

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

Mailed: April 28, 2008

Opposition No. 91164161

GA MODEFINE S.A.

v.

ROBERT JEROME THOMPSON

Before Bucher, Zervas and Wellington, Administrative Trademark
Judges.

By the Board:

Applicant seeks to register the following mark



for "men's, women's, and children's clothing, namely jeans, jackets, suits, coats, slacks, shorts, shirts, dress shirts, knit shirts, sweaters, sweatshirts, sweatpants, dresses, skirts, undergarments, neckties, belts, hats, caps, gloves, shoes, sneakers, boots."¹ Applicant has disclaimed "JEANSWEAR U.S.A." and "MONTREAL KAMPALA CANNES BANGKOK."

¹ Application Serial No. 78305612, filed on September 25, 2003, claiming a *bona fide* intention to use the mark in commerce.

Opposer, as grounds for the opposition, alleges priority of use and likelihood of confusion and dilution. Opposer pleads ownership of registered marks as follows:



(hereinafter sometimes referred to as AJ and design)² and



(hereinafter sometimes referred to as AJ ARMANI JEANS and design)³ for a wide variety of goods and services including, *inter alia*, leather goods in Class 18, textile goods in Class 24, clothing items in Class 25, retail store services in Class 35, and fashion and dress designing in Class 42.

Applicant's answer is in the nature of a general denial of the salient allegations of the notice of opposition.

As background, this proceeding commenced on February 10, 2005. Applicant is representing himself. On December 7, 2005, after opposer's motion to compel was granted as conceded, applicant sought, and was granted, substantial time to obtain counsel. In an order dated April 28, 2006, the Board provided

² Registration No. 2883471, issued on September 14, 2004, under Trademark Act Section 44(e).

³ Registration No. 2742849, issued on July 29, 2003, claiming a date of first use anywhere and a date of first use in commerce of January 1, 2001.

applicant with information about Board proceedings and, noting that sufficient time had passed for applicant to obtain counsel, allowed applicant a final period of thirty days to obtain counsel. (In all, applicant was allowed five months to find an attorney.) The Board also reset discovery and trial dates notwithstanding the status of applicant's representation in view of the amount of time that had passed while applicant was seeking legal counsel. On March 14, 2007, opposer filed a motion for summary judgment in its favor on its likelihood of confusion claim only. Such motion was granted as conceded on May 14, 2007 and this opposition proceeding was terminated on the same day.

On July 11, 2007, applicant filed a motion for relief from final judgment and his response to opposer's motion for summary judgment.⁴ The Board, in an order dated December 6, 2007, granted applicant's motion for relief from final judgment as conceded and denied opposer's motion for summary judgment. In denying opposer's motion, the Board found that a genuine issue of material fact existed with respect to priority, noting specifically that opposer failed to carry its burden of establishing that its asserted trademark registrations are valid and subsisting because it did not submit appropriate and sufficient evidence. The Board further found that genuine issues of material fact exist as to the similarities of the parties'

⁴ On July 14, 2007, applicant filed a copy of his certificate of service for his motion for relief from final judgment and for his response to opposer's motion for summary judgment.

respective marks, including the commercial impressions conveyed, and as to the strength and fame of opposer's pleaded marks. Insofar as discovery closed long ago, only trial dates were reset.

This case now comes up on the following motions: 1) opposer's motion, filed December 14, 2007, for reconsideration of the Board's December 6, 2007 decision granting applicant's motion for relief from final judgment and 2) opposer's renewed and second motion, also filed December 14, 2007, for summary judgment in its favor on its priority and likelihood of confusion claim and its dilution claim.⁵ Applicant, on December 26, 2007, filed a succinct, combined response to opposer's motions.

Motion for reconsideration is denied.

