

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB

Mailed: 18 FEB 2004
Paper No. 52
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pacific Sunwear of California, Inc.
v.
AIT, Inc.

Opposition No. 91111244
to application Serial No. 75323781

Matthew D. Murphey of Murphey & Murphey, A.P.C. for Pacific Sunwear of California, Inc.

Ira S. Dorman, Esq. for AIT, Inc.

Before Hohein, Rogers and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

AIT, Inc. (applicant) applied to register the mark PAC AIT in typed form for "men's, women's and children's clothing, namely, shirts, sweatshirts, T-shirts, jackets, coats, robes, sweaters, hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear, and neckwear" in International Class 25.¹

¹ Serial No. 75323781, filed July 14, 1997. The application contains an allegation of a bona fide intention to use the mark in commerce.

Opposition No. 9111244

Pacific Sunwear of California, Inc. (opposer) opposed the registration of applicant's mark. In its notice of opposition, opposer alleges that it "has engaged, is now engaged, and plans to continue to engage in the services of advertising, sale, and marketing of clothing, namely, pants, shirts, shorts, hats, swimwear, T-shirts, jackets, sweat shorts, tank tops, sport shirts, wind resistant jackets, jogging suits and shoes" under the mark PAC SUN in typed form in International Class 25.² Opposition at 2. Opposer also maintains that it "has used and is now using the trademark 'PAC SUN®' in doing business in the clothing industry" and that potential customers have "come to know and recognize Opposer's service mark and services and to associate them with Opposer and the goods sold by Opposer." Opposition at 2-3. Applicant denied the salient allegations of the notice of opposition.

The Record

The record consists of the following items: the file of the involved application; the testimony deposition of opposer's president, Timothy Harmon, with accompanying exhibits; opposer's notices of reliance on the discovery deposition of applicant's principal, Conrad J. Kronholm, Jr. with exhibit and applicant's answers to opposer's

interrogatories; the "agreed upon" testimony of Conrad J. Kronholm, Jr., with accompanying exhibits; and applicant's notice of reliance on opposer's responses to applicant's request for admissions, opposer's response to interrogatories, and copies of third-party federal trademark registrations.

Procedural Matters

Both parties have raised numerous evidentiary objections to the other party's evidence. Opposer "objects to the testimonial Affidavit of Conrad J. Kronholm, Jr. and exhibits ... on the grounds of lack of foundation and authentication under Rule 901, and lack of personal knowledge." Opposer's Brief at 39. This affidavit was submitted under an "Agreement as to Testimony." The parties' attorneys agreed that the "testimony shall be submitted in this Opposition in the form of the attached Affidavit." Trademark Rule 2.123(b) ("By written agreement of the parties, the testimony of any witness or witnesses may be submitted in the form of an affidavit").³

² Registration No. 1,613,010, issued September 11, 1990, renewed. The registration contains an allegation of a date of first use and first use in commerce of October 21, 1987.

³ In opposer's reply at 1 (which we will consider), opposer argues that "[w]hile it is true that Pac Sun stipulated to Pac Ait's request to use affidavit testimony, Pac Sun's stipulation did not include the inclusion of improper or objectionable exhibits in that affidavit." While opposer is perhaps technically correct, it is a poor practice to agree to the submission of testimony by affidavit without indicating in advance that the party intends to raise a plethora of objections to the affidavit after the defendant's testimony period closes.

Opposition No. 91111244

Any "objection to testimony in affidavit form, which is waived if not made at deposition, must be raised promptly after receipt of the affidavit submission." TBMP § 707.04. Applicant's notice of reliance was submitted on November 9, 2001, applicant's testimony period closed on November 11, 2001, and opposer's objections were filed on December 18, 2001. We find that the objections as to foundation and lack of authentication are untimely. We also note that opposer's objection as to lack of personal knowledge of the witness is based on the witness's use of the passive voice in the affidavit. Again, this objection should have been raised earlier because it is likely that it could have been obviated or removed at that time. Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845, 847 (TTAB 1984) ("[W]ith respect to respondent's objections on the grounds of improper identification and/or authentication of exhibits and/or that the exhibits were inadmissible hearsay with no foundation laid for an exception to the hearsay rule[,],... [i]t is our view that that all of respondent's objections are of a type that could have been remedied or obviated had they been made during the taking of the deposition"). In addition, simply because a witness uses the passive voice does not establish

Cf. Hercules Casualty Ins. Co. v. Preferred Risk Ins. Co., 337 F.2d 1, 4 n.3 (10th Cir. 1964) ("*Subject to the objections of materiality and relevancy it was stipulated that certain affidavits could be, and were, received as the testimony of the affiants*") (emphasis added).

