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**THIS DISPOSITION
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Paper No. 25
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

PRL USA Holdings, Inc.
v.
Malibu Riding and Tennis Club, Ltd.

Opposition Nos. 106,932 and 110,254
to application Serial Nos. 75/019,265; 75/227,228;
75/227,229; and 75/227,230

Anthony F. Lo Cicero of Amster, Rothstein & Ebenstein for
PRL USA Holdings, Inc.

Marc J. Schwartz for Malibu Riding and Tennis Club, Ltd.

Before Seeherman, Quinn, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Malibu Riding and Tennis Club, Ltd. (applicant) has
filed four trademark applications to register the
following marks for the words "MALIBU POLO CLUB" and the
design of a polo player depicted in the two drawings¹
below for the identified goods and services:

¹ The first mark shown below is much clearer in the actual
drawing in the application file (75/019,265).



for "clothing, headgear, and footwear, namely, athletic shoes, bathrobes, boxer shorts, briefs, clothing caps, rain coats, over coats, polo shirts, jackets, parkas, ponchos, sports shirts, sweat shirts, T-shirts, under shorts, Bermuda shorts, gym shorts, sweat shorts, socks, gum [sic] suits, jogging suits, sweats suits, warm-up suits and athletic uniforms" in International Class 25;²



for "clothing, headgear, and footwear, namely, shoes, socks, shorts, pants, shirts, jackets and hats" in International Class 25;³

² Serial No. 75/019,265 filed on November 15, 1995, and based on an allegation of a bona fide intent to use the mark in commerce. Applicant has disclaimed the words "Malibu" and "Polo."

³ Serial No. 75/227,228 filed on January 17, 1997, and based on an allegation of a bona fide intent to use the mark in commerce. Applicant has disclaimed the words "Malibu Polo."

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for the services of "dissemination of advertising matter" in International Class 35;⁴ and for "goods of precious metals and their alloys, namely, jewelry, clocks, watches and watch bands, and chronographs" in International Class 14.⁵

On July 15, 1997, and April 21, 1998, PRL USA Holdings, Inc. (opposer) filed notices of opposition to oppose the registration of the marks in this case alleging that applicant's marks were confusingly similar to various trademark registrations it owned. Opposer ultimately based its opposition on its ownership of the following eight⁶ registrations.

Opposer's first registration is for the mark:



⁴ Serial No. 75/227,229 filed on January 17, 1997, and based on an allegation of a bona fide intent to use the mark in commerce. Applicant has disclaimed the word "Malibu."

⁵ Serial No. 75/227,230 filed on January 17, 1997, and based on an allegation of a bona fide intent to use the mark in commerce. Applicant has disclaimed the word "Malibu."

⁶ Opposer's ninth registration (Registration No. 1,846,817 issued July 26, 1994) was for the mark USA POLO CLUB for "T-Shirts." This registration was cancelled August 4, 2001, for failure to file a Section 8 affidavit. Therefore, we do not give this registration any weight in our determination. Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc., 204 USPQ 144 (TTAB 1979); Duffy-Mott Co. v. Borden, Inc., 201 USPQ 846 (TTAB 1978).

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for "men's suits, slacks, ties, sweaters, shoes, shirts, hats, belts, socks; and ladies' blouses, skirts, suits and dresses" in International Class 25.⁷

Opposer's second registration is for the mark THE POLO CLUB (typed form) for "retail clothing store services" in International Class 42.⁸ Opposer's third registration is for the mark POLO (typed form) for "clothing-namely, suits, slacks, trousers, shorts, wind resistant jackets, jackets, blazers, dress shirts, sweatshirts, sweaters, hats, belts, socks, blouses, skirts, coats, and dresses" in International Class 25.⁹

Opposer's fourth registration is for the following mark:



⁷ Registration No. 978,166 issued February 5, 1974, and it alleges a date of first use and a date of first use in commerce of May 1967. The registration has been renewed.

⁸ Registration No. 1,271,213 issued March 20, 1984, and it alleges a date of first use and a date of first use in commerce of August 14, 1977. Sections 8 and 15 affidavits have been accepted and acknowledged, respectively.

⁹ Registration No. 1,363,459 issued October 1, 1985, and it alleges a date of first use and a date of first use in commerce of May 1967. The mark registered under Section 2(f) of the Trademark Act. Sections 8 and 15 affidavits have been accepted or acknowledged, respectively.

