

**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

Gap (Apparel), LLC
v.
Gap One Enterprises, LLC

Opposition No. 91172505
to application Serial No. 78683999
filed on August 2, 2005

Linda K. McLeod of Finnegan, Henderson, Farabow, Garrett &
Dunner, L.L.P. for Gap (Apparel), LLC.

Marie Breaux of Milling Benson Woodward LLP for Gap One
Enterprises, LLC.

Before Seeherman, Quinn and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Gap One Enterprises, LLC ("applicant") filed a use-based application for the mark GAP ONE, in standard character format, for "general business merchandising services, namely, marketing," in Class 35 (Serial No. 78683999). As discussed more fully below, applicant is an independent sales agent that renders marketing services, including arranging for the sale of promotional products, such as shirts, hats, jackets, and coffee mugs, etc. that display the customer's logo or trademark.

Gap (Apparel), LLC ("opposer") filed a notice of opposition against the registration of applicant's mark on the grounds of priority of use and likelihood of confusion, and dilution. Sections 2(d), 13(a), and 43(c) of the Trademark Act of 1946, 15 U.S.C. §§1052(d), 1063(a), and 1125(c). Specifically, opposer alleges that it is "one of the world's leading consumer retail stores featuring a wide variety of clothing, shoes, clothing accessories, jewelry, bags, personal care products, toys, paper products, bed and bath linens, and other merchandise"; that it has used the marks GAP and THE GAP in connection with retail clothing store services, clothing and related accessories since at least as early as 1969; that the GAP marks became famous prior to applicant's first use of the mark GAP ONE; and that applicant's use of the mark GAP ONE in connection with "general business merchandising services, namely marketing" is likely to cause confusion and dilution with opposer's GAP marks. In addition, opposer made the following allegation:

7. In connection with its products and services offered under the GAP marks, Opposer has marketed and sold corporate gift cards since at least as early as 1996, and has marketed and sold corporate apparel with customized embroidery and silk screening (including t-shirts, button-down shirts, sweatshirts, fleece jackets, pullovers, and hats) and accessories (including leather cardholders, travel cases,

frames, and desk accessories) since at least as early as April 2005.¹

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

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. The testimony deposition of Julie Alonso, Senior Director of Public Relations and Buzz Marketing for Gap, Inc., with attached exhibits;²

2. A notice of reliance with copies of opposer's pleaded registrations prepared by the U.S. Patent and Trademark Office showing the current status and title of opposer's pleaded registrations. Those registrations include, but are not limited to, the mark THE GAP, in typed drawing form, for retail clothing store services (Registration No. 0944941) and the mark GAP, in typed drawing form, for clothing (Registration No. 1129294), tote bags and hand bags (Registration No. 1752562), sunglasses and eye glass cases (Registration No. 1912356), stationery,

¹ Amended notice of opposition, ¶7.

² Opposer is a wholly-owned subsidiary of Gap, Inc. (Alonso Dep., p. 10).

pencils, and note books (Registration No. 2138241), watches (Registration No. 2146558), blankets, sheets, linens, quilts, and comforters (Registration No. 2341527), cosmetics (Registration No. 2532258), and luggage, purses, book bags, wallets and umbrellas (Registration No. 2527652);

3. A notice of reliance consisting of unsolicited articles and stories from printed publications and wire services available to the general public that opposer asserts recognize the fame of opposer's GAP marks;

4. A notice of reliance consisting of articles and stories from printed publications and wire services available to the general public that mention the GAP marks;

5. A notice of reliance consisting of advertisements featuring the GAP marks that appear in printed publications available to the general public;

6. A notice of reliance consisting of certified copies of form 10-K for Gap, Inc. filed with the U.S. Securities and Exchange Commission for fiscal years 1997-2006;

7. A notice of reliance on applicant's responses to opposer's first and third sets of requests for admission;

8. A notice of reliance on applicant's responses to opposer's first and second sets of interrogatories;

9. A notice of reliance on applicant's responses to opposer's second set of requests for admission;

10. A notice of reliance on excerpts from the discovery deposition of George A. Peterson, the founder and owner of applicant;

11. A notice of reliance on records from Board proceedings in which opposer asserted its rights in the GAP marks against third-parties;³ and,

12. A notice of reliance on articles and stories available to the general public that opposer asserts demonstrate that it sells products displaying the logos and trademarks of its customers.

