

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

Mailed:
October 10, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bear U.S.A., Inc.

v.

Dada Corporation

Opposition No. 91176592
to application Serial No. 78695990
filed on August 18, 2005

Timothy J. Kelly of Fitzpatrick, Cella, Harper & Scinto for
Bear U.S.A., Inc.

Do Hyun Park for Dada Corporation.

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Bear U.S.A., Inc. has opposed, on the ground of
likelihood of confusion, the application of Dada Corporation
to register PINK BEAR as a trademark for "clothing namely
hats, caps and headwear, headbands, jerseys, jackets, jeans,
casual wear namely shorts, pants, T-shirts, overcoats,

Opposition No. 91176592

shoes.”¹ In particular, opposer has alleged that since as early as 1993, well prior to the filing date of applicant’s intent-to-use application, opposer has used in commerce its BEAR trademarks, including BEAR, BEAR MOUNTAIN, BABY BEAR, BEAR MAX, BEAR U.S.A. and BEAR U.S.A. and design, in connection with clothing products; that as a result of opposer’s sales, advertising and promotion, the BEAR trademarks became famous prior to the filing date of applicant’s application; that opposer owns a number of trademark applications and registrations; and that applicant’s use of its mark for its identified goods is likely to cause confusion or mistake or to deceive.

In its answer applicant denied the allegations set forth in the notice of opposition.

The record includes the pleadings, the file of the opposed application; the testimony, with exhibits, of Thomas Hong, opposer’s president; and copies of opposer’s pleaded registrations, to wit:²

MARK	GOODS
BEAR	Clothing, namely parkas, jackets, shirts, hats, headbands and footwear ³

¹ Opposer also pleaded in the notice of opposition that applicant’s mark will dilute its famous BEAR trademarks. However, opposer did not discuss this ground in its trial brief, and we therefore have given it no further consideration.

² Opposer did not submit copies of all of the registrations it pleaded in the notice of opposition. No consideration has been given to those registrations which were not made of record.

³ Registration No. 3038588, issued January 10, 2006.

BEAR-MAX	Clothing, namely, parkas, jackets ⁴
BABY BEAR	Clothing, namely, parkas, jackets, sweatshirts and shorts ⁵
BABY BEAR	Clothing, namely, footwear, shirts, hats, pants, socks, gloves, mittens, scarves and caps ⁶
	Clothing, namely, parkas, shirts, hats, sweatshirts, jackets, pants, shorts, socks, gloves, mittens, scarves and caps ⁷
 (USA disclaimed)	All purpose athletic, sport and duffel bags ⁸
 (USA disclaimed)	Parkas and jackets ⁹
 (USA disclaimed)	Clothing, namely parkas and jackets ¹⁰

⁴ Registration No. 2191596, issued September 22, 1998; Section 8 affidavit accepted.

⁵ Registration No. 2286759; Section 8 & 15 affidavits accepted and acknowledged.

⁶ Registration No. 2559155, issued April 9, 2002. Section 8 & 15 affidavits were filed on October 8, 2008. They have not yet been acted on by the USPTO.

⁷ Registration No. 2556355, issued April 2, 2002. Section 8 & 15 affidavits were filed on October 2, 2008. They have not yet been acted on by the USPTO.

⁸ Registration No. 2559096, issued April 9, 2002. Section 8 & 15 affidavits were filed on October 8, 2008. They have not yet been acted on by the USPTO.

⁹ Registration No. 2700829, issued March 25, 2003.

¹⁰ Registration No. 2997379, issued September 20, 2005.

	All purpose athletic sport and duffel bags; clothing, namely sweaters, gloves, headbands and footwear, including shoes and boots ¹¹
 (USA disclaimed)	Clothing, namely, parkas, jackets, sweaters, sweatshirts, t-shirts, pants, jeans, shorts, socks hats, caps, gloves and headbands ¹²
BEAR MOUNTAIN	Clothing, namely parkas and vests ¹³

Applicant did not submit any evidence in its behalf, and only opposer filed a trial brief.

The evidence of record shows that opposer was formed in 1994. It designs, manufactures, imports and sells apparel and accessories. Since 1994 it has used various BEAR trademarks for its products. The products include outerwear, such as insulated and non-insulated jackets, parkas and coats; sportswear which includes t-shirts, women's shirts, and sweatshirts; footwear items and accessories, which includes hats, caps, headbands and gloves. Among the first products it sold were a vest and a parka with the mark BEAR MOUNTAIN. Subsequently marks such as BEAR USA, BEAR per se and BEAR with the design of a bear were used.

¹¹ Registration No. 2623471, issued September 24, 2002.

¹² Registration No. 2691242, issued February 25, 2003.

¹³ Registration No. 2384568, issued September 12, 2000; Section 8 & 15 affidavits accepted and acknowledged.

