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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE  
TTAB

NOV. 13, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Genesco Inc.

v.

Street Beat Sportswear, Inc.

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Opposition No. 95,686  
to application Serial No. 74/469,169  
filed on December 13, 1993

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Virginia S. Taylor of Kilpatrick & Cody for Genesco Inc.

Stephen L. Baker of Baker & Friedman for Street Beat  
Sportswear, Inc.

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Before Simms, Cissel and Seeherman, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Genesco Inc. has opposed the application of Street Beat  
Sportswear, Inc. to register STREET CODE for "clothing,  
namely: hats, scarfs, blouses, vests, jackets, sweaters,  
t-shirts, tops, dresses, pants, skirts, shirts, bottoms,

hosiery, shoes, slippers, boots."<sup>1</sup> As grounds for opposition, opposer asserts that it has used and owns registrations for the marks STREET HOT and STREET HOT and design for shoes and footwear, and for CODE WEST for jackets and shirts, shoes and boots, and retail store services in the field of apparel and footwear; that since prior to the filing date of applicant's application, opposer has used its marks STREET HOT and CODE WEST in connection with footwear, apparel and related accessories; and that applicant's mark so resembles opposer's marks that, if used on the goods identified in the application, it would be likely to cause confusion, mistake or deception.

In its answer, applicant denied the salient allegations of the notice of opposition, and asserted affirmatively, inter alia, that the individual elements of opposer's mark are widely used and are weak, and that "Opposer admitted the weakness of its alleged mark when it applied to register the same over prior registration [sic] which included the individual elements of Opposer's alleged marks."<sup>2</sup>

Subsequently, the Board granted opposer's uncontested motion to amend the notice of opposition to delete all

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<sup>1</sup> Application Serial No. 74/469,169, filed December 13, 1993, based on an asserted bona fide intent to use the mark in commerce.

<sup>2</sup> Applicant referred to opposer's mark in the singular, despite the fact that opposer pleaded ownership of two different marks. Applicant did not indicate in its answer to which mark it was referring, although the comments made in its brief show that the mark was CODE WEST.

references to the marks STREET HOT and STREET HOT and design, which opposer had sold, and to include an allegation of an additional registration, No. 1,872,558, for CODE WEST for shoes, boots, shirts and jackets, which issued after the original notice of opposition was filed.<sup>3</sup>

The record includes the testimony depositions, with exhibits, of opposer's witness George Andrew Gill.<sup>4</sup> Opposer also made of record, under a notice of reliance, copies of Office records showing that opposer herein opposed an application by a third party for the mark CODE-3S which resulted in the abandonment of that application, and that its opposition to the registration of another party's application for CODE BLEU for footwear was sustained as a result of that party's failure to file an answer to the notice of opposition. Opposer has also submitted, under a

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<sup>3</sup> Because of the way the proceeding transpired, applicant did not file an answer to the amended notice of opposition; rather, the parties and the Board treated the proceeding as though applicant had reiterated its denials, and had denied the allegation with respect to Registration No. 1,872,558.

<sup>4</sup> In its brief applicant has objected to Mr. Gill's testimony as being incompetent to prove the advertising and sales figures which he provided. This objection is not well taken. Mr. Gill's testimony included the statements that he is familiar with the history of the CODE WEST trademark, and that his testimony was based on personal knowledge and upon his familiarity with the books and records of opposer, which are maintained under his supervision. Such statements adequately establish Mr. Gill's competence to testify. Moreover, it is noted that applicant did not attend Mr. Gill's testimony deposition, and therefore did not raise any objections about his testimony at a point where any perceived infirmities could be cured. If a ground for objection might have been obviated or removed if presented during the deposition, and the objection is not timely raised, it will be

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notice of reliance, status and title copies of opposer's four pleaded registrations for CODE WEST for sportswear, namely, jackets and shirts;<sup>5</sup> for shoes and boots;<sup>6</sup> for retail store services in the field of apparel and footwear;<sup>7</sup> and for CODE WEST, in the design form shown below, for footwear and clothing; namely, shoes, boots, shirts and jackets.<sup>8</sup>

Applicant has submitted, under notice of reliance, copies of applications and registrations for marks which contain the word CODE or WEST; a copy of the cover and title page of the Zane Grey novel, Code of the West; articles taken from newspapers and magazines which use the phrases "code of the West" or "street code"; and what applicant describes as "articles" published on the Internet which include the word(s) "code," "street code" and "code of the

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deemed to be waived. See TBMP § 718.03(c) and cases cited therein.

