

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
October 17, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Li & Fung (B.V.I.) Limited

v.

Kenosha Ferrell

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Opposition No. 91174386  
to application Serial No. 78761667  
filed on November 28, 2005

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Brent E. Routman of Merchant & Gould, P.C. for Li & Fung  
(B.V.I.) Limited.

Kenosha Ferrell, pro se.

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Before Seeherman, Quinn and Hohein, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Li & Fung (B.V.I.) Limited has opposed, on the ground  
of likelihood of confusion, the application of Kenosha  
Ferrell to register the mark Black Cat Beauty (in typed  
form, with upper and lower case letters as shown) for the  
following goods:

Baseball caps; baseball shoes; bathing  
caps; bed jackets; cap visors; capri  
pants; caps; caps with visors; denim  
jackets; denims; down jackets;

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fishermen's jackets; fur coats and jackets; fur jackets; golf caps; headgear, namely, caps; heavy jackets; jackets; jogging pants; knitted caps; leather jackets; leather pants; light-reflecting jackets; long jackets; men and women jackets [sic], coats, trousers, vests; mock turtle-neck sweaters; nurse pants; pants; rain jackets; rainproof jackets; short-sleeved or long-sleeved t-shirts; shower caps; ski jackets; ski pants; skull caps; sleeved or sleeveless jackets; smoking jackets; snow pants; snowboard pants; sports jackets; suede jackets; sweat pants; sweaters; swimming caps; t-shirts; tap pants; toboggan hats, pants and caps; track pants; turtleneck sweaters; v-neck sweaters; waterproof jackets and pants; wind resistant jackets; wind-jackets.

In particular, opposer has alleged that since prior to the filing date of applicant's application, or any date of actual use on which applicant can rely, opposer has used the mark BLACK CAT or marks incorporating BLACK CAT in connection with fireworks and firecrackers; that opposer owns applications for the marks BLACK CAT and BLACK CAT and design for various items of clothing, and an application for the mark BLACK CAT and design for masquerade costumes and the like; that opposer owns several registrations for BLACK CAT and BLACK CAT marks for firecrackers and fireworks; that opposer's marks are famous; that opposer "has a bona fide intent to sell clothing and other items in Class 25 as evidenced by the Opposer's pending applications and therefore Opposer has 'bridged the gap' in demonstrating its

interest in preserving avenues of expansion and areas related to the goods already sold by the Opposer in the United States"; that applicant's mark is likely to cause confusion with opposer's "previously filed" "BLACK CAT mark" [sic]; and that applicant's mark is likely to cause confusion with opposer's registrations Nos. 828730, 2999612, 2999953, 3087068 and 3107457.<sup>1</sup>

Applicant has denied the essential allegations of the notice of opposition in his answer.

The record includes the pleadings, the file of the opposed application, and the testimony deposition, with exhibits, of Harrison Chang, the managing director of Golden Gate Investment Management, which is a unit of opposer. Applicant did not submit any evidence. Only opposer filed a trial brief.

We begin with an evidentiary point. Opposer pleaded ownership of several registrations in its notice of opposition, and introduced "soft" copies of those

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<sup>1</sup> In its brief opposer argued that it has a family of marks. Opposer, however, did not plead a family of marks in its notice of opposition, nor do we find that this issue was tried. The only reference to a "family of marks" was in one of opposer's counsel's questions: "Is it fair to say that in your prior testimony that other objects also bear the Black Cat family trademarks," test. p. 33. The answer went on to list products, rather than to discuss the different marks. This interchange was not sufficient to put applicant on notice that opposer was claiming a family of marks, and thus we cannot conclude that the issue of a family of marks was tried by consent.

Opposer also argues in its brief that applicant's mark will dilute opposer's BLACK CAT mark. This issue was neither pleaded nor tried, and we have given it no consideration.

