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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

WORLD TRIATHLON CORPORATION
v.
IRON MAN COMPANY

Opposition No. 91153811
to Application Serial No. 78114096
filed on 3/11/2002

Frank R. Jakes and Joseph J. Weissman of Johnson, Blakely, Pope, Bokor, Ruppel & Burns, LLP for World Triathlon Corporation.

Kevin R. Erdman and M. Kristin Glazner of Baker & Daniels LLP for Iron Man Company.

Before Seeherman, Holtzman and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

World Triathlon Corporation (opposer) has opposed the intent-to-use application of Iron Man Company (applicant), an Indiana partnership, to register the mark IRONMAN.COM in standard-character form for services now identified as "computer services providing customized online web pages featuring user-defined information, which includes search engines and online informational web links to news, weather, sports, current events, reference materials, and customized

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e-mail messages, all in a wide range of user-defined fields" in International Class 42.

Opposer alleges two grounds for its opposition. Opposer first alleges likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its prior use and registration of a number of marks which include IRONMAN in varying forms for a wide range of goods and services.¹ Opposer also alleges dilution of its IRONMAN marks under Trademark Act Section 43(c), 15 U.S.C. § 1125(c). Applicant has denied the essential allegations in the notice of opposition.

In addition to the application file, the record in this proceeding consists of the following submissions by opposer: (1) the testimonial depositions of Benjamin Craig Fertic, president of opposer, and of Anthony Pepler, a partner in applicant, both taken by opposer; (2) opposer's notice of reliance on status and title copies of twenty-five registrations for IRONMAN marks owned by opposer; and (3) opposer's notice of reliance on certain of applicant's answers to opposer's first set of interrogatories. The only evidence applicant submitted is a notice of reliance on copies of nine third-party "IRONMAN" registrations.

¹ In the notice of opposition opposer refers to its marks as a family of marks, but it does not pursue this argument in its briefs. Accordingly, we have not given any consideration to that allegation.

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Opposer has shown that it has used the IRONMAN marks and that it is the owner of numerous registrations for those marks. Accordingly, opposer has established standing. See generally Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

Priority is not at issue in this proceeding. Opposer has made of record valid and subsisting registrations for various IRONMAN marks which it owns. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Opposer

Mr. Fertic, president of opposer, testified as to opposer's activities and its use of the IRONMAN marks. Opposer organizes, promotes and conducts triathlon events in the United States and elsewhere in the world under the IRONMAN marks. The events combine long distance swimming, bicycling and running. Opposer's predecessor held the first event, identified as the IRONMAN TRIATHLON WORLD CHAMPIONSHIP, in Hawaii in 1978. Opposer or its predecessor has conducted the championship event every year since 1978 in Hawaii; in 2004, 1680 competitors took part in the event. Opposer also conducts numerous qualifying events each year under the IRONMAN mark leading up to the championship event, including "eleven or twelve" in the United States.

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Since 1982 the championship event using the IRONMAN marks has been telecast nationally on either the ABC or NBC television network. The telecasts have been nominated for 38 and received twelve Emmy awards. Seven U.S. qualifying events have also been telecast on cable.

Since 1998 opposer has maintained web sites. Opposer uses ironmanlive.com as the domain name in conjunction with its principal web site where it presents information regarding its events. Opposer also maintains what appear to be additional sites, one for the sale of DVDs and videos of races, at ironmandvd.com, and one for the sale of licensed products, at ironmanstore.com. Opposer also uses the ironmanlive.com site to air its championship race live "with full streaming video" and "editorial reports, minute-by-minute updates on lead changes for the entire 17 hours of the race."

In 2004, the year previous to Mr. Fertic's testimony three and a half million separate individuals or entities visited the site to view the championship race. Opposer spends between a half-million and seven hundred thousand dollars each year to "showcase" the event on the web site. Mr. Fertic also states more broadly that annually opposer's web site receives "upwards of 30 million page views." The average person stays on the site for 12 to 15 minutes.

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Opposer has numerous sponsors for its events and numerous licensees which use its IRONMAN marks with their products or services to promote the IRONMAN events. For example, the licensed products include the TIMEX IRONMAN sports watch which "is the number-one selling sports watch in the world." The watches are sold through Wal-Mart, the Sports Authority and other retailers. Foster Grant, another licensee, sells its IRONMAN sunglasses through the same type of retailers. The goods are marketed to athletes and non-athletes.

