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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Addict, Ltd.

v.

GS & G, Inc. USA

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Cancellation No. 92046699

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John R. Sommer, Esq. for Addict, Ltd.

Richard S. Ross, Esq. for GS & G, Inc. USA.

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Before Zervas, Bergsman and Ritchie, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On January 10, 2006, Registration No. 3039758 ("the '758 registration") for the mark ADDICT (in standard character form) issued on the Principal Register to GS & G, Inc. USA ("respondent" or "Defendant") for "retail store services featuring clothing" in International Class 35, based on an application filed on January 4, 2005. The '758 registration recites dates of first use anywhere and first use in commerce on August 12, 2004.

Addict, Ltd. ("petitioner" or "Addict") has filed a petition to cancel the '758 registration, alleging that petitioner owns a trademark application (Serial No. 78852067) for ADDICT for various clothing items in International Class 25, which the Office refused registration in view of respondent's registration. Petitioner further alleges that prior to respondent's claimed first use date, petitioner has been and is now (i) engaged in the business of manufacturing, promoting, distributing, and selling clothing worldwide and in the United States under the ADDICT and ADDICTWEAR marks; and (ii) providing retail store services featuring clothing under the ADDICT mark. Additionally, petitioner claims that it owns Registration No. 2310612 (the '612 registration) for the mark ADDICTWEAR (in standard character form) for "sportwear clothing, namely, shirts, shorts, hats, pants, jackets and socks" in International Class 25. According to petitioner, "[i]n the event there is any conflict between the Addict's rights and marks and Defendant's right and marks, Addict clearly has priority over Defendant as to clothing under the ADDICT and ADDICTWEAR marks and as to retail store services under the ADDICT mark."

Respondent has filed an answer to the petition to cancel in which it denied petitioner's salient allegations.

The record consists of (i) the pleadings; (ii) the file of the involved registration; (iii) petitioner's notice of reliance in which it made of record, among other items, a certified copy of the '612 registration showing the status and title of this registration,[1] a copy of "part or all" of the file history of petitioner's pending application Serial No. 78852067 (including an Office action in which the assigned examining attorney has refused registration of petitioner's mark in view of the '758 registration), and respondent's responses to various discovery requests propounded by petitioner; and (iv) the trial testimony of (a) Merwin Andrade, the owner of a clothing store named Memes in New York City, and exhibits, (b) David Jefferies, petitioner's Director of Sales, and exhibits, and (c) Piers Kannangara, petitioner's Managing Director, and exhibits. In addition, the parties filed a stipulation on May 19, 2008 providing that petitioner "stipulates that Respondent GS & G, Inc. USA, has made continuous United States interstate commerce use of its ADDICT mark for the services set forth in U.S. Reg. No. 3,039,758 since at least as early as August 12, 2004."

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[1] The '612 registration was filed on April 15, 1998, claims first use anywhere and first use in commerce in March 1996 and issued on January 25, 2000. Section 8 accepted and Section 15 acknowledged. Also, Mr. Kannangara has testified that petitioner uses the ADDICTWEAR mark on clothing in the United States. Kannangara dep. p. 47.

Petitioner has filed a main brief; respondent has not filed any evidence or a main brief.

Preliminary Issue

Petitioner has not specifically asserted a likelihood of confusion or referenced Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in its pleading. However, the parties have proceeded as though likelihood of confusion is an issue at trial, with respondent's attorney participating in the testimonial depositions of Messrs. Jeffries, Kannangara and Andrade, during which petitioner elicited testimony regarding matters pertaining to likelihood of confusion, without objection from respondent. Indeed, at one point in Mr. Jeffries testimonial deposition respondent's attorney stated, "[I]f it would help, I think the client is willing to stipulate to the issue of confusion." Jeffries dep. at 71. We therefore consider respondent to have been fairly apprised that petitioner was offering evidence in support of the likelihood of confusion issue and find that the likelihood of confusion issue was tried by the consent of the parties. See TBMP § 507.03(b) (2d ed. rev. 2004) and cases cited therein.

Standing

Petitioner has submitted proof that it is the owner of the '612 registration, and that the registration is valid and subsisting. *Cunningham v. Laser Golf Corp.*, 222 F.3d

943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Additionally, petitioner has submitted proof, that it is the owner of application Serial No. 78852067 for ADDICT which has been refused registration in view of respondent's '758 registration. In view of such evidence, petitioner has established its standing. See *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235 (TTAB 2007).

Priority

Because this is a cancellation proceeding, petitioner does not necessarily have priority simply because it owns a registration. *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (the "Board has taken the position, in essence, that the registrations of each party offset each other; that petitioner as a plaintiff must, in the first instance, establish prior rights in the same or similar mark …."). In this case, the parties have stipulated that respondent "has made continuous United States interstate commerce use of its mark ADDICT for the services set forth in U.S. Reg. No. 3,039,758 since at least as early as August 12, 2004." This date is earlier than the January 4, 2005 filing date of the underlying application for respondent's '758 registration, on which respondent may also rely. See *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156

n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application."). Inasmuch as petitioner's use-based application that matured into petitioner's pleaded '612 registration was filed on April 15, 1998, a date earlier than the stipulated date of August 12, 2004 for "retail store services featuring clothing," petitioner has priority in connection with the goods set forth in the '612 registration, "sportwear clothing, namely, shirts, shorts, hats, pants, jackets and socks."[2] We hence award priority to petitioner.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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). 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.*

[2] We need not consider petitioner's allegation of priority based on common law use of ADDICT in light of our disposition of this case based on petitioner's pleaded registration.

Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider first the similarity or dissimilarity of petitioner's and respondent's marks. We determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Petitioner's ADDICTWEAR mark consists of two components, ADDICT and WEAR. "Wear" is defined in *Merriam-Webster's Online Dictionary*, located at merriam-webster.com, as: "**2 a:** clothing or an article of clothing usually of a particular kind; *especially* **:** clothing worn for a special occasion or popular during a specific period **b:** FASHION, VOGUE."[3] Because WEAR merely describes a feature of the goods, i.e., clothing, ADDICT is the dominant term in petitioner's mark. The Federal Circuit has recognized that there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). According to the court, "the

[3] The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *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). We take judicial notice of this definition of "wear."

'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham*, 55 USPQ2d at 1846, quoting, *National Data Corp.*, 224 USPQ at 752.

The dominant term in petitioner's mark is identical to respondent's mark. Because the additional term WEAR does not significantly change the meaning of petitioner's mark, we find that the marks are similar in meaning and commercial impression. They are also similar in sound and appearance in view of the shared term ADDICT, with ADDICT being the first term in petitioner's mark. See, e.g., *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (likelihood of confusion with addition of the words "The" and "Café" and a diamond-shaped design to registrant's DELTA mark); and *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (if "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.") Any differences in the marks due to petitioner's inclusion of the term WEAR are outweighed by the similarity due to the shared term ADDICT. The *du Pont* factor regarding the similarity of the marks is therefore resolved in favor of finding a likelihood of confusion.

Next, we consider the *du Pont* factor regarding the similarity or dissimilarity and nature of the goods and/or services. Such goods and services are similar if they are

related in some manner. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The record reflects that clothing companies use the same mark on both their clothing and clothing stores. See Kannangara dep. at 50; Jefferies dep. at 44, 66 and 74; and third party registrations submitted with petitioner's notice of reliance, from petitioner's application Serial No. 78852067.[4] This evidence suggests that consumers would consider the source of clothing and retail sales of clothing to be the same when sold or provided under similar marks. Additionally, the Board has found in the past that clothing and retail sales of clothing are related for purposes of the likelihood of confusion analysis. See *In re Peebles, Inc.*, 23 USPQ2d 1795 (TTAB 1992) (MOUNTAINHIGH for clothing, namely coats sold in applicant's store is likely to cause confusion with MOUNTAIN HIGH for retail outlet store services for camping and mountain climbing equipment); and *In re Gerhard Horn Investments, Ltd.*, 217 USPQ 1181 (TTAB 1983) (MARIPOSA for retail women's clothing store services is likely to cause confusion with MARIPOSA for woven and knit fabrics of cotton, acrylic and polyester). Because there is a relationship between clothing and retail clothing

[4] The third-party registrations serve to suggest that the goods and services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783 (TTAB 1993).

store services, we resolve the *du Pont* factor regarding the goods and services in petitioner's favor.

Petitioner has said little in its brief about the *du Pont* factor concerning the similarity or dissimilarity of trade channels. We point out that our determination of the likelihood of confusion issue is based on the identification of goods and services as recited in the registrations. See *Hewlett-Packard Co. v. Packard Press Inc.,* 281 F.3d 1261, 62 UPSQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.,* 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Because there are no restrictions as to channels of trade or classes of purchasers in either petitioner's identification of goods or respondent’s identification of services, we presume that petitioner's items of clothing travel in all channels of trade normal for such goods, and that they are available in retail stores, such as respondent’s retail stores, and sold to the general public. We find, therefore, that the trade channels for petitioner's clothing and respondent’s retail store services featuring clothing are the same and that petitioner's clothing and respondent’s services are offered to the same class of purchasers.

We turn next to the *du Pont* factor regarding actual confusion. Petitioner maintains that “[v]arious friends of Mr. Jefferies who have traveled to Miami have asked him

about the GS&G shop because even though it is called 'Addict' it caries no ADDICT products." Brief at p. 22, citing to Jefferies dep. at 71 – 72. Because there is no indication in the record that Mr. Jefferies' friends are purchasers or even potential purchasers of petitioner's goods, we give Mr. Jefferies testimony in this regard limited weight. The *du Pont* factor regarding actual confusion is neutral in our analysis.

Considering and evaluating all of the evidence as it pertains to the relevant *du Pont* factors discussed above, we conclude that a likelihood of confusion exists.[5] Respondent's mark is sufficiently similar to petitioner's registered mark that use of respondent's mark on respondent's services related to petitioner's goods is likely to lead to confusion as to source, sponsorship or affiliation.

DECISION: The petition to cancel Registration No. 3039758 is granted.

[5] Petitioner contends that it has used its mark on a wide variety of goods, but has not submitted proof of which of such uses was in the United States. Petitioner's contention therefore is not persuasive.