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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Bear Partnership and Wings Research and Development, S.r.L.[1]
v.
Bear U.S.A., Inc.

Opposition Nos. 91119974 and 91120597
to application Serial Nos. 75063344 and 75063345

Mitchell N. Reinis of Buchalter, Nemer, Fields & Younger for The Bear Partnership and Wings Research and Development, S.r.L.

Timothy J. Kelly of Fitzpatrick, Cella, Harper & Scinto for Bear U.S.A., Inc.

Before Simms, Walters, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On February 26, 1996, Bear U.S.A., Inc. (applicant) applied to register two marks for the term BEAR. Serial No. 75063344 is for the mark BEAR shown in typed form for "all purpose athletic sport and duffel bags" in International Class 18 and for "clothing, namely, parkas, jackets, shirts,

[1] In a paper dated June 24, 2004, the board joined Wings Research and Development, S.r.L., as a party plaintiff in view of the assignment of the pleaded registration.

hats, headbands and footwear" in International Class 25. The application alleges a date of first use of May 1993 and a date of first use in commerce of November 1993. The second application (No. 75063345), based on an allegation of a bona fide intention to use the mark in commerce, is for the mark BEAR and design shown below for "clothing, namely, parkas, jackets, T-shirts, technical pants, underwear, cold weather hats, headbands, footwear (excluding golf shoes), and denim products, namely, jeans, shorts, shirts, jackets and hats" in International Class 25:

On August 10 and 18, 2000, The Bear Partnership (opposer) filed oppositions to the registration of applicant's marks on the ground that applicant's marks are likely to cause confusion with opposer's registered mark (No. 2,221,077) shown below for "posters, stickers and decals" in International Class 16; "beach towels" in International Class 24; and "pants, pantsuits, shirts, skirts, slacks, sweatsuits, sweaters, T-shirts, tank tops, blouses, jackets, trousers, pull over shirts, vests,

jumpers, coveralls, cardigans, dresses, rompers, jumpsuits, leggings" in International Class 25.[2]

While it is not clear from the drawing above, the registration contains the words BEAR SURF BOARDS. The registration also indicates that the mark is lined for the color red. The underlying application was filed on June 6, 1996 and it alleged a date of first use and a date of first use in commerce on May 1992. The registration issued on February 2, 1999.

Opposer also alleges that it "has adopted and has continuously used the trademark BEAR SURFBOARDS (AND DESIGN), a copy of which is attached as Exhibit 'A' hereto[3] and incorporated herein, in interstate commerce, from at least as early as May, 1992." Opposer is, therefore, also relying on its common law rights.

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[2] In its notice of opposition in No. 91119974 (pp. 1-2) involving application No. 75063344 for goods in International Classes 18 and 25, opposer paid a single fee of $300. Opposer indicated that "it will be damaged by registration of the mark in the above-identified application Serial No. 75/063,344 as it relates to goods in class 25." Therefore, regardless of the outcome of this proceeding, applicant will be entitled to a registration for the goods in Class 18, to which there is no opposition.

[3] Interestingly, Attachment A actually is for the mark BEAR and diamond design without the words SURF BOARDS or SURFBOARDS.

Applicant has denied the salient allegations of the notice of opposition. On September 14, 2001, the board consolidated the two oppositions for "purposes of evidence and final decision."[4] Both parties have filed briefs,[5] but subsequently proceedings were suspended so that the parties could explore the possibility of settlement. When no settlement agreement was reached, an oral hearing was held on June 29, 2004.[6]

The Record

The record consists of the pleadings, the files of the involved applications; the trial testimony deposition, with accompanying exhibits, of Stephen Paul Holmes, opposer's licensee; the trial testimony deposition, with accompanying exhibits, of Richard G. Reinis, opposer's managing partner; the trial testimony deposition, with accompanying exhibits, of Thomas Hong, applicant's president; and the rebuttal testimony by affidavit of Richard G. Reinis submitted by

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[4] The decision consolidating the proceedings was miscaptioned.

[5] On May 29, 2002, the board denied applicant's motion to strike opposer's brief in Opposition No. 91120597 because of the confusion regarding the consolidation order.

