

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brooks Sports, Inc.

Serial No. 86946003

Syed Abedi and Jennifer R. Ashton of Seed IP Law Group LLP
for Brooks Sports, Inc.

Odette Martins, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

Before Taylor, Lykos, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Brooks Sports, Inc. (“Applicant”) seeks registration on the Principal Register of the mark CALDERA in standard characters, for “athletic footwear” in International

Class 25.¹ The Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark CALDERA, registered on the Principal Register in standard characters, for goods that include “[c]lothing, namely, knit face masks and neck warmers” in International Class 25.² After the final Office Action, Applicant requested reconsideration and appealed. The Board remanded the case, and the Examining Attorney denied reconsideration. The appeal resumed and has been fully briefed. We affirm the refusal to register for the reasons set out below.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The 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.”). We discuss below these

¹ Application Serial No. 86946003 was filed March 18, 2016, based on a declared intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Principal Register Registration No. 4310746 issued March 26, 2013.

and other relevant factors. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (only *du Pont* factors that are “relevant and of record” need be considered).

A. Similarity of the Marks

We first turn to the *du Pont* factor comparing the applied-for and cited marks, which we consider “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs., Inc. v. Glenn Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

To state the obvious, the applied-for and registered marks are identical – CALDERA in standard characters. Applicant makes no argument regarding this *du Pont* factor. Overall, the marks are indistinguishable in appearance, sound, meaning, and commercial impression, weighing in favor of likely confusion.

B. Relatedness of the Goods

As to the goods, they need not be “competitive or intrinsically related” to find a likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1737 (Fed. Cir. 2017). “Instead, likelihood of

confusion can be found “if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). In making this analysis of the second *du Pont* factor, we look to the identifications in the application and cited registration. *See Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We bear in mind that where identical marks are involved, the relationship between the goods need not be as close to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). Applicant identifies athletic footwear, while the cited registration identifies, *inter alia*, knit face masks and neck warmers.

The record includes evidence that goods of this type emanate from the same source under the same mark. For example:

- The Columbia Sportswear Company website offers a “Neck Gaiter” bearing the COLUMBIA mark, as well as various athletic shoes bearing the same mark;³
- The website for REI (Recreational Equipment, Inc.) offers trail-running athletic shoes and neck gaiter scarves all under the NORTH FACE mark;⁴

³ TSDR July 1, 2016 Office Action at 2-3 (columbia.com); *see also* TSDR Jan. 26, 2017 Office Action at 2-3 (columbia.com).

⁴ TSDR July 1, 2016 Office Action at 4-5 (rei.com); *see also* TSDR Jan. 26, 2017 Office Action at 18-19 (Dicks Sporting Goods website at dickssportinggoods.com offering NORTH FACE hiking shoes and NORTH FACE neck gaiters).

- The L.L. Bean website features under its L.L. BEAN mark various neck gaiters and knit balaclava face masks, as well as athletic hiking shoes;⁵
- The Cabela's ("World's Foremost Outfitter") website shows the CABELA'S mark used for athletic shoes, neck gaiters, and knit balaclava face masks;⁶
- The Carhartt website also shows its mark on athletic shoes and on neck gaiters.⁷
- The Under Armour website shows the UA mark used on neck "gaitors" [sic] and athletic shoes.⁸
- The Zappos website offers neck warmers and athletic shoes under the MICHAEL MICHAEL KORS mark.⁹
- The ARC'TERYX website offers athletic shoes and neck gaiters under the same design mark.¹⁰
- The Backcountry website offers athletic running shoes and neck gaiters under the NIKE mark.¹¹

Applicant argues that the evidence lacks probative value because it involves house marks and designer marks used for a broad range of goods, while the Examining Attorney responds that Applicant failed to offer any proof of this. While the webpages show that the third-party marks sometimes may be used with other marks, they do not show their use with such a wide variety of goods as to undermine their probative

⁵ TSDR July 1, 2016 Office Action at 6-7 (llbean.com); *see also* TSDR Jan. 26, 2017 Office Action at 13-17 (llbean.com featuring neck gaiters and walking shoes).

