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Paper No. 29
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

No Fear, Inc.
v.
Frank Scott White

Opposition No. **106,928**
to application Serial No. **75/193,223**
filed on **October 21, 1996**

**Kit M. Stetina and Darren S. Rimer of Stetina Brunda
Garred & Brucker for No Fear, Inc.**

**Ernest Kettelson of Kettelson Law Offices, Ltd. for Frank
Scott White.**

Before **Cissel, Quinn and Hairston**, Administrative
Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

Frank Scott White has filed an application to
register the mark SNOW FEAR for "clothing articles,
namely T-shirts, Sweat Shirts and Hats."¹

Registration has been opposed by No Fear, Inc.
on the ground that since long prior to the filing date of

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applicant's application, opposer has used the marks NO FEAR and NO FEAR and design for a wide variety of wearing apparel and other products; and that applicant's mark SNOW FEAR, when used in connection with the identified goods, so resembles opposer's previously used and registered marks for its products as to be likely to cause confusion, mistake or deception. Opposer has pleaded ownership of a number of registrations for its marks, the most pertinent of which are: Registration No. 1,737,420 issued December 1, 1992 (Section 8 affidavit filed) for the mark NO FEAR and design as set forth below,

for "decals" in class 16; "wearing apparel; namely, T-shirts, shirts, shorts, pants, sweat shirts, sweat pants, hats, visors, shoes, sandals, and belts" in class 25; and surfboards, skateboards, surf leashes, and protective

¹ Serial No. 75/193,223 filed October 21, 1996, alleging dates

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articles; namely, knee pads, elbow pads, and helmets for use in skateboarding" in class 23; Registration No. 1,842,402 issued June 23, 1994 (Sections 8 & 15 affidavit filed) for the mark NO FEAR and design as shown below,

for "footwear; namely, shoes, sandals, and thongs;" Registration No. 1,855,031 issued September 20, 1994 (Sections 8 & 15 affidavit) for the mark NO FEAR in typed capital letters for "jewelry; namely, watches, bracelets, earrings and anklets" in class 14; "clothing and footwear, namely, pants, shirts, shorts, T-shirts, bathing suits, jackets, sweat shirts, visors, sandals and shoes" in class 25; Registration No. 1,856,752 issued October 4, 1994 (Sections 8 & 15 affidavit filed) for the mark NO FEAR and design as shown below,

of first use and first use in commerce on September 1, 1995.

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for "printed matter, namely decals" in class 16 and "wearing apparel, namely, T-shirts, shirts, sweatshirts, tank tops, shorts, pants, visors, swim trunks, shoes and caps" in class 25; Registration No. 1,978,563 issued June 4, 1996 for the mark NO FEAR and the design of a man on a bike, as shown below,

for "wearing apparel, namely shorts, pants, shirts, T-shirts, sweat shirts, sweatpants, visors, belts and shoes"; Registration No. 1,978,596 issued June 4, 1996 (Sections 8 & 15 affidavit filed) for the mark NO FEAR and design as shown below,

for "wearing apparel, namely T-shirts, shirts, shorts, pants, sweatshirts, sweatpants, hats, visors, shoes, thong footwear and belts;" and Registration No. 1,978,597

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issued June 4, 1996 (Sections & 15 affidavit filed) for the mark NO FEAR and design as shown below,

for "wearing apparel; namely, T-shirts, shirts, shorts, pants, sweatshirts, sweatpants, hats, visors, shoes, thong footwear, and belts."

Applicant, in its answer, denied the salient allegations in the notice of opposition.

We must first consider opposer's objections to certain materials submitted by applicant under notice of reliance. In particular, opposer objects to applicant's submission of the specimens in the involved application, citing Trademark Rule 2.122(b)(2) which provides, in pertinent part, that "specimens in the file of an application for registration

. . . are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for taking testimony."

Further, opposer objects to the submission of applicant's responses to opposer's request for production of documents, pointing out that there is no provision in the Trademark Rules of Practice for applicant to introduce

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its own responses to a request for production of documents. Finally, opposer objects to the submission of applicant's responses to all of opposer's interrogatories on the ground that opposer made of record applicant's responses to only certain of opposer's interrogatories and that applicant failed to provide, as required by Trademark Rule 2.120(j)(5), a written statement explaining any reasons why applicant needed to rely on the additional discovery responses. For the reasons set forth by opposer, each of its objections to the above materials is well taken. In view thereof, the materials do not form part of the record in this case and we have not considered the materials in reaching our decision herein.

The record includes the pleadings; the file of the involved application; and the testimony (with exhibits) of opposer's vice president, Marty Moates. Opposer also submitted under notice of reliance applicant's responses to certain of opposer's discovery requests; the discovery deposition of applicant Frank Scott White; and copies of excerpts from printed publications.

Applicant did not take testimony. However, applicant submitted under notice of reliance a declaration executed by opposer's vice president Marty

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Moates. While such a declaration was not stipulated in writing (See Trademark Rule 2.123(b) and further, is not proper subject matter for a notice of reliance, we note that opposer did not object to the declaration, but has instead treated it as of record. Thus, we will we treat the declaration as part of the record in this case.

The parties have fully briefed the case, but no oral hearing was requested.

The record shows that opposer is in the business of manufacturing, marketing, merchandising and licensing goods and services under the NO FEAR and NO FEAR and design marks.

