

**THIS OPINION IS NOT A
PRECEDENT OF
THE TTAB**

Hearing:
April 17, 2007

Mailed: January 11, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Wrangler Apparel Corp.
v.
Quiksilver, Inc.

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Opposition No. 91158458 to application Serial No. 78214773
filed on February 13, 2003

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Larry C. Jones and Jason M. Sneed of Alston & Bird LLP for
Wrangler Apparel Corp.

Jeffrey L. Van Hoosear and Scott Loras Murray of Knobbe,
Martens, Olson & Bear, LLP for Quiksilver, Inc.

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Before Holtzman, Cataldo and Taylor, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Applicant has filed an application to register on the Principal Register the mark QUIKSILVEREDITION, in standard character form, for "[a]ll purpose sport bags, animal game bags, athletic bags, barrel bags, beach bags, book bags, boston bags, carry-on bags, clutch bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bats [sic], hunters game bags, leather shopping bags, mesh shopping bags, overnight bags, roll bags, school bags,

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school book bags, shaving bags sold empty, shoe bags for travel, shoulder bags, souvenir bags, suit bags, textile shopping bags, tool bags sold empty, tote bags, travel bags, wrist mounted carryall bags, luggage, backpacks, wallets and umbrellas" in Class 18.¹

Registration has been opposed by Wrangler Apparel Corp. on the ground of priority of use and likelihood of confusion with its previously used mark SILVER EDITION. Opposer specifically alleges that since at least as early as June 8, 1998, and, in any event, since prior to either the filing date of the involved application, i.e., February 13, 2003, or the actual date of first use of the QUIKSILVEREDITION mark, opposer and/or its predecessor have continuously used SILVER EDITION as a trademark in offering, selling, advertising, promoting and/or transporting various clothing products in commerce within this country and elsewhere; that by reason of the adoption and continuous use of the SILVER EDITION mark, it has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying opposer and its clothing products; and that consequently through such usage, opposer has acquired common law rights in SILVER EDITION as a proprietary trademark. Opposer further alleges that it is

¹ Serial No. 78214773, filed on February 13, 2003 and alleging a bona fide intent to use the mark in commerece on the recited goods.

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the owner of application Serial No. 78276782, filed July 21, 2003, for the mark SILVER EDITION (in standard character form) for "jeans, casual pants and short, shirts." June 8, 1998 is the alleged date of first use of the mark anywhere and in commerce. The term EDITION has been disclaimed in the application. Opposer also alleges that "Applicant's QUIKSILVEREDITION mark incorporates within it the entirety of Opposer's senior SILVER EDITION mark, thus causing a likelihood of confusion [and that] ... some or all of Applicant's listed goods are substantially related to the goods on which Opposer's SILVER EDITION mark has been used." (Notice of Opposition at ¶ 7).

Applicant, in its answer, has denied the essential allegations of the notice of opposition. Applicant also appears to claim priority by its assertion that it "owns Registration NO. 1,453,205 for QUIKSILVER for goods in Class 18, which was filed on April 25, 1986 and registered on August 18, 1987."

THE RECORD

The record consists of the pleadings and the file of application Serial No. 78214773. In addition, opposer submitted the testimony deposition, with exhibits, of Helen Littell Winslow, opposer's assistant general counsel and a notice of reliance on six third-party registrations. Applicant submitted the testimony deposition, with exhibits,

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of John Bathurst, vice-president of applicant's QuikSilverEdition division and a notice of reliance on Registration Nos. 827212, 1431266, 1453205 and 1800150 for the mark QUIKSILVER and Registration No. 1803546 for the QUIKSILVER and design, with the certified status and title copies thereof showing such registrations to be subsisting and owned by applicant.

PRELIMINARY MATTER

Although opposer did not specifically allege use of its pleaded SILVER EDITION mark on or in connections with wallets, opposer introduced evidence of such use by means of the testimony deposition of its assistant general counsel, Ms. Helen Winslow, and applicant cross-examined Ms. Winslow on that issue. Moreover, both parties presented arguments on the issue in their briefs. Accordingly, we deem this issue to have been tried by the implied consent of the parties, and we therefore deem the notice of opposition to be amended to include an allegation of use of the SILVER EDITION mark on or in connection with wallets. See Fed. R. Civ. P. 15(b).²

² Fed. R. Civ. P. 15(b) provides, in pertinent part, as follows:

(b) Amendments to Conform to the Evidence.

