

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 16, 00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Simple Shoes, Inc.

v.

Marc Wear

Opposition No. 106,061
to application Serial No. 75/031,201
filed on December 11, 1995

Paul G. Juettner of Juettner, Pyle, Piontek & Underwood for
Simple Shoes, Inc.

Robert A. Weikert of Thelen, Reid & Priest LLP for Marc
Wear.

Before Simms, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Simple Shoes, Inc. (opposer), a California corporation,
has opposed the application of Marc Wear (applicant), a
California corporation, to register the mark SIMPLE LIFE for
the following goods: men's, women's and children's
sportswear, namely, T-shirts, tank tops, shirts, sport
shirts, sweatshirts, blouses, sweaters, pullovers, jackets,
hooded sweat jackets, vests, pants, sweat pants, leggings,

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stirrup pants, shorts, sweat shorts, dresses, skirts, rompers, jumpers and jumpsuits.¹ In the notice of opposition, opposer asserts use of the mark SIMPLE, by itself and a predecessor, in connection with footwear and T-shirts since December 1991 and use in commerce since March 13, 1992. Opposer also pleads ownership of Registration No. 1,805,363, issued November 16, 1993, covering this mark for men's, women's and children's casual and athletic shoes and T-shirts. Finally, opposer asserts that applicant's mark SIMPLE LIFE as proposed to be used in connection with applicant's goods so resembles opposer's previously used and registered mark SIMPLE, as to be likely to cause confusion, to cause mistake or to deceive.

In its answer, applicant has denied the essential allegations of the notice of opposition, except that it admits that no use has been made of its applied-for mark. As "affirmative defenses," applicant asserts that SIMPLE is commonly used in the clothing and footwear fields, that it cannot be distinctive of these goods, that opposer's rights are limited, and that opposer lacks standing. Applicant has also asserted that opposer has abandoned any right it may have had in the pleaded mark.² Applicant also alleged that

¹ Application Serial No. 75/031,201, filed December 11, 1995, based upon applicant's bona fide intention to use the mark in commerce.

² However, applicant has asserted no counterclaim to cancel opposer's pleaded registration. Because applicant's assertion of

this opposition is barred by laches, acquiescence, estoppel and unclean hands.

Summary of the Record and Procedural Rulings

The record of this case consists of testimony (and exhibits) submitted by opposer, and notices of reliance filed by both parties. Opposer's notice of reliance makes of record opposer's pleaded registration as well as applications it has filed to register the mark SIMPLE for bags and for watches as well as an application to register SIMPLEGIRL for shoes and shirts.³ Opposer also relies upon applicant's discovery responses to opposer's interrogatories.

Applicant's notice of reliance, by which applicant seeks to introduce various materials, is the subject of a motion to strike. Essentially, opposer contends that many of these materials may not be submitted by notice alone.

First, applicant has sought to rely upon various catalogues available in electronic form on the Internet. While applicant argues that numerous public libraries have free Internet access and that these catalogues are the electronic equivalent of printed publications, we agree with

abandonment must be accompanied by a counterclaim to cancel, this so-called affirmative defense cannot be entertained.

³ Opposer neither pleaded these applications in the notice of opposition nor claimed use of the mark SIMPLEGIRL. Nonetheless, these were the subject of trial testimony.

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opposer that the printout of Internet Web pages is not a printed publication within the meaning of Trademark Rule 2.122(e). See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999). *Cf.* *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998) (holding that, in view of the transitory nature of Internet postings, a declaration is necessary to permit these kinds of materials to be considered on summary judgment) and TBMP Section 708. Applicant's attempt to submit a declaration of its attorney in response to opposer's motion to strike is ineffective. An affidavit or declaration, in the absence of a stipulation, is not an appropriate way to introduce any evidence at trial. See Trademark Rule 2.123(b). This kind of material may be introduced by way of the testimony of the person who performed the Internet search and printed out the documents. No such testimony is of record in this case.

Second, opposer's motion to strike third-party packaging and receipts, which are not admissible by notice of reliance, is also well taken. These exhibits must be authenticated by the testimony of the person or persons who purchased those goods, testimony subject to cross-examination by opposer.

Third, opposer's objections to applicant's attempt to rely upon files obtained from Thompson & Thompson and from the Lexis computer search system of various registrations

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and applications are well taken. These are not considered copies of official records made by this Office.

Finally, the Dunn & Bradstreet report attempted to be relied upon by applicant is not a printed publication or an official record of this Office. Moreover, this report is not adequate to show use of any mark listed therein.

