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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:
August 2, 2000

Paper No. 22
ewh/emc

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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ETW Corp.

v.

Sunburst Products, Inc.

—
Opposition No. 111,490
to application Serial No. 75/335,058
filed on August 4, 1997
—

Siegrun D. Kane of Morgan & Finnegan, L.L.P. for ETW Corp.

Surjit P. Soni of The Soni Law Firm for Sunburst Products,
Inc.

—
Before Hanak, Hairston and Walters, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Sunburst Products, Inc. seeks to register TIGER SHARK
in typed drawing form for "watches, watchbands." The
intent-to-use application was filed on August 4, 1997. At
the request of the Examining Attorney, applicant stated that
it was the owner of Registration No. 1,640,415 for the mark
SHARK, registered in typed drawing form for "watches."

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ETW Corp. (opposer) filed a notice of opposition stating that prior to August 4, 1997 it filed applications seeking to register TIGER and TIGER WOODS for watches. Opposer alleged that applicant's TIGER SHARK mark "is confusingly similar to opposer's TIGER and/or TIGER WOODS marks." (Notice of opposition paragraph 12). While opposer did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the basis for opposer's opposition.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition including in particular those contained in paragraph 12. Applicant set forth three "affirmative defenses." The second "affirmative defense" is a mere statement that there exists no likelihood of confusion resulting from the concurrent use of applicant's TIGER SHARK mark and opposer's marks TIGER and/or TIGER WOODS. The first "affirmative defense" essentially alleges that applicant has used its existing mark SHARK in connection with watches since at least as early as May 1986, and that hence applicant "would be severely prejudiced if it were prevented from obtaining a federal registration for its TIGER SHARK mark." Finally, as a third "affirmative defense," applicant alleges that opposer's use of TIGER and TIGER WOODS is merely decorative and/or promotional and does not constitute trademark use.

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The evidentiary record in this case consists of three notices of reliance properly made of record by opposer. The first notice of reliance makes of record a certified status and title copy of opposer's Registration No. 2,220,957 issued January 26, 1999 for the mark TIGER depicted in typed drawing form for "watches and parts thereof." The second and third notices of reliance make of record portions of publications consisting of advertisements (exhibit numbers 2-18) or articles (exhibit numbers 19-23) for or regarding opposer's TIGER watches. Applicant did not properly make of record any evidence.

Both parties filed briefs and were present at a hearing held on August 2, 2000.

Before turning to the merits of this case, some procedural matters must be resolved. Opposer has filed a motion requesting that the Board strike the following: (1) exhibits attached to applicant's brief which consist of materials which were not previously introduced into evidence; (2) portions of applicant's brief which purportedly deal with said materials; and (3) all references in applicant's brief wherein applicant depicts its mark as TIGERSHARK (one word) when the mark published for opposition is TIGER SHARK (two words). Opposer's motion to strike materials attached to applicant's brief which were not previously properly made of record is granted. It is clear

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that "evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party." Section 540, Trademark Trial and Appeal Board Manual of Procedure (1995). Opposer's motion to strike portions of applicant's brief is essentially moot. This Board has read all of applicant's brief as well as all of opposer's brief and all of opposer's reply brief. This Board cannot "strike" from its minds what it has read. However, this Board will give no consideration to factual statements in applicant's brief which are premised on evidentiary materials which were improperly attached to applicant's brief unless said statements serve to assist opposer's position and not applicant's position. Finally, opposer is correct when it states that applicant throughout its brief has referred to its mark as TIGERSHARK (one word) when applicant in reality seeks to register TIGER SHARK (two words). In reading applicant's brief, we have treated all references to TIGERSHARK (one word) as in reality references to TIGER SHARK (two words).

Applicant has moved to strike opposer's exhibits 2-23 on the basis that they consist primarily of "print advertisements" and hence are "irrelevant to the core issue of likelihood of confusion." (Applicant's motion page 2).

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We disagree. These exhibits consist of advertisements and articles depicting opposer's TIGER mark. Accordingly, they are relevant to the issue of likelihood of confusion, and will be accorded their appropriate weight.

