

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 10, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gilmar S.p.A.
v.
Mizuno Kabushiki Kaisha

Opposition No. 91156043
to application Serial No. 76362643
filed on January 24, 2002

Dennis H. Cavanaugh of D H Cavanaugh Associates for Gilmar S.p.A.

Michael D. Hobbs and John M. Bowler of Troutman Sanders LLP for Mizuno Kabushiki Kaisha

Before Rogers, Kuhlke and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Mizuno Kabushiki Kaisha, seeks registration of the mark shown below for goods identified in the application as "clothing; namely baseball uniforms, baseball stockings, baseball undershirts, baseball under stockings, baseball sliding pants, badminton shirts, badminton pants and shorts, badminton skirts, tennis jackets, tennis shirts, tennis pants, tennis shorts and skirts, table tennis

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jackets, table tennis pants and shorts, table tennis shirts, basketball shirts, basketball pants, basketball jerseys, golf shirts, golf vests, golf jackets, golf pants, golf socks, golf raincoats, golf rain jackets and pants, golf sweaters, rugby shirts, rugby pants, football jackets, football pants, football shirts, football hose being socks and stockings, volleyball jackets, volleyball warm-up shirts, volleyball warm-up pants, volleyball shirts, volleyball pants, ski jackets, ski pants, ski anorak coats, ski jump suits, ski stockings and socks; skate suits, boxing trunks, boxing shirts, wrestling uniforms, track and field shirts, track and field pants, track and field warm up shirts, track and field warm up pants, gymnastic shirts, gymnastic pants, mountaineering jackets, mountaineering shirts, mountaineering pants, mountaineering socks, mountaineering breeches, mountaineering anoraks, bowling shirts, judo uniforms composed of pants, coats and belts, women's judo underwear, karate uniforms composed of pants, coats and belts, women's karate underwear, kendo uniforms composed of pants, coats and belts, swim pants, swim suits, handball shirts, handball pants, soccer shirts, soccer pants, wet suits, water ski jackets; suits, coats, jackets, shirts, underwear, T shirts, shorts, sweat shirts, sweat pants, gloves, polo shirts, blousons, vests, cardigans, trousers, slacks, short pants, socks and hose, rain wear,

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skirts, culottes and wind protection jackets, blouses; footwear; namely baseball shoes, softball shoes, badminton shoes, tennis shoes, table tennis shoes, basketball shoes, golf shoes, football shoes, volleyball shoes, hockey shoes, archery shoes, handball shoes, ski boots, after ski boots, ice skate boots, wrestling shoes, running shoes, track and field shoes, walking and climbing footwear, gymnastic shoes, weight lifting shoes, boxing shoes, soccer shoes, rugby shoes, cross training shoes, cross court shoes, racket ball shoes and squash shoes; caps and hats; namely baseball caps, golf caps, golf sun visors, ski caps, swim caps" in International Class 25.¹ The application includes a disclaimer for the following wording: BODY COOLING TECHNOLOGY.



Opposer, Gilmar S.p.A., opposed registration of applicant's mark on the grounds that, as applied to applicant's goods, the mark so resembles opposer's

¹ Serial No. 76362643, filed January 24, 2002. The application is based on an allegation of a bona fide intention to use the

previously used and registered marks ICE and ICEBERG for clothing as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations.

The evidence of record consists of the pleadings herein; the file of the opposed application; opposer's notices of reliance on its pleaded registrations and applicant's discovery responses; opposer's testimony deposition, with exhibits, of Zeljko Moric, Vice President of Gilmar USA, Inc.; applicant's notice of reliance, filed by stipulation, on the discovery depositions of Angela Casiero, opposer's Vice President Sales and Marketing, taken in this proceeding and another proceeding involving opposer; applicant's notices of reliance on opposer's responses to applicant's discovery requests, applicant's two registrations for marks that include ICE TOUCH and 48 third-party registrations that contain the word ICE; applicant's testimony deposition, with exhibits, of Janice Jean Bashore, Director of Apparel for Mizuno USA; opposer's rebuttal testimony deposition of Angela Casiero; and opposer's notice of reliance, filed by stipulation, on exhibits attached to the discovery deposition of Angela Casiero.

mark in commerce under Trademark Act Section 1(b), 15 U.S.C.