[6] On December 31, 2001, applicant filed a petition to cancel (No. 92040216) opposer's Registration No. 2,221,077 for the goods in International Class 25. On June 24, 2004, the board denied applicant's motion to suspend proceedings in the oppositions pending the outcome of the cancellation proceeding. The board noted that "applicant waited for over two years, after trial, briefing and rescheduling of the oral hearing, before notifying the Board that its pending cancellation proceeding may have a bearing on the instant opposition." Order at 3. We agree and we will not further delay this case that is ready for decision to await the outcome of the cancellation proceeding that applicant failed to bring to our attention for more than two years.

consent; and applicant's first Notice of Reliance filed August 14, 2001 for numerous BEAR registrations of applicant.[7]

In its brief in Opposition No. 91120597, opposer also indicates that opposer's responses to applicant's first set of interrogatories and applicant's responses to opposer's first set of interrogatories are part of the record. Applicant objects to these items as part of the record, because they were not properly filed by Notice of Reliance.[8] There is no record in either opposition file that these responses were submitted. Therefore, we do not consider them to be part of the record.

Discussion

The first issue we must address in these proceedings is the status of opposer's Registration No. 2,221,077. If this registration is of record, priority would not be an issue. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). There are several ways for a party to introduce a registration it owns into evidence in a

[7] After oral argument, opposer submitted a copy of a decision by the Office for Harmonization in the Internal Market involving a European Community Trade Mark opposition. On July 29, 2004, applicant objected to the submission of this decision. Inasmuch as we must determine the issues in this case under the laws of the United States, we will not consider the decision of this tribunal.

[8] Applicant also correctly points out that it did not submit opposer's answers to its interrogatories and a party, therefore, may not submit its own answers to interrogatories by Notice of Reliance. 37 CFR § 2.120(j)(5).

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. 37 CFR § 2.122(d). Opposer has not provided such copies.[9] Other ways a party's registration 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 registrations; by admission in the applicant's answer; or by the applicant treating the registration as being of record in its brief. TBMP § 702.03(a). While opposer's witness (Reinis) did introduce a copy of the registration certificate (Ex. 1) and a copy of an assignment to Bear Partnership dated 1999 as part of his testimony, the witness did not testify as to the current status and title of the registration. Reinis dep. Ex. 35. Furthermore, applicant did not admit the existence of the registration in its answer and, inasmuch as applicant contests the validity of the assignment of the mark to opposer, we cannot say that applicant has treated the registration as being of record.

> The Trademark Rules provide a means for implementing this proof of a prima facie case. They require that,

[9] While opposer did attach copies of its registration to the notices of opposition, these copies do not contain status and title information. They appear to be copies of the original certificate of registration that issued approximately eighteen months before the oppositions were filed.

> in an opposition proceeding, registrations may be entered into evidence by (1) furnishing two copies of each registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration; (2) appropriate identification and introduction of the registrations during the taking of testimony; or (3) filing a notice of reliance on the registrations during Opposer's testimony period. 37 C.F.R. § 2.122(d) (emphasis added). These rules are simple and clear, but Hewlett did not follow them.

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). We, therefore, conclude that opposer has not properly made its registration of record.

Therefore, priority remains an issue and opposer must demonstrate that it has priority in order to prevail on its likelihood of confusion claim.

Even without the registration, we determine that opposer has standing in these proceedings. An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit." Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213

USPQ 185, 189 (CCPA 1982).[10] The evidence of record does show that opposer is the source of clothing items with which it uses its BEAR SURF BOARDS and design mark. Therefore, opposer has a real interest in the outcome of these proceedings.

Thus, the remaining issues in this case are priority and likelihood of confusion. Opposer bears the burden of proof, by a preponderance of the evidence, on these issues. See Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

The key issue in this case is whether opposer has demonstrated that it has priority. Both applications in this case were filed on February 26, 1996. An applicant is entitled to rely on the application's filing date for its priority 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 application and that an intent-to-use applicant can rely upon this date in an opposition brought

[10] Because of the linguistic and functional similarities of the opposition and cancellation provisions of the Lanham Act, "we construe the requirements of those two sections of the Lanham Act consistently." Ritchie, 50 USPQ2d at 1025 n. 2.

