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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Deckers Outdoor Corporation,
substituted as party plaintiff for
Simple Shoes, Inc.

v.

Shoe Show, Inc.

Cancellation No. 92028287

Paul G. Juettner of Greer, Burns & Crain, Ltd. for Deckers Outdoor Corporation, substituted as party plaintiff for Simple Shoes, Inc.

Clifford R. Jarrett of Kennedy Covington Lobdell & Hickman, L.L.P. for Shoe Show, Inc.

Before Seeherman, Walters and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Deckers Outdoor Corporation, substituted as party plaintiff for Simple Shoes, Inc.,[1] has petitioned to cancel

[1] Simple Shoes, Inc. filed the petition for cancellation. After trial and briefing, petitioner filed a motion to substitute, which was granted by the Board. The evidence shows that Simple Shoes, Inc. is a wholly-owned subsidiary of Decker Outdoor Corporation.

the registration of Shoe Show, Inc. for the mark SIMPLE IMAGES and design, as shown below, for footwear.[2]

As grounds for cancellation, petitioner has alleged that it and its predecessors have used the trademark SIMPLE on shoes and T-shirts since at least as early as December 1991 and in interstate commence since at least as early as March 13, 1992; that petitioner owns a registration, No. 1805363, for SIMPLE for men's, women's and children's casual and athletic shoes and T-shirts; that respondent's registration is based on dates of first use long after petitioner's dates of first use; and that respondent's use and registration of SIMPLE IMAGES is likely to cause confusion, mistake or deception.

Respondent has admitted that Registration No. 1805363 issued to petitioner on November 16, 1993, and denied the salient remaining allegations in the petition for cancellation. Respondent has also asserted affirmatively that there are at least thirteen other registrations in Class 25 for marks that include the word SIMPLE, and that

[2] Registration No. 2198930, issued October 20, 1998, based on an intent-to-use application dated November 13, 1996. A statement of use asserted first use and first use in commerce on March 1, 1997.

petitioner should not be allowed to now take the position that respondent's mark is confusingly similar to petitioner's mark but that petitioner's mark is not confusingly similar to the registered marks in existence prior to the issuance of petitioner's registration; that the Examining Attorney has already determined that the two marks are not confusingly similar; and that the design element in respondent's mark further differentiates the marks.

The record includes the pleadings; the file of the registration sought to be cancelled; the testimony, with exhibits, of petitioner's witnesses Ruth Davis, petitioner's vice president of marketing and brand manager for the Simple brand, and respondent's witnesses Jay W. Manning, who is on the executive staff of respondent, and Robert B. Tucker, respondent's president.

Petitioner has submitted, pursuant to stipulation, the deposition of its founder, Eric Meyer, taken in another proceeding, Simple Shoes, Inc. v. Marc Wear, Opposition No. 106,061. Petitioner has also submitted, under notice of reliance, respondent's responses to petitioner's interrogatories. Respondent has submitted, under notice of reliance, various third-party registrations for marks comprising or including the word SIMPLE; petitioner's responses to respondent's interrogatories; and documents from respondent's registration file and a status report

taken from the USPTO TARR database. The parties have also filed a stipulation regarding J.Jill, an online store.

Petitioner has also submitted, under notice of reliance, respondent's responses to petitioner's document production requests, and respondent has submitted petitioner's responses to respondent's document production requests. It should be noted that responses to document production requests cannot be made of record by notice of reliance. See Trademark Rule 2.120(j)(3)(ii). However, because each party, in its brief, has treated this material as being of record, we consider the responses to have been stipulated into the record. Similarly, respondent has attempted to submit, under notice of reliance, its own responses to petitioner's interrogatories and document production requests. Generally, a party cannot make of record its own responses to its adversary's discovery requests, except that, if the inquiring party makes of record fewer than all of the responses, the responding party may submit any other responses which should in fairness be considered so as to make not misleading what was offered by the inquiring party. Trademark Rule. 2.120(j)(5). Here, however, because petitioner has treated them of record, we deem them to have been stipulated into the record.

