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29 APR 1998

THIS DISPOSITION  
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Paper No. 50  
PTH

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Converse Inc.

v.

Michael Wilkerson Jones

Sams ~~at~~ ~~vs~~

086/23/97

Opposition No. 90,333

to application Serial No. 74/298,814

filed on July 28, 1992

Kenneth Solomon and Anthony Simon of Howell & Haferkamp for  
Converse Inc.

Carl W. Battle, Esq. for Michael Wilkerson Jones.

Before Cissel, Quinn and Hairston, Administrative Trademark  
Judges.

Opinion by Hairston, Administrative Trademark Judge.

Converse Inc. has opposed the application of Michael  
Wilkerson Jones to register the mark RAP ALLSTARS for  
"clothing and apparel, namely pants, tops, bottoms, shirts,  
jackets, coats, neckwear, headwear, sleepwear, underwear,  
shorts, vests, swimwear, sweat pants, sweat shirts, sweat

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suits, suits, vests, jump suits, overalls, suspenders, belts and footwear."<sup>1</sup>

In the notice of opposition, opposer alleges that it manufactures and sells footwear and wearing apparel under the following registered trademarks ALL STAR for athletic shoes of rubber and fabric,<sup>2</sup> all purpose sports bags, excluding bags intended primarily for sports equipment,<sup>3</sup> shirts;<sup>4</sup> and eyewear, namely, sunglasses, eyeglasses, eyewear cases, and frames;<sup>5</sup>

The logo consists of the words "ALL" and "STAR" in a bold, black, sans-serif font. A large, solid black five-pointed star is positioned between the two words, partially overlapping them.

for footwear;

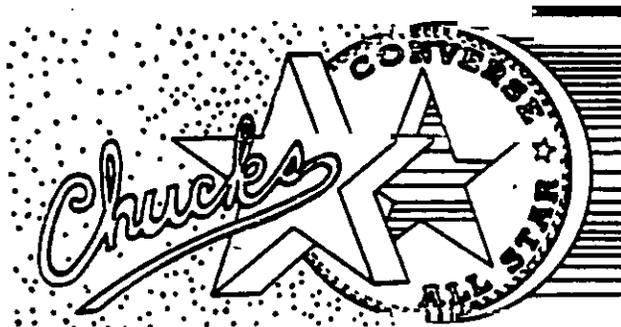
<sup>1</sup> Application Serial No. 74/298,814, filed July 28, 1992, claiming a date of first use of January 15, 1991 and a date of first use in commerce of January 16, 1991

<sup>2</sup> Registration No. 369,971, issued August 8, 1939; renewed twice. Registration No. 1,275,191, issued April 24, 1984, Sections 8 & 15 affidavit filed

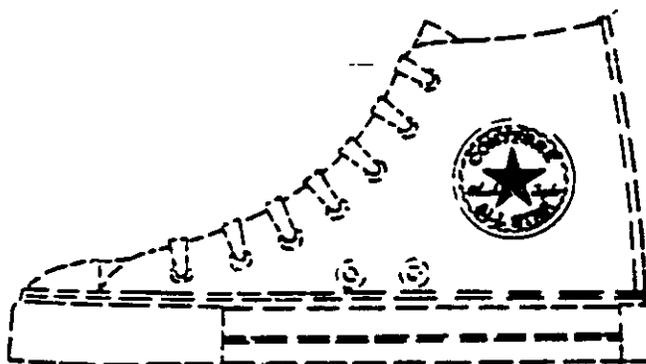
<sup>3</sup> Registration No. 1,276,236, issued May 1, 1984, Sections 8 & 15 affidavit filed

<sup>4</sup> Registration No. 1,568,131, issued November 28, 1989, Sections 8 & 15 affidavit filed

<sup>5</sup> Registration No. 1,146,976, issued February 10, 1981; Sections 8 & 15 affidavit filed



for apparel, namely sweaters, pants, shirts, shorts, jackets and warm-up suits;<sup>7</sup>



for athletic footwear;<sup>8</sup>

<sup>7</sup> Registration No. 1,471,496, issued January 5, 1988; canceled

<sup>8</sup> Registration No. 1,490,262, issued May 31, 1988; Sections 8 & 15 affidavit filed.



