; cylinder heads for engines; cylinder block; camshafts for vehicle engines; gear boxes other than for land vehicles; driving chains other than for land vehicles; brake linings for machines; machine parts, namely, work holding fixtures for precision machining applications; pulleys being parts of machines; air filters for mechanical purposes; oil filters; machines parts, namely, cylinders; fuel filters; gas filters for motors and engines; air cylinder; fuel injectors; fuel injection nozzles; clutches for machines; pistons for cylinders; exhaust manifold for engines; pistons for engines; cooling radiators for motors and engines; mufflers for motors and engines; catalytic converters for motors and engines; crank shafts for engines; shock absorbers for machines; power transmission belts for machines, motors and engines used in industrial applications; fan belts for motors and engines; machine parts, namely hoods.

Opposer has not explained how any of these goods are related to any of the goods on which Opposer uses or has registered its S-design mark, nor is there any evidence from which we could conclude that the goods are related. In

view thereof, and the limited similarity of the marks, we find that Opposer has not met its burden to show likelihood of confusion with respect to this application in Class 7.

The opposition to Class 7 is dismissed.

Class 11 (Application Serial No. 77375588):

The goods are identified as:

> Anti-dazzle headlights for vehicles; light bulbs for directional signals for vehicles; anti-glare headlights for vehicles; defrosting apparatus for vehicles; vehicle reflectors; vehicle headlights; air conditioners for vehicles; lights for vehicles; dashboard and door courtesy lights for vehicles.

It appears from Opposer's arguments that it is asserting that bicycles and its clothing are complementary because its clothing can be worn while riding a bicycle, and perhaps it is arguing that consumers might make an association between Opposer's goods and bicycles because Opposer sponsors bicycle races, "distributes its goods to the bike specialty market," Munro dec. ¶ 22, and some of its advertising is "targeted at bikers." Munro dec. ¶ 24. Mr. Munro's testimony regarding these activities is that Opposer's goods "are regularly pictured in conjunction with bicycles in magazine articles about [Opposer's] products and in advertising in magazines that also feature bicycles." ¶ 21.

The goods as identified in Class 11 of Applicant's application are not bicycles, nor does the identification even mention bicycles. Because the items are broadly described as parts for vehicles, we accept that the identifications for "vehicle reflectors" and "vehicle headlights" could include reflectors and

headlights for bicycles. However, merely because a part can be used on a bicycle, and an item of clothing or a backpack can be worn when riding a bicycle, does not make a vehicle reflector or a vehicle headlight and a backpack or outdoor clothing complementary goods. As for Opposer's sponsorship of bicycle races, the evidence shows that Opposer is listed as THE NORTH FACE or is listed with its THE NORTH FACE logo in connection with these sponsorships. Numerous other companies are also listed as sponsors, ranging from KISS MY FACE to CASCADE DESIGNS to BEARTOOTH PUBLISHING to NORTHERN MICHIGAN UNIVERSITY to BELL HOSPITAL. We cannot conclude that consumers would assume that Opposer is a manufacturer of bicycles, let alone assume that reflectors and headlights for bicycles sold under an S-design mark have their source in Opposer, from the mere fact that Opposer sponsors bicycle races. As shown by Opposer's own activities, sponsors may support sporting events even though their goods are not used in the sporting event. Nor are we persuaded by the facts that Opposer advertises in magazines that feature bicycles, that in 2004 Opposer licensed its mark THE NORTH FACE for bicycles, and that in 2005 Opposer obtained a registration[25] for THE NORTH FACE for "bicycles, bicycle frames and structural parts thereof," that as a result, Opposer's clothing and backpacks and other gear, and reflectors and headlights for bicycles, are related. In particular, we note that Opposer's registration for

[25] Registration No. 2935516, 62 TTABUVE 66.

bicycles, bicycle frames and structural parts thereof was not for reflectors and headlights and that, in any event, it was cancelled for failure to file a Section 8 affidavit of use; once a registration has been cancelled, it has no real evidentiary value.