B. Applicant's evidence.

1. A notice of reliance on the entire discovery deposition of George Peterson, with exhibits;⁴

2. A notice of reliance on printouts of third-party registrations and applications from the electronic records of the Trademark Office;⁵

³ Opposer submitted an additional opposition record through a notice of reliance filed during its time for rebuttal.

⁴ When, as here, opposer has introduced excerpts from applicant's discovery deposition, applicant is entitled to introduce by notice of reliance any other portions of the deposition that are necessary to present a fair representation of the entire testimony. Trademark Rule 2.120(j)(ii)(4). In such circumstances, applicant's notice of reliance must explain why it needs to rely on the additional parts of the discovery deposition. *Id.* Applicant did not include such a statement in its notice of reliance. However, because opposer noted applicant's notice of reliance in its brief and did not object to it, we deem opposer to have stipulated to the admission of the entire deposition.

⁵ Although the Board has received applicant's notice of reliance, our records do not include copies of the registrations and applications. However, because opposer has treated the evidence as being of record by referencing it in its brief and reply

3. A notice of reliance on opposer's responses to applicant's first set of interrogatories and requests for admission; and,

4. A notice of reliance on documents produced by opposer during discovery.⁶

Standing

Because opposer has properly made its pleaded registrations of record, 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 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case vis-à-vis the goods and services identified in the registrations.

brief, and because applicant provided a table, in its brief, listing the third-party registrations, the marks and the goods and services, we will consider the third-party registrations for whatever probative value they may have. The only probative value that applications may have is to show that the applications were filed.

⁶ A party that has obtained documents in response to a request for production of documents may not introduce those documents into evidence through a notice of reliance unless they are admissible pursuant to Trademark Rule 2.122(e). Trademark Rule 2.120(j)(3)(ii). However, because opposer has also introduced these documents into evidence through a notice of reliance (Document Nos. 3568-3651) and through the Alonso deposition (Document Nos. 3484-3567 as Alonso Dep. Exhibit 28), we deem opposer to have stipulated to the admission of applicant's documents.

King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer's witness Julie Alonso testified that since at least as early as 1996, opposer has been selling personalized apparel and accessories such as bags, wallets, frames and credit card holders, displaying customers' logos and trademarks.⁷ These corporate or bulk sales are made through Gap, Inc. Business Direct.⁸

Q. Now, what is the history of this Gap Business Direct program? When did it start?

A. I believe in 1996. However, since I've been here in 1992, companies have called for bulk sales of specific items.

Q. But the formal program started in 1996?

A. As a formal program.

But earlier, movie studios and others would call for bulk items to then logo the merchandise.

Q. And it has been continuous use for that service since then?

Was there ever a time when it was discontinued?

⁷ Alonso Dep., pp. 102, and 106-111; Exhibit 28 (Corporate Apparel and Gift Catalog, Spring/Summer 2006). The catalog displays the GAP trademark. See also *BrilliantResults* magazine (January 2006) (Opposer's notice of reliance (A-12 *supra*)) with a feature story regarding opposer's customized promotional apparel sales. We reference this article only for the fact that it was written, and not to prove the facts set forth therein.

⁸ Alonso Dep., pp. 108; Exhibit 28.

- A. It's always on the table. Bulk sales and big merchandise sales are always on the table as something that we consider.⁹

On the other hand, applicant's earliest date of first use of its mark in connection with applicant's services is July 1997.¹⁰ Accordingly, opposer has established prior use

⁹ Alonso Dep., pp. 109-110.