for all purpose sport bags;<sup>9</sup>



for footwear, ALL STAR FIELDERS CHOICE for footwear;<sup>10</sup> and

<sup>9</sup> Registration No 1,508,127, issued October 11, 1988, canceled

<sup>10</sup> Registration No 1,109,468, issued August 5, 1980; Sections 8 & 15 affidavit filed

<sup>11</sup> Registration No 1,001,187, issued July 13, 1982; Sections 8 & 15 affidavit filed



for footwear,<sup>12</sup> that opposer has used the registered marks since prior to the date of use claimed by applicant, and that applicant's use of his mark for his goods is likely to cause confusion or mistake or to deceive, and applicant's mark falsely suggests a connection with opposer<sup>13</sup>

Applicant, in his answer, denied the salient allegations in the notice of opposition.

The record includes the pleadings; the file of the involved application, and the testimony of opposer's witnesses Michael Bell, Donald Camacho, John O'Neil, Daniel Dull and Robert Savoca, with exhibits. Opposer has also made of record, by notice of reliance, copies of newspaper articles and publications; applicant's responses to certain of opposer's requests for admissions; applicant's response to opposer's interrogatory no 15, and status and title copies of opposer's eleven pleaded registrations Applicant, as the

<sup>12</sup> Registration No 1,138,469, issued August 5, 1980, Sections 8 & 15 affidavit filed

<sup>13</sup> Opposer made no mention of the false suggestion of a connection claim in its brief on the case. Thus, we consider the claim to have been dropped.

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sole admissible evidence introduced on his behalf, has filed a notice of reliance on six third-party registrations and an article discussing applicant and this proceeding which appeared in a number of newspapers.<sup>14</sup>

The parties have fully briefed the case, but no oral hearing was requested.

The record shows that opposer began manufacturing footwear in 1909. In approximately 1916 opposer developed its ALL STAR shoe, a canvas-upper, high-top basketball shoe which became its most important product. On the outsole of this canvas-upper, high-top basketball shoe there was a logo consisting of CONVERSE in a semicircle, with a five-pointed star below the name, and the words ALL STAR under the star. At the same time, opposer started using a circular ankle patch on the shoe, which originally had CONVERSE in the upper part of the circle, a five-pointed star in the center and the words ATHLETIC SHOE on the bottom part of the circle. In 1921 the patch was modified to add the signature of CHUCK TAYLOR, opposer's first salesman and an Indiana high school basketball star. In 1946 ALL STAR was substituted for the phrase ATHLETIC SHOE. Since 1946 opposer has continuously used that version of the ankle patch on its ALL STAR basketball shoes, with the only change occurring in the mid-

<sup>14</sup> We note opposer's renewed motion to strike the materials submitted by applicant. For the reasons set forth in the Board's January 22, 1997 order, the renewed motion is denied. The probative value of these materials will be discussed infra.

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1950's when the color red was adopted for the words ALL STAR and the color blue for the star. In 1952 opposer introduced a low-cut canvas shoe which also bore an ALL STAR mark, this time the words ALL STAR with a five-pointed-star between the two words appearing on the tongue, and on the outsole the same logo as on the outsole of the high-cut ALL STAR basketball shoe.

Due to the success of the ALL STAR shoes, opposer began using and registering variations of ALL STAR or star design marks, and also began, in the 1970's, using the ALL STAR marks for collateral products such as T-shirts, sweat shirts, socks, and sport bags.

In the early 1980's opposer developed a full line of active wear, including tennis shorts and shirts, warm-up suits, coaches' shorts, and golf and tennis shirts. Opposer has recently licensed use of its ALL STAR marks on other items such as eyeglasses, time pieces, watch bands and hats.