When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to

FINDINGS OF FACT

Opposer

Opposer, Wrangler Apparel Corp., has sold SILVER EDITION jeans and other goods nationwide through K-Mart stores since at least 1998. (Winslow test. at Exh. 2). Opposer created the SILVER EDITION mark in late 1997 and commissioned the production of hangtags by the agency Lynn Rolls Creative, which opposer began to use in 1998 to identify its SILVER EDITION clothing. (Winslow test. at 11 and Ext. 6). Opposer first used its SILVER EDITION trademark in commerce in the United States since at least as early as June 8, 1998. Since at least July 8, 1998, and in any event prior to the February 13, 2003 filing date of the application, opposer has used SILVER EDITION continuously as a trademark in offering, selling, advertising, promoting and/or transporting various clothing products, including jeans, short and shirts, in commerce within the United States. (Winslow test. at 2-4, 6, 15, 17 and Exh. 2 at ¶¶ 3 and 10, and Exh. 9). Since prior to February 13, 2003, opposer has sold wallets under its SILVER EDITION MARK, which products continue to be available for sale to the

conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure so to amend does not affect the result of the trial of these issues.

public at present.³ (Winslow test. at 6-7 and 73, and Exh. 15). Opposer has sold its SILVER EDITION goods through mass

³ Ms. Winslow specifically testified that:

Q Particularly looking at paragraph three of Exhibit 2 [Exhibit 2 is a copy of the declaration of Helen Winslow originally submitted in connection with a response to a motion for summary judgment filed by applicant.]. What was your testimony regarding the first use of the Silver Edition mark owned by Wrangler?

A I stated in my declaration that our first use of the Silver Edition trademark was on June 8, 1998.

Q And that statement in particular is a true statement?

A That is correct. That is a true statement.

Q And what types of products has Wrangler used the Silver Edition mark in connection with since 1998?

A With clothing, most -- the clothing that comes to mind specifically are jeans, shirts, shorts. There may be other pieces of clothing. But those are the predominant ones. Also, at least one bag. I'm sorry, one wallet product that I have seen.

Q Has such use of the Silver Edition mark in connection with the apparel items you described been continuous from 1998 to the present

A Yes, it has been continuous.

(Winslow test. at 6-7).

Q And do you have a recollection as to the date or more specifically than at least as early as or prior to 2003?

THE WITNESS: My understanding is that the wallets were sold, or offered for sale, starting about five years ago.

(Id. at 50).

Q Ms. Winslow, would you turn to Exhibit 16? This is the TESS printout of the application subject to this opposition proceeding, the Class 18 Quiksilver Edition [sic] application of Quiksilver. What is the date that this application was filed with the PTO?

A February 13, 2003.

Q And to clarify your prior testimony. Did Wrangler sell wallets in commerce in connection with the Silver Edition mark prior to February 13, 2003?

A Yes, it did.

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retailer outlets such as K-Mart, Wal-Mart, Target and via the Internet at opposer's website. (Winslow test. at 12 and 18). Wallets sold under the SILVER EDITION brand have been sold at least through K-Mart stores. (Winslow test. at 30, Exh. 15). In 1998, the year the SILVER EDITION brand was launched, opposer sold over \$17 million (wholesale) in apparel products bearing the mark. (Winslow test. at 20). Additionally, in the first five years of use of the SILVER EDITION mark, i.e., 1998 through 2002, opposer sold at least 12,153,596 units of SILVER EDITION apparel and other products, accruing at least \$177,330,997 in wholesale sales. (Winslow test. at 21, Exh. 2 at ¶ 7 and Exh. 10). Opposer advertises its SILVER EDITION apparel via K-Mart store circulars and newspaper inserts, and the prices at which the apparel are offered and sold range from \$13.99 to \$29.99. (Winslow test at 21-29, Exhs. 12-14).

Applicant

Applicant, Quiksilver, Inc. is a manufacturer and distributor of apparel and accessories. Applicant operates 75 to 100 stores throughout the United States and approximately 300 stores worldwide. (Bathurst test. at 28-29, 76-77). As of the date of the Bathurst deposition, i.e., June 22, 2006, applicant had yet to sell any of the goods listed in its application Serial No. 78214773 in the

(Id. at 73).

United States. (Bathurst test. at 19 and 71). Applicant intends to offer its QUIKSILVEREDITION merchandise in "better surf shops, better men's stores, resort shops that are higher end, higher-end department stores like Federated accounts, Macy's, Bloomingdale's, [and] Nordstrom." (Bathurst test. at 30).