¹⁰ Peterson Dep., p. 64; applicant's answer to Interrogatory No. 2. Mr. Peterson also testified that applicant may have used GAP ONE as early as 1996. (Peterson Dep., pp. 65-68). If an applicant wishes to claim a first use date prior to that set forth in its application (January 13, 1999), the evidence must be clear and convincing. *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (the date asserted in the application is considered to be an admission against interest at the time the time the application was filed, and applicant's change of position "requires enhanced substantiation"). Here, Mr. Peterson's testimony on this point was not clear and convincing and it was contradicted by his other testimony and evidence. See *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted). In view of the uncertainty of Mr. Peterson's testimony and lack of documentation, we conclude that applicant's date of first use can be no earlier than July 1997. See *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period). See also *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB 1985) (evidence

of the mark GAP in connection with the sale of personalized apparel and accessories.¹¹

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The relevant *du Pont* factors are discussed below.

A. Fame.

We turn first to the factor of fame because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* Indeed, "[a] strong mark . . . casts a long shadow which competitors must

established first use in 1968-1969, therefore December 31, 1969 is date of first use).

¹¹ Applicant asserts that opposer has ended its Gap, Inc. Direct Business sales of personalized apparel and accessories, citing Investor Information at www.gapinc.com - 10-K annual report filed with the SEC April 2, 2007, p. 18, note 3 and page 19, note 3. (Applicant's Brief, p. 17). However, that 10-K annual report was not introduced into evidence, and may not be given any consideration

avoid." *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In addition to applicant's admission in its answer to opposer's amended notice of opposition that opposer's GAP marks have become famous,¹² applicant's owner testified that opposer's GAP marks are famous.

Q. Do you think that Gap is famous for their name for a company?

A. The Gap is famous for the name of a retail store.

Q. And what retail store is that?

A. The Gap.

Q. The party involved in this proceeding?

A. Correct.¹³

* * * *

Q. - - was Gap famous to you at the time you filed your application?

A. I don't know if they were as famous then as they are know.¹⁴

* * * *

Q. Do you see there at the bottom of page 2, the "Request for Admission No. 8," the answer to admit that

¹² Opposer's amended notice of opposition, ¶¶9 and 16. Applicant also acknowledged that opposer is "the owner of an admittedly famous family of marks" in its brief. (Applicant's Brief, p. 1).

¹³ Peterson Dep., p. 123.

¹⁴ Peterson Dep., p. 124.

Opposer's Mark - - in this case Gap
- - was famous for clothing prior
to the day of the filing of your
trademark application?

A. (Views document.) Yes.

Q. And you see on page 3 that it says,
"Admitted"?

A. (Views document.) Correct.

Q. Okay. Was it famous at the time
you picked "GAP One Enterprises" -
- the name of your company?

* * * *

A. Yeah, I guess so. I guess it was
famous at that time.¹⁵

See also Applicant's answers to opposer's second set of
requests for admission.

REQUEST FOR ADMISSIONS NO. 7:

Admit that Opposer's Mark is well
known to the general public in
connection with clothing.

ANSWER TO REQUEST FOR ADMISSIONS NO. 7:

Admitted.

REQUEST FOR ADMISSIONS NO. 8:

Admit that Opposer's mark was
famous in connection with clothing prior
to the filing date of Application Serial
No. 78/683,999.

ANSWER TO REQUEST FOR ADMISSIONS NO. 7:

Admitted.

¹⁵ Peterson Dep., p. 125.

Opposer also introduced other evidence to demonstrate that its GAP marks are famous. For example, opposer introduced testimony and evidence regarding its sales revenues and advertising expenditures. While this evidence was introduced under seal, we can report that those figures are substantial under any standard. In addition, opposer introduced numerous news articles and stories referring to the GAP mark as famous or well-known, including the following articles and stories:¹⁶

The Gap, *Business Week*, p. 58 (March 9, 1992).

Millard S. Drexler, 47, has turned The Gap into the most popular and profitable specialty clothing chain in American retailing today.