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registrations through the testimony of Mr. Chang. However, this testimony was not sufficient to make the registrations of record. Because the registrations submitted as exhibits were not status and title copies, it was incumbent on opposer to provide evidence that the registrations were currently owned by opposer, and that they were "live" registrations at the time they were introduced. See Trademark Rule 2.122(d)(2). However, the testimony of Mr. Chang merely recited what the registrations showed on their face. Here is a typical interchange:

- Q: Do you recognize this document?  
A: Yes.  
Q: Can you identify what this document is?  
A: This is a Certificate of Registration from the U.S. Patent and Trademark Office for the mark Black Cat X series. And this one has a design on it, so it's not just words.  
Q: Is this a true and original copy of the document?  
A: Yes.  
Q: What is the date provided on the registration?  
A: May 2<sup>nd</sup>, 2006.  
Q: Who is listed as the owner?  
A: Li & Fung (B.V.I.) Limited.  
Q: And what goods are covered by this mark?  
A: Fireworks and firecrackers.

With that opposer's attorney had the document entered as exhibit 6, and went on to elicit similar information for the next registration exhibit. Thus, there was no testimony

that the registration was current, or currently owned by opposer.

Although opposer thus cannot rely on its pleaded registrations, it has demonstrated common law rights in BLACK CAT marks. The evidence of record shows opposer began using the mark BLACK CAT in the United States in 1952 for fireworks and firecrackers, and since then has also used variations of this mark, such as BLACK CAT with a cat face design, BLACK CAT GOLD COLLECTION and design, and BLACK CAT X SERIES and design. Opposer sells these goods to wholesalers who in turn sell to retailers, and ultimately consumers buy the fireworks from retail outlets, including stores, tents and stands. Opposer sells its fireworks in the 45 states in which such consumer sales are allowed.

In addition to fireworks, opposer uses or licenses its various BLACK CAT marks for other items, including mopeds. In 1992 it began offering, through its catalog, t-shirts and baseball caps, and subsequently sold denim shirts, windbreakers, boxer shorts, polo shirts and belt buckles. A brochure from the Black Cat 200 NASCAR race, which it sponsored in 2004, shows use in connection with polo shirts, lady's tank tops, t-shirts and racing caps. Opposer started selling fashion t-shirts in 2005. In addition, opposer entered into a license agreement with Levi Strauss in 2005, through which BLACK CAT t-shirts were sold in fall 2005 and

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spring 2006. Another licensee sells bicycle racing jerseys with BLACK CAT and the cat design logo, and opposer had a previous arrangement with a licensee through which t-shirts were sold to a mall-based retailer called Hot Topping. Opposer also sells its clothing items directly to the consumer through its website, and has been doing so since at least 2004.

Opposer promotes its BLACK CAT marks and goods through a newsletter which is sent to retailers and wholesalers; it will also send the newsletter to ultimate buyers who request it. Opposer sponsors sweepstakes and contests, and in 2004 it sponsored a race, the above-noted Black Cat 200, at a NASCAR event in Wisconsin. It does not do direct consumer advertising itself, but participates in a 50% co-op advertising program with its fireworks dealers, who in turn advertise on radio, television, billboards and in theaters and newspapers. In 2006 opposer spent \$325,000 for such co-op advertising, which meant that its dealers spent at least that amount as well. When opposer's expenditures for sweepstakes and contests and the expenditures of its dealers are included, a minimum of \$750,000 for advertising and promotion was spent in 2006.

Opposer has established its standing by its evidence of use of its BLACK CAT marks for fireworks and apparel. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842

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(Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Turning to the issue of likelihood of confusion, we will confine our analysis to a consideration of opposer's word mark BLACK CAT, since this mark is the closest to the Black Cat Beauty mark of applicant. We will also confine our comments to opposer's use of this mark for apparel, since these goods are closest to those for which applicant is seeking to register his mark.