<sup>5</sup> Registration No. 1,654,968, issued August 27, 1991. We take judicial notice of the Office records, which show that a Section 8 affidavit was accepted for this registration subsequent to the date the status and title copy was made of record. See TBMP § 703.02(a) and cases cited therein.

<sup>6</sup> Registration No. 1,495,199, issued July 5, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

<sup>7</sup> Registration No. 1,769,020, issued May 4, 1993.

<sup>8</sup> Registration No. 1,872,558, issued January 10, 1995.

west" as well as "articles" from the Internet about Zane Grey.<sup>9</sup>

The parties have fully briefed the case, and both were represented at an oral hearing before this Board.

The record shows that opposer sells, inter alia, boots, shoes and other clothing items under the mark CODE WEST, and also operates, under the stylized CODE WEST mark shown above, retail stores featuring boots. Opposer started marketing its CODE WEST products in 1987, and sells its footwear in all 50 states, and in virtually all trade channels for shoes and boots in the United States. These include upper-end department stores like Nordstrom's, chain stores like Sears and Kenney's, independent shoe stores, mom-and-pop stores, farm stores, western chains like Boot Town, and discount retailers. Opposer's CODE WEST footwear is also sold through catalogs.

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<sup>9</sup> Although applicant has referred to the Internet materials as articles, as far as can be ascertained from the submissions, they are available only on the Internet, and there is no identification of a permanent source for the materials. Accordingly, they cannot be considered as printed publications, which may be made of record under a notice of reliance in accordance with Trademark Rule 2.122(e). See **Racioppi v. Apogee Inc.**, 47 USPQ2d 1368 (TTAB 1998). However, materials improperly offered under Rules 2.122(e) may nevertheless be considered by the Board if the adverse party does not object thereto. See TBMP § 708, and cases cited therein. Because opposer never raised an objection to the Internet materials, and indeed has treated the materials as of record (although in terms of stating that applicant's reliance on them is "bizarre", reply brief, p. 7), the Board has considered them.

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Since 1987 its annual sales of CODE WEST boots and shoes at wholesale have ranged from \$4 million in 1989 to a high of \$27.2 million in 1993. Retail sales would be approximately double those numbers. Over 13 million pairs of CODE WEST boots were sold between 1987 and the taking of opposer's witness's deposition in June 1996.

Opposer has advertised its CODE WEST products in catalogs and print advertising, including in such magazines as "Esquire," "Elle" and "Vogue," and has exhibited its footwear and apparel at trade shows. Annual advertising costs from 1989 to 1993 were in the \$1 million to \$2 million range, although these expenditures dropped to \$330,000 in 1994 and \$90,000 in 1995. The products have also been advertised directly by retailers in newspapers, on television and radio, and through direct mail and billboards.

Applicant has not furnished any evidence regarding its business or activities under the mark, which we note has been applied for under the provisions of Section 1(b) of the Act.

Priority is not in issue in view of opposer's registrations, which have been made of record. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer has used its CODE WEST mark on at least boots since

prior to December 13, 1993, the filing date of applicant's intent-to-use application and the earliest date on which it is entitled to rely.

Turning to the issue of likelihood of confusion, there is no question that the jackets, t-shirts, tops, shoes and boots identified in applicant's application must be deemed to be legally identical to the jackets, shirts, shoes and boots identified in opposer's registrations. Similarly, these goods must be deemed to travel in the same channels of trade, and to be sold to the same consumers. These duPont factors clearly favor opposer. **E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We recognize that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). However, in this case the marks are sufficiently different that we find confusion is not likely to occur.

While both marks include the word CODE, when they are considered in their entirety, they are very different in appearance, pronunciation and connotation. The order in which CODE appears in the marks is reversed, with STREET having a prominent place in applicant's mark because it appears and is pronounced first. We cannot agree with

opposer's assertion that CODE is the dominant part of both marks because a trade magazine referred to a footwear fashion as "street fashions." Further, although the word WEST, particularly when used in a mark for boots, suggests western fashions, we do not believe that CODE is the dominant part of opposer's marks. Rather, the marks CODE WEST and STREET CODE must both be regarded as unitary marks, in which each resultant phrase has a meaning different from that of the individual words.<sup>10</sup>

With respect to the meanings of the marks, both opposer and applicant agree that opposer's mark, CODE WEST, would be seen as referring to the "Code of the West." This phrase, as shown by the newspaper articles and Internet materials submitted by applicant, refers to a code of conduct taken from the Old West of the cowboy era, and encompasses such values as honesty, respect for women, defending the defenseless, and "a man's word is his bond." "Street Code," on the other hand, connotes the philosophy of today's inner cities, an ethos of gangs and those who live on the streets. Principles of "street code," as reported in the articles and Internet materials submitted by applicant, include "You tell on someone, you die"; witnesses do not talk to police; and one does not murder children or officers of the court.