The World According To Gap, *The Sunday Oregonian* (September 13, 1992).

As ubiquitous as McDonald's, as centrally managed as the former Soviet Union, and as American as Mickey Mouse, Gap, Inc. has you covered from the cradle to at least 50.

* * *

Last year, Gap-labeled clothes became the second-largest selling brand name in the United States, after Levi Strauss.

* * *

Check it out:

¹⁶ The probative value of the news articles is that they show how the third parties perceive, or refer to, opposer's marks.

When Kelly, a character from "Beverly Hills, 90210," shows up on "Melrose Place," she is seen shopping at The Gap for something to captivate a 24-year old older man.

When speechwriter Peggy Noonan decries the sameness of the Democrats and Republicans, she writes that we are all becoming "Gapped, lined and Lancomed."

In Fashion, The Atlanta Journal and Constitution (October 10, 1993).

Famous for jean (sic) and T-shirts, The Gap is out to convince consumers that the "Gap Look" includes stretch pants and leather vests.

Runways Aglow With Mary Janes' Return, Pittsburgh Post-Gazette (May 11, 1994).

Gap Shoes - - the San Francisco chain famous for real clothes for real people - - has introduced two spring tributes to the Mary Jane.

1997 NRF Gold Medal Award Winner Donald G. Fisher Chairman of The Gap Inc., Stores Magazine (1997).

The Gap brand is synonymous with casual American sportswear, and Gap is regarded as one of the nation's top specialty retail chains. The Gap brand is second only to Levi Strauss in the number of units its sells, and the "Gap look" - characterized by khaki pants, denim jeans, woven denim shirts and the ubiquitous one-pocket T-shirt - has become an icon of American style.

The World According To Gap, Business Week (January 27, 1997).

After all, Gap may be opening a lot of new stores, but it isn't just a retailer anymore. Unless you think that Coca-Cola just makes soda pop.

European Makeup Sensation Lands Fans In U.S., *The Commercial Appeal* (March 12, 2000).

He wants Sephora to be a well-known brand like the Gap, which consumers trust for trendy, good quality merchandise that's constantly changing, drawing shoppers back again and again.

Preview 2004: Retail - Bay Area retail has much more in store, *San Francisco Business Times* (January 2, 2004).

Two of the city's most famous brand names, Gap Inc. and Levi Strauss & Co., are both in the midst of radical makeovers.

Gap, Old Navy generate industry buzz with Staton agreement, *Wearables Business* (February 1, 2006).

The greatest buzz at both the ASI Show in Orlando and the PPAI EXPO in Las Vegas last month was the breaking news that styles from the famous retailers The Gap and Old Navy are being offered to the corporate/promotional marketplace through venerable wholesaler Staton Corporate & Casual.

In view of the foregoing, opposer has established that its GAP trademarks are famous and thus entitled to a broad scope of protection.

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

Applicant contends that opposer's GAP marks are entitled to only a narrow scope of protection because the fame and strength of opposer's marks persist in a crowded field of "Gap" marks. In other words, opposer is not the only company that uses the word "Gap" as a part of its

mark.¹⁷ The basis for this argument is the third-party registrations consisting in part of the word "Gap" for a wide variety of products and services. These third-party registrations have little value in determining the issue of likelihood of confusion before us because they do not prove that the registered marks are in commercial use or that the public is familiar with them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993). Accordingly, there is no evidence of record to demonstrate that the public is so conditioned to the use of the word "Gap" in connection with any goods and services, let alone clothing, retail clothing services, and marketing services, that consumers will be able to distinguish the marks based on the additional word "One" in applicant's mark.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

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.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be

¹⁷ Applicant's Brief, pp. 14-16 and 20-21.

similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that 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 overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). In this regard, when, as here, an opposer's mark is famous, the degree of similarity between the marks need not be as great as when the opposer's mark is obscure or weak. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 22 USPQ2d at 1456. See also *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) ("less care may be taken in purchasing a product under a famous name"). In other words,

there is "no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous. . . ."

Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

With these principles in mind, we begin our analysis of the marks by noting that, although likelihood of confusion must be determined by analyzing the marks in their entirety, "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 consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, the word "Gap" is the dominant element of applicant's mark GAP ONE. It is the first word of the mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, supra (upon

encountering the marks, consumers must first notice the identical lead word).

In addition, the way in which applicant uses the mark GAP ONE emphasizes the dominance of the word "Gap." All of the sample advertising featuring applicant's mark display the word "Gap" in a larger font, as shown below, thus directing the consumer's attention to the word "Gap."¹⁸



Applicant also uses the advertising tagline, "Let us fill in the **gap** for you!" (with the word "Gap" emphasized).¹⁹

Thus, it is not surprising that George Peterson, applicant's owner, testified that the word "Gap" is the dominant part of applicant's mark.

Q. And that "gap" is the dominant part of the mark.

A. (Views document).²⁰ Yes.

Q. Okay. And that you consider the "gap" part of the mark to be the unique part of the mark?

A. (Views document). Yeah. Because that's George A. Peterson - -

Q. Okay.

¹⁸ Peterson Dep., Exhibits 11, 12, and 17. See also the specimens submitted as part of the application.

¹⁹ *Id.*

²⁰ Exhibit 11.

A. - - "gap."²¹

In comparing the two marks, we note that the applicant's mark GAP ONE contains Opposer's entire mark (*i.e.*, GAP). Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *Coca-Cola Bottling Co. v. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL LANCER and design for club soda, quinine, water and ginger ale is likely to cause confusion with BENGAL for gin); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY for dresses is likely to cause confusion with LILLI ANN for dresses); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re Cosvetic*, 202 USPQ 842 (TTAB 1979) (HEAD START COSVETIC and design for vitamins for hair conditioning, hair shampoo and hair conditioner is likely to cause confusion with HEADSTART for after-shave lotion).

Not only is the dominant part of the marks identical, but the additional word "One" in applicant's mark does not serve to distinguish the marks because it has a suggestive laudatory significance.²² See *Hoover Co. v. Royal Appliance*

²¹ Peterson Dep., pp. 177-178.

²² Also, Mr. Peterson testified that it was his understanding that GAP ONE was too close opposer's marks, and therefore he named his company GAP ONE ENTERPRISES to avoid a conflict. (Peterson Dep., pp. 13-15 and 124). Mr. Peterson further testified that he

Manufacturing Co., 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) ("Number One In Floor Care" is a generally laudatory phrase); *General Mills Inc. v. Health Valley Foods*, 24 USPQ 1270, 1277 (TTAB 1992) (when used in opposer's mark FIBER ONE, the word "One," has a laudatory meaning), citing *Hertz System, inc. v. A-Drive Corporation*, 222 USPQ 625, 630 n.14 (TTAB 1984) (the number "1" is widely used to indicate superiority); *Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736, 739 (TTAB 1983) (opposer's mark THE ONE may be suggestive of superiority). Accordingly, we find that in terms of appearance and sound the marks are similar.

Applicant argues that the marks of the parties have different meanings, and therefore engender different commercial impressions because the "Gap" part of applicant's mark GAP ONE was derived from Mr. Peterson's initials (*i.e.*, George A. Peterson).²³ A fundamental problem with applicant's argument that its mark is an acronym derived

always uses GAP ONE ENTERPRISES, that he never uses just GAP ONE, and that he has no intention of ever using just GAP ONE without the word "Enterprises." (Peterson Dep., pp. 58-59, 66-67, and 127). Applicant filed the application for GAP ONE, rather than GAP ONE ENTERPRISES, based on advice of counsel. Apparently, "the word 'Enterprises may have been - - not - - not be able to be trademarked of part of a trademark." (Peterson Dep., pp. 126-127).

