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Paper No.

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Carol Ihlenburg

v.

Antoinette Young d.b.a. Young Associates

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Opposition No. 108,296 to application Serial No. 75/104,152  
filed on May 14, 1996

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Nancy J. Moriarty and Charles D. McClung of Chernoff,  
Vilhauer, McClung & Stenzel, L.L.P. for Carol Ihlenburg.

Joseph H. Roediger of Nelson & Roediger for Antoinette Young  
d.b.a. Young Associates.

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Before Hohein, Hairston and Wendel, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Antoinette Young d.b.a. Young Associates has filed  
an application to register the mark "DIGGERS" for "clothing,  
namely, jackets, vests, pants and shirts."<sup>1</sup>

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<sup>1</sup> Ser. No. 75/104,152, filed on May 14, 1996, which is based on an  
allegation of a bona fide intention to use the mark in commerce.

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Carol Ihlenburg has opposed registration on the ground that prior to the filing date of applicant's application, opposer "adopted and used in commerce the mark DIGGER for shoes and t-shirts, through her exclusive Licensee, Larsen Travis Golf Co."; that on March 24, 1997, opposer filed an application, Ser. No. 75/262,510, to register such mark; that if applicant's mark becomes registered, it will prevent opposer from registering her mark; that the respective marks "are essentially the same and are used on the same or similar goods"; and that "[u]se by Applicant of the mark DIGGERS, when applied to Applicant's goods, would be likely to cause confusion with Opposer's DIGGER mark as used with Opposer's goods, or to cause mistake or to deceive."

Applicant, in her answer, has admitted that opposer "is the Applicant for U.S. Trademark Application Serial No. 75/262,510 for the mark DIGGER ... which was filed on March 24, 1997," but has otherwise denied the salient allegations of the notice of opposition. In particular, applicant has alleged among other things that any use of the mark "DIGGER" by opposer or any of her asserted licensees "has been insufficient to result in the development of a trade identity" therein and that, as an affirmative defense, "any alleged use of the mark DIGGER ... has been abandoned" by opposer or any licensees of opposer.

The record consists of the pleadings; the file of the involved application; and, as opposer's case-in-chief, the testimony, with exhibits, of Frederick H. Ihlenburg, who is the chief executive officer of Diggers, Inc. in addition to being the husband and business partner of opposer. Applicant did not take testimony or otherwise submit any evidence. Briefs have been filed, but an oral hearing was not requested.

Preliminarily, we note that the record reveals that, as actually used, opposer's mark is "DIGGERS" rather than "DIGGER," as pleaded in the notice of opposition, and that the "DIGGERS" mark has been used in connection with shorts and equipment bags in addition to the particular goods, namely, shoes and t-shirts, as set forth in the notice of opposition. Although opposer asserts in her reply brief that her pleading should be deemed to be amended, pursuant to Fed. R. Civ. P. 15(b),<sup>2</sup> to conform to the evidence presented at trial, based upon applicant's allegedly implied consent thereto, we note that only counsel for opposer, and not applicant's attorney,

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<sup>2</sup> Such rule provides, in relevant part, that:

When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure to so amend does not affect the result of the trial of these issues.

....

attended the trial deposition of opposer's sole witness. While perhaps, if applicant's attorney had appeared at the deposition and failed to object to testimony and/or exhibits demonstrating opposer's mark to be "DIGGERS" instead of "DIGGER," such lack of objection could be construed as implied consent, we fail to see how the absence of applicant's attorney from the deposition can be viewed as tantamount to consent to anything which was said or introduced therein on behalf of opposer.

However, in applicant's trial brief, we observe that her attorney has repeatedly referred to opposer's mark as being "DIGGERS" and the single objection specifically raised by applicant is the contention that opposer "is not entitled to rely on use of the mark on goods other than those goods specified in the Notice of Opposition," which as applicant observes "alleges [prior] use of the mark on shoes and t-shirts only." In view thereof, we hereby deem opposer's pleading to be amended pursuant to Fed. R. Civ. P. 15(b) so as to set forth, in light of the implied consent thereto by applicant, the mark "DIGGERS" as the mark actually used by opposer and to state, as so limited in the original notice of opposition, that prior use of such mark has been in connection only with respect to "shoes and t-shirts."

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Consequently, and inasmuch as applicant's pleaded affirmative defense of abandonment is considered to have been waived since no evidence or argument has been offered by applicant with respect thereto, the issues to be determined in this proceeding are whether opposer has priority of use of her "DIGGERS" mark for shoes and t-shirts and, if so, whether contemporaneous use by applicant of the identical mark "DIGGERS" in connection with jackets, vests, pants and shirts is likely to cause confusion.

