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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Minnesota Timberwolves Basketball Limited Partnership
v.
Paul R. Mikus

Opposition No. 91117391
to Application Serial No. 75556676

Ayala Deutsch of NBA Properties, Inc. for Minnesota
Timberwolves Basketball Limited Partnership.

Gary L. Eastman of Eastman & Associates for Paul R. Mikus.

Before Seeherman, Chapman, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 23, 1998, Paul R. Mikus (applicant)
applied to register the mark shown below for "headgear,
namely hats; and clothing, namely shirts" in International
Class 25.



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The application (Serial No. 75556676) originally was based on an allegation of a bona fide intent to use the mark in commerce. On March 18, 1999, applicant filed an amendment alleging a date of first use anywhere and in commerce of March 11, 1999, which was accepted by the USPTO.

Minnesota Timberwolves Basketball Limited Partnership (opposer) has opposed registration on the ground that applicant's mark "so resembles the Timberwolves Marks as to be likely, when applied to Applicant's goods, to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's goods originate from the same source as Opposer's goods and services, or are authorized, endorsed or sponsored by, or in some way connected with Opposer." Notice of Opposition at 3. Opposer referred to the following relevant registrations, all for the mark shown below, for:



Clothing, namely, hosiery[,] footwear, T-shirts, sweatshirts, sweatpants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters, belts, ties, nightshirts, hats, warm-up suits, jackets, parkas, coats, cloth bibs, head bands, wrist bands, aprons, boxer shorts, slacks, caps, ear muffs, and gloves in International Class 25;¹

¹ Registration No. 2,217,540, issued January 12, 1999.

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Entertainment services in the nature of rendering live basketball games and basketball exhibitions, and the production and distribution of radio and television broadcasts of basketball games and exhibitions in International Class 41;²

Publications and printed matter, namely, basketball trading cards, dance team trading cards, mascot trading cards, entertainment trading cards, stickers, decals, commemorative basketball stamps, trading card milk bottle caps, post cards, paper and plastic place mats, note cards, memo pads, ball point pens, pencils, 3-ring binders, stationery folders, wirebound notebooks, portfolio notebooks, unmounted and mounted photographs, posters, calendars, bumper stickers, book covers, gift wrapping paper, children's activity books, statistical books, guide books and reference books for basketball, magazines in the field of basketball, commemorative game programs, paper pennants, stationery, stationery-type portfolios, and statistical sheets for basketball topics, newsletters and pamphlets in the field of basketball for distribution to the television and radio media in International Class 16;³ and

Pre-recorded audio, video, and laser discs, audio and video tapes, audio and video cassettes, and compact discs featuring basketball; computer software, namely, screen saving programs and multimedia programs providing information, statistics and trivia on basketball in International Class 9.⁴

Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the pleadings; the involved application; opposer's notice of reliance on status and

² Registration No. 2,100,073, issued September 23, 1997. Affidavits under Section 8 and 15, accepted and acknowledged, respectively.

³ Registration No. 2,139,472, issued February 24, 1998, Affidavits under Section 8 and 15, accepted and acknowledged, respectively.

⁴ Registration No. 2,263,346; issued July 20, 1999.

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title copies of its registrations and copies of other registrations; and the trial testimony deposition of Lisa Piken, Senior Manager of Apparel Licensing of NBA Properties (NBAP), Global Merchandising Group,⁵ with exhibits.

Applicant did not submit any evidence during his trial testimony period. Furthermore, applicant did not file a brief and neither party requested an oral hearing.

Preliminary Matters

Because opposer submitted evidence of its use and registration of the marks MT and design, we find that opposer has established its standing to oppose. See, e.g., Lipton Industries, Inc. v. Ralston Purina Company, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, priority is not an issue here in view of opposer's ownership of four registrations for its MT and design marks. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Discussion

Opposer, as plaintiff in the opposition proceeding, bears the burden of proving, by a preponderance of the evidence, likelihood of confusion. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir.

⁵ NBA Properties is the "licensing agent" for the teams of the NBA. Piken dep. at 7.

