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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Montrail Corporation.
v.
Jennifer Wright-Tubbs

Opposition No. 91175338

Paula Jill Krasny, John C. Filosa and M. Tally George of Baker & McKenzie LLP for Montrail Corporation.

Marvin Feldman of Lackenbach Siegel LLP for Jennifer Wright-Tubbs.

Before Holtzman, Walsh and Bergsman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Jennifer Wright-Tubbs (applicant) has filed an application to register the mark shown below for "sports attire, namely, shirts, hats, shorts, pants and shoes" in Class 25.¹

¹ Application Serial No. 78783919 was filed January 3, 2006 based on an allegation of a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use, accepted by the examining attorney, wherein applicant asserted dates of first use and first use in commerce on March 10, 2006. The application includes the statement: "The mark consists of a heart-shaped design, divided vertically down the middle, with the left half consisting of the left-half of a heart and the right half consisting of the side view of a



Montrail Corporation (opposer) filed a notice of opposition on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act. In particular, opposer alleges that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used mark RUN LIKE A GIRL for apparel as to be likely to cause confusion. Opposer asserts, in paragraphs 2 and 6 of the notice of opposition, that opposer is the owner of application Serial No. 78873086 for the mark RUN LIKE A GIRL for hats and t-shirts; and that the subject application has been cited as a potential Section 2(d) bar to registration of opposer's mark.

Applicant, in her answer, admits the allegations in paragraphs 2 and 6 of the opposition. Applicant has denied the remaining salient allegations.

The record includes the pleadings; the file of the involved application; and opposer's notice of reliance on evidence including a certified status and title copy of Registration No.

running shoe with the heel at the top and the toe at the bottom; together with the word 'RUNLIKEAGIRL.'

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3310020 for the mark RUN LIKE A GIRL for "organizing sporting events, namely, running races" in Class 41;² the file for opposer's application Serial No. 78873086 for the mark RUN LIKE A GIRL for "hats; T-shirts" with an Office action advising opposer that registration will be refused when the subject application matures into a registration; opposer's unanswered requests for admissions to applicant.³

Applicant did not introduce any testimony or other evidence in her own behalf. Only opposer filed a brief.

Because applicant failed to respond to opposer's requests for admissions, each of opposer's requests is deemed admitted and, moreover, each fact in the requests deemed admitted is "conclusively established."⁴ Fed. R. Civ. P. 36(a)(3) and (b).

² This registration was not pleaded by opposer in the notice of opposition. However, because applicant has not objected to opposer's reliance on the unpleaded registration, we find that the registration was tried with applicant's implied consent. Accordingly, we deem the opposition amended in accordance with Fed. R. Civ. P. 15(b) to conform to the evidence.

³ Opposer also seeks to introduce, by its notice of reliance, a copy of a "purchase order" for an advertisement in "Dandelion Magazine" as well as a copy of an advertisement "placed for events in 2003" that allegedly appeared in that magazine (Exh. 4). The purchase order is not admissible by notice of reliance as it is not a printed publication within the meaning of Trademark Rule 2.122(e). Therefore, this evidence will not be considered. Furthermore, it is not otherwise clear that the advertisement was actually published; but even assuming it was, the advertisement would not be admissible for opposer's intended purpose, that is to prove that the "events" in the advertisement actually occurred, or that they took place on a particular date. See, e.g., Fischer Gesellschaft m.b.H. v. Molnar and Company, Inc., 203 USPQ 861, 864 n.3 (TTAB 1979).

⁴ Nevertheless, the Board retains the authority to decide the ultimate issue of likelihood of confusion and that finding cannot be delegated despite the facts deemed admitted.

Applicant's admissions include the following:⁵

Opposer is the owner of application Serial No. 78873086 for the mark RUN LIKE A GIRL, and the subject application has been cited as a potential Section 2(d) bar to registration of opposer's mark (Req. Nos. 20, 25);

Opposer's mark RUN LIKE A GIRL was first used in commerce in connection with hats and t-shirts in 2002 (Req. No. 23);

Applicant's mark RUNLIKEAGIRL (and design) was not used in commerce prior to 2005 (Req. No. 30);

Opposer's mark RUN LIKE A GIRL has priority of use over applicant's mark (Req. No. 24);

Opposer's mark RUN LIKE A GIRL is distinctive "for goods in Class 25" (Req. No. 47);

Opposer's mark RUN LIKE A GIRL and applicant's mark RUNLIKEAGIRL and design are similar in sound, appearance, connotation and overall commercial impression (Req. Nos. 51-54);

The goods in use by opposer, i.e., hats and t-shirts, are the same as, and/or similar to, the goods in the involved application (Req. Nos. 58, 59);

Both applicant's and opposer's goods are sold or distributed at sporting events (Req. No. 65); and

Opposer's and applicant's goods travel in the same trade channels (Req. Nos. 60, 63); and the goods are sold to similar consumers (Req. No. 66).

Standing and Priority

Applicant's admissions, and opposer's evidence of ownership of an application that will be refused registration when

⁵ In the instructions for opposer's requests for admissions, opposer states that "Opposer's Mark" refers to the mark RUN LIKE A GIRL covering "hats, t-shirts" and common law rights thereto; and that "Applicant's Mark" refers to the mark RUNLIKEAGIRL and design as set forth in the subject application. We have construed the requests in accordance with opposer's instructions.

applicant's application matures into a registration, demonstrate opposer's standing to bring the opposition. Furthermore, applicant's admissions establish opposer's priority of use of the distinctive mark RUN LIKE A GIRL for hats and t-shirts.

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 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 or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Opposer has established, through applicant's admissions, that opposer's hats and t-shirts are the same as, and/or similar to, the goods identified in the application - "sports attire, namely, shirts, hats, shorts, pants and shoes." Applicant's admissions further establish that the respective goods are sold in the same channels of trade, including at sporting events, to the same types of purchasers.

In addition, applicant's admissions establish that opposer's mark RUN LIKE A GIRL and applicant's mark RUNLIKEAGIRL (and design) are similar in sound, appearance, connotation and overall commercial impression. In fact, the marks are identical in

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sound, and to that extent, applicant has appropriated opposer's mark in its entirety. Furthermore, the identity of the word portions of the marks far outweighs any differences due to the design element in applicant's mark or the display of the words in her mark as a single term. See *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"). The word portion of a composite word and design mark is generally accorded greater weight because it would be used by purchasers to request the goods. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

We find that because substantially similar marks are used on identical and otherwise similar goods, likelihood of confusion exists.

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