

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

PEI Licensing, Inc.
v.
Pro Preferred

Opposition No. 91159028 to application Serial No. 76496993
filed on March 13, 2003

Kimberly Kolback of Sarah Steinbaum, PA for PEI Licensing, Inc.
Kenneth L. Wilton of Seyfarth Shaw LLP for Pro Preferred.

Before Hohein, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Pro Preferred, a California general partnership
consisting of James P. Eaton, Scott Knopf, Daris Toussaint, Glen
Raasch and James E. Zielgler, has filed an application to
register the mark "PRO PREFERRED" and design, as shown below,



for "clothing, namely, caps, headbands, shirts, shorts, socks, sweat pants, sweatshirts, tights, T-shirts, jackets and visors."¹

PEI Licensing, Inc. has opposed registration of applicant's mark, alleging in its amended pleading that "[p]ursuant to ... Registration No. 2401979," which pertains to a stylized letter "P" mark, as illustrated below,



for "men['s], women['s] and children's shirts, jackets and fleece tops,"² opposer "and its predecessors have engaged in the manufacture, sale and/or licensing of a prominent line of clothing ... bearing a stylized P trademark and normally used in conjunction with or associated with Opposer's PRO PLAYER™ trademark (hereafter referred to as 'PEI's Marks')"; that "[o]ver the past several years," opposer "has made a substantial investment in developing, advertising and promoting the sales and goodwill in relation to the PEI's Marks"; that opposer's "customers and the public in general have come to know and recognize PEI's Marks and associate PEI's Marks with Opposer and the goods sold by Opposer"; that the mark which applicant seeks to register and "PEI's Marks ... appear visually similar, are for

¹ Ser. No. 76391287, filed on April 3, 2002, which is based on an allegation of a date of first use of the mark anywhere and in commerce of March 22, 2002.

² Such registration, which issued on November 7, 2000 to Pro Player, Inc., sets forth a date of first use anywhere and in commerce of November 10, 1998.

similar goods and products ..., and [are] potentially marketable to the same consumers in the same channels of trade"; and that applicant's mark "would likely be confused with PEI's Marks ... and would result in niche market dilution of PEI's Marks."³

Applicant, in its answer, has denied the salient allegations of the amended opposition.

The record consists of the pleadings; the file of the involved application; and, as opposer's case-in-chief, the testimony deposition, with exhibits,⁴ of opposer's vice president, Jim Scully.⁵ Applicant did not take testimony or otherwise submit any evidence on its behalf, except for certain exhibits offered during its counsel's cross-examination of Mr.

³ To the extent that opposer may be asserting dilution as a second ground for opposition, it is noted that no evidence with respect to such a claim was presented by opposer at trial and it offered no argument with respect thereto in either its initial brief or its reply brief. Accordingly, and since it is clear from opposer's briefs that it regards the claim of priority of use and likelihood of confusion as its sole ground for opposition, the putative claim of niche market dilution is deemed to be waived and will not be given further consideration.

⁴ It is noted, however, that although described and otherwise referred to in detail in the testimony, opposer apparently did not submit with the transcript of Mr. Scully's deposition the items constituting its Exhibits 2 and 16, which were respectively identified as the annual reports of Perry Ellis International, Inc. for the years 2001 and 2002, and its Exhibits 7-14, which were identified as various garments consisting of several styles of shirts, underwear and a T-shirt.

⁵ While opposer's witness initially testified that he was vice president of Perry Ellis International, Inc. rather than opposer, PEI Licensing, Inc., he corrected his misstatements with respect thereto in his errata sheet filed with the transcript of his deposition. Moreover, later in the course of his deposition, when again asked the name of his employer, he stated that "[m]y employer is Perry Ellis--excuse me, PEI Licensing," to which applicant's counsel indicated that: "We'll stipulate that he works for PEI Licensing, Inc., the opposer in this case." (Scully dep. at 71.) Such confusion by the witness as to his employer, it would seem, may be due to his also being "the head" of the "licensing and marketing department" at Perry Ellis International, Inc. (Id. at 189.)

Scully. Both parties have filed briefs,⁶ but an oral hearing was not requested.

Before turning, however, to the ground of priority of use and likelihood of confusion, there are several matters which should be resolved. Buried in the text of its reply brief, without any heading or other distinguishing title to call attention thereto, opposer sets forth a request that, "if appropriate," its initial testimony period be reopened for the limited purpose of making its sole pleaded registration properly of record. Specifically, in view of the arguments in applicant's brief concerning whether such registration is properly in evidence in that it has been shown to be subsisting and owned by

⁶ Accompanying opposer's 25-page reply brief, and referred to therein, are two appendices. "APPENDIX I" is entitled "OPPOSER'S EVIDENTIARY OBJECTIONS" and consists of two pages, while "APPENDIX II" is entitled "OPPOSER'S RESPONSE TO APPLICANT'S OBJECTIONS" and covers 12 pages. Trademark Rule 2.128(b) provides in relevant part that "[w]ithout prior leave of the ... Board, ... a reply brief shall not exceed twenty-five pages in its entirety." However, as set forth in TBMP §801.03 (2d ed. rev. 2004), which pertains to "Form and Contents of Brief," "appendices to a brief, not being part of the brief itself, are not included within the page limit" and thus as a general rule "evidentiary objections that may be properly raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections." Therefore, while opposer may reply to the evidentiary objections set forth with applicant's brief, as it has done in APPENDIX II, and not run afoul of the 25-page limitation on its reply brief, and could have listed its evidentiary objections in an appendix to its initial brief, failing to raise such objections until the reply brief stage (instead of with or as part of its initial brief) is considered a waiver thereof. Clearly, inasmuch as applicant is not permitted to submit a reply brief, and consequently cannot respond to opposer's evidentiary objections in APPENDIX I, it would be unfair to applicant to allow opposer to raise such objections with its reply brief. No reason is apparent as to why opposer did not assert its evidentiary objections with or as part of its initial brief and it appears, instead, that such objections have been interposed solely in response to applicant's having raised certain objections with its brief. Accordingly, while not in violation of the page limitation imposed by Trademark Rule 2.128(b), no further consideration will be given to the evidentiary objections set forth by opposer in APPENDIX I to its reply brief.

opposer, opposer asserts with respect thereto that (footnote omitted):

[Section] 509.01(b) of the TTAB Manual Of Procedure provides that a party may move to reopen an expired testimony period upon the showing of excusable neglect. Opposer believed and believes that it appropriately pled, introduced and then proved its ownership of Registration No. 2,401,979 during its [initial] testimony period in accordance with the relevant trademark and evidentiary rules. If, however, it is determined that Opposer failed in its task to properly introduce the Registration into evidence, it was not intended, foreseen or an act of bad faith, but the result of excusable neglect, in which Applicant can demonstrate no prejudice. Justice would not be served if this case were not determined on its merits but rather on a procedural deficiency. Therefore, if appropriate, Opposer respectfully moves for the re-opening of its [initial] testimony period so that Opposer may re-introduce Registration No. 2,401,979 in accordance with 37 C.F.R. 1.222(d) [sic].