The licensed products also include high-end bikes, bicycle tires, running insoles, wetsuits, treadmills and other fitness products and jogging strollers.

Opposer is also involved in promotions for Gatorade beverages where the IRONMAN marks are featured in advertisements which aired on NASCAR events, AFC and NFC playoff games and on the MTV network. In describing the Gatorade campaign Mr. Fertic testified that "the domestic expenditure will exceed \$30 million for the 2005 year." Opposer has also conducted promotions with Fig Newtons, involving use of "the IRONMAN logos" on 20 million packages, and Campbell's soup. In these promotions, the IRONMAN marks are used on products distributed through general grocery retailers, such as Kroger. Mr. Fertic states that opposer spends "several million dollars" in advertising the IRONMAN

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marks, but he does not specify either the time period in question or the forms of advertising. In discussing the licensed products and promotions, opposer does not specify the form of the IRONMAN mark used in conjunction with specific products or in promotions, nor does opposer provide examples of these uses on actual products or in promotions. However, many of the licensed products Mr. Fertic discusses are the subject of the registrations opposer has made of record.

Opposer has pleaded and properly made of record the following valid and subsisting registrations which it owns:

Reg. No. 2343316 for the mark IRONMANLIVE.COM for "providing information concerning athletic competitions featuring bicycling, swimming and running and participants therein via global computer networks" in International Class 41;

Reg. No. 1873783 for the mark IRONMAN for "plastic trash bags" in International Class 16;

Reg. No. 2022721 for the mark IRONMAN for "electric vacuum cleaners" in International Class 9;

Reg. No. 1353313 for the mark shown below for "entertainment services - namely, presentation of athletic contests featuring running, swimming and biking" in International Class 41;



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Reg. No. 2357949 for the mark IRONMAN for "non-carbonated soft drinks" in International Class 32;

Reg. No. 2350149 for the mark shown below for "watches and chronometers sold in association with contests consisting of running, biking and swimming" in International Class 14;

The logo consists of a solid black circle positioned centrally above the word "IRONMAN". The word "IRONMAN" is rendered in a very bold, black, sans-serif typeface with a slightly distressed or textured appearance.

Reg. No. 2911303 for the mark shown below for "swimwear with built in flotation device, marketed in association with contests consisting of running, biking and swimming" in International Class 25;

The logo consists of a solid black circle positioned centrally above the word "IRONMAN". The word "IRONMAN" is rendered in a very bold, black, sans-serif typeface with a slightly distressed or textured appearance.

Reg. No. 2380160 for the mark IRONMAN for "bicycles" in International Class 12;

Reg. No. 1705114 for the mark IRONMAN TRIATHLON for "clothing; namely, shirts, shorts, hats, shoes, headbands and wristbands, pants, pajamas, belts and sweatshirts marketed in association with contest consisting of running, biking and swimming" in International Class 25;

Reg. No. 2356707 for the mark IRONMAN TRIATHLON for "bicycle carrying bags, namely, saddle bags, handlebar bags, panniers which affixed (sic) to bicycles" in International Class 12 and "all purpose sports bags, back packs, activity bags in the nature of fanny packs, tote bags" in International Class 18, and "back pack-style canteens featuring hydration bags" in International Class 21;

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Reg. No. 2356232 for the mark IRONMAN TRIATHLON for "sunglasses, frames for glasses; small handheld electronics with head sets, namely, portable radios, portable CD players and portable audio cassette tape players and recorders, marketed in association with contests consisting of running, biking and swimming" in International Class 9;

Reg. No. 2369406 for the mark IRONMAN TRIATHLON for "credit card services" in International Class 36;

Reg. No. 2384055 for the mark IRONMAN TRIATHLON for "sun block, perfumes, cologne, skin lotions, personal deodorant, body and massage oils, marketed in association with contests consisting of running, biking and swimming" in International Class 3;

Reg. No. 2420355 for the mark IRONMAN TRIATHLON for "bicycles marketed in association with contests involving swimming, biking and running" in International Class 12;