⁶ TSDR July 1, 2016 Office Action at 8-9 (cabelas.com); *see also* TSDR Jan. 26, 2017 Office Action at 9-10 (cabelas.com).

⁷ TSDR July 1, 2016 Office Action at 10-11 (carhartt.com); *see also* TSDR January 26, 2017 Office Action at 20-23 (carhartt.com).

⁸ TSDR January 26, 2017 Office Action at 4-8 (underarmour.com)

⁹ *Id.* at 9-12 (zappos.com).

¹⁰ *Id.* at 24-29 (arcteryx.com).

¹¹ *Id.* at 30-34 (backcountry.com).

value. Rather, the screenshots in the record do not show a broad range of goods, and the other indicia of the webpages suggests that the overall scope of goods potentially covered by most of these third party marks appears relatively limited to “sportswear,” “sporting goods,” recreational clothing and gear, and the like. We find this marketplace evidence persuasive to show that consumers encounter athletic footwear being sold by a single entity under the same mark as knit face masks and neck warmers.

The Examining Attorney also submitted additional evidence, in the form of ten (10) use-based third-party registrations that identify athletic footwear and knit face masks under the same mark.¹² These registrations suggest that the relevant goods may emanate from the same source. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (“The use-based, third-party registrations . . . also have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.”); *see also In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Applicant argues against finding relatedness because the goods “have different purposes and would be displayed in different sections of a department store.”¹³ The Examining Attorney correctly notes that consumers would use both Registrant’s and Applicant’s goods for an athletic purpose, and that Applicant failed to provide

¹² TSDR July 1, 2016 Office Action at 15-88.

¹³ 5 TTABVUE 9 (Applicant’s Brief).

supporting evidence for its assertion about the asserted method of display. Regardless, relatedness does not depend on goods having the same purpose, or on their being sold in the same sections of a store. *See, e.g., Shell Oil Co.*, 26 USPQ2d at 1689 (automotive parts distributorship services and service station oil change and lubrication services deemed sufficiently related to cause confusion because even where the services differ, “the use of identical marks can lead to the assumption that there is a common source”). Although as Applicant’s particular cited cases note, differences in purpose and placement in different departments of retail stores *may* factor in to an overall finding that goods are not related, these considerations are not dispositive of relatedness or the lack thereof. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ at 29 (evidence that the only link between the goods is that they are sold in the same area of a supermarket is not sufficient to establish that the goods are related). As previously noted, “it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion.” *Coach Servs.*, 101 USPQ2d at 1722 (citation omitted). It suffices that the goods are “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Id.* (citation omitted). The Examining Attorney’s evidence demonstrates that consumers would encounter the type of athletic footwear identified by Applicant and the specific type of clothing items identified in the cited registration offered by the same entities under the same marks.

Applicant next argues that the goods are not related because they are not complementary. As an initial matter, although a showing that goods are complementary may be one way to demonstrate relatedness, it is not *required* to demonstrate relatedness. Regardless, the record contains evidence that consumers who exercise in cold weather would wear athletic shoes as well as knit face masks or neck warmers, thereby reflecting that the goods are complementary. The Examining Attorney introduced eight articles and blogs relating to winter running, each of which recommends that athletic shoes and neck gaiters be worn together.¹⁴ Also, she submitted screenshots of promotional webpages for race events that include recommendations to wear both athletic shoes and face masks or neck gaiters.¹⁵ Applicant criticizes this evidence, although without any supporting counter-evidence, asserting that the evidence involves “a very specialized form of running through mountains, and under winter and extreme weather.”¹⁶ However, we find that the relevant goods are recommended for use together in cold weather running, which the quantity and nature of evidence indicates is reasonably common. Applicant also opines that because this evidence “reference[s] other completely unrelated goods,” it

¹⁴ TSDR August 16, 2017 Denial of Reconsideration at 2 (“5 unlikely Tips for Winter Running” in [trailandultrarunning.com](#)); *id.* at 3 (“Winter Running Gear – Review of Personal Favorites from Head-to-Toe” in [runblogger.com](#)); *id.* at 4 (“Winter Running: 10 Tips” in [gearjunkie.com](#)); *id.* at 5 (“The Beginner’s Guide to Winter Running” in [blog.mapmyrun.com](#)); *id.* at 6-9 (“Winter Advisory” in [runnersworld.com](#)); *id.* at 10 (“Winter Running Guide” in [michiganrunnergirl.com](#)); *id.* at 12 (“The Right Stuff: Alpine Running” in [trailrunproject.com](#)); *id.* at 14 (“It’s Only Cooler if You’re Standing Still: How to Dress for Winter Running Success” in “Dick’s Pro Tips” at [protips.dickssportinggoods.com](#)).