ANALYSIS

Standing and Priority

An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." *Richie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The record shows that opposer manufactures and distributes apparel and wallets under the SILVER EDITION mark, and in view of opposer's pleading of a reasonable claim of likelihood of confusion, we consider there to be no issue regarding opposer's standing. *Richie v. Simpson*, *supra*; and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

To establish priority on a likelihood of confusion claim brought under Trademark Act § 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. § 1052. A party may establish its own prior proprietary rights in a mark through ownership of a prior registration, actual use

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or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which create a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act §§ 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994). Priority is an issue in this case because opposer does not own an existing registration upon which it can rely under § 2(d). See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer's asserts common law rights in the SILVER EDITION mark. In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Applicant has not questioned the distinctiveness of SILVER EDITION⁴; nor or there any other circumstances in the case which would have put opposer

⁴ Notably, applicant was advised in the Board's decision, issued October 19, 2004 denying applicant's motion for summary judgment, that in order to pursue a claim at trial that opposer's mark is laudatory, applicant must amend its answer to assert such a defense. Applicant did not do so.

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on notice of this defense, and we therefore find that the mark is distinctive. See *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). See also *Wetseal Inc. v. FD Management Inc.*, 82 USPQ2d 1629 (TTAB 2007).

As regards priority, the record is clear that opposer first used its SILVER EDITION mark on June 8, 1998 on jeans, shirts and shorts and, with respect to wallets, at least prior to February 13, 2003. Although applicant admits that it has not used the QUIKSILVEREDITION mark in the United States on or in connection with its identified goods, applicant nonetheless contends that it has priority by virtue of its earlier use (over thirty years) of the marks QUIKSILVER and QUIKSILVER and design. (Applicant's brief at p. 26). It appears that applicant is attempting to defeat opposer's claim of priority by tacking its use of the QUIKSILVER and QUIKSILVER and design to QUIKSILVEREDITION. We find the argument unavailing as applicant is not entitled to tack in this case.

"Tacking" (for priority purposes) of a party's use of an earlier mark or name onto its use of a later mark or name is permitted only in rare circumstances, and only where the applied-for mark is "the same mark" as the one, or ones, previously used. See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159, 17 USPQ2d 1866, 1868 (Fed. Cir.

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1991); *Ilco v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976); and *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). That is, whether the applied-for mark and the previous marks/names are "legal equivalents," i.e., whether they create the same, continuing commercial impression such that the consumer would consider all of the marks as the same mark. See *Van Dyne-Crotty Inc.*, *supra* at 17 USPQ2d at 1868. A minor difference in the marks such as mere pluralization or an inconsequential modification of a later mark will not preclude application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ513 (TTAB 1984) *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) and *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). At the same time, however, it is clear that the "legal equivalents" standard is considerably higher than the standard for "likelihood of confusion." Thus the fact that two (or more) marks may be confusingly similar does not necessarily mean that they are legal equivalents. *Van Dyne-Crotty, Inc.*, *supra*.

In this case, we find that applicant's earlier-used QUIKSILVER word mark is not the legal equivalent of its applied-for QUIKSILVEREDITION mark because the involved mark contains the additional term EDITION. While that term may be descriptive in relation to the identified goods, the term nonetheless contributes to the overall commercial impression

of the mark. *See, e.g., American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989) (AMERICAN MOBILPHONE held not the legal equivalent of AMERICAN MOBILPHONE PAGING, notwithstanding that PAGING was merely descriptive of the services). We further find that applicant's previously used QUIKSILVER and design mark, shown below,



is not the legal equivalent of its applied-for QUIKSILVEREDITION mark not only because the latter contains the additional term EDITION, but also because applicant's registered mark contains a distinctive design element not found in applicant's applied-for mark.

Since applicant is not entitled to tack on its use of the QUIKSILVER and QUIKSILVER and design marks, and because applicant admittedly has not used the QUIKSILVEREDITION mark in the United States for any of the goods identified in the involved application, the earliest date upon which applicant can rely for purposes of priority is the filing date of its application, i.e., February 13, 2003, a date that is subsequent to opposer's June 8, 1998 first use date. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c). *See Hilson Research Inc. v. Society for Human Resource*

Management, 27 USPQ2d 1423, 1428-29, n. 13 (TTAB 1993); and *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). Consequently, priority rests with opposer.