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for "men's and women's wearing apparel and accessories, namely, t-shirts, sweatshirts, sweaters, jackets, pants, wind-resistant jackets" in International Class 25.¹⁰

Opposer's fifth registration is for the following mark:



for "clothing --namely, suits, slacks, trousers, shorts, wind-resistant jackets, jackets, blazers, dress shirts, knit shirts, sweatshirts, sweaters, hats, belts, socks, blouses, skirts, coats and dresses" in International Class 25.¹¹

Opposer's sixth and seventh registrations are for the same mark shown below:

¹⁰ Registration No. 1,378,247 issued January 14, 1986, and it alleges a date of first use and a date of first use in commerce of 1975. Sections 8 and 15 affidavits have been accepted or acknowledged, respectively.

¹¹ Registration No. 1,512,754 issued November 15, 1988, and it alleges a date of first use and a date of first use in commerce of December 12, 1972. Sections 8 and 15 affidavits have been accepted or acknowledged, respectively.



for "jewelry" in International Class 14¹² and for the service of "providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global computer network" in International Class 42.¹³

Opposer's eighth registration is for the mark POLO (typed form) for the service of "providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global computer network" in International Class 42.¹⁴

Applicant denied that its marks and opposer's marks are confusingly similar. As an affirmative defense, applicant alleged that: "Opposer is barred by Laches, Estoppel and Waiver in that Opposer has known of Applicant's use of the mark and has taken no legal action

¹² Registration No. 1,729,192 issued November 3, 1992, and it alleges a date of first use and a date of first use in commerce of 1976. Sections 8 and 15 affidavits have been accepted or acknowledged, respectively.

¹³ Registration No. 2,085,471 issued August 5, 1997, and it alleges a date of first use and a date of first use in commerce of November 1, 1995.

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for more than seven years." Answer dated January 23, 1998, p. 2.

On March 25, 1999, the Board granted the parties' motion to consolidate the two oppositions.

The Record

The record consists of the file of the involved applications; the trial testimony deposition, with accompanying exhibits, of Lee S. Sporn, opposer's vice-president of intellectual property and associate general counsel; and the trial testimony deposition, with accompanying exhibits, of Samuel K. Freshman, applicant's general partner.

Both parties have filed briefs, but no oral hearing was requested.

Priority

Priority is not an issue here in view of opposer's ownership of eight registrations for marks containing the word POLO and/or the design of a polo player. See King

¹⁴ Registration No. 2,083,276 issued July 29, 1997, and it alleges a date of first use and a date of first use in commerce of November 1, 1995.

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Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182
USPQ 108 (CCPA 1974).¹⁵

Laches, Estoppel, and Acquiescence

Before we address the issue of likelihood of confusion, we must address applicant's arguments in its brief that opposer is precluded from opposing the registration of its four current applications because it previously failed to oppose other applications of applicant, which issued as registrations. "Opposer had the opportunity to oppose Malibu's trademark registration over ten years ago, and has had all the time since then to file a cancellation proceeding[]. They chose to do neither. Polo's acquiescence, combined with the long period of time of such acquiescence prevents Polo from now opposing Malibu's registration of same and similar marks on similar goods." Applicant's Br., p. 5.¹⁶

¹⁵ Opposer introduced two of the registrations (Nos. 2,083,276 and 2,085,471), discussed above, during the testimony of its witness that were not originally pled as a basis of its oppositions. Applicant has not objected to the introduction of these registrations. In addition, in its brief, applicant incorporates by reference "Polo's trademarks identified in Opposer's trial brief." Applicant's Trial Br., p. 1. Therefore, we deem the pleadings to be amended to conform to the evidence. Fed. R. Civ. P. 15(b).

¹⁶ Opposer has not objected to applicant's argument concerning opposer's failure to object previously to the registration of applicant's earlier applications as a new issue not raised in the answer and, therefore, we will consider it.

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Applicant is the owner of the following two registrations:



for "shirts, shorts and caps" in International Class 25;¹⁷
and



for "goods of precious metals and their alloys, namely, jewelry, clocks, watches and watch bands, and chronographs" in International Class 14.¹⁸

An opposer can be prohibited from opposing an application if it has failed to oppose or cancel an existing registration for the same marks on the same

¹⁷ Registration No. 1,492,318 issued June 14, 1988, and it alleges a date of first use and a date of first use in commerce of December 1, 1983. A Section 8 affidavit was accepted. The registration disclaims the words "Malibu Polo."

