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Mailed: June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gecko Trading Company, Inc.
v.
Rip-Tie, Inc.

Opposition No. 91124181
to application Serial No. 76149367
filed on October 17, 2000

Bruce B. Brunda of Stetina Brunda Garred & Brucker for Gecko Trading Company, Inc.

Paul W. Vapnek of Townsend and Townsend and Crew LLP for Rip-Tie, Inc.

Before Simms, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Rip-Tie, Inc. (a California corporation), seeks to register on the Principal Register the mark GECKO for "hook and loop fastening ribbon and tape." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce on the identified goods.

The application has been opposed by Gecko Trading Company, Inc. (a Hawaii corporation), asserting as grounds

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therefor that continuously since April 1982 (and long prior to applicant's filing date), opposer has been in the development and marketing of a wide variety of products (clothing, jewelry, sporting goods such as surfboards, bicycles and in-line skates, skin cleansing soaps and gels, sunglasses and eyeglasses, tobacco products and accessories, etc.);¹ that opposer offers these products under the marks GECKO, MAUI GECKO and GECKO HAWAII; that opposer owns 14 registrations for those marks (paragraphs 5-18); and that applicant's mark, when used on its goods, so resembles opposer's previously used and registered marks, consisting of or including the word GECKO, as to be likely to cause confusion, mistake, or deception in contravention of Section 2(d) of the Trademark Act. Opposer also includes a claim that its GECKO mark is famous and became famous prior to applicant's use of its mark; and that applicant's use of GECKO causes dilution of the distinctive quality of opposer's famous mark GECKO.

¹ Opposer's pleading is very broad in its claim of rights in the mark GECKO for a wide variety of goods. In order to be clear about the pleadings, we find that opposer's pleading includes a claim of common law rights in the mark GECKO for goods not covered in its registrations. Moreover, even if the pleading is not interpreted as broadly as we have done here, the record is clear that opposer took testimony on its common law rights in the mark for various goods and applicant did not object thereto. Accordingly, to whatever extent it is necessary, we consider the pleadings amended to conform to the evidence under Fed. R. Civ. P. 15(b) regarding opposer's claim of common law rights in the mark GECKO.

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In applicant's answer it denies the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance on (i) 16 registrations ("identified and introduced during the testimonial deposition of Tina Fein" - notice of reliance filed November 27, 2002, unnumbered page 2), (ii) applicant's responses to opposer's first set of interrogatories, (iii) the trial testimony, with exhibits, of Tina Fein, opposer's vice president, and (iv) the trial testimony, with exhibits, of Julie McCormick, opposer's president;² and applicant's notice of reliance on opposer's responses to applicant's first set of interrogatories, and opposer's responses to applicant's first set of requests for admission.

Both parties filed briefs, and neither party requested an oral hearing.

The Parties

Gecko Trading Company, opposer, has been in existence since 1981 (its original trade name was "T. BEARS," later changed to Gecko Trading Company, which was subsequently incorporated); and opposer licenses the manufacture,

² Opposer is advised that it is unnecessary to submit trial testimony under a notice of reliance. See Trademark Rule 2.125(c). See also, TBMP §703.01(k) (2d ed. rev. 1, March 2004).

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marketing and selling of the many products it offers under its GECKO marks. Some of opposer's licensees include Happy Shirts, Incorporated which handles t-shirts and accessories; MJC which handles sleepwear and men's boxer shorts; ES Apparel which handles children's and infants' clothing, Gecko Stores which handles clothing, accessories, novelty items and gifts; Concept One which handles backpacks, duffels, accessories for backpacks, hats, visors, gloves; and Gecko Cycles which handles bicycles and accessories therefor. In addition, there are pending licenses, including ones for bedding, towels, rugs and window treatments.

Opposer first conceived and adopted the mark GECKO in April 1982 with regard to various items of clothing and the mark has been in continuous use since that date. Within a short time, the mark GECKO became "very popular" for clothing, surfboards and gift and novelty items. Opposer's witnesses, Ms. Fein and Ms. McCormick, testified that opposer sells such varied goods as clothing and sporting goods, as well as artificial flowers, tattoos, Velcro closure straps for watches, accessory clip straps, hair bands and hair barrettes, and portable radios.

Opposer's licensed products are sold in department stores (e.g., Penney's and Sears), sporting goods stores, boutique stores (including one operated by opposer in

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Makawao, Hawaii), souvenir shops, gift stores, and over the Internet. Opposer advertises in major newspapers (e.g., "The Los Angeles Times"); and it attends and exhibits at numerous trade shows (e.g., the "Magic Show" in Las Vegas). Approximately \$50,000 - \$70,000 is spent annually for "coop" advertising of opposer's marks for its broad range of goods.

One licensee's (Happy Shirts, Inc.) sales of goods sold under the GECKO mark have been approximately \$7 - \$10 million annually for the last twelve years.

Opposer has successfully stopped several third-party uses of the mark GECKO or a similar mark, either through the party ceasing use or licensing use through opposer.