by a third party asserting common law rights"). However, an applicant can establish a priority date earlier than its application's filing date. Corporate Document Services inc. v. I.C.E.D. Management Inc., 48 USPQ2d 1477, 1479 (TTAB 1998) ("[A]n intent-to-use applicant is entitled to rely upon actual use, or use analogous to trademark use, prior to the constructive use date of the intent-to-use application"). In this case, one application is a use-based application (No. 75063344) and the other is an intent-to-use application (No. 75063345). If an applicant is attempting to prove a date of use earlier than that alleged in its use-based application, the applicant must prove this date by the clear and convincing evidence standard. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 7 USPQ2d 1846, 1852 n.7 (Fed. Cir. 1993) ("VCDS alleges use prior to the date that it apparently listed in its registration application as its date of first use, i.e., prior to May of 1985, and therefore VCDS has the burden of establishing that use by clear and convincing evidence instead of mere preponderance of the evidence"). Otherwise, the preponderance of the evidence standard is the appropriate standard. Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) ("Where an applicant seeks to prove a date earlier than the date alleged in its application, a heavier burden has been

imposed on the applicant than the common law burden of preponderance of the evidence”).

We begin our analysis with a review of the evidence that applicant has used the mark BEAR for the goods identified in its applications,[11] i.e., parkas, jackets, shirts, hats, headbands and footwear.[12] In its brief (p. 11), applicant alleges that “in 1993, Bear [applicant] sold its first products, which consisted of down vests and parkas carrying the trademarks BEAR MOUNTAIN and BEAR.” Applicant’s witness was Thomas Hong, applicant’s president since applicant’s inception in April of 1994. Hong dep. at 8-9. Prior to that, he worked for his parents’ store, KP Original, in New York City. Hong dep. at 9-10. “KP Original was the predecessor to Bear U.S.A.” Hong dep. at 22. The witness testified that applicant’s predecessor marketed a parka (Ex. 3) that “had the word ‘Bear’ and the leather patches on the back neck collar since 1993.” Hong dep. at 31. See also Hong dep. at 18 (Sold the “latter part of 1993”), Ex. 2 (vest). Applicant’s invoices (Hong Ex. 24) show sales of Bear products in 1993. See, e.g., # 1066 dated December 10, 1993 (“6 Bear Blk XL 3534B”) and # 1081 dated December 15, 1993 (“24 Bear Blk 3534B L”). Indeed, some invoices are even earlier. See, e.g., # 1036 dated

[11] These goods are virtually the same in both applications.
[12] As noted earlier, the opposition does not seek to oppose the goods in International Class 18.

November 12, 1993 ("12 Bear BLK vest"); # 1007 dated November 24, 1993 ("20 Bear 3534 Navy XL); and # 1009 dated November 12, 1993 ("20 Bear BLK 3834, 20 Bear vest BLK 3524"). In its testimony, applicant identified clothing items and testified that they were sold in 1993 and applicant's invoices support this use. Thus, the evidence supports applicant's use of the mark BEAR on parkas and down vests since at least December of 1993.

Both applicant's word mark and word mark with the polar bear design are still in use. See Hong dep. at 43 and Exhibits 5, 28, and 39.

Therefore, we now look at opposer's evidence to determine primarily if it has been using the mark prior to applicant's earliest priority date of December 1993. Much of opposer's evidence for priority involves the movie "Big Wednesday." "Warner Brothers featured a film called Big Wednesday, directed by John Milius, which first ran in 1978, and it is considered to be the second most successful surf film ever made." Reinis dep. at 9. The BEAR SURF BOARDS mark was "featured prominently in the film." Reinis dep. at 19. While there is some evidence that another entity advertised some clothing items and surfboards with the BEAR SURF BOARD logo shortly after the movie was released, we cannot conclude that this use has been continuous or that opposer can rely on this use. See, e.g., Reinis Ex. 59

(Surfer magazine December 1978 "Don't wait, or you'll be too late! Rare underground special. Two special T-shirt designs you'll never again have a chance to score").[13] While opposer refers to these earlier uses, it essentially argues that it "has continuously used its 'BEAR AND DESIGN' mark in connection with its goods since at least as early as May 1992." Opposer's Brief at 19.[14] If opposer had used the mark in May of 1992, it would have priority. Most of opposer's evidence postdates applicant's priority date of December 1993. Exhibits 2 (1995), 3 (1995), 4 (2001), 9 (1995), 11 (2001), 12 (2001), 13 (1997), 14 (1996), 15 (1996), 16 (1998), 17 (2000), 20 (1995), 21 (2000), 22 (2000), 23 (2000), 25 (1999), 26 (1997), 27 (1996), 28 (1996), 29 (1999), 30 (2001), 31 (2000), 32 (2000), 35 (1999), 39 (1995), 43 (1995), 44 (1995), 45 (1996), 49 (1997), 50 (1996), 51 (2000), 52 (1995), 54 (1996), 56 (1996), 58 (1997), 61 (1996), and 62 (1999).