Opposition No. 91176592

Opposer sells its products in department stores such as Macy's, Bloomingdale's and Nordstrom, regional chain stores such as Modell's Sporting Goods, and independently family-owned (mom and pop) specialty stores throughout the country. Although the products originally had their strongest appeal to the urban consumer, their appeal now is primarily mainstream to both genders and various races in the 18-35 year old category. The retail prices for outerwear jackets range from \$70-\$250, while the sportswear products are in the \$60-\$80 range, and accessories such as hats would be in the \$20-\$30 range. Since the company started it has sold about \$110 million in the United States, with more than twice that in global sales.

Opposer advertises its goods in fashion and consumer magazines, such as "Stuff," "FHM" and "Blender," and has promoted them through product placement in television shows such as "Fresh Prince of Bel-Air," and through cooperative or cross-marketing advertising, including contests and events. Opposer has also been involved in community service activities, including donating its BEAR USA brand jackets to needy children in New York City, for which it has received press coverage. Since the inception of the company it has spent over \$7 million on advertising and promotion. In addition, opposer's products have been featured by magazine fashion editors in fashion editorials.

Opposition No. 91176592

Opposer has demonstrated its standing by virtue of its registrations and use of various BEAR marks. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Further, because opposer's registrations are of record, priority is not in issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

This brings us to the issue of likelihood of confusion. Our determination of this issue 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, 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Because opposer's registration for BEAR for parkas, jackets, shirts, hats, headbands and footwear is the most similar to applicant's mark and goods, we will confine our discussion to this registration.

Opposition No. 91176592

Opposer's and applicant's goods are identical in part, and otherwise closely related. In particular, applicant's identification of goods includes jackets, hats, headbands and t-shirts, which are either identical to or encompassed by opposer's identified jackets, shirts, hats, headbands and footwear. See *Tuxedo Monopoly, Inc. v. General Mills Fun 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 in the application). Because these goods are legally identical, they must be deemed to be sold in the same channels of trade. Both of these du Pont factors--the similarity of the goods and the channels of trade--favor a finding of likelihood of confusion.

When marks would appear on virtually identical goods or services, 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). Here the marks are BEAR and PINK BEAR. Although applicant's mark has the additional word PINK, the word BEAR retains its identity and to this extent the marks are identical in appearance, pronunciation and connotation. The adjective PINK merely provides some additional information about the color of the BEAR, but BEAR is still the dominant part of the mark. See *In re National*

Opposition No. 91176592

Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (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 a consideration of the marks in their entirety.) In short, the additional word PINK in applicant's mark is insufficient to distinguish its mark from opposer's mark BEAR, and the marks convey similar commercial impressions. See Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556 188 USPQ 105 (CCPA 1975) (source of BENGAL LANCER for mixers likely to be confused with source of BENGAL for gin, since goods are sold to same class of purchasers and used together); In re West Point-Pepperell, Inc., 468 F.2d 200, 201, 175 USPQ 558, 559 (CCPA 1972) (WEST POINT PEPPERELL and design for woven and non-woven fabrics not registrable in view of registered mark WEST POINT for woolen piece goods).

The du Pont factor of the similarity of the marks also favors a finding of likelihood of confusion.

With respect to the factor of the conditions of purchase, the goods at issue are general consumer goods, and the customers cannot be treated as particularly sophisticated or knowledgeable. Further, many of the items can be relatively inexpensive, e.g., caps and headbands, and are likely to be purchased on impulse and without a great

Opposition No. 91176592

deal of care. This factor, too, favors a finding of likelihood of confusion.

With respect to the factor of fame, we reject opposer's position that its mark is famous. Opposer has used the general term "Bear marks" to refer to its marks, without separating out the use or advertising of particular BEAR marks, so we cannot ascertain the sales and advertising for the mark BEAR per se. Even if we were to assume that the testimony and exhibits apply to the mark BEAR, these figures are not of the level that is normally required for us to find a mark to be famous. Opposer has not given us any basis to compare its sales and advertising figures, or to indicate its market share, but total sales of \$110 million and advertising expenditures of \$7 million in a 14-year period (1994 to 2008) does not appear to be especially large. Compare Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984), where in 1984 the plaintiff had annual sales of \$25 million and total advertising expenditures exceeding \$3 million. Certainly comparable figures almost 25 years later would be significantly higher, but opposer's annual sales would not even match the annual sales of that earlier time.

Although we do not find opposer's mark to be famous, we must consider it to be a strong mark, in that BEAR is an

Opposition No. 91176592

arbitrary mark for clothing, and is therefore distinctive. Moreover, there is no evidence in the record of third-party use of BEAR marks.

We consider the remaining du Pont factors to be neutral. Although there is no evidence of actual confusion, there is no information in this record that applicant has even begun using its mark. As a result, the lack of evidence of actual confusion does not suggest that confusion is not likely to occur.

After considering all of the relevant du Pont factors, we find that opposer has demonstrated that applicant's mark, if used on its identified goods, is likely to cause confusion.

Decision: The opposition is sustained.