In support of its motion for reconsideration, opposer argues that applicant's "default" on opposer's first summary judgment motion was not an error and consequently, the Board erred in granting applicant relief by "finding that Applicant has presented evidence to show that his failure to respond to Opposer's Motion for Summary Judgment was due to excusable neglect." Opposer also points out that applicant repeatedly missed deadlines in this proceeding; that applicant chose to

⁵ On January 14, 2008, opposer filed a motion for an enlargement of the trial schedule in view of its pending motion for summary judgment and because the Board had not yet suspended proceedings. On December 15, 2007, opposer filed its motion for an enlargement of the trial schedule with applicant's consent. Proceedings are considered suspended since December 14, 2007, the filing date of opposer's renewed and second motion for summary judgment. Trademark Rule

remain *pro se* in this proceeding notwithstanding periods of suspension to permit him to retain counsel; and that applicant should not be allowed to continue his pattern of delay and disregard for applicable rules and procedures. Opposer notes that, due to a mistake in docketing, it inadvertently failed to respond to applicant's motion for relief from final judgment.⁶

In response, applicant argues that, because he sent a mailed copy and an emailed copy of his filing to opposer, opposer's argument that it made a docketing mistake is "completely inappropriate and not warranted."⁷

A motion for reconsideration under Trademark Rule 2.127(b), provides an opportunity for a party to point out any error the Board may have made in considering the matter initially, based on the evidence of record and the prevailing legal authorities before the Board at the time the motion was considered. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. Rather, the motion should be limited to a demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error

2.127(d). Accordingly, opposer's motions for enlargement of the trial schedule are deemed moot.

⁶ Opposer points out that it otherwise has adhered to the deadlines and due dates set in this proceeding.

⁷ Applicant also argues that opposer's "response" to applicant's motion for relief from final judgment is untimely because opposer had ample time for a (timely) response and chose not to so respond. However, it is opposer's timely-filed motion for reconsideration of the Board's December 6, 2007 order that is presently before us, not opposer's "response" to applicant's motion for relief from final judgment.

and requires appropriate change. See TBMP §518 (2nd ed. rev. 2004).

In this case, the Board granted applicant's motion for relief from final judgment as conceded, not because the Board found excusable neglect so as to permit applicant to file his response late to the first motion for summary judgment. While it is unfortunate that opposer mistakenly failed to docket a response to applicant's motion for relief from final judgment, based on the circumstances before us when the ruling was made, the Board did not commit any error of law or fact.

Accordingly, opposer's motion for reconsideration of the Board's December 6, 2007 decision granting applicant's motion for relief from final judgment is denied. See also Trademark Rule 2.127(a); and TBMP §502.04 (2d ed. rev. 2004).

Opposer's renewed and second motion for summary judgment is granted.

Opposer seeks summary judgment in its favor on its priority and likelihood of confusion claim and on its dilution claim.

In support of its motion for summary judgment, opposer argues that there are no genuine issues of material fact that the parties' respective marks are similar in sight, sound, meaning, and commercial impression; that the clothing goods identified by applicant are the same as the clothing goods identified in opposer's registrations; that, because the parties have not limited their channels of trade, the goods are presumed to be

Opposition No. 91164161

sold in the same channels of trade; that opposer's marks are strong as evidenced by the fact that there are no other AJ marks for clothing; and that opposer has priority of use.

More particularly, opposer argues that the AJ component of its marks is the dominant feature of its marks; that the AJ component of applicant's mark is also dominant with the remaining terms being non-distinctive and disclaimed, making the other wording in applicant's mark insufficient to distinguish the parties' marks. Opposer argues that applicant's responses to opposer's document requests include samples of proposed advertising and packaging evidencing applicant's intent to use "AJ'S JEANSWEAR" without the other components of the applied-for mark and that no evidence has been submitted by applicant that his use of AJ in his mark has a different meaning than opposer's use of AJ in its mark or that his mark conveys a different commercial impression.

As to the goods, opposer's AJ and design registration (No. 2883471) includes the following Class 25 goods:

Clothing, namely, pullovers, cardigans, sweaters, trousers, skirts, jackets, blouses, shirts, jeans, sweatpants, shorts, sweatshirts, suits, dresses, overcoats, coats, raincoats, belts, jerseys, neckwear, socks and stockings, tights, vests, waistcoats, jumpers, tracksuits, blousons, gymsuits, knickers, T-shirts, anoraks, suspenders, loungewear, underwear, beachwear, sleepwear, headwear, overalls, hats and caps, gloves, shoes, sandals, boots and slippers.