The evidence shows that opposer has priority. It has used the mark BLACK CAT, as well as variations of this mark, on t-shirts and caps since 1992, and has continued to sell such goods, while adding other apparel items subsequently. These uses predate the November 28, 2005 filing date of applicant's application which, because applicant has not submitted evidence of any earlier use, is the earliest date on which applicant can rely.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and

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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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the goods, opposer has shown that it has used the mark BLACK CAT on goods that are identical in part to applicant's identified goods, namely, t-shirts and caps. We need not discuss the other items of apparel that are listed in applicant's application (although it is clear that opposer's goods are closely related to many of applicant's other goods), because 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 in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). The du Pont factor of the similarity of the goods favors a finding of likelihood of confusion.

Because opposer's rights in its mark are based on common law, rather than a registration, we must look at the actual channels of trade in which opposer's goods are sold. The testimony shows that at least opposer's licensed apparel products were sold in department stores such as Kohl's, rather than in retail outlets that sell fireworks, and that they were sold in such stores in the fall of 2005. They

also continue to be sold in mainstream outlets. Moreover, even those consumers who encounter opposer's apparel items only in fireworks stores would also purchase the general apparel items that are listed in applicant's identification of goods. Thus, the same classes of consumers are likely to encounter both parties' goods. This du Pont factor, too, favors a finding of likelihood of confusion.

The consumers of opposer's and applicant's goods are the public at large, and they cannot be considered to be sophisticated purchasers. Further, applicant's identified goods, as well as the apparel sold by opposer, must be deemed to be relatively inexpensive items, e.g., caps and t-shirts, that may be purchased on impulse and without a great deal of care. The du Pont factor of the conditions of purchase favors a finding of likelihood of confusion.

This brings us to a consideration of the marks, keeping in mind that when marks would appear on virtually identical goods or services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Opposer's mark BLACK CAT is an inherently distinctive mark. It is an arbitrary term for items of apparel, and there is no evidence of third-party use of BLACK CAT marks or, for that matter, any CAT marks

whatsoever. Therefore, opposer's mark must be considered a strong mark. Applicant has appropriated opposer's mark BLACK CAT in its entirety, and added the laudatory word BEAUTY to it. This additional word, however, is not sufficient to distinguish the marks. The words BLACK CAT in applicant's mark still retain their significance, such that the marks are similar in appearance, pronunciation, connotation and commercial impression. Consumers who are familiar with opposer's BLACK CAT marks for items of apparel are likely to believe, when they view "Black Cat Beauty" on identical or similar items, that the latter mark is a variation of opposer's BLACK CAT mark, to indicate a fashion line of opposer's products. The du Pont factors relating to the similarity of the marks and the strength of opposer's mark favor a finding of likelihood of confusion.

Although we have found opposer's mark to be strong and distinctive, we do not find it to be famous, as opposer asserts. We acknowledge that opposer's argument is that its mark is famous for fireworks, and our discussion of likelihood of confusion is confined to opposer's use of BLACK CAT for apparel. But considering the fame of the mark for fireworks, we cannot conclude, based on the evidence of record, that BLACK CAT is famous for fireworks. In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives,

and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it. Here, although there is testimony that opposer has used the mark for fireworks for a long period of time, opposer has submitted no evidence of its sales, and the evidence regarding its advertising is relatively meager. For example, opposer has not submitted any evidence of advertisements that are directed to ultimate consumers, as opposed to newsletters that are primarily distributed to dealers. We acknowledge that opposer's witness testified that in the last 2-3 years it has hired a professional market research firm to conduct surveys to determine the recognition factor of its mark, with results of an 85-90% recognition factor based on this data, but opposer has not submitted either the survey or even the report by the research firm. The most information we have is a comment in its August 1, 2006 newsletter (exhibit 9) that said a survey of 600 consumers of fireworks were asked 25 questions, and that 82% of respondents (not the 85-90% to which Mr. Chang testified) were aware of it.

We find the remaining du Pont factors on which there is evidence or argument to be neutral. In particular, the lack of evidence of actual confusion has no persuasive value

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because there is no evidence that applicant has actually used his mark on any goods.

After considering all the relevant du Pont factors, we find that opposer has established that applicant's mark, if used for his identified goods, is likely to cause confusion with opposer's mark BLACK CAT for t-shirts and caps.

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