¹⁵ *Id.* at 11 (White Mountains 100 race at [wm100.endurancenorth.org](#)); *id.* at 13 (Antarctic Ice Marathon & 100k at [icemarathon.com](#)).

¹⁶ 5 TTABVUE 12 (Applicant’s Brief).

undermines the case that the relevant goods are complementary.¹⁷ We disagree. References in some of the resources to other non-apparel items that might also be useful in cold weather does not undermine the showing that the relevant goods are complementary. The evidence generally shows that athletic footwear and knit face masks and neck warmers often would be worn together, indicating that they are complementary items.

Overall, we find that the record amply supports the relatedness of the relevant goods.

C. Trade Channels and Classes of Consumers

This *du Pont* factor must be assessed according to the identifications of the respective goods in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs.*, 101 USPQ2d at 1722; *Octocom*, 16 USPQ2d at 1787. “[I]n the absence of specific limitations,” which we do not have in these identifications, we must assume that the identified goods move through all normal and usual channels of trade for such goods and to all normal potential purchasers. *In re i.am.symbolic llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1750 (Fed. Cir. 2017); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). The marketplace evidence set out above reflects that athletic footwear, knit face masks, and neck warmers are promoted and sold together through the same websites, reaching the

¹⁷ *Id.*

same classes of consumers. Thus, we find that the trade channels and classes of consumers overlap.

D. Number and Nature of Similar Marks in Use on Similar Goods

Evidence of third-party use and registration of a term *in the relevant industry* is considered in the likelihood of confusion analysis. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). In the case before us, however, Applicant points to no evidence of third-party actual use, and instead relies only on four third-party registrations of marks (two of which have the same owner) that consist of or include CALDERA. Applicant's record thus does not demonstrate *commercial* weakness from third-party use, and cannot support its claim that "consumers are well-conditioned to make fine-grained distinctions"¹⁸ among marks including CALDERA. However, even where the record lacks proof of actual third-party use, third-party registration evidence may show *conceptual* weakness, in that a term carries a highly suggestive or descriptive connotation in the relevant industry. Yet Applicant's showing does not rise to this level. Three of the four third-party registrations identify soft drinks, restaurant services, and wine, quite far afield from Registrant's goods in this case.¹⁹ Thus, unlike in *Juice Generation* and *Jack Wolfskin*, where the third-party evidence involved the very same goods and services at issue,

¹⁸ 5 TTABVUE 14 (Applicant's Brief).

¹⁹ Registration Nos. 4828776, 3977834, and 4733229.

here most of Applicant's third-party registration evidence relates to entirely different goods and services. It therefore lacks probative value as to alleged weakness of the term CALDERA in relation to Registrant's knit face masks and neck warmers. *See i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for goods in other classes where the proffering party "has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, ... support a finding that registrants' marks are weak with respect to the goods identified in their registrations"). The remaining third-party registration of CALDERA SPRINGS for "clothing, namely, hats, shirts and visors,"²⁰ also involves different goods, albeit closer to Registrant's goods in that they are items of clothing. As to the mark, we agree with the Examining Attorney that CALDERA SPRINGS creates a somewhat distinct, geographic commercial impression from CALDERA alone. More importantly, we cannot find, based on a single third-party registration that Registrant's mark is conceptually weak and deserving of less protection.

III. Conclusion

The identical marks for related goods that move in overlapping channels of trade, reaching the same classes of customers, renders confusion likely.

Decision: The refusal to register Applicant's mark is affirmed.

²⁰ Registration No. 3628825.