Likelihood of Confusion

At the outset, we note that inasmuch as applicant is not entitled to tack the use of its QUIKSILVER marks, the marks at issue before us in this proceeding are applicant's applied-for mark QUIKSILVEREDITION and opposer's pleaded SILVER EDITION mark.⁵

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

We first consider the *du Pont* factors which pertain to the similarity or dissimilarity of the goods, the similarity

⁵ To the extent that the parties have argued and submitted evidence with respect to applicant's QUIKSILVER marks, the arguments and evidence have not been considered in our decision.

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or dissimilarity of the classes of purchasers and the similarity or dissimilarity of the channels of trade. In this regard, the registrability of an applicant's mark must be determined on the basis of the identification of its goods as set forth in the involved application and, because opposer relies on common law rights acquired through use of its mark, the goods for which opposer has established prior rights. This is so regardless of what the record may reveal as to the particular nature of applicant's goods, their actual or asserted channels of trade, or the classes of purchasers to which they are in fact or intended to be directed. See e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, *supra*. Here, applicant's goods are identified in its application as "[a]ll purpose sport bags, animal game bags, athletic bags, barrel bags, beach bags, book bags, boston bags, carry-on bags, clutch bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bats [sic], hunters game bags, leather shopping bags, mesh shopping bags, overnight bags, roll bags, school bags, school book bags, shaving bags sold empty, shoe bags for travel, shoulder bags, souvenir bags, suit bags, textile shopping bags, tool bags sold empty, tote bags, travel bags, wrist mounted carryall bags, luggage, backpacks, wallets and

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umbrellas." The goods for which opposer has established prior rights are clothing items, particularly, jeans, shirts and shorts, and wallets. The parties' goods are identical, in part, as to wallets. Contrary to applicant's contention, likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application, even if the common goods constitute only a small percentage of the goods intended for sale. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Further, we find that applicant's various bags and wallets are closely related to opposer's clothing items. In this regard, opposer has submitted copies from the TESS database of the United States Patent and Trademark Office ("USPTO") of six use-based registrations of third-party apparel companies which opposer contends show that purchasers are accustomed to viewing the same trademark on goods that are classified in both Classes 18 and 25. While classification of goods for registration purposes primarily facilitates administration within the USPTO, four of the respective identifications of goods include, *inter alia*, bags and wallets, on the one hand, and apparel items on the other. These third-party registrations serve to suggest that the respective goods are of a type which may emanate

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from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Moreover, in its brief, applicant states that "Quiksilver does not dispute that Class 18 goods are closely related to Class 25 goods." (Applicant's brief at 20).

As identified, applicant's wallets and bags contain no limitations or restrictions as to types of purchasers or channels of trade. Thus, we must presume that applicant's goods will move in all channels of trade that would be normal for such goods, and that the goods would be purchased by the same class of purchasers. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Such trade channels would include all normal retail trade channels for clothing and accessories items (e.g., both high-end and low-end department stores, specialty clothing stores, boutiques and the Internet), and the classes of purchasers would include ordinary consumers. The *du Pont* factors of the similarity of the goods, the similarity of the purchasers and the similarity of the trade channels thus favor opposer.

With respect to the conditions under which the parties' goods will be purchased, applicant contends that the evidence of record establishes that there are significant differences in the conditions under which and buyers to whom sales are, or will be, made as between its QUIKSILVEREDITION

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goods and opposer's SILVER EDITION goods. In particular, applicant maintains that its goods will be relatively expensive as compared to opposer's goods and, thus, applicant's average consumer will be likely to carefully consider an item prior to buying. As noted above, in the absence of any limitations in applicant's identification, applicant's bags and wallets will be sold to ordinary consumers at all of the normal price ranges for such goods. These ordinary consumers would be expected to exercise no more than ordinary care when selecting the respective goods. Accordingly, this *du Pont* factor favors opposer.

The next *du Pont* factor to consider is the fame of opposer's SILVER EDITION mark. The fame of a prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Opposer claims that its mark is strong and entitled to a relatively broad scope of protection. The evidence of record establishes that opposer has had sales of goods bearing the SILVER EDITION mark in excess of \$175 million between mid-1998 and 2002 and that goods bearing the SILVER EDITION mark have been advertised and marketed in circulars and advertising mailings. These facts, without more (e.g., average sales

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figures of similar items by third parties and contextual facts regarding advertising expenditures and circulation), are insufficient to establish that opposer's mark is a famous one. Thus, the *du Pont* factor of fame is neutral.

However, on the other hand, there is no evidence of record of third-party use or registrations of similar marks for similar goods. This factor thus favors opposer.