Opposer's conclusory statement of excusable neglect is insufficient to warrant reopening of its initial testimony period. As provided in TBMP §509.01(b)(1) (2d ed. rev. 2004), "A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient." Here, opposer seeks to reopen its initial testimony period to make of record its pleaded registration by means of a notice of reliance on a copy thereof, prepared by the U.S. Patent and Trademark Office ("Office") and showing the current status of and title to such registration, only if it is determined that the testimony of its witness, and the exhibits with respect thereto, fail to establish that its pleaded

registration is indeed subsisting and owned by opposer.⁷ Having chosen the latter course as one of several possible means for attempting to make its pleaded registration properly of record,⁸ opposer has not shown that it should now be permitted, on the basis of excusable neglect, to utilize another method of introducing such registration simply to attempt to cure any possible deficiencies in its initial effort. The request to reopen is therefore denied. Fed. R. Civ. P. 6(b).

Opposer, in its reply brief, also requests, in response to applicant's arguments in its brief that a second registration upon which opposer attempts to rely was neither pleaded nor made properly of record, that the Board either take judicial notice of such registration, which allegedly issued to opposer during the course of this proceeding,⁹ or alternatively deem the pleadings to be amended, pursuant to Fed. R. Civ. P. 15(b), "to include a claim in relation to rights matured under the newly issued Registration No. 2,901,823." In particular, opposer asserts in support of such request that (footnotes omitted):

⁷ Trademark Rule 2.122(d)(2) provides that: "A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice."

⁸ For a discussion of the various ways a pleaded registration may properly be made of record, see TBMP §704.03(b)(1)(A) (2d ed. rev. 2004).

⁹ Based upon opposer's contentions, the underlying application was filed prior to the January 7, 2004 commencement of this proceeding and matured into a registration just after the October 28, 2004 closing date of opposer's initial testimony period.

Opposer's Application Serial No. 78/325967 was filed on November 11, 2003 in order to re-register its rights to the word mark PRO PLAYER (which had been lost due to the inadvertent cancellation of former Registration Nos. 1,751,335 and 1,897,027 for failure to file a Section 9 [Renewal] Application). This application was still in the processing stage at the time Opposer filed its Amended Notice Of Opposition on February 25, 2004. Yet, Applicant ... contends that Opposer improperly failed to identify Application Serial No. 78/325967 in its Amended Notice. Since no rights in Opposer's pending Application had yet matured, Opposer appropriately excluded the Application from its assertions and properly asserted in paragraph 1 of the Amended Notice, the rights that Opposer did possess at that time, to wit: rights in Registration No. 2,401,979 and common law rights in the PRO PLAYER™ word mark, singularly and in combinations.

Next, Applicant asserts ... that "Opposer did not properly introduce the '823 Registration during its testimony period." At Mr. Scully's deposition, Mr. Scully properly identified and introduced, in accordance with 37 C.F.R. §2.122(d)(2), Application Serial No. 78/325967 as Exhibit 5. At such time, Mr. Scully also testified that Opposer believed that its rights pursuant to the Application had matured and it was simply waiting for the issuance of a registration number. Moreover, pages of testimony confirm that Applicant was prepared to and did, in fact, fully cross-examine Deponent on this Application. For Applicant to suggest that it was surprised or prejudiced by Opposer's assertion of rights under Application Serial No. 78/325967, now Registration No. 2,901,823, at trial is disingenuous.

....

... §704.12 of the TTAB Manual of Procedure provides that the TTAB may take discretionary judicial notice, at any time in a proceeding, of facts which are capable of accurate and ready determination by resort to

sources whose accuracy cannot be reasonably questioned. Opposer properly introduced into evidence during its testimony period the matured Application Serial No. 78/325967 and the fact that Opposer intended to rely on the matured rights thereunder. Applicant had a full and fair opportunity to defend as to this Application. The fact that Registration No. 2,901,823 has now been assigned to Serial No. 78/325967 is capable of accurate and ready determination by resort to reliable USPTO sources, namely the USPTO website. Accordingly, Opposer respectfully requests that TTAB take judicial notice that Registration No. 2,901,823 has now been issued to Application Serial No. 78/325967

In the alternative, Rule 15(b) of the Federal Rules of Civil Procedure provides that:

If evidence is objected to at the trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleadings to be amended and shall do so freely when the presentation of the merits of the action will be subserved thereby and objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's action or defense upon the merits

.... No party can deny that Opposer has rights pursuant to the newly issued Registration No. 2,901,823, or that the rights and defenses related thereto were litigated prior to this trial. The merits of this action will [not] be undoubtedly subserved if the free amendment of the pleadings to include these rights is not permitted. Because Applicant has had the full opportunity to defend against these rights, it is unable to satisfy the TTAB that the admission of such evidence would prejudice the Applicant's defense upon the merits. Therefore, if appropriate, Opposer respectfully requests that the TTAB allow the pleadings to this proceeding to be amended to include a claim in relation to rights matured

under the newly issued Registration No. 2,901,823.

Opposer's request is denied. As a general proposition, the Board does not take judicial notice of applications or registrations which reside in the Office and are not the subject of a proceeding. See, e.g., *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). Rather, applications or registrations which are not the subject of a proceeding must be made of record in accordance with the Trademark Rules of Practice, as indicated in TBMP §704.03(b) (2d ed. rev. 2004). See, e.g., *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991). However, as noted in TBMP §704.03(b)(1)(A) (2d ed. rev. 2004),¹⁰ while the Board, where an application or registration of a plaintiff has been properly pleaded and introduced at trial, will confirm and update the status thereof at final hearing through a check of Office records, opposer did not plead in its amended notice of opposition any allegation of ownership and/or intention to rely upon its then-pending application Serial No. 78/328967 for the mark "PRO PLAYER" *per*

¹⁰ Such section specifies in pertinent part that:

[W]hen a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and the status of the registration changes between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the Office.

See, e.g., *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1654 at n. 7 (TTAB 2002); *Ultratan Suntanning Centers Inc. v. Ultra Tan Int'l AB*, 49 USPQ2d 1313, 1314 at n. 6 (TTAB 1998); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB 1979); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846, 847 at

se, which assertedly has since matured into Reg. No. 2,901,823. Instead, opposer solely pleaded its "stylized letter 'P' mark" as used singularly and "in conjunction with or associated with Opposer's PRO PLAYER™ trademark (... referred to as 'PEI's Marks')." Such failure to allege a likelihood of confusion between applicant's mark and the "PRO PLAYER" mark alone, and the attendant unfair surprise to applicant, see, e.g., *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884-85 (TTAB 1993), constitute sufficient reason to deny opposer's request to take judicial notice thereof, notwithstanding that applicant's counsel asserted only generalized objections with respect to the introduction of Opposer's Exhibit No. 5, which Mr. Scully identified as "the PRO PLAYER application" (Scully dep. at 16) and consists of a printout from Office records of status information, as of October 26, 2004, with respect to opposer's then-pending application.

Further, in its brief, applicant has in any event objected to consideration of such registration, arguing among other things that to do so at this juncture would deprive it of "the chance to file a counterclaim attacking the validity of that registration." Noting, in particular, that "[i]t has long been the law that a Section 1(a) application in which the subject mark has not been used in commerce prior to the filing date [thereof] is void *ab initio*" (citations omitted), applicant points out that when, on cross examination, "Mr. Scully was asked about the use

n. 5 (TTAB 1978); and *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 80 at n. 3 (TTAB 1979).

of the 'PRO PLAYER' mark on each of the goods listed in the application that apparently matured to the '823 Registration," he "went on to admit, unequivocally, that Opposer was not using the 'PRO PLAYER' mark in commerce on or in connection with leotards ..., swim trunks ..., socks ..., sports bras ..., headwear ... or footwear ... when the application was filed on November 11, 2003."