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2000); Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

In likelihood of confusion cases, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

In its brief, opposer primarily bases its case on an argument that applicant's mark is confusingly similar to opposer's registered mark for goods in International Class 25 (Reg. No. 2,217,540). The goods in that registration include hats and caps, as well as numerous types of shirts (T-Shirts, sweatshirts, jerseys, sport shirts, and rugby shirts). Applicant's identified goods are "headgear, namely, hats; and clothing, namely, shirts." Obviously, both parties' goods include hats, and applicant's shirts would overlap with opposer's shirts to the extent that applicant's shirts would include T-shirts, sweatshirts, jerseys, sport shirts, and rugby shirts. Therefore, opposer's and applicant's goods are identical. When the parties' goods are identical, the Court of Appeals for the Federal Circuit has held that "the degree of similarity necessary to support a conclusion of likely confusion

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declines.” Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Therefore, this factor clearly favors opposer.

Related to the factor regarding the similarity of the goods are the factors concerning channels of trade and purchasers.

There are no restrictions in either the application or registrations so we must assume that the goods travel in “the normal and usual channels of trade and methods of distribution.” CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). See also, Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); Kangol Ltd. v. KangaRoos U.S.A. 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

In this case, both applicant’s and opposer’s goods include hats and shirts. Therefore, we must presume that the prospective channels of trade and prospective purchasers are identical. See Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”). Therefore, the resolution of these factors again favors opposer.

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The next factor we consider is the similarities and dissimilarities in the marks. While we can consider the individual features of the marks, ultimately the question is whether the marks in their entireties are similar. In re Shell Oil, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

The marks at issue here are both for the letters "M" and "T"⁶ and a stylization or design.



The Board has set out a summary of the case law on combinations of letters in the context of determining whether there is a likelihood of confusion. Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530, 533 (TTAB 1986) (double brackets indicate that the full citation was not in the original).

We must also consider the well-established principle of our trademark law that confusion is more likely between arbitrarily arranged letters than between other types of marks. This principle was set forth fifty years ago in the decision of the Court of Customs and Patent Appeals in Crystal Corp. v. Manhattan Chemical Manufacturing Co., 75 F.2d 506, 25 USPQ 5, 6 (1935) wherein the following reasoning was applied in holding

⁶ In its brief (p. 2), opposer refers to applicant's "interlocking MT letter mark." In its notice of opposition (p. 3), opposer described applicant's "wording TM."

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Z.B.T. likely to be confused with T.Z.L.B. for talcum powder.

We think that it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words, or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely.

The same principle has been applied in numerous other decisions of the Court above and of this Board wherein lettered marks comprising two letters in common, used on identical or closely related goods, have been held likely to be confused. Feed Service Corp. v. FS Services, Inc., 432 F.2d 478, 167 USPQ 407 (CCPA 1970) [FSC and FS]; Dere v. Institute for Scientific Information, Inc., 420 F.2d 1068, 153 USPQ 347 (CCPA 1970) [ISI and IAI]; Cluett Peabody & Co. v. J. H. Bonck Co., 390 F.2d 754, 156 USPQ 401 (CCPA 1963) [TTM and T.M.T.]; Helena Rubenstein [[Inc. v. Hudnut, 193 F.2d 207, 92 USPQ 147 (CCPA 1951)] [RHR and HR]; Vitamin Corp. v. American Home Products Corp., 166 F.2d 203, 76 USPQ 611 (CCPA 1948) [VCA and IVC]; [[ECI Division of E-Systems, Inc. v. Environmental Communications, Inc., 207 USPQ 443 (TTAB 1980)] [ECI and EC]; Sales Analysis Institute, Inc. v. Sales Training, Inc., 181 USPQ 341 (TTAB 1973) [SAI and STI]; American Optical Corp. v. Southwest Petro-Chem, Inc., 175 USPQ 317 (TTAB 1972) [AOC and AO]; Scott Forsman & Co. v. Scientific Film Co., 165 USPQ 287 (TTAB 1970), aff'd, Scientific Film Co. v. Scott Forsman & Co., 171 USPQ 525 (N.D. Ill., 1971) [SFC and SF]; Chemetron Corp. v. NRG Corp., 157 USPQ 111 (TTAB 1968) [NRG and NCG]; Chemetron Corp. v. Matsuo Electric Co., 153 USPQ 372 (TTAB 1967) [NCC and NCG]; Cities Service Oil Co. v. A.W. Chesterton Co., 127 USPQ 459 (TTAB 1960) [DSC and DC]; Mutual Citrus Products Co. v. Pacific Citrus Products Co., 74 USPQ 241 (Com'r Pats., 1947) [PCP and M.C.P.].