Applicant, Rip-Tie, Inc., first adopted and used the mark GECKO in December 2000. According to applicant (applicant's answer to opposer's interrogatory No. 5), it offers "a variety of non-adhesive, self-gripping tapes" under the mark. Applicant advertises its goods sold under the mark through the Internet, direct mail, dealer's catalogs and brochures. Its goods are sold to the data communication wire management industry through distributors, OEMs and installers. (Applicant's response to opposer's interrogatory No. 6.)

Priority

In this opposition, opposer pleaded ownership of 14 registrations, but submitted photocopies of 16 registrations

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for the mark GECKO³ or MAUI GECKO or GECKO HAWAII as Exhibit No. 4 during the testimony of its witness, Tina Fein.⁴ Ms. Fein testified that opposer is the owner of all of the 16 registrations, but there is no testimony regarding the current status of the registrations. Nonetheless, applicant clearly and unequivocally acknowledged in its trial brief that these registrations are subsisting and are of record. (Applicant's brief, pp. 1 and 5-6.) Accordingly, as both parties treated all 16 registrations of record, the Board will do likewise.

In view of opposer's valid and subsisting registrations covering the goods and services set forth therein, the issue of priority does not arise herein. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, opposer has established priority of use since at least 1999 for all of its wide variety of goods

³ Such registrations are the following: Registration Nos. 1510173 for shirts, dresses, sweatsuits, hats, shorts, skirts and shoes; 1512691 for textile tote bags and duffle bags; 1903602 for pajamas; 1943766 for "retail and wholesale stores featuring apparel, beach products, stuffed dolls and novelty items"; 2049045 for various cosmetics, hair preparations, skin cleansing soaps and gels, and the like; 2183226 for "bicycles and bicycle frames"; 2260689 for "sunglasses, eyeglasses, eyeglass cases, eyeglass straps to attach to eyeglasses"; 2308720 for "towels"; 2463090 for stuffed toy animals and flying discs; 2347417 for snowboards, surfboards, skateboards and in-line skates; 2453448 for "beverage glassware, mugs, plates"; 2446676 for "jewelry, clocks, watches"; and 2482688 for cigars, cigarettes and smoking accessories such as cigar holders, cigar cutters, cigar humidors, rolling papers.

⁴ To whatever extent it is necessary, we consider the pleadings amended to conform to the evidence under Fed. R. Civ. P. 15(b); and thus we consider all 16 registrations to be of record.

as well as its store service, which is a date prior to the filing date of applicant's application on October 17, 2000.

Likelihood of Confusion

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Based on the record before us, we find that confusion is likely.

As explained previously, some of opposer's registrations are for the marks MAUI GECKO and GECKO HAWAII. Obviously, opposer's mark GECKO is the closest (being identical) to applicant's mark. Therefore, we will focus our discussion of likelihood of confusion in relation to opposer's GECKO mark.

The term "GECKO" refers to a small lizard, and the term is arbitrary as applied to the parties' respective goods and services involved herein. Applicant's mark and one of opposer's marks are the identical word, GECKO.⁵ This fact

⁵ Applicant acknowledges that the marks are "virtually identical in the context of sight and sound" (brief, p. 4). We are aware that applicant contends that because "gecko" is an ordinary,

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"weighs heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods... [which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993). "The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

We turn to a consideration of opposer's goods and services (as identified in its registrations) as well as the goods for which opposer has established common law rights vis-a-vis applicant's identified goods.

In Board proceedings, the issue of likelihood of confusion must be determined in light of the goods or services as identified in the involved application and registration(s) and, in the absence of any specific limitations therein, on the presumption that all normal and usual channels of trade and methods of distribution are or

English word referring to a type of lizard, opposer is not

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may be utilized for such goods or services. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Of course, the plaintiff may assert and prove common law rights in a particular mark for particular goods or services as well. See Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990).

Applicant's goods are identified as "hook and loop fastening ribbon and tape." Applicant included no limitations on the uses of its goods, the channels of trade for its goods and/or the purchasers to whom its goods are marketed. Thus, applicant's arguments that its goods are "highly specialized" tapes which are used to bundle cables, and can also be used for wire harness assembly, medical tubing, home theater and audio equipment, or used in nurseries, orchards, vineyards, florists and in gardening; that applicant's customers are cable management professionals (people in the data communication wire management industry); and that its sells its goods through distributors, OEMs and installers, are essentially irrelevant distinctions in the context of this proceeding

entitled to the exclusive use of the word in all contexts.

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concerning the registrability of applicant's mark. In addition, applicant refers to opposer's goods as "Hawaiian tourist" clothing, sporting goods and novelty items, but there is no such "Hawaii tourist" limitation in any of opposer's identified goods or services.

It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); *Chemical New York Corp. v. Conmar Form Systems Inc.*, 1 USPQ2d 1139 (TTAB 1986); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

As our primary reviewing Court stated in *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000): "Even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." The same Court reiterated in the case of *Hewlett-Packard Company v.*

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Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) as follows: "Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services."

As identified, it is very plausible that applicant's identified goods, "hook and loop fastening ribbon and tape," could and would be used in conjunction with many of opposer's identified goods, such as clothing and textile tote bags. Moreover, opposer has established that it sells embroidered decorative ribbon and fasteners such as Velcro closure straps for watches, accessory clip straps, dress clips, hair bands and hair clips, all under the mark GECKO.

