

Oral Hearing held:
April 14, 2004

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

*Decision mailed:
September 22, 2004
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Sporting Goods Corp.

v.

Glory Shoes Co., Inc.

Opposition No. 91120905 to application Serial No. 75384563
filed on November 4, 1997

Cancellation No. 92031180

Michael A. Painter of Isaacson, Kaufman & Painter for American
Sporting Goods Corp.

Ronald M. St. Marie of Chan Law Group LC for Glory Shoes Co.,
Inc.

Before Seeherman, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Glory Shoes Co., Inc. ("Glory") has filed an
application to register the mark "AVA II" and design, as
reproduced below,



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for "bags, namely, shoe bags for travel, travel bags, all purpose athletic bags, gym bags, leather shopping bags, textile shopping bags, shoulder bags, and school bags" in International Class 18 and "footwear" in International Class 25."¹ Glory is also the owner of a registration for the mark "AVA" for "footwear" in International Class 25.²

American Sporting Goods Corp. ("ASG") has respectively opposed registration of and petitioned to cancel the registration for the above marks³ on the ground that it "is engaged in the business of designing, manufacturing and selling footwear and all purpose sport bags, duffel bags, tote bags, waist packs, shoulder bags and book bags"; that, in connection therewith, it "has used, continues to use and owns the following registered trademarks":⁴

(1) the mark "AVIA," which is registered
for:

¹ Ser. No. 75384563, filed on November 4, 1997, which is based on an allegation of a bona fide intention to use the mark in commerce.

² Reg. No. 2,237,432, issued on April 6, 1999 from an application filed on March 7, 1997, which sets forth a date of first use anywhere and in commerce of October 30, 1997.

³ The Board, in its order instituting these proceedings, indicated that in view of the combined notice of opposition and petition to cancel filed by ASG, such proceedings would be treated as having been consolidated.

⁴ It is noted that ASG also pleads that it has used, continues to use and owns Reg. No. 1,880,956, issued on February 28, 1995, for the mark "AVIA" for "organizing and conducting off road foot races and competitions" and Reg. No. 1,202,828, issued on July 27, 1982, for the mark "AVIA" and design for "athletic shoes." However, as to the former, no evidence was made of record with respect thereto and, as to the latter, while a certified copy thereof was made of record which shows that the registration is subsisting and owned by ASG, it is further noted from the records of the U.S. Patent & Trademark Office that such registration has since expired for failure to be renewed. See TBMP §704.03(b)(1)(A) (2d ed. rev. 2004). In view thereof, no further consideration will be given to either of such registrations.

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(a) "athletic shoes" in
International Class 25;⁵

(b) "t-shirts, sweatsuits, shorts
and polo shorts" in International Class
25;⁶

(c) "toys and sporting goods;
namely, flying discs, balloons, exercise
devices for exercising hands and wrists
and ankle weights for exercising" in
International Class 28;⁷ and

(d) "all purpose sport bags, duffel
bags, tote bags, waist packs, shoulder
bags and book bags" in International
Class 18;⁸ and

(2) the mark "AVIA" and design, which is
registered as reproduced below



for "athletic shoes, t-shirts, sweatsuits,
shorts and polo shirts" in International
Class 25;⁹

⁵ Reg. No. 1,202,827, issued on July 27, 1982 from an application filed on April 15, 1981, which sets forth a date of first use anywhere and in commerce of February 26, 1981; renewed.

⁶ Reg. No. 1,348,151, issued on July 9, 1985 from an application filed on October 29, 1984, which sets forth a date of first use anywhere of December 1982 and a date of first use in commerce of June 1983; combined affidavit §§8 and 15.

⁷ Reg. No. 1,720,437, issued on September 29, 1992 from an application filed on July 3, 1990, which sets forth a date of first use anywhere and in commerce of March 1, 1987; renewed.

⁸ Reg. No. 1,731,119, issued on November 10, 1992 from an application filed on February 3, 1992, which sets forth a date of first use anywhere and in commerce of July 1989; renewed.

⁹ Reg. No. 1,349,604, issued on July 16, 1985 from an application filed on October 16, 1984, which sets forth a date of first use anywhere of December 1982 and a date of first use in commerce of June 1983; combined affidavit §§8 and 15.

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that the registrations for the above marks are valid and subsisting; that since at least as early as February 26, 1981 and long prior to any use by Glory of its "AVA" marks, ASG, "by and through its predecessors-in-interest, has extensively and continuously used in interstate commerce" its "AVIA" marks in connection with its goods; and that, due to the similarity between Glory's "AVA" marks and ASG's "AVIA" marks, and the "related nature" of their respective goods, Glory's "AVA" marks so resemble ASG's "AVIA" marks as to be likely to cause confusion, or to cause mistake, or to deceive.

Glory, in its answer, has denied the salient allegations set forth in the combined pleading.¹⁰

The record includes the pleadings, the file of the opposed application and the file of the involved registration. As its case-in-chief, ASG has submitted (1) the testimony, with exhibits, of (a) Edward (a/k/a Ed) L. Goldman, its vice president of marketing (taken on August 21, 2001),¹¹ and (b) James Ho,

¹⁰ Although Glory also alleged, as a putative affirmative defense, that the relief sought by ASG "is barred by the doctrine of laches," no evidence with respect thereto was offered at trial. Accordingly, no further consideration will be given to such defense.