While also noting that on redirect examination, opposer "tried to rehabilitate Mr. Scully through a series of questions relating to the listed goods and elicited vague responses that the goods had been 'offered' to third parties," applicant contends that opposer "failed to ask Mr. Scully whether the 'PRO PLAYER' mark itself had been used on the ... leotards, swim trunks, socks, sports bras, headwear or footwear to which he testified." Applicant, in particular, stresses that "[e]ven assuming [that] this vague testimony of 'offering' might have salvaged the registration," Mr. Scully's final comment "cemented its doom" when he presented "clear testimony that, under any circumstances, Opposer has *not* used the 'PRO PLAYER' mark on or in connection with headgear, and was not using it for those goods when the application was filed," such that "its registration should be cancelled." Applicant argues, moreover, that because such registration "had not issued as of the time of Mr. Scully's deposition, Applicant does not concede that the issue of the existence, ownership or validity of the '839 Registration was tried, but asserts that if amendment of the pleadings is allowed pursuant to Fed. R. Civ. P. 15(b), "the Board should deem

Applicant's Answer to be amended to include counterclaims under Sections 1(a) and 45 of the ... Trademark Act based upon Opposer's non-use [sic] of the 'PRO PLAYER' mark in commerce prior to the filing date of its use-based application." No fee for any counterclaim, however, has been tendered.

Fed. R. Civ. P. 15(b), as made applicable by Trademark Rule 2.116(a), provides in pertinent part that:

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 conform to the evidence and to raise these issues may be made upon motion of any party at any time If evidence is objected to at the trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleadings to be amended and shall do so freely when the presentation of the merits of the action will be subserved thereby and the objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's action or defense upon the merits.

With respect thereto, TBMP §507.03(b) (2d ed. rev. 2004) provides in relevant portion that (footnotes omitted):

When issues not raised by the pleadings are tried by the express or implied consent of the parties, ... the Board will treat them in all respects as if they had been raised in the pleadings. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time ..., but failure to so amend will not affect the result of the trial of these issues.

Implied consent to the trial of an unpleaded issue can be found only where the

nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.

Aside from the fact, as indicated previously, that applicant's counsel raised generalized objections to the introduction of evidence pertaining to opposer's anticipated registration of the mark "PRO PLAYER," the testimony by Mr. Scully during questioning on cross-examination by applicant's counsel conclusively establishes that opposer had made no use of such mark for many of the identified goods prior to both the filing date and registration date. Consequently, even if the opposition were deemed to be amended to include a subsisting registration by opposer for the mark "PRO PLAYER" for various items of apparel, the prima facie presumptions which, pursuant to Section 7(b) of the Trademark Act, attach to the registration, including the validity of the registered mark and the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods specified in the certificate of registration, have been effectively rebutted.

Therefore, allowing opposer to add Reg. No. 2,901,823 to its pleaded ground for opposition would be futile inasmuch as such registration is basically of no evidentiary value for purposes of priority and likelihood of confusion. See, e.g., Reed Tool Co. v. Litton Industrial Products, Inc., 225 USPQ 880, 881 (TTAB 1985); Airport Canteen Services, Inc. v. Farmer's Daughter, Inc., 184 USPQ 622, 626 (TTAB 1974) [although a "[p]arty to cancellation proceeding may not challenge validity of

registration of adverse party in absence of petition to cancel registration; ... when there is conclusive evidence that registered mark was not used at time application was filed or for a number of years thereafter on or in connection with goods recited in registration, Board can refuse to accord any evidentiary value to registration in determining question of likelihood of confusion or question of prior rights"]; and Gates Rubber Co. v. Western Coupling Corp., 179 USPQ 186, 189-90 (TTAB 1973).

Furthermore, deeming the pleadings to be amended in the manner requested by opposer would not result in the presentation of the merits of this action being subserved thereby. As opposer essentially concedes in its initial brief, it is not the "PRO PLAYER" mark itself which applicant's mark most resembles and thus would be most likely to cause confusion with; rather, as opposer maintains in its initial brief, applicant's mark is most likely to cause confusion with those composite marks, which opposer pleaded in the amended notice of opposition, that consist of its stylized letter "P" mark used variously in conjunction with the mark "PRO PLAYER" (underlining in original):

But what makes Applicant's mark particularly confusing with Opposer's marks is Applicant's use of a large stylized P with the words PRO PREFERRED. This combination of a large stylized P used with two words, the first being PRO and the second starting with a P, clearly impersonates Opposer's P PRO PLAYER combinations wherein a large stylized P is used in combination with the word PRO followed by the second word which also starts with a P.

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Opposer, as to "this disturbing combination," likewise basically admits in its reply brief that: "It is Applicant's combined use of a stylized P in front of the word PRO and then followed by a second word starting with the letter P that is confusingly similar to Opposer's marks, particularly the P PRO PLAYER combinations."

Inasmuch as we agree with opposer that if confusion is likely, it would most likely occur from contemporaneous use of applicant's mark for articles of clothing and opposer's use of a composite mark that consists of its stylized letter "P" mark and the words "PRO PLAYER" for items of apparel, there is simply no reason to permit amendment of the pleadings in order to add an extraneous allegation of likelihood of confusion between applicant's mark for its goods and the registered mark "PRO PLAYER" itself for all of the goods set forth in opposer's asserted registration of such mark. Instead, to the extent that opposer may have demonstrated, through the testimony of Mr. Scully and the exhibits thereto, any prior common law rights in the "PRO PLAYER" mark in combination with its stylized letter "P" mark, it may rely thereon without the need for the pleadings to be deemed to have been amended to include a likelihood of confusion claim based on the "PRO PLAYER" mark *per se*.

Finally, there remains the matter of opposer's insistence in the testimony of Mr. Scully and in its briefs of referring to a "family of PRO PLAYER marks" consisting of its

stylized letter "P" mark, its "PRO PLAYER" mark,¹¹ and various combinations of such marks, which it lumps under the designation "P PRO PLAYER marks." Applicant has objected, both during the taking of Mr. Scully's deposition and in its brief, to opposer's collective characterization of such marks as a "family of PRO PLAYER marks," arguing that aside from the asserted fact that opposer "failed to prove that it markets these marks together as a family," by definition "[t]here is no need to belabor the fact that these marks cannot be part of a family, given that there is no 'common characteristic' or 'common element' in each of them."

Opposer, in its reply brief, acknowledges that "[w]hile this case is not the garden variety 'Mc' family of marks," it nonetheless asserts that it "believes that it has fully argued and justified its position as to why the P, PRO PLAYER and P PRO PLAYER marks constitute a family," arguing that:

The fact that the common elements of the two registered [P (stylized) and PRO PLAYER] marks are often used, displayed and advertised together, to wit: marks that display the common element of the stylized P ... or marks that display the common element of the word mark PRO PLAYER ... -- results in the public associating all such marks with Opposer and leading Opposer to characterize its marks as a family."

¹¹ While opposer also includes reference to the mark "PRO PLAYER TOUR" as one of its "PRO PLAYER" marks, and Mr. Scully testified with respect thereto, no further consideration will be given to the mark "PRO PLAYER TOUR" since not only was such mark not pleaded, either separately or as part of a composite mark which includes opposer's stylized letter "P" mark, but in any event it is obvious that the "PRO PLAYER TOUR" mark is more dissimilar to applicant's mark than would be the mark "PRO PLAYER" itself. Hence, if there is any likelihood of confusion, it would be between, as noted previously, applicant's mark and the combination of opposer's stylized letter "P" mark and the words "PRO PLAYER."