¹⁸ Registration No. 2,231,291 issued March 16, 1999, and it alleges a date of first use and a date of first use in commerce of December 1, 1983. The registration disclaims the word "Malibu."

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goods. Morehouse Manufacturing Corp. v. J. Strickland and Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969). A prior registration or Morehouse defense is an equitable defense in the nature of laches or acquiescence. TBC Corp. v. Grand Prix Ltd., 12 USPQ2d 1311, 1313 (TTAB 1989). We understand applicant's laches, estoppel, and acquiescence argument to raise a Morehouse or prior registration defense.

Applicant's argument must fail. First, applicant's oldest registration (no. 1,492,318) is for shirts, shorts, and caps. None of the opposed applications is limited to shirts, shoes, and caps. The failure to oppose the registration of a mark for one set of goods does not bar a party from opposing the mark on a different set of goods. Magnovox Co. v. Multivox Corp. of America, 341 F.2d 139, 144 USPQ 501 (CCPA 1973); Federated Foods, Inc. v. Ft. Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). The goods must be identical or substantially identical before an opposer can be denied the opportunity to file an opposition to a later filed application. La Fara Importing Co. v. F. Lli De Cecco di Filippo Fara S. Martino S.p.a., 8 USPQ2d 1143 (TTAB 1988) (Failure to oppose the registration of a mark

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for alimentary pastes does not preclude opposition to the same mark for spaghetti sauce).

In this case, two of the involved applications are for dissemination of advertising matter and jewelry, clocks, watches and watch bands and chronographs of precious metals, which are clearly different from shirts, shorts, and caps. While the other two applications are for clothing items, including shirts, shorts, and caps, there are numerous other clothing items that are specifically different, including jackets, bathrobes, parkas, ponchos, overcoats, shoes, and socks.

The goods in applicant's second registration (No. 2,231,291), however, are identical to the goods in its application (Serial No. 75/227,230). This registration issued March 16, 1999. The oppositions were filed on July 15, 1997, and April 21, 1998. We have held that "[t]here is an exception to the defense of ownership of a subsisting registration when the registration which bottoms the defense issued subsequently to the institution of the opposition" as in this case. S. Gumpert Co., Inc. v. ITT Continental Baking Co., 191 USPQ 409, 411 (TTAB 1976). See also Texas Instruments Incorporated v. Peerless Teleread, Inc., 171 USPQ 376, 377 (TTAB 1971).

In addition, applicant has not established any specific prejudice to itself as a result of any delay on opposer's part. Therefore, for the reasons set out above, applicant's ownership of the two registrations of record does not prevent these oppositions from going forward because of laches, estoppel, or acquiescence.

Likelihood of Confusion

Both parties have analyzed the issue of likelihood of confusion under the principles set forth by the Court of Customs and Patent Appeals, one of the predecessor courts of the Court of Appeals for the Federal Circuit, in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Therefore, we begin our discussion by analyzing whether applicant's and opposer's marks as identified in the applications and registrations are confusingly similar under the du Pont factors.

- (1) The fame of the prior mark (sales, advertising, length of use).

While not the first factor listed in the du Pont case, we start with this factor because it plays a significant role in our decision. With this factor, we look at what fame the mark has achieved in the marketplace. "Thus, a mark with extensive public recognition and renown deserves and receives more legal

protection than an obscure or weak mark." Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Applicant acknowledges that opposer's trademarks are famous. Applicant's Br., p. 6 (*"While it is true that Polo's trademarks are famous, their fame is not relevant in this case since the appearance of the Malibu's Marks is such that it would not cause confusion"*) (emphasis added). The record indicates that in 1998 opposer spent \$23.5 million advertising its men's clothing line. Sporn testimony dep., p. 33. Also, in 1998, it had sales of \$1.3 billion. Sporn testimony dep., p. 35. In 1997 and 1998, opposer placed 2513 pages of advertising in more than 80 publications including *Architectural Digest*, *Entertainment Weekly*, *Fortune*, *Golf Digest*, *The New York Times Magazine*, *Rolling Stone*, *Time*, and *USA Today*. Sporn Ex. 13. Opposer is listed as one of the largest advertisers in the fashion, accessories, and beauty industry. Sporn Ex. 16.¹⁹

¹⁹ In addition, opposer has cited several federal court cases that recognized the renown of its marks. Opposer's Br., pp. 6-7. Polo Fashions, Inc. v. Magic Trimmings, Inc., 223 USPQ 1178, 1179 (S.D. Fla. 1984) ("Polo is a world famous fashion house ... under the direction of its world famous designer Ralph Lauren"); Polo Fashions, Inc. v. Clothes Encounters, 227 USPQ 327, 328 (N.D. Ill. 1985) ("The defendants do not dispute that Polo is a world-famous fashion house and that the Polo trademarks are

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The Federal Circuit "has acknowledged that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21, 23 USPQ2d at 1701, quoting, Kenner Parker Toys, 22 USPQ2d at 1456. "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for edible dog treats confusingly similar to FRITO-LAY snack foods). In this case, because of the undisputed fame of the Polo marks, this factor strongly favors opposer.