Because applicant has yet to use the QUIKSILVEREDITION mark in commerce on or in connection with its various bags and wallets, the *du Pont* factors of the nature and extent of any actual confusion, the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, and the market interface between applicant and the owner of the prior mark are neutral.

We finally consider the similarity of the marks, keeping in mind that when marks would appear on identical goods, as they do here in part, the degree of similarity 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, 1700 (Fed. Cir. 1992). In determining the similarity or dissimilarity of the marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *du Pont*, supra. See also *Palm Bay Imports*,

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Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test 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 their entireties 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. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurant Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

Applicant contends that the differences between the parties' marks are so striking that there is "zero possibility" that the purchasing public might be confused as to source or affiliation. Applicant argues that the parties' marks differ greatly in appearance. Applicant specifically argues that its mark is a composite mark consisting of the dominant term QUIKSILVER and the descriptive term EDITION, and not, as opposer contends, a composite mark consisting of the prefix QUIK and opposer's SILVER EDITION mark. Applicant further argues that because

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QUIKSILVER is a widely recognized mark, is "well-known," and appears at the beginning of applicant's mark, it is the part of applicant's mark most likely to be remembered; and that the EDITION portion of the mark is much weaker, not only because it appears second, but also because it is descriptive. Applicant thus maintains that the visual appearance of QUIKSILVEREDITION emphasizes the QUIKSILVER portion of the mark and de-emphasizes the EDITION portion of the mark, especially due to the lack of space between QUIKSILVER and EDITION.

As previously indicated, applicant's QUIKSILVER marks are not at issue in this proceeding and therefore applicant's arguments and evidence relative thereto have no probative value. On this record, we are not persuaded that purchasers of wallets under applicant's QUIKSILVEREDITION mark would necessarily perceive the term "Quiksilver" as the dominant portion of applicant's mark. The only "evidence" proffered by applicant to support its contention that the term EDITION is descriptive in relation to the parties' goods is the presence of disclaimers in opposer's applications, Serial Nos. 78276782 and 78510140⁶, to register the marks SILVER EDITION and GOLD EDITION, respectively. Such evidence is insufficient to prove

⁶ A copy of this application was introduced as Exhibit 26 to the Winslow deposition.

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descriptiveness, especially since the disclaimer, at least with respect to SILVER EDITION, was required by the trademark examining attorney and, as explained by opposer's witness, Ms. Winslow, opposer sometimes agrees to disclaimers to obtain a registration. (Winslow test. at 69). In the absence of other evidence, we do not consider EDITION a descriptive component of either party's mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("The technicality of a disclaimer ... has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed...").

In addition, applicant's mark QUIKSILVEREDITION incorporates the entirety of opposer's mark SILVER EDITION. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. See *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982); (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and *In re South Bend Toy Manufacturing Company, Inc.* 218 USOPQ 479, 480 (TTAB 1993) (LIL' LADY BUG for toy doll carriages and LITTLE LADY for doll clothing). Although applicant's mark included the prefix QUIK, the term "Silver Edition" is still a recognizable component of its mark. Purchasers familiar with opposer's SILVER EDITION mark for the identical goods, wallets, may focus on that portion of applicant's

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QUIKSILVEREDITION mark. Further, the deletion of the space between the words SILVER and EDITION in applicant's mark does not distinguish applicant's mark from opposer's mark. Simply, put, the differences between the marks, i.e., the addition of the prefix QUIK and the deletion of the space is not enough to make the marks appear dissimilar.

Next, we are not persuaded that the parties' marks differ substantially in sound. Applicant points out that its mark has one more syllable [consisting of the letters "q-u-i-k"] than opposer's mark. However, as there is no correct way to pronounce a particular trademark⁷, and because there is no evidence of record - save applicant's unsupported assertion - as to how the public pronounces applicant's mark, the public may, in fact, pronounce applicant's mark in a manner that highlights "sil" (QUIKS**SILVER**EDITION) as opposed to "quik" (**QUIKS**SILVEREDITION), thus de-emphasizing the presence of the additional letters "q-u-i-k."

We also find applicant's contention that the parties' marks differ in connotation unavailing. Specifically, applicant asserts that the QUIKSILVER portion of its mark is an intentional misspelling of the word "quicksilver," which, according to applicant, is a common name for the element

⁷ See e.g. Kabushiki Kaisha Hattori Tokeiten v. Scutto, 228 USPQ 461 (TTAB 1985).

