

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
Sept. 24, 2004

Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Tribal Sportswear, Inc.

v.

Jayson R. Abram

Cancellation No. 92032828

George W. Neuner and Carrie Webb Olson of Edwards & Angell,
LLP for Tribal Sportswear, Inc.

Jayson R. Abram, pro se.

Before Quinn, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Jayson R. Abram, respondent herein, owns Registration
No. 2234902, which is of the mark TRIBAL IMPRESSIONS (and
design) as depicted below.



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The goods identified in the registration are "apparel for men and women, namely, tee shirts, shirts, pants, dresses, skirts, jackets, suits, athletic tops and bottoms and accessories, namely, scarves, hats and hand-batiked scarves," in Class 25. The registration issued on March 23, 1999 from an application filed on January 6, 1997.¹

Tribal Sportswear, Inc., petitioner herein, filed a petition to cancel respondent's registration on March 6, 2002. As its ground for cancellation, petitioner alleges that respondent's registered mark, as applied to the goods identified in the registration, so resembles petitioner's previously-used and registered mark TRIBAL,² as to be likely

¹ June 1, 1998, is alleged in the registration as the date of first use of the mark anywhere and as the date of first use of the mark in commerce. The following statement also appears in the registration: "The mark contains a stylized drawing of an ivory necklace."

² In the petition for cancellation, petitioner alleged ownership of Registration No. 1843013, of the mark TRIBAL (in typed form) for "men's, ladies and children's clothing; namely, woven and knit shirts, jeans, sweatshirts, pants, skirts, shorts, jumpsuits and jackets." However, petitioner failed to make this registration properly of record, either by timely submission of a status and title copy of the registration pursuant to Trademark Rule 2.122(d), or by proving the current status and title of the registration by means of the testimony of a competent trial witness. (A printout of the registration obtained from the USPTO website was introduced as an exhibit to the testimony deposition of petitioner's witness Mr. Chong, who testified that the registration originally issued to a third party and was subsequently assigned to petitioner. However, Mr. Chong failed to testify clearly that the registration is extant.) In view of Mr. Chong's testimony establishing petitioner's priority of use of its mark on clothing, however, the unavailability to petitioner of the statutory presumptions arising from ownership of a registration is not fatal to petitioner's case herein.

to cause confusion. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).³

Respondent filed an answer by which he denied the salient allegations of the petition to cancel, and in which he also made various allegations denominated as "affirmative defenses," which in essence are merely further denials of petitioner's likelihood of confusion claim.⁴

The evidence of record consists of the February 25, 2003 discovery deposition of respondent Jayson Abram and the exhibits thereto (made of record by petitioner via notice of

³ Petitioner's petition for cancellation also alleges (at paragraph 14) that respondent's mark "dilutes the distinctiveness" of petitioner's mark. Assuming that this allegation was made in support of a claim of dilution under Trademark Act Section 43(c), we note that petitioner presented no argument in support of such claim in its brief on the case and thus is deemed to have waived such claim. The evidence of record fails to establish the claim in any event. Also, in petitioner's brief on the case, petitioner argues that respondent's registration should be cancelled because, according to petitioner, the evidence shows that respondent had not made use of the registered mark in commerce prior to the date the registration issued. However, this "non-use" claim was neither pleaded in the petition to cancel nor tried by the express or implied consent of the parties, and we therefore shall give it no consideration. Thus, the only statutory ground for cancellation at issue in this case is Section 2(d).

⁴ We note, however, that respondent's allegation that confusion is not likely due to the geographic separation of the parties is not a valid defense in this proceeding. Respondent's registration is not geographically restricted, and so is presumed to have nationwide effect. Also, in respondent's brief on the case, respondent argues that petitioner's mark is generic and thus not entitled to protection. Aside from the fact that there is no evidence of record to support this argument, we note that this argument constitutes an attack on the validity of petitioner's pleaded registration and is therefore a compulsory counterclaim which should have been pleaded with respondent's answer. See Trademark Rule 2.144(b)(2), 37 C.F.R. §2.114(b)(2). We have given this argument no consideration.

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reliance), and the May 13, 2003 testimony deposition of petitioner's officer Michel Chong and the exhibits thereto. Petitioner and respondent filed main trial briefs, and petitioner filed a reply brief. No oral hearing was requested. We grant the petition to cancel.