²³ Peterson Dep., p. 11-13. As indicated above, Mr. Peterson recognized the similarity of his mark with opposer's marks and testified that he named his company GAP ONE ENTEPRISES to avoid confusion with THE GAP stores. (Peterson Dep., p. 13).

from Mr. Peterson's initials is that consumers are not likely to understand this from looking at the mark alone. Applicant has not depicted its mark with any periods, hyphens, or spaces between the letters in the word "Gap." Thus, when looking at the mark, there is no way for consumers to know that the word "Gap" in the mark GAP ONE is an acronym or initials. Even though Mr. Peterson testified that he always tells customers that "GAP ONE Enterprises means George A. Peterson,"²⁴ we may not consider applicant's sales pitch when we compare the marks because what applicant tells its customers is not part of applicant's mark. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) ("No consideration can be given to allegedly distinguishing features which are not part of the mark sought to be registered").

Also, it is not clear how adding the word "One" to applicant's mark leads consumers to interpret the word "Gap" as an acronym or initials. When considering applicant's mark in its entirety, GAP ONE is the combination of the words "Gap" and "One," without any indication that the word "Gap" is an acronym or that it is derived from initials.

It appears that applicant's use of the mark "Gap" is intended to reference an opening or an empty space in one's marketing program. On the other hand, opposer derived its GAP marks from the term "generation gap," referencing a

²⁴ Peterson Dep., p. 116.

divergence or difference in attitudes, perceptions, and character among generations.²⁵ However, to the extent that the meaning of opposer's GAP marks once referenced a generation gap, that meaning has long since ceased inasmuch as opposer is now a leading, national retailer that sells to every demographic.²⁶

Q. Who are the consumers for your products?

A. Everyone.

Q. All ages?

A. All ages.

We have products for newborn babies and we have products that people could wear well into their retirement years and all of the years in between.

Q. Do you have any business customers for your products?

A. Yes.²⁷

The word "Gap" in opposer's marks now engenders the same ordinary meaning of the word "Gap" as does applicant's mark (e.g., an opening or empty space), as illustrated by the "Fall Into The Gap" advertisements shown below.²⁸ Accordingly, the marks have similar meanings.

²⁵ Alonso Dep., p. 16.

²⁶ Alonso Dep., p. 101-102.

²⁷ *Id.*

²⁸ Alonso Dep., pp. 65-66; Exhibit 8 (e.g., Document Nos. 4322, 4141, 4143).

Levi's[®] for Guys & Gals!

Levi's! Levi's! Levi's![®]
Over 4 tons of great gift ideas.
14 thousand pairs in each store alone.
The newest styles, shapes and colors.
Neat Levi's Sta-Prest slacks.[®]
Smashing Levi's for Gals.[®] And Guys.
So wrap your favorite someone
in style this Christmas.
In Levi's. (From The Gap, of course.)

Have a fit.
Fall into The Gap.
It's The store for Levi's.



Likewise, the commercial impression engendered by the marks is similar.

While the marks of the parties are not identical, we find that they are similar in appearance, sound, meaning and commercial impression, and that this du Pont factor favors opposer.

D. The similarity or dissimilarity and nature of the goods or services.

Applicant is seeking to register its mark for "general business merchandising services, namely, marketing."

Applicant acts as a middleman or broker between vendors/suppliers and customers who want, among other things, personalized merchandise displaying trademarks and logos. George Peterson described applicant as "an

independent sales organization"²⁹ and "a commissioned sales agent."³⁰

GAP One Enterprises did not - - does not provide apparel. We provide the service of getting logo-imprinted items for the - - company or entities that provide those services.³¹

As shown below, applicant's telephone directory advertisement and its advertising flyers promote applicant's ability to provide personalized clothing.³²

