

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: January 23, 2013

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Ronald J. Sober  
v.  
Megaware KeelGuard, Inc.

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Opposition No. 91199073  
to application Serial No. 85078009

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David Allen Hall of Hall Law Firm for Ronald J. Sober.

Gary D. E. Pierce of Pierce IP Law Group PC for Megaware KeelGuard, Inc.

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Before Seeherman, Cataldo and Adlin,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On July 5, 2010, applicant, Megaware KeelGuard, Inc., filed an application to register on the Principal Register the standard character mark MEGAWARE SKEGGUARD, with “SKEG GUARD” disclaimed, based upon its assertion of a bona fide intent to use the mark in commerce for “structural parts for boats,” in International Class 12.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85078009.

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Registration has been opposed by Ronald J. Sober (“opposer”). As grounds for opposition, opposer asserts in his amended notice of opposition that he is the owner of the following mark, previously used and registered on the Principal Register:



with “SKEGGARD” disclaimed, for “marine engine cover kits for protecting skegs comprised of a preformed cover member designed to fit over the skeg and permanently attach to the lower unit of the marine engine” in International Class 7.<sup>2</sup>

Opposer alleges that he has made use in commerce of his above-displayed mark in connection with the above-listed goods since prior to any date of first use upon which applicant may rely; and that applicant’s mark, when used in connection with applicant’s goods, so resembles opposer’s mark for his recited goods as to be likely to cause confusion, to cause mistake, and to deceive.

Applicant, in its answer, generally denies the salient allegations contained in the notice of opposition and presents arguments which are construed as amplifications of such denials.<sup>3</sup>

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<sup>2</sup> Registration No. 3025883 issued on December 13, 2005. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

<sup>3</sup> In addition, applicant asserted in its answer to the amended notice of opposition that opposer’s pleading fails to state a claim upon which relief can be granted. However, applicant failed to pursue such assertion by motion. *See* TBMP § 503

**The Record**

By operation of Trademark Rule 2.122, 37 C.F.R. §2.122, the record in this case consists of the pleadings and the file of the involved application. In addition, during his assigned testimony period opposer submitted notices of reliance upon a status and title copy of his pleaded registration; advertisements for opposer's goods under his mark appearing in printed publications;<sup>4</sup> examples from printed publications and Internet webpages of opposer's mark and applicant's mark used in connection with their recited goods; opposer's patent for the goods identified by the mark in his pleaded registration; applicant's responses to opposer's interrogatories; and applicant's written responses and objections to opposer's requests for production of documents.<sup>5</sup>

During its assigned testimony period, applicant submitted notices of reliance upon dictionary definitions of "skeg" and "guard;" a thesaurus entry for "guard;" examples printed from Internet websites of use of the term "skeg guard" by third parties; and examples printed from applicant's Internet website of applicant's use of its mark in connection with its goods.

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(October 2012) and authorities cited therein. Accordingly, it has been given no consideration.

<sup>4</sup> Opposer also submitted a price quotation and sample advertisements from an advertising firm for the goods under opposer's mark. However, such documents are not appropriate for introduction by notice of reliance inasmuch as they do not qualify as either printed publications, such as books and periodicals available to the public, or as official records as contemplated by Trademark Rule 2.122(e).

<sup>5</sup> While documents produced in response to a request for production cannot be made of record by notice of reliance, written objections and responses to the effect that no such documents exist can be.

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Both parties filed main briefs, and opposer filed a reply brief.

**Opposer's Standing and Priority of Use**

Because opposer has properly made his pleaded registration of record, we find that opposer has established his standing to oppose registration of applicant's mark. See *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). Moreover, because opposer's pleaded registration is of record, priority is not an issue in this case as to the mark and goods covered in that registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

**Likelihood of Confusion**

Our likelihood of confusion 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 likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Goods

As noted above, the goods identified in opposer's pleaded registration are identified as "marine engine cover kits for protecting skegs comprised of a

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preformed cover member designed to fit over the skeg and permanently attach to the lower unit of the marine engine.” According to a definition of record, a “skeg” is “a projection supporting a rudder at its lowest end, located abaft a sternpost or rudderpost” or “an extension of the keel of a small craft, designed to improve steering.”<sup>6</sup> Thus, as identified, opposer’s goods are preformed covers designed to fit over and protect a boat’s rudder or keel extension - or skeg - located at the bottom of a boat’s engine. Accordingly, opposer’s skeg covers are closely related to applicant’s goods inasmuch as opposer’s goods are parts for a boat’s motor and applicant’s goods are parts for boats. We further note that, in its brief, applicant does not present any arguments with regard to the similarity of the goods.

In view of the highly similar nature of opposer’s goods and applicant’s goods, this du Pont factor favors a finding of likelihood of confusion.

#### Channels of Trade and Classes of Consumers

It is settled that in making our determination regarding the relatedness of the parties’ goods, we must look to the goods as identified in the involved application and pleaded registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

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<sup>6</sup> Applicant’s First Notice of Reliance, retrieved from dictionary.com.

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Because there are no restrictions in either applicant's or opposer's identification of goods as to the channels of trade in which the goods may be encountered, or type or class of customer to which the goods are marketed, both applicant's and opposer's goods must be presumed to move in all normal channels of trade and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Inasmuch as opposer's goods are skeg covers for marine engines and applicant's goods are structural parts for boats, the goods as identified may be presumed to be marketed to boat owners and mechanics who would customarily repair and refit boats.

In addition, evidence of record establishes that the parties' goods are marketed in the same channels of trade, namely, magazines and catalogs for boaters, and to the same classes of consumers, namely, boat owners.<sup>7</sup> We find that, as a result of the foregoing, this du Pont factor also favors a finding of likelihood of confusion.

