

03/13/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 21
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Joseph J. Juras

v.

Kent Christopher Lyons

—
Opposition No. 113,737
to application Serial No. 75/374,625
filed on October 16, 1997
—

James E. Shlesinger of Shlesinger, Arkwright & Garvey, LLP
for Joseph J. Juras.

Timothy J. Humphrey of Owen, Wickersham & Erickson, PC
for Kent Christopher Lyons.

—
Before Hairston, Wendel and Holtzman, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Kent Christopher Lyons filed an application to register
the mark YELLOW DOG SPORT for "men's, women's and children's
clothing, namely, shirts, sweatshirts, pants, jackets, hats,
caps and active wear."¹

—
¹ Serial No. 75/374,625, filed October 16, 1997, based on an
allegation of a bona fide intention to use the mark in commerce.
A disclaimer has been entered of the word SPORT.

Joseph J. Juras filed an opposition to registration of the mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act. Opposer alleges that, since prior to applicant's filing date, opposer has used the mark YELLOW DOG, either alone or in combination with other words, for T-shirts; that he has sold YELLOW DOG T-shirts since at least as early as July 1997; that applicant's YELLOW DOG SPORT mark is confusingly similar to opposer's mark; that use of applicant's mark in connection with his goods is likely to cause confusion; and that opposer filed an application for the mark YELLOW DOG NANTUCKET for T-shirts and other clothing items on June 30, 1998 which has been refused registration under Section 2(d) over applicant's pending application.

Applicant, in his answer, denied the salient allegations of the notice of opposition and set forth the affirmative defense of unclean hands.²

The Record

The record consists of the file of the involved application; opposer's trial testimony deposition, with accompanying exhibits, of Joseph J. Juras; certain of applicant's discovery responses made of record by opposer's notice of reliance and certain of opposer's discovery

² Applicant has failed to pursue this affirmative defense and accordingly we have given no consideration thereto.

responses made of record by applicant's notice of reliance.³ Both opposer and applicant have filed briefs but an oral hearing was not requested.

Opposer initiated his first activities with respect to the sale of T-shirts bearing the mark YELLOW DOG NANTUCKET in May 1997 when he had twelve white T-shirts and two rugby shirts printed for him by College Corner in Potsdam, New York. (Invoice for T-shirts Exhibit 2 and sale receipt for rugby shirts Exhibit 3). He set up an additional telephone line in New York State in June 1997 for voice mail box messages with respect to sale of his T-shirts. (Exhibit 4). Opposer testified that after the first twelve T-shirts were shipped to him, he shipped some to Nantucket for sale, "right after they were produced in May or June of 1997." (Deposition p. 11). He described this shipment and subsequent receiving of funds as his first sale. Upon cross-examination, more particulars were given as to the sale of these twelve T-shirts. Opposer testified that he approached the retailer Gazebo Outfitters in Nantucket in June 1997 who agreed to purchase eight T-shirts for sale at their retail location; that the T-shirts were sold; and that opposer was given money for the T-shirts in July 1997. (Deposition p. 55-57). Opposer further testified that the

³ We note that Exhibits 46, 48 and 49 which accompanied opposer's trial testimony deposition automatically became of record for all

Opposition No. 113,737

remaining four T-shirts were sold by him directly to individuals residing in Nantucket, naming three of the four persons. When questioned as to the date of these sales, opposer first stated "June and July" but subsequently identified the time of his first sale as the weekend of the Fourth of July. (Deposition p.65-67). Opposer made no more sales in 1997.

In May-July 1998 opposer had several orders of T-shirts produced for him by the Holy Shirt Company, and these T-shirts were subsequently sold at retail outlets in Nantucket. (Exhibits 7-17). In 1999 T-shirts were similarly produced for opposer and subsequently sold in the summer months in retail outlets in both Nantucket and Skaneateles, New York.⁴ (Exhibits 18-45). Opposer has also sold to individuals contacting him via the Internet. Opposer testified that he sold approximately 4000 T-shirts in 1998 and 2000 T-shirts in 1999.

Opposer identified a handbill (Exhibit 48) which he stated was posted on message boards advertising his T-shirts in June 1997 directing persons to Gazebo Outfitters to purchase his YELLOW DOG NANTUCKET T-shirts and an advertisement (Exhibit 49) which was sent in the summers of

purposes and there was no need for applicant to make the same of record by means of his notice of reliance.

