

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

George H. Zoes
v.
Brett Shevack

Opposition No. 91161124
to application Serial No. 78296792
filed on September 5, 2003

Anastassios Triantaphyllis of Triantaphyllis Law Firm for
George H. Zoes.

Cynthia L. Stewart of Frost Brown Todd LLC for Brett
Shevack.

Before Hohein, Holtzman, and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Brett Shevack filed an intent-to-use application for
the mark BORN IN TEXAS, in standard character form, for the
following goods and services, as amended:

Men's, women's and children's clothing,
namely, T-shirts, jackets, shirts,
sweatshirts, hats, caps, sweat pants,
coats, shoes, boxer shorts, underwear,
shorts, sleepwear, socks, sweaters and
necktie, in Class 25; and,

Arranging and conducting sports
competitions of others; entertainment in

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the nature of stickball tournaments, softball tournaments, handball tournaments, punch ball tournaments, skully tournaments, basketball tournaments, and film festivals; arranging and conducting athletic competitions, street fairs, live music events and concerts, class reunions, special events in the nature of organizing art exhibitions and live theatre performances; audio production services; production of television programs; television show production, live performances by a musical band, live performances by a rock group, music production services, night clubs, discotheques, in Class 41.¹

George H. Zoes opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion alleging the following as his basis for opposition:

1. Opposer is the owner of application Serial No. 76512168 for the mark TEXAS BORN TEXAS PROUD for the following products:²
 - A. "printed matter, posters and flyers, bumper stickers, and shopping bags," in Class 16;
 - B. "picture frames and plastic key rings," in Class 20;

¹ Application Serial No. 78296792, filed September 5, 2003.

² On February 1, 2005, after the filing of the opposition, the mark TEXAS BORN TEXAS PROUD registered as Registration No. 2,922,037. Opposer, as to all the goods and services, claimed a date of first use anywhere of January 30, 2001 and a date of first use in commerce of June 15, 2003. The list of goods set forth in the Notice of Opposition by opposer *supra* is not an exact copy of the goods set forth in opposer's application or registration. Finally, we note that opposer never sought to amend the Notice of Opposition to plead ownership of the registration. However, as discussed *infra*, opposer did not properly make his registration of record.

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- C. "cups, dishes and china," in Class 21;
 - D. "clothing, namely t-shirts, hats, belts, caps, blouses, "shirts, shorts and jackets," in Class 25; and,
 - E. "promotion of Texas and Western heritage, namely dissemination of Texas historical information," in Class 41;
- 2. Opposer has been using its mark on the above-identified products prior to the filing date of applicant's application; and,
 - 3. Applicant's mark BORN IN TEXAS, if used in connection with the goods and services set forth therein, so resembles opposer's mark TEXAS BORN TEXAS PROUD, as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant denied the pertinent allegations in the Notice of Opposition.

The case has been fully briefed.

The Record

By operation of the rules, the record includes the pleadings and the application file of the mark sought to be registered.³ The record also includes testimony and other evidence introduced by the parties, as set forth below.

A. Opposer's evidence.

1. Opposer introduced the testimony deposition of George H. Zoes with attached exhibits, including a soft copy of opposer's registration;

³ Because the pleadings and the application file are part of the record by operation of the Trademark Rules of Practice, the submission of these documents in opposer's notice of reliance was unnecessary.

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2. Opposer also filed a notice of reliance on the following documents:

- a. A soft copy of opposer's Registration No. 2,922,037 for the mark TEXAS BORN TEXAS PROUD;
- b. Four (4) declarations from attendees at the February 24-26, 2005 Houston Livestock Show and Rodeo testifying that they received TEXAS BORN TEXAS PROUD bumper stickers and pins, and that they were happy to have these items because "I was born in Texas";⁴
- c. "Applicant's Answers To Opposer's First Set Of Interrogatories";
- d. Applicant's Responses to Opposer's First Request For Production Of Documents Requests For Production";
- e. Opposer's "Response To Applicant's First Set Of Interrogatories";
- f. Opposer's "Response To Applicant's Request for Production Of Documents"; and,
- g. Opposer's "Supplemental Response To Applicant's First Set of Interrogatories."⁵

⁴ The declarations were also introduced as Zoes Deposition Exhibit 4.