Opposer's AJ ARMANI JEANS and design registration (No. 2742849) includes the following Class 25 goods:

Clothing, namely, pullovers, cardigans, sweaters, trousers, skirts, jackets, blouses, shirts, jeans, sweatpants, shorts, sweatshirts, suits, dresses, overcoats, coats, raincoats, belts, jerseys, neckwear, socks and stockings, vests, waistcoats, jumpers, tracksuits, blousons, T-shirts, anoraks, suspenders, loungewear, headwear, overalls, hats and caps, gloves, shoes, sandals, boots and slippers.

Opposer points out that the following identical or nearly identical goods are identified in both the AJ ARMANI JEANSWEAR and design registrations and the application:

men's, women's, and children's clothing, namely jeans, jackets, suits, coats, slacks, shorts, shirts, dress shirts, knit shirts, sweaters, sweatshirts, sweatpants, dresses, skirts, undergarments, neckties, belts, hats, caps, gloves, shoes, sneakers, boots.

Opposer argues that its AJ marks are the only registered AJ marks that cover clothing. As a result, opposer contends that the consuming public is accustomed to seeing only opposer as the source of clothing items with the label AJ. Thus, opposer argues, its AJ marks are very strong and applicant's use of his mark would dilute the distinctive quality of opposer's AJ marks. Opposer argues that its marks are famous and very well known.

Opposer's motion is supported by certified copies of its pleaded registrations showing that the registrations are valid and subsisting and are owned by opposer. Opposer's motion is further supported by the declaration of its attorney introducing numerous exhibits, including discovery responses from applicant.⁸

⁸ Among the submissions introduced by opposer's attorney are a copy of the USPTO assignment record and a copy of the TARR record for a third-party registration (No. 1349538), cancelled under Trademark Act §8 in 1992, for the mark AJ'S JEANSWEAR U.S.A. MONTREAL KAMPALA CANNES BANGKOK and design. The exhibit was introduced for the purpose of showing that applicant was at no time the record owner of such registration. Opposer's introduction of such

Opposition No. 91164161

Opposer's motion is also supported by the declaration of opposer's chief financial officer ("CFO") stating, among other things, that opposer has been using both its marks in commerce in the United States for clothing since as early as 2000. Opposer's CFO also provides monetary figures in Euros for total sales since 2000 and for the year 2006 as well as monetary figures for promoting and advertising activities in the United States since 2000.⁹

In response, applicant argues that opposer "has not shown any new grounds" in support of its motion by way of argument (referred to applicant as "memorandum"), declaration or exhibits. Applicant also argues that "there is a genuine factual dispute and material facts exist." Applicant requests resumption of proceedings.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to

material is in anticipation of an argument from applicant and is based on applicant having attached a TARR printout of the cancelled, third-party registration as an exhibit to his answer in support of his averment that his mark is "the same as the Original AJ'S JEANWEAR and design mark" which "has priority over the Opposer's [registrations] by virtue of Original's earlier ... effective filing date."

⁹ The Board noted in its December 6, 2007 order that the introduction of this information in Euros was not particularly enlightening. Opposer now provides an equivalent in U.S. dollars in its brief for its CFO's statements as follows: 1) since 2000, opposer has sold approximately \$1.8 million in clothing bearing the AJ and design marks; 2) in 2006, opposer sold approximately \$1.5 million in clothing bearing the AJ and design marks; 3) since 2000, opposer has spent approximately \$5 million in advertising and promotion of the AJ and design marks in the United States.

a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Nonetheless, if the moving party meets its burden, that is, if the moving party has supported its motion with affidavits or other evidence which if unopposed would establish its right to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and TBMP §528.01 (2d ed. rev 2004).