- (2) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

Opposer has eight registrations for marks containing the word POLO and/or design of a polo player for various goods and services. These registrations include the marks POLO and THE POLO CLUB in typed form as well as the registrations set out below for clothing or retail clothing store services.

among the most well-known trademarks in the fashion clothing field").



Applicant is seeking to register the two marks shown below for various clothing items.



Both marks contain the identical wording "MALIBU POLO CLUB."

We start with the observation that the marks are certainly not identical although that, of course, does not end the likelihood of confusion analysis. It is well settled that it is improper to dissect a mark and that marks must be viewed in their entirety. In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to

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a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant argues that the "visual impression of the drawings clearly distinguish Malibu's marks from Polo's trademarks." Applicant's Br., p. 7. Opposer argues that the overall effect of the marks is the same. We agree that there are differences between applicant's and opposer's marks and that the addition of the word "Malibu" cannot be ignored. We find, however, that there are more similarities than differences between the marks. In particular, both applicant's and opposer's marks have a polo theme. Both applicant and opposer have marks that include the word "polo" and both have at least one mark that includes the word "club." While applicant's marks include the geographically descriptive word "Malibu," this word alone is not sufficient to distinguish the marks. Potential customers, who are familiar with opposer's "polo" marks and its retail store services identified by the mark "THE POLO CLUB" are likely to believe that the goods identified with a mark referring to a specific polo club, the "Malibu Polo Club," are related to opposer's "THE POLO CLUB" and other "POLO" marks for identical and related goods and services.

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Obviously, a side-by-side comparison does not reflect the way the goods would necessarily be sold in the marketplace. Here, applicant's marks are dominated by the polo theme through the use of the word "polo" and the similar polo player design. In addition, opposer also uses the word "club" in its retail clothing store service mark. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977)(CALIFORNIA CONCEPT and design likely to be confused with CONCEPT for hair care products). See also Dixie Restaurants, 105 F.3d at 1407, 41 USPQ2d at 1534 (THE DELTA CAFE and design was confusingly similar to DELTA; more weight given to common dominant word DELTA).

Applicant also seeks to register the following mark for jewelry and the dissemination of advertising matter.



In addition to its registrations for clothing, opposer owns the mark shown below for jewelry and for providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global computer network.



Opposer also owns a registration for the mark POLO in typed form for the same services.

Opposer's polo design and the word mark POLO are similar to applicant's mark MALIBU POLO CLUB and polo player design for its advertising dissemination services. While opposer has only made of record a design of a polo player for jewelry, there are similarities between the polo players of applicant's and opposer's designs such that, considered in relation to opposer's other registrations, the marks would be similar.

Therefore, we conclude that the marks are similar in sound, appearance, and meaning and the differences do not outweigh the similarities of the marks. National Data, 753 F.2d at 1060, 224 USPQ at 749.

- (3) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

When we compare the goods and services of applicant and opposer, we must compare the goods and services as described in the applications and the registrations to

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determine if there is a likelihood of confusion.

Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d

1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Applicant "does not dispute that many of the goods listed in Malibu's applications may be similar to those that Polo uses in conjunction with its trademarks."

Applicant's Br., p. 8. Indeed, many of the goods are identical (jackets, socks, shorts, and hats) or virtually identical (applicant's rain coats, over coats, parkas, and ponchos v. opposer's wind resistant jackets and jackets; applicant's boxer shorts, under shorts, Bermuda shorts and sweat shorts v. opposer's shorts). In addition, both applicant and opposer use their marks on jewelry. Finally, there is no argument by applicant that its dissemination of advertising matter services are not related to opposer's Internet and retail store services.²⁰

Because the marks are used on identical clothing items and jewelry, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical

²⁰ Applicant does not discuss its "dissemination of advertising matter" services in its brief.

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goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines”).