PRIORITY/STANDING

Because opposer has made its pleaded registrations of record by way of notice of reliance, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the question of likelihood of confusion.

LIKELIHOOD OF CONFUSION

Opposer's pleaded registrations are in full force and effect and are set forth as follows:

Registration No. 1269297 for the mark ICEBERG in typed form for "t-shirts, skirts, trousers, shirts, jackets, and blazers" in International Class 25, issued March 6, 1984, renewed; and

Registration No. 1850734 for the mark ICE in typed form for "clothing, namely, men's women's suits, coats, caps, shirts, t-shirts, belts, vests, scarves, skirts, ties, shorts, bathing suits, dresses, jackets, sweaters, jeans, pajamas, kerchiefs, underwear, shoes" in International Class 25, issued August 23, 1994, renewed.

In addition, opposer has submitted status and title copies of its registrations for the marks ICEBERG JEANS and design, IJ ICEBERG JEANS, ICEBERG SPORT ICE, AISBERG, HISTORY ICEBERG, ICE B, ICE B ICEBERG, SPORT ICE, and ICE ICE BABY ICEBERG, for use in connection with a variety of

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clothing and accessory items.² For our determination of likelihood of confusion in this opposition, we focus our decision on the registration with the most similar mark, Reg. No. 1850734 for the mark ICE.

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 factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

² In the notice of opposition, opposer pleaded two registrations for the marks ICE, Reg. No. 1269297, and ICEBERG, Reg. No. 1850734. Opposer submitted status and title copies of these registrations under a notice of reliance. In addition, opposer submitted under a notice of reliance status and title copies of several other of its registrations, which were not pleaded in the notice of opposition. Applicant "does not object to those other registrations being in the record if Opposer is relying on these other marks only to make an individual mark-by-mark comparison [however applicant] does object to the extent opposer may be trying to rely on a family of ICE marks." Br. p. 20. In view thereof, we consider these other registrations stipulated into the record but we will not consider opposer's argument and evidence to the extent opposer is attempting to prove a family of marks. We further note that, in any event, this record does not establish a family of marks. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). The mere fact that opposer has registered many of the purported family members is not sufficient to prove that a family of marks exists. *Consolidated Foods Corp. v. Sherwood Industries, Inc.*, 177 USPQ 279, 282 (1973). In addition, the evidence of use in this record cannot support a finding that "the pattern of usage of the common element is sufficient to be indicative of the origin of the family." *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) citing *J & J Snack Foods*, 18 USPQ2d at 1881. In other words, there is not sufficient evidence to show that the registered marks have been widely used and promoted together in such a manner as to create public recognition coupled with an association of common origin predicated on the family feature. *Land-O-Nod Co. v Paulison*, 220 USPQ 61, 65-66 (TTAB 1983). See also *Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334 (TTAB 2006).

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In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Before turning to these factors, we begin by addressing two other factors raised by the parties that impact the strength of the asserted marks and scope of protection to be accorded them. While fame has not been specifically pleaded, opposer argues that it has "built up substantial fame in its ICE marks for clothing and related goods." Br. p. 26. Opposer tends to blend the evidence and argument of all of the "ICE marks" together and it is difficult to draw from that evidence of sales, advertising and length of use conclusions pertaining to the individual marks; however, we consider this evidence because any recognition by consumers of one of opposer's ICE marks is likely to contribute to recognition of its other ICE marks. Opposer's mark ICE has been registered for over ten years and has appeared in nationally distributed magazines. *Moric Test.* p. 19; *Opp. First Notice of Reliance*; *Casiero Disc. Dep.* p. 89-92. While there is testimony and a few examples as to the various "ICE marks" appearing in several nationally distributed magazines (e.g., *The Source*, *Vibe*, *Harper's*

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Bazaar and Women's Wear Daily), and sales of goods under various ICE marks in the United States,³ the evidence of record is not sufficient to establish that any or all of the "ICE marks" are famous. For example, it is not clear how pervasive the advertising has been or how substantial the sales figures are in the context of this industry to rise to the level of establishing fame. However, although the record does not establish opposer's registered ICE mark to be famous it does show it to be a strong mark.

In an attempt to limit the scope of protection for opposer's ICE mark by showing the term is "weak" in connection with clothing, applicant has submitted third-party registrations that contain the word ICE for use in connection with a variety of clothing items. However, absent evidence of actual use of those marks, the third-party registrations are entitled to little weight in our likelihood of confusion analysis. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973) (existence of third-party registrations not evidence of what happens in the market place or that customers are familiar with term nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive). Applicant also submitted its two registrations

³ The sales figures were submitted under seal.

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that include the ICE TOUCH and design mark in support of this argument. As to these registrations, there is evidence of use of the mark in commerce in connection with sports-related clothing; however, one other user of the term ICE is not sufficient to conclude that purchasers have been conditioned to look for other elements to distinguish these marks.⁴

In short, there is nothing in the record to establish that the term ICE by itself is anything other than an arbitrary term in the context of the opposer's goods. Therefore, opposer's mark ICE is inherently strong to the extent that it is an arbitrary mark. However, in view of our finding with regard to the factor of fame, the strength of the mark on this record does not reach the level of playing "a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also, *Palm Bay Imports, Inc. v. Veuve Clicquot*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003); and *Bose Corp.*

⁴ We note that applicant has not asserted a Morehouse defense. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Moreover, such a defense would not be appropriate in view of the differences in the identification of goods between applicant's registrations and the subject application. See *Aquion Partners Limited Partnership v. Envirogard Products Limited*, 43 USPQ2d 1371, 1373 (TTAB 1997).

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v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002).

This brings us then to our consideration of the similarities between opposer's and applicant's goods, channels of trade and class of purchasers. We must make our determinations under these factors based on the goods as they are recited in the application and registration, respectively. 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 sales of the goods are directed."); *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

Applicant ineffectively focuses its arguments on the sports-related goods in its identification and does not address the identical goods, without any limitation, listed in its identification of goods. Thus, applicant's "swim suits; suits, coats, jackets, shirts, underwear, T shirts, shorts, vests, cardigans and skirts" are identical to or encompassed by opposer's "men's women's suits, coats, shirts, t-shirts, vests, skirts, shorts, bathing suits,

jackets, sweaters and underwear.” The fact that applicant’s actual use is limited is not a factor in our decision, which is solely concerned with the four corners of the application and the rights to be accorded it by registration on the Principal Register. Thus, for purposes of our analysis, some of applicant’s goods are identical and we need not discuss whether applicant’s sports-related items, for example, volleyball warm-up shirts, are related to opposer’s shirts. See, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). See also *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n. 9 (TTAB 2004). However, we note that opposer’s registration is not limited to exclude sports-related clothing; for example, applicant’s “tennis shorts” could be encompassed by opposer’s “shorts” as identified in the registration.⁵

With regard to the channels of trade and class of purchasers, at least as to the identical goods, absent restrictions in the identification as to trade channels and purchasers, we must presume that the parties’ goods would be sold in the same channels of trade and to the same relevant purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*,

⁵ We also note that applicant’s arguments with regard to opposer’s use or non use of the mark ICE by itself are equally ineffective. Absent a counterclaim, these arguments constitute an impermissible attack on opposer’s registration.

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281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom, 16 USPQ2d 1783.

We turn now to a consideration of the first du Pont factor, i.e., whether applicant's ICE TOUCH BODY COOLING TECHNOLOGY and design mark and opposer's mark ICE in typed form are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, where the goods are identical, "[t]he degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992).