In its brief, petitioner states that it "objects to the admission of Registrant's Exhibit R-14, submitted during the

trial testimony of Jay Manning." P. 3. We believe that this is a typographical error, and that the objection is actually to Exhibit R-4. Petitioner did not raise any objection to Exhibit R-14 during the testimony deposition, but petitioner's attorney did specifically state, at the end of that deposition, that "I'd like to add on the record that as to Exhibit R-14, that we would object to the admission of that exhibit on the grounds of hearsay--excuse me--Respondent's Exhibit 4, only Respondent's Exhibit 4." It appears that the same error that was initially made in counsel's statement at the deposition--confusing Exhibit 14 with Exhibit 4, was simply repeated in the brief. With respect to Exhibit 4, we find the objection to be well taken. The exhibit is a memo prepared by the witness's assistant, reporting on research she had done for third-party "SIMPLE" marks. Her comments on what she discovered are clearly hearsay.

Respondent has also raised an evidentiary objection, to petitioner's exhibit 14, introduced during the testimony deposition of Ruth Davis. This exhibit is a copy of a decision of the Trademark Trial and Appeal Board in another proceeding, Simple Shoes, Inc. v. Marc Wear, Opp. 106061 (TTAB March 16, 2000), involving petitioner as the opposer therein, with respect to the mark SIMPLE LIFE. Respondent's objection is based on the fact that the decision is marked

"Not Citable as Precedent." Because petitioner was a party in this proceeding, we believe that the decision is relevant, in the same manner that decisions in other proceedings brought by petitioner against third-party marks, e.g., Exhibits 49, 50, 51, 52 and 53 to the testimony deposition of Eric Meyer, are relevant. Moreover, we note that this decision is in the very case in which petitioner's witness Eric Meyer gave the testimony which the parties have stipulated into this record. However, although we do not strike the exhibit, we do not treat the decision as having precedential value, nor do we consider it probative of the findings of fact stated therein. The present proceeding must be decided on the record before us here, not on the record adduced in another proceeding.

Finally, in its appeal brief, petitioner has also listed, under evidentiary disputes, "there are occasional objections to trial testimony, which objections are noted in the transcripts of Jay Manning and Ruth Davis." P. 3. If a party does not maintain its objection in its brief on the case, it may waive an objection that was seasonably raised at trial. TBMP §707.02 (2d ed. rev. 2004). The vague language used by petitioner, without reference to any specific objections, is not sufficient to preserve any "occasional" objections raised by either party during the

testimony depositions. Accordingly, we consider any such objections to be waived.

The proceeding has been fully briefed. An oral hearing was not requested.

The record shows that petitioner, through its predecessor-in-interest, began doing business in December 1991, and that by 1992 was using the mark SIMPLE on various styles of casual footwear, hats, t-shirts, socks, decals and stickers. The accessory line subsequently expanded to include key chains, wallets, backpacks, socks and sweatshirts. By 1992 petitioner had accounts in most states in the United States, and by 1996 its catalog was being distributed in all 50 states to new accounts, existing retail stores, shoe stores, clothing stores and department stores. At that point petitioner had 30 styles of shoes bearing the mark SIMPLE.

SIMPLE is a casual footwear brand directed at the youth market, with its target customer being 17-25. Among the shoes it sells are sneakers, sandals and clogs. As of 1999, the retail prices of its footwear ranged from $50 to $100.

Petitioner's sales were $600,000 in 1992; $2 million in 1993; $14 million in 1994; $23 million in 1995, and $30 million in 1996.[3] Eighty per cent of these figures

[3] There is some discrepancy between the testimony of Eric Meyer, who stated that petitioner's sales for all its SIMPLE-branded goods, sold both domestically and internationally, was

represent domestic sales; 95-97% of the sales are from shoes. Sales of footwear in the United States were $29 million in 1997; $20 million in 1998 and $13 million in 1999. The footwear is sold in independent shoe stores, such as Urban Outfitters; department stores such as Nordstrom's; and outdoor retailers.

Petitioner advertises primarily in magazines, including national magazines such as "Nylon," "Wallpaper" and "Jump." Petitioner also participates in co-op advertising with stores such as Dillard's and Lord & Taylor, as a result of which its products are featured in local newspaper ads. It also began advertising its products on the Internet in 1997, and began selling them on its website in September/October 2000.

In addition, petitioner advertises in trade publications such as "Footwear News," and exhibits at trade shows such as Fannie in New York and WSA (Western Shoe Show). Since 1992 it has distributed catalogs twice a year to its accounts as well as potential accounts.

Prior to 1998, when the testimony of Eric Meyer was taken, the record shows petitioner also advertised in such

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$30 million in 1996, and petitioner's response to Interrogatory No. 12, which stated that the sales in the United States for footwear under the SIMPLE mark was $36 million. Similarly, the interrogatory response listed sales of $15 million in 1999, and Ruth Davis testified that domestic sales were $13 million. The discrepancies have no bearing on our decision herein, and we have used the lower figures in our consideration of petitioner's rights.

national magazines as "Spin" and "Rolling Stone." It sponsored some professional athletes who were engaged in action sports; film festivals such as the New York Underground Film Festival; and concert tours such as the Warped Tour. Its mark would be displayed at these activities, and at many events petitioner would have a manned booth where it would show its goods and explain its philosophy. It also sponsored a pamphlet-style magazine called Moonlight Chronicles, which was on its website and was also distributed free-of-charge through its retailers.

Petitioner's advertising budget for 1999 was $400,000, and was $700,000 in 2000. In 1994 petitioner spent $750,000 on advertising, and for the years 1995 through 1997 annual expenditures were approximately $1 million.

Petitioner has also used variations of its SIMPLE mark in connection with its footwear and apparel. It used SIMPLE GUM for a component of its shoes, and SIMPLE GIRL and SIMPLE with the design of a girl for its women's shoes.

Turning to respondent and its activities, respondent's president designed the mark SIMPLE IMAGES and design because he wanted a mark for a "young" dress shoe. He saw the design feature used as a prop in a magazine, decided to use it in "hot" colors, and then chose the term SIMPLE IMAGES because it described the design. Respondent began using the mark in March 1997 on ladies' footwear which is directed to

young, fashion-forward consumers. The price range for the shoes is $25-$35. The shoes are sold only in respondent's own stores, of which there were 730 at the time of the president's deposition in February 2001. These stores are located throughout the eastern half of the United States. The SIMPLE IMAGES and design shoes are advertised only in newspapers.

As a preliminary matter, we find that petitioner has established its standing by virtue of its use of SIMPLE for shoes, the same goods identified in respondent's registration.

The ground of likelihood of confusion has two components: priority and likelihood of confusion. With respect to the issue of priority, we note that petitioner did not make of record status and title copies of its pleaded registration, nor did petitioner elicit any testimony from its witnesses as to the status of the registrations which it introduced. Further, although respondent admitted in its answer that "on November 16, 1993, the U.S. [P]atent and Trademark Office granted to Petitioner U.S. Trademark Registration no. 1,805,363 for the mark SIMPLE in International Class 25," Answer, ¶2, it denied the allegation in the notice of opposition that "said registration is valid, subsisting and owned by Petitioner." However, in its brief respondent asserts, in the "Statement

of Facts," that petitioner "is the owner of U.S. Trademark Reg. No. 1,805,363 for the word mark SIMPLE for 'men's women's and children's casual and athletic shoes and T-shirts' in International Class 25, which registration was issued on November 16, 1993." p. 7. We construe this statement as a stipulation that petitioner's registration is in full force. This registration, as noted, issued on November 16, 1993, (from an application filed on December 27, 1991), which filing date is earlier than the November 13, 1996 filing date of the application which matured into respondent's registration. Moreover, the evidence submitted by petitioner, and particularly the testimony of Eric Meyer and the exhibits introduced therewith, demonstrate that petitioner began using and continued to use the mark SIMPLE on shoes and other products as early as 1992, well prior to respondent's application filing date in November 1996 and prior to respondent's first use of the mark SIMPLE IMAGES and design in 1997. Accordingly, petitioner has shown it has priority.

With respect to the issue of likelihood of confusion, our determination 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 Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Respondent's goods are defined as footwear in its application; petitioner's goods include various types of shoes. The goods, thus, must be considered legally identical. As such, they must be deemed to be sold in the same channels of trade to the same classes of consumers.

We note respondent's argument that its goods and those of petitioner are of a "vastly different style and use," brief, p. 16, and that they are sold in different channels of trade, since respondent's shoes are sold only in its own stores, which are called Shoe Dept. and Burlington Shoes, and these stores do not carry petitioner's shoes. We also note that at present the parties' shoes have different price points, and may therefore appeal to a different clientele (although respondent's targeted consumer is a young, fashion-conscious female, and petitioner's women's shoes are targeted to "fashion-conscious but … not trendy" women aged 17 to 25). Davis dep. p. 31. However, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in respondent's registration vis-à-vis the goods and/or services recited in a petitioner's registration, rather than what the evidence shows the goods or services to be. See Canadian Imperial Bank of Commerce v. Wells Fargo

Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Because the identification of goods in respondent's registration is not limited to specific types of footwear or to specific channels of trade, it must be presumed that the footwear encompasses shoes of all types, and that they are sold through all types of retail outlets that deal in footwear. See Interco Incorporated v. Acme Boot Company, Inc., 181 USPQ 664 (TTAB 1974). Accordingly, for purposes of the likelihood of confusion analysis, respondent's goods are legally identical to petitioner's, and are sold in legally identical channels of trade. These two duPont factors, thus, favor petitioner.

