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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Trek Bicycle Corporation
v.
Tektite Industries, Inc.

Opposition No. 91164982
to application Serial No. 78124164
filed on April 25, 2002

Mary Catherine Merz and Ameen Imam of Merz & Associates for
Trek Bicycle Corporation.

Joseph F. Posillico and Lisa B. Lane of Synnestvedt &
Lechner for Tektite Industries, Inc.

Before Quinn, Hohein and Wellington, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Tektite Industries, Inc. filed an application to
register the mark TREK for "flashlights." The application
alleges first use anywhere and first use in commerce on
January 10, 1997.

Trek Bicycle Corporation opposed registration. As
grounds for opposition opposer asserts that applicant's
mark, when used in connection with applicant's goods, so
resembles opposer's famous mark TREK, previously used and

registered for bicycles and bicycle parts and accessories, including lights, as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations regarding the likelihood of confusion claim. Applicant set forth several allegations captioned as "Affirmative Defenses" that amplify the reasons why it believes there is no likelihood of confusion between the parties' marks.

The record consists of the pleadings; the file of the involved application; trial testimony, taken by each party, with related exhibits;¹ status and title copies of opposer's pleaded registrations, applicant's responses (including documents) to certain of opposer's interrogatories, and excerpts from printed publications, all introduced by way of opposer's notices of reliance; and copies of five third-party registrations and one application, all for the mark TREK, made of record by applicant's notice of reliance. Both parties filed briefs.

Evidentiary Objections

Applicant first objects to all documents opposer introduced as trial evidence, due to opposer's alleged failure to produce those documents during discovery "as fully indicated and articulated in Applicant's Motion In

¹ Applicant took the testimony of Scott Mele, its president and chief executive officer. The transcript was filed with the Board concurrently with the brief at final hearing.

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Limine filed on August 27, 2007, which motion is repeated and renewed here."

As opposer is quick to point out in response, applicant's earlier motion was denied by the Board in an order dated August 27, 2007 following a telephone conference. Further, as spelled out by opposer, opposer informed applicant that the documents were available to applicant for inspection, but applicant, despite several indications that it wished to inspect the documents, never followed through with the inspection.

Applicant's first objection is therefore overruled.

As for applicant's second objection, applicant seeks to strike the testimony, and related exhibits, of Messrs. Joe Siefkes (opposer's vice president for finance) and Patrick Sullivan (opposer's general manager of aftermarket products). Applicant contends that the testimony was "improperly presented" because the witnesses were never identified during discovery.

As opposer has responded, it was not required, in advance of trial, to identify all of its witnesses.

Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040, 2041 (TTAB 1989). Moreover, applicant did not avail itself of the opportunity to cross examine those witnesses, nor did it request an extension or postponement if it felt that the circumstances of the substitution of

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witnesses left it inadequately prepared to cross examine the witnesses. *Beech Aircraft Corp. v. Lightning Aircraft Co., Inc.*, 1 USPQ2d 1290, 1291 (TTAB 1986).

Accordingly, applicant's second objection is overruled.

Applicant next objected to opposer's third notice of reliance on the grounds that the documents were never properly authenticated, that a proper foundation was lacking, and that the documents are inadmissible hearsay.

The documents relied upon are printed publications available to the general public in libraries or of general circulation among members of the general public.

The documents relied upon in the notice of reliance were properly introduced. The listed publications qualify for submission by notice of reliance because they are considered essentially self-authenticating. TBMP §704.08 (2d ed. rev. 2004). In connection with the hearsay objection, the printed publications are probative only for what they show on their face, not for the truth of the matters contained therein.²

In view thereof, applicant's third objection is overruled.

Finally, applicant objected to all documents comprising surveys, consumer studies and Internet articles introduced

² Contrary to opposer's contention, the hearsay objection may be timely raised in the brief, rather than by a motion to strike. TBMP § 707.02(c) (2d ed. rev. 2004).

during Mr. Sullivan's testimony. Applicant objected on the grounds that the documents were not properly authenticated, that a proper foundation was not laid, and that the documents are inadmissible hearsay.

Mr. Sullivan testified that the documents were kept in opposer's ordinary course of business. Further, Mr. Sullivan had personal knowledge of the documents and the information contained therein. Thus, the documents are properly of record and have been given appropriate probative value.

Applicant's fourth objection is accordingly overruled.

In sum, we have considered the entire record presented to us, and we have given the testimony and documents whatever probative value is merited.

The Parties

Opposer has been manufacturing bicycles and related bicycle products for over thirty years and, in the process, has become the second largest bicycle company in the world. Although its specific sales figures for the United States have been designated "confidential," we are able to generally state that its annual sales under the mark TREK are in the hundreds of millions of dollars and that its sales this decade exceed one billion dollars. Opposer's annual advertising expenditures are in the tens of millions of dollars. Opposer began using its mark TREK in connection

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with bicycle lights in 1993, and total sales of opposer's lighting products in 2006 exceeded one million dollars.