Reg. No. 1462281 for the mark IRONMAN TRIATHLON WORLD CHAMPIONSHIP for "entertainment services, namely, presentation of athletic events consisting of running, swimming and biking contests" in International Class 41;

Reg. No. 2325508 for the mark shown below for "food and vitamin supplements" in International Class 5;



Reg. No. 2384057 for the mark IRONMAN INSTITUTE for "physical fitness consultation and physical rehabilitation services" in International Class 42;

Reg. No. 2384056 for the mark IRONMAN INSTITUTE for "educational services namely lectures, seminars and classes in the field of physical fitness and physical rehabilitation" in International Class 41;

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Reg. No. 2571690 for the mark IRONMAN TRIATHLON for "non-carbonated soft drinks, namely bottled water" in International Class 42;

Reg. No. 2869852 for the mark IRONMAN TRIATHLON for "Entertainment services namely arranging and conducting athletic competitions consisting of running, swimming and biking" in International Class 41;

Reg. No. 2443598 for the mark IRONMAN TRIATHLON for "wetsuits marketed in association with contests consisting of running, biking and swimming" in International Class 25 and "sporting equipment, namely, stationary bicycles, treadmills, steppers, climbers, elliptical trainers, stretching trainers, strength-building equipment, namely, weight benches, weights, home gym trainers, for conditioning the body; swimming goggles, fins and masks; all marketed in association with contests consisting of running, biking or swimming" in International Class 28;

Reg. No. 2457898 for the mark IRONMAN TRIATHLON for "handheld massagers marketed in association with contests consisting of running, biking and swimming" in International Class 10;

Reg. No. 2261283 for the mark IRONMAN for "machine parts, namely linear ball and roller bearing slides" in International Class 7;

Reg. No. 2891454 for the mark shown below for "Baby stroller designed for running and walking" in International Class 12;



and

Reg. No. 2911298 for the mark IRONMAN for "clothing for men, women and youths namely, shirts, shorts, jackets, swimwear, socks, gloves, hats, headbands, wristbands and wetsuits, marketed in association with contests

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consisting of running, biking and swimming" in
International Class 25.

In the case of Reg. Nos. 2911303, 2869852, 2891454 and 2911298, opposer did not assert the registrations in its notice of opposition. Opposer referenced them for the first time and submitted status and title copies of these registrations under a notice of reliance. Applicant has not objected. In the absence of any objection we conclude that the parties have tried the issues related to these registrations by implied consent. Therefore, we deem the pleadings amended to include opposer's claims with regard to these registrations. Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002). See generally TBMP § 507.03(b) (2d ed. rev. 2004) and cases cited therein. Furthermore, in its notice of opposition opposer did reference Reg. Nos. 1258881, 1226245, 1375270, 1356881, 1370616, 1370617, 1873005, 2477113, 2454839, 2450736, 2449376, 2281583 and 1916623. However, opposer did not submit status and title copies of any of these registrations. Accordingly, we have not considered these registrations.

Applicant

Applicant is a partnership and Mr. Pepler appears to be its most active partner. Mr. Pepler indicates that he has been involved in a series of information technology and Internet-related businesses. Most recently he has formed a

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number of businesses which he conducts from his residence. Mr. Peppler testified that he had conceived numerous businesses and many had not succeeded. Mr. Peppler has set up and maintained at least one Internet-related business. Mr. Peppler discusses his involvement with a company which he established and which apparently still maintains a web site at AboutMe.com. In describing the venture, he states, "It's just a place where people can go and build their own websites and we were going to do email, but we have issues with email due to spam... So it's just a place where people can go and post their own websites and their own stuff." Mr. Peppler also refers to ventures he began with FindAVideo.com and RedRocket.com which operated for a time but no longer operate.

In conjunction with various businesses, including applicant partnership, Mr. Peppler states that he owns between 20,000 and 27,000 domain names either personally or through businesses he has formed. He also states that he has filed ten trademark applications for marks related to those domain names for use in connection with businesses he conceived related to those domain names. These include the application which is the subject of this proceeding. Mr. Peppler registered the ironman.com domain name in August of 2000. Mr. Peppler states that he has spent \$30,000 on the development of the business related to the IRONMAN.COM

domain name and mark, including \$10,000 for the development of a tool bar for the web site related to the business. He indicates that he has not done anything further with respect to this business, and has not used the mark, due to the litigation regarding the trademark.

LIKELIHOOD OF CONFUSION

We first address opposer's claim regarding likelihood of confusion. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors we may consider in determining likelihood of confusion. We must determine the issue of likelihood of confusion case by case and based on the evidence of record relating to the factors. In re Majestic Distilling Co., 315 F.3rd 1301, 65 USPQ2d 1201, 1203-04 (Fed. Cir. 2003). Accordingly, we will discuss each of the factors as to which opposer or applicant has presented evidence or arguments.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of

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Appeals for the Federal Circuit observed, "... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Opposer argues, "WTC's 'IRONMANLIVE.COM' mark and Applicant's 'IRONMAN.COM' mark are identical except for the addition of the word 'LIVE' in the WTC mark. The dominant part of both marks is the 'IRONMAN' name. The addition of the word 'LIVE' in the WTC mark is nothing more than a descriptive term regarding the nature of some of the web content at the WTC site." Opposer argues further that the ".com" suffix does nothing to distinguish applicant's mark from opposer's other IRONMAN marks.

Applicant does not argue, as such, that its mark differs from opposer's marks. Applicant states, "While the identity of IRONMAN.COM to WTC's registered marks is evident, so is the identity of IRONMAN.COM to several registered marks that are not related to WTC." We will discuss the strength of opposer's IRONMAN marks later, but for the purpose of comparing applicant's mark to opposer's

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marks we simply note applicant's comment that the "identity" of the parties' marks is "evident."

We conclude that opposer's IRONMANLIVE.COM mark is highly similar to applicant's IRONMAN.COM mark in all respects - appearance, sound, connotation and commercial impression. We conclude so principally because IRONMAN is both the first and the dominant element in both marks. Presto Products, Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). Here, the inclusion of "LIVE" in opposer's mark is insufficient to distinguish the marks. We would conclude so whether "LIVE" is considered merely descriptive, as opposer argues, or suggestive of the content of opposer's services. We note further that the presence of the ".com" element in both marks contributes to the overall similarity even though it is not a distinctive element in its own right. See In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); In re Reed Elsevier Properties Inc., 77 USPQ2d 1649 (TTAB 2005).

Furthermore, we conclude that applicant's IRONMAN.COM mark is similar to opposer's other IRONMAN marks covered by the remaining registrations noted above. In each instance, again, IRONMAN is the dominant element of the registered

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mark, and as we concluded above, the dominant element in applicant's mark. In the case of all of opposer's registered marks, other than IRONMANLIVE.COM, the additional word elements are merely descriptive or generic, and as such, subordinate to IRONMAN in contributing to the appearance, sound, connotation and commercial impression of the marks. Also, in the case of opposer's registered marks which include a design element, in all instances the design element is subordinate to the dominant IRONMAN word element. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)

Furthermore, the ".com" element in applicant's IRONMAN.COM mark is insufficient to distinguish applicant's mark from the registered marks which do not include ".com" as an element. The ".com" element is devoid of source-identifying characteristics, and as such, is not distinctive. Consequently, it has no significant impact on the overall appearance, sound, and most importantly the connotation and commercial impression projected by the IRONMAN.COM mark. In re Oppendahl & Larson LLP, 71 USPQ2d at 1373.

More generally, in this case, we note that the ".com" element is not combined with other elements in either mark in a way which creates a new and distinct commercial impression. Thus, it is unlike the hypothetical

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"tennis.net" example the Federal Circuit discussed in Oppendahl & Larson where the addition of the top level domain (TLD) ".net" created a new and distinctive combination. Id. at 1373.

The Goods and Services and Channels of Trade

The goods and services of opposer and applicant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods or services originate from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). See also On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000);

Furthermore, in comparing the goods and services and the channels of trade for the goods and services, we must consider the goods and services as identified in the application and registrations. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods,

the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also 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.")

Also, the proper inquiry is not whether the goods and services could be confused, but rather whether the source of the goods and services could be confused. Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); In re Rexel, Inc., 223 USPQ 830, 831 (TTAB 1984).

Opposer relies primarily on its registration for IRONMANLIVE.COM for "providing information concerning athletic competitions featuring bicycling, swimming and running and participants therein via global computer networks," and applicant agrees that these services are the closest opposer has to applicant's. Applicant's Brief at 7. Accordingly, we will concentrate on this registration in our likelihood of confusion analysis.