In this case, opposer has introduced new evidence in support of its priority: certified copies of its pleaded registrations. This proof, in addition to establishing that there are no genuine issues of material fact regarding opposer's standing, removes the issue of priority from this case. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA

1974). Thus, no genuine issue of material fact exists as to opposer's priority of use.

With respect to likelihood of confusion, we are guided by the factors set forth in the case *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1793). It is not required that every *du Pont* factor be considered but only "those factors that are relevant and of record." See *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

A comparison of the clothing items identified in opposer's registrations to the clothing items identified in applicant's application shows that they are, as opposer points out, identical in large part and otherwise overlapping. Thus, no genuine issue of material fact exists with respect to the relatedness of the parties goods which are, in fact, the same, overlapping and related clothing items.

Insofar as applicant seeks a registration unrestricted with respect to channels of trade (or classes of purchasers to which sales of the goods are directed), and opposer's registrations are also unrestricted, the parties' respective goods are presumed to travel in the same channels of trade (and are further presumed to be sold to the same class of purchasers).¹⁰ See *Octocom Systems*,

¹⁰ Although not discussed directly by opposer, consideration of the class of purchasers is also relevant because neither the registrations nor the application are restricted in any way.

Opposition No. 91164161

Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Opposer, by way of the declaration of its CFO and its indication that its AJ marks are the only AJ marks registered for clothing (*i.e.*, in Class 25), has supported its position that its marks are strong. Applicant has not provided any countering evidence. Thus, there exists no genuine issue of material fact with respect to the strength of opposer's AJ marks.

Turning next to the similarity of the marks, we must compare the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Nevertheless, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, opposer has made a showing that the parties' marks are similar and have the same meaning. Opposer points out that AJ is the dominant component of the parties' respective marks. More particularly, it is the only term of opposer's AJ and design mark; makes up a dominant component of opposer's AJ ARMANI JEANS and design mark because it is the first term reading left to right and is in larger lettering than the terms ARMANI JEANS; and

Opposition No. 91164161

makes up a dominant component of applicant's mark because it is displayed in larger lettering than the remaining wording, which, in applicant's mark, has been disclaimed, and is centered in the design, which draws the attention of the viewer to such term. Disclaimed matter is often "less significant in creating the mark's commercial impression." See *In re Code Consultants, Inc.*, 61 USPQ2d 1699, 1702 (TTAB 2001). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 1056, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) (regarding descriptive terms, our primary reviewing Court has noted that the "descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion ..."). In addition, the possessive aspect of the AJ component in applicant's mark is minimized because the "'s" is much smaller in comparison to the letters AJ. Moreover, the "'s" has a minimal effect in distinguishing the marks in sound and commercial impression. See, e.g., *In re Chatam International Inc.*, 380 F.3d 1340, 71 UPSQ2d 1944, 1946 (Fed. Cir. 2004) ("... GASPAR is [] the dominant feature of the registered mark, GASPAR'S, albeit in possessive form."). Applicant has not provided any countering evidence that AJ is not the dominant feature of the involved marks. The carrier design elements in each mark and the font types used by opposer differ from those used by applicant. However, the differences are not sufficiently distinct so as to distinguish the marks, accounting

for the strength of the term AJ, the dominant feature of the parties' marks. Thus, no genuine issue of material fact exists and we find that the parties marks are similar.

Accordingly, we find that opposer has carried its burden of proof and that no genuine issues of material fact remain as to opposer's standing, priority, or the ground of likelihood of confusion. In view thereof, opposer's motion for summary judgment is granted and the opposition is sustained with respect to opposer's claim of priority and likelihood of confusion based on both the AJ and design mark and the AJ ARMANI JEANS mark and design, and registration to applicant is refused.¹¹



¹¹ Insofar as opposer's motion for summary judgment is sustained on its priority of use and likelihood of confusion claim, we need not reach a determination on opposer's dilution claim. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990). Also, we note that a plaintiff must meet more stringent requirements to establish that its mark is famous for dilution purposes. In addition, opposer must establish that the parties' mark are substantially similar, which is different than confusingly similar. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001).