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The term "family of marks," however, is a term of art in trademark law. As explained in *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991), a case which opposer even cites in its briefs:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

Suffice it to say that not only does the record herein fail to contain sufficient evidence to show that applicant has in fact developed any "family of marks" as such term is defined in trademark law, but applicant is indeed correct that there can be no "family of marks" which includes, on the one hand, opposer's stylized letter "P" mark and, on the other hand, opposer's "PRO PLAYER" mark inasmuch as such marks plainly contain no common element or characteristic as a "family" feature. Specifically, as set forth in *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983), in order to establish the existence of a family of marks:

[I]t must be shown by competent evidence, first, that ... the marks containing the claimed "family" feature, or at least a substantial number of them, were 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; and second, that the "family" feature is distinctive (i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as a distinguishing feature of any party's mark).

Here, applicant has not submitted sufficient evidence that it has promoted any of its claimed marks together in such a way as to create a family of marks. The most that applicant has done, instead, is merely to demonstrate that it owns a stylized letter "P" mark which it has variously used in conjunction with its "PRO PLAYER" mark, but such use alone, without proof of conjoint promotion thereof, is an inadequate basis on which to predicate the existence of a family of marks having a stylized letter "P" as the recognized family member. See, e.g., Hester Industries, Inc. v. Tyson Foods, Inc., 2 USPQ2d 1646, 1647 (TTAB 1987); Consolidated Foods Corp. v. Sherwood Medical Industries Inc., 177 USPQ 279, 282 (TTAB 1973); Polaroid Corp. v. American Screen Process Equipment Co., 166 USPQ 151, 154 (TTAB 1970); and Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419, 421 (CCPA 1965). Accordingly, we sustain applicant's objection to opposer's assertion of a "family of PRO PLAYER" marks and will not further consider such assertion.

Turning now to the merits of this case,¹² while the principal issues to be determined would otherwise be which party has priority of use and, if priority of use were to lie with opposer, whether there is also a likelihood of confusion, we need not decide the issue of priority of use. This is because even assuming, without deciding, that opposer has priority of use, we find that contemporaneous use of applicant's "P PRO PREFERRED" and design mark for its items of clothing is not likely to cause confusion with any of opposer's marks for articles of apparel, including the mark which opposer contends, and we concur, is the most similar to applicant's mark, namely, opposer's stylized letter "P" mark as used to the left of and immediately adjacent to its "PRO PLAYER" mark so as to form a composite "P PRO PLAYER" and design mark.

According to the record, opposer is a holding company for trademark and licensing agreements, and is a wholly-owned subsidiary of Perry Ellis International, Inc. ("Perry Ellis"), which designs, produces and sells various men's, women's and children's apparel. In particular, Mr. Scully maintains that opposer "owns all the Perry Ellis trademarks," including ownership of various "PRO PLAYER" marks, which Perry Ellis

¹² Other than applicant's hearsay objections with respect to Opposer's Exhibits 2 and 16 and the testimony with respect thereto, we will not burden this opinion with rulings on each of the host of "EVIDENTIARY OBJECTIONS" set forth and discussed in a separate attachment to applicant's brief. Not only are many of such objections not well taken, but most appear to be interposed solely as pedantic exercises since, even if the evidence objected to were to be excluded, applicant has not demonstrated how the disposition of this proceeding would be different. Suffice it to say that to the extent evidence is discussed herein which has been objected to by applicant as being inadmissible,

"purchased from Fruit of the Loom in July of 2000" and assigned to opposer "in May, 2002." (Id. at 8-9.) Moreover, as shown by Opposer's Exhibit 4, opposer is also the owner, by an assignment from Perry Ellis to opposer dated May 16, 2002, of its pleaded registration for a stylized letter "P" mark, namely, Reg. No. 2,401,979, which issued on November 7, 2000 for "men['s], women['s] and children's shirts, jackets and fleece tops." No information as to the current status of such registration, e.g., whether it is subsisting, was furnished, however, either in Mr. Scully's testimony or by documentary exhibit(s). Mr. Scully, during his testimony, variously referred to such mark as the "PP" mark, the "Pro Player icon" and the "PP icon" (id. at 13-14) and did so repeatedly. In addition, opposer is also the owner of a pending application to federally register the mark "PRO PLAYER" for "clothing and accessories, namely, swimsuits, jackets, shorts, leotards, ... swim trunks, casual shirts, shorts, workout pants, warm-up shirts and suits, cover-ups, socks, sport bras, sweatshirts, sport shirts, headwear and footwear." Such application has been published for opposition and, since no opposition thereto has been filed, a registration is expected to issue according to Mr. Scully.

Opposer, as noted by Mr. Scully, uses its stylized letter "P" mark and its "PRO PLAYER" mark "in a variety of ways":

What we do is we use the PP, which is actually the Pro Player icon, in conjunction with the name Pro Player.

immaterial or irrelevant, such objections are overruled and the evidence has been considered for its appropriate probative value.

Sometimes the Pro Player icon or the PP is on top and Pro Player is on the bottom and other times we use it where the Pro Player and the PP icon appears to the left and the Pro Player icon is horizontal in terms of the letters.

Sometimes we use the PP icon separately and apart from the words Pro Player.

(Id.) Moreover, as an example of the use of the "PRO PLAYER" mark by itself, Mr. Scully pointed to its use on the sign or marquee for Pro Player Stadium in Miami, which is the home field for both the Miami Dolphins professional football team and the Florida Marlins professional baseball team. Among other things, Mr. Scully claims that the "PRO PLAYER" mark has designated a line of clothing since the debut thereof in 1982.

Mr. Scully testified, in particular, to use of the stylized letter "P" and "PRO PLAYER" marks, pursuant to alleged licensing agreements, in connection with various articles of clothing. Specifically, in addition to the separate use of opposer's stylized letter "P" mark on certain clothing items and accompanying hang tags, he noted with respect thereto that:

(i) a shirt (Opposer's Exhibit 7) "sold by one of the licensees" displays "the University of North Carolina logo" and has "inside the garment ... a woven label indicating the PP and the words Pro Player underneath" and also bears "a point of sale hang tag which identifies the word[s] Pro Player on the left and the PP to the right." (Id. at 24-25.);

(ii) a knit shirt (Opposer's Exhibit 8) "features the Ohio State University Buckeyes" and has "the Pro Player woven label inside which features on the top the PP icon and underneath the words 'Pro Player'" in addition to bearing "the same [hang tag] as the previous shirt which shows the Pro Player

brand in words with the PP icon." (Id. at 25-26.);

(iii) a "woven short" (Opposer's Exhibit 9) "features the North Carolina insignia" and "on the inside ... it shows a Pro Player label, with the PP and the words 'Pro Player' on the bottom" as well as "another hang tag ... that features[,] ... to the right of the words 'Pro Player,' the PP." (Id. at 27-28.);

(iv) a polo or golf shirt (Opposer's Exhibit 10) "on the inside features a Pro Player PP as well as the Pro Player words underneath." (Id. at 28.);

(v) a short sleeved knit shirt (Opposer's Exhibit 11) "on the outside ... features Ohio State, and ... there is ... a point of sale hang tag which has Pro Player with a PP." (Id. at 29.);

(vi) an item of "Pro Player Performance underwear" (Opposer's Exhibit 12) features "[o]n the inside ... a Pro Player label with the PP icon as well at [sic] the words 'Pro Player'." (Id. at 30.);

(vii) a "bike short" (Opposer's Exhibit 13) features "on the inside ... the Pro Player PP icon as well as the Pro Player words ... underneath that." (Id. at 32.); and

(viii) another item of "Pro Player Performance underwear" (Opposer's Exhibit 14) "features the Pro Player PP icon as well as the words 'Pro Player.'" (Id. at 33.)