Opposition No. 9111244

that the statement is not based on personal knowledge and opposer's objection to this testimony on this ground is overruled.

Opposer's objection as to the relevance of third-party registrations and responses to requests for admissions are overruled. While third-party registrations, by themselves, cannot be used to justify the registration of a confusingly similar mark, they are not irrelevant. They may be used in connection with evidence of use to show that a term is not entitled to a broad scope of protection and they may be used to show the meaning of a term much as a dictionary is used. In re Nashua Corporation, 229 USPQ 1022, 1023 (TTAB 1986) ("Third-party registrations may provide some evidence as to the meaning of a mark or portion of a mark in the same way dictionaries are used. In this case they provide some evidence that applicant and registrant, as well as others, adopted marks beginning with "THERM" to convey a suggestion of heat" (citation omitted)).

Opposer's other objections to the admission of the cross-examination of its witness, which are on the grounds that it exceeds the scope of the direct examination, it calls for speculation, or that it calls for a lay opinion, are overruled. While we are not convinced that most of this testimony is entitled to much weight, we will not exclude it.

Opposition No. 9111244

We also overrule applicant's motion to strike opposer's notice of reliance submitting the complete set of its discovery responses, and as provided in Trademark Rule 2.120(j)(5), we will exercise our discretion and consider these responses. We also overrule applicant's objections to Mr. Harmon's testimony on the ground of hearsay, lack of foundation and relevance. Mr. Harmon, as the president of opposer who was employed by opposer for ten years, could testify regarding sales and advertising. Harmon dep. at 7.

Finally, we note that on December 17, 2003, the Deputy Commissioner for Trademark Examination Policy denied opposer's motion to reverse the Board's previous order granting applicant's motion to strike opposer's reply brief. Therefore, we have not considered opposer's reply brief.

Priority

In its notice of opposition, opposer refers to its Registration No. 1,613,010 and attaches a plain copy of the registration to its notice of opposition. Applicant, in its answer, admitted that a copy of the registration was attached to the notice of opposition. A plain copy of the registration was also introduced during opposer's president's testimony. Opposer's witness answered in the affirmative when asked whether he was familiar with the registration and whether the dates of use in the

Opposition No. 9111244

registration were correct. Harmon dep. at 11. Opposer, however, did not submit a status and title copy of the registration.

Trademark Rule 2.122(d) provides that:

(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals and photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original and photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

While opposer has alleged ownership of a registration and has attached a copy thereof to its notice of opposition, the registration is not properly of record. There are several ways for a party to introduce a registration that it owns into evidence in a Board proceeding. The most common way is to attach to the notice of opposition two copies of the registration prepared and issued by the USPTO showing both current status and title or to submit such copies under notice of reliance. Trademark Rule 2.122(d). Opposer has not provided such copies. Other ways a party's registration

Opposition No. 9111244

will be considered to be of record include by identification and introduction during the testimony period by a qualified witness who testifies concerning the status and title of the registration; by admission in the applicant's answer; or by the applicant treating the registration as being of record in its brief. TBMP § 704.03(b)(1)(A) (2d ed. 2003).

Inasmuch as opposer's witness did not testify as to the status and title of its pleaded registration, and because applicant did not admit the existence of the registration in its answer, in its admissions or in its brief, the registration was not made of record by any of these means.

Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (Federal Circuit affirmed the Board's dismissal of an opposition for failing to present a prima facie case of likelihood of confusion).

Therefore, opposer will not be permitted to rely on such registration as a basis to oppose the registration of the application in this case.

Applicant also maintains that "opposer cannot rely upon common law or trade name rights" and that the notice of opposition "makes no mention whatsoever of common law trademark rights." Applicant's Brief at 9. However, while the notice of opposition did not use the term "common law" rights, it did put applicant on notice that opposer was relying on the use of its mark prior to applicant's use.