In short, when the differences in Opposer's S-design and Applicant's applied-for mark are considered in light of the differences in the goods, we find that Opposer has failed to prove likelihood of confusion with respect to the goods in this class.

The opposition to Class 11 is dismissed.

Class 12 (Application Serial No. 77375588):

The goods are identified as:

> Vehicles, namely, automobiles, motorcycles, motorized carts for personal transportation for senior citizens, electric motorcycles, sports motorcycles, electric scooters, electric bicycles, and all-terrain vehicles, and parts and fittings thereof namely, brake cables, clutch cables, fork bearings and races, fork dust boots, fork seals, handle bars, handle bar control levers, handle bar dampers, handle bar grips, brake calipers, brake pedals, brake rotors, front spacers, front dash panels, shift levers, headlight mounts, structural parts, pneumatic tires and inner tubes for motorcycles, engines for land vehicles, spoiler for vehicles, motors for automobiles, mudguards, automobile bodies, brake cylinder repair kits sold as a unit for land vehicles, brake cylinders, main brake cylinders, braking systems for vehicles and parts thereof; transmissions for land vehicles; wheels; land vehicles parts, namely, drive gears, drive belts, axles, rearview mirrors, shock absorbers.

For the goods in this class, the items that Opposer has submitted specific evidence about and/or has mentioned in its brief or reply brief are automobiles, scooters, motorcycles and electric bicycles, and therefore we

treat these as the goods that Opposer considers to be related to its goods. With respect to automobiles, Mr. Munro testified that Opposer promoted its S-design mark "through a Summit Series road trip featuring a vehicle bearing" the mark. ¶ 17. The evidence on this is that Opposer had a blog, "Never Stop Exploring," in which it posted about a roadtrip to various places in Europe in an RV which had the trademarks THE NORTHFACE logo and SUMMIT SERIES with S-design appearing on panels of the RV. There is no way that any reasonable person would view THE NORTHFACE logo or SUMMIT SERIES with S-design trademark as they appear on the panels as trademarks for the vehicle, any more than a person seeing a beer trademark on a delivery van would believe that the delivery van is sold by the brewery, or a person seeing a university decal on a passenger car would believe that the car was manufactured or sold by the university. Mr. Munro testified that "in the past" Opposer licensed its marks to General Motors for a sport utility vehicle which was co-branded as "The North Face edition of a Chevrolet Trailblazer" ¶ 28. Such vague testimony is insufficient to show that consumers would now be aware of those activities or make a connection between Opposer's and Applicant's goods. Certainly more would be necessary to prove that consumers would assume that Opposer's secondary mark, the S-design, would be used to identify automobiles.

As for the relatedness of Opposer's goods and scooters and motorcycles, Opposer's arguments are, as noted, that Opposer's clothing and backpacks

can be worn when riding motorcycles. The specific evidence is Mr. Munro's testimony that Opposer's "clothing is designed to offer a range of movement during physical activity," and that the "clothing, bags, and equipment" in Opposer's "Summit Series" product line "in particular are designed to withstand the elements," so that the products are useful "for athletes as well as bikers and motorcyclists." ¶ 12. The only evidence that shows any promotion of Opposer's goods in connection with a scooter/motorcycle is Exhibit D to the Munro declaration, 65 TTABVUE 37, a webpage from the Backcountry.com website offering a jacket called "The North Face Mack Moto Jacket-Men's." The text includes the sentence, "Throw on The North Face Mack Moto Jacket, rev up your scooter, and cruise the strip." A moto jacket, of course, is a style of jacket, in the same way that a bomber jacket is a style of jacket. Merely calling a jacket a moto jacket does not mean that it is designed to be worn, or in fact is worn, while riding a motorcycle or scooter. Thus, we cannot say that merely because Opposer has shown one example of a so-called moto jacket it has shown that its goods and motorcycles or scooters are complementary. Nor does the fact that Opposer's goods could be used while riding a motorcycle or scooter because they offer a range of movement or can withstand the elements make these goods complementary. Merely because goods can be used together is not a sufficient basis on which to find them to be complementary. *See, e.g.*, *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004). Rather, there must

be some showing that customers would seek out both types of goods for the same purpose, for example, making an outfit by matching shoes and clothing, or making a sandwich by combining bread and cheese, to show that the goods are complementary. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (women's shoes and women's pants, blouses, shorts and jackets complementary because shoes must match or contrast with an ensemble); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (bread and cheese complementary products, often used in combination).