Neither opposer nor its parent Perry Ellis directly manufacture their own apparel products. Instead, such products are produced by contractors and Supreme International, a subsidiary of Perry Ellis, under licenses granted by opposer. Opposer, as of the October 28, 2004 closing date of its initial testimony period, had the following licensees according to Mr. Scully, although no actual license agreement was ever offered to

corroborate his testimony: Knight's Apparel, which has been a licensee since April 2000; Knot Apparel Corp., which has been "a licensee of active-wear garments" starting in 2004; Meridian, which has been "a hosiery licensee" since May 2001; Retro-Active, which has been an "active-wear" licensee since July 2001; and Supreme International, which is "a wholesale division which also produces Pro Player garments." (Id. at 34.) In addition, opposer is "working on a number of agreements" by which it intends to license its pleaded marks for use in connection with belts, eyewear, hosiery, golf towels, golf umbrellas, golf accessories, watches, headwear and women's wear. (Id.) The "heritage" of the PRO PLAYER" mark, as Mr. Scully also testified, "basically was sports inspired and active-wear inspired" and is used "predominately to create products that are sports-related" for both men and women. (Id. at 35-36.) Opposer thus intends to expand "the brand into any sporting category." (Id. at 40.)

Opposer's "PRO PLAYER" products are advertised on billboards, in print and "extensively through the media," with spending by Perry Ellis for all of the marks held by opposer (and not just those pleaded in the notice of opposition)¹³ totaling in excess of \$7 million in 2000, over \$8 million in 2001 and more than \$7.5 million in 2002.¹⁴ (Id. at 41.) Opposer also claims

¹³ According to Mr. Scully, advertising expenditures are not broken down by brands.

¹⁴ Although applicant's counsel objected to such amounts as hearsay in that Mr. Scully was reading those figures from a Perry Ellis annual report, the objection is overruled inasmuch as the record establishes that the information falls within the hearsay exception which pertains to records of regularly conducted business activity. Fed. R. Evid. 803(6).

annual expenditures on trade shows of approximately \$1 million. In addition, opposer considers the name of Pro Player Stadium, including the marquee or prominently displayed sign thereon, to be a "large marketing tool" in that "the games are being broadcast [on radio] and telecast [on television,]" resulting in additional exposure of the public to the "PRO PLAYER" mark. (Id. at 49.) Opposer's "PRO PLAYER" mark is also advertised and promoted on a website specifically dedicated to such brand, namely, www.proplayer.com, which (as shown in Opposer's Exhibit 17) displays in several instances opposer's stylized letter "P" mark centered immediately above its "PRO PLAYER" mark so as to form a composite mark.

Opposer's apparel items retail on average for between \$20 to \$50. It's "PRO PLAYER" brand of products are sold at such department stores and specialty retailers as "JC Penneys," "Sports Authority," "Sears," "Kohl's," "Meiyers," "M.C. Sports," "Dix," "Big 5," "Beaals," "Mervyn's" and "Schel's." (Id. at 58-59 and 61.) Opposer also claims that it markets its products "at the stadium," although no elaboration thereof was provided.¹⁵ (Id. at 64.) According to its witness, "total sales of Pro

¹⁵ Opposer's witness testified as follows:

Q Do you market your products at the stadium?

A Yes, we do.

Q Either you or your licensee?

A Yes.

(Scully dep. at 64.)

Player was approximately \$15 million in retail," although no time frame was indicated for such sales. (Id. at 66.)

On cross-examination, however, Mr. Scully conceded that with respect to the garments introduced as Opposer's Exhibits 7-14, he did not know when such items were manufactured and that the items were just samples. While he was able to testify that the University of North Carolina shirt (Opposer's Exhibit 7) was manufactured under a license with Knight's Apparel, he conceded that such shirt could have been produced in 2004 inasmuch as he did not know how long that particular shirt had been sold. The same was true, he admitted, with respect to the Ohio State University knit shirt (Opposer's Exhibit 8) and the University of North Carolina woven short (Opposer's Exhibit 9) insofar as, while both were manufactured pursuant to a license with Knight's Apparel, he did not know when such goods were made or how long such styles had been for sale. In short, although Mr. Scully testified that opposer's license with Knight's Apparel began in April 2001, he did not know if such garments were being sold as of April 2001. Similarly, with respect to the other Ohio State shirt (Opposer's Exhibit 11), he confirmed that while such was made by Knight's Apparel under license, he conceded that he did not know how long such company had been selling such product, in that "[i]t could have been 2004" or "[t]hey could have sold it in 2002. We don't know." (Id. at 89.)

As to the polo or golf shirt (Opposer's Exhibit 10), Mr. Scully noted that it was produced by Supreme International "within the last three months," that is, after August 2004, and

stated that it was currently being sold. (Id. at 87.) He qualified the latter statement, however, to indicate that such sales had not been at the retail level and were instead only orders for such goods for delivery in the upcoming spring season:

Q If I'm a retail customer, I could order this?

A Well, they've been given presentations by our sales force.

Q Not a retailer, a retail consumer. Would a retail consumer see this shirt?

A What do you mean by a retail consumer?

Q Johnny Consumer --

A No. A retail consumer would not yet see the shirt.

Q So it is not currently in the marketplace.

A It is not currently in the marketplace.

(Id. at 87-89.) Similarly, with respect to the underwear (Opposer's Exhibits 12 and 14) and bike short (Opposer's Exhibit 13), Mr. Scully noted that such garments, which were produced under license by Knote Apparel, were available to the retail consumer as of August 2004, but only at JC Penney stores, and that no underwear garments were available for retail purchase prior thereto.

Furthermore, Mr. Scully indicated on cross-examination that Meridian, even though previously stated to be a hosiery licensee since May 2001, is not in fact a current licensee inasmuch as the license it held to manufacture socks terminated

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in 2002 (although it had six months thereafter to continue selling any surplus stock). No other hosiery licenses have been granted since such termination. Likewise, while he previously testified that Retro-Active was an active-wear licensee since July 2001, he admitted on cross-examination that such license ended in 2002 (although it had an additional six months to sell any surplus inventory). Such company, he further noted, is not currently manufacturing goods and was not doing so in 2003 either. In addition, while opposer is presently negotiating a licensing agreement for a line of belts, no belts are currently being sold under the "PRO PLAYER" brand.

Moreover, as of the date of his testimony, Mr. Scully confirmed that opposer does not sell any goods which are specifically for women only; rather, its currently available products for women, as set forth in its pleaded registration for its stylized letter "P" mark, consist of products which he characterized as "generic, neutral." (Id. at 93.) In addition, as to the products listed in its application for registration of the mark "PRO PLAYER," Mr. Scully testified, when asked item by item (with the exception of various shirts, shorts, workout pants, warm-up suits and cover-ups) whether such mark is currently in use in connection therewith, that the mark was not presently being used, and in fact it had either not been used or he did not know whether it had been used as of the November 11, 2003 filing date, with respect to swimsuits, leotards, swim

trunks, socks, sports bras, headwear and footwear.¹⁶ The only item on cross-examination to which Mr. Scully could testify that opposer's "PRO PLAYER" mark was in use on, of the items of apparel listed in the application for registration, was jackets, although on redirect examination he also stated that casual shirts, shorts, workout pants, warm-up suits and cover-ups were "[i]n the market" as of the application filing date.¹⁷ (Id. at 173.) Consequently, while he could not say for sure how many different retailers were selling "PRO PLAYER" brand products in either 2001 or 2002, he insisted that such goods were in retail stores during those years and maintained that, in particular, the Sports Authority was selling such merchandise through a license in 2003.