Applicant has been using its mark TREK in connection with flashlights since 1996. In that time applicant has sold more than one million flashlights under the mark. Applicant's first flashlights were designed for use in scuba diving, and applicant later expanded its line of flashlights into high-end outdoor use, mountain climbing use, fire and police department use, and military use.

Standing

Opposer has established its standing to oppose registration of the mark in the involved application. In particular, opposer has properly made its pleaded registrations of record (*see infra*) and, further, has shown that it has a personal interest in this proceeding. Opposer's use of and registrations for its marks establish that opposer has standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority

Opposer introduced during its testimony period certified copies of its sixteen pleaded registrations covering its TREK marks and TREK-formative marks. Such

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copies show each registration to be subsisting and owned by opposer. The registrations include registration of the mark TREK for, inter alia, "bicycles, bicycle frames, and a full line of parts and accessories for bicycles, namely ... lighting systems for bicycles."³ The other valid and subsisting registrations are of the mark TREK or marks including TREK as a portion thereof, including TREKKING, TREK 100, ETREK, TREKLITE, TREKBIKES.COM, TREK TRAVEL, TREK UNIVERSITY and TREKER. In addition to bicycles, and bicycle parts and accessories, the various registered marks cover a variety of goods and services, including bicycle apparel, orienteering equipment and clothing for outdoor sporting activities, backpacks, fanny packs, saddle bags, all purpose sports bags, off-road all-terrain utility vehicles, non-alcoholic beverages, on-line retail and wholesale store services, bicycle touring services, and arranging travel tours featuring outdoor activities such as hiking, river rafting and bicycling.

As indicated above, we highlight opposer's Registration No. 2060274 because, of all the pleaded registrations, that one is closest to the involved application in terms of the similarities between the goods and the identity between the marks.

³ Registration No. 2060274, issued May 13, 1997; renewed.

In view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion.

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 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. The relevant du Pont factors in the proceeding now before us are discussed below.

The Marks

Turning first to the marks in this proceeding, the TREK marks are identical in sound, appearance, meaning and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73

USPQ2d 1689 (Fed. Cir. 2005). This factor heavily favors opposer.

Fame

Inasmuch as opposer introduced evidence bearing on the fame of its TREK mark, we now turn to consider this du Pont factor. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1694. The relevant consuming public herein comprises the general public.

Opposer has continuously used its mark TREK for over thirty years. Opposer's sales figures under the mark TREK, both in terms of revenue dollars and units sold, are impressive. As indicated earlier, opposer's annual sales under the mark TREK are in the hundreds of millions of dollars; opposer's sales this decade exceed one billion dollars. Further, opposer has expended great effort in

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promotional activities to support the mark TREK. Annual advertising expenditures are in the tens of millions of dollars. The purchasing public has been exposed to the mark TREK in a variety of national publications such as Time, Sports Illustrated and Bicycling. Opposer has sponsored two professional cycling teams, the U.S. Postal Team and the Discovery Channel team. Opposer's mark also has been the beneficiary of unsolicited publicity, especially in the years Lance Armstrong rode TREK bikes on his way to an unprecedented seven-straight wins in the Tour de France bicycle race. Armstrong has been pictured in many advertisements and articles riding a TREK bike and wearing clothing that both prominently display opposer's TREK mark. Surveys conducted by independent magazines featuring bicycles and bicycling-related information show strong TREK brand awareness among the bicycle-purchasing public.

Based on the record before us, we find that the mark Trek is famous for bicycles and bicycle accessories. These accessories include opposer's bicycle lighting systems. Our finding of fame in the present case is consistent with the Board's finding of fame in *Trek Bicycle Corp. v. Alyx Fier*, 56 USPQ2d 1527 (TTAB 2000).

The fame factor weighs heavily in opposer's favor.

The Goods

It is well established that the goods of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In comparing the goods, we initially note that where identical marks are involved, as is the case here with respect to opposer's mark TREK, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d

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1650 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

Opposer's "lighting systems" include bicycle headlights that may be attached to the handlebars by way of a clamp. These lights are sold separate and apart from opposer's bicycles or other lights. The headlights are removable and, according to Mr. Sullivan, can be used as a flashlight. Mr. Sullivan testified that "consumers could use TREK lights in a wide variety of circumstances," including night bicycle riding, camping and as a flashlight during outdoor activities. (Sullivan dep., p. 16). Opposer's headlights, as shown in the pictures in opposer's catalogs, look very similar to a typical, hand-held flashlight.