This brings us to the factor of the similarity or dissimilarity of the marks. Obviously respondent's mark includes the word SIMPLE, which comprises the whole of petitioner's mark. However, because of the additional elements in respondent's mark, we find that it conveys a totally different impression from petitioner's mark. The design is a prominent visual element in respondent's mark, and the phrase SIMPLE IMAGES describes the design element. The word SIMPLE in respondent's mark, because it modifies or describes the word IMAGES, is subordinate to and intrinsically connected to IMAGES, rather than standing out on its own. The words reinforce the significance of the

design, and the design reinforces the connotation of the words.

Petitioner's mark SIMPLE, on the other hand, has a different connotation. It suggests that the shoes have "clean, basic styles," the look that petitioner's founder testified he was trying to achieve. Meyer dep. p. 12. The mark also suggests a way of life and a philosophy that petitioner's advertising materials have emphasized from the start, e.g.:

> Simple is based on good old fashioned honesty and wholesome values. Our products are made from the best materials and we offer the best prices. We make money… but we're not greedy. We're straight up, simple…no big marketing scams, no fifty piece clothing line, no high digit four color full page ad advertising…just the best shoes and the best prices…and maybe a hat or somethin'!
> 1992 catalog
>
> My goal is to blend performance and style into simple shoes with a modern twist. Not everybody out there wants to wear hyped out, over logo'd athletic shoes and I am trying to offer an alternative.
> ***
> It's just damn hard to find good comfy boots that aren't all fussed up…so I made some.
> Spring 1994 catalog
>
> **Simple®**
> What that means is like well… less is more, you know… like the less you have the better your life can be
> Cover, Fall 1995 catalog

Thus, although there is a slight visual and phonetic similarity in that both marks contain the word SIMPLE, the additional elements in respondent's mark result in a mark that is very different from petitioner's. See Lever Bros. Co. v. Barcolene Co., 463 F.2d 1107, 174 USPQ 392 (CCPA 1972) (ALL v. ALL CLEAR); In re Ferrero, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973) (TIC TAC TOE v. TIC TAC). This situation is different from the cases cited by petitioner at pages 8 and 9 of its brief, in which a party appropriates the entire mark of another, and adds to it a non-distinctive term or other subordinate matter. When the marks at issue are viewed in their entireties, they are different in appearance, pronunciation, connotation and commercial impression. This duPont factor strongly favors respondent.

We have considered petitioner's argument that "many popular multi-word marks are simplified to one word" (citing, as an example, "Sears" for Sear Roebuck & Co.), brief, p. 10. We are not persuaded by this argument. That a company might decide to use part of its trade name as a trademark does not mean that every company does so. In this case, because the words SIMPLE IMAGES were chosen to describe the images, there would be no point in respondent's shortening the word portion of its mark to SIMPLE. Nor is there any evidence that anyone refers to respondent's mark (which has been in use since March 1997) as SIMPLE.

Petitioner has also argued that it "has also made use of common design elements such as ovals and rectangles on the footwear, packaging, and in the marketing of the brand." Brief, p. 10. However, the oval design is clearly used as a background "carrier." Similarly, in the instances where the mark SIMPLE appears on a rectangular tag that is sewn, for example, into the side of petitioner's sneakers or into the sock liner of a clog, the rectangular shape would be viewed only as the label. In other examples cited by petitioner the rectangles and squares are used as decorative elements in the vicinity of the word SIMPLE.[4] These incidental uses by petitioner of geometric shapes in no way show that respondent's design element is similar or even reminiscent of petitioner's mark, or that the public would associate the