⁴ The shirts sold in Skaneateles were printed with the designation YELLOW DOG SKANEATELES.

Opposition No. 113,737

1997-1999 to various retail outlets soliciting the purchase of T-shirts.

Applicant filed his intent-to-use application on October 16, 1997. Applicant has filed no evidence of actual use of his mark, although in an interrogatory response he gave a date of first use of December 15, 1997.

The Opposition

The primary issue in this opposition is that of priority. Applicant, by the filing of his application is entitled to a constructive use date of October 16, 1997. Opposer, in his notice of opposition, has alleged a first use date of July 1997. The burden of proof upon opposer as to a priority date of July 1997 is that of a preponderance of the evidence. See *Hydro-Dynamics Inc. v. George Putnam & Company*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987). Although applicant contends that opposer is under the heavier burden of clear and convincing evidence, we do not find this to be the case. Such a standard is appropriate when an applicant is attempting to prove a date earlier than that alleged in its application. Here, although opposer has a pending application, the first use date alleged therein is July 3, 1997. As stated above, opposer alleges a date of July 1997 in the notice of opposition. Although there may be some testimony as to first sales in June, no date earlier than a time in July 1997 is needed to establish use prior to

applicant's filing date. Accordingly, the heavier burden of clear and convincing evidence of prior use is not applicable here.

The next matter of contention is the nature of the evidence upon which opposer is relying. Applicant strongly argues that the oral testimony of opposer as to his first sales with little or no documentary evidence as support is insufficient to establish priority. The oral testimony of a single witness may suffice, however, in proving priority, if sufficiently probative. The determinative factor is whether the testimony of this one witness is not characterized by contradictions, inconsistencies, and indefiniteness, but rather carries a conviction of accuracy and applicability. In re B. R. Baker Co. v. Lebow Bros., 150 F.2d 580, 66 USPQ 232 (CCPA 1945).

Applicant maintains that the oral testimony of Joseph Juras, opposer's only witness is in fact characterized by contradictions, inconsistencies and indefiniteness. Applicant points in particular to variations in opposer's testimony as to the exact date of first sale from June 1997 to the weekend of the Fourth of July. While we agree that some inconsistencies do appear in this testimony, we do not consider these more than minor in nature. Whether opposer made his first individual sale in June or early July, and whether he approached Gazebo Outfitters to sell his T-shirts

Opposition No. 113,737

in June or the Fourth of July weekend is of little consequence. The evidence clearly shows that opposer had YELLOW DOG NANTUCKET T-shirts produced for him by June 1997 and that he received payment for the eight T-shirts turned over to Gazebo Outfitters for sale by July 1997. Whether the four additional individual sales were in June or not until early July and whether at least one was to a friend is insignificant. Opposer's testimony and accompanying evidence is sufficiently probative to show sales of T-shirts by at least July 1997, a date well prior to the constructive use date upon which applicant may rely. It is the evidence as a whole, rather than any one particular piece, which must be looked at in determining prior use. See *West Florida Seafood Inc. v Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994).

Applicant further challenges both the lack of documentary evidence to support this testimony and the accuracy of opposer's testimony with respect to the advertising materials which were introduced. While the documentary evidence is minimal with respect to the first sales, we find the oral testimony sufficient to overcome this paucity of documentary evidence. The fact that there are apparent contradictions in at least the advertising material of Exhibit 49 which would make distribution of this material in the summer of 1997 unlikely is immaterial to

Opposition No. 113,737

opposer's proof of first use by at least July 1997. Opposer is not relying on this advertising to support any analogous use theory as would make the authenticity of the material and time of distribution essential. Furthermore, even though the handbill of Exhibit 48 bears a local Massachusetts telephone number, rather than the New York number opposer had allegedly set up for this purpose, we cannot totally disregard opposer's testimony that this handbill was posted during the summer of 1997.