¹¹ Glory, in its brief, states that it "objects to ASG's summary [in its brief of such] ... evidence on the grounds that it misrepresents the testimony taken and ... is based on testimony and Exhibits to which objection was timely made." As to the former, since TBMP §801.01 (2d ed. rev. 2004) provides, *inter alia*, that "the facts and arguments presented in the brief must be based on the evidence offered at trial," suffice it to say that we have considered only those facts and arguments referred to by opposer which have support in the record. With respect to the latter, applicant has reiterated in its brief a host of objections which one of its attorneys interjected during Mr. Goldman's August 21, 2001 deposition. While such objections to the witness' testimony and the exhibits introduced in connection therewith were wide-ranging and extensive (we note, as an aside, that it is only a modest exaggeration to say, as ASG's counsel remarked in a colloquy with an attorney for applicant, that "the only thing you haven't

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Glory's president (taken on August 24, 2001); and (2) notices of reliance on (a) certified copies of the pleaded registrations noted above, showing that each of such registrations is subsisting and owned by ASG, and (b) Glory's responses to ASG's interrogatories. Glory, as its case-in-chief, likewise has submitted (1) the testimony, with an exhibit or exhibits (respectively), of (a) Ed Goldman (taken on April 10, 2003) and (b) James Ho (taken on June 2, 2003);¹² and (2) a notice of

objected to is his name" (Goldman 8/21/01 dep. at 77-78)), the bulk of the objections were on grounds of lack of relevance, lack of first-hand personal knowledge by the witness and/or, as to documentary exhibits, hearsay and/or lack of authentication. Rather than burden this opinion, however, with a lengthy discussion of each of Glory's numerous objections, suffice it to say that, although the testimony and exhibits pertaining to the use of ASG's "AVIA" marks abroad is obviously irrelevant (since the issue herein involves likelihood of confusion in the United States) and has therefore not been given any consideration, none of Glory's remaining objections is considered to be well taken for the reasons explained by ASG in its reply brief. Accordingly, the testimony and exhibits objected to by Glory have not been excluded as inadmissible and, instead, have been considered for whatever probative value such may have.

¹² Like its previously noted objection with respect to ASG's deposition of Mr. Goldman, Glory objects in its brief to the characterization and admissibility of certain portions of Glory's deposition of Mr. Ho. In particular, although Glory cites to portions of ASG's deposition of Mr. Ho on August 24, 2001, ASG in its reply brief correctly points out that such references actually pertain to the June 2, 2003 deposition of Mr. Ho, which includes objections raised by an attorney for Glory during ASG's cross-examination of the witness. As indicated previously, we have considered, with respect to ASG's characterization of the evidence, only those facts and arguments which have support in the record. Moreover, as to the objections reiterated by Glory in its brief, we concur with ASG that, for the reasons explained in its reply brief, "the objections are without merit and should be denied." Specifically, while Glory's objections were based on the ground that the testimony, including that relating to an exhibit, was beyond the scope of the direct examination of Mr. Ho, we agree with ASG that its cross-examination "was appropriate since it was either within the scope of the direct examination which took place on June 2, 2003 or was for the purpose of impeachment of the witness" in that the attack on Mr. Ho's credibility was based upon earlier "statements he had made during his testimonial deposition" on August 24, 2001. Accordingly, because the testimony objected to by Glory is admissible, it has been considered for whatever probative value it may have.

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reliance on various official records¹³ and printed publications.¹⁴

Briefs have been filed and an oral hearing, attended by counsel for the parties, was held.

¹³ Noting, *inter alia*, that Glory relies upon both certified copies of its Registration Nos. 2,237,432 (its involved registration) and 2,352,232 for, respectively, the marks "AVA" and "AVA" and design as well as copies of its applications for restriction, in each instance, of the goods set forth therein from "footwear" to "work boots and safety boots," ASG has objected in its initial brief to consideration of Reg. No. 2,352,232 and the applications for restriction of the registrations. Specifically, ASG contends that such are "irrelevant" to this proceeding and "should either be stricken from the record or should be given no consideration whatsoever." As grounds therefor, ASG asserts that Registration No. 2,352,232 "is the subject of a collateral cancellation proceeding commenced by ASG and designated as Cancellation No. 92/042,265"; that "applications for restriction of goods are neither printed publications nor official records" under Trademark Rule 2.122(e); and thus that such registration is irrelevant herein and the applications for restriction of goods are not proper subject matter for introduction by means of a notice of reliance. In addition, as to the implicit request to amend the registration involved herein in accordance with the application for restriction of the goods therein, ASG points out that, under Trademark Rule 2.133(a), "a registration which is involved in an inter partes proceeding may not be amended except with the consent of the other party ... and the approval of the Board"; that "[a]s is evident from the document attached to the Notice of Reliance, Glory neither sought the consent of ASG nor was consent given" to the application for restriction; and that "[m]ost importantly, ... the purported restriction of the goods is specious since it is in open conflict with the testimony of Glory's President, James Ho," who stated that Glory offers "urban footwear" (i.e., shoes which look like a "kind of a work boot type of shoes but" which are "without the safety functions"). (Ho 8/24/01 dep. at 8.)