The Court of Appeals for the Federal Circuit has also held that it "is especially hard to distinguish between TMS and TMM when the marks only differ by the last letter. Because it is hard to distinguish between these letters, the mark TMM is confusing with TMS." Weiss Associates Inc. v. HRL

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Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990).

When we apply these principles, we note that both opposer's and applicant's marks are for the same letters "M" and "T." Both marks are also depicted in stylized lettering.⁷ The letters are not depicted in the normal left-to-right, English language order, i.e., MT or TM. Instead, they are superimposed on each other. Therefore, it is not clear how prospective purchasers will view the marks. Obviously, prospective purchasers may study the marks and observe that applicant places the base of the "T" on top of the "M," while opposer places the "M" on top of the "T." This may lead some purchasers to conclude that one mark is TM and the other mark is MT. However, we must also consider that a "[s]ide by side comparison is not the test," Grandpa Pigeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973), and that human memories are not infallible, In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). Indeed, for cases involving letters that are initials, it has been held that: "Initials, by their very nature, are abbreviations, a shortened version designed to be comprehended at a glance. If the number of letters is the same, and there is a

⁷ Opposer's mark also includes a somewhat nebulous design element around the letters.

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significant overlap in the letters used, that is generally sufficient to sustain a claim of similarity.” Continental Connector Corp. v. Continental Specialties Corp., 492 F. Supp. 1088, 207 USPQ 60, 66 (D. Conn. 1979) (CCC and CSC similar).

Applying these principles to the case now before us leads us to conclude that the marks are more similar than they are dissimilar. Both marks are for the same letters, displayed in a similar fashion (one letter on top of the other). Visually, the marks look similar, and, to the extent that they are pronounced, many purchasers would pronounce them identically (MT) even if other purchasers would distinguish them as TM and MT. There is no evidence concerning the meanings of the letters but many people may consider them to be just an arbitrary letter string without any specific meaning. We determine that the letters “M” and “T” with a similar style would create a similar commercial impression.⁸

In addition, there is no evidence that purchasers of hats and shirts are sophisticated purchasers. Indeed, purchases of hats and T-shirts could be impulse purchases. Moreover, there is evidence that opposer has registered and

⁸ We also have no basis to conclude that the marks MT or TM are weak marks. While there is one third-party registration for the mark TM in a very different form (Registration No. 2,459,206), there is no evidence of use of this or other similar marks.

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used the MT and design mark on various goods and services, e.g., media guides, shorts, and a professional basketball team. These factors provide additional support for opposer's position.

Another factor that can be very significant in likelihood of confusion cases is the fame of opposer's mark. In this case, there is evidence that opposer's mark has achieved some public recognition. Opposer has submitted evidence that the mark is used as "a secondary logo" of the Minnesota Timberwolves basketball team. Piken dep. at 9. Opposer uses the mark on the players' shorts, shorts sold to the public, and on the cover of opposer's media guide. Piken dep. at 19-20 and Exhibits 1 and 7. Millions of people have attended Timberwolves games and even more have viewed these games on national and regional television. Piken dep. Exhibits 2 and 3. This evidence does show that opposer's mark has achieved some renown. We resolve this factor in opposer's favor although we do not find that opposer's mark has achieved the type of fame where it would play "a dominant role in cases featuring a famous or strong mark.'" Century 21, 23 USPQ2d at 1701, quoting, Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Finally, we briefly note that there is no evidence to the extent of applicant's use of its mark and no evidence of

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actual confusion. Of course, the absence of actual confusion does not mean there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Therefore, the lack of actual confusion is a neutral factor.

We conclude that opposer has sustained its burden of showing that there is a likelihood of confusion. Of course, we add that if we had any doubts about whether there is a likelihood of confusion, we resolve that doubt, as we must, in favor of registrant. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The opposition is sustained.

