

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 28, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Tony Marterie & Associates dba North Coast Industries
v.
Blast Eyewear, Inc.¹

Cancellation No. 23,852

Robert B. Chickering of Flehr Hohbach Test Albritton &
Herbert LLP for Tony Marterie & Associates dba North Coast
Industries.

Blast Eyewear, Inc., pro se.

Before Cissel, Seeherman and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

This cancellation proceeding involves respondent's
Registration No. 1,590,583, which is of the mark BLAST (in
typed form).² As of the commencement of this proceeding,

¹ Substituted for W.R. Pearson dba Blast Eyewear, Inc., pursuant
to assignment recorded September 24, 1999 at Reel 1963, Frame
0653.

² The registration issued on April 10, 1990, under Trademark Act
Section 44(e). It arose from application Serial No. 73/612,859,
filed August 4, 1986, in which a Section 44(d) priority claim was

Cancellation No. 23,852

the registration identified the following goods and services: "sunglasses, radios, audio tape players, videotape players, electric cigarette lighters" in Class 9; "watches" in Class 14; "pens, pencils, paper party decorations" in Class 16; "non-toy coin banks" in Class 20; "paper face masks, toy coin banks" in Class 28; "ashtrays, non-electric cigarette lighters" in Class 34; and "retail store services specializing in sunglasses, audio equipment, smokers' accessories, pens, coin banks and novelty items such as party decorations and face masks" in Class 42.

On March 17, 1995, petitioner filed a petition to cancel the registration in its entirety, asserting as grounds therefor that respondent has abandoned the registered mark due to non-use, and that the registered mark, as applied to the goods and services identified in the registration, is likely to cause confusion vis-à-vis petitioner's previously-used and registered family of BLAST marks for clothing. On April 10, 1996, after commencement of this proceeding and service of notice thereof on respondent, respondent filed a Section 8 affidavit in the Post-Registration Section of this Office by which it asserted that the mark remained in use only on "sunglasses" in Class 9 and "retail store services specializing in sunglasses" in Class 42. On May 11, 1998, the registration

asserted based on a Canadian application filed on February 4,

Cancellation No. 23,852

was cancelled under Section 8 as to all of the other goods and services identified in the registration.

On September 14, 1999, the Board issued an order allowing respondent time to show cause why judgment should not be entered against it under Trademark Rule 2.134 as to the cancelled goods and services. Respondent did not respond to the Board's show cause order. In view thereof, judgment is hereby entered against respondent on petitioner's abandonment and Section 2(d) grounds for cancellation, as to all of the goods and services which were identified in the registration as of the commencement of this proceeding, listed above, except for "sunglasses" in Class 9 and "retail store services specializing in sunglasses" in Class 42. See Trademark Rule 2.134.

Thus, the only matters remaining for decision in this case are petitioner's pleaded abandonment and Section 2(d) grounds for cancellation as they apply to the goods and services remaining in the registration, i.e., "sunglasses" in Class 9 and "retail store services specializing in sunglasses" in Class 42. The record before us consists of the file of the involved registration, the pleadings, the testimony deposition of petitioner's president, Tony Marterie, and exhibits attached thereto, and respondent's notice of reliance on petitioner's answers to certain of

respondent's interrogatories. Petitioner filed a brief on the case, but respondent filed no brief. No oral hearing was requested.

We turn first to the issue of abandonment. The burden of proof is on the petitioner to establish abandonment by a preponderance of the evidence. *See Cervecería Centroamericana S.A. v. Cervecería India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). Under the Lanham Act, a federally registered trademark is considered abandoned if its "use has been discontinued with intent not to resume." Trademark Act Section 45, 15 U.S.C. §1127. Under the law in effect when this proceeding was commenced in 1995, proof of nonuse of the mark in the United States for two consecutive years was sufficient to establish a prima facie case of abandonment.³ *See Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998).

Petitioner, upon whom the burden of proof rests, failed to present any evidence in support of its pleaded allegations of respondent's nonuse of the registered mark in commerce on or in connection with sunglasses and retail store services specializing in sunglasses. In view thereof, and in view of respondent's denial, in its answer, of

³ Section 45 of the Trademark Act was amended, effective January 1, 1996, to extend the minimum period of nonuse necessary to establish a prima facie case of abandonment to three consecutive years. *See Uruguay Round Agreements Act*, Pub. L. No. 103-465, §521, 108 Stat. 4809, 4981-82 (1994).

Cancellation No. 23,852

petitioner's allegations of nonuse as to those goods and services, we find that petitioner has failed to make out a prima facie case of abandonment. Accordingly, we dismiss the petition to cancel insofar as it seeks cancellation, on the ground of abandonment, of respondent's registration for "sunglasses" in Class 9 and "retail store services specializing in sunglasses" in Class 42.

We turn next to petitioner's Section 2(d) ground for cancellation. Petitioner alleges in the petition to cancel that, since prior to the earliest date upon which respondent might rely for priority purposes, petitioner has used the trademark BLAST for various items of wearing apparel; that petitioner has used and is the owner of a family of trademarks for wearing apparel using the formative BLAST, and is the owner of several federal trademark registrations for members of its BLAST family of marks⁴; and that

⁴ Petitioner pleaded ownership of the following registrations:

Registration No. 1,613,960, issued September 18, 1990, of the mark BLAST for "women's wearing apparel, namely, tops, pants and skirts";

Registration No. 1,613,961, issued September 18, 1990, of the mark BLASTMAN for "women's wearing apparel, namely, tops, pants, skirts, jackets, dresses and shorts";

Registration No. 1,618,860, issued October 23, 1990, of the mark BLAST FOR MEN and design, for "men's clothing, namely pullover tops, shirts and pants";

Registration No. 1,651,190, issued July 16, 1991, of the mark BLAST POINT for "wearing apparel, namely, tops, pants, skirts, jackets, dresses and shorts";

Cancellation No. 23,852

respondent's registered mark BLAST, as applied to the goods and services identified in the registration, so resembles petitioner's BLAST mark as to be likely to cause confusion, to cause mistake, or to deceive. Respondent, in its answer, denied the essential allegations of petitioner's Section 2(d) ground for cancellation.

The evidence of record establishes petitioner's priority. On this record, the earliest date upon which respondent can rely for priority purposes is February 4, 1986, the filing date of the Canadian application which served as the basis of respondent's §44(d) priority claim in

Registration No. 1,853,164, issued September 6, 1994, of the mark BLAST BLUES for "men's women's and children's wearing apparel, namely, pants, shorts, jackets, tops, suits, jumpers, skirts, jogging suits, overalls, coveralls, scarves, gloves, sweaters, hats, jerseys, t-shirts, sweatshirts, belts, vests and footwear";

Registration No. 1,543,619, issued June 13, 1989, of the mark BLAST OFF and design for "children's clothing, namely, pants, shirts, sweaters, jackets, suits, jumpers, shorts, skirts, jog suits, overalls, and coveralls."

Petitioner introduced status and title copies, dated November 22, 1996, of these registrations as exhibits to the December 3, 1996 testimony deposition of its president, Tony Marterie. Each of the registrations was certified to be in full force and effect. However, the Board's recent review of the Office's automated records reveals that Registration No. 1,613,961 (BLASTMAN) was cancelled under Section 8 on March 24, 1997, and that Registration No. 1,543,619 (BLAST OFF and design) was cancelled under Section 8 on December 18, 1995. (It is unclear why the November 22, 1996 status and title copy of Registration No. 1,543,619 erroneously states that the registration was in full force and effect as of that date.) The Office's records reveal that the other pleaded registrations made of record by petitioner remain extant and are owned by petitioner.