[4] For example, Exhibit 1 to the Davis deposition, cited by petitioner in its brief, is petitioner's Spring 99 catalog. On the front of the catalog is the trademark SIMPLE shown in the upper left-hand corner. In the center of the page, and clearly separated from SIMPLE, are two overlapping diamond shapes in orange and red, with a taupe-colored smaller diamond formed by the overlap. Anyone viewing the cover would consider these diamonds to be the "picture" on the catalog cover, rather than being part of the trademark. Another example is a single advertisement in the July 3, 2000 issue of "Footwear News," in which a neon green rectangle appears to the left of the SIMPLE mark. Petitioner's witness acknowledged that this was simply a design detail used on this particular advertisement. Petitioner also sold a T-shirt during the spring 2000 season which bore on the front, in addition to the word SIMPLE, a decorative design consisting of the map symbols for a town, urban area, and a capital. This shirt was not being sold at the time of the witness's deposition in September 2000. (It is interesting to note that all of these examples occurred subsequent to the filing of the petition to cancel.)

connotation of petitioner's mark SIMPLE with plain or ordinary geometric shapes or images.

Petitioner has demonstrated significant sales and advertising of its SIMPLE mark, as well as use since at least 1992, and this is a factor that favors petitioner.[5] At the same time, however, the word SIMPLE has, as noted above, an obvious suggestive significance for shoes. In this connection, we take judicial notice of the dictionary definitions of "simple": "without embellishment; not ornate or adorned; not elaborate, elegant, or luxurious; not affected; unassuming or unpretentious."[6] As a result, petitioner's mark is not entitled to a broad scope of protection. The determination of whether marks are similar must consider all the elements of the mark. In the case of respondent's mark, SIMPLE would not be perceived as referring to the goods, but only to the word IMAGES.

Our finding on the suggestiveness of petitioner's mark is based on the meaning of the word "simple" per se, and not on the third-party registrations that were made of record by

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[5] We wish to make clear, however, that petitioner has not demonstrated that its mark is famous. The SIMPLE mark is not entitled to the wide latitude of protection accorded a famous mark, nor does the factor of fame play a dominant role in this case. Cf. Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992)

[6] The American Heritage Dictionary of the English Language, (1970). The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

respondent. These registrations are for goods and services that are sufficiently different from shoes (the only registration in the clothing class being SIMPLE PLEASURES for women's bathrobes and caftans) that we could not conclude, from the registrations alone, that the term "simple" has a significance for shoes. See Mead Johnson & Company v. Peter Eckes, 195 USPQ 187 (TTAB 1977) (third-party registrations are probative to the extent that they may show the meaning of a mark or a portion of a mark in the same way that dictionaries are employed). We also point out that we have given no consideration to respondent's comments that petitioner's mark might be considered merely descriptive. Respondent did not counterclaim to cancel petitioner's registration on this ground, and therefore it may not attack the registration in its brief.[7]

With respect to the factor of the conditions under which, and buyers to whom, sales are made, petitioner's own witness has testified that "footwear consumers have good knowledge of the industry, yes, brands and so on." Davis, p. 65. Even though respondent's shoes, in particular, are not expensive, the shoe-buying process, which involves trying on shoes to assess fit and appearance, requires some

[7] Nor could respondent have counterclaimed to cancel petitioner's registration on the ground of mere descriptiveness, since the registration was five years old at the time petitioner brought this action. See Section 14(1) of the Trademark Act.

time and deliberation. The discrimination of buyers, and the care involved in the purchase, favor respondent.

The next factor we consider is the number and nature of similar marks in use on similar goods. Respondent has submitted evidence of third-party uses of marks containing the word SIMPLE. For the most part, these uses are for sufficiently different goods and services that they are not helpful to respondent's position. However, there are some third-party uses for clothing or clothing-related goods and services. There is evidence that SIMPLE SOLUTIONS is in use for brassieres and hosiery, and SIMPLE PLEASURES for lingerie. Respondent has made of record a printout from the website www.simpleelegance.net, which features the mark SIMPLE ELEGANCE in connection with T-shirts, denim shirts, sweatshirts, fleece jackets and French terry jumpers. Another printout, for J.Jill, operating an on-line store at jjill.com, advertises shoes under the heading "simple suede loafers" shown in lower case, bold type. The record shows that, subsequent to respondent's making this evidence of record, petitioner sent this company a cease and desist letter, and it ceased using the phrase, but that it subsequently used "simple ballet loafers." Petitioner sent another cease and desist letter, but at the time the parties filed the stipulation as to these activities, J.Jill was still using this heading.

