

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mighty Fine

v.

Sayaka W. Draper

Opposition No. 119,943
against Application No. 75/831,116,
filed October 22, 1999

Jill M. Pietrini of Manatt, Phelps & Phillips, LLP for
Mighty Fine.

Matthew Miller for Sayaka W. Draper.

Before Simms, Cissel and Quinn, Administrative Trademark
Judges:

Opinion by Simms:

Mighty Fine (opposer), a California corporation, has
opposed the application of Sayaka W. Draper (applicant), a
California sole proprietorship, to register the mark
MIGHTYFINE for various items of men's, women's and

children's apparel.¹ Applicant has submitted an answer. Only opposer took testimony and submitted evidence.² Only opposer filed a brief, and no oral hearing was requested.

In the notice of opposition, opposer asserts that it has used the mark FINE since as early as June 6, 1994, for T-shirts, sportswear, and active wear; that it has used the trade name and trademark MIGHTY FINE for clothing since June 6, 1994; that it has filed applications to register those marks; that opposer has developed extensive goodwill in those marks; and that applicant's mark so resembles opposer's trade names and marks as to be likely to cause confusion, to cause mistake or to deceive. In its answer, application has denied these allegations, but has asserted

¹Application Serial No. 75/831,116, filed October 22, 1999, based upon applicant's allegation of a bona fide intention to use the mark in commerce. The specific goods listed in the application are "hats, caps, visors, hoods, berets, head bands, sweat bands, ear muffs, gloves, mittens, wrist bands, suspenders, belts, socks, stockings, pantyhose, bodysuits, leotards, leggings, sweat socks, thermal socks, shoes, sneakers, galoshes, waders, boots, sandals, slippers, kerchiefs, scarves, mufflers, bandannas, neckerchiefs, vests, pajamas, robes, kimonos, caftans, smocks, aprons, boxer shorts, briefs, underpants, corsets, corselets, girdles, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees, peignoirs, shirts, blouses, knit tops, dresses, skirts, jumpsuits, pant suits, rompers, swimming trunks, wet suits, thermal underwear, undershirts, tunics, tank tops, cotton woven shirts, knit shirts, polo shirts, T-shirts, sweat shirts, crew neck sweaters, v-neck sweaters, turtleneck sweaters, cardigans, suits, jogging suits, shorts, sweat shorts, jeans, pants, slacks, trousers, sweat pants, ski suits, ski pants, ski bibs, capes, shawls, blazers, waistcoats, rain coats, overcoats, top coats, sport coats, parkas, bolero jackets, jackets, wind resistant jackets, outer jackets, leather jackets, ski jackets, flannel jackets, wool jackets, polyester woven shirts, rayon woven shirts, wool woven shirts, leather coats, elastic waist shorts, fixed waist shorts, denim shorts, and denim jackets."

²On the last day for taking testimony, applicant submitted a motion to extend its testimony period. The Board denied that motion.

that the mark FINE is common in the clothing field, with many third-party registrations and uses, and that it cannot be a distinctive trademark of opposer. Further, applicant asserts that opposer has no proprietary rights in the mark MIGHTY FINE and that applicant's interstate use and filing date precedes opposer's use of this mark.³

Opposer has submitted the testimony of its president and a notice of reliance on applicant's discovery responses, printed publications and official records, including its own applications.

According to the testimony of Stacy Lynn Kitchin, opposer's president, opposer began business as a sole proprietorship under the trade name Fine in Hawaii in 1992 or 1993. Kitchin dep., 9. At that time, opposer sold T-shirts under the trademark FINE. When Ms. Kitchin moved to California in June 1994, she began selling T-shirts at (night)club events and raves (music parties for young adults). Later, opposer sold other goods under the mark FINE such as skirts, dresses, pants, lingerie and accessories. Opposer obtained orders for merchandise at trade shows held in 1994 or 1995. Kitchin dep., 32.

³ Because applicant introduced no testimony or evidence and failed to file a brief, we consider these defenses to have been waived.