Applicant has also objected to opposer's exhibits 5, 11 and 22 on the basis that these exhibits come from trade journals and hence may not be available to the general public. Again, we disagree. Public libraries routinely carry trade journals. Thus, they are available to the general public, although the general public may have little or no interest in them. Section 708, Trademark Trial and Appeal Board Manual of Procedure (1995). Finally, applicant has requested that we strike portions of opposer's reply brief. Our response to this request is the same as our response to opposer's request that we strike portions of applicant's brief.

Turning to the merits of this case, we note at the outset that priority rests with opposer because opposer has properly made of record the previously mentioned certified status and title copy of its registration of TIGER for "watches and parts thereof." King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). At this point, it should also be noted that opposer's TIGER registration serves to negate applicant's third affirmative defense to the effect that opposer has not

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used TIGER as a trademark. Applicant has in no way attacked opposer's TIGER registration. Thus, opposer is permitted to rely upon its TIGER registration as a basis for this opposition proceeding absent any showing by opposer that it has actually used TIGER as a trademark. Moreover, in point of fact, numerous of opposer's exhibits show that opposer has used TIGER as a trademark at least for watches in that this mark appears on the face of the watch.

As for applicant's first "affirmative defense" that it would be prejudiced if it did not obtain a registration for TIGER SHARK in view of its long use of its SHARK mark, we simply note that not only is said affirmative defense legally insufficient, but in addition, applicant has not argued this affirmative defense in its brief. Finally, applicant's second "affirmative defense" to the effect that the contemporaneous use of its mark and opposer's mark is not likely to result in confusion is, of course, not a true affirmative defense but rather is simply an argument that goes to the merits of the central issue in this proceeding, which we turn to now.

At the outset, we note that in its briefs, opposer has made no reference to its purported TIGER WOODS trademark mentioned in its notice of opposition. Moreover, opposer has made of record no registration for the mark TIGER WOODS nor has opposer shown any use of the mark TIGER WOODS in

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connection with watches or any other types of goods. As opposer notes at page 1 of its brief, "the marks at issue in this proceeding are TIGER and TIGER SHARK."

We begin our likelihood of confusion analysis by acknowledging that opposer's TIGER registration and applicant's TIGER SHARK application both encompass watches without any limits or restrictions whatsoever as to types of watches. Thus, the goods of the parties are, in part, legally identical. Because the goods are identical, many of the DuPont factors favor opposer's contention that there is a likelihood of confusion. When the goods are legally identical, the channels of trade and purchasers will be identical. Moreover, because both the registration and the application list simply "watches," this encompasses watches of all types including very inexpensive watches which will be purchased by ordinary consumers who are not terribly sophisticated. With regard to the inexpensive nature of the goods, applicant's acknowledges at page 11 of its brief that its watches sell for as little as \$24. With regard to the lack of sophistication of purchasers of inexpensive watches, we simply note that included in the "evidence" improperly attached to applicant's brief is the declaration of Nancy Anderson who states that applicant sells its products to, among other groups, "the youth market." As noted earlier in this opinion, we will not consider the "evidence" improperly

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attached to applicant's brief to the extent that it may assist applicant in making its arguments. However, we will consider this "evidence" when it assists opposer's position in as much as such "evidence" can be considered as an admission against the interests of applicant.

However, while for the purposes of this opposition proceeding we must assume that both opposer's and applicant's watches are inexpensive and are purchased by unsophisticated individuals, we also find that the purchase of any watch involves at least a modest amount of care by the purchaser. Purchasers would review watches to select those that they find appealing. Moreover, most purchasers of watches would try a watch on to see how it looks and fits.

Finally, we note that applicant argues that there are other TIGER marks registered for jewelry and that "there has been ample opportunity for [actual] confusion" to arise but none has. (Applicant's brief pages 14-15). Suffice it to say, applicant has simply not submitted any evidence to support either of these factual allegations. In particular, applicant has not properly submitted any evidence showing that it has sold even one watch under its TIGER SHARK mark. Thus, the absence of actual confusion in this case is not a relevant factor to be considered because applicant has

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simply failed to prove that there has been any chance of actual confusion to have occurred.

However, having said all of the above, there is one DuPont factor which clearly favors applicant and which causes us to find that there is no likelihood of confusion. Put quite simply, we believe that opposer's mark TIGER is so dissimilar from applicant's mark TIGER SHARK that there is no likelihood of confusion. Our primary reviewing Court has made it clear that in appropriate cases, one DuPont factor can outweigh all of the other factors. Kellogg Co. v. Pack'em Enterprises, 951 F.2d 330, 21 USPQ2d 1142, 1144 (Fed. Cir. 1991). This is "especially [true] when that single factor is the dissimilarity of the marks." Champagne Louis Roederer v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998). In Champagne Louis, the Court affirmed a decision of this Board in which it was found that the contemporaneous use by applicant of CRYSTAL CREEK for wine and by opposer of CRISTAL for wine would not result in a likelihood of confusion.

We find that the dissimilarities in visual appearance, pronunciation and especially meaning between applicant's mark TIGER SHARK and opposer's mark TIGER are, if anything, greater than the differences in the marks CRYSTAL CREEK and CRISTAL. In the present case as in Champagne Louis, applicant's mark consists of two words, with the first word

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being identical or nearly identical to the one word mark of opposer. Put quite simply, we find that the presence of SHARK in applicant's mark, like the presence of CREEK in the prior applicant's mark, causes the mark to be dissimilar from opposer's mark TIGER in terms of visual appearance and pronunciation.

More importantly, in terms of meaning, the differences between TIGER SHARK and TIGER are vast. The term "tiger shark" is a common term which is defined as "a large very voracious gray or brown stocky-bodied shark that is often a man-eater." Webster's Third New International Dictionary (1993). A tiger shark is totally different from a tiger. Moreover, tigers and sharks are well known animals, even to young children. Even if a youth purchasing a watch did not know exactly what a tiger shark was, we believe that her or she would, at a minimum, know that it is a type of shark, and not a tiger.

The dictionary lists numerous animals whose names consist of two words with the first word being "tiger." These include the following: tiger bass; tiger beetle; tiger butterfly; tiger finch; tiger fish; tiger frog; tiger mosquito; tiger moth; tiger python; tiger rattlesnake; tiger salamander; tiger shark; tiger snake; tiger swallowtail; tiger weasel; and tiger wolf. Id. We believe that even an unsophisticated purchaser would distinguish between a tiger

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and any of the forgoing animals. More importantly, we believe that a youth or other unsophisticated purchaser would not assume that a watch bearing the mark TIGER and a watch bearing the mark TIGER SHARK would emanate from a common source.

In making our finding of no likelihood of confusion, we have not ignored opposer's argument that "TIGER SHARK is likely to be viewed as part of the TIGER line intended for water sports wear." (Opposer's brief page 5). Two comments are in order. First, opposer has offered no proof that consumers would perceive TIGER SHARK watches as a line extension of TIGER watches. Second, in any event, opposer's own advertisements repeatedly tout the fact that opposer's TIGER watches are "water-resistant and pressure-proof to 200 meters." (Opposer's exhibits 5, 11 and 23). Opposer has already promoted its existing TIGER line of watches as being fit for water sports wear, and thus there would be no need for opposer to come out with a TIGER SHARK line of watches for water sports wear.

We hasten to add that neither in its briefs nor at the oral hearing did opposer contend that its TIGER mark was famous. To be clear, at pages 7 and 8 of its brief and at page 3 of its reply brief opposer has argued that its "TIGER mark is strong." Opposer makes this argument on the basis that TIGER as applied to watches is arbitrary; that there is

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no evidence of third-party use of other TIGER marks for watches; and that opposer has submitted copies of its various advertisements for its TIGER watches.

To begin with, we note that the fact that a mark is arbitrary and not used by others does not make the mark famous. Moreover, the advertisements which opposer has made of record (exhibits 2-18) actually undercut any possible claim of fame for the TIGER mark, a claim which opposer has not even made. In virtually all of these ads, the mark TIGER is barely visible and generally appears in very small lettering on the face of a watch which is depicted within the ad. The primary focus of these ads is on the famous golfer Tiger Woods. In addition, even if the mark TIGER had been more prominently displayed in these ads (which it has not), opposer has submitted no evidence of the extent of distribution of these advertisements. Finally, opposer has provided no sales and advertisement figures with regard to its TIGER brand of watches.

In short, in finding that there is no likelihood of confusion, we have done so on the basis that opposer has never even claimed, much less even remotely proven, that its TIGER mark is famous.

Decision: The opposition is dismissed.