The Marks

We turn then to the first du Pont factor, i.e., whether applicant's MEGAWARE SKEGGUARD mark and opposer's



mark are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc.* 73 USPQ2d at 1691.

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In this case, applicant's MEGAWARE SKEGGUARD mark essentially incorporates the word that is the subject of opposer's mark, which consists of the disclaimed term SKEGGARD with a novel spelling and presented in stylized script that is the sole inherently distinctive portion of the mark. The terms SKEGGUARD and SKEGGARD are identical in sound and, as discussed above, in meaning.

However, we note that opposer has disclaimed the wording "SKEGGARD" in his mark and that applicant also has disclaimed the term "SKEG GUARD" in its mark. Applicant argues that the common portion of the marks is a generic indicator for opposer's goods and that, as a result, the additional material in its mark serves to distinguish them. Applicant's contention is supported by its evidence of generic use of the term "skeg guard" by third parties in Internet advertisements and blogs to describe protective covers for the skeg on a boat motor.<sup>8</sup> Applicant's contention further is supported by evidence made of record by opposer. Opposer's Internet advertisements for its goods contain the following information:

Protect your outboard and sterndrive engine from damage with a SKEGGARD skeg guard!  
High-quality marine-grade stainless steel.  
Twice as strong as the original skeg.  
No effect on performance.  
Easy, do-it-yourself installation.  
Now there's a better way to repair lower unit skeg damage.  
Simply bolt on the SKEGGARD skeg guard right over the damaged skeg. It's quick, it's easy, and it's stronger than the

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<sup>7</sup> Id.

<sup>8</sup> Applicant's Third Notice of Reliance, Exhibits G – S.

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original, so it protects your skeg and propeller from future damage.<sup>9</sup>

Thus, opposer himself uses the term “skeg guard” as a generic term applied to his goods identified under his pleaded mark. As a result, we find that the term comprising opposer’s



mark is, at best, highly descriptive, if not generic, as applied to his goods. We further find that opposer’s mark consists of a highly descriptive term in stylized lettering, including a letter “G” in the shape of what appears to be a keel or skeg. In view thereof, we find that opposer’s mark is very weak as applied to his goods and that the scope of protection to which it is entitled does not extend to preventing registration of any marks simply because they include the highly descriptive or generic term SKEG GUARD.

Applicant’s MEGAWARE SKEGGUARD mark also obviously includes the term MEGAWARE. Although applicant asserts that this is its house mark, we find little evidence, apart from applicant’s assertion, that it uses MEGAWARE as such. Nonetheless, the term appears to be arbitrary and strong as applied to applicant’s goods, and certainly there is no evidence of record to suggest that it is descriptive, or even suggestive, thereof. As a result, regardless of whether MEGAWARE is a house mark for applicant, the

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<sup>9</sup> Opposer’s Second Notice of Reliance.

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similarity of the marks turns on whether the addition of MEGAWARE is sufficient to distinguish the marks for closely related goods.

In this case, with the highly descriptive, if not generic, term SKEGGUARD (or SKEGGARD) as the sole shared term between the mark in the application and opposer's registration, we find the marks to be more dissimilar than they are similar in appearance, sound, connotation and overall commercial impression. This situation is analogous to the case of Knight Textile Corp. v. Jones Investment Co., 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS allowed to register despite opposition from owner of ESSENTIALS). There, the parties had in-part-identical goods and the applied-for-mark incorporated in full the registered mark. The Board found, however, that the registered mark (*i.e.*, the shared term) was "highly suggestive as applied to the parties" goods. *Id.* at 1315. Furthermore, the Board found that the addition of applicant's house mark to what the evidence had shown to be a "highly suggestive" shared term resulted in a showing of no likelihood of confusion. Presented with similar circumstances here, and particularly because the shared term is highly descriptive or generic, we reach the same result.

In sum, we find that, viewed in their entirety, the dissimilarities of the marks outweigh their similarities. We further find that consumers would be likely to distinguish the marks based on those differences. Accordingly, we find that this du Pont factor weighs against a finding of likelihood of

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confusion.

### Applicant's Intent

Next, opposer argues that applicant's selection of its mark, and the filing of its involved application, was made with actual knowledge of opposer, his mark and businesses. To the extent that opposer is arguing that applicant adopted its mark in bad faith, there is insufficient evidence to show this or from which we can infer it. As opposer acknowledges, mere knowledge of the existence of opposer's mark does not, in and of itself, constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ 1307 (Fed. Cir. 1989) ; *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006). The record in this case simply does not show that applicant intentionally sought to trade on opposer's good will. Applicant's mere acknowledgement that it was aware of opposer since 2000,<sup>10</sup> and its failure to indicate whether it conducted a trademark clearance search prior to filing or produce documentary evidence in support thereof,<sup>11</sup> fall short of demonstrating that applicant acted in bad faith.

### **Summary**

We have carefully considered all of the evidence pertaining to priority of use and the relevant du Pont factors, as well as all of the arguments with

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<sup>10</sup> Opposer's Notice of Reliance, Exhibit W.

<sup>11</sup> *Id.*, Exhibit S.

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respect thereto, including any evidence and arguments not specifically discussed in this opinion.

We conclude that opposer has established his standing to bring this proceeding and his priority of use. However, in balancing the du Pont factors we find that consumers familiar with opposer's goods under his mark would not be likely to believe, upon encountering applicant's involved mark for its recited goods, that the parties' goods originate with or are associated with or sponsored by the same entity.

DECISION: The opposition is dismissed.