Tiffany & Co. v. Classic Motor Carriages Inc., 10 USPQ2d 1835, 1839 at n. 5 (TTAB 1989) ["the probative value of such reports is limited, since the reports do not indicate the extent to which a company's name is used or what opportunity the public has had to become aware of any use."].

Accordingly, exhibits 1d-i, k, m-q, r-v and 2a-e are stricken. Opposer's discovery responses, also submitted by applicant's notice of reliance, are considered of record.

Opposer's Record

With respect to the origin of opposer's trademark, Mr. Eric Meyer, opposer's founder and president, testified, at 11-12:

Q. Why did you decide to call it Simple Shoes?

A. Well, as I walk into a shoe store in 1991, I look up at the big wall of shoes, and there was a lot of little industrial design projects on the wall. And you put them on your foot, and they feel very good, but you look like a dork if you try to walk out of the store.

And subsequently, I thought we could take the idea of the interior components of athletic shoes, the comfort factors and so forth, and put them into casual shoes and classic athletic shoes that didn't stereotype, that didn't say

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football or didn't say soccer or didn't say anything about you other than that they were just very clean, basic styles. No one could stereotype you.

And then we developed the line several directions around that. From the very outset, casual athletic, and then we had accessories, and additionally, we had several T-shirts in the beginning, hats, socks as well.

Opposer's promotional literature also helps convey the meaning of its mark. For example, opposer's catalogue, Exhibit 4, notes:

Simple

all the performance... none of the hype

...My goal is to blend performance and style into simple shoes with a modern twist. Not everyone out there wants to wear hyped out, over logo'd athletic shoes and I am trying to offer an alternative.

Simple™ shoes don't stereotype you into any category... they're not running shoes, work shoes, basketball shoes, or hiking shoes... they're all of these. They work for all occasions...

Opposer's Fall 1995 catalogue notes: "Simple what that means is like, well... less is more, you know... like the less you have the better your life can be".

Mr. Meyer testified that opposer introduced shoes, hats and T-shirts under the mark SIMPLE in 1992. Thereafter, opposer expanded its line of merchandise to caps, backpacks, socks, sweatshirts, wallets and key chains. Since 1995, opposer has also used the mark SIMPLEGIRL for women's shoes,

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and opposer anticipates expanding its line of SIMPLE brand goods into shirts, pants and shorts. Mr. Meyer testified, at 62, that other shoe companies have expanded into the clothing field and vice versa.

Opposer sells its goods through department stores, clothing stores, sporting goods stores, athletic shoe stores, other shoe stores, surf, skateboard and snowboard shops, and by mail-order catalogues. While its registration is not so limited, Mr. Meyer testified that opposer's principal market is among young adults and adults in their 30s and 40s.

Opposer advertises and promotes its goods by catalogues, newspaper and magazine advertisements, various trade shows, mailings and its Web site. Opposer's witness also testified that opposer is the patron of the author of Moonlight Chronicles, which publication features opposer's trademark on its cover and is distributed by opposer to its customers. Through this publication and by other means, opposer communicates a theme of leading a less complicated or a simpler life. Opposer also sponsors teams, athletes, performing groups, film festivals and college radio stations.

Opposer's annual sales in this country have exceeded \$20 million in recent years, mostly from shoes. Its annual advertising expenses in recent years are around \$1 million.

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With respect to third-party marks containing the word SIMPLE or variations thereof, Mr. Meyer testified that opposer has filed a number of oppositions against third-party marks including SIMPWEAR (judgment entered by default), SIMPLE TOUCHES and SIMPLY COMFORT (both of which were settled), SIMPLY KIDS (judgment entered by default), CHIC SIMPLE (applications abandoned) and SIMPLE BY DESIGN (still pending at the time of opposer's testimony).⁴ Mr. Meyer indicated that he was aware of the third-party mark SIMPLE PLEASURES for lingerie. When asked about a number of other third-party marks, he testified that he was not aware of them. When asked if there would be confusion between opposer's mark SIMPLE and applicant's mark SIMPLE LIFE, Mr. Meyer testified, at 76-77:

- A. Because we have been marketing the brand and its underlying philosophy about how to live your life through our advertising and marketing efforts for some time, and this would be confusing to the general public. It's the exact same distribution, exact same products.

Arguments of the Parties

It is opposer's position that the marks SIMPLE and SIMPLE LIFE have the similar connotation of leading a simple lifestyle. In this regard, opposer points to the Midnight Chronicles publication by which opposer communicates its

⁴ That opposition eventually resulted in a judgment in favor of opposer on the issue of likelihood of confusion.