Mr. Mele testified that detachable bicycle lights are not flashlights, but he acknowledged that it is "certainly possible to dismount [the bicycle] and use the light for other purposes." (Mele dep., p. 73). Mr. Mele also acknowledged that it is possible for one of applicant's TREK flashlights to be part of the packed gear of a bicyclist who is riding a TREK bicycle. (Mele dep., p. 84). Mr. Mele further testified that "[w]e certainly had correspondence from people asking if products are suitable for use on bicycles. Usually we reply in the negative." (Mele dep., p. 24). Mr. Mele indicated this happened on six occasions. (Mele dep., p. 72).

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We find that opposer's bicycle lights and applicant's flashlights are sufficiently related that, when sold under the identical mark TREK, confusion is likely to occur among consumers in the marketplace. Both goods serve the same purpose and, because opposer's headlights are detachable from the bicycle, it is inevitable that bicyclists may use the headlight as a flashlight when necessary.

With respect to trade channels and classes of purchasers, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in opposer's pleaded registration(s). *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the goods in the application at issue and/or in the pleaded registration(s) are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

In the present case, both the identifications in the application and the pertinent pleaded registration have no restrictions relating to trade channels or classes of purchasers. Normal trade channels for bicycles and bicycle accessories include retail bicycle stores. However, normal trade channels also include the same mass merchandisers (e.g. Wal-Mart, Target, Sears and the like) that sell flashlights. Further, the goods would be bought by the same consumers, and these would include ordinary ones who would exercise nothing more than ordinary care in making their purchasing decision involving such goods.

The similarities between the goods, trade channels and purchasers are factors that weigh in opposer's favor.

Third-Party Uses and Registrations

The record includes a dictionary definition of the term "trek" showing the term means "journey or leg of a journey, migration." Webster's New Twentieth Century Dictionary of the English Language (unabridged ed. 1983). Given this commonly understood and recognized meaning of "trek," it is not surprising that others have been attracted to adopt it as a mark for their various goods and services.

Mr. Mele testified about several third-party uses of TREK marks. These uses have no impact on the degree of distinctiveness of opposer's mark for bicycles and bicycle accessories. Firstly, the uses are in connection with goods

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(and services) far different from the types involved herein (e.g., barcode scanners, medical equipment, musical instruments and air ambulance services). Secondly, there is no evidence bearing on the extent of use of these marks by the third parties. That is to say, there is no information concerning actual revenues under the marks or that the public is familiar with such marks. See *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995).

Applicant also introduced five third-party registrations of the mark TREK for a variety of goods and services (e.g., floor varnishes and sealers, shock absorbers, internal combustion engines, office furniture and educational services), but none related to bicycles. As often stated, third-party registrations are not evidence of use of the marks shown therein, or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Thus, while we have considered the third-party registrations to the extent that they act like a dictionary definition showing that a term has a normally understood meaning (as shown by the dictionary definition itself), they are of limited probative value in deciding this case. *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988). The one application is evidence of nothing

more than that it was filed. Moreover, this evidence has no effect on the level of distinctiveness of opposer's mark.

Mr. Mele indicated that he selected the mark TREK "to indicate outdoor travels of one description or another ... an outdoorsy feel." (Mele dep., p. 15). To the extent that opposer's mark TREK is a suggestive mark, applicant's mark conveys a similar suggestion (namely, of an outdoor journey).

This factor is neutral.

Actual Confusion

Opposer has not presented any evidence of actual confusion, and Mr. Mele testified that he is unaware of any instances of actual confusion. The absence of actual confusion does not compel a different result in the likelihood of confusion analysis. Although each party is unaware of any actual confusion over a twelve-year period of contemporaneous use of the marks, evidence of actual confusion is not essential to proving a case of likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). This factor is neutral or, at best, weighs only slightly in applicant's favor.

Bad Faith Intent

Opposer contends that opposer contacted applicant prior to the time applicant's mark was published, yet applicant

"refused to heed Trek's warnings." Further, applicant was on constructive notice of opposer's TREK registered marks, and, opposer contends, it must be assumed that applicant's attorney would have apprised applicant of opposer's prior trademark rights. Opposer also argues that applicant has misused the registration symbol (applicant's mark was the subject of an inadvertently issued registration), "an obvious indication of applicant's bad faith in its trademark use of TREK." (Brief, pp. 33-34).

At the time applicant adopted its mark, Mr. Mele was unaware of opposer's use of its mark TREK in the bicycle field. Suffice it to say that opposer's bad faith argument is not supported by the record. We have given no weight to opposer's contentions in this regard. This factor is neutral.

Conclusion

Upon balancing the relevant du Pont factors, we conclude that consumers familiar with opposer's bicycles and bicycle accessories, namely lighting systems for bicycles sold under its famous mark TREK would be likely to believe, upon encountering applicant's mark TREK for flashlights, that the goods originate with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that

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doubt, as we must, in favor of opposer as the prior user and registrant. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, Id.

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