⁵ Responses to a request for production of documents, a party's own answers to interrogatories, and declarations by third parties are not generally admissible through a notice of reliance. Trademark Rules 2.10(j)(3)(ii) and (j)(5). However, since both opposer and applicant identified such documents as part of the record and neither party objected to the admission of the documents, the parties have impliedly stipulated to the admission of those documents. See Trademark Rule 2.123(b). Accordingly, we will consider them for whatever probative value they may have.

B. Applicant's evidence.

1. Applicant submitted a notice of reliance on certified copies showing status and title of the following registrations owned by applicant:

- a. Registration No. 2,860,793 for the mark BORN IN THE BRONX for men's, women's, and children's clothing;⁶
- b. Registration No. 2,553,864 for the mark BORN IN BROOKLYN for men's, women's, and children's clothing;⁷

2. Applicant also filed a notice of reliance on the following:

- a. "Applicant's Answers To Opposer's First Set of Interrogatories"; and,
- b. "Applicant's Supplemental Answers To Opposer's First Set of Interrogatories" which consists only of the "Affidavit Of Cynthia L. Stewart" regarding the purchase of the following items:
 1. "Born Texan and Proud of It," "Texas Born," and "Born & Raised Texas Made" t-shirts from cafeexpress.com;
 2. A "Texas Born and Raised" t-shirt from mytexasstore.com; and,
 3. A "Texas Born Texas Bred" t-shirt from amazon.com.

⁶ Registration No. 2,860,793, issued July 6, 2004. Applicant claimed March 2, 2004 as its dates of first use and first use in commerce. Applicant disclaimed the exclusive right to use "Bronx."

⁷ Registration no. 2,553,864, issued March 26, 2002. Applicant claimed August 18, 2001 as its dates of first use and first use in commerce. Applicant disclaimed the exclusive right to use "Brooklyn."

3. Finally, applicant introduced the testimony deposition of Brett Shevack with attached exhibits.

With respect to the copy of opposer's registration introduced into evidence through both his notice of reliance and the Zoes deposition, opposer did not submit a certified copy or other copy showing the status of and title to the registration. The copies of the registration attached to opposer's deposition and his notice of reliance are, instead, merely soft copies of the registration. More significantly, Mr. Zoes did not testify as to the current status or ownership of the registration.⁸ Therefore, having failed to make his pleaded registration properly of record for purpose of this proceeding, opposer must rely on his common law use of his mark to prove his priority.⁹ Trademark Rule 2.122(d), 37 CFR 2.122(d). See *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978).

Applicant introduced the following third-party registrations of variations of the "Born In _____" mark

⁸ Mr. Zoes testified that the mark was still in use.

⁹ We note that although applicant acknowledged that opposer introduced the registration into evidence, applicant did not otherwise reference the registration or treat it of record. Also, having failed to amend the Notice of Opposition to plead ownership of his registration, opposer failed to provide applicant with sufficient notice of his reliance on the registration.

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through the Brett Shevack deposition.¹⁰ However, Mr. Shevack did not conduct the searches. It was the witness' understanding that the trademark registrations were printed from the U.S. Patent and Trademark website.¹¹

Reg. No.	Mark	Goods
2678431	BORN IN THE USA	Men's and boy's clothing and purses, wallets, handbags, duffel bags, and luggage
2863258	BORN IN THE USA	Motorcycles and structural parts therefore
3058399	AMERICAN BORN	Clothing, namely, shirts, t-shirts, tops and bottoms, hats
2901958	BORN IN AMERICA	Clothing, namely jackets, sweaters, vests, sweat shirts, sweat pants, shirts, blouses, t-shirts, pants, shorts, skirts, "skorts", dresses, hats and shoes
2890103	B.I.G. BORN IN GEORGIA	Children's clothing, namely shirts, sweatshirts, dresses and baby bibs not made of paper

Applicant also introduced the following web pages promoting the sale of t-shirts through the Brett Shevack deposition. Mr. Shevack did not conduct the searches from which the web pages were obtained.¹²

¹⁰ Applicant also sought to introduce third-party applications through the Shevack deposition. However, the only inference that may be drawn from an application is that it was filed.

¹¹ Shevack Dep., pp. 30 and 39.

¹² Shevack Dep., p. 40.

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1. A webpage from Custom Diggity at cafepress.com/customdiggity selling clothing featuring the state of Texas and the words "Texas Born";
2. A webpage from affordabletess.com selling t-shirts and sweatshirts featuring a dog in the back of a pick-up truck and the words "TEXAS BORN TEXAS BRED";¹³
3. A webpage from texasstore.com selling a t-shirt featuring the Texas flag and the words "Texas Born & Raised"; and,
4. A webpage from the University of Texas catalog featuring a baby romper with the design of a longhorn cow and the words "Born to be a Longhorn".

Opposer did not object to the third-party registrations or the third-party web pages. In fact, in his brief, opposer referenced the web pages to show that applicant and opposer sell their products through the same channels of trade, including the Internet.¹⁴ We consider opposer's references in his brief to applicant's third-party registrations and web pages as opposer's implied stipulation to the admissibility of that evidence.¹⁵

Findings Of Fact

A. Opposer

Opposer adopted the mark TEXAS BORN TEXAS PROUD to convey that the consumers using the products were proud to

¹³ This same t-shirt was advertised at amazon.com.

¹⁴ Opposer's Brief, p. 26.

¹⁵ In any event, the third-party registrations appear to be authentic and would be admissible as official records.

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have been born in Texas.¹⁶ At the February 2005 Houston Livestock Show & Rodeo, opposer distributed stickers and hatpins featuring the mark TEXAS BORN TEXAS PROUD. The products were favorably received as evidenced by comments such as "These are great, I was born in Texas."¹⁷

Opposer testified that he exhibited TEXAS BORN TEXAS PROUD bumper stickers, picture frames, and coffee mugs at a trade show in Denver and Dallas in 2001¹⁸ and that he has continued exhibiting TEXAS BORN TEXAS PROUD products at trade shows from 2002 through 2005.¹⁹ Opposer has been continuously using the mark in commerce since June 2003²⁰ on picture frames, notepads, bumper stickers, coffee mugs, luggage tags, hat pins, t-shirts, baby clothes, key chains, money clips, and shot glasses.²¹ Opposer also hands out brochures promoting the state of Texas.²²

The TEXAS BORN TEXAS PROUD trademark is placed on the products in the following manner:

[o]n our T-shirts the mark would be silk-screened either in the brown logo we have or in other designs we're working on. Our clothing, it would be affixed to items like hats or jackets as

¹⁶ Zoes Dep., p. 5.

¹⁷ Zoes Dep., pp. 11-12; Exhibit 4.

¹⁸ Zoes Dep., pp. 29 and 31. Subsequently, on cross-examination, opposer confirmed that he introduced TEXAS BORN TEXAS PROUD products in 2001. Zoes Dep., pp. 45-46, 47, and 52.

¹⁹ Zoes Dep., pp. 32-33.

²⁰ Zoes Dep., pp. 5-6; Opposer's Response to Interrogatory No. 11.

²¹ Zoes Dep., pp. 7-8; Exhibit 2.

²² Zoes Dep., pp. 8-9. Mr. Zoes testified that he first used the TEXAS BORN TEXAS PROUD mark in connection with the Class 41 services in June of 2003. Zoes Dep., p. 6.

embroidery work. On ceramic mugs it is actually baked on the mugs. It's a label that's baked on to it to make them dishwasher safe. Some other items are cast out of metals and other items are stamped into leather.²³

Opposer is planning on expanding his TEXAS BORN TEXAS PROUD line of products to include baby bibs, socks, hats, teething cups, and pacifiers, children's socks, and birth certificates and birth announcements.²⁴

Opposer sells its TEXAS BORN TEXAS PROUD products through wholesale channels (*i.e.*, directly to stores through trade shows), through the Internet, and through a retail store in opposer's warehouse.²⁵ Also, opposer sells his products at retail trade shows during the Christmas season.²⁶

The TEXAS BORN TEXAS PROUD products are impulse purchases.

Q. What is a typical Internet buyer?

A. Typical Internet buyer, I would say most of them are - - a lot of them are impulse buyers. They go through Web sites. Most of these people will either know about a Web site and find it based on the entry points which Yahoo gives us and most will impulse buy. A lot of them are native Texans searching for Texas products specifically.²⁷

²³ Zoes Dep., p. 9.

²⁴ Zoes Dep., pp. 10-11.

²⁵ Zoes Dep., p. 14.

²⁶ Zoes Dep., p. 14.

²⁷ Zoes Dep., p. 17.

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Opposer's advertising is primarily through trade shows and by mailing catalogs to customers.²⁸ However, opposer also places an advertisement in the *Texas Parks & Wildlife* magazine at the beginning of hunting season.²⁹

Opposer estimates his total sales of TEXAS BORN TEXAS PROUD products are \$75,000 to \$100,000.³⁰

B. Applicant

During the 1986 New York Marathon, applicant wore a t-shirt with "Born In Brooklyn" written across the chest. The t-shirt generated a very positive response from the race fans lining the streets, and the applicant thought that this could be a brand. Thus, the idea of "Born In Brooklyn," and born in other places was created.³¹ The "Born In _____" concept allows "people to feel for themselves what their attachment is to the place they were born."³²

On April 26, 2000, applicant filed an application for the mark BORN IN BROOKLYN for clothing.³³ On January 22, 2002, applicant filed an application for the mark BORN IN THE BRONX for clothing.³⁴ On June 8, 2004, applicant filed the application at issue for the mark BORN IN TEXAS. While

²⁸ Zoes Dep., p. 29.

²⁹ Zoes Dep., pp. 34-35.

³⁰ Zoes Dep., p. 37.

³¹ Shevack Dep., p. 4; Exhibit 5.

³² Shevack Dep., p. 16.

³³ Notice of Reliance.

³⁴ Notice of Reliance.

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applicant has filed over 20 applications for various "BORN IN _____" trademarks, he is only using BORN IN BROOKLYN and BORN IN THE BRONX.³⁵ Applicant has been continuously selling BORN IN BROOKLYN t-shirts, banners, and hats since 2001.³⁶

Applicant provided further testimony regarding his business model, which presumably describes how applicant intends to sell all of his "Born In ____" products and services, including BORN IN TEXAS. Applicant is currently using his marks on t-shirts, hats, coffee mugs, bumper stickers, and postcards³⁷ with plans to expand to jackets, bags, sweatshirts, coats, boxer shorts, baby apparel, infant apparel, and children's apparel.³⁸ Applicant sells his BORN IN BROOKLYN and BORN IN THE BRONX products through the Internet, street fairs, and retail stores.³⁹

Applicant has advertised on different Internet websites, and at one time sponsored the Brooklyn Cyclones minor league baseball team. Also, applicant uses meta-tags to attract hits from search engine searches.⁴⁰

Applicant applies his marks to the exterior of the products and on labels and hangtags.⁴¹

³⁵ Shevack Dep., pp. 4-5.

³⁶ Shevack Dep., pp. 7-8.

³⁷ Shevack Dep., p. 9.

³⁸ Shevack Dep., p. 9.

³⁹ Shevack Dep., pp. 5-6.

⁴⁰ Shevack Dep., pp. 11-13.

⁴¹ Shevack Dep., pp. 14 and 27.

Standing

Opposer, through its testimony and related exhibits, has established with respect to his claim of priority of use and likelihood of confusion that he uses the mark TEXAS BORN TEXAS PROUD in connection with picture frames, notepads, bumper stickers, coffee mugs, luggage tags, hat pins, t-shirts, baby clothes, key chains, money clips, shot glasses, and brochures promoting the state of Texas. Inasmuch as opposer's mark is at least arguably similar to applicant's mark, there is thus no issue with respect to opposer having proven his standing to prosecute the opposition.

Priority

The first key issue in this case is the question of priority of use.

Applicant's application was filed on September 5, 2003. Applicant testified that he has not yet used the mark BORN IN TEXAS.⁴² Therefore, the earliest date upon which applicant can rely for purposes of this opposition is September 5, 2003, the filing date of his application. *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 36 USPQ2d 1328, 1332 (TTAB 1998), quoting *Alliance Manufacturing Co., Inc. v. ABH Diversified Products, Inc.*, 226 UPSQ 348, 351 (TTAB 1985) ("an applicant is entitled to rely upon the filing date

⁴² Shevack Dep., pp. 4-5.

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of its application as a presumption of use of the mark subject of the application as of that date").

To prevail on his claim of priority of use and likelihood of confusion, opposer must prove that he has a proprietary interest in the mark TEXAS BORN TEXAS PROUD prior to the filing date of applicant's intent-to-use application. Section 2(d) of the Lanham Act, 15 U.S.C. §1057(d); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 UPSQ2d 1542 (TTAB 1991).

Opposer testified that he first used the TEXAS BORN TEXAS PROUD trademark on bumper stickers, picture frames, and coffee mugs at trade shows in Dallas and Denver in 2001.⁴³ He further testified that he first used the mark on additional products, including t-shirts and baby clothes, as well as promoting the state of Texas, as of June 2003.⁴⁴ June 2003 is prior to the September 5, 2003 filing date of applicant's application. Oral testimony, even of a single witness, if "sufficiently probative," may be sufficient to prove priority. *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965)); *4U Co. of America, Inc. v. Naas Foods, Inc.*, 175 UPSQ 251, 253 (TTAB 1972). We find that Mr. Zoes' testimony is credible and it

⁴³ Zoes Dep., pp. 29, 31, 45-47, and 52.

⁴⁴ Zoes Dep., pp. 5-8.

has not been contradicted. Accordingly, Mr. Zoes' testimony satisfies opposer's burden of proof in showing, by a preponderance of the evidence, that opposer has priority of use in connection with picture frames, notepads, bumper stickers, coffee mugs, luggage tags, hat pins, t-shirts, baby clothes, key chains, money clips, shot glasses and promoting the state of Texas.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

At the outset, we note that applicant is seeking to register his mark BORN IN TEXAS for clothing in Class 25 and entertainment services in Class 41. For the purposes of our likelihood of confusion analysis, applicant's two-class application is treated as two separate applications. *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1456 (TTAB 1998). That is to say, we will make separate determinations as to likelihood of confusion between opposer's mark TEXAS BORN TEXAS PROUD for the goods and services on which the testimony shows that the mark has been used and applicant's

mark BORN IN TEXAS for the goods and services set forth in his application.

A. Men's, women's, and children's clothing, in Class 25.⁴⁵

1. The similarity or dissimilarity of the goods.

Opposer has been using his marks on a wide variety of consumer products, including hatpins, t-shirts and baby clothes. The goods of both parties include t-shirts. If applicant's children's clothing does not encompass opposer's baby clothes, the two are certainly related products. Accordingly, the similarity or dissimilarity of the goods is a factor that weighs in favor of finding a likelihood of confusion.

2. The similarity or dissimilarity of established, likely-to-continue trade channels.

Opposer sells his TEXAS BORN TEXAS PROUD products through wholesale channels (*i.e.*, directly to stores through trade shows), through the Internet, and through a retail store in opposer's warehouse.⁴⁶ Opposer also sells his

⁴⁵ Opposer introduced no evidence or made any arguments that applicant's use of BORN IN TEXAS for clothing so resembles TEXAS BORN TEXAS PROUD for promoting the state of Texas as to be likely to cause confusion. Accordingly, we will focus our analysis on clothing *per se*, and we find that applicant's use of BORN IN TEXAS for clothing would not so resemble TEXAS BORN TEXAS PROUD for promoting the state of Texas as to be likely to cause confusion.

⁴⁶ Zoes Dep., p. 14.

products at retail trade shows during the Christmas season.⁴⁷ Opposer described these trade shows as follows:

Usually they're held either in convention centers, church halls, schools. We'll put on retail shows for their community and all the items are sold at retail prices and not at wholesale prices.⁴⁸

By the same token, applicant testified that he sells his BORN IN BROOKLYN and BORN IN THE BRONX products through the Internet, street fairs, and retail stores.⁴⁹ Presumably applicant introduced this testimony because he intends to sell his BORN IN TEXAS products in the same channels of trade. The evidence clearly demonstrates that the products of the parties move in similar channels of trade. Therefore, this factor favors finding a likelihood of confusion.

3. The conditions under which and buyers to whom sales are made (i.e., impulse vs. careful, sophisticated purchasing).

As demonstrated above the goods of the parties are sold to all classes of consumers, including ordinary consumers. Moreover, the clothing sold by both parties is inexpensive: opposer's t-shirts cost \$16 and "onezies" cost \$15⁵⁰ while

⁴⁷ Zoes Dep., p. 14.

⁴⁸ Zoes Dep., p. 20.

⁴⁹ Shevack Dep., pp. 5-6.

⁵⁰ Zoes Exhibit 5.

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applicant's t-shirts cost \$20.⁵¹ Opposer further testified that his products were "impulse purchases."⁵² This is not surprising since the parties both testified that their consumers purchase the products to proclaim their birthplace, rather than as a fashion statement. Accordingly, we find that the classes of consumers and the degree of consumer care is a factor that favors a finding of likelihood of confusion.

4. The number and nature of similar marks in use on similar goods.

Referencing the third-party registrations for variations of the "Born in ___" trademarks and third-party web pages selling variations of "Born in Texas" clothing, applicant argues that "the novelty clothing market is saturated with examples of uses of some combination of 'BORN' and 'TEXAS' on products to the point that consumers have by necessity become extremely discriminating"⁵³ and that "consumers are accustomed to distinguishing among the many different providers of clothing and similar products on the basis of even the slightest differences between these designations."⁵⁴

⁵¹ Shevack Exhibit 5.

⁵² Zoes Dep., 17.

⁵³ Applicant's Brief, p. 10.

⁵⁴ Applicant's Brief, p. 11.

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Third-party registrations, absent evidence of actual use of those marks, are entitled to little weight on the question of likelihood of confusion. Third-party registrations are not evidence of use of the marks shown therein. Without evidence of use, the third-party registrations prove nothing about the impact of the third-party marks on purchasers in terms of conditioning consumers as to the existence of similar marks in the marketplace. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-286 (TAB 1983). Third-party registrations may, of course, have probative value in the manner of dictionary definitions to show that a term has significance in a particular industry.

Accordingly, to the extent that the registrations have any probative value, they indicate that clothing distributors use trademarks to proclaim a consumer's birthplace (e.g., BORN IN THE U.S.A., AMERICAN BORN, BORN IN AMERICA, etc.).

The third-party web pages, on the other hand, do not support applicant's argument that consumers have become discriminating or that consumers have become accustomed to distinguishing among the many providers of "Born in Texas" style clothing. We note that the third-party web pages display the "Born in Texas" slogan as ornamentation, not necessarily as a trademark. The "Born in Texas" slogans are

placed in the middle of the shirts. Moreover, some of the web pages identify the source of the clothing such "Custom Diggity," "Texas Shirt Company," and "My Texas Store.com."⁵⁵ Contrary to applicant's argument, the web pages demonstrate that third parties use the "Born in Texas" slogans as ornamental designs and that consumers select a t-shirt to proclaim where they were born,⁵⁶ with or without regard to the source of the product.

In view of the foregoing we find that the number and nature and similar marks in use on similar goods is a factor that slightly favors a finding that there is no likelihood of confusion.

5. Evidence of Actual Confusion.

Opposer's contention that people at the February 2005, Houston Livestock Show & Rodeo who were happy to receive his hatpins and stickers because they were "born in Texas" is evidence of actual confusion is specious. The exclamations that they were "born in Texas" is simply a statement of fact motivated by their receipt of opposer's clever promotional give-away. There is no evidence of actual confusion.

⁵⁵ Shevack Exhibit 7.

⁵⁶ To the extent that applicant is arguing that opposer's use of TEXAS BORN TEXAS PROUD is merely ornamental and not a trademark, that issue was neither pleaded as an affirmative defense or counterclaim to cancel (had opposer amended its Notice of Opposition to claim ownership of its registration), nor was it

Therefore, this is a neutral factor in the likelihood of confusion analysis.

6. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co., supra.* We note at the outset that as the degree of similarity of the goods of the parties increases, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In this case, the goods are, in part, identical.

In a particular case, any one of the bases for comparison (*i.e.*, appearance, sound, connotation, or commercial impression) may be critical in finding the marks to be similar. In addition, it is a well-established principle that, in articulating the reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a

tried by express or implied consent. Therefore, any such

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consideration of the mark in their entirety." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Opposer's mark TEXAS BORN TEXAS PROUD and applicant's mark BORN IN TEXAS share and stress the concept of "born in Texas." Opposer adopted the mark TEXAS BORN TEXAS PROUD to convey that the consumers using the products are proud to have been born in Texas.⁵⁷ Opposer achieved his intent as evidenced by the customer comments such as "These are great, I was born in Texas."⁵⁸ Likewise, applicant adopted BORN IN TEXAS for a similar reason (*i.e.*, to allow "people to feel for themselves what their attachment is to the place they were born")⁵⁹. This is a matter of some importance in our analysis because the "born in Texas" concept is the first element in opposer's mark (and the only element in applicant's mark) and as such it is that portion of opposer's mark that is most likely to be impressed upon the mind of a purchaser and remembered. *Presto Products v. Nice-Pak Products*, 9 USPQ2d 1895, 1897 (TTAB 1988). In view of the foregoing, we find that TEXAS BORN is the dominant portion of opposer's mark.

It must also be kept in mind that a side-by-side comparison of the marks is not the proper test because

argument is given no consideration.

⁵⁷ Zoes Dep., p. 5.

⁵⁸ Zoes Dep., pp. 11-12; Exhibit 4.

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consumers are not exposed to the marks in that way. The proper emphasis is on the recollection of the average consumer, who normally retains a general rather than a specific impression of the marks. *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir., June 5, 1992). Thus, the connotation and commercial impression engendered by TEXAS BORN TEXAS PROUD and BORN IN TEXAS are the same. As evidenced by the testimony of the parties, the purpose and meaning of the marks is to allow consumers to proclaim their Texas heritage. Since the products are identical, in part, and are also inexpensive, impulse purchases, the two marks are likely to be construed as one because of the identity of the message.

While applicant argues that there are only limited similarities between opposer's mark and applicant's mark, the similarities in appearance and sound when combined with the virtually identical connotation and commercial impression outweigh any differences in appearance or sound.

Finally, applicant argues that opposer's TEXAS BORN TEXAS PROUD mark is always used in a logo format featuring a map of the state of Texas within concentric circles surrounded by TEXAS BORN TEXAS PROUD.⁶⁰ Applicant's

⁵⁹ Shevack Dep., p. 16.

⁶⁰ Mr. Zoes testified that opposer has always used the mark in the logo format except for his use of the mark on coffee mugs.

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argument is unavailing because opposer is claiming rights in the words TEXAS BORN TEXAS PROUD separate and apart from their appearance in the logo. Opposer's claim to rights in the words separate and apart from the logo is not unreasonable because the words create a separate commercial impression, and opposer's products would normally be requested by the words TEXAS BORN TEXAS PROUD. *CBS Inc. v. Morrow*, 708 F.2d 157, 218 ISPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal position of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co. Inc.*, 3 UPSQ2d 1553, 1554 (TTAB 1987) ("if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services").

In view of the foregoing, we find that the similarity or dissimilarity of the marks is a factor that favors a finding of likelihood of confusion.

* * * *

Upon balancing the *du Pont* likelihood of confusion factors, we find that applicant's mark BORN IN TEXAS, if used in connection with men's, women's, and children's clothing, would so resemble opposer's mark TEXAS BORN TEXAS

However, he has made some prototype t-shirts without the logo, but he has not distributed them because of pricing problems. *Zoes Dep.*, p. 54.

PROUD, used in connection with t-shirts and baby clothes, as to be likely to cause confusion.

2. Applicant's Class 41 Services.

Opposer, as the plaintiff in this proceeding, bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not countered, negates applicant's right to a registration. *Sanyo Watch Co., Inc. v. Sanyo Electric Co., Ltd.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982). With the exception of the similarity or dissimilarity of the marks, opposer has introduced no evidence for any of the other *du Pont* likelihood of confusion factors with respect to applicant's services listed in Class 41. Without such evidence, opposer has failed to meet its burden of proof. Accordingly, we find that applicant's mark BORN IN TEXAS, if used in connection with the services listed in Class 41 of its application, would not so resemble opposer's mark TEXAS BORN TEXAS PROUD, used in connection with opposer's clothing and other products, or in connection with its services relating to promoting the state of Texas, as to be likely to cause confusion.

Decision: The opposition is sustained as to the goods set forth in Class 25.

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The opposition is dismissed as to the services set forth in Class 41.