In addition, applicant has challenged the volume of the 1997 sales, arguing that the sale of twelve T-shirts, even if proven, is de minimis and does not constitute adequate use for purposes of priority. What is "de minimis" must be considered, however, in terms of the nature of the items and the industry in question. Here we are concerned with T-shirts which were being sold either at a retail outlet in Nantucket or individually. Opposer was an individual entrepreneur. Under these circumstances, we find the sale of twelve T-shirts in the first year sufficient to establish prior use. See *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998) (sale by business consisting of three persons of two or three dozen shirts in the year of 1986, some of which were to other than family and friends, sufficient to establish use commencing as early as 1986).

We find the subsequent evidence thoroughly convincing as to opposer's continued use of its YELLOW DOG mark on T-shirts. The documentary evidence fully supports the production and sale of T-shirts in the summer months of both 1998 and 1999, with increasing sales figures. While applicant argues that there is no evidence of opposer's intent to continue his business in the period from the summer of 1997 until May 1998, we do not find evidence of this nature necessary. As pointed out by the court in *West Florida Seafood Inc. v. Jet Restaurants Inc.*, *supra*, 31 USPQ2d at 1665, Section 2(d) does not speak of continuous use but rather whether the mark has been "previously used in the United States by another and not abandoned." Here there is no question of abandonment. Opposer resumed his business activities in the summer of 1998 and again in the summer of 1999. The business was clearly seasonal in nature and opposer merely followed a reasonable pattern.⁵

Accordingly, we find the evidence of record fully adequate to establish by a preponderance of the evidence opposer's prior use of the mark YELLOW DOG NANTUCKET for T-shirts.

Thus, we turn to the issue of likelihood of confusion, making our determination on the basis of those of the

⁵ We note that on cross-examination, opposer testified that Nantucket was a "seasonal" island; that businesses only operate from Memorial Day through Labor Day. (Deposition p. 97).

*du Pont*⁶ factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the marks YELLOW DOG NANTUCKET⁷ and YELLOW DOG SPORT, we find the dominant portion in each to be the term YELLOW DOG. While marks must be considered in their entireties in determining likelihood of confusion, it is well established that there is nothing improper in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although disclaimed or descriptive matter cannot be ignored, the fact remains that consumers are more likely to rely upon the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). Here consumers would be much more likely to look to the YELLOW DOG portion of the respective marks as an

⁶ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

⁷ While opposer frequently refers to his YELLOW DOG mark, the mark for which prior use has been established is YELLOW DOG

Opposition No. 113,737

indication of source, rather than the disclaimed word SPORT in applicant's mark or the geographically descriptive term NANTUCKET in opposer's mark. Although there are obvious differences in the appearance and sound of the marks as a whole, the overall commercial impressions are highly similar.

Although applicant argues that consideration must be given to the differences in the visual elements which accompany the marks, we must point out that applicant is seeking to register the mark YELLOW DOG SPORT in block letters, with no accompanying design features. While opposer's use of its mark YELLOW DOG NANTUCKET on T-shirts is in the presence of a dog figure, applicant's mark, as sought to be registered, is unrestricted as to any accompanying visual elements. There is no evidence of record of any use by applicant of his mark, much less of the manner of use. By seeking registration of his mark in a typed drawing form, applicant is free to adopt a presentation identical to opposer's. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

Turning to the goods at hand, we find that the T-shirts of opposer are fully encompassed by the "shirts" of applicant. Furthermore, since there are no limitations in the identification of goods in the application as to any

NANTUCKET. Thus, our analysis of likelihood of confusion has

Opposition No. 113,737

particular channels of trade, we must assume that applicant's goods would travel in all the normal channels of trade and be sold to all the usual purchasers for goods of this nature. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As such, the potential purchasers and the retail outlets for applicant's clothing items, including shirts, must be presumed to be the same as those for opposer's T-shirts. Both being relatively inexpensive items which would be purchased without great care, confusion is highly likely when the similar marks involved here are used thereon.

Although applicant also raises the factor of the strength of the parties' marks, applicant has failed to introduce any evidence whatsoever to substantiate its argument that "color DOG" marks are widely used on clothing items. Hence, we must accord no less than full protection to opposer's mark.

Accordingly, we find the relevant *du Pont* factors to weigh heavily in opposer's favor on the issue of likelihood of confusion.

Decision: The opposition is sustained and registration is refused to applicant.

been made on the basis of use of this mark.