We find that applicant's identified goods are related within the meaning of the Trademark Act to some of opposer's identified registered goods as well as some of opposer's goods in which it has established common law rights.

Turning next to the du Pont factors of trade channels and purchasers, as explained previously, applicant's application does not include any limitation or restriction as to trade channels or purchasers or uses of its product. Therefore, we must presume in this administrative proceeding that the goods are sold in all normal channels of trade (which would include department stores, fabric stores, notions stores) to all usual classes of purchasers for such

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goods (which would include the general public). See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, supra.

We find that the channels of trade and the classes of purchasers for the parties' goods, as identified, and as proven by opposer, are similar or at the very least, are overlapping.

Moreover, the parties' respective goods are generally inexpensive and do not require that consumers be particularly sophisticated for proper use and application thereof.

Another du Pont factor we consider in this case is the fame of opposer's mark. Opposer contends that its mark GECKO is famous based on its use for over 20 years, since April 1982; opposer's ownership of numerous federal registrations of its mark GECKO for various goods and its retail store services; annual sales through one licensee being around \$7 - \$10 million annually for the last 12 years; "coop" advertising expenditures of over \$70,000 annually for several years; the nationwide scope of opposer's sales, including through major department stores such as Sears and Penney's and through the Internet; opposer's extensive licensing program with numerous companies approaching opposer to obtain licenses; and

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opposer's consistent program to protect its rights in the mark GECKO. Opposer also contends that its mark is entitled to a broad scope of protection because the mark is arbitrary in relation to the goods and services.

Applicant contends that opposer has not submitted any evidence that establishes the significance of opposer's sales and advertising figures, or putting it in a market share context; and that even if opposer's "mark is considered to be well-known" (brief, p. 8), there is no likelihood of confusion due to the other factors.

Mere length of time that a mark is in use does not by itself establish consumer awareness of the mark, such that the mark can be found to be famous. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992). The limited evidence we have of long use (just over 20 years) of this mark and availability of opposer's goods to consumers through its own retail store, and in department stores and specialty stores (with no indication as to how long the goods have been sold in the different channels of trade), is not sufficient to establish public recognition and renown of opposer's GECKO mark, as that du Pont factor has been interpreted. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Cf. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

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However, opposer's evidence clearly demonstrates that its arbitrary mark GECKO is strong and well-known in relation to clothing and sporting goods (i.e., its volume of sales (through licensees) and advertising expenditures under the mark GECKO for over twenty years). Thus, opposer's strong mark is entitled to a broad scope of protection. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Henry Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ2d 1154, 1161 (TTAB 1987).

Another du Pont factor to be considered in the case now before us is "the variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)." In re *E. I. du Pont de Nemours & Co.*, supra, at 567. Opposer has registered the mark GECKO for a wide variety of general consumer products, including numerous items of clothing, various sporting goods, various cosmetics and personal care products, jewelry and watches, sunglasses and eyeglasses, toys, tobacco products and smoker's accessories, and household items such as towels, mugs, plates. Further, the record is clear that opposer currently sells and since at least 1999 has sold items such as decorative ribbon and Velcro closure straps for watches. Purchasers aware of the variety of opposer's goods sold under the mark GECKO may well assume that opposer is now offering hook and loop fastening ribbon and tape under the mark GECKO. See Uncle

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Ben's Inc. v. Stubenberg International Inc., 47 USPQ2d 1310, 1313 (TTAB 1998).

There is no evidence of third-party uses of the mark GECKO or GECKO-derivative marks for goods and/or services in the involved and/or closely related fields, other than those uses which opposer successfully stopped -- either through the third-parties' agreements to cease use or their agreement to purchase a license from opposer.

Neither party is aware of any instances of actual confusion. However, there is no evidence of the geographic scope of applicant's use, or the nature and extent of applicant's sales. The absence of actual confusion is not surprising given the relatively short duration of use by applicant of its mark (commencing December 2000). In addition, the nature of goods such as hook and loop fastening ribbon and tape, Velcro closure straps for watches, dress clips, hair bands and hair clips does not lend itself to consumer complaints and follow up. This du Pont factor is thus neutral. In any event, the test is not actual confusion, but likelihood of confusion. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

Accordingly, because of the identity of the parties' marks; the strength of opposer's mark; the relatedness of

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some of the parties' goods; the overlapping trade channels and identical purchasers; and the variety of goods on which opposer has used (and for most of the goods registered) its mark, we find that there is a likelihood that the purchasing public would be confused when applicant uses GECKO as a mark for its hook and loop fastening ribbon and tape.

We agree with applicant that there is no particular evidence of applicant's intent to cause confusion in this case. Nonetheless, this factor is of little weight because, as stated by the Court of Appeals for the Federal Circuit (our primary reviewing court), in *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991): "Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion. (citation omitted)."

Decision: The opposition is sustained on the ground of likelihood of confusion and registration to applicant is refused.⁶

⁶ In view of our decision in opposer's favor on the basis of likelihood of confusion, we need not reach opposer's claim of dilution.