

Mailed:
November 5, 2008

This Opinion is Not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ACI International
v.
Ned W. Branthover

Opposition No. 91175652
to application Serial No. 78827121
filed on March 2, 2006

Louis J. Bovasso of Greenberg Traurig, LLP for ACI
International.

Ned W. Branthover, Esq., pro se.

Before Rogers, Kuhlke and Ritchie de Larena, Administrative
Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Ned W. Branthover (applicant) has applied to register
the mark DENALI for goods identified as "footwear" in Class
25. The application is based on applicant's stated
intention to use the mark in commerce for the identified
goods and was not amended during prosecution to assert
actual use of the mark.

ACI International (opposer) has opposed the
application, asserting that it has used the mark DENALI for

footwear continuously "since long before the date of filing of Applicant's intent-to-use application." Notice of opposition, ¶1. Opposer also pleaded that there will be a likelihood of confusion because the marks and goods are the same.

Applicant admitted only opposer's allegations related to the filing of applicant's application and the publication of the mark for opposition, but otherwise denied the substantive allegations in the notice of opposition.

It does not appear that either party took discovery. Opposer took the testimony of its executive vice president, Jeffrey Glazier (Glazier dep.), during its assigned testimony period, and later filed the transcript of such testimony, and accompanying exhibits.¹ The witness was sworn in for his testimony but did not sign the transcript. Applicant submitted no testimony or evidence. Opposer filed a brief on the case, but applicant did not.

As noted, opposer's witness did not sign the transcript of his testimony. We have, nonetheless, considered such testimony, notwithstanding that Trademark Rule 2.123(e)(5) states that a transcript of testimony shall be read and signed by the witness, unless the reading and signature requirements are waived on the record by all parties. In

¹ Applicant was provided notice that testimony would be taken by opposer but did not attend the deposition. Glazier dep., "certification" of M. Sean McMillan who conducted the deposition.

this case, applicant did not attend the Glazier testimony deposition. Clearly, then, all parties could not have waived reading and signature on the record. However, in its brief on the case, in its description of the record, opposer noted that the testimony was unsigned. Applicant neither filed a responsive brief nor filed any separate objection to consideration of the testimony. Accordingly, we have considered the testimony. See *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001).

As for opposer's standing, opposer pleaded, and the record supports the pleading, that it has used the involved mark for the same or similar goods as those identified by applicant in the involved application. Opposer has therefore established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Opposer did not claim ownership of a registration for its DENALI mark. A party opposing registration of another's mark on the basis of likelihood of confusion with its own unregistered mark must establish that the unregistered mark is distinctive of its goods or services either inherently or through the acquisition of secondary meaning. See *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990). There is no question that the mark DENALI for footwear is inherently distinctive. Applicant

seeks registration of its mark on the Principal Register without resort to a claim of acquired distinctiveness; and although the term may have some geographic significance to some prospective purchasers of footwear,² there is no evidence of record tending to establish that the term is either geographically descriptive or geographically misdescriptive for such goods.

Turning to the question of priority, the earliest date on which applicant can rely is the filing date of its application, specifically, March 2, 2006. In contrast, opposer has been selling "hikers" bearing the mark DENALI for "four to five years" prior to January 2008. Glazier dep. p. 5. Significant sales have been made through approximately 600 retail stores in the Western and Midwestern United States. Glazier dep. pp. 18-19. From 2004 through January 2008, annual sales and pending orders of various types of DENALI footwear for one retailer ("Big 5") have exceeded 115,000 pairs worth more than one million dollars. Glazier dep. exh. 4. In view of the record

² The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In this instance, we note the presence of an entry for DENALI NATIONAL PARK in The Random House Dictionary of the English Language (2d ed. 1987), p. 531: "a national park in S central Alaska, including Mount McKinley. 3030 sq. mi. (7850 sq. km). Formerly, Mount McKinley National Park." We also note that there is no entry for DENALI or DENALI NATIONAL PARK in Webster's Third New International Dictionary (1993).

evidence, we hold for opposer on the issue of priority³ and turn our attention to the question of likelihood of confusion.

We analyze the issue of likelihood of confusion using the factors that were articulated in the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

"The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted). In many cases, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. See, e.g., *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). The case at hand is such a case.

Legally, the marks are identical. Applicant seeks registration of DENALI in standard character form and

³ We note that the record is clear not only that opposer is the prior user of DENALI, but that its use since it first adopted the mark has been continuing and has not been abandoned.

opposer provided evidence showing its use of the mark DENALI in a simple block letter form on shoe boxes. Glazier dep. pp. 11-12, exh. 3. Under our required analysis, we must assume that applicant could use its mark in the same typeface or font as that used by opposer. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). The fact that the marks are identical "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1729 (TTAB 2003).

Turning to the goods, applicant's identification simply of "footwear" must be read to include all types of footwear, and therefore must be read to include opposer's "hikers." See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application...."), and *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, because applicant's identification of goods includes no restrictions as to channels of trade or classes of purchasers, we must assume that the goods could be

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marketed in any customary channels of trade for footwear and to all possible purchasers of footwear, including those targeted by opposer. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983), and *Interstate Brand Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1913 (TTAB 2000).

Opposer argues in its brief that the involved goods may be inexpensive and purchased on impulse and that its mark is famous. The record is lacking on the former point, though we readily conclude that because applicant's identification is not limited, it must be read to include footwear at all price points, including lower-priced or discount footwear which may be purchased without significant deliberation. As for the purported fame of opposer's mark, we cannot find it famous on the record presented.

Balancing the few likelihood of confusion factors for which evidence is of record, it is clear that a likelihood of confusion exists.

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