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mercury. Thus, applicant argues, that when a consumer sees or hears the mark QUIKSILVEREDITION, he or she may relate the mark to mercury. While the term "quicksilver" may be another name for mercury, there is no evidence in the record to show that consumers would be familiar with that meaning. Similarly, applicant asserts, without support, that "when a consumer sees or hears the mark SILVER EDITION, he or she is likely to relate the mark to a level or standard that the goods are second tier." Given the absence of supporting evidence for these assertions, we are not persuaded that it is likely that consumers will appreciate any difference in connotations of the parties' respective marks.

In view of the foregoing, and even assuming that the respective marks may be perceived as having slightly different connotations, we find that the similarity in sound, appearance and overall commercial impression outweigh any such differences in connotation. Accordingly, the *du Pont* factor of similarity of the marks favors opposer.

ADDITIONAL ARGUMENTS

Three additional arguments made by the parties require comment. First, citing, *inter alia*, to *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), applicant contends that it is the owner of Registration No. 3136441 for the mark QUIKSILVEREDITION for goods, including shirts, T-shirts and sweatshirts in Class

25, and that ownership of such registration bars opposer from contesting applicant's current application for bags and wallets.

Opposer, on the other hand, argues that applicant's "Morehouse defense" falls short because it is unpleaded and because the registration involves a different class of goods than those at issue here.

Applicant did not assert the *Morehouse* defense or any other affirmative defenses in its answer. However, as indicated previously, the Board will deem the pleadings to be amended to conform to the proof where an issue has been tried by the implied consent of the parties. See Fed. R. Civ. P. 15(b). In this regard, a review of the record reveals that neither applicant nor opposer presented any evidence on this defense at trial. It was instead raised for the first time in a section of applicant's brief entitled "Opposer is Estopped from Claiming that it Will be Damaged by Registration of QUIKSIVEREDITION in Class 18." Opposer, in its response to the argument, merely points out the procedural and technical failings of the defense. We therefore find that the *Morehouse* defense was not tried by express or implied consent of the parties.⁸

⁸ Even if the defense had been properly pleaded, it would have failed. The *Morehouse* doctrine is an equitable defense to the effect that a plaintiff cannot be injured by the subject application or registration because there already exists an injurious registration and, therefore, an additional (or later)

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Second, opposer has extensively argued that applicant has failed to control the manner of use of the QUIKSILVEREDITION mark on clothing items by its retailers. Inasmuch as applicant's applied-for mark is based on applicant's intent to use the identified bags and wallets in commerce, opposer's arguments regarding applicant's purported failure to control the use of the QUIKSILVEREDITION mark with regard to goods other than those at issue in this proceeding are irrelevant and have not been considered.

Third, and contrary to opposer's position, there is no evidence of any bad faith by applicant in adopting its mark. According to the Bathurst testimony, applicant ultimately selected the QUIKSILVEREDITION mark to more closely

registration for the same mark for substantially identical goods and services does not add to the injury. See *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); and *Morehouse Mfg. v. J. Strickland & Co.*, *supra*. The mark and the goods or services in the prior registration must be "substantially identical" to those in the subject application or registration. See *Jackes-Evans Manufacturing Co. v. Jaybee Manufacturing Corp.*, 481 F.2d 1342, 179 USPQ 81 (CCPA 1973); and *Bausch & Lomb, Inc. v. Leupold & Stevens, Inc.*, 1 USPQ2d 1497 (TTAB 1986). In determining whether the goods are "substantially identical," the *Morehouse* defense requires the goods to be "identical, substantially the same, or so related so as to represent in law a distinction without a difference." *La Fara Importing Co. v. F. Lli de Cecco*, 8 USPQ2d 1143, 1147 (TTAB 1988) (spaghetti sauce and alimentary pastes not substantially the same). Here, while the mark sought to be registered is identical to the mark that is the subject of the prior registration, the goods are clearly different. The prior registration covers clothing items whereas the goods listed in the present application are, though related for purposes of likelihood of confusion, accessory items, namely bags and wallets. In short, the relationship between the goods of the

associate the goods offered thereunder with the goodwill of Quiksilver, Inc. (Bathurst test. at 23, 24, 47-49).

CONCLUSION

We have considered all relevant evidence in this case bearing on the *du Pont* factors and, for the reasons discussed above, conclude that there is a likelihood of confusion between opposer's SILVER EDITION mark and applicant's QUIKSILVEREDITION mark. We conclude so principally because the goods are identical or closely related and the marks are similar in appearance, sound and overall commercial impression.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

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

prior registration and the goods herein does not support a *Morehouse* defense.