

4/11/02

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

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

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Opposition No. 121,820

Fashion Boom, Inc.

v.

Gap (Apparel) Inc.

Before Cissel, Hairston and Walters,  
Administrative Trademark Judges.

By the Board:

Fashion Boom. Inc. has opposed the application of  
GAP (Apparel) Inc. to register the mark shown below for

Anoraks, shortalls, jeans, khaki pants,  
trousers, fleece tops, coats, rainwear, shawls,  
lingerie, robes, sleepwear, pajamas and  
nightgowns, brassieres, underwear, shapers,  
undergarments, boxer shorts, sport bras, gym  
shorts, camisoles, slips, bodysuits, tank tops,  
sweatshirts, sweat pants, tankinis, bikinis,  
bathing suits, swim trunks, leggings, slippers,  
caps.<sup>1</sup>



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In its notice of opposition, opposer asserts that it is the

owner of the mark **AMERICAN CONNECTION** for

men's, women's and children's wearing apparel, namely, pants, shirts, blouses, jackets, vests, T-shirts, skirts, shorts, sweaters, scarves, dresses, jumpsuits and rompers.<sup>2</sup>

Opposer further asserts that it is the owner of the mark shown below for

Anoraks, shortalls, jeans, khaki pants, trousers, fleece tops, coats, rainwear, shawls, lingerie, robes, sleepwear, pajamas and nightgowns, brassieres, underwear, shapers, undergarments, boxer shorts, sport bras, gym shorts, camisoles, slippers, bodysuits, tank tops, sweatshirts, sweat pants, tankinis, bikinis, bathing suits, swim trunks, leggings, slippers, caps.<sup>3</sup>



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<sup>1</sup> Application Serial No. 76/037,688 was filed on May 1, 2000, reciting December 1988 as the date of first use of the mark anywhere and in commerce.

<sup>2</sup> Registration No. 2,012,040 was registered on October 29, 1996, reciting June 10, 1995 as the date of first use of the mark anywhere and in commerce.

<sup>3</sup> Application Serial No. 78/041,974 was filed on January 6, 2001, reciting July 1997 as the date of first use of the mark anywhere and in commerce.

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Opposer alleges that it has made use of the mark "AC in the square" long prior to applicant's first use; that its mark "AC in the square" is highly similar in appearance to applicant's mark "GAP in the square"; that opposer uses, licenses, and authorizes use of its mark "AC in the square"

on goods that are identical in part to those identified by applicant's mark; that, as a result, confusion, mistake, and deception are likely among consumers as to the source of those goods; that opposer's "AC in the square" mark is famous; and that registration of applicant's mark "will result in the dilution of the descriptive quality of Opposer's marks".

In lieu of an answer, applicant filed a motion to dismiss the proceeding under Fed. R. Civ. P. 12(b)(6), for failure to state a claim upon which relief may be granted. Opposer filed a brief in opposition to the motion. In addition, applicant submitted a reply brief. All of the papers filed by the parties in connection with the motion to dismiss are supported by exhibits. Accordingly, the Board issued an order (1) notifying the parties that the Board would consider the exhibits submitted by the parties in our determination of

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applicant's motion to dismiss; (2) indicating that, as a result, the motion to dismiss would be treated as a motion for summary judgment; and (3) allowing the parties time in which to submit additional materials made pertinent to the motion for summary judgment by Fed. R. Civ. P. 56. Consequently, applicant submitted additional exhibits supported by the declaration of Julie Gruber, its Vice President and Senior Corporate Counsel.

In support of its motion for summary judgment, applicant argues that while opposer claims prior use of its "AC in the square" mark, opposer's application Serial No. 78/041,974 recites July 1997 as the date of first use of the mark in commerce; that applicant has made use of its "GAP in the square" mark since December 1988; and that, as a result, opposer cannot establish priority of use for purposes of its claim under Section 2(d). Applicant has submitted a printed copy of its search of the U.S. Trademark Electronic Search System (TESS) for opposer's pleaded "AC in the square" mark.

In response, opposer essentially argues that it has made use of its "AC in the square" mark since July 1997; and that confusion is likely among consumers due to the similarities between its "AC in the square" mark and applicant's "GAP in the square" mark. Opposer has

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submitted a printed copy of its search of the U.S. Trademark Electronic Search System (TESS) for applicant's Registration No. 1,745,875 for the mark GAP and design.<sup>4</sup>

Applicant argues in reply that it never received a filing receipt from this Office for its application Serial No. 76/037,688, at issue herein; that when application Serial No. 76/037,688 was published for opposition in the Official Gazette, applicant's dates of first use anywhere and in commerce were mistakenly listed as December 1998; that applicant's correct dates of first use anywhere and in commerce, as indicated in its application, are December 1988; and that it subsequently requested from the Office an amended filing receipt indicating applicant's correct dates of first use. Applicant submits a copy of its letter to the Office requesting an amended filing receipt for its application Serial No. 76/037,688; and a photocopy of page 300 of the December 12, 2000 Official Gazette displaying applicant's application Serial No. 76/037,688.

As indicated above, applicant further supported its motion with the declaration of Julie Gruber, attesting to

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<sup>4</sup> The Board notes that while applicant pleads ownership of Registration No. 1,745,875 for the mark GAP and design in its

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the foregoing and including additional copies of the above noted exhibits.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and *Octocom Systems Inc. v.*

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motion for summary judgment, said registration is not the subject of any Board proceeding.