Since 1916 the ALL STAR shoe has been opposer's primary canvas shoe, and opposer has promoted the shoe extensively. Beginning in 1921 opposer distributed an annual Basketball Yearbook to all high school and college basketball coaches in the country, and also sent them to anyone who requested one. One reason for the yearbook was to promote the ALL STAR shoe. As early as the 1920's opposer placed print ads in major

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metropolitan newspapers throughout the country, and in the 1930's opposer began sending trade ads to retailers.

Opposer's first radio advertisements were broadcast shortly after World War II and its first television advertisements ran in the mid-1950's.

Opposer has appeared at trade shows since the 1930's. It participates in national, regional and even international trade shows, and was a founding exhibitor of the National Sporting Goods Association and a founding member of the Sporting Goods Manufacturers Association.

Opposer has also distributed catalogs since the early 1930's on an annual or a semi-annual basis, in which it displays its product line and pictures of the products. These catalogs are distributed at trade shows and by opposer's salesmen when they call on customers, and they are mailed to those on opposer's mailing list, including athletic and sporting goods retailers, footwear buyers of major department stores, and footwear and athletic footwear chain stores. Opposer also sends them in response to mail, telephone or telemarketing requests.

Opposer also promotes its products by endorsers, i e., professional sports players or coaches. Recent endorsers include Julius Erving and Magic Johnson. Opposer was the first official sponsor of the U S. Olympic basketball team

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from 1936 through 1988, and up to and including the 1980 Olympics opposer supplied the team with ALL STAR shoes.

Opposer sells its products throughout the United States. Its customers include sporting goods stores, department stores, and shoe stores that sell athletic footwear and apparel. Approximately 9,000 to 10,000 retail outlets handle opposer's products, including Footlocker, J. C. Penny, Sears, and Endicott Johnson. In addition, opposer sells its footwear and active wear in its 29 company-owned stores

Little is known about applicant's business activities under the mark RAP ALLSTARS. In response to opposer's interrogatories, applicant stated that his products are sold at musical trade exhibitions, music concerts, special events, and through street vendors and specialty shops. Also, applicant indicated that he had advertised and promoted his products at the 1993 "Black Expo U S A." held in Los Angeles, California and Washington, D.C.

As indicated above, opposer has made of record status and title copies of its pleaded registrations. We note that two of the registrations (Registration Nos 1,471,496 and 1,508,127) have been canceled under Section 8 of the Trademark Act and opposer did not establish, through testimony, its priority with respect to the marks in these registrations. However, as to the other subsisting registrations, there is no issue with respect to opposer's

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priority as to the marks shown in these registrations. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

We now turn our attention to the issue of likelihood of confusion. With respect to the most relevant of opposer's marks, ALL STAR, and applicant's mark RAP ALLSTARS, it is our view that when considered in their entireties, these marks are substantially similar in sound, appearance and commercial impression, due to the shared presence of the term ALL STAR. Applicant's mark RAP ALLSTARS encompasses the entirety of opposer's ALL STAR mark, and while it adds thereto the term RAP, this is insufficient to distinguish applicant's mark from opposer's mark. Further, the fact that applicant uses the plural ALLSTARS rather than the singular ALL STAR does not aid in distinguishing the marks. In this regard, we note the testimony of opposer's witnesses that the purchasing public often refers to its athletic shoes as ALL STAPS. Further, opposer submitted copies of newspaper articles and its own advertising wherein its athletic shoes are referred to as ALL STARS.

In addition, we have no trouble concluding that, based on opposer's extensive advertising, promotion and sale of athletic shoes bearing the ALL STAR mark for over 75 years,

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ALL STAR has become a famous trademark.<sup>15</sup> In the past, it has been observed that the propensity of consumers to associate a relatively unknown mark with one which is well known to them increases the likelihood of confusion, mistake or deception. See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir 1984) and Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir 1992) [The fame of a mark plays a dominant role in cases involving a famous or strong mark]. The following excerpts are indicative of the unsolicited publicity enjoyed by opposer's ALL STAR athletic shoes:

No, they don't make you run faster, jump higher. They won't help you Be Like Mike. And they'll never inspire gang warfare. But, 300 million pairs later, Converse Chuck Taylor All Stars are going strong. They are members of that definitive cliché, American classics, right up there with '65 Chevy's, Louisville Sluggers and Fig Newtons--the sort of consumer products that inspire nostalgia, devotion and remembrances. (Sole Survivor, New Orleans Time-Picayune, April 14, 1992), and

Cons. Connies. Chucks, High-tops. All Stars. By any name, the Converse Chuck Taylor All Star Basketball Shoe is an American classic--and still a hot seller. (These Shoes Have Legs, Time, April 12, 1992).

