

This Opinion is Not
Citable as Precedent of
the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

TYR Sport, Inc.
v.
Datanation, LLC

Opposition No. 91120414
to application Serial No. 75619174
filed on January 16, 1999

Virginia R. Richard and Lana C. Fleishman of Winston &
Strawn for TYR Sport, Inc.

Datanation, LLC, pro se.

Before Chapman, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Datanation, LLC (applicant) has applied to register the
mark ZYR for goods identified as "apparel; namely, pants,
shirts, t-shirts, headwear, jackets, sweaters, polo shirts,
underwear, sweat pants, baby clothes; namely, bonnets, bibs,
undershirts, t-shirts, pants," in International Class 25.¹

¹ Applicant, in adopting proposed amendments to the
identification of goods that were suggested by the examining
attorney, misspelled two words. We have corrected these
misspellings.

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The application is based on applicant's statement of its bona fide intention to use the mark in commerce for the identified goods.

TYR Sport, Inc. (opposer) has opposed the application, essentially asserting that it is the owner of incontestable Registration No. 1,458,467, for the mark TYR, for a variety of products used by swimmers and for various clothing items, both casual wear and swimwear²; that it has used TYR as a trade name and trademark for an even broader array of clothing, swimwear and swimming products than that identified in its registration, commencing in 1985; that it has also made extensive use of the trade name TYR SPORT; that it is well-known in its field, very successful and has a "high profile" both in the United States and abroad; that it has extensively advertised and promoted its products and marks; that the TYR name and mark are famous both within the competitive swimming field and among the general public; that the involved marks TYR and ZYR are virtually identical and rhyme; that there exists a likelihood of confusion,

² The registration issued September 22, 1987; Section 8 affidavit accepted and Section 15 affidavit acknowledged. The identification of goods read as follows, when the registration issued: "clothing, namely undershirts, t-shirts, shorts, bike shorts, fitness shorts and warm up tights, and swimwear, namely swimsuits, swim caps, bathing suits and bathing trunks," in International Class 25 and "swim accessories, namely goggles, hand paddles, training paddles, kick boards, nose clips, and ear plugs," in International Class 28. Opposer did not claim use of the mark for "undershirts" when it filed its combined Section 8 & 15 affidavit. Thus, that item has been cancelled from the registration.

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mistake or deception because consumers will presume a connection or arrangement of some type between applicant and opposer, because of the near identity of the marks; and that applicant's use of the ZYR mark for the goods identified in applicant's application will dilute the distinctive quality of opposer's mark and damage opposer.

We construe the notice of opposition as setting forth only a claim under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). We do not construe opposer's allegation of fame as anything more than an allegation directed to a factor to be considered in a Section 2(d) case; nor do we consider the allegation that registration of applicant's mark would dilute the distinctive quality of opposer's registered mark as anything more than an allegation relating to opposer's standing. In short, there is no dilution claim under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), in this notice of opposition.

Applicant admitted certain allegations related to the filing of applicant's application and that opposer's and applicant's marks rhyme, but otherwise expressly or effectively denied the allegations in the notice of opposition. Applicant included certain arguments to embellish its denials.

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At trial, opposer took the testimony deposition of its executive vice president, Steve Furniss,³ and introduced thereby 215 exhibits. Opposer also filed three notices of reliance. Applicant's president, Jeffrey Jagmin, attended the Furniss deposition by telephone, after having discharged applicant's counsel just days before.⁴ Applicant submitted no testimony or evidence. Opposer filed a brief on the case, but applicant did not. No oral hearing was requested.

³ Mr. Furniss testified that he was a founder of opposer and its president and CEO from 1985 to 1999, when he sold his interest in the company and took his present position; that, over the years, he has been involved in sales, marketing, production, distribution and many other activities; and, in his current position, is responsible for all operations at opposer's TYR Sport operation in Huntington Beach, California.

⁴ Opposer's counsel and applicant's counsel made arrangements for applicant to participate in the deposition by telephone, before the latter was discharged. No effort was made by applicant to bring to the Board's attention the termination of counsel virtually on the eve of the deposition. It is clear from the transcript of the deposition that arrangements for Mr. Jagmin to participate, in lieu of applicant's former counsel, were made, and that Mr. Jagmin did, in fact, participate, at least in the early stages of the deposition.

More than 10 months later, Mr. Jagmin filed a short one page letter to a Board interlocutory attorney, in response to a filing by opposer asking that the Board confirm possession of the exhibits to the Furniss deposition. In that letter, Mr. Jagmin complained of difficulty with the telephone connection and that he was unable to cross-examine the witness; and he stated a blanket objection to the exhibits as not illustrating "any case of the letter z becoming the letter t."

The Board interlocutory attorney ruled that if any difficulty with the phone connection arose after the deposition began, it was Mr. Jagmin's duty to have made some effort to bring the problem to the attention of opposer's counsel during the deposition, or to the attention of opposer's counsel and the Board immediately after the deposition; yet it appears Mr. Jagmin did neither. The interlocutory attorney also noted that any substantive objections by applicant to the exhibits or testimony of Mr. Furniss were appropriately raised in applicant's brief. Applicant did not request reconsideration of the interlocutory order on this matter.