However, opposer's witness did testify about exhibit 6 and identified it as "a T-shirt similar to T-shirts that The Bear Partnership sold directly or though licensees since

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[13] Reinis Ex. 60 involves a 1986 license but under "Trademarks" the license refers to "Logo from Licensor's motion picture entitled "Big Wednesday'" and, under "Licensed Product(s)," it refers to the "'Big Wednesday' logo will be utilized on apparel, hangtags and labels."

[14] Indeed, opposer's Exhibit 52, p.3, suggests that there was a hiatus in the use of the BEAR trademark ("In closing I feel that it is very important that the licensee and licensor work very closely to execute bringing the bear label back to the market place").

1992 or three." Reinis dep. at 24. The same witness described exhibit 7 as follows: "this is likely to be a heavier weight T-shirt or lighter weight sweatshirt – it's hard to tell from this photograph – with the Bear logo, and it's used in this context in the way it's been used since 1992 or 1993." Reinis dep. at 24-25. This vague and general testimony is not definite enough to establish that opposer was using the mark on these clothing items prior to applicant's priority date. The witness could only specify a twenty-four month period as a date of possible use (1992-93). It is possible that this window could be somewhat longer and include 1994. This vague testimony is not supported by documentation. Elder Mfg. Co. v. International Shoe Co., 194 F.2d 114, 92 USPQ 330, 333 (CCPA 1952) ("The testimony shows [appellant] carried on an extensive business and sold collars on a large scale. However, there is no evidence of any advertising or of sales of any product to any particular customers, nor is there any evidence which would indicate use of the trade mark "Mark Twain" on collars prior to October 1, 1921, except the oral testimony of the three witnesses aforementioned. The only specimen produced showing use of the mark was the above-mentioned collar which was manufactured in 1937").

Indeed, opposer's other evidence seems to contradict a 1993 or earlier date of first use. Opposer's Exhibit 42

(p.3) is a "Holiday Price List '94" and it identifies delivery dates beginning in September 1994. Opposer's Exhibit No. 19, "Royalty Summary for 1994/1995/1996" for "'BEAR' Surf Clothing" contains no entries for January and February 1994. The first entry is in March 1994. Opposer's Exhibit No. 18, a list of invoices, but it does not contain any entries prior to September 1994. Opposer's literature (Exhibit No. 52) discusses sales in 1995 and it refers to "the first season of bringing the Bear label back…" "[O]ral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." Powermatics, Inc. v. Globe Roofing Products Co., 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). However, such testimony should "not be characterized by contradictions, inconsistencies and indefiniteness." B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945). The conflicting evidence of record and the indefiniteness of the testimony itself preclude us from relying on Mr. Reinis' testimony of a priority date of 1993 or earlier.

Opposer's other evidence is no more persuasive. One exhibit is a copy of a U.S. district court consent judgment filed August 26, 1993 (Opposer's Ex. 48). However, the consent judgment addresses the issue of copyright infringement. See, e.g., p. 48-4 ("Plaintiff is the sole

owner of the copyright of the Bear artwork" and "As the owner of a valid copyright, plaintiff is the proper plaintiff"); and p. 48-5 ("Defendant's use … constitutes a substantially similar use of the copyrighted artwork"). Opposer's copies of four California trademark registrations in the name of Valkyrie Corp. and dated November 14, 1994 do not corroborate opposer's use of a mark prior to applicant's priority date. See West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1665 (Fed. Cir. 1994) ("Indeed, where there is additional evidence of actual use, such a [regulatory] license becomes quite probative in that it further corroborates the other evidence. The same applies to a state registration").

In this case, we are also mindful of the Federal Circuit's admonition on the question of evidence of priority. "[W]hether a particular piece of evidence by itself establishes priority is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which when fitted together, establishes prior use." Id. at 1663. When we look at the evidence as a whole, we are not convinced that opposer has established by a preponderance of evidence that it was using the BEAR trademark prior to applicant's December 1993 priority date. Most of opposer's

evidence is subsequent to that date. Its earlier evidence is often related to copyright ownership.[15] Other evidence is simply too vague to lead us to the conclusion that opposer has priority over applicant at least with regard to the typed mark BEAR.