Applicant identifies its services as "computer services providing customized online web pages featuring user-defined information, which includes search engines and online informational web links to news, weather, sports, current events, reference materials, and customized e-mail messages,

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all in a wide range of user-defined fields." Opposer argues, "Both marks are for domain names for computer services. Like WTC's mark Applicant's proposed mark is for information relating to 'sports.' Thus the similarity of the described services is great. Applicant's partial focus on sports also raises a likelihood of confusion issue with respect to the many other IRONMAN marks that relate to triathlon competitions, swimming and biking." Opposer's Main Brief at 13-14.

Applicant attempts to distinguish its "computer services" from those of opposer by stating,

The closest service that WTC provides is in relation to its IRONMANLIVE.COM registration for "providing information concerning athletic competitions featuring bicycling, swimming and running and participants therein via global computer networks" which is a non-user specific information web site operated to support triathlon services associated with WTC's other servicemark (sic) registrations... In distinction IMC seeks to provide customized web pages based on user-defined information, such a service would require a registration or similar process to create the user-defined fields, all of which would increase the scrutiny of a customer... Undeniably, WTC and IMC are not marketing the same goods (IMC does not market any goods) and services.

Applicant's Brief at 7.

Applicant's identification of services is broad and arguably somewhat ambiguous. To the extent we might legitimately look to evidence to understand the nature of those services, we have very little to consider. Cf. In re Trackmobile Inc., 15 USPQ2d 1152, 1154 (TTAB 1990). When

asked whether he had "any documents showing that you had ever put anything up at the Ironman.com web site" Mr. Peppler said "no." He also said that he did not remember anything that he may have put up on the site. At the time of Mr. Peppler's testimony the domain name accessed a page which simply indicated that something was "coming soon." In fact, applicant has not claimed any use of its mark to date. As we stated above, Mr. Peppler also indicated that he had put his plans for use of the IRONMAN.COM mark on hold due to this litigation.

As to his future intentions with regard to use of the mark, Mr. Peppler testified as follows:

Q Do you have any intent to use this website in the future?

A Yes.

Q How do you intend to use it?

A In the ways I've already described.

Q Which is what specifically again?

A Community site with email so you could have Joseph Weissman at IronMan.com and post up on the website.

Q Any other way that you intend to use this website in the future?

A It, not, (sic) I mean that hopefully will be enough.

Q So then you intend to use Ironman.com basically just as a community site where people can come and create their own web pages?

A Yes.

Applicant's counsel had the opportunity to examine Mr. Peppler with regard to this and other issues but did not do so. Nor has applicant provided any other evidence regarding the services applicant identified in its application.

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In its fundamental argument regarding the similarity of its services to those identified in the registration opposer oversimplifies the matter. We must look beyond the facts that both parties provide "computer services" and that the content in each case relates to "sports" to some extent. Cf. Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988) (no per se rule holding all computer goods related). We must also look beyond the simple fact that both services are or would be provided online. These facts alone would not be sufficient to conclude that the services are related. Rather, we must look to the identifications of services in detail to determine whether, under the totality of the circumstances before us, opposer's services are related to applicant's.

To the extent applicant's identification of services may be ambiguous, opposer has argued that we should construe any ambiguity in the identification in favor of opposer, citing David Crystal, Inc. v. Soo Valley, Co., 471 F.2d 1245, 176 USPQ 326 (CCPA 1973) and other cases. In construing the scope of applicant's services - "computer services providing customized online web pages featuring user-defined information, which includes search engines and online informational web links to news, weather, sports, current events, reference materials, and customized e-mail messages, all in a wide range of user-defined fields" - we

can follow our usual analysis and need not entertain any presumptions regarding ambiguities.

The construction of "providing customized online web pages..." is most critical in that analysis. In the absence of any explicit limitations, we conclude that "providing" could include both the service of enabling users to design and display such pages, as well as the service of affording users the opportunity to view the pages. While designing web pages may require a higher level of involvement and attention by the party serviced, as applicant suggests, the viewing of such pages by a party would require far less involvement and attention. We also conclude that members of the general public would be among those potentially availing themselves of the service either by using the service to design and display a customized web page or to view a page.

We also conclude, as the identification itself specifies, that personalized web pages made available for viewing may include materials or links related to sports. "Sports" necessarily encompasses biking, running or swimming. In fact, this type of subject matter could be the only or dominant subject matter displayed on one or more personalized web pages on the IRONMAN.COM site.

Most importantly, we conclude that the IRONMAN.COM mark could be displayed and encountered by either potential type of party serviced, that is, either one seeking to design and

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display a personalized web page or one who is merely viewing such pages. In the latter case, the viewer, even a casual user of the service, could encounter the mark in conjunction with a page or pages which include content related to running, biking or swimming.

Accordingly, we conclude that the services of applicant and registrant, as identified in the IRONMAN.COM application and the INRONMANLIVE.COM registration, are related. We conclude further that applicant's services are also related to opposer's services identified in other registrations noted above, in particular, those registrations which identify services in the field of sports.² Applicant's identification of services specifies "sports" as being among the potential subject matter for its services.

Furthermore, we conclude on the same basis that applicant's services and opposer's services, which we have determined to be related, could reach the same consumers through the same or related trade channels, that is, principally online.

Fame

Opposer also argues that its marks are famous and applicant disagrees.

Opposer's evidence regarding the fame of its IRONMAN marks includes: 1) long use, that is, conducting opposer's

² Reg. Nos. 1353313, 1462281 and 2869852.

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championship and qualifying events under the IRONMAN marks for nearly 30 years; 2) broadcast of its championship events on national television since 1982; 3) recognition accorded those telecasts through the award of twelve Emmys; 4) broadcast of seven U.S. qualifying events on cable; 5) the operation of opposer's web site at IRONMANLIVE.COM since 1998 with "upwards of 30 million page views" annually with visits of 12 to 15 minutes; 5) video streaming of opposer's championship event on the Internet with three and a half million visitors viewing the race in the previous year; and 6) promotions of opposer's events and IRONMAN marks through sponsors and licensed products, including the TIMEX IRONMAN sports watch, Foster Grant IRONMAN sunglasses, and other products noted above. Opposer also notes advertising campaigns featuring its marks broadcast on MTV and during NASCAR events and the AFC and NFC championship games.

While the showing is superficially impressive, it lacks precision in a number of respects. Opposer fails to provide precise figures regarding the number of participants other than for the 2004 championship event. Opposer does not indicate the number of viewers for any of the event telecasts, nor does opposer specify sales figures for any of its licensed products for particular periods of time. Similarly, opposer often fails to distinguish U.S. activities from activities outside the United States;

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activities outside the United States are not relevant for our purposes. For example, Mr. Fertic states that the TIMEX IRONMAN watch is the "number-one selling sports watch in the world," but he fails to specify precise sales figures either overall or for any specific years, and he fails to differentiate U.S. sales from sales outside the United States. Finally, in stating that opposer spends "several million dollars" on advertising, the testimony does not indicate expenditures for specific time periods. In this case, and more generally, opposer fails to provide documents reporting relevant data.

The lack of precision detracts significantly from the impact of a showing which might otherwise be highly impressive. See Packard Press Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000). Nonetheless, the record is adequate to establish that the IRONMAN marks have achieved a significant degree of recognition or renown with respect to entertainment services related to athletic competitions involving triathlons, running, biking and swimming. The recognition or renown extends to all versions of the mark covered by the registrations opposer submitted; IRONMAN is by far the most prominent and dominant element in each of these marks, including IRONMANLIVE.COM.

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The degree of renown shown here entitles opposer to a somewhat broader scope of protection for its IRONMAN marks. Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Though we conclude on this record that opposer's IRONMAN marks possess a significant degree of recognition or renown the showing falls short of that required to qualify the marks for inclusion in the select class of marks which are characterized as famous. See NASDAQ Stock Market Inc. v. Antarctica S.r.l., 69 USPQ2d 1718 (TTAB 2003); Toro Co. v. ToroHead Inc., 61 USPQ 1164, 1173 (TTAB 2001).

In view of this renown, we further conclude that the scope of protection for opposer's IRONMAN marks in conjunction with its identified sports-contest entertainment services would extend to related services such as "computer services providing customized online web pages featuring user-defined information, which includes search engines and online informational web links to news, weather, sports, current events, reference materials, and customized e-mail messages, all in a wide range of user-defined fields." We note here again our analysis with regard to the scope of applicant's services.

Third-Party Registration/Use of IRONMAN Marks

As we noted above, applicant argues that opposer's IRONMAN marks are weak, and applicant offers nine third-party registrations for marks consisting of or comprising IRONMAN to support this position. In fact, this is the only evidence applicant submitted in the case. At the outset we note our conclusion immediately above that opposer's IRONMAN marks have achieved a degree of recognition and renown, a conclusion which necessarily implies that opposer's marks are strong and not weak.

We also point out that third-party registrations are entitled to little weight on the question of likelihood of confusion. See, e.g., In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Such registrations are not evidence that the marks are in use or that the public is familiar with them. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). As the Federal Circuit has stated, "[t]he probative value of third-party trademarks depends entirely upon their usage." Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 73 USPQ2d at 1693.

Furthermore, the goods and services covered by the registrations range from "telephone booths" to "refractory crucibles" to "tires for motor vehicles" to "fertilizers for turf and agricultural use." The goods and services

identified in the third-party registrations are generally far afield from the services of both opposer and applicant. With respect to the goods and services, the most relevant registration is Reg. No. 1899110 for the mark IVAN "IRONMAN" STEWART for "promoting the race driving products of others and race driving, by making personal appearances, custom commercials, product promotion, product endorsement, and the like" in International Class 35. However, in this registration the mark conveys a very different connotation than opposer's IRONMAN marks or applicant's IRONMAN.COM mark. Thus, the registrations fail to demonstrate that IRONMAN is a weak mark or to rebut the evidence submitted by opposer of the strength of its marks.

In sum, we conclude that applicant has failed to establish that opposer's rights in the IRONMAN marks are weakened as a result of third-party use.

Actual Confusion

Opposer also argues that there has been actual confusion. Specifically, opposer references instances in which individuals have used the ironman.com domain name in an attempt to access opposer's website without success and similar instances of confusion with regard to the domain name. Opposer argues, "People contact WTC regularly asking whether WTC's website is down or if something is wrong with WTC's server." Opposer's Main Brief at 17. Mr. Fertic

testified that, "A lot of people would e-mail and say, hey, you're down. Your web site is down..." Fertic Testimony at 42. Opposer testified as to one instance in which Kodak listed ironman.com as the web address for ordering photographs of opposer's events. Id. at 40. Other companies, such as Intel, have made similar mistakes, according to Mr. Fertic's testimony.

In responding to opposer's evidence and arguments regarding actual confusion applicant argues that the four specific instances of confusion which opposer identifies are insufficient to show confusion. Applicant questions whether the examples truly show consumer confusion and more generally argues that opposer has failed to show that "an 'appreciable' number of consumers" have been confused. Applicant states, "The infringing use need not confuse a majority of consumers; a confusion level of 15% is not 'small' or 'de minimis' and is sufficient for liability under the Lanham Act. *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 279 (7th Cir. 1976). WTC has failed to even come close to satisfying this burden of proof." Applicant's Brief at 3.

We find flaws in the positions of both opposer and applicant on this issue. Most importantly, we begin by noting the practical difficulty in proving actual confusion

where, as here, one party has not even begun to use its mark.

In arguing that there has been actual confusion, opposer relies principally on evidence that companies and individuals have mistakenly tried to use the ironman.com domain name. In this evidence, there is no indication that relevant consumers confused the source of any goods and services since applicant has not used its mark. In fact, there is no evidence here that applicant has begun to use its mark or provide the service it identifies in the application under that mark. Accordingly, we conclude that the "confusion" which opposer's evidence demonstrates is not the type of trademark confusion contemplated under the actual-confusion factor in du Pont.

In arguing against opposer's actual confusion evidence, applicant relies on the James Burrough case.³ This reliance is misplaced.⁴ In the process, applicant misconstrues the actual-confusion factor for purposes of this proceeding. It is not necessary to show actual confusion at all, let alone a defined level of confusion as applicant argues, in order

³ In fact, in a later opinion in the same case the Seventh Circuit emphasized that, even in an infringement action, "likelihood of confusion [not actual confusion] is the gravamen of the action." James Burrough Ltd. v. Sign of the Beefeater, Inc., 572 F.2d 574, 197 USPQ 277, 279 n.2 (7th Cir. 1978).

⁴ Here and elsewhere applicant relies on infringement cases from the federal courts. These cases are of limited relevance in this proceeding. In re Bercut-Vandervoort & Co., 229 USPQ at 765 (TTAB 1986).

to establish likelihood of confusion. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). In this case, where the intent-to-use applicant has not begun to use the mark on the services identified in the application, we must necessarily look to factors other than actual confusion to determine likelihood of confusion.

We also reject applicant's implied argument that the absence of actual confusion in this record supports its position. The Federal Circuit has stated, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight (citation omitted) . . ." Majestic, 65 USPQ2d at 1205. See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Again, in the case of an intent-to-use application where use has not commenced it is not logical to ascribe importance to the actual-confusion factor.

Accordingly, we conclude that the actual-confusion factor is neutral in this case.

Bad Faith

In developing its evidence and in its briefs opposer devotes substantial attention to applicant's alleged bad faith. We must look to the record to see whether opposer

has established bad faith. See Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); Blue Man Productions Inc. v. Tarmann, 75 USPQ2d 1811, 1820 (TTAB 2005).

Opposer offers two types of evidence to establish applicant's bad faith. First, opposer presents evidence regarding Mr. Peppler's activities with regard to domain name registrations unrelated the IRONMAN marks,⁵ and secondly opposer presents testimony from Mr. Peppler regarding his "reasons" for selecting the IRONMAN.COM mark. With respect to the domain name registrations, Mr. Peppler does testify that he and companies he controlled registered at least 20,000 and possibly as many as 27,000 domain names. Mr. Peppler also testified that he received about 100 cease-and-desist letters regarding domain names he had registered, apart from ironman.com. Mr. Peppler testified further that he or companies he controlled had been compelled to transfer various domain name registrations to complaining parties as a result of determinations in eight Uniform Dispute Resolution (UDRP) proceedings.

⁵ After the close of the testimony periods, opposer had attempted to reopen its testimony period to place in evidence a decision under the Uniform Dispute Resolution Policy ("UDRP") whereby applicant was compelled to transfer the ironman.com domain name registration to opposer. The Board denied the request in a decision dated February 16, 2006. Accordingly, we have not considered that evidence.

Opposition No. 91153811

In response to opposer's questions regarding applicant's reasons for selecting the IRONMAN.COM mark Mr. Pepler states, "I love the music and I love the song Iron man and that's why I wanted it." He then explains that Iron Man is a song by Black Sabbath. Opposer notes that Mr. Pepler was unable to recite any of the lyrics of the Iron Man song and suggests that this calls into question Mr. Pepler's account of his reason for selecting the IRONMAN.COM mark.

The evidence submitted by opposer certainly casts doubt on applicant's bona fides in adopting its mark. However, because we find that opposer has established likelihood of confusion even in the absence of such evidence, we do not need to reach the question of whether applicant adopted its mark in bad faith, and in an attempt to capitalize on opposer's IRONMAN marks. Cf. NASDAQ Stock Market Inc. v. Antartica S.r.l., 69 USPQ2d at 1733 ("On the other hand, merely because we decline to find that applicant adopted its mark [NASDAQ] in bad faith, it does not follow from this record that applicant has acted entirely in good faith. While the factor does not weigh in the balance against applicant, it does not weigh in its favor either").

Therefore, we have not considered bad faith as a factor in reaching our conclusions with regard to likelihood of confusion in this case.

Conclusion

Finally, we have considered all relevant evidence in this case bearing on the du Pont factors and conclude that there is a likelihood of confusion between opposer's IRONMAN marks, most notably the IRONMANLIVE.COM mark as well as opposer's other IRONMAN marks for sports-related services in Reg. Nos. 1353313, 1462281 and 2869852, and applicant's IRONMAN.COM mark. We conclude so principally because the marks of opposer and applicant are similar and the services of opposer and applicant are related, and due to the strength of opposer's IRONMAN marks.

DILUTION

Opposer also asserts dilution as a ground for opposition. In view of our decision to sustain the opposition on the ground of likelihood of confusion, it is not necessary for us to consider opposer's dilution claim.

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