We have also considered Opposer's evidence regarding the channels of trade. Opposer submitted, under notice of reliance, Internet evidence from various websites indicating that third parties sell both electric scooters and Opposer's goods. For example, the Macy's website offers for sale an "electric scooter" as well as Opposer's jackets, t-shirts, shorts and other clothing items, and backpacks, all sold under THE NORTH FACE logo, Exhibit 8, 67 TTABVUE 53; and webpages from the Dick's Sporting Goods website offer for sale electric scooters and Opposer's THE NORTH FACE logo backpacks, hoodies, jackets and gloves, Exhibit 9, 67 TTABVUE 62.[26] Other websites show that motorcycles, clothing and bags can be sold through the same

[26] Apparently neither Macy's nor Dick's Sporting Goods currently sells Opposer's products bearing the S-design mark, because Opposer submitted, during its rebuttal testimony period, a declaration of Neil Munro stating that Opposer "has in the past, and may in the future," sell goods bearing the S-design mark in department stores such as Macy's and sporting goods stores such as Dick's Sporting Goods. ¶ 4, 75 TTABVUE 3.

outlets, for example, Danny's Scooter Shop advertises Applicant's motorcycles as well as jackets, vests, gloves and backpacks, Exhibit 12, 67 TTABVUE 80, while the PowersportsMax website offers moped scooters and shows links to the "riding gear" categories of "Jackets, Vests, Jersey and Suits," "Pants and Chaps" and "Rainwear" as well as "Bags & Luggage," Exhibit 10, 67 TTABVUE 70.

Opposer has also made of record Applicant's admissions that some retailers in the United States that sell its scooters also sell apparel such as jackets (Admission No. 35); that one online retailer that sells scooters and/or scooter accessories also offers for sale a backpack bearing the mark THE NORTH FACE (Admission No. 29); that the website www.dickssporting goods.com advertises both a battery-powered children's recreational scooter and products bearing the mark THE NORTH FACE (Admission No. 18); and that the website Scooter Parts Place offers for sale scooter parts, accessories and THE NORTH FACE bags (Admission No. 30).

The evidence shows that clothing and backpacks, on the one hand, and electric scooters or mopeds or motorcycles, on the other, can be sold through the same channels of trade. As a result, consumers can encounter both Opposer's identified goods and the motorcycles and electric scooters identified in Applicant's application. This *du Pont* factor therefore favors Opposer. However, this is outweighed by the differences in the nature of the goods. The evidence provided by Opposer is not sufficient to show that consumers would

believe that the same company that sells clothing and tents and backpacks would also sell motorcycles and electric scooters, even when they see the goods offered in the same store. Further, although we have found that the marks are similar in our assessment of the first *du Pont* factor, there are also, as we have said previously, definite differences between the marks; as a result, consumers are not likely to assume a licensing arrangement whereby the goods are sponsored by the same source.

In addition, the fourth *du Pont* factor, the conditions of purchase, plays a role. The Internet evidence submitted by Opposer shows that even the basic electric scooters, which look like a child's toy scooter with a battery underneath the foot rest, cost between $130 and $250, while mopeds cost between $400 and $1100 and motorcycles cost thousands of dollars. Applicant's own scooters sell with suggested retail prices of $1,999 and up. Tsai dec. ¶ 13. Because of the expense of these goods, even at the lower end of this range, some care will be taken in making a purchase, and the differences in Opposer's and Applicant's design marks will be apparent.

