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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Meramec Group, Inc.**

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Serial No. 75/095,782

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**Paul M. Denk, Esq.** for **Meramec Group, Inc.**

**Elizabeth A. Dunn**, Trademark Examining Attorney, Law Office 109  
(**Ron Sussman**, Managing Attorney).

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Before Hohein, Wendel and Bucher, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

An application has been filed by **Meramec Group, Inc.** to register the mark EXCEL for "urethane structural shoe components marketed to footwear manufacturers".<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

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<sup>1</sup> Ser. No. 75/095,782, filed on April 29, 1996, which alleges dates of first use of August 1992.

applicant's mark, when applied to its goods, so resembles the mark EXCEL, which is registered for "shoes,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

The marks of applicant and registrant are obviously identical. Moreover, as pointed out by the Examining Attorney, since both marks have been presented in typed drawings, applicant could display its mark in the same format as that used by registrant. See *Squirto Co. v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

Turning to the respective goods, the Examining Attorney argues that shoes and urethane structural shoe components marketed to footwear manufacturers are closely related goods. As shown by copies of certain third-party registrations, several footwear manufacturers have registered the same mark for shoes and components of shoes, (e.g., leather, straps, uppers, heels, soles and cushioning materials). Other footwear manufacturers own registrations for marks for a wide variety of individual footwear components, including fabrics, insoles, outsoles, toepieces, heels and soles. The Examining Attorney contends, in view thereof, that:

None of the registrations in the record are limited to components used in the registrant's own footwear. The same footwear manufacturers who purchase the applicant's shoe components may purchase the shoe

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<sup>2</sup> Reg. No. 1,255,371, issued on October 25, 1983, which sets forth dates of first use of September 1979; combined affidavit §§8 and 15.

components of other shoe manufacturers. Thus, the footwear manufacturer who is familiar with the EXCEL footwear competitor and then encounters EXCEL footwear components is likely to believe the footwear and the components emanate from a single source.

The Examining Attorney also points out that the record contains evidence which "shows that shoe purchasers look for shoe components when purchasing shoes." Specifically, the Examining Attorney refers to excerpts from an article in the March 17, 1997 issue of the trade publication Footwear News, headlined "The right stuff: hot components can do wonders for shoe sales," which states, in relevant part, that:

Vibram, Thinsulate and Gore-Tex -- hot brands in the components arena -- are what educated shoppers are asking for these days when it comes to lifestyle as well as performance-driven products. These names have become so integral a part of the footwear market, say industry sources, that they can sometimes overshadow the brand name of a shoe or boot.

So powerful are these components that even unknown footwear brands can often bank on them ....

"If you're in the waterproof business, Gore-Tex is the buzz word," said Peter Hillier, general manager of Chippewa Boot ....

Not leaving anything to chance, Chippewa makes use of hangtags. "I put as many as I can on," boasted Hillier, about the number a particular item can carry. "I want the Encyclopedia Brittanica on my boot. Customers may not read it all, but otherwise it's a Kmart boot."

Since a portion of Lewiston, Maine,- based Dunham Bootmakers' line can feature anywhere from four to six name-brand components, the company has developed a hangtag of its own, which it uses in place of

those supplied by component producers. ....  
The tag explains the benefits of each  
component and serves as an educational tool  
for both consumers and sales associates.

The Examining Attorney maintains, in view thereof, that  
"while the applicant's shoe components may be marketed directly  
to footwear manufacturers, those manufacturers may market the  
shoes to consumers using the trademarked EXCEL component." In  
consequence thereof, the Examining Attorney insists that "[s]hoe  
purchasers familiar with EXCEL shoes who then encounter shoes  
advertising EXCEL shoe components are likely to believe [that]  
the goods ... originate from the same source."

Applicant, on the other hand, contends that the exclusive  
channels of trade for its urethane structural shoe components,  
and hence the only persons who will purchase its goods or  
otherwise encounter its mark, are manufacturers of footwear:

The applicant markets its shoe components ...  
to footwear manufacturers, ... sells these  
components in bulk, and applies a hang tag to  
the packaging, containing a plurality of the  
[applicant's] out soles, with the hang tag  
showing the word EXCEL, upon its label.