Petitioner has proven that it markets clothing sold under the mark TRIBAL. (Chong Depo. at 7.) In view thereof, and because petitioner's likelihood of confusion claim is not frivolous, we find that petitioner has established its standing to petition to cancel respondent's registration. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

To prevail on its Section 2(d) ground for cancellation, petitioner must establish its priority and the existence of a likelihood of confusion. Petitioner has proven that it has used the mark TRIBAL in the United States on or in connection with ladies' clothing continuously since approximately 1988. (Chong Depo. at 5-7.) The earliest date upon which respondent can rely for priority purposes in this case is the January 6, 1997 filing date of the application which matured into his involved registration. See Trademark Act Section 7(c), 15 U.S.C. §1057(c). We therefore conclude that petitioner has established its priority of use under Section 2(d).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we find that the parties' goods are legally identical in part and otherwise closely related, and that they are marketed in legally identical trade channels and to legally identical classes of purchasers. These facts weigh in favor of a finding of likelihood of confusion. Petitioner has proven that it uses its mark on and in connection with ladies' wear, casual wear, and sportswear, including suits, slacks, pants, skirts, tops and shorts. (Chong Depo. at 4-5; Exhibit Nos. 31-36.) Respondent's goods, as identified in the registration, are "apparel for men and women, namely, tee shirts, shirts, pants, dresses, skirts, jackets, suits, athletic tops and bottoms and accessories, namely, scarves, hats and hand-batiked scarves." These goods are identified broadly, and we must

presume that they include all types and manners of such goods, and that they are sold in all normal trade channels and to all normal classes of purchasers for such goods. See *Octocom Systems, Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ 1783 (Fed. Cir. 1990). We therefore reject as irrelevant respondent's contention that his goods, unlike petitioner's goods, "are intended to appeal to the niche African-American market with association to the African tribal legacy." (Brief at 2.) Moreover, we find that clothing items of the type sold by petitioner and identified in respondent's registration are general consumer items which are purchased with only a normal degree of care, a fact which weighs in favor of a finding of likelihood of confusion.

We next must determine whether respondent's mark and petitioner's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a

specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on virtually identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applying these principles in the present case, we find that respondent's mark is sufficiently similar to petitioner's mark that confusion is likely to result from use of the respective marks on the parties' legally identical and otherwise closely related goods. TRIBAL, petitioner's mark, is a significant and in fact the dominant feature in the commercial impression created by respondent's mark. The word TRIBAL in respondent's mark is presented as the first word in the mark, and in a size which is many times larger than the word IMPRESSIONS. The design element of respondent's mark (which is stated to be a depiction of

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an ivory necklace) would be perceived as merely reinforcing the prominent significance of the word TRIBAL.

Viewing the marks in their entirety, we find that the similarity which results from the prominent use of the word TRIBAL in both marks far outweighs the points of dissimilarity between the marks, i.e., the presence in respondent's mark of the additional word IMPRESSIONS and the additional design element. Stated differently, we find that respondent's mark uses as its dominant feature the entirety of petitioner's mark, i.e., the word TRIBAL, and that the resulting likelihood of source confusion is not negated or reduced by the presence in respondent's mark of the word IMPRESSIONS and the design element. The "impressions" which are connoted by respondent's mark are TRIBAL impressions, and the design of the ivory necklace further reinforces the concept of TRIBAL. Purchasers are likely to assume, based on the prominence of the word TRIBAL in both petitioner's and respondent's marks, that clothing items sold under the two marks come from the same or a related source.

Additionally, we find that petitioner's mark, if not a famous mark, is at least a mark with a strong presence in the marketplace. Petitioner has sold clothing under its TRIBAL mark since 1988, with 1996-2002 sales revenue of approximately \$107 million and advertising and promotional expenditures of approximately \$783,000 dollars during that

same period. (Chong Depo. at 7, 11-16.) Petitioner's clothing is sold in major department store chains such as Macy's, as well as in 1500 to 2000 other retail stores across the country. (*Id.* at 7.) This evidence further supports a finding of likelihood of confusion in this case.

Based on the evidence of record and for the reasons discussed above, we find that petitioner has established that a likelihood of confusion exists. Any doubt as to the correctness of this conclusion (and we have none) must be resolved in petitioner's favor and against respondent, the later user. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). Because petitioner also has established its standing and its Section 2(d) priority, we find that petitioner is entitled to the relief it seeks.

Decision: The petition to cancel is granted.