Cancellation No. 23,852

the application which matured into respondent's involved registration. According to the uncontroverted deposition testimony of petitioner's president, Mr. Marterie, petitioner has used its BLAST mark on clothing since August 1985. Accordingly, we find that priority rests with petitioner in this case.

With respect to likelihood of confusion, our determination is based on an analysis of all of the probative 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We shall analyze petitioner's likelihood of confusion claim first with respect to respondent's goods, i.e., "sunglasses," and then with respect to respondent's services, i.e., "retail store services specializing in sunglasses."

We find that respondent's mark BLAST is identical to petitioner's primary mark BLAST.⁵ Moreover, we find that

⁵ We reject petitioner's contention that it owns a "family" of BLAST marks. There is no evidence showing that petitioner has used and promoted its marks in the manner of a family of marks. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460,

Cancellation No. 23,852

petitioner's BLAST mark is a strong mark. That is, BLAST is an arbitrary term as applied to petitioner's goods, and there is no evidence of any third-party use of marks which consist or are comprised of the word BLAST, either for the goods and services involved in this case or for any other goods and services.

The relative strength of petitioner's mark is further established by petitioner's evidence of its extensive use and promotion of the mark. See *Pasco, Inc. v. Diamond Shamrock Corporation*, 191 USPQ 59 (TTAB 1976). In view of the parties' confidentiality agreement and the stipulated protective order of record in this case, we will not mention petitioner's specific sales and advertising figures in this opinion, but we can state that petitioner's gross sales, in terms of unit and dollar volumes, are substantial. Petitioner's clothing products are sold in over 2,000 stores throughout the United States, including specialty retail shops and leading department stores such as Nordstrom, Macy's, Hecht's, Marshall Fields, J.C. Penney and Dayton Hudson. Petitioner distributes substantial amounts of its own advertising materials directly to retailers and to retail customers, and also advertises its products in the department stores' own widely-distributed catalogs. Retail

18 USPQ2d 1889 (Fed. Cir. 1991); *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457 (TTAB 1978).

stores do in-store advertising of petitioner's BLAST clothing products, such as placing signage bearing petitioner's mark on the racks bearing petitioner's clothes, and they also feature petitioner's products in their own newspaper advertisements.

We turn next to the question of the similarity of the parties' respective goods and services. Because the parties' marks are identical, there need be only a viable relationship between their respective goods and services in order to find that a likelihood of confusion exists. *See In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). Moreover, because petitioner's BLAST mark is a strong mark, as discussed above, it is entitled to a relatively broad scope of protection. *See Pasco, Inc. v. Diamond Shamrock Corporation, supra; Baker Industries, Inc. v. Bowers*, 191 USPQ 260 (TTAB 1976); *Andrea Radio Corporation v. Premium Import Co., Inc.*, 191 USPQ 232 (TTAB 1976).

We find that "sunglasses," the goods identified in respondent's involved registration, are sufficiently related to petitioner's clothing products that confusion is likely to result if they are sold under the identical, strong and arbitrary mark BLAST. That is, we find that sunglasses and clothing, particularly sportswear items like petitioner's, are complementary products. It appears from petitioner's

president's uncontroverted testimony that clothing manufacturers commonly market numerous accessory items, including sunglasses, under the same marks that they use for their clothing products; that this is true not only for designer name marks like Calvin Klein and Donna Karan, but also for non-designer name marks such as Esprit and Nike; that customers are accustomed to seeing sunglasses and clothing items advertised and sold under the same mark in the same department stores; and that every department store which carries petitioner's clothing products also carries eyewear or sunglasses.

Additionally, because the identification of goods in respondent's registration does not limit the trade channels and classes of customers for respondent's sunglasses, we must presume that the sunglasses are marketed in all normal trade channels and to all normal classes of customers for such products. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The evidence of record establishes that the normal trade channels for sunglasses include department stores such as those in which petitioner's clothing products are sold.