According to the record, opposer first used the mark "DIGGERS" in connection with the sale of t-shirts on September 29, 1995. Subsequently, opposer commenced use of her mark with respect to the sale of softball shoes on January 1, 1996, which was followed by the first use of such mark in connection with the sale of paintball shoes on January 15, 1996. Opposer's t-shirts were introduced first as accessories to its later development of shoes for softball and paintball since the former, which were initially sold at various softball tournaments, were easier to produce than items of footwear. In particular, opposer had 1,000 t-shirts printed with her "DIGGERS" mark in September 1995 and had 500 pairs of softball shoes bearing such mark ordered in November 1995, with sales of such goods respectively commencing on the dates indicated above.

The "DIGGERS" mark appears on woven labels sewn into t-shirts as well as being printed on the goods themselves. Such mark is used on footwear by being printed on the heel and tongue of each shoe in addition to appearing on the outer sole thereof and, in the case of paintball shoes, on the cover of the boxes therefor. Use of the "DIGGERS" mark has been continuous since the introduction of each product with which it is used, with sales of such products having been made throughout the United States. In addition, opposer has filed an intent-to-use application, which was given a filing date of March 24, 1997 by the Patent and Trademark Office, to register the mark "DIGGER" for "footwear."<sup>3</sup>

Opposer's sales of her "DIGGERS" clothing and footwear have been by her licensees, the first of which was Larsen Travis Golf Company. According to Mr. Ihlenburg, there have been several other licensees since then, including Diggers, Inc., which sells apparel, including footwear, to the softball industry, while her other licensees sell to the paintball industry. With respect to the selection of the mark "DIGGERS," opposer's witness also testified that, inasmuch as

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<sup>3</sup> A previous application filed by opposer to register the same mark for the same goods, and which was signed on October 17, 1995, was inadvertently allowed to become abandoned following issuance of a notice of allowance when opposer, who was traveling with her husband on business outside of the United States, was not available to sign either a statement of use or a request for an extension of time to file a statement of use by the due date of March 10, 1997.

"[t]he products which form the basis of the company are footwear," and since "digging into the ground and forming an attachment with the ground is the connotation that is associated with digging or diggers, ... we chose the name Diggers to show that we were a fast-moving, hard grabbing, athletic-oriented company." (Ihlenburg dep. at 15-16.)

The approximate dollar volume of sales in the United States of goods sold under opposer's "DIGGERS" mark has been indicated to be as follows:<sup>4</sup>

Year	Shoes	Clothing and Equipment Bags
1995	\$7,000	\$1,000 to \$1,500
1996	\$42,000	\$3,000 to \$5,000
1997	\$500	\$3,000 to \$5,000
1998	\$175,000	none

Mr. Ihlenburg testified that, as to such sales volume for the year 1999, "we sold slightly more in shoes and we had, I believe, something in the range of \$50,000 in accessories, which would include clothing, bags and other items." (Id. at 18.) He further indicated that "we are going to come out in the year 2000 with our full line of softball clothing and shoes" and estimated that "we are expecting somewhere in the

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<sup>4</sup> While not deemed part of opposer's claim of prior proprietary rights in the mark "DIGGERS," the record does reveal that opposer first used such mark in connection with both shorts and equipment bags as early as October 1995 and that the mark has also been used in connection with sweatshirts, jackets, pants and pullover-type vests. However, unlike the case with sales of shoes, separate sales figures for t-shirts were not furnished. Instead, sales thereof were lumped together with sales of other clothing items and those of equipment bags.

neighborhood of 800,000 to a million dollars in sales in the year 2000 ...." (Id.)

As to advertising expenditures on opposer's behalf for the goods offered under the "DIGGERS" mark, Mr. Ihlenburg stated that, "[f]or the most part, our exposure has been print media of various kinds, magazines, newspapers, catalogs, fliers, all manner of print materials" and some "television exposure." (Id. at 18-19.) He additionally testified that "we're on the Internet through our licensees." (Id. at 19.) Samples of print media advertising for "'Diggers'<sup>TM</sup> The Ultimate Paintball Shoe" and Internet ads for "Diggers 'The Ultimate Paintball Shoe'" and "Diggers Paintball Shoes" were also provided. (Opposer's Exhs. 18-20, respectively.) Furthermore, according to opposer's witness, her "DIGGERS" mark "has a high level of exposure" in the paintball industry and, "[i]n the softball market, we have a low level of exposure, [but] growing." (Ihlenburg dep. at 20.)

Finally, as to use in the marketplace by applicant or others of marks similar to opposer's "DIGGERS" mark in connection with similar products, Mr. Ihlenburg observed that, "other than Ms. Young, we have never seen anything that would carry the Diggers name or trademark." (Id. at 21.) He noted, in particular, with respect to any actual use by applicant of her "DIGGERS" mark that:

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To the best of my knowledge, she has nothing more than business cards or a concept of a line. I do not know of any product that she's actually produced, even for sample.

(Id.)

Turning first to determination of the issue of priority of use, it is clear from both the uncontroverted testimony and the answers to certain interrogatories that opposer is the prior user of the "DIGGERS" mark in connection with her t-shirts, softball shoes and paintball shoes. Opposer, in this regard, has made substantially continuous, commercially significant sales of such goods bearing her mark since as early as September 29, 1995 with respect to t-shirts, January 1, 1996 as to softball shoes, and January 15, 1996 in the case of paintball shoes. Each of such dates is plainly prior to the May 14, 1996 filing date of applicant's involved intent-to-use application for her "DIGGERS" mark, which in the absence of testimony or other proof of an actual date of first use is the earliest date for priority purposes upon which applicant can rely in this proceeding. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); and Zirco Corp. v. American Tel. & Tel. Co., 21 USPQ2d 1542, 1544 (TTAB 1991).

This brings us to consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists. As previously noted, the marks at issue are identical in all respects. Both applicant's "DIGGERS" mark and opposer's "DIGGERS" mark not only have the same sound, appearance and connotation but, when utilized in connection with the respective goods of the parties--including articles of clothing such as shirts and t-shirts--engender the same overall commercial impression. The principal focus of our inquiry, therefore, is on the factor of the similarity or dissimilarity in the parties' goods and the nature thereof as those goods are described in applicant's application and are in use by opposer.

Here, it is plain that the respective goods of the parties are in part identical and are otherwise closely related, at least insofar as articles of apparel other than softball and paintball shoes are concerned. Applicant's goods, as identified in her application, are set forth as "clothing, namely, jackets, vests, pants and shirts," while opposer's goods include t-shirts, an item of clothing which is encompassed by the term "shirts" in applicant's application. Such items, on their face, are common, everyday items of outerwear which would be sold to the same classes of ordinary

purchasers through identical channels of trade. When such goods are sold by two different parties under the same, arbitrary mark "DIGGERS," it is obvious that confusion as to the source or sponsorship of applicant's jackets, vests, pants and shirts and opposer's t-shirts is inherently likely to occur.

However, where the goods of the parties on their face are specifically different, as is the case between opposer's softball and paintball shoes, on the one hand, and applicant's jackets, vests, pants and shirts, on the other hand, it is incumbent upon opposer, as the party having the burden of proof, to show that such goods are related in some viable fashion and/or that they are marketed or promoted under circumstances and conditions that could bring them to the attention of the same purchasers or prospective customers in a situation that could cause such consumers reasonably to assume, because of the identity of the parties' marks, that the particular goods share a common source or sponsorship. See, e.g., *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). Here, it is clear that opposer's "DIGGERS" footwear is not simply a type of athletic shoes, such as sneakers, which are commonly worn, like applicant's "DIGGERS" jackets, vests, pants and shirts, as everyday items of outerwear. Instead, the shoes in connection with which

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opposer utilizes her "DIGGERS" mark are softball and paintball shoes. Such shoes prominently feature cleats and are specifically designed and used solely as items of sporting equipment to improve players' performance in the sport of softball and in the game of paintball. Opposer's softball and paintball shoes plainly are not suitable for everyday wear, as is the case with applicant's clothing.

Moreover, the mere fact that clothing of some sort happens to be worn by those engaged in playing softball or paintball does not, without more, suffice to establish that shoes for playing such activities would be seen by ordinary consumers of opposer's footwear and applicant's clothing items as being commercially or otherwise closely related to articles of apparel of the kinds applicant intends to offer. Stated otherwise, the record contains nothing to demonstrate that sporting equipment such as softball and paintball shoes would be viewed by the purchasing public as affiliated or otherwise originating with the same source which produces and/or sells apparel such as jackets, vests, pants and shirts. Absent such evidence of a viable relationship between the specific goods, as was the case in, for example, *In re Kangaroos USA Inc.*, 223 USPQ 1025 (TTAB 1984), opposer has failed to meet her burden of proving that confusion is likely from the contemporaneous use of the mark "DIGGERS" by opposer for softball and

paintball shoes and by applicant for jackets, vests, pants and shirts. Moreover, while opposer in her reply brief characterizes both her shoes and applicant's clothing as being items of "wearing apparel," it is settled that the mere fact that a term may be found which encompasses the parties' products does not mean that customers will view the goods as related in the sense that they will assume that they emanate from or are associated with a common source. See, e.g., General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690, 694 (TTAB 1977) and Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd., 188 USPQ 517, 520 (TTAB 1975).

Accordingly, while we find that there is a likelihood of confusion from the contemporaneous use by the parties of the mark "DIGGERS" in connection with opposer's t-shirts and applicant's jackets, vests, pants and shirts, opposer has failed to satisfy her burden of demonstrating that confusion is likely to occur in connection with the use of such mark by opposer for softball and paintball shoes and by applicant for jackets, vests, pants and shirts. As to the latter, we note that our principal reviewing court has cautioned that "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal."

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Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

**Decision:** The opposition is sustained in part and dismissed in part as indicated.