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The parties differ on whether the word ICE is the dominant element in applicant's mark. Certainly it is dominant over the disclaimed wording BODY COOLING TECHNOLOGY, not only due to the descriptiveness of the wording⁶ but also due to the presentation of the disclaimed wording in a smaller type face blending in with the background color. By comparison, the wording ICE TOUCH is in large lettering juxtaposed against a different background color, and therefore is visually dominant. In addition, as has often been said the literal element of a combined mark generally dominates over a design element inasmuch as it is the words by which potential consumers will call for the goods or services. CBS Inc. v. Morrow, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983); Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). The snowflake design in this case is not such that it would dominate over the wording ICE TOUCH. With regard to the phrase ICE TOUCH, the word ICE does predominate to the extent that it is the first word, however, as a modifier of the word TOUCH it is part of a unitary phrase. That being said, the phrase ICE TOUCH

⁶ In regard to the features of the apparel sold under the ICE TOUCH mark applicant's witness, Ms. Bashore, testified as follows: It's a double layer construction with a polyethylene vinyl alcohol inside fiber layered with either cotton or polyester on the outside to create the double layer construction, and it pulls away the body heat. I'm not a technical, you know, fiber person, but in layman's terms it pulls away the heat that's on the skin level and traps it within that double layer and then disburse it over a greater surface area, so it dries quickly. Bashore Test. p. 19.

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incorporates the entirety of opposer's mark ICE and is to that extent similar in sound and appearance. As to meaning, it appears from opposer's testimony that the intent for its ICE mark is to indicate something hip or cool, however, there is nothing in the drawing of the mark in the registration to guide a consumer to that particular meaning and it could equally mean ice or be suggestive of a cold temperature, which is the clear suggestion in applicant's mark ICE TOUCH due to its use with the explanatory wording BODY COOLING TECHNOLOGY.

Opposer argues that the addition of the term TOUCH does not serve to distinguish the marks but rather serves to increase the likelihood of confusion in that consumers would consider applicant's mark to be one of a series of opposer's ICE marks. Applicant counters that opposer has not pleaded or proven a family of marks and thus may not rely on this line of argument. As noted above, opposer may not rely on a family of marks; however, it is undisputed that in the clothing industry it is common to use derivative or "diffusion" marks within a brand line, and thus consumers are accustomed to seeing variations on a brand. See Casiero Disc. Dep., pp. 8-9, 12-14, 21-26, 110-114; Rebuttal Test. Casiero pp. 16-18, 43. Thus, in this case, where there are identical goods and opposer's mark is inherently strong, the addition of TOUCH does not serve to obviate a likelihood of

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confusion in view of this practice in the industry to spin off diffusion marks from a main mark. Consumers accustomed to seeing slight variations in marks in the clothing industry, would likely confuse a mark (ICE TOUCH) that uses as its base the entirety of a prior user's mark (ICE) on identical goods.

In view thereof, we find the marks to be similar and this factor weighs in favor of likelihood of confusion.

As to the level of care in the purchasing decision, the testimony from both parties' witnesses indicates a range in pricing. However, because the identifications in the application and registration are not restricted in terms of price, the t-shirts identified in both the registration and application encompass inexpensive items. Overall, we find this factor to be neutral and, at a minimum, does not outweigh the other relevant du Pont factors.

Applicant also argues that there is no known instance of actual confusion despite approximately five years of concurrent use. This is not a particularly long time of concurrent use, and, more importantly, it appears from the record that there has been little opportunity for confusion. The use in the record points to the parties selling in different types of stores and advertising in different magazines and press, thus no meaningful inference may be drawn from a lack of actual confusion. See Gillette Canada

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Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992).

Finally, it is well established that actual confusion is not necessary for a finding of likelihood of confusion. Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

Considering the respective marks in their entireties, the strength of opposer's mark, and considering the goods, which are in part identical, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a likelihood of confusion between opposer's ICE mark and applicant's ICE TOUCH BODY COOLING TECHNOLOGY and design mark. To the extent we have any doubt, we must resolve that doubt in favor of opposer, the prior registrant. See Hewlett-Packard Co. v. Packard Press, Inc., 281 USPQ2d 1001, 1003 (Fed. Cir. 2002); Hard Rock Cafe International (USA) Inc. v. Thomas D. Elsea, 56 USPQ2d 1504, 1514 (TTAB 2000) and W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308, 311 (TTAB 1976).

Decision: The opposition is sustained.