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theme of leading a simpler life. Opposer also argues that some of the goods of the parties (T-shirts, shirts and sweatshirts) are identical and that other goods of applicant are closely related to opposer's goods. Also, because there is no limitation in the respective registration and application, opposer maintains that the goods of the parties may travel through similar channels of trade to the same prospective purchasers. Opposer also argues that purchases of clothing are not usually the subject of careful reflection.

It is opposer's position that its mark is well known and entitled to a broad scope of protection. Opposer points to sales of over \$40 million in 1995 and 1996 and sales of nearly \$60 million in the period 1992-1996. In the years 1995 through 1997, over \$3 million was spent in connection with advertising and promoting opposer's goods. Opposer also points to its efforts in policing its mark and argues that, aside from the fact that applicant has introduced no evidence of actual use of third-party marks, many of these marks are more dissimilar and include other distinctive terms (for example, SIMPLY FOR SPORTS) or are for different goods (for example, lingerie or auto parts). Accordingly, opposer maintains that third-party registrations are entitled to little or no weight. Finally, opposer asks us

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to resolve any doubts there may be in favor of the established user -- opposer.

Applicant, on the other hand, argues that opposer's mark SIMPLE is "weak and descriptive" (brief, 4) and is entitled to a narrow scope of protection. Applicant also maintains that the respective marks do not sound or look alike and that they have different meanings, applicant's suggesting a lifestyle and clothing compatible with that lifestyle. Also, it is applicant's position that opposer uses secondary marks on its specific lines of shoes, which marks purchasers would use to identify and distinguish opposer's goods.

With respect to the goods, it is applicant's position that opposer's T-shirts and hats are merely marketing vehicles for opposer's shoes, which are its primary products. Applicant contends that there is no overlap in the goods of the parties. Applicant also argues that opposer's shoes are sold to a narrow, discriminating segment of the market -- brand-conscious teenagers and "twentysomething" males -- as opposed to applicant's sportswear intended to be sold to "thirtysomething" and older women. While applicant concedes that the respective goods could appear in different departments of a large department store, it is applicant's position that purchasers

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of these relatively expensive goods are not impulse purchasers.

Applicant contends that opposer's mark is not famous because of its other marks used to identify shoe styles which are used with the mark SIMPLE, and because of various third-party marks. Applicant maintains that consumers are faced with a number of products bearing similar marks and that opposer's lack of knowledge of these third-party marks does not prove that they do not exist.

Opinion

There is no issue with respect to priority in this case, in view of opposer's testimony and opposer's ownership of a valid and subsisting registration. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) and *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

With respect to applicant's argument that opposer's primary goods are shoes, even if this is the case, T-shirts are listed in opposer's pleaded registration. Furthermore, as opposer has noted, the identifications of goods in the registration and application are unrestricted as to class of purchasers and channels of trade. Accordingly, the question of registrability of applicant's mark must be decided on the basis of the identification of goods set forth in the application and registration (together with any testimony

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and evidence with respect to opposer's common law use) regardless of what the record may reveal as to the particular nature of the respective goods, the particular channels of trade or the class of purchasers to which sales of those goods may in fact be directed. See *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992), *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). The parties' respective goods are in part identical, and applicant's goods and opposer's casual and athletic shoes and T-shirts are otherwise closely related, and must be deemed to be sold in the same or similar channels of trade. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

While the marks SIMPLE and SIMPLE LIFE have obvious differences in sound and appearance, we nevertheless believe that they are sufficiently similar that, when considering the fallibility of purchasers' memories and the fact that side-by-side comparison of marks is not the test, these marks are sufficiently similar that confusion is likely. Finally, third-party registrations offered by applicant, even if considered to be of record, are not evidence of use of those marks, what happens in the marketplace or that

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consumers are familiar with those marks. Nor should the existence of confusingly similar marks on the register aid an applicant to register another mark which is likely to cause confusion. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).

Accordingly, there is little probative evidence of record concerning uses of similar marks on similar goods.

Applicant has, therefore, not demonstrated that opposer's mark is a weak one.

Because of the similarities of the marks, the identity or close relationship of the goods and the fact that they may be sold in the same channels of trade to the same class of purchasers, confusion is likely if applicant's mark were to be used in connection with the goods set forth in the application. Finally, any doubt with respect to the question of likelihood of confusion should be resolved in favor of the prior user and registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991) and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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

R. L. Simms

C. E. Walters

G. F. Rogers
Administrative Trademark
Judges, Trademark Trial
and Appeal Board