Glory, in its brief, has failed to respond to ASG's objections. Tellingly, its notice of reliance contains no statement of the general relevance of its applications for restriction as required by Trademark Rule 2.122(e) and the claimed relevance of its registrations is merely that they "show Applicants [sic] original registration of the mark[s]." Furthermore, in accordance with TBMP §704.03(b)(1)(A) (2d ed. rev. 2004), not only has Reg. No. 2,352,232 now been canceled due to the default judgment entered in Cancellation No. 92042265, but pursuant to TBMP §514.03 (2d ed. rev. 2004), Glory's implicit request to amend its involved registration to restrict the goods set forth therein is denied since such request is considered to be untimely and, in any event, Glory has failed to show that the entry of the proposed restriction would serve to avoid a likelihood of confusion. Accordingly, no further consideration will be given either to the copy of Reg. No. 2,352,232 or to the copies of the applications for restriction.

¹⁴ ASG, in its initial brief, has also objected to Glory's reliance on a copy of a brochure of its products and a sheet depicting a hang tag

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Priority is not in issue in the opposition proceeding and lies in favor of ASG in the cancellation proceeding. In particular, because ASG has proven, by the certified copies thereof, that its pleaded registrations for its above-noted "AVIA" marks are subsisting and owned by ASG, priority is not in issue with respect to its opposition to Glory's "AVIA II" and design mark. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Moreover, because the certified copies of such registrations additionally show that the filing dates of the applications which matured into those registrations are earlier than the filing date of the application which resulted in Glory's involved registration for its "AVA" mark, ASG has therefore established priority vis-à-vis such marks for purposes of the petition to cancel. See, e.g., Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1428-29 (TTAB 1993) at n. 13; and American Standard Inc. v. AQM Corp., 208 USPQ 840, 841-42 (TTAB 1980). Furthermore, the record demonstrates that in any event ASG's "AVIA" marks have

and posters, contending that such "business records do not constitute printed publications" within the meaning of Trademark Rule 2.122(e) and thus are not proper subject matter for a notice of reliance. ASG also asserts that such business records "have no probative value in this proceeding" and "should be stricken from the record or given no consideration whatsoever." Although Glory's brief is silent with respect thereto, we note that, while ASG is technically correct that a party's brochures, hang tags and posters are not proper subject matter for introduction by means of a notice of reliance, such evidence otherwise forms part of the record herein, and will not be heard to be lacking in probative value, since the brochure previously was introduced by ASG as Exhibit 34 to its August 21, 2001 deposition of Mr. Goldman and the hang tag and posters were previously offered by ASG as Exhibit 38 to its August 24, 2001 deposition of Mr. Ho. In consequence thereof, the copies of such evidence submitted by Glory are considered surplusage and need not be stricken or otherwise denied consideration.

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been in continuous use since on or before both the November 4, 1997 filing date of Glory's intent-to-use application for its "AVA II" and design mark and the March 7, 1997 filing date of Glory's underlying application for its registration for its "AVA" mark (which is earlier than its proven date of first use of October 30, 1997 for such mark). Accordingly, the focus of our determination is on the issue of whether Glory's "AVA" and "AVA II" and design marks, when respectively used in connection with the goods set forth in its involved registration and application, so resemble one or both of opposer's "AVIA" marks for any or all of its various goods as to be likely to cause confusion, mistake or deception as to source or sponsorship.

According to the record, ASG's vice president of marketing, Mr. Goldman, has been employed by ASG since August 1996 and his duties in his current position are "[t]o manage all facets of the consumer marketing arena for the AVIA brand." (Goldman 8/21/01 dep. at 7.) Recounting his admittedly acquired knowledge of the history or origins of such brand, Mr. Goldman testified that ASG purchased the "AVIA" brand, including various associated registrations, from AVIA Group International, Inc., an entity affiliated with athletic shoe manufacturer Reebok Worldwide, in May 1996. Such entity, in turn, had obtained the "AVIA" brand by purchase thereof from Pensa, Inc., which had founded the brand in the early 1980s and by no later than 1981. The "AVIA" marks, which as indicated earlier, are the subjects of ASG's subsisting registrations therefor, are in use and have been

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in continuous use since at least the date of their acquisition by ASG. In particular, the "AVIA" and design mark is used on "[a]ll packaging for ... AVIA products." (Id. at 13.) The proper pronunciation of the term "AVIA," Mr. Goldman confirmed, is as follows:

Q Avia. So that is "ah" as in abandon, and then V as in the letter V, and "ah" as in abandon. Avia.

A That is correct.

Q And the emphasis is on the second syllable, Avia?

A That's correct.

(Goldman 4/10/03 dep. at 6.)

ASG promotes the sale of its "AVIA" brand products "[p]rimarily through coop advertising with retail partners; [and] through national advertising campaigns, in print media, at point of sale, and through regional promotions around the country." (Goldman 8/21/01 dep. at 19-20.) In particular, for the five years since 1996, ASG has advertised its "AVIA" brand shoes in Footwear News, a weekly magazine for footwear buyers which Mr. Goldman regards as the leading publication in the footwear field, and has done other trade advertising. ASG has also done consumer advertising through print media, broadcasting, promotions and point-of-sale displays. Specifically, as to print ads, ASG spends up to \$7,000,000 annually to advertise in over 20 magazines, including Shape, Fitness, Maxim, The Source, Vibe, Spin, Running Times, Honey and Nylon. ASG has also advertised in such magazines as Gear, Mademoiselle, Self, Glamour, GO, Bride's,

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Voque, Gourmet, Bon Appetite, Allure and Vanity Fair. As of August 2001, ASG had over 15 different print ads running concurrently, and it changes its print ad campaign every three months to represent different categories of "AVIA" footwear.