<sup>15</sup> Opposer's sales and advertising figures have been made of record under seal. A review of the documents relative thereto shows very large numbers in both categories. In testimony not marked confidential, opposer's witness, Mr. Bell, testified that opposer has sold over 600 million pairs of ALL STAR athletic shoes.

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Applicant, in its brief on the case, argues that marks comprising ALL STAR are weak marks and thus entitled to a limited scope of protection. In support of its position, applicant submitted copies of six third-party registrations for marks which include the term ALL STAR. We note that only two of the registrations cover goods which are of the type involved here, namely, Registration No. 1,583,094 for the mark ALL STAR GOLF CENTERS and design for, inter alia, golf apparel; and Registration No. 1,630,954 for the mark McDONALD'S All STAR RACE TEAM and design, for, inter alia, T-shirts and hats.<sup>16</sup> These two registrations, however, are of limited probative value because the registrations are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed to the existence of similar marks in the market place Richardson-Vicks, Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982). In short, this evidence does not weaken in the least the fame of opposer's ALL STAR mark.

With respect to the goods, we note that the most relevant of opposer's goods are footwear and shirts. Applicant argues that the parties' goods travel in different

<sup>1</sup> The other four registrations are irrelevant because they cover goods or services totally unrelated to the goods involved in this case. For example, one registration is for the mark ALL STAR WRESTLING for the promotion and production of professional wrestling matches and another registration is for the mark ALL STAR SERVICE PLUS and design for franchising vehicle service stations

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channels of trade, i.e., applicant sells its goods at musical trade exhibitions, music concerts, special events, and through street vendors and specialty shops. Further, applicant contends that it does not sell shoes, but footwear such as socks and pantyhose. It is well settled that, in a proceeding such as this, likelihood of confusion must be determined on an analysis of the mark as applied to the goods identified in applicant's application vis-à-vis the marks as applied to the goods identified in opposer's registrations, rather than what the evidence shows the goods to be.

Canadian Imperial Bank of Commerce, N.A. v Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In this case, applicant's application includes footwear, with no limitations as to the nature thereof. Also, the application contains no limitations as to channels of trade. Thus, we must presume that applicant uses its mark on footwear of all types, and sells its footwear and clothing in all of the usual channels of trade, to all the normal classes of customers for these goods. The parties' goods, therefore, are legally identical in terms of footwear and shirts and must be considered to travel in the same channels of trade to the same classes of purchasers.

With respect to the newspaper article relied on by applicant, we again note that it is a single article which appeared in a number of newspapers. The article provides

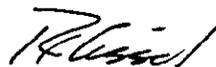
little information about applicant's business activities and merely offers applicant's opinion concerning the merits of this opposition. It is not surprising that applicant does not believe that there is a likelihood of confusion. The article, however, is devoid of any probative value on the issue of likelihood of confusion.

Finally, the lack of evidence of any known instances of actual confusion does not trouble us. Not only is actual confusion difficult to prove, but in the absence of evidence regarding the extent of applicant's use of its mark, we do not know whether there has been any meaningful opportunity for confusion to have occurred in the marketplace.

In view of the foregoing, we conclude that purchasers familiar with opposer's footwear and shirts sold under the ALL STAR marks would be likely to believe, upon encountering applicant's mark RAP ALLSTARS for clothing and footwear, that the goods originated with or were somehow associated with or sponsored by the same entity.

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Decision: The opposition is sustained.



R. F. Cissel



T. J. Quinn



P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board