Opposer started using the trade name and mark MIGHTY FINE in 1999 (Kitchin dep., 17) and it is now the main trade name under which opposer does business (Kitchin dep., 250). Opposer first used the mark MIGHTY FINE on T-shirts in 1999 and expanded its goods to include pants, skirts and tops. Kitchin dep., 71. Ms. Kitchin identified Exhibit 56 as an item of clothing bearing the mark MIGHTY FINE sold in 1999. Kitchin dep., 263. Opposer displayed its MIGHTY FINE merchandise at a trade show in June 1999. Kitchin dep., 83. Opposer now sells its goods under this mark as a private label (Kitchin dep., 225), and presents this mark and goods at licensing trade shows (Kitchin dep., 226). Opposer's sales under this mark are not as great as those under the FINE mark. Kitchin dep., 240. Opposer has also introduced invoices (Exhibit 19) from the spring and summer of 1999 evidencing sales of MIGHTY FINE merchandise, as well as a 1999 catalog displaying its MIGHTY FINE goods (Kitchin dep., 81-2).⁴

In addition to trade shows, opposer uses its trade names and marks and promotes its goods by mail-order catalogs, posters, business cards which use various trade names (Fine, Mighty Fine, etc.), point-of-purchase

⁴ Corroborating opposer's first trade name use is Exhibit 23, an October 1998 permit for an alarm listing Mighty Fine as the applicant.

displays, letterheads, invoices and magazine advertisements. Opposer now also sells its goods over the Internet. Ms. Kitchin also testified that opposer's apparel has been the subject of some unsolicited publicity.

Ms. Kitchin stated that in opposer's application to register the mark MIGHTY FINE, opposer incorrectly stated the date of first use to be June 1994.⁵ Ms. Kitchin testified that this application was prepared by another employee, and that this mistake was apparently caused by confusing the date of first use of this mark with the date of first use of the mark FINE (June 1994). Kitchin dep., 87. She testified that this mistake was an honest one not made with an intent to deceive the Office. Kitchin dep., 260. She stated that the correct date of first use of the mark MIGHTY FINE should be 1998 or perhaps January or February of 1999. Kitchin dep., 70, 88, 202, and 253.

Opposer also testified concerning use of such marks as DOE BY MIGHTY FINE, used as both a trade name and a trademark since 2000 (Kitchin dep., 186-87), and the mark FINETUNING, used since 1997 or 1998 for T-shirts designed to be worn by deejays. Kitchin dep., 16. Opposer does not currently display any FINETUNING goods at trade shows.

⁵ The incorrect date was also pleaded in the notice of opposition.

Opposer became aware of applicant's use in 2000 when a Canadian distributor noticed one of applicant's advertisements in *Vice* magazine, a magazine in which opposer also advertises. Ms. Kitchin also testified that she received an invoice from a vendor for a bounced check fee that was being billed to opposer (Kitchin dep., 179). Also, two or three customers, after returning from trade shows, have asked opposer if it was related to applicant. Kitchin dep., 180. Finally, Ms. Kitchin testified that people have asked for applicant at opposer's trade show booths.

As noted above, only opposer submitted a brief. Opposer argues essentially that it has priority (use before applicant's filing date) and that applicant's mark is likely to be confused with all of opposer's marks--FINE, MIGHTY FINE, DOE BY MIGHTY FINE and FINETUNING. Opposer also argues that it has a family of FINE marks. However, this allegation was not pleaded and we do not believe that this issue can be considered tried merely by the introduction of a few advertisements in which some of opposer's marks appear. We shall determine this case on

the basis of opposer's use of the virtually identical mark MIGHTY FINE.⁶

First, the record establishes that opposer began use of the trade name and mark MIGHTY FINE in 1998 to early 1999, with displays at a trade show in June 1999, prior to applicant's filing date, the earliest date which applicant may claim. See also applicant's response to Req. for Admission 21.

As opposer has argued, these marks are virtually identical in appearance, and are identical in sound and meaning. Also, some of applicant's goods are identical to those on which opposer has previously used its mark MIGHTY FINE. Other goods of applicant are closely related. Further, there is no limitation in applicant's application as to channels of trade and classes of purchasers. Moreover, the testimony shows that the parties both offer their clothing at the same trade shows and have advertised in the same magazines to the same class of purchasers. In addition, these items of clothing are relatively inexpensive and would be purchased without much consideration by members of general public. The testimony

⁶We note that opposer cannot establish use of the mark DOE BY MIGHTY FINE prior to applicant's filing date of October 22, 1999. Opposer's testimony reveals that opposer began use of this mark in 2000. As to the mark FINETUNING, while opposer has priority with respect to this mark, it appears that opposer's current use of this mark is minimal with no current promotion of goods under this mark.

reveals that opposer received at least one piece of misdirected mail and that individuals at trade shows have asked whether there was an association between the parties.

While opposer has argued that applicant adopted its mark with knowledge of opposer's use of the FINE mark in order to trade off of opposer's reputation, suffice it to say that the testimony and other evidence is not persuasive in that regard. Nevertheless, we conclude that applicant's mark MIGHTYFINE for its items of men's, women's and children's apparel so resembles opposer's previously used trade name and mark MIGHTY FINE used in connection with similar items of clothing so as to be likely to cause confusion.

The opposition is sustained and registration to applicant is refused.