ASG also promotes the sale of its "AVIA" brand products by publishing catalogs, which "are distributed exclusively to the ... trade-buying public, [i.e.,] the retailers." (Id. at 20.) In addition, since 1996, it has annually displayed its "AVIA" brand footwear (or a combination of such footwear and its apparel) at several trade shows, including attendance at "The Super Show, World Shoe Association, Action Sports Retailer, The Men's Apparel Guild, [and] The Footwear Association of New York." (Id. at 56.) ASG has also participated in the National Sporting Goods Association and Personal Trainer trade shows.

The "AVIA" brand products which ASG sells include, in addition to a collection of what it calls "athletic performance" or "white-base footwear," "a hiking [footwear] collection, a lifestyle footwear collection, an apparel collection, a sport bag collection, a hat collection, [and a] T-shirt collection." (Id. at 21.) In particular, as to the footwear which it offers under its "AVIA" marks, Mr. Goldman noted that "[t]he categories of shoes run the gamut" from "[r]unning, walking, aerobics, cross training, hiking, or rugged footwear," including over 20 models of hiking shoes, to "water sports, and casual or lifestyle" shoes. (Id. at 22.) Furthermore, Mr. Goldman stated that "[h]iking shoes and boots are synonymous, are one and the same,"

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and are also considered in the footwear industry as a kind of "[c]asual footwear." (Goldman 4/10/03 dep. at 10.)

ASG's customers "range from sporting goods chains, [and] family shoe stores, to athletic specialty retailers." (Goldman 8/21/01 dep. at 28.) Such customers include, for example, The Sports Authority, Big 5 Sporting Goods, Gart's Sports, Foot Locker, Lady Foot Locker, Finish Line, Venator Group and Sport Chalet. ASG's "AVIA" footwear is also sold directly to consumers over the Internet and is available in department stores, such as Macy's and Nordstrom, and through specialty retailers, such as REI. In all, because ASG basically will market its "AVIA" brand products to any retailers who desire to sell them, such goods are available at over 10,000 retail outlets in all 50 states and all major cities.

ASG's annual gross sales of and advertising expenses for its "AVIA" brand products during the roughly five-year period since the brand was acquired were indicated to be as follows:

<u>Year</u>	<u>Gross Sales</u>	<u>Advertising Expenses</u>
1996	\$39,318,000	\$850,000
1997	\$79,291,000	\$6,500,000
1998	\$81,112,000	\$7,500,000
1999	\$93,500,000	\$8,000,000
2000	\$93,300,000	\$7,000,000

(Id. at Exhibit 31.) While no sales figures were provided for any period of 2001, the advertising budget for such year was \$10,000,000, of which in excess of \$7,000,000 had been spent as of Mr. Goldman's deposition on August 21, 2001. Based upon certain research reports on market share to which it subscribes and relies upon, Mr. Goldman testified to his belief that ASG's

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"AVIA" brand of footwear "represents one of the top ten manufacturers of footwear in all categories." (Id. at 80.) He also noted that, at the retail level, prices for ASG's "AVIA" footwear range from \$30 or \$40 at the low end to \$90 or \$100 per pair at the high end. ASG regards its competitors to its "AVIA" brand as "anyone who sells footwear" of "any kind." (Goldman 4/10/03 dep. at 22-23.)

On cross-examination by an attorney for Glory, Mr. Goldman stated that he did not know if the term "AVIA" has any meaning other than as a mark for ASG's various products. With respect to ASG's use of its "AVIA" marks in connection with hiking boots, which are a type of footwear which is identical in legal contemplation to a product which Glory markets under its "AVA" mark, Mr. Goldman testified that, from his review of catalogs and corporate records, the first use of "AVIA" as a mark in connection with the sale of hiking boots was "prior to 1990"; that the term "'hiking boots' is a broad classification of athletic footwear"; that ASG "probably sell[s] in excess of a hundred thousand pair of outdoor classified footwear" annually; and that by "outdoor classified footwear" he is referring to "[f]ootwear intended for hiking outside," which includes "trail running" footwear. (Goldman 8/21/01 dep. at 93.) Furthermore, Mr. Goldman noted that ASG's "AVIA" hiking boots were displayed at "probably all" of the trade shows that ASG has attended inasmuch as he was present and saw such products there. (Id. at 106.)

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As to the use of its "AVIA" marks in connection with work boots, which are another kind of footwear which is legally identical to a product which Glory actually markets under its "AVA" mark, Mr. Goldman testified on cross-examination as follows:

Q. Has AVIA ever used its brand name in connection with the sale of work boots?

A. Yes, it has. Work boots are -- again, the classification ... is very undefined here, so ... -- to a wholesale consumer, [that] includes everything from ... what you might be considering [as] rugged footwear to work boots to any other footwear used for outdoor purposes, so ... it's an undefined category.

....

Q. Does AVIA target any of its advertising, with respect to its shoes, to people who might use the shoes as work boots, as opposed to for use outdoors?

A. Again, ... you'd have to clarify what is a work boot intended for.

Q. Well to my mind, a work boot would be something that somebody would wear to work, as opposed to something that's intended for hiking.