Opposer's vice president, Marty Moates testified that opposer adopted the NO FEAR mark to establish a brand recognition and source indication of a particular positive image or attitude, namely encouraging sports enthusiasts to face their fears, live their dreams and to push themselves harder. Opposer began business in 1990 and its total sales have exceeded \$500,000,000. For the past several years, opposer's sales have been approximately \$50,000,000 per year. According to Mr. Moates, the majority of opposer's sales are for T-shirts, sweatshirts and caps, all of which bear one of opposer's NO FEAR registered marks. Opposer sells its wearing

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apparel items to over 14,000 retail outlets, including stores such as Nordstrom, Macy's, JCPenny's, Miller Outpost, Gadzooks, and Brass Buckle. Opposer also sells its wearing apparel items at sporting goods stores and ski shops. The goods are relatively inexpensive; opposer's T-shirts retail for around \$16.00 and its sweatshirts retail for around \$44.00.

Opposer spends approximately \$12,000,000 per year advertising its products. Opposer has advertised during the Super Bowl, on ESPN, and on a monthly basis in magazines such as NASCAR, Bike, Surfer, Football, Basketball, BMX, Motocross, Mountain Bike, Surfing, Formula 1, and Racer. Opposer also promotes its products and image through over 140 sports figures in the United States and around the world. Many of opposer's advertisements show athletes engaged in action sports or winter sports such as skiing, snowmobiling and the like. Opposer has engaged in cross-promotions with such companies as Burger King, Coca-Cola, Sprite, Chrysler Corporation, Mars Candy Company and Pepsi.

Opposer has vigorously protected its trademarks against counterfeiters and infringers. Opposer is a member of the International Anti-Counterfeiting Coalition

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and in 1997 alone opposer spent \$1,100,000 enforcing its trademark rights.

Applicant Frank Scott White testified during his discovery deposition that he sells T-shirts, sweatshirts, hats and decals under the mark SNOW FEAR. According to Mr. White, he adopted the SNOW FEAR mark several years prior to 2000 and it was his intent to encourage people to get out and go in the snow more. Applicant's goods are primarily marketed for winter activities and the goods are primarily sold at ski shops, snowmobiling shops and by direct sales. Mr. White testified that he sells between one and fifty SNOW FEAR T-shirts and sweatshirts on average per month. Applicant's T-shirts and sweatshirts generally feature a slogan on the back. Applicant's sweatshirts retail for about \$25.00 and his T-shirts and hats retail for under \$20.00. Applicant has advertised in two magazines, namely Snow West and Mod-Stock.

Priority of use is not in issue inasmuch as opposer introduced copies of its pleaded registrations through the testimony of Mr. Moates and he testified that each of the registrations is subsisting and owned by opposer. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Each of opposer's

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pleaded registrations on the Principal Register is prima facie evidence of the use of the mark shown therein for the goods identified in the registration since the filing date of the application, which matured into the registration. See *Andrea Radio Corp. v. Premium Import Co., Inc.*, 191 USPQ 232 (TTAB 1976).

This brings us to the issue of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all the relevant and probative facts in evidence. In re *E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning first to the goods, applicant's T-shirts, sweatshirts and hats are identical and otherwise closely related to the wearing apparel items listed in opposer's pleaded registrations. There being no limitations in the identification of goods in either applicant's application or opposer's registrations, it must be presumed that both parties' wearing apparel would travel in all the normal channels of trade for such goods (e.g., general sporting goods stores, specialty sporting goods shops, department stores, and mass merchandisers), and be sold to all the usual purchasers for goods of this nature, namely, the general public.

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We turn next to a consideration of the marks. The test for confusing similarity is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). The marks at issue may not be dissected but rather must be considered in their entireties. However, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

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Applying the above principles to the marks at issue, we find that applicant's mark SNOW FEAR and opposer's marks NO FEAR and NO FEAR and design are substantially similar in commercial appearance, sound and connotation. Applicant's mark and the word portion of opposer's marks follow the same pattern - a one syllable word followed by the word FEAR. Moreover, the marks sound alike because SNOW and NO rhyme. The word FEAR is the dominant portion of applicant's and opposer's marks and the portion most likely to be remembered by consumers. In addition, applicant's and opposer's marks have similar connotations in that they encourage persons to overcome their fears. Further, opposer's NO FEAR marks are inherently distinctive, and the evidence of record indicates that opposer's use and promotion of the marks for wearing apparel has been extensive, with the result that the marks have acquired considerable goodwill and strength. Thus, opposer's marks are entitled to a broad scope of protection. As to applicant's argument in its brief that marks including the word "FEAR" are weak marks, applicant offered no evidence of third-party uses of marks including the word

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"FEAR" for goods of the type involved here.²

While we recognize that there have been no instances of actual confusion, we are cognizant that instances of actual confusion are difficult to discover. More importantly, we cannot conclude on the limited evidence of use of applicant's mark that there has been any meaningful opportunity for confusion to have occurred. In any event, the test under Section 2(d) of the Trademark Act is not actual confusion, but likelihood of confusion.

In view of the foregoing, we conclude that purchasers familiar with opposer's T-shirts, sweatshirts, caps and other items of wearing apparel offered under the marks NO FEAR and NO FEAR and design would be likely to believe, upon encountering applicant's mark SNOW FEAR for T-shirts, sweatshirts, and hats, that the goods originate

² A mere list of third-party registrations in a brief is not the proper way to make such registrations of record. Rather, plain copies of the registrations themselves or the electronic equivalent thereof must be submitted during the offering party's testimony period. Moreover, even if applicant had properly made the registrations of record, we should point out that third-party registrations, in and of themselves, are entitled to little weight in evaluating whether there is a likelihood of confusion. See, e.g. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). This is because third-party registrations are not evidence of what happens in the marketplace. Also, we should note that none of the "FEAR" marks listed in applicant's brief is as similar to opposer's marks as is applicant's mark.

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with or are somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained.