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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The North Face Apparel Corp.
v.
Lorenz Hoser

Opposition No. 91162069
to application Serial No. 78187739
filed on November 21, 2002

Susan M. Kayser of Howrey LLP for The North Face Apparel Corp.

Patrick R. Roche of Fay, Sharpe, Fagan, Minnich & McKee, LLP
for Lorenz Hoser.

Before Quinn, Hohein and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Lorenz Hoser filed an application in accordance with Sections 1(b) and 44(e) of the Lanham Act, 15 U.S.C. §§1051(b) and 1126(e), to register the mark NEVER STOP MOVING, in standard character format, for goods ultimately identified as "bicycles and parts thereof, namely, bicycle bells, air pumps for bicycles, panniers adapted for bicycles, baskets adapted for bicycles, seats for bicycles, gears for bicycles, mechanical anti-theft devices for bicycles, bicycle frames, bicycle forks, wheel set for

bicycles, engines for bicycles, and auxiliary engines for bicycles."¹ The North Face Apparel Corp. opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion. Opposer alleged that applicant's use of KEEP ON MOVING for bicycles and parts thereof so resembles opposer's mark KEEP ON EXPLORING for a wide variety of outdoor products, including bicycles, and apparel as to be likely to cause confusion. Only opposer introduced evidence and filed a brief. For the reasons set forth below, we sustain the opposition.

Standing

Opposer introduced a certified copy showing both the current status and title to Registration No. 2,897,197 for the mark KEEP ON EXPLORING for the following products:²

1. "backpacks, luggage, duffel bags, waist packs," in Class 18:
2. "sleeping bags," in Class 20;
3. "tents," in Class 22; and,
4. "clothing, namely, t-shirts, tops, shorts, sweatshirt, sweaters, pants, jackets, vests, anoraks, ski suits, ski jackets, ski vests, rain jackets, and rain pants, footwear and headwear," in Class 25.

The registration is subsisting, and ownership of the registration is in opposer's name.

¹ Application Serial No. 78187739, filed November 21, 2002. During the prosecution of the application, applicant deleted the intent-to-use filing basis.

² Opposer's notice of reliance, Exhibit 159.

Because opposer has properly made its pleaded registration of record, and because opposer's claim of likelihood of confusion is not frivolous, we find that opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 UPSQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and the goods covered by said registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We reject opposer's argument that its "non-technical use of its mark NEVER STOP EXPLORING" in connection with bicycles confers priority on opposer for bicycles. (Opposer's Brief, p. 30). Use of a term in a manner analogous to trademark use may be the basis of an opposition where such use creates a public identification between the opposer's mark and product. "Analogous use" may be inferred from opposer's use of its mark in advertising brochures, catalogs, and articles in newspapers and trade publications. *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). "The manner of use must be 'calculated to attract the attention of potential customers

or customers in the applicable field of trade.'" *Dyneer Corp. v. Automotive Products plc*, 37 UPSQ2d 1251, 1254 (TTAB 1995), quoting *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 308 (TTAB 1979). There is simply no evidence in the record evidencing the use of opposer's mark KEEP ON EXPLORING in connection with bicycles directed to potential customers prior to the filing date of applicant's application.

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.

A. Similarity of the marks.

We must determine whether applicant's mark and opposer's mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, *supra*. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impression that confusion as to the source of the goods offered under the

respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980).

We find that applicant's mark NEVER STOP MOVING and opposer's mark NEVER STOP EXPLORING have similar meanings and engender a similar commercial impression. "Never stop" means continuous or to continue. "Moving" means "passing from one place or position to another."³ "Exploring" means "to traverse or range over (a region, area, etc.) for the purpose of discovery: to explore the island."⁴ Thus, both marks mean continuous motion in some form or another. When used in connection with the goods of the parties, the marks engender the commercial impression to continue outdoor activity (e.g., biking, camping, hiking, etc.) or to continue striving. See Flannery Deposition Exhibit 6, opposer's 1997 Technical Outdoor Clothing and Equipment catalog.⁵ That exhibit is illustrative of the commercial

³ Dictionary.com Unabridged (v 1.1), based on the Random House Unabridged Dictionary (2006). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); TBMP §704.12 (2nd ed. rev 2004).

⁴ *Id.*

⁵ Deposition of Joseph Flannery, opposer's Vice President of Marketing.

impression engendered by opposer's mark as shown by the following text:

Never Stop Exploring
1997

What does it mean to explore? Most would say it's simply about going places we've never been before. More deeply, it's about expanding personal limits, find out what we're really made of. Exploration means escaping the ordinary, feeling the exhilaration of getting to the top, accomplishing things others thought impossible. These are life's great moments. Once you've stopped exploring, you've stopped growing. At North Face, we've always believed that any product, no matter how good, can be made better. The men and women who use our products are always challenging their limits. So are we. . . . There will always be a challenge. We will never stop exploring.

The similarity in the meaning and commercial impression of the marks emphasizes the similarity in the appearance of the marks especially because both marks begin with the words "Never Stop." See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 UPSQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering each mark (CENTURY 21 and CENTURY LIFE OF AMERICA), consumers will notice the identical lead word first); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (the first part of the mark is that part of the mark most likely to be impressed on the mind of the consumer and remembered). For the same reason, the marks have a similar sound.

In view of the foregoing, we conclude that the marks are similar and that this factor favors opposer.

B. The similarity or dissimilarity of the goods.

It is well settled that the goods of the parties need not be identical or even competitive in nature in order to support a finding a likelihood of confusion. In determining whether there is likelihood of confusion, it is sufficient that the goods are related in some manner and/or that they may be purchased by the same consumers under circumstances likely to give rise to the mistaken belief that the products emanate from the same source. In other words, the issue is not whether purchasers can differentiate the goods, but rather whether purchasers are likely to confuse the source of the goods. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989).

NEVER STOP EXPLORING is a mark that is used as an advertising tagline or motto to symbolize opposer's corporate image. The mark is placed on products and hangtags and it appears in advertising, signage, and store fixtures.⁶ Since 1997, NEVER STOP EXPLORING has been used in connection with a wide variety of clothing and equipment for cycling and other outdoor activities. Those products include the following:

1. Fanny packs specifically designed for mountain biking;

⁶ Flannery Dep., pp. 22-23.

2. Adventure travel accessories packs used to organize and hold personal items during trips by cyclists;
3. Clothing used for cycling and other aerobic activities;
4. Stuff sacks for cycling and other activities;
5. Daypacks for cycling and other activities; and
6. Hydration packs (*i.e.*, water bottles) for cycling and other activities.⁷

In view of the foregoing, we believe that the relationship between the goods of the parties is significant, especially because opposer is "the largest specialty outdoor equipment supplier in the world"⁸ whose mark has been extensively promoted. In light of the similarity of the marks, the complementary nature of opposer's cycling and outdoor clothing and gear and applicant's bicycles will lead consumers to believe that there is a common source for the products. Accordingly, we find that the goods of the parties are similar and that this factor favors opposer.

Before considering the next *du Pont* factor, we would be remiss if we did not comment on the third-party registrations submitted by opposer. We have consistently held that third-party registrations which have issued under Sections 44 and 66 of the Lanham Act, without any use in

⁷ Flannery Dep., pp. 82-92; Exhibits 6, 8, 11, 12, and 13.

⁸ Flannery Dep., pp. 16, 108, and 119.

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commerce, have very little, if any, persuasive value in suggesting that the goods and services listed therein may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 2988).

Nevertheless, opposer submitted 91 third-party registrations based on Sections 44 and 66 of the Lanham Act. Only the 65 use-based registrations should have been introduced into evidence.

Opposer stated that it submitted the third-party registrations purportedly "to show that third parties own registered trademarks that include (1) goods related to bicycles of the type sold by Opposer and (2) bicycles of the type identified in Applicant's application and that consumers, therefore, would expect these categories of goods to originate from the same source when sold under trademarks at issue."⁹ However, the last 13 use-based registrations submitted (Exhibits 143-145 and 147-156) do not list both bicycles and bicycle related goods. Opposer should have reviewed the third-party registrations to ensure that each registration was, in fact, probative.

Finally, the third-party registrations were submitted to show that opposer's outdoor clothing and outdoor equipment and bicycles are the types of products that

⁹ Opposer's notice of reliance, p. 5.

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emanate from a single source. Opposer submitted multiple registrations for similar marks. For example, opposer submitted, *inter alia*, three registrations for marks comprising the letters REI (Exhibits 42, 43, and 105), two registrations for marks comprising the letters BMW (Exhibits 48 and 78), and three registrations for marks comprising the word VOLKSWAGEN (Exhibits 93, 113, and 120). Multiple registrations with essentially the same mark are unnecessarily cumulative, rather than probative.

It was poor practice for opposer simply to "dump" the third-party registrations into the record and expect the Board to ferret through the evidence to identify any possibly relevant registrations. Opposer's obligation, like that imposed on all other litigants, is to submit only such evidence as is relevant and probative, rather than force the Board to search through reams of irrelevant paper to find the probative evidence.

C. The similarity or dissimilarity of likely-to-continue trade channels.

The channels of trade factor concerns how and to whom the respective products are sold and distributed. In other words, this factor focuses on whether the same class of persons are exposed to the marks at issue under circumstances likely to give rise to the belief that the products emanate from a single source. *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 61 (TTAB 1984).

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Opposer sells its outdoor/cycling apparel and equipment through outdoor specialty stores, sports specialty stores, high-end gear and apparel stores, general sporting goods store, and high-end department stores.¹⁰ Representative retailers of opposer's products include Recreational Equipment, Inc. (REI), The Sports Authority, Hudson Trail Outfitters, and Dick's Sporting Goods.¹¹ Many of opposer's retail customers also sell bicycles.¹² Such retailers often promote opposer's products in conjunction with bicycles.¹³

Since its inception in the 1960's, opposer has sponsored numerous outdoor exhibitions and events, including cycling events such as pole-pedal-paddle races, adventure races, triathlons and challenge bike rides. Opposer uses its NEVER STOP EXPLORING mark in connection with these events.¹⁴

Consumers who purchase or use opposer's outdoor and cycling clothing and equipment also purchase and use bicycles. In addition, the same class of persons are likely to be exposed to the marks at issue when purchasing the

¹⁰ Flannery Dep., p. 17.

¹¹ Flannery Dep., p. 18.

¹² Flannery Dep., pp. 113-121; Exhibits 33-35; Siroff Dep. and the exhibits attached thereto. Jason Siroff is a private investigator representing opposer. Opposer engaged the services of Mr. Siroff to visit retail stores in the Washington, D.C. metropolitan area and document how opposer's products were presented to the public.

¹³ Flannery Dep., p. 121; Siroff Dep. and the exhibits attached thereto.

parties' products or taking part in a cycling exhibition or event. We find, therefore, that the channels of trade and classes of consumers are the same, and therefore this factor favors opposer.

E. Balancing the factors.

We find that because the marks of the parties are similar, their products are similar, and their products move in the same channels of trade to the same classes of consumers, confusion is likely between applicant's mark NEVER STOP MOVING for "bicycles and parts thereof, namely, bicycle bells, air pumps for bicycles, panniers adapted for bicycles, baskets adapted for bicycles, seats for bicycles, gears for bicycles, mechanical anti-theft devices for bicycles, bicycle frames, bicycle forks, wheel set for bicycles, engines for bicycles, and auxiliary engines for bicycles" and opposer's mark NEVER STOP EXPLORING for the products identified in its pleaded registration.

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

¹⁴ Flannery Dep., pp. 128-134. Strangely, opposer introduced into evidence the home page for one of its sponsored footraces (Flannery Exhibit 38), rather than for a bicycle event.