A. Yes. We manufacture ... tens of thousands of pairs of shoes intended for work-related functions. Yes.

Q. What sorts of work-related functions are you referring to?

A. Restaurant staffing, a variety of ... casual work, dress work, and ... performance work, ... "performance" meaning the need for grip, traction, those types of things. Yes.

Q. How long has AVIA used its market [sic] in connection with the sale of the shoes you just described?

A. I'd have to check the records.

....

Q. Do you think AVIA has been doing so
for the last three years?

A. Yes.

(Id. at 94-97.) Moreover, according to Mr. Goldman, "AVIA" brand shoes which could broadly be considered work shoes were displayed at the trade shows which ASG has attended.

Additionally, upon cross-examination by an attorney for Glory, Mr. Goldman admitted that he did not know whether ASG has received any customer complaints regarding Glory's "AVA" shoes, as opposed to shoes bearing ASG's "AVIA" brand name, because "[t]hat would be a customer service function" and "[t]hey wouldn't call me." (Id. at 101.) Mr. Goldman also stated that he did not know of anyone else using the "AVIA" marks on footwear other than ASG and that he did not know of anyone else besides Glory which is using a mark which he regards as confusingly similar mark to ASG's "AVIA" marks. He conceded, however, that he is not aware of any instances in which consumers have confused "AVIA" shoes with any other brand of footwear, including Glory's "AVA" shoes.

Glory is a wholesaler of footwear and has been engaged in such business since around September 1993. With respect, in particular, to its "AVA" and "AVA II" and design marks, such marks were chosen, at the suggestion of Glory's president, James, Ho, because they were short for two of its other marks, "Z AVALANCHE!" and "AVALANCHE." Moreover, according to Mr. Ho, when

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he decided to shorten such marks to "AVA," he was not aware of ASG's "AVIA" marks. The term "AVA," according to Mr. Ho, is correctly pronounced "as in the actress Ava Gardner," rather than as the separate letters "A-V-A" or with an "A" sound as in the word "abandon," and has two syllables. (Ho 6/2/03 dep. at 6.)

Glory's "AVA" and "AVA II" and design marks were first used in connection with work boots and such marks have also been used in connection with hiking boots, with continuous use in commerce of the "AVA" mark having begun on October 30, 1997. The use of its "AVA II" and design mark, however, has been "abandoned."¹⁵ (Responses to Interrogatory Nos. 3 and 4.) Specifically, the "AVA" mark has been used on or in connection with work boots and hiking boots, which Glory sells wholesale to individual, privately owned retailers in the states of California, Michigan, Massachusetts and Nevada.

However, according to Mr. Ho's testimony depositions, Glory markets "all kind of shoes," although its "major, main footwear are work boots, and ... safety footwear in terms of steel toe, fireproof, waterproof type[s] of shoes." (Ho 8/24/01 dep. at 6.) Nonetheless, Glory "also do[es] footwear for casual

¹⁵ It is nonetheless noted that despite Glory's unequivocal statements that its use of the "AVA II" and design mark has been abandoned, ASG never moved for leave under Fed. R. Civ. P. 15(a) to amend its pleading to assert such abandonment as an additional ground for opposition, nor is it the case that the pleadings can be deemed to be amended pursuant to Fed. R. Civ. P 15(b) because such issue plainly was never tried by either the express or implied consent of Glory. Nevertheless, since it is clear that Glory has abandoned its "AVA II" and design mark, the parties are advised that if Glory ultimately prevails herein, its involved application will be remanded to the Examining Attorney pursuant to Trademark Rule 2.131 for reexamination with respect to the issue of abandonment.

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purpose[s]" which is "kind of [a] criss-cross between work and casual" in that such can be worn "to work and also after work." (Id. at 7.) Glory uses the mark "ROAD MATE" mainly to designate its work boots; it uses the mark "BIG BEAR" primarily to identify its hiking boots; it uses the mark "HEAVY UNIT" to designate lower-priced industrial purpose footwear; and it uses the marks "AVALANCHE" and "AVA" in connection with "urban footwear," which it characterizes as "footwear ... for young people such [as are] in high school and college." (Id. at 8.) Such footwear consists of "white shoes, such as sneakers, and brown shoes," which are a "kind of working type of boots for young people" but do not provide "the protective function" of working boots. (Id.) As indicated earlier, Mr. Ho derived the "AVA" mark, which was first used by Glory in the United States in connection with footwear on October 30, 1997, from his "AVALANCHE" mark, which was first used by Glory around 1993. A "full search" as to the availability of "AVA" as a trademark was done for Glory by its counsel's firm herein prior to the commencement of its use of such mark. (Id. at 14.)

According to its president, Glory does not manufacture any athletic shoes which bear the mark "AVA" nor does it sell under such mark what Mr. Ho refers to as "sports shoes." (Ho 6/2/03 dep. at 23.) Similarly, it does not manufacture, sell or promote T-shirts, sweatsuits, shorts, polo shirts, toys, sporting goods, all purpose sport bags, duffel bags, tote bags, waist packs, shoulder bags and book bags using the "AVA" mark.

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Glory does "very little" advertising of its footwear in the United States because such is "very costly." (Ho 8/24/01 dep. at 23.) Although it has promoted its "ROAD MATE" collection in Footwear News, it has not done so for its "AVA" collection. Instead, the advertising which it does is principally cooperative advertising, by which it advertises in its customers' circulars. However, Glory also advertises in its own flyers and posters, which it gives to its customers to "fix in the store[s]," as well as advertising in its own catalogs, which it likewise distributes to retailers. (Id. at 24.) Such promotional material includes advertising of its "AVA" mark. Glory does not advertise in the consumer magazines in which ASG regularly advertises. However, like ASG, Glory attends the World Shoe Association trade show, where it has displayed its catalogs, footwear and hosiery products.