Another entity uses CHIC SIMPLE for a series of books about simplifying one's life. The materials for this company shows that the books in the series include the titles "CLOTHES," "MEN'S WARDROBE," "WORK CLOTHES," "SHIRT AND TIE" "SCARVES" and "WOMEN'S WARDROBE." The books showcase products and brands. Respondent has also made of record printouts from the aol.com website featuring CHIC SIMPLE which state:

> Shop@AOL Chic Simple Wardrobe is where Chic Simple becomes your own personal shopper. The Chic Simple lessons of comfort, quality, and versatility are brought to life in modern, affordable outfits put together from AOL's key vendors. Though Chic Simple is using only the AOL vendors we independently decide what we feature--our only influence is what seems to work best, not the brand or manufacturer.

The website features "Shoes closet," which not only gives fashion advice, but advertises particular shoes.

Dillard's had applied for the mark SIMPLY COMFORT for shoes, which application petitioner had opposed. The opposition was settled with the agreement that Dillard's could use and register SIMPLY COMFORT for footwear without creating a likelihood of confusion provided that Dillard's not use the term SIMPLY in a manner more prominent than the term COMFORT, and that it not use SIMPLE, by itself or with other terms or designs, for footwear.

Another opposition proceeding brought by petitioner was against Simple Touches, Inc., which resulted in a settlement agreement in which the applicant agreed to amend its identification of goods to "originally designed clothing, namely, shirts, collars, vests and caps, embroidered with Bible verses and sold through religious stores."

This evidence of third-party use is obviously limited, and in many instances the goods involved are substantially different from shoes (brassieres, shirts and jumpers) or are sold in different channels of trade (religious stores). However, there is some third-party use of marks containing the word SIMPLE or SIMPLY for shoes and closely related goods and services, i.e., SIMPLY COMFORT for shoes, SIMPLE SOLUTIONS for hosiery, CHIC SIMPLE for online sales of shoes and books recommending brands of shoes, and A SIMPLE SLIPPER for shoes. This evidence at least suggests that consumers will look to other elements of these marks to distinguish them. Thus, this factor must be considered to favor respondent, albeit slightly.

We turn next to the factors relating to actual confusion or the lack thereof. Neither petitioner nor respondent is aware of any instances of confusion or even of any questions being raised as to whether there is an affiliation or connection in source between the shoes sold under the mark SIMPLE and those sold under the mark SIMPLE

IMAGES and design. Although evidence of actual confusion is not necessary in order to prove likelihood of confusion, the absence of such evidence in this case has some persuasive value. It is clear from the record that petitioner has made extensive use of its SIMPLE mark, and that it has engaged in extensive advertising. Respondent had, at the time of trial, 730 stores, with more being opened literally every week. There is clearly geographic overlap for sales of the parties' goods throughout the eastern half of the United States. Although respondent's SIMPLE IMAGES and design shoes are sold only in its own stores, the customers for the shoes must be presumed to shop in other stores as well, where they would be exposed to both parties' marks. Further, respondent's stores sell a variety of brands of shoes, including brands that petitioner considers to be its competitors. Thus, consumers would not assume that shoes sold in respondent's stores are sold only under its own store brands. In view of the foregoing, the actual confusion/lack of confusion factors somewhat favor respondent.

The remaining duPont factor discussed by the parties is the extent of potential confusion. Both have essentially repeated their arguments regarding such other factors as the goods and marks. We will not repeat these arguments, or our comments in response.

The determination of likelihood of confusion is not based simply on a toting up of how many factors favor petitioner, and how many favor respondent, with the "winner" being the party with the greatest number of duPont factors in its favor. Depending on the case, each of the factors may play a dominant role. DuPont, 476 F.2d at 1361, 177 USPQ at 567. Thus, in a particular case, a single duPont factor may be dispositive. Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

In the Kellogg Co. v. Pack'em Enterprises Inc. case, that single duPont factor was the differences in the marks. Here, too, we find that the differences in the marks to be dispositive. As discussed above, the marks convey very different commercial impressions. Therefore, on this factor alone, we would find no likelihood of confusion. But in addition, there are other factors, such as the care and sophistication of purchasers, that favor respondent, and add further support to our conclusion that respondent's mark SIMPLE IMAGES and design, used on footwear, is not likely to cause confusion with petitioner's mark SIMPLE for shoes.

Decision: The petition to cancel is denied.