On cross-examination, Mr. Scully confirmed that the advertising figures testified to earlier in his deposition relate to expenditures for all brands advertised by Perry Ellis and thus does not know what amount would be attributable to spending on the "PRO PLAYER" brand. He also conceded, with respect to his earlier assertion of a promotional benefit to the "PRO PLAYER" line of clothing from the display of the "PRO PLAYER" mark as the name of a stadium used by professional sports teams, that such benefit was limited at best:

¹⁶ On redirect examination, however, he explained that such goods had been "offered" or "shown" to retailers in 2002 and 2003, but gave no indication that the goods were actually in stores for retail sale or otherwise had been sold in a bona fide commercial manner. (Id. at 171-75.)

¹⁷ As to sweatshirts and sports shirts, however, he testified on redirect examination only to the fact that such goods, respectively, "are presently in stores" and are "[i]n the stores." (Id. at 174.)

Q When sports broadcasters are calling a game and they use the words "Pro Player," they're usually referring to the stadium, correct?

A Well, yes.

Q Have you ever heard of Pro Player clothing when they call a Dolphin game?

A No.

Q So if I was not familiar with the Pro Player brand as a brand for clothing and I was listening to a Dolphin game and I was hearing the broadcaster refer to Pro Player Stadium, I wouldn't know that it was a clothing brand?

....

[A] Right.

(Id. at 126-27.) He also acknowledged, with respect to the website specifically dedicated to the "PRO PLAYER" brand, namely, www.proplayer.com, that he did not know how long such website had been advertising and promoting the availability of "PRO PLAYER" garments at JC Penney, although he noted that such goods first became available there in August 2004. In addition, he confirmed that such website, as indicated by the printouts thereof for the dates of May 11, 2004, December 31, 2003 and as far back as October 18, 2000 (Applicant's Exhibits 5, 6 and 7, respectively), was "under construction" on those dates, even though, as shown by the printout thereof for the date of July 13, 2004 (Applicant's Exhibit 4), the website was promoting underwear under the composite "PRO PLAYER" and stylized letter "P" mark as of such date.

As to whether Mr. Scully knew of any incidents of actual confusion, he testified on cross-examination as follows:

Q Are you aware of any instances of actual confusion in the marketplace between the Pro Preferred mark and any ... Pro Player mark?

A The only confusion that [I] am aware of is your web site causes confusion around here, within the company.

Q Within your company?

A Yes.

Q Any confusion outside of your company?

A Not to my knowledge.

(Scully dep. at 159.) The level of sophistication of the ultimate purchasers of opposer's "PRO PLAYER" branded products, he maintained, consists of "a combination" of impulse shoppers and careful buyers. (Id.)

Finally, while applicant introduced on cross-examination instances of third-party uses of, in particular, a "Wilson Women's Pro Player Skirt" advertised in a "Tennis Warehouse" website (Applicant's Exhibit 9) and a "b-line Pro Player Polo" offered for sale in a "bowling.com" website (Applicant's Exhibit 10), Mr. Scully simply acknowledged that such goods were not "PRO PLAYER" branded products by opposer or its licensees. No information, however, was provided as to the extent of such third-party uses.

There is very little information of record concerning applicant and its activities. Basically, the record reveals that applicant has a website, www.propREFERRED.com, which advertises

and offers for sale various styles of shirts and shorts under the mark "PRO PREFERRED" as well as a mark very similar to the "P PRO PREFERRED" and design mark opposed herein (but with a partial second letter "P" immediately adjacent to a stylized letter "P" with a star design). Such goods are marketed with the slogan or tag line "What the Pro's Prefer, and the Pro's of Tomorrow Wear!" (Opposer's Exhibit 18.) Applicant (as shown by Opposer's Exhibit 19, which actually refers to an entity named "Pro-Preferred, LLC") also appears to promote a variety of styles of shirts and shorts in a brochure, likewise using the very similar mark noted above but not its involved mark. Based upon the prices listed in the brochure, Mr. Scully remarked that the goods "look to be between twenty and forty dollars" and thus would sell for essentially the same price points as opposer's similar products. (Scully dep. at 54.) Mr. Scully testified that the respective goods are commercially related, noting that:

Well, we're all selling ... the same kind of products here. It's all active sportswear and related products. We're all selling products we've already established within the same price range.

(Id. at 70.)

Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether there is a likelihood of confusion herein, we find, as indicated previously, that contemporaneous use of applicant's "P PRO PREFERRED" and design mark for its items of clothing is not likely to cause confusion with any of opposer's marks for articles of apparel,

including the mark which is the most similar to applicant's mark, namely, opposer's stylized letter "P" mark as used to the left of and immediately adjacent to its "PRO PLAYER" mark so as to form a composite "P PRO PLAYER" and design mark. To be sure, such relevant *du Pont* factors as (i) the similarity or dissimilarity and the nature of the respective goods, and (ii) the similarity or dissimilarity in their established, likely to continue trade channels, clearly favor opposer. Specifically, opposer's goods are either identical in part (e.g., shirts and jackets) or otherwise commercially related to applicant's goods, as set forth in the involved application, and the respective goods would consequently share the same channels of trade. Plainly, as testified to by Mr. Scully, opposer's items of apparel and applicant's articles of clothing are "all active sportswear and related products" which would sell "within the same price range" (*id.*) through not only the parties' respective websites but also, given the absence of any stated restrictions or implicit limitations in the identification of applicant's goods, would be available through such identical retail trade channels as the apparel sections of department and specialty stores. Applicant, moreover, admits in its brief that, in any event, "the goods at issue are concededly similar."

In addition, a third relevant *du Pont* factor favors opposer, at least to a degree. In particular, as to the factor of the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing, to the extent that the parties' goods, while not "impulse" items, have

nonetheless been shown to be relatively inexpensive items of active sportswear in the \$20 to \$40 price range, ordinary consumers would typically not be expected to exercise a great deal of care or sophistication in their purchases of such apparel and thus any likelihood of confusion would be increased.¹⁸ Of the remaining pertinent *du Pont* factors, however, one clearly favors applicant, two others are inapplicable and, in view of the failures of proof with respect thereto, the rest simply do not favor opposer. On balance, we find for the reasons explained below that there is no likelihood of confusion.

The relevant--and determinative--*du Pont* factor, which is in applicant's favor, is the similarity or dissimilarity of the respective marks in their entireties as to appearance, sound, connotation and commercial impression. Focusing our attention, for this purpose, on the mark of opposer which, as noted above, arguably most closely resembles applicant's mark, we nonetheless find that such marks differ significantly in all respects. Opposer, in its initial brief, nevertheless contends that "there exists [sic] strong similarities in appearance, sound, connotation and commercial impression between Opposer['s] and Applicant's marks." Among other things, opposer insists that (footnote omitted):

Opposer's marks and Applicant's mark are undeniably similar in sound and particularly

¹⁸ By contrast, if the price range of the parties' goods were higher, such factor would tend to favor applicant inasmuch as even ordinary consumers would be expected to be more discriminating and careful in their purchasing decisions, which would thereby lessen any likelihood of confusion.

appearance. Both PRO PLAYER and PRO PREFERRED start with the dominant first word "PRO". This word is spelled identically and pronounced the same. The word PRO is then followed by an unmemorable second word beginning with the letter "P"--that being the word PLAYER in relation to opposer's marks and PREFERRED in relation to the Applicant's mark.