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<sup>10</sup> For the same reason, we reject applicant's argument that the word CODE "must be given little consideration in determining the

Opposer argues that applicant's mark has a parallel meaning to opposer's, with opposer's referring to the "Code of the West" and applicant's to "Code of the Street." Although there may be a superficial similarity in that both marks refer loosely to unwritten rules, the two philosophies are themselves so different that we do not believe that consumers would associate them with the same source. CODE WEST represents a philosophy that is generally admired and respected; it is a compliment to say that one lives by the "Code of the West." STREET CODE, on the other hand, is associated with negative characteristics; one article describes it as a culture which is oppositional to that of decent family middle-class values. Because of the negative connotations of STREET CODE, it is unlikely that consumers would see clothing and footwear sold under this mark as a line extension of opposer's CODE WEST boots, shoes, jackets and t-shirts.

In reaching this decision we have rejected opposer's argument that its mark is famous. Although opposer has submitted evidence of its sales and advertising, it has not put those sales and advertising figures in context, such as by showing its market share. Raw sales and advertising figures, unless they are extraordinarily large, which is not the case with opposer's products, are not sufficient by

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issue of confusing similarity/likelihood of confusion." Brief,

themselves to establish that a mark is famous. See **Fossil, Inc. v. The Fossil Group**, \_\_USPQ2d\_\_, Op. 98,191 (TTAB Oct. 30, 1998); **General Mills Inc. v. Health Valley Foods**, 24 USPQ2d 1270, 1277 (TTAB 1992). We also note that, while opposer's sales and advertising figures had increased from 1989 through 1993, in 1994 its sales dropped from over \$27 million to \$12.4 million and in 1995 to \$8.6 million, the latter figure representing sales of only 156,650 pairs of boots. Its advertising expenditures similarly dropped from \$1.9 million in 1993 to \$330,000 in 1994 and \$90,000 in 1995.

Thus, although we acknowledge that in certain cases the fame of a mark can play a dominant role in determining the issue of likelihood of confusion, it does not play such a role in the present situation.

Although we have not found opposer's mark to be famous, we cannot agree with applicant's argument that "the designation 'code' has been adopted by so many third parties for clothing that Opposer's alleged mark is entitled to only a very narrow scope of protection." Brief, p. 26.

Applicant bases this argument on the various third-party registrations and applications which it has made of record. However, as opposer has correctly pointed out, third-party registrations are not evidence of use of the marks shown

therein or that the public is familiar with them. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Third-party registrations may, of course, be used to show that a portion of a mark has a meaning, and as a result that the inclusion of the particular term in both an opposer's and applicant's mark may be an insufficient basis on which to find a likelihood of confusion. **Cutter Laboratories, Inc. v. Air Products and Chemicals, Inc.**, 189 USPQ 108 (TTAB 1975). However, in this case, although applicant has made numerous third-party registrations of record, the meanings conveyed by the word CODE in these marks differ. For example, there are registrations for AREA CODE 212, ZIP CODE, SECRET CODE, D-CODE and PRODUCT CODE 31. The only registrations in which CODE appears to refer to a philosophy or ethic are FOR THOSE WHO LIVE BY A CODE, BUSINESS CODE, CITY CODE, and perhaps CODE per se.

In summary, although opposer's mark CODE WEST must be considered a distinctive and strong mark for boots, this does not mean that opposer is entitled to prevent the registration of any marks which contain the word CODE. Here, when we consider the marks in their entireties, because of the differences in appearance, pronunciation, connotation and commercial impression between CODE WEST and STREET CODE, we find that confusion is not likely, even when the respective marks are both used on boots and shoes.

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Decision: The opposition is dismissed.

R. L. Simms

R. F. Cissel

E. J. Seeherman  
Administrative Trademark Judges  
Trademark Trial and Appeal Board