Respondent has made of record petitioner's interrogatory answer by which petitioner admits that it is unaware of any instances of actual confusion. We have not accorded the apparent absence of actual confusion significant weight in our likelihood of confusion analysis

Cancellation No. 23,852

in this case, in view of the fact that there is no evidence as to the extent of respondent's use of its mark on sunglasses and thus no evidence as to whether there has been a significant opportunity for actual confusion to have occurred. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Accordingly, although we have considered this evidence, we find that the absence of actual confusion is not sufficient, in this case, to outweigh the other evidence of record which supports a finding of likelihood of confusion.

For the reasons discussed above, we find that respondent's use of BLAST as a mark for sunglasses is likely to cause confusion vis-à-vis petitioner's clothing products sold under the identical mark. In view thereof, and in view of petitioner's priority, we find that petitioner has established its Section 2(d) ground for cancellation of respondent's registration with respect to Class 9 "sunglasses."

We also find that petitioner is entitled to prevail on its Section 2(d) ground for cancellation of respondent's registration with respect to Class 42 "retail store services specializing in sunglasses." As discussed above, petitioner's BLAST mark is a strong and arbitrary mark which is entitled to a broad scope of protection, given petitioner's widespread use and promotion of the mark and

Cancellation No. 23,852

the absence of any evidence of third-party use of similar marks on similar goods or services. *Pasco, Inc. v. Diamond Shamrock Corporation, supra*. Respondent's mark is identical to this strong and arbitrary mark of petitioner's, a factor which weighs heavily against respondent in our likelihood of confusion analysis. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In these circumstances, it is not dispositive that petitioner's goods and respondent's services are not the same. Because the parties' marks are identical, there need be only a viable relationship between their respective goods and services in order to support a finding of likelihood of confusion. *In re Concordia Forwarding Corp. supra*. We find that the requisite relationship exists in this case. The evidence of record establishes the existence of a close, complementary relationship between sunglasses and clothing items such as petitioner's. In view of that relationship, it is likely that purchasers familiar with clothing sold under petitioner's strong and arbitrary mark BLAST, upon encountering BLAST retail stores specializing in sunglasses, would be likely to mistakenly assume that a source, sponsorship or other connection exists.

Indeed, to find for respondent on this issue, we essentially would have to conclude that the degree of

dissimilarity between petitioner's goods and respondent's services is so great as to outweigh all of the other evidence of record, such as the identity of the marks and the strength of petitioner's mark, which supports a finding of likelihood of confusion in this case. See, e.g., *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). We cannot so conclude. Rather, after carefully considering all of the evidence of record pertaining to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists as between petitioner's BLAST clothing products and respondent's BLAST retail store services specializing in sunglasses.⁶ In view thereof, and in view of petitioner's priority, we find that petitioner has established its Section 2(d) ground for cancellation of respondent's registration with respect to Class 42 "retail store services specializing in sunglasses."

In summary, as to all of the goods and services identified in the registration as of the commencement of this proceeding except for "sunglasses" in Class 9 and "retail store services specializing in sunglasses" in Class

⁶ As was the case with respect to respondent's sunglasses, see *supra* at pp. 10-11, we have accorded no significant weight in our likelihood of confusion analysis to the apparent absence of any instances of actual confusion between petitioner's goods and respondent's services. There is no evidence as to the extent of respondent's use of its mark in connection with such services, and thus there is no basis for concluding that any meaningful opportunity for actual confusion has existed. See *Gillette Canada Inc. v. Ranir Corp.*, *supra*.

Cancellation No. 23,852

42, judgment is hereby entered against respondent pursuant to Trademark Rule 2.134. As to "sunglasses" in Class 9 and "retail store services specializing in sunglasses" in Class 42, the petition to cancel is dismissed with respect to petitioner's abandonment ground, but is granted with respect to petitioner's Section 2(d) ground.

Decision: The petition to cancel is granted.

R. F. Cissel

E. J. Seeherman

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board