Asserting, as mentioned earlier in this opinion, that "what makes Applicant's mark particularly confusing with Opposer's marks is Applicant's use of a large stylized P with the words PRO PREFERRED" (underlining in original), opposer urges that "[t]his combination of a large stylized P used with two words, the first being PRO and the second starting with a P, clearly impersonates Opposer's P PRO PLAYER combinations wherein a large stylized P is used in combination with the word PRO followed by the second word which also starts with a P." Opposer therefore maintains that:

Under such circumstances, confusion will not be avoided by Applicant's insubstantial change of PLAYER to PREFERRED as the second word of its mark. This second word is not a dominant, distinguishing or even memorable feature in relation to the overall appearance(s) of the parties' marks.

Moreover, as to the connotation and commercial impression engendered by the respective marks, opposer argues in its initial brief that (footnote omitted):

The word PRO is short for Professional. *Webster's II, New Riverside Dictionary*, Office Edition (2002).

Evidence introduced in this case demonstrates that Opposer uses its mark[s] on sportswear and active wear. In relation to these goods, the ... marks denote clothing designed for the professional or serious athlete or player of sports. This connotation is bolstered by Opposer's

association with and exposure from the ...
PRO PLAYER Stadium located in Miami, Florida.

Goods identified in Applicant's Application ... reveal that Applicant also uses and intends to use its mark on sportswear and active wear. Ergo, the commercial impression relayed by P PRO PREFERRED is clothing designed or preferred by the professional or serious athlete. There is no unique or distinct connotation or commercial impression relayed by changing the word PLAYER to PREFERRED. The word PREFERRED is merely suggestive, and does not alleviate the likelihood of confusion.

Because the commercial impression portrayed by both marks is the same, the average consumer, with its general, rather than specific recollection of trademarks, is not going to distinguish the origin of the marks. If anything, the public is likely to believe that P PRO PREFERRED goods are simply a specialized or "preferred" line of the P PRO PLAYER products

Clearly, this crucial factor, coupled with the similarity in appearances of the parties' marks, escalates the likelihood of confusion among the marks.

We concur with applicant, however, that the respective marks are readily distinguishable when considered in their entirety. In particular, far from being an "unmemorable" or otherwise "insubstantial change," as characterized by opposer, the word "PREFERRED" in applicant's "P PRO PREFERRED" and design mark differs appreciably and meaningfully in sound, appearance, connotation and commercial impression from the word "PLAYER" in opposer's "P PRO PLAYER" and design mark. In view thereof, and given the distinct differences in the stylization of the letter "P" in each mark, including the star design in applicant's mark and the outer band or arc in opposer's mark, it is obvious that,

other than their structural similarities, the sole similarity between the respective marks lies in the word "PRO," as preceded by a stylized letter "P" and followed by a common word which begins with the letter "P."

As a general proposition, if a mark is composed of both word and design elements, it is usually the word portion which is the dominant element,¹⁹ since such would be used by prospective consumers to call for or otherwise refer to the associated goods. See, e.g., Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192, 1197 (TTAB 1994); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). In a similar vein, it is generally the case that the dominant word in a mark is often at the beginning, or the first word, of a mark inasmuch as such is the portion that consumers are most likely to remember. See, e.g., Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994); and Presto Products, Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). Here, however, the word "PRO," which opposer concedes "is short for Professional,"²⁰ is highly suggestive of the parties' goods,

¹⁹ Opposer, in a footnote to its initial brief, correctly points out that the "dominant portion of a mark is the portion that the consumer is more likely to remember in relation to a mark," citing Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994).

²⁰ Although opposer failed to make its cited definition of the word "pro" of record, it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v.

as further shown by the plethora of third-party registrations for marks containing such word (Applicant's Exhibit 2), and thus, because of its frequent adoption as a component of marks, the mere fact that applicant's and opposer's marks share the common, highly suggestive word "PRO"--even as the first word of the literal elements of the respective marks--is considered an insufficient basis to support findings that it is the dominant portion of each of such marks and hence that confusion would be likely. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) [while third-party registrations are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use, they may be given some weight to show the meaning of a mark in the same way that dictionaries are used].

Moreover, the literal elements of applicant's and opposer's marks, namely, "PRO PREFERRED" and "PRO PLAYER," plainly are not the same nor are they even appreciably similar in sound, appearance, connotation or commercial impression, given

American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981). Accordingly, we have considered such definition and, in addition, we judicially notice that The American Heritage Dictionary of the English Language (4th ed. 2000) at 1397 defines "pro" as an adjective meaning "professional: *pro football*" and as an "informal" noun meaning "1. A professional, especially in sports. 2. An expert in a field of endeavor." The same dictionary lists "professional" at 1400 as an adjective signifying "1a. Of, relating to, engaged in, or suitable for a profession: *lawyers, doctors and other professional people*. b. Conforming to the standards of a profession: *professional behavior*. 2. Engaging in a given activity as a source of livelihood or as a career: a *professional writer*. 3. Performed by persons receiving pay: *professional football*. 4. Having or showing great skill; expert: a *professional repair job*" and as a noun connoting "1. A person following a profession, especially a learned profession. 2. One who earns a living in a given or implied occupation: *hired a professional to decorate the house*. 3. A skilled practitioner; an expert."

that the words "PREFERRED" and "PLAYER" have essentially nothing in common other than that both start with the letter "P." In particular, the literal element of applicant's mark, "PRO PREFERRED," is highly suggestive of sportswear and active-wear products which are the preference of professionals, while that of opposer's mark, "PRO PLAYER," is highly suggestive of sportswear and active-wear products which are designed for someone who plays professionally. Furthermore, while especially the case with applicant's mark, although also true to a significant degree as to opposer's mark, the disproportionately large stylized letter "P" is the portion of each of the respective marks which visually is the most prominent, and thus the dominant, feature thereof. In this regard, it is additionally the case that the stylization of the letter "P" in applicant's "P PRO PREFERRED" and design mark, including the prominent star element, looks nothing like the stylization of the letter "P" in opposer's "P PRO PLAYER" and design mark, including the outer band or arc feature, which arguably creates--as repeatedly referred to by Mr. Scully in his testimony--a "PP" or double letter "P" design which further distinguishes the marks at issue. Cumulatively, the significant dissimilarities in such marks in sound, appearance, connotation and commercial impression result in marks which overall are strikingly different and readily distinguishable, thereby precluding a likelihood of confusion.

Admittedly, inasmuch as there is no evidence that applicant has actually used the mark which is the subject of this

proceeding, the *du Pont* factors of the nature and extent of any actual confusion and the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion are, strictly speaking, inapplicable. With respect to the *du Pont* factor of the number and nature of similar marks in use on similar goods, applicant, referring to the evidence made of record with, *inter alia*, Applicant's Exhibits 1, 2, 9 and 10, argues in its brief that during Mr. Scully's deposition, it "introduced evidence of hundreds of third[-]party registrations for various stylized 'P' design marks and marks which include a 'PRO' component for clothing items in International Class 25" as well as evidence of "actual third[-]party uses of stylized 'P' design marks, 'PRO' marks, and even other marks using 'PRO PLAYER.'" Applicant, in particular, maintains that through the testimony of its witness, opposer "admitted that it was aware" of such third-party uses, "[y]et those ... uses, by Opposer's own admission, present no likelihood of confusion." Applicant contends that "[t]here can be no question, therefore, that this factor favors Applicant."