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Seeherman, Administrative Trademark Judge, dissenting

I respectfully dissent from the holding of the majority that applicant's mark, as used on its goods, is likely to cause confusion with opposer's registered mark.

Specifically, I think that the differences in the marks are sufficient to preclude confusion.

The marks in question, and particularly opposer's mark, consist of highly stylized letters, and are "therefore in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be." Georgia-Pacific Corp. v. Great Plains Bag Co., 614 F.2d 757, 760, 204 USPQ 697, 699 (CCPA 1980). Opposer's mark is not simply the letters "M" and "T," but the letters depicted within the design of an animal head, with the shape of the letters dictated by the overall shape of the head. Applicant's mark, on the other hand, consists of the letters "T" and "M" shown in relatively simple, outlined capital letters, with the "T" in a more prominent position, above and superimposed on the "M."

The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur. In re Electrolyte Laboratories, Inc., 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Thus, the marks must be considered within the environs of the marketplace.

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Georgia-Pacific Corp. v. Great Plains Bag Co., supra, 204 USPQ at 699.

As the majority has pointed out, opposer's mark is used as a "secondary logo" of the Minnesota Timberwolves basketball team. "Millions of people have attended Timberwolves games and even more have viewed these games on national and regional television." Majority opinion, p. 11. Because the public associates the logo with the Minnesota Timberwolves, the animal head design element in opposer's mark takes on a particular significance as being a representation of a timberwolf. Further, consumers will view the letters in opposer's mark as being "MT," for Minnesota Timberwolves, as opposed to "TM." Thus, opposer's mark is not merely two arbitrarily arranged letters which might be transposed in the public mind from "MT" to "TM." Rather, because of the association with the team name, the letters will be recognized and remembered as "MT." Further, the mark will not be seen only as the letters "MT," but as a logo having the prominent design of the head of a timberwolf, and with the letters helping to form that head. As a result, this case presents a different fact situation from the cases cited in *Edison Brothers Stores, Inc. v. Brutting E.B. Sport International GmbH*, 230 USPQ 530, 533

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(TTAB 1986), and quoted at pages 7 and 8 of the majority opinion.¹

The commercial reality is that consumers purchase goods marked with team logos because of the logo. They are, in this respect, discriminating purchasers. Therefore, even if the goods are inexpensive items such as T-shirts, consumers who want goods bearing the Minnesota Timberwolves logo will know what that logo looks like, and will not mistake another mark for that logo simply because it contains the letters "T" and "M."

As for applicant's mark, the "T" design is more prominent because it stands out from, and is superimposed on the "M." Because people normally read letters that are set out in a column from top to bottom, in the same way that they would view numbers, I believe that they will view applicant's mark as "TM," rather than "MT." This is, in fact, the way that opposer itself characterized applicant's mark in the notice of opposition. (As the majority notes, opposer changed its characterization of the mark to "MT" in its brief, presumably to try to make applicant's mark seem closer to opposer's mark.)

¹ I would also point out that there are numerous cases finding no likelihood of confusion between letter marks, even when identical letters and identical goods were involved. See, for example, *In re Burndy Corp.*, 300 F.2d 938, 133 USPQ 196 (CCPA 1962); *In re Anderson Electric Corporation*, 470 F.2d 593, 152 USPQ 245 (CCPA 1967); *In re Rodix, Inc.* 187 USPQ 255 (TTAB 1975).

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When the marks are compared in their entireties, as they must be, there are significant differences between opposer's MT and wolfhead design mark and applicant's stylized TM mark in appearance, pronunciation, connotation and, as a result, in commercial impression. It is well-established that each of the du Pont factors may, from case to case, play a dominant role. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Further, in appropriate cases, the factor of the dissimilarity of the marks may be dispositive. Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). I believe that, in this case, too, the single du Pont factor of the dissimilarity of the marks, is dispositive. Therefore, despite the du Pont factors favoring opposer that the majority has pointed out, I would, on the basis of the marks and the context in which they would be viewed, find that confusion is not likely, and would dismiss the opposition.