While Glory attempts to market its "AVA" footwear in all states, with the exception of Alaska, it actually sells such products only in the states, as mentioned above, of California, Michigan, Massachusetts and Nevada. In those states in which it actually sells its goods, its products are sold in "any kind of footwear store" and, in the case of one of its customers, such goods are sold in a sporting goods store. (Id. at 31.)

Glory, like ASG, is unaware of any instances of actual confusion between its marks and ASG's "AVIA" marks. Nonetheless, Glory admits that, unlike ASG's sales of its "AVIA" footwear, it does not sell its "AVA" footwear through such sporting goods and department store retailers as Big 5 Sporting Goods, The Sports

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Authority, Sport Chalet and Nordstrom. According to its president, Glory does not consider ASG to be a competitor because "[w]e are in a different market which sells ... [a] different category of product." (Ho 6/2/03 dep. at 27.) Specifically, Mr. Ho elaborated as follows:

Q How would you describe your market?

A ... we have work boots and we have safety boots ... for people who use either at work or at their leisure.

Q And how would you describe the ... Avia line, as far as you know?

A To me, it's ... running shoes, it's sports shoes that I will wear for track.

(Id.) As to the discrepancy between his indication in an earlier answer to an interrogatory that Glory uses its "AVA" mark on work boots and hiking boots, Mr. Ho replied that he "considered a kind of hiking boot as safety boots." (Id. at 35.) Mr. Ho conceded, on cross-examination, that technical differences in footwear, such as details in manner of construction and materials, would not be recognized by the ultimate consumer, although he insisted that "the consumer would be able to know the purpose" (e.g., hiking boots) of different types of footwear. (Id. at 52.)

We find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether there is a likelihood of confusion that, because each of such factors either favors ASG or is neutral, at a minimum confusion is likely from the contemporaneous use of the parties' marks in connection with such legally identical goods as their respective bags and

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footwear.¹⁶ Specifically, as to the *du Pont* factor concerning the similarity or dissimilarity of the marks at issue in their entirety as to appearance, sound, connotation and commercial impression, it must be kept in mind that, as pointed out in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Here, while there are some minor differences between the respective marks as noted by Glory in its brief, overall its "AVA" and "AVA II" and design marks are substantially similar in sound, appearance and commercial impression to ASG's "AVIA" and "AVIA" and design marks, given that the term "AVA" differs from the term "AVIA" only by the presence of the letter "I" in the latter.

In view thereof, and since it is well settled that there is no correct pronunciation of a mark, see, e.g., *Gio. Budon & C. S.p.A. v. Buitoni Foods Corp.*, 205 USPQ 477, 482 (TTAB 1979); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701, 703 (TTAB 1977); and *Sterling Drug Inc. v. Sankyo Co., Ltd.*, 139 USPQ

¹⁶ Where there is a likelihood of confusion as between any of the goods listed in the plaintiff's registration(s) and those set forth in the defendant's involved application(s) and/or registration(s), such is sufficient to support a finding of likelihood of confusion as to the entire class of goods in the defendant's application(s) and/or registration(s). See, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963) ["the board properly held that where there is likelihood of confusion as to any of the goods listed in the application, it is not necessary to rule on other goods listed therein"].

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395, 396 (TTAB 1963), the term "AVA" in Glory's marks is readily susceptible to the first syllable thereof being pronounced, like the first syllable of the term "AVIA," in the same manner as the initial syllable of the word "abandon," especially since the last syllable of both terms is likewise spoken the same as the initial portion of the word "abandon." On the other hand, the first syllable of the term "AVIA" is just as capable of being pronounced with a long "A," like that of the first syllable of the given name of movie actress Ava Gardner, that is, in the same manner as applicant contends that its "AVA" marks would be pronounced. Moreover, and in any event, even if actual and prospective consumers were to pronounce the terms "AVA" and "AVIA" as Glory and ASG respectively maintain is the proper pronunciation, the marks still sound substantially alike.

Similarly, the absence or presence of the letter "I" in the terms "AVA" and "AVIA" fails sufficiently to distinguish the marks at issue visually. Among other things, it should be noted that because Glory's "AVA" mark is registered in the form of a typed drawing, the depiction thereof is not limited to a particular manner of display. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Such registration consequently covers the use of the "AVA" mark by Glory in any reasonable style of lettering, including the bold and slanted manner in which ASG depicts its "AVIA" and design mark. Furthermore, while Glory's "AVA II" and design mark contains several design features, the dominant literal element thereof, which customers would utilize when asking about or

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calling for Glory's various bags and footwear, is the term "AVA," given its prominent manner of display in contrast to the subordinate depiction of the designation "II." It thus is the case that visually, the marks "AVA" and "AVA II" and design are substantially similar to the marks "AVIA" and "AVIA" and design.