We next consider the relatedness of electric bicycles and Opposer's goods, which do not include any type of bicycle. As previously noted, Opposer has argued that it is associated with biking because it has sponsored bicycle races, has featured bicycles in the marketing of its clothing items, and its clothing has been sold in some bicycle stores. However, the bicycles that Opposer has associated itself and its clothing with are non-motorized

bicycles, not electric bicycles. Opposer's marketing materials and advertising efforts showing mountain biking and other outdoor activities do not feature electric bicycles. Opposer has simply failed to show why consumers would be likely to believe that electric bicycles sold under Applicant's mark – a mark that has differences from Opposer's S-design mark – would be sponsored by or emanate from Opposer.

The opposition to Class 12 is dismissed.

Class 16 (Application Serial No. 77376388):

The goods identified in this class are:

> Stickers; envelopes; letter paper; note papers; books in the field of automobiles and motorcycles; notebooks; manuals in the field of automobiles and motorcycles; pictorial prints; calendars; photograph stands; paper bags; boxes of paper or cardboard; glue for stationery or household purposes; pens; pen cases; advertising boards of paper; flags of paper; blank cards.

Opposer has not discussed in its briefs how any of these goods are related to Opposer's goods, nor do we view any of the testimony or evidence as showing that they are related. At the oral hearing there was some characterization about the marks that appeared on the RV used in connection with the Never Stop Exploring blog (see analysis regarding Class 11) being stickers, but to the extent that Opposer is making that argument, we are not persuaded thereby. Opposer does not contend and there is no evidence that it sells stickers as opposed to using them to apply its mark to methods of advertising. It is also not clear from the testimony and evidence regarding the RV and blog that the marks are in fact on stickers, as opposed to being

screened or painted on the RV. In any case, merely using a sticker that displays one's mark does not make a company a seller of stickers, nor is there any basis for us to conclude that consumers would recognize the marks as stickers, let alone believe that Opposer is the source of stickers that are sold under Applicant's S design mark.

The opposition to Class 16 is dismissed.

Class 37 (Application Serial No. 77375588):

The services identified in this class are:

> Automobile maintenance and repair; motorcycle maintenance and repair; automobile washing; motorcycle washing; automobile rustproofing; motorcycle rustproofing; automobile greasing; motorcycle greasing; automobile cleaning; motorcycle cleaning; automobile service station services; tire retreading; installation, maintenance and repair of machines in the field of automobile maintenance; installation, maintenance and repair of machines in the field of motorcycles maintenance.

The evidence concerning Opposer's activities regarding automobiles is the co-branding with General Motors of a "The North Face" edition of a Chevrolet Trailblazer "in the past." Munro dec. ¶ 28. As previously discussed, this is not sufficient to show a relatedness between automobiles and Opposer's goods. It certainly is not sufficient to show a relatedness between Opposer's goods and car and motorcycle maintenance, repair, washing, rustproofing, greasing and cleaning services, or any of the other services in Applicant's identification in this class. The difference in the goods and services is dispositive on the issue of likelihood of confusion. *See Kellogg*, 21 USPQ2d at 1145.

The opposition to Class 37 is dismissed.

We have concentrated our analysis on the *du Pont* factors of fame, the similarity of the marks and the similarity of the goods/services, since, as we have said, if fame exists it plays a critical role, and because, in any likelihood of confusion analysis, similarity of the marks and the goods/services are two key considerations. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also*, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). This is not to say that we have ignored the evidence and argument with respect to the other factors. On the contrary, we have considered all the arguments and evidence that pertain to all the *du Pont* factors. However, in reaching our conclusions on the classes for which we have dismissed the opposition, to the extent that any *du Pont* factors favor Opposer's position, we have found them not to outweigh the differences in the goods and services, as discussed. Each factor may, from case to case, play a dominant role. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567.

Decision

Application Serial No. 77375588: The opposition is dismissed with respect to all three classes in the application – 11, 12 and 37.

Application Serial No. 77376388: The opposition is dismissed with respect to Classes 7 and 16; the opposition is sustained with respect to Classes 25 and 35.