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*Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Turning first to the issue of priority, we note as a preliminary matter that Parmani, Ltd., a New York corporation, is listed as the owner of opposer's asserted application Serial No. 78/041,974 for the mark "AC in the square". We further note that neither Office records nor any papers filed in the instant proceeding clarify the nature of the relationship between Parmani, Ltd. and opposer.<sup>5</sup> Thus, on the record before the Board, there is nothing to indicate the basis for opposer's claim of ownership of application Serial No. 78/041,974.

Nonetheless, opposer asserts that it has made use of the mark "AC in the square" since July 1997. We note that opposer has not supported its assertion by evidence, affidavit or declaration. However, applicant does not dispute that opposer is entitled to claim July 1997 as the date of first use of the "AC in the square" mark.

On the other hand, applicant has submitted the declaration of Julie Gruber, its Vice President and Corporate Counsel, asserting, *inter alia*, that it has made use of its "GAP in the square" mark since December

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1988. Further, opposer neither alleges nor introduces evidence that applicant is not entitled to rely upon its asserted date of first use.

Accordingly, we find no genuine issue that applicant has made use of its "GAP in the square" mark prior to opposer's use of its asserted "AC in the square" mark. Therefore we find, as a matter of law, that opposer cannot establish priority for purposes of its claim of likelihood of confusion based upon its asserted use of the mark "AC in the square".

We note that applicant's motion for summary judgment is directed solely toward the issue of priority. However, upon careful review of the record in this proceeding, we find no genuine issue with regard to the remaining issues of likelihood of confusion and dilution. Therefore, in accordance with our inherent authority to schedule the disposition of cases on our docket, the Board will make a determination with regard to likelihood of confusion and dilution at this time.

Turning now to likelihood of confusion, it is well settled that the determination of whether a likelihood of confusion exists is made by evaluating and balancing the

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<sup>5</sup> We note in addition that application Serial No. 78/041,974 was abandoned on February 21, 2002 for failure to respond to an Office action.

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pertinent *du Pont* evidentiary factors. See *In re E. I. du Pont de Nemours*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In other words, not every factor is equally important to the likelihood of confusion analysis in every case. Indeed, our principal reviewing court and this Board frequently has held, in appropriate cases, that a single *du Pont* factor may be dispositive of the likelihood of confusion analysis. See, e.g., *Kellogg Co. v. Pack 'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)(dissimilarity of the marks under the first *du Pont* factor held dispositive); *Keebler Co. V. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (dissimilarity of the marks dispositive); and *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 USPQ2d 1227 (TTAB 1992)(dissimilarity between the marks dispositive).

After a careful review of the record in this case, we believe that application of the first *du Pont* factor, i.e., the similarity or dissimilarity of the marks in their entireties, is dispositive of this proceeding. There is no genuine issue as to the fact that opposer's pleaded mark is "AC" inside the design of a square, while applicant's mark is "GAP" inside the design of a square.

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The only similarity between the two is the square design element. However, the word portions of the marks are decidedly different. The wording "GAP" in applicant's mark and "AC" in that of opposer convey highly dissimilar commercial impressions.

Furthermore, it is well settled that when a mark consists of a word portion and a design portion, as do the marks under consideration herein, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *See, for example, Amoco Oil Co., v. Amerco, Inc.* 192 USPQ 729 (TTAB 1976). We are, therefore, of the opinion that the marks, when considered in their entireties, are not so similar in appearance, sound, connotation or meaning that their use by different parties will result in confusion.<sup>6</sup> Moreover, opposer has not disclosed any evidence that it could produce at trial which

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<sup>6</sup> We note that while opposer pleads ownership of Registration No. 2,012,040 for the mark AMERICAN CONNECTION, it does not appear from the notice of opposition that opposer is asserting likelihood of confusion between the mark in its registration and applicant's "GAP in the square" mark. To the extent that the notice of opposition may be construed to assert such a claim, we find, in accordance with the above discussion, that the dissimilarity between the marks AMERICAN CONNECTION and GAP inside a square design element is so great that this *du Pont* factor outweighs all others in mitigating against a finding of likelihood of confusion.

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would reasonably be expected to cause us to reach a different conclusion. The first *du Pont* factor simply outweighs all of the others that might be relevant in this case.

We turn finally to opposer's claim of dilution. The Board has recently held that in order to prevail in a claim of dilution, an owner of an allegedly famous mark must make a showing that (1) the other party's use is in commerce; (2) the other party adopted its mark after the plaintiff's mark became famous; (3) plaintiff's mark is famous; and (4) the other party diluted the mark. See Section 43(c) of the Trademark Act; and *The Toro Company v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).

In this case, as discussed above, we find no genuine issue that applicant adopted its mark prior to opposer's adoption of its allegedly famous mark. Inasmuch as applicant has made prior use of its mark, we find no genuine issue that applicant adopted its mark before opposer's mark allegedly became famous. Accordingly, as a matter of law, we find that opposer cannot prevail in its dilution claim because opposer cannot make a showing that applicant adopted its "GAP in the square" mark subsequent to the time opposer's "AC in the square" mark allegedly became famous. See *Id.*

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In view of the foregoing, and as noted above, we believe that applicant has met its burden of establishing that there is no genuine issue of material fact as to priority. Furthermore, we find no genuine issue of material fact as to likelihood of confusion and dilution. Accordingly, applicant is entitled to judgment on these questions as a matter of law. See Fed. R. Civ. P. 56(c) and (e). Applicant's motion for summary judgment is hereby granted and the opposition is dismissed with prejudice. The application file shall be forwarded to registration in due course.