As to any similarity or dissimilarity in connotation, the respective marks are basically arbitrary terms which are devoid of any ordinary dictionary or other meaning with the exception of their trademark significance. While Glory contends, in its brief, that "AVIA connotes the verb 'To Fly'" whereas, "[b]y contrast, AVA is short for avalanche, connoting the mountains and danger," the record fails to support either proposition. In particular, the evidence simply does not show that, to retailers and/or the ultimate customers for the parties' goods, the mark "AVIA" signifies or suggests flying,¹⁷ or that the mark "AVA" is regarded as a shortened version of Glory's "Z

¹⁷ The sole evidence with respect thereto consists of the following testimony by Mr. Goldman:

Q Do you know if the word Avia has any meaning other than to connote your product? Identify your product.

A I believe it has a dramatic meaning to fly or -- there is a -- some definition of Avia, however, it's meaningless with respect to the marketing and the brand of Avia.

Q Okay. You don't use a flying theme or anything similar to that --

A No.

Q -- in your marketing?

A That's correct.

(Goldman 4/10/03 dep. at 64-65.)

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AVALANCHE!" or "AVALANCHE" marks, from which Mr. Ho claims to have derived the "AVA" mark. Furthermore, while we recognize that "AVA" is a feminine name, there is nothing in the record which even suggests that buyers would attribute such connotation to applicant's mark. Accordingly, and in view of the substantial similarities between the respective marks, as discussed above, in terms of sound and appearance, the overall commercial impressions conveyed thereby are substantially similar as well. Such similarities are thus a *du Pont* factor which favors ASG.

With respect to the *du Pont* factors which pertain to the similarity or dissimilarity of the goods and the similarity or dissimilarity of established, likely to continue trade channels, such factors clearly favor ASG. In this regard, it is well settled that the registrability of a defendant's involved mark(s) must be evaluated on the basis of the identification(s) of its goods as set forth in its subject application(s) and/or registration(s) for its mark(s) and the identification(s) of the goods as recited in the pleaded registration(s) made of record by a plaintiff for its mark(s), regardless of what the record may reveal as to the particular nature of the respective goods, their actual channels of trade, or the classes of purchasers to which they are in fact directed and sold. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). It is also well established that, absent any specific limitations or restrictions in the

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identification(s) of goods as listed in a defendant's subject application(s) and/or registration(s) and in the identification(s) of goods as set forth in a plaintiff's pleaded registration(s), the issue of likelihood of confusion must be determined in light of a consideration of all normal and usual channels of trade and methods of distribution for the respective goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as broadly identified in the subject application and registration and as set forth in the pertinent pleaded registrations, Glory seeks to register its "AVA II" and design mark for, on the one hand, "bags, namely, shoe bags for travel, travel bags, all purpose athletic bags, gym bags, leather shopping bags, textile shopping bags, shoulder bags, and school bags," and "footwear," on the other hand. In addition, Glory owns a registration for its "AVA" mark for "footwear." Likewise, ASG owns a registration for its "AVIA" mark which lists "all purpose sport bags, duffel bags, tote bags, waist packs, shoulder bags and book bags," and it owns registrations for its "AVIA" and "AVIA" and design marks for, *inter alia*, "athletic shoes." Plainly, on their face, Glory's various "bags" are legally identical in part and otherwise closely related to those of ASG, while Glory's "footwear" encompasses ASG's "athletic shoes." Moreover, as identified, neither parties' goods contain any

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express limitation or restriction as to types of purchasers or channels of distribution. Thus, and as the record discloses, the parties' bags and footwear would be sold to the same classes of purchasers, including footwear retailers as well as ultimate consumers such as fashion-conscious young adults, and would be distributed through the identical channels of trade, including specialty footwear retailers, sporting goods outlets and department stores. Furthermore, and in any event, the record discloses that even if Glory's "footwear" were to be considered as limited to the kinds of work boots and hiking boots on which it has actually used and continues to use its "AVA" mark, such goods include shoes which, like ASG's "AVIA" brand athletic shoes, are used as casual or "urban" footwear by young adults and that ASG also markets shoes under its "AVIA" marks for use as work shoes and hiking shoes. Consequently, when such identical or otherwise closely related goods are sold under the substantially similar marks at issue herein, confusion as to the origin or affiliation of the respective goods is likely to result.¹⁸

As to the *du Pont* factor which concerns the conditions under which and buyers to whom sales are made, it is notable that Glory, despite its assertion that such factor is indeed relevant,

¹⁸ Suffice it also to say that, even if we had sustained all of the numerous evidentiary objections reiterated by Glory in its brief, we would still find a likelihood of confusion herein based solely on the substantial similarities in the respective marks and the identical in part and otherwise closely related nature of the parties' goods as set forth in Glory's subject application and registration and ASG's pertinent registrations.

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does not otherwise discuss the matter in its brief and ASG likewise fails to address it in its briefs. Suffice it to say, however, that while the retailers who buy the parties' goods are obviously sophisticated purchasers, the ultimate consumers of such goods are ordinary, reasonably prudent customers who constitute members of the general public. Given, for example, the relatively modest price points (in the range of between, roughly \$30 or \$40 to \$90 or \$100 per pair) at which footwear is available to the ordinary consumer, the purchasers thereof would not be expected to exercise a great deal of deliberation or care in the selection of such goods or that they would be likely to note the presence or absence of the letter "I" within the respective marks. Moreover, even in the case of footwear retailers, the fact that such dealers may be considered to be sophisticated, highly discriminating buyers "does not necessarily preclude their mistaking one trademark for another" or establish that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Thus, the conditions under which and buyers to whom sales are made is a *du Pont* factor which further favors ASG.