A more difficult question is raised by the BEAR and polar bear design mark. The application for that mark is an intent-to-use application. In addition, applicant filed a separate appeal brief in that case and, in that brief, it does not directly argue that it has priority. However, applicant has not conceded priority and opposer must establish its priority in order to prevail in this proceeding.

Applicant is seeking to register the mark shown below:

Applicant's evidence shows that it has used the word BEAR with a similar design of a polar bear. Applicant's Exhibit

[15] We note that opposer has not pleaded in its notice of opposition its ownership of a copyright. Even if had, an "allegation of copyright infringement alone does not constitute the necessary statutory ground which negates the appellant's right to the subject registration. Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983), citing Knickerbocker Toy Co. v. Faultless Starch Co., 467 F.2d

2 has the word BEAR with a similar polar bear standing above the word BEAR and facing to the right. Applicant's witness testified that these vests were sold by its predecessor in the "latter part of 1993." Hong dep. at 18. By 1994, applicant was using the same polar bear design except the word BEAR and the left-facing polar bear design were side-by-side rather than overlapping. See Hong dep. at 36 and Ex. 4. The words and the bear design do not overlap as they do in the mark for which registration is sought. The parka with the design in the '345 application was manufactured in the 1996/1997 timeframe. Hong dep. at 43. Ex. 5.

In addition, we note that applicant has obtained registrations for several similar marks. See Registration No. 2,282,358 for "clothing, namely, parkas and jackets"; and 2,285,696 for "clothing, namely, cold weather hats, headbands, and footwear (excluding golf shoes)" for the following mark:

501, 175 USPQ 417 (CCPA 1972)." Carano v. Vina Concha Y Toro S.A., 67 USPQ2d 1149, 1151 (TTAB 2003).

Registration No. 2,276,955 for "clothing, namely, parkas and jackets" is for the same design with the words "U.S.A., Inc." underneath the word BEAR.

The differences between the marks with the word BEAR and a polar bear design in different positions are de minimis. See, e.g., Visa International Services Association v. Life-Code Systems, Inc., 220 USPQ 740, 743-44 (TTAB 1983) (Mark with words OMNI-VISA below an upward pointing plane not a material alteration of the same words above a downward pointing plane). See also In re Larios, 35 USPQ2d 1214 (TTAB 1995) (VINO DE MALAGA LARIOS and label design not a material alteration of GRAN VINO MALAGA LARIOS and label design). Our case law recognizes that a party may have priority if there are minor differences between the prior mark and the current mark. In a case in which applicant was seeking registration of the mark BLUE ROBIN and design of a bird, the board found that the applicant could rely on several blue bird designs with the words BLUE BIRD to establish priority.

> Opposer in its brief makes much of the fact that the word and design marks now used by applicant in connection with the sale of its goods are not the same as the word and design marks for which applicant has established priority, but this is considered here to be of no particular consequence insofar as applicant's rights as against opposer are concerned. That is to say, while the marks in question differ in a number of respects, they nevertheless create substantially the same general impression, namely, that of a blue-colored bird, and hence are believed to symbolize a single and continuing trademark right in applicant.

Laura Scudder's v. Pacific Gamble Robinson Co., 136 USPQ 418, 419 (TTAB 1962). The Federal Circuit noted that the "Board permitted tacking of the mark 'BLUE BIRD' to the use of 'BLUE ROBIN' because both marks 'create substantially the same general impression, namely, that of a blue-colored bird." Van Dyne-Crotty inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1869 (Fed. Cir. 1991). We find that there are even less differences between applicant's use of the word BEAR with a polar bear design with the polar bear above the term and this application in which the word BEAR partially obscures a very similar polar bear design. Therefore, we find that applicant has established its priority date for its word BEAR and polar bear design in December 1993.[16] Inasmuch as we found previously that opposer could not establish a date earlier than this in regards to applicant's word mark BEAR, similarly opposer has not met its burden to show a priority date earlier than applicant's BEAR and polar bear design mark.

Therefore, inasmuch as we find that opposer has not established its priority, opposer cannot prevail and we do not address the issues of likelihood of confusion and

[16] Even if an intent-to-use applicant would be required to prove a use date earlier than its application's filing date by the clear and convincing standard, we would still find that applicant has met this burden.

whether opposer has acquiesced to applicant’s registration of its marks.

Decision: The oppositions to the registration of application Nos. 75063344 and 75063345 are dismissed.