

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

APRIL 30, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Diplomat Corporation

v.

E-OK, Inc.

Opposition No. 95,370

to application Serial No. 74/159,956

filed on April 23, 1991

Robert L. Epstein of James & Franklin for Diplomat
Corporation.

E-Ok, Inc., pro se.

Before Sams, Simms and Quinn, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Diplomat Corporation (opposer), a New York corporation,
has opposed the application of E-OK, Inc. (applicant), a
Michigan corporation, to register the mark shown below



for clothing, namely, T-shirts and sweatshirts.¹ Opposer asserts in the notice of opposition that opposer and its predecessor have used the mark ECOLOGY KIDS for underwear for infants, diapers and related products including diaper covers, sleeping pants and training pants; that opposer filed an application to register this mark on November 9, 1992; that opposer used the mark ECOLOGY KIDS prior to applicant's filing date and prior to the date of first use claimed in applicant's application; and that applicant's mark so resembles opposer's mark as to be likely to cause confusion, to cause mistake or to deceive. In its answer, applicant has denied the allegations of the opposition.

The record of this case consists of the testimony of opposer's executive vice president (and related exhibits),

¹ Application Serial No. 74/159,956, filed April 23, 1991, claiming use in commerce since April 1990. In the application, applicant has disclaimed the word "KIDS" and the ecology symbol apart from the mark as shown.

and the application file.² The parties have submitted briefs but no oral hearing was requested.³

The testimony of opposer's executive vice president, Mr. Stuart Liederman, establishes that opposer (by its predecessor), located in Stony Point, New York, has been using the mark ECOLOGY KIDS since June or July of 1989. Opposer has used the mark in connection with such products as infants' underwear (layette), pullovers, T-shirts, diapers, training pants, receiving blankets and gowns. Although opposer has not so pleaded, the testimony also reveals that opposer sold ECO SUDS and ECO PRE-WASH detergents and bath products since at least 1991.⁴

Opposer's goods are sold to mass merchandisers, to specialty retailers such as Toys R' Us, to grocery stores, drug stores and to infants' specialty catalogs. Opposer's goods have been sold in 8000-9000 stores. Opposer has advertised its goods in magazines and at trade shows. Opposer has touted its products as being ecological

² On March 14, 1997, the Board struck from the record applicant's evidence, which was in the nature of a declaration with exhibits, because this matter was submitted without opposer's written consent. See Trademark Rule 2.123(b).

³ In its brief, applicant objected to the timeliness of the filing of opposer's testimony. As pointed out by opposer in its reply brief, however, the pertinent rule only requires that opposer's testimony (and exhibits) be "promptly" filed. Accordingly, this objection is not well taken.

⁴ These goods are listed upon opposer's 1990 price list. The mark has been used on infants' underwear since 1991.

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(Leiderman, 17) because they are not disposable paper diapers. Opposer's 1995 sales were around \$8 million.

Opposer argues that the respective marks are similar in meaning, "eco" being an assertedly well-recognized abbreviation of "ecology". Moreover, opposer points to its evidence of use of the word "ECO" (as part of its marks) in connection with some of its accessory products. Opposer argues that its infants' underwear and diaper products are closely related to applicant's T-shirts and sweatshirts and that such goods may travel in the same channels of trade to the same class of purchasers. Opposer also notes that its use precedes applicant's filing date, the earliest date upon which applicant is entitled to rely in the absence of evidence.

Applicant argues, on the other hand, that opposer's mark is a combination of two descriptive nouns and that no exclusive rights should be accorded to these words.

Upon careful consideration of this record and the arguments of the parties, we believe that opposer has shown that confusion is likely. Aside from the fact that applicant did not plead that opposer's mark ECOLOGY KIDS is merely descriptive, raising this defense for the first time in its brief, there is no evidence at all to support applicant's argument. Rather, opposer has shown that it uses these words as a trademark and has done so for

approximately nine years. We also agree with opposer that applicant's mark ECO KIDS and opposer's mark ECOLOGY KIDS are substantially similar in sound, appearance and meaning.⁵ Moreover, applicant's T-shirts and sweatshirts are items of clothing which are closely related to opposer's infants' clothing (and identical to at least one item of opposer's -- T-shirts). These goods may all well be sold in the same retail stores to the same classes of purchasers. Purchasers aware of opposer's ECOLOGY KIDS infants' underwear, diapers and other items, who then encounter applicant's ECO KIDS T-shirts and sweatshirts are likely to believe that those goods emanate from or are otherwise sponsored by or affiliated with the same source.

Decision: The opposition is sustained and registration to applicant is refused.

J. D. Sams

R. L. Simms

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁵ In this regard, we note that the *Random House Unabridged Dictionary* (2d ed. 1993) defines "eco-" as:

a combining form representing **ecology** in the formation of compounds (*ecosystem; ecotype*)...

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