Opposition No. 9111244

See Notice of Opposition at 2 (Opposer "has engaged, is now engaged, and plans to continue to engage in the services of advertising, sale, and marketing of men's, women's and children's clothing..." and opposer "has used and is now using the trademark 'PAC SUN®' in doing business in the clothing industry"); and Notice of Opposition at 3 ("Because of this investment in the advertising, sale and marketing of Opposer's products bearing the trademark 'PAC SUN®,' customers, potential customers and others in or familiar with the clothing industry have come to know and recognize Opposer's service mark and services and to associate them with Opposer and the goods sold by Opposer"). Therefore, we hold that opposer can rely on its pleading of common law rights in the mark PAC SUN.

In a case involving common law rights, "the decision as to priority is made in accordance with the preponderance of the evidence." Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Applicant's mark was filed on July 14, 1997. Its application is an intent-to-use application. Such an application has its filing date as a constructive use date. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use

Opposition No. 9111244

application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

The next question is whether opposer has demonstrated that it has used its mark for its goods or services prior to applicant's July 14, 1997, priority date. Opposer's witness testified in 2001 that he has worked for opposer since 1991. Harmon dep. at 7 ("Q. How long have you worked for Pacific Sunwear? A. Ten years"). He has been president of opposer for four years prior to his deposition. Harmon dep. at 58. There is nonetheless little definitive evidence that shows use of the mark PAC SUN on clothing items prior to applicant's constructive use date. We note that while opposer has also testified that it operates 684 stores (Harmon dep. at 52), the testimony regarding its use of its mark on goods is less clear. Most of the exhibits appear to refer to retail clothing store services. There is an exhibit (# 10) that consists of garment labels but the testimony regarding these labels consists of the following statement: "These are PacSun labels that are sewn into garments that are sold in our stores." Harmon dep. at 37. There is no testimony as to when these labels were used or on what goods they were used. Some exhibits refer to a different mark, PACIFIC SUNWEAR. Harmon Ex. 13 at 2-10; 14 at 2, 5, 7, and 9.

However, we find that at the very least one exhibit demonstrates that opposer was using the mark PAC SUN in association with retail clothing store services. Harmon Ex. 9-1. Opposer's witness testified that this exhibit was part of a program that started in 1995. Harmon dep. at 35. There is other evidence that supports opposer's use of the mark as a service mark for retail sales of clothing. See Harmon Ex. 14 at 4 (PACSUN Stores, PACSUN gift certificates, an 888-4PACSUN telephone number).⁴

The exhibits and testimony support a conclusion that opposer began using its mark, at least in connection with retail store services, prior to July 14, 1997. The evidence regarding use of opposer's marks on goods consists of its president stating that the dates of use in its registration were correct. However, the dates of use preceded the president's tenure with the company. We decline to assume that the PAC SUN mark was in use on the goods identified in the pleaded registration at the time of the witness's employment by opposer because the testimony was not very clear and the documentary evidence provides little support for this statement.

Likelihood of Confusion

The central question in this case is whether there is a likelihood of confusion. In likelihood of confusion cases,

⁴ The goods in the exhibit were identified by different

Opposition No. 91111244

we look to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We start by considering whether the goods and services of the parties are similar. We must consider the goods as they are identified in the identification of goods in the application. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). The application in this case is for men's, women's and children's clothing, namely, shirts, sweatshirts, T-shirts, jackets, coats, robes, sweaters, hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear, and neckwear. Regarding opposer's mark, we will consider that opposer's retail clothing store services involve many of applicant's clothing items. We find that clothing items are related to retail clothing store services for the

trademarks (VANS shoes, SURF DIVA T-shirts, ANGEL sunglasses).

Opposition No. 9111244

identical clothing items.⁵ In re United States Shoe Corp., 229 USPQ 707, 708 (TTAB 1985) ("The goods must, for our purposes, be considered to be identical and the services are closely related to the goods. Applicant sells women's clothing and renders women's retail clothing store service under its mark. Registrant also sells clothing under its mark"); In re Gerhard Horn Investments Ltd., 217 USPQ 1181, 1182 (TTAB 1983) ("[C]onfusion and mistake as to the origin of 'MARIPOSA' clothing store services and fabric goods would be equally likely.").