- (4) The similarity or dissimilarity of established, likely-to-continue trade channels.

While applicant argues that it “does not sell in the same stores as Opposer, nor does Malibu advertise in the same magazines as Opposer,” it does not dispute that “the trade channels in which the goods are distributed may be similar.” Applicant’s Br., p. 8. As discussed above, we must consider the goods and services as defined in the applications and registrations. Neither the applications nor registrations contain any limitation on where the goods can be sold. Therefore, we must assume that identical goods would be marketed in similar trade channels.

Even looking at opposer’s actual trade channels reveals that opposer:

[O]wns its own full-price, free-standing Polo Ralph Lauren stores. We also own a chain of Polo Ralph Lauren factory stores, which are discount outlets. We distribute our products through the major upscale department stores, Bloomingdale’s and Macy’s and the like. And then a wide variety of specialty store accounts, depending on what the product is.

Sporn testimony dep., p. 17.

Thus, opposer already has its own discount outlets, which indicates that its goods are not marketed as exclusively as applicant argues. In addition, nothing in

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opposer's identification of goods restricts it from selling its goods in any other type of store if it chooses to change its marketing strategy.

- (5) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

Applicant argues that "[i]n making purchasing decisions regarding expensive goods, the reasonably prudent person standard is elevated to the standard of discriminating purchaser." Applicant's Br., p. 9. Applicant cites Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). In Weiss Associates, the "products are used primarily by professional persons of large manufacturing plant and institutions for property maintenance and management. Both products sell in the range of thousands of dollars." Id. at 1841. The products in this case include shorts, socks, hats, belts, dress shirts, slacks, wind resistant jackets, jewelry, and similar products, which are in a different class from expensive software bought by professional property managers.²¹ We have no basis to hold that purchasers of opposer's items are sophisticated purchasers.

²¹ Sporn Ex. 7 is a shirt with a tag indicating that the shirt was priced to sell at \$52.50.

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(6) The number and nature of similar marks in use on similar goods.

Applicant relies heavily on this factor. Applicant maintains there are numerous third-party registrations for similar marks containing the word "polo" and a design of a polo player. To the extent that applicant relies on registrations without submitting copies of the registration, they will not be considered. In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994); Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993).

We will consider two²² registrations (Reg. Nos. 1429,311 and 1,743,296) introduced during the Sporn deposition.²³ Both registrations are for various clothing items.



²² A third registration was also introduced involving the mark MEADOWBROOK POLO CLUB and design (Registration No. 1,819,237). However, since the mark was for polo club services, it is not relevant to this proceeding.

²³ We determine that the cross-examination of opposer's witness on the subject of these registrations was not outside the scope of the direct examination, and therefore the registrations are properly of record.

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Opposer has also acknowledged that the BEVERLY HILLS POLO CLUB worldwide sales "are a bit over 300 million." Sporn Testimony dep., p. 102. Opposer has entered into a settlement agreement with the owner of the Beverly Hills Polo Club mark. Sporn Ex. 24.

At best, applicant has shown that there are two other marks containing the words "polo club" with a geographic term and the design of a polo player for clothing. This evidence does nothing to diminish the fame of opposer's marks, and hardly establishes that there is no likelihood of confusion between applicant's and opposer's marks.

(7) The nature and extent of any actual confusion.

There is no evidence of actual confusion in this case. However, the absence of actual confusion does not mean that there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). As explained below, because applicant has not shown extensive marketing of products sold under its marks, it is not surprising that there is no evidence of actual confusion. This factor weighs only slightly in applicant's favor.

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- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

As discussed above, there has been no actual confusion, but this is likely due to the limited marketing of applicant's goods. Apparently, the licensees of applicant's clothing ceased sales years ago although "there were sales of clothing in the pro shop." Freshman testimony dep., p. 53. Sales at the pro shop at applicant's Malibu location ceased in April of 1997 when the pro shop itself closed. Freshman testimony dep., p. 54. Over the years, applicant sold over 10,000 watches with the Malibu Polo Club and polo player design. Applicant's general partner has testified that it sells its products through "catalogs, direct personal calls on wholesalers and jobbers and trade shows." Freshman testimony dep., p. 25. Therefore, the goods and services of applicant and opposer, as actually marketed, would be unlikely to be sold or displayed together because of the parties' current marketing strategies. However, there is no restriction in the identification of goods and services that limits either party to the current channels of trade. In addition, as discussed above, the sales of applicant's goods have been limited and, therefore, the significance of the lack of actual confusion, while it

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cannot be discounted, cannot weigh too strongly in applicant's favor.

- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

Opposer, as the owner of at least eight registrations, has demonstrated that it uses its POLO and polo player marks on a wide variety of products and services. Applicant does not dispute that the goods listed in the identification of goods in the applications and opposer's registrations may be similar. In fact, many of the goods are identical.

- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

There is no consent agreement and it is therefore not a factor in this case. We have previously considered the laches and estoppel argument.

- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

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As the owner of very well-known trademarks, opposer is entitled to broad protection from marks that are confusingly similar to its registrations.

(12) The extent of potential confusion, i.e., whether de minimis or substantial.

Inasmuch as opposer has established the recognition and renown of its mark, the potential for confusion is more likely when opposer's well-recognized mark is used as a dominant part of another's trademark.

(13) Any other established fact probative of the effect of use.

Opposer has alleged that applicant has essentially copied its marks and that there is an inference of bad faith. We decline to so hold. Applicant is the owner of registration that issued more than ten years ago, which is similar to its pending applications. Based on the record in this case, we cannot draw an inference of bad faith.

Analysis of Likelihood of Confusion Factors

We now balance the du Pont factors and conclude that there is a likelihood of confusion in this case. Likelihood of confusion is decided upon the facts of each case. Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ 1531, 1533 (Fed. Cir. 1997); Shell Oil, 992 F.2d at 1206, 26 USPQ at 1688. The various factors may play more or

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less weighty roles in any particular determination of likelihood of confusion. Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

We start with the fact that applicant uses its marks on goods and services that are either identical to opposer's goods and services or closely related. In addition, opposer has alleged and applicant conceded that opposer's marks are famous. The marks of the parties are also similar. Applicant's and opposer's word marks contain the word POLO and the parties' marks with designs have similar polo player designs. Opposer also uses the mark "THE POLO CLUB" for retail clothing store services. Thus, potential customers, who are familiar with opposer's marks used on a wide variety of clothing items, jewelry, and related goods and services, when they are confronted with applicant's MALIBU POLO CLUB and polo player design for identical and related goods and services, are likely to believe that opposer is somehow associated with the source of the goods and services of applicant.

In addition to the applications for goods, applicant also has an application for the services of dissemination of advertising matter in this consolidated opposition (Serial No. 75/227,229). At best, the parties have made

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only passing reference to this application. Opposer has not clearly articulated its specific basis for alleging a likelihood of confusion although it appears to be based on the fame of opposer's marks and the similarity to its services with applicant's. After opposer listed all the goods and services identified in the applications, opposer stated that it "has used the Polo Trademarks on virtually all of these goods, with the exception only of 'gum suits.'" Opposer's Br., p. 15. See also Sporn testimony dep., pp. 53-54. Opposer's brief also briefly discusses applicant's advertising storyboards used in its attempts to license products for its marks. Freshman Ex. 8. These storyboards relate to fashion and lifestyle, and they are similar to opposer's service of providing information in the field of fashion, fragrance, lifestyle, and other topics of general interest by means of a global computer network. Applicant never alleges that the services are dissimilar. Rather, its argument is that the similarity of the goods and services is irrelevant because of other factors. Therefore, we find that there is a likelihood of confusion when applicant's and opposer's similar marks are used on these services.

The only true difference between applicant's and opposer's various marks is the fact that applicant's

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marks have an added geographic term, Malibu, which applicant has disclaimed. While we must consider marks in their entireties, disclaimed matter is often given less weight than other elements of a mark. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). We also must resolve doubts about confusion against the newcomer. Kenner Parker Toys, 963 F.2d at 355, 22 USPQ2d at 1458. Furthermore, we must also consider the goods and services as identified in the applications and registrations without limitations on how the goods and services are presently marketed. Current marketing and distribution methods may change. Because there are no restrictions in the applications or registrations as to the channels of trade, we must assume that the goods and services travel in the same channels of trade and are purchased by the same purchasers. Kangol Ltd. v. KangaRoos U.S.A. 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

We have considered the lack of actual confusion, the presence of two other users, and the fact that the marks are not identical, but we find these factors are outweighed by the renown and recognition of opposer's marks, the identical and/or highly related nature of the goods and services, the similarities of the marks, and

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the lack of differences between the channels of trade and the purchasers of the goods and services described in the registration and applications.

Decision: The oppositions are sustained and registration to applicant of all four applications is refused.