With respect to the *du Pont* factor of the fame of the prior mark in terms of sales, advertising and length of use, ASG contends in its initial brief that its "AVIA mark should be considered as a strong, well-known mark in the field of athletic

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footwear which is therefore entitled to a broad scope of protection." While the evidence properly of record is insufficient to establish that ASG's "AVIA" marks are famous, we nevertheless concur with ASG that its gross sales and advertising figures, its promotional materials, its many years of continuous use of such marks, its position as one of the top ten manufacturers of footwear in all categories, and the absence of any third-party uses of similar marks suffice to collectively demonstrate that ASG's "AVIA" marks are indeed well known and hence strong marks in the athletic footwear field. Thus, the demonstrated strength of ASG's "AVIA" marks for athletic footwear is an additional factor which favors ASG.

As to the *du Pont* factor of the length of time during and conditions under which there has been "concurrent use" without evidence of actual confusion, the record is clear that neither ASG nor Glory is aware of any instances of actual confusion with respect to the marks at issue during a period of nearly six years of contemporaneous use. Glory essentially contends in its brief that such fact is persuasive evidence that there is no likelihood of confusion and that, in particular, "the instant cancellation proceeding is nothing more of [sic] an academic assault on the AVA trademark."

Although the absence of any instances of actual confusion over a significant period of time is indeed a *du Pont* factor which is indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the defendant of its mark in the same

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markets as those served by the plaintiff under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); and *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 541 (TTAB 1979). Specifically, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

In this case, the absence of any instances of actual confusion is not considered to be a mitigating factor favoring Glory inasmuch as, in the period spanning the approximately six years since October 30, 1997 during which the parties have contemporaneously used their respective "AVA" and "AVIA" marks, Glory's sales of its footwear have been limited to the states of California, Michigan, Massachusetts and Nevada rather than the entire United States, as is the case with ASG's sales of its athletic shoes. More importantly, there is no indication as to the level or extent of Glory's sales and it admits that, unlike ASG's sales of its "AVIA" footwear, Glory does not sell its "AVA" footwear through such sporting goods and department store retailers as Big 5 Sporting Goods, The Sports Authority, Sport Chalet and Nordstrom. Furthermore, as to promotion of its "AVA" footwear, Glory concedes that what little advertising it has done has not been in the same consumer magazines as those in which ASG regularly advertises. In the case of trade advertising, Glory admits that it has not promoted its "AVA" mark in the leading industry trade journal, Footwear News, where ASG regularly advertises its "AVIA" shoes. In fact, the sole common trade

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channel which the parties have shared is their attendance at the World Shoe Association trade show. Glory maintains, moreover, that it and ASG are actually in different markets because the parties sell different categories of products. Specifically, Glory insists that because it principally sells work boots and safety boots (including hiking boots) rather than what it views as athletic or sports shoes like those sold by ASG, it does not even consider ASG to be a competitor. Circumstances, therefore, have not been such that the absence of any incidents of actual confusion can be said to be probative of a lack of a likelihood of confusion.

Finally, we agree with Glory that the record does not support the assertion by ASG that Glory adopted its "AVA" and "AVA II" and design marks in bad faith. The sole argument advanced by ASG, as set forth in its initial brief in support of its contention, is that while Glory admitted that the search report which it had its counsel prepare disclosed ASG's "AVIA" marks, Glory's failure to produce a copy of such report, which ASG asserts is clearly relevant evidence within the control of Glory, in response to ASG's discovery requests therefor "gives rise to an adverse inference that the evidence is unfavorable to it." ASG further maintains, in view thereof, that because Glory, as the newcomer, had the duty "to avoid confusion with the well-known marks of others," "Glory's appropriation of ASG's registered AVIA trademark should be given significant weight in determining the issue of likelihood of customer confusion." However, as Glory, quoting from what is currently 3 J. McCarthy,

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McCarthy on Trademarks & Unfair Competition (4th ed. 2004)

§23:115, points out in its brief, "the junior user's mere knowledge or awareness of the senior user's mark is not the same as an intent to confuse customers" and, as Mr. Ho testified, Glory derived its "AVA" mark as a shortened form of its "Z AVALANCHE!" and "AVALANCHE" marks. Consequently, and since Mr. Ho admitted that the search report which he had commissioned for Glory included ASG's registered "AVIA" marks, we find it too speculative to conclude that Glory's failure to produce such report mandates a finding of bad faith adoption by Glory of its marks. Nonetheless, the absence of bad faith is simply not outweighed by the numerous other du Pont factors, all of which, as noted above, either favor ASG and a finding of a likelihood of confusion or are neutral.

We accordingly conclude, in light of the above, that contemporaneous use by Glory of the mark "AVA" in connection with various bags and footwear and the mark "AVIA II" and design for footwear is likely to cause confusion with ASG's use of the mark "AVIA" in connection with its identical in part and otherwise closely related bags and athletic shoes and its use of the mark "AVIA" and design for athletic shoes.

Decision: The opposition is sustained and registration to applicant is refused; however, in the event that applicant ultimately prevails in the opposition, its involved application will be remanded to the Examining Attorney pursuant to Trademark Rule 2.131 for reexamination with respect to the issue of

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abandonment of the subject mark. The petition to cancel is granted and Reg. No. 2,237,432 will be canceled in due course.