The next important factor in a likelihood of confusion analysis is the similarity or dissimilarity of the marks. When we compare the marks, we must compare them in their entireties rather than the individual features of the marks. In re Shell Oil, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Here, opposer's mark is PAC SUN while applicant's mark is PAC AIT. The only feature that the marks have in common is the initial word PAC. The second words in the marks are completely different except for the fact that they contain three letters (SUN and AIT). Applicant indicates that the word "ait" is defined as "a

⁵ For the sake of completeness, we add that, even if opposer had proven that it was using its mark PAC SUN on clothing items, including some of the same goods as applicant, this fact would not change the outcome in this case. The other factors strongly support the outcome in this case. See Bost Bakery, Inc. v. Roland Industries, Inc., 216 USPQ 799 (TTAB 1982) (HERITAGE HEARTH and OLD HEARTH, both for bread, not confusingly similar).

Opposition No. 9111244

small island, esp. in a river (Brit. Dial.)" and that it is "also homonymous with the word 'eight.'" Applicant's Notice of Reliance, Ex. 7; Applicant's Answers and Objections at 2. This is not a case in which the parties' respective uses of generic or highly descriptive terms create a situation where the marks become very similar. Cf. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985):

To illustrate, assume the following pairs of hypothetical marks for identical financial services: ACCOUNT and EXCHANGE; CASH ACCOUNT and CASH EXCHANGE or MANAGEMENT ACCOUNT and MANAGEMENT EXCHANGE; CASH MANAGEMENT ACCOUNT and CASH MANAGEMENT EXCHANGE; and, finally, CASH MANAGEMENT ACCOUNT BANK and CASH MANAGEMENT EXCHANGE BANK. That these pairs are of progressively greater similarity is readily apparent, with the result that likelihood of confusion of the public becomes a closer question at each step of the progression, until it becomes virtually undeniable even though only a "generic" word, "BANK," has been added to the final stage.

We find that there are significant differences in the pronunciation and appearance of the marks PAC SUN and PAC AIT. The word, PAC, which opposer acknowledges is an abbreviation of the word PACIFIC, is hardly a unique or arbitrary term in the United States. Harmon dep. at 13.

Regarding the meaning of the marks, opposer acknowledges that its mark is a shortened version of its name, PACIFIC SUNWEAR. Harmon Dep. at 13 ("Kids starting calling the company PacSun instead of Pacific Sunwear"). The term, as a shortened form of sunwear, is again not an arbitrary or unique term when applied to clothing items.

Opposition No. 91111244

Applicant argues that the term "A-I-T is a play on words in that it sounds like the number, and you had Pac 8 on the West Coast and Big Ten and the Big West, and it's really just a take-off on that concept of various sports leagues." Applicant's Brief at 15, citing, Kronholm disc. dep. at 14.⁶ We tend to agree, at least, in part with applicant that prospective purchasers may pronounce the word "ait" as the number "eight" similar to the former PAC 8 (now the PAC 10). To the extent that purchasers would not pronounce the mark as the number "eight," they would likely just spell out the letters as if they were an acronym, "A.I.T." While a few people may be familiar with the British Dialect definition of "ait" as an island chiefly in a river, it is unlikely that even this definition would lead the purchasers to view applicant's and opposer's mark as similar in meaning as opposer argues. Opposer's Brief at 21 ("`Sun' in `PAC SUN' accentuates the pacific island effect. Similarly, `Ait' in `PAC AIT' also accentuates the pacific island effect"). We conclude that, regardless of the interpretation of the word "ait," the meanings of the marks PAC SUN and PAC AIT would be different.

When we view the marks as a whole, we conclude that their commercial impressions are substantially different. PAC SUN and PAC AIT have significant differences in sound,

⁶ Applicant's witness also cryptically asserted that "there are

Opposition No. 9111244

appearance, and meaning and their overall commercial impressions are not similar. Furthermore, there is little evidence to suggest that PAC, the abbreviation for "pacific," is itself associated with opposer in such a way that it would dominate both marks and lead consumers to associate applicant's mark with opposer's mark.⁷