GAP ONE ENTERPRISES
gap one
ENTERPRISES, L.L.C.
"Let Us Fill in the **gap** for You"
Logo Imprinted Items
Wearables • Printing • Silkscreen
Other Services:
Signage • ATM's • Pay Phones
Credit Card Systems • Vending Machines
And Much, Much More!
Whatever Your Business Needs
We Can Fill in the **gap**!
"We're Here To Serve You" 244-7617

gap one
ENTERPRISES, L.L.C.
Does...
**IMPRINTABLE
SPORTSWEAR**
EMBROIDERY - SCREENPRINTING
T-Shirts - Sports Shirts - Jackets - Caps
Sweats - Towels - Aprons - Tote Bags
Clubs - Teams - Leagues - Schools
Organizations - Corporations
See what we can do for you...
Call
(504) 431-GAP1



Let Us Fill in the GAP for You!
We are your ONE STOP SOURCE for
t-shirts, golf/polo shirts, ladies apparel,
jackets, hats, and more
(Screen Printed or Embroidered)
for:
❖ Employees ❖ Pool Leagues
❖ Dart Teams ❖ Resale
Call GEORGE today for a Quote!
504-415-1467 (Cellular)



Let Us Fill in the GAP for You!
We do Screen Printed or
Embroidered Wearables for:
Employees
Dart Teams
Pool Leagues
Resale
Call for Quotes
T-Shirts, Golf/Sports Shirts, Ladies
Apparel, Jackets, Hats
504-431-GAP1

²⁹ Peterson Dep., p. 67.

³⁰ Peterson Dep., p. 71.

³¹ Peterson Dep., pp. 81-82.

³² Peterson Dep., Exhibits 10 and 11.

On the other hand, while opposer has registered its marks for, *inter alia*, retail clothing store services, clothing, tote bags, and bath linens (all products that applicant will broker), opposer also sells personalized apparel and accessories such as bags, wallets, frames and credit card holders, displaying customers' logos and trademarks.³³ Accordingly, applicant's marketing services and opposer's sales of personalized products are essentially identical, or at least very highly related: applicant is a commissioned sales agent for personalized products, including, but not limited to, apparel and other products, and opposer is a vendor of personalized apparel and accessories.

The fact that clothing products are only one of many products that applicant will broker does not diminish the relatedness of applicant's services and opposer's goods and services. See *Tuxedo Monopoly, Inc. v. General Mills Fund Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Applicant argues, in essence, that marketing services *per se* and clothing are not related. However, applicant

³³ Alonso Dep., pp. 102-103, and 106-111; Exhibit 28 (Corporate Apparel and Gift Catalog, Spring/Summer 2006).

ignores the fact that it will arrange for the sale of personalized apparel while opposer sells personalized apparel. Presumably, the reason applicant ignores this fact is because it asserts that opposer has abandoned its sale of personalized clothing and accessories. Unfortunately, for applicant, this argument is unsupported by any evidence or testimony, and therefore may not be given any consideration.³⁴

Even assuming, *arguendo*, that opposer no longer sells personalized apparel and accessories, when a famous mark is part of the equation in determining the issue of likelihood of confusion, "special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark." *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Cir. 2002). Thus, a consumer is likely to believe that opposer, whose GAP marks are famous for clothing and retail store services in the field of clothing, is the source of GAP ONE marketing services that include personalized apparel and other related products.

E. The similarity or dissimilarity of established, likely-to-continue trade channels and classes of consumers.

Because applicant's marketing services and opposer's sales of personalized apparel are essentially the same, or very highly related, we must presume that the channels of

³⁴ See the discussion regarding priority and footnote 11 *supra*.

trade and purchasers would be the same (*i.e.*, applicant renders its marketing services to the same consumers to whom opposer will sell its personalized apparel). *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). *See also Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchaser through the same channels of trade").

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

Applicant argues that consumers exercise a high degree of care in deciding to use its marketing services: "The decision to engage in merchandising is itself a sophisticated act."³⁵ "Merchandising is not an 'impulse' or even an 'instant' purchase."³⁶

Typically, applicant makes a sale when Mr. Peterson calls the person at a company empowered to buy corporate apparel or logo-imprinted products. Initially, Mr. Peterson

³⁵ Applicant's Brief, p. 18.