It appears that the gist of such contention is that marks which include a stylized letter "P," the word "PRO" or even the term "PRO PLAYER" are weak marks which are entitled only to a narrow scope of protection because consumers have become so accustomed to encountering marks with such features that they will look to and distinguish marks with those characteristics by the differences therein. Likewise, according to applicant, consumers would so distinguish its "P PRO PREFERRED" and design

mark. The problem with such an argument, at least with respect to applicant's reliance on the marks which are the subjects of the third-party registrations (Applicant's Exhibits 1 and 2), is that it is well settled that third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the subject marks. See, e.g., National Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). The reason therefor is that third-party registrations simply do not show that the marks which are the subjects thereof are actually being used, or that the extent of their use is so great that customers have indeed become accustomed to seeing the marks and hence have learned to distinguish them. See, e.g., Smith Brothers Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). The third-party registrations relied upon by applicant thus fail to support its argument since, as indicated in AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973):

[L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them 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.

On the other hand, while the evidence which applicant introduced of two third-party uses of the term "PRO PLAYER" is troubling, in

the absence of any indication as to the extent of such usages, it cannot be said that the *du Pont* factor of the number and nature of similar marks in use on similar goods favors applicant, but clearly such factor does not favor opposer either. In short, this factor is neutral.

Finally, opposer urges that confusion is nonetheless likely because its marks, including its "P PRO PLAYER" and design mark, are famous. As noted by our principal reviewing court in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992), "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." The Federal Circuit reiterated these principles in *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), stating that "the fifth *DuPont* factor, fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *DuPont* factors," *citing, inter alia, Kenner Parker Toys*, 22 USPQ2d at 1456, and reaffirmed that "[f]amous marks thus enjoy a wide latitude of legal protection." Recognizing, however, that "[d]irect evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion," the Federal Circuit has also stated, as the parties observe in their main briefs, that "the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time

those indicia of commercial awareness have been evident." Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

In support of its contention of fame, opposer notes in its initial brief that, among other things, its witness testified that "total sales of Pro Player was approximately \$15 million in retail." (Scully dep. at 66.) However, as pointed out earlier in this opinion, no time frame was indicated for such sales, so there is no way of knowing whether the total sales are for a recent year, represent all sales since the claimed introduction of the brand in 1982 or just since the asserted first use of the "stylized P and P PRO PLAYER combinations" in 1996, or pertain to sales for some other period of time.²¹ It is also highly questionable, in light of Mr. Scully's testimony, as to exactly what--if any--items of clothing, other than perhaps jackets, have actually been sold under opposer's "PRO PLAYER" marks. He also conceded, in this regard, that he could not say for sure how many different retailers were selling "PRO PLAYER" brand products in either 2001 or 2002, even though he insisted that such goods were in retail stores during those years and maintained that, in particular, the Sports Authority was selling such merchandise through a license in 2003. Opposer's evidence regarding sales of

²¹ Although opposer, in footnote 11 of its main brief, has requested that the Board "take judicial notice pursuant to TBMP §704.12 of the official NASDAQ website" for Perry Ellis' "total revenues" for 2004, we fully agree with applicant that, as indicated in footnote 22 of its brief, such judicial notice is plainly inappropriate.

"PRO PLAYER" merchandise, in short, is manifestly insufficient to demonstrate fame.

Opposer, as further evidence of fame, points to advertising expenditures by Perry Ellis for all of the marks held by opposer (and not just those pleaded in the notice of opposition) totaling in excess of \$7 million in 2000, over \$8 million in 2001 and more than \$7.5 million in 2002. In addition, opposer notes that such sums do not include expenditures for trade shows, which run approximately \$1 million annually, nor do such amounts include advertising by licensees. Although opposer consequently asserts that "these total marketing expenses are immense," Mr. Scully admitted that such advertising and promotional expenditures are not broken down by brand and, thus, there is simply no way to determine the amounts expended in connection with opposer's "PRO PLAYER" marks, including its "P PRO PLAYER" and design mark. Moreover, although no argument with respect thereto appears in opposer's initial brief, even assuming that opposer's advertising and promotional expenditures include advertising through its www.proplayer.com website, Mr. Scully nonetheless conceded that he did not know how long such website had been advertising and promoting the availability of "PRO PLAYER" garments at JC Penney. He noted, instead, only that such goods first became available at such retailer in August 2004 and the record, in addition, shows July 13, 2004 as the earliest date that opposer's www.proplayer.com website was promoting underwear under the "P PRO PLAYER" and design mark. Accordingly, opposer's evidence concerning its advertising and promotional expenditures

for its "PRO PLAYER" marks is inadequate to establish fame, even when viewed in conjunction with its evidence regarding sales of such products.

Nevertheless, and "[m]ost significant," according to opposer, "is the evidence that the Opposer and its predecessor have received tremendous exposure since 1996 through their association with the ... PRO PLAYER stadium located in south Florida," which among other things has hosted numerous professional and other sporting events. Opposer argues in its initial brief that, "[n]ot only are each of these events seen annually by million of viewers across the country, [but] the ... PRO PLAYER marks receive extensive radio and print exposure when each event is advertised, mentioned, reported or broadcast." Opposer insists, in consequence thereof, that "[t]he goodwill generated from this association alone has made the ... PRO PLAYER marks famous." However, as its witness admitted, any benefit from such association has been limited at best, with consumers being unlikely, unless they were otherwise familiar with the "PRO PLAYER" line of clothing, to know from references to Pro Player Stadium (either from televised or print images of the marquee thereon or in broadcasts of a game) that "PRO PLAYER was also a clothing brand. In sum, we agree with applicant that opposer has failed to present any evidence sufficient to support a claim of fame. Such *du Pont* factor, therefore, does not favor opposer.

Accordingly, notwithstanding those *du Pont* factors which favor opposer, given the showing that the goods at issue are commercially related, travel in the same channels of trade

and may be purchased by some consumers without the exercise of much care or deliberation, we find on this record that, even assuming that opposer has priority of use, there is no likelihood of confusion from the contemporaneous use by applicant of its "P PRO PREFERRED" and design mark in connection with "clothing, namely, caps, headbands, shirts, shorts, socks, sweat pants, sweatshirts, tights, T-shirts, jackets and visors" and the use by opposer of any of its "PRO PLAYER" marks, including its "P PRO PLAYER" and design mark, for its various articles of clothing including "men['s], women['s] and children's shirts, jackets and fleece tops." This is because the *du Pont* factors which favor opposer are decisively outweighed by the *du Pont* factor of the dissimilarities of the marks at issue in their entireties, which favors applicant, due to the significant differences in sound, appearance, connotation and commercial impression between the respective marks, especially in light of the failure of proof by opposer with respect to its claim of fame. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) [Board, in finding no likelihood of confusion between mark "CRYSTAL CREEK" for wine and marks "CRISTAL" for wine and "CRISTAL CHAMPAGNE" for champagne, did not err in relying solely on dissimilarity of marks in evaluating likelihood of confusion and failing to give surpassing weight to other *du Pont* factors, all of which favored a likelihood of confusion; court noted that "we have previously upheld Board determinations that one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially

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when that single factor is the dissimilarity of the marks"]; and Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) [Board, in finding no likelihood of confusion between mark "FROOTEE ICE" and elephant design for packages of flavored liquid frozen into bars and mark "FRUIT LOOPS" for, *inter alia*, cereal breakfast food, correctly held that "a single *duPont* factor--the dissimilarity of the marks--was dispositive of the likelihood of confusion issue"; court observed that "[w]e know of no reason why, in a particular case, a single *duPont* factor may not be dispositive"].

Decision: The opposition is dismissed.