Applicant's addition of the word "AIT" is hardly a term that would be glossed over by prospective purchasers or simply substituted for "SUN." It would likely cause purchasers to pause and consider its meaning and pronunciation. It would also diminish the significance of the initial word "PAC." See Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) quoting, National Distillers and Chemical Corp. v. William Grant & Sons, Inc., 505 F.2d 719, 184 USPQ 34, 35 (CCPA 1974) ("[W]e here consider as marks a commonly known term, BOSTON TEA PARTY, and an uncommon term, BOSTON SEA PARTY. Although appellant argues that there exist similarities in sight, sound, and meaning (which are self-evident), and that appellee admits that its term is a play on 'Boston Tea Party,' we remain convinced that 'the familiar is readily distinguishable from the unfamiliar'").

eight Pacific islands." Kronholm disc. dep. at 14

⁷ We grant opposer's request to take judicial notice of the definitions of "Pacific." University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Opposition No. 9111244

See also Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185, 186 (Fed. Cir. 1984) ("Stated otherwise, the fact that both marks [HUNGRY HOBO and HOBO JOE'S] play on the hobo theme is not enough to make confusion likely, in light of the differences in the marks as a whole") (quoting and affirming Board).

We now look at other factors that are important in a likelihood of confusion determination. Opposer argues that its "mark is famous as determined by its sales, advertising, and length of use." Brief at 30. Opposer's witness testified that it advertises on Warner Brothers television (WB) as well as on MTV, ESPN, and ESPN2. Harmon dep. at 47. In addition, its advertising budget was \$10,000,000 in 2000 and \$13,000,000 in 2001. Harmon dep. at 51. Opposer has 684 stores now (Harmon dep. at 52) and opposer's sales have increased from \$112,000,000 in 1996 to \$436,800,000 in 2000. We also note that much of the increase in opposer's sales and advertising occurred after the filing of the application in this case. In his 2001 deposition, opposer's witness indicated that he has been running the advertising "for the last three years" and opposer "really didn't advertise prior to that." Harmon dep. at 65.⁸

⁸ Interestingly, opposer has also introduced nine questionnaires from several consumers. Harmon Ex. 18. In response to the question, "Of all the stores you shop for casual clothes, which ones are your favorites," none of the respondents used the mark PAC SUN to refer to opposer's stores. They all identified the

The Federal Circuit "has acknowledged that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21, 23 USPQ2d at 1701, quoting, Kenner Parker Toys v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for edible dog treats confusingly similar to FRITO-LAY snack foods). When we review the evidence that opposer has submitted regarding the fame of its mark, we are convinced that opposer's mark is not weak and that it has obtained some public recognition or renown, but there is little evidence that opposer's recognition extends to the term "Pac" alone. We also find that the public recognition and renown is not so great that the public would be likely to confuse these otherwise significantly different marks.

Another factor that the parties dispute is the sophistication of the purchasers of the respective goods and services. Opposer argues that purchasers of clothing of the

store as Pacific Sunwear or Pacific Sun. In response to the request to rank their favorite brand of clothing, no respondent listed PAC SUN or even Pacific Sunwear as their favorite brand. Inasmuch as the respondents "are customers that have shopped within a Pacific Sunwear store in the last 90 days prior to the event," the total lack of identification of opposer's PAC SUN mark by its own customers is surprising.

Opposition No. 9111244

type sold by opposer⁹ and applicant are impulsive. Opposer also argues that its purchasers are "young, relatively unsophisticated consumer[s]." Brief at 28. Applicant argues that the "purchasers for the goods are not impulsive or unsophisticated." Brief at 16. We find that the evidence does not support opposer's argument that the purchasers would be impulsive or unsophisticated. Opposer has indicated that the price of its goods range from \$18 for T-shirts to \$130 for jackets. Harmon dep. at 26-27. In addition, opposer's own questionnaires of its purchasers pertaining to trademark recognition do not provide any basis to infer that these purchasers, who identified their ages as ranging from 15-18, were less sophisticated than other purchasers.

When we analyze this case and consider all the factors on the issue of likelihood of confusion, we are convinced that there is no likelihood of confusion in this case. The marks have little in common other than the term PAC, which opposer's evidence does not indicate is a dominant term associated with opposer. The overall commercial impressions of the marks PAC SUN and PAC AIT are different. Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ 1142, 1143-44 (Fed. Cir. 1991) (FROOTEE ICE and elephant design is so different from FROOT LOOPS that, even if goods were

⁹ Patrons of opposer's retail stores would apparently be similar

Opposition No. 91111244

closely related and opposer's mark were famous, there was no likelihood of confusion).

Decision: The opposition is dismissed.

to the purchasers of its goods.