The mark is not used upon the shoe components  
themselves, nor upon the out soles as  
marketed.

Applicant argues that the Examining Attorney's assumption  
that customers of the retail shoes may see the footwear  
components of applicant, bearing its trademark, is without  
support and that there is no indication that applicant licenses  
the use of its mark to the footwear manufacturers to which it  
exclusively sells its goods.

Applicant has made of record an affidavit from its president, Thomas H. Dieckhaus, who besides confirming the above facts, avers among other things that:

The product[s] marketed by my Company, under the trademark EXCEL, are merely footwear components, for incorporating into originally manufactured shoes. These urethane structural shoe components ... are blended into the originally manufactured footwear. We sell this product to footwear manufacturers. These components are not sold individually on the retail market. Hence, the channels of trade for the marketing of our urethane footwear components are completely different and distinct from [sic] a footwear manufacturer that eventually ships its goods into the retail trade. Hence we do not use our trademark in the retail market place.

Mr. Dieckhaus also states that since beginning the production of EXCEL outsoles in 1987, and through sales of over a million pairs of outsoles, applicant has never encountered any instances of actual confusion of its goods and shoes marketed under the EXCEL mark.

Thus, while applicant concedes that its products are sold for incorporation "into originally manufactured shoes," it maintains that the channels of trade for its goods are separate and distinct from those for registrant's goods and are likely to remain so, thereby making confusion as to origin or affiliation among resellers of footwear and/or their customers unlikely.

In the first place, the Examining Attorney has shown, by means of third-party registrations, that a number of companies market both footwear and footwear components under the same mark. Thus, we find it entirely reasonable for purchasers such as

footwear manufacturers, upon seeing the identical mark EXCEL used for both footwear and footwear components, to assume a common origin for the goods. See *In re Kabushiki Kaisha Hattori Seiko v. Satellite International Ltd.*, 29 USPQ2d 1317, 1319 (TTAB 1991); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). Applicant argues that it is unaware of actual confusion over the years of coexistence of the marks in the trade. Since, however, in this ex parte proceeding, we are obviously without the benefit of registrant's input, we can give little probative value to applicant's claim of an absence of actual confusion. See *In re Whittaker Corp.*, 200 USPQ 54 (TTAB 1978). Moreover, the test under Section 2(d) is the likelihood of confusion, not the more stringent test of actual confusion.

But even more significantly, the Examining Attorney has made of record evidence of the recent trend in the footwear trade for the separate promotion and advertising to the general purchasing public of the components included in the final footwear product. We find the article submitted by the Examining Attorney highly convincing with respect to the promotion of particular components under their own brand names and the advertisement of the components in the sale of the finished branded products. Thus, while applicant may argue that its outsoles are sold only to footwear manufacturers and do not bear the EXCEL mark, except on a hangtag to the packaging of a plurality of the components, this does not eliminate the likelihood that the ultimate purchasers of footwear containing EXCEL outsoles will come in contact with applicant's mark. There is no restriction in the identification

of goods that applicant will never affix the EXCEL mark directly to its outsoles. Even more importantly, there are no restrictions on applicant's licensing footwear manufacturers in the future to advertise the fact that EXCEL outsoles are a component of the footwear, in keeping with the recent marketing trend demonstrated by the Examining Attorney. Accordingly, we find sufficient evidence to conclude that the ultimate purchasers of footwear may well encounter the EXCEL marks of both registrant and applicant, and, as a result, are likely to be confused as to the source of the goods. Cf. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) [no evidence of record that the ultimate purchasers of registrant's leather goods including luggage, sports bags, attache cases, briefcases and handbags bearing the mark PHOENIX would be likely to encounter applicant's PHOENIX mark, when used in connection with leather sold in bulk, as would make confusion much more likely].

To the extent that any doubt may have been raised by the dissent, the Board follows the well-established principle that any doubts regarding the likelihood of confusion must be resolved against applicant, as the newcomer in the field. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusal under Section 2(d) is affirmed.

H. R. Wendel

**Ser. No.** 75/095,782

D. E. Bucher  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board