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One of the exhibits to the Furniss deposition is a copy of opposer's pleaded registration. The witness identified it as opposer's registration. Furniss dep., pp. 262-63 and exh. 213. In addition, a few days later, by opposer's second notice of reliance, opposer put a photocopy of the registration into the record and noted that it was waiting for the USPTO to produce a certified copy attesting to opposer's ownership and that the registration was valid and subsisting. By this notice, opposer reported that it would forward the certified copy when it arrived. Approximately a week later, by opposer's third notice of reliance, it submitted the certified copy of its pleaded registration.

Opposer has proven that its pleaded registration is subsisting and owned by opposer. Therefore, we find that opposer has established its standing to oppose. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, Section 2(d) priority is not in issue as to the goods identified in opposer's registration. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering any

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evidence of record bearing on these factors, we are guided by the principle that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In regard to the goods identified in applicant's application and in opposer's pleaded registration, we note that both parties use their marks⁵ for some of the same items. For example, both parties list t-shirts among their goods, and opposer lists warm-up tights while applicant lists sweat pants, items that we consider very similar, if not functionally equivalent. Also, many of the other items in the respective identifications can be considered complementary, in that they might be worn together. In short, the parties' clothing goods are in part the same and otherwise closely related.

As for the parties' target classes of consumers and channels of trade, there are no restrictions or limitations in the identifications and, therefore, we must presume that the identified goods move in all customary channels of trade to all potential consumers for such items. *See Canadian*

⁵ Though applicant's application is based on its intent to use the mark in commerce, the record, specifically, applicant's interrogatory responses, make it clear that applicant has actually begun using its mark.

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Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Specifically, we conclude that both parties could market their goods to wholesalers or retailers, through catalogs, the Internet, etc., and that they could utilize some of the same outlets. The classes of prospective purchasers would include the general public.

Turning to the similarity of the marks, we begin by noting that our analysis cannot be influenced by the stylized wing design that often appears with opposer's mark TYR, to form what has been referred to as the TYR logo. Nor can our analysis be influenced by applicant's apparent use of numbers such as 2001 (to refer to the year 2001), or other design elements applicant combines with ZYR to form composite marks, e.g., applicant's ZYR golf logo or ZYR volleyball logo. (Furniss dep., exh. 215, applicant's answer to opposer's interrogatory no. 5.) Rather, we must compare only TYR and ZYR, because both opposer's registration and applicant's application are limited to those typed marks. In other words, because either party is free to change the typeface of its mark, we must consider that the marks could appear in the same or similar typefaces and may be used at any time without any design elements that might otherwise serve to distinguish the marks. See *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB

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1992), *citing Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).

In terms of the sound of the marks, we acknowledge that they each begin with a different letter, and that there is no rule regarding "correct" pronunciation of marks. However, applicant has admitted that TYR and ZYR rhyme. We do not believe that the different first letters of the respective marks results in a significantly different pronunciation. In terms of the look of the marks, we find that they are visually similar. On this point, i.e., visual similarity, we also note that courts and this Board have often held that consumers have more difficulty recalling differences in what appear to be arbitrary letter strings. *See, e.g., Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990), and *Dere v. Institute for Scientific Information, Inc.*, 420 F.2d 1068, 164 USPQ 347, 348 (CCPA 1970).

We acknowledge that opposer's witness testified that opposer adopted TYR because it is the name of a deity in Nordic mythology. Furniss dep., p. 29. We have not, however, found listings for TYR in numerous dictionaries we have consulted and we find it unlikely that the average consumer would understand the origin of the mark and would be more likely to consider it an arbitrary letter string. Likewise, while applicant apparently created its mark as a

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combination of Z and YR, the latter being an abbreviation of "year," we do not believe the average consumer would see applicant's mark as anything other than an arbitrary letter string.

Finally, because the marks would appear to consumers to be arbitrary letter strings, neither would project a definite connotation. We cannot, therefore, find that the marks possess significant differences in connotation.

Because the marks are similar in appearance and would be pronounced similarly, and do not have definite differences in connotation that might serve to distinguish them, we find the marks to create very similar overall commercial impressions. When such marks are used on goods that are in part identical or otherwise closely related, we find there is a likelihood of confusion among consumers.

We do not have any doubt about the likelihood that consumers would be confused. We note, however, that were there any doubt, we would resolve such doubt in favor of opposer, as the prior user and registrant of what the record reveals to be a well-known and strong mark.⁶ See, e.g.,

⁶ Opposer has argued that its mark is famous. While we do not agree that the record supports a finding of significant fame, it is clear that opposer has been very successful in selling its products throughout the United States (and abroad), and that it is a significant competitor in the swimwear and related apparel field.

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Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd., 774
F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985).

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