³⁶ Applicant's Brief, p. 18.

makes an appointment to meet the customer representative to determine whether the company has a marketing need applicant can satisfy.³⁷ During the initial sales presentation, Mr. Peterson always tells the customer representative the following:

GAP One Enterprises means George A. Peterson, one man enterprise. I've been doing this for ten years. And we just fill in the - - we're here to fill in the gap for you. Whatever you need, we can do.³⁸

Once Mr. Peterson finds out what the customer wants in terms of corporate apparel or imprinted merchandise, he contacts a supplier to get a price which he forwards to the customer.³⁹ The majority of applicant's customers are bars and restaurants, pool leagues, and dart leagues. Essentially, applicant's customers are businesses that want to buy shirts for their employees or sell them to customers.⁴⁰

Applicant is simply Mr. Peterson's alter ego. Applicant's sales of personalized apparel and imprinted merchandise are made through personal sales calls by Mr. Peterson where customers meet "applicant." So long as applicant remains a "one man enterprise," the conditions

³⁷ Peterson Dep., pp. 113-114.

³⁸ Peterson Dep., p. 116.

³⁹ Peterson Dep., pp. 116-117.

⁴⁰ Peterson Dep., pp. 101-103.

under which applicant's sales are made weigh against finding that there is a likelihood of confusion.

However, we do not rest our analysis of the conditions of purchase on the manner in which applicant currently offers its services, but on how such services may be offered in the future, as defined by the identification in the application. Thus, even if the personal sales calls element were missing, applicant's services are still directed toward businesses that intend to order "logoed" merchandise to promote their businesses or organizations as part of their own marketing efforts. Presumably, these customers will exercise a high degree of care in making their purchases because applicant's services (and the logoed products it brokers) are for promoting the customers' businesses.

Accordingly, this factor favors applicant.

F. The nature and extent of any actual confusion.

While there have been no reported instances of actual confusion,⁴¹ we do not find this fact particularly compelling. Applicant has promoted its services through "word of mouth" and by a listing in the New Orleans East telephone directory.⁴² Applicant has not done any

⁴¹ Opposer's responses to Interrogatory Nos. 2 and 3.

⁴² Peterson Dep., p. 106. As part of its "word of mouth advertising," Mr. Peterson has spoken to people at trade shows that he has attended related to his other businesses. (Peterson Dep., p. 108).

newspaper, magazine, radio or television advertising.⁴³
Applicant has not been an exhibitor at any trade shows.⁴⁴
Applicant is a "one man business,"⁴⁵ and applicant's principal, Mr. Peterson, has devoted most his energies to building the other businesses that he is involved in.⁴⁶
Under these circumstances, applicant has failed to show that it has made even a minimal impact in the market, and therefore there has not been an opportunity for actual confusion to have occurred. This factor is therefore neutral.

G. Balancing the factors.

When, as here, the opposer's trademark is a strong, famous mark, it can never be of "little consequence". *Specialty Brands v. Coffee Bean Distributors*, 223 USPQ at 1284 ("The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name").
Therefore, a famous trademark is entitled to a broad scope of protection or exclusivity of use. In view of the facts that the applicant's services and opposer's clothing and retail clothing store services are related, as well as the fact that opposer also sells clothing personalized with

⁴³ Peterson Dep., pp. 106-107.

⁴⁴ Peterson Dep., p. 108.

⁴⁵ Peterson Dep., p. 110.

⁴⁶ Peterson Dep., p. 100.

company logos and trademarks, that the goods and services of the parties must be deemed to move in similar channels of trade and be offered to the same consumers, and that the marks are similar, opposer has shown that applicant's use of the mark GAP ONE in connection with "general merchandising services, namely marketing," is likely to cause confusion with opposer's GAP trademarks. In reaching this decision, we note that there is "no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 12 USPQ2d at 1904, quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

Because we have found that there is a likelihood of confusion, we do not reach the issue of dilution.

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