

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: October 4, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Oakley, Inc.
v.
Costa Del Mar Sunglasses, Inc.

Opposition No. 91120006
to application Serial No. 75542083
filed on August 20, 1998

Janet Robertson Kaufman of Weeks, Kaufman & Johnson LLP for
Oakley, Inc.

Costa Del Mar Sunglasses, Inc., pro se.¹

Before Chapman, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Oakley, Inc. (a Washington corporation) has opposed the
application of Costa Del Mar Sunglasses, Inc. (a Florida

¹ In the certificate of service section of some papers filed herein as well as in a portion of the discovery deposition of Mr. William Ed Moody, applicant's executive vice president, there are indications that applicant may have an attorney. However, no attorney has entered an appearance on applicant's behalf.

Opposition No. 91120006

corporation) to register on the Principal Register the mark EX-FRAME for "optical and sunglass frames."²

Opposer asserts as grounds for opposition that it manufactures and distributes protective eyewear, including sunglasses, goggles, accessories therefor, and other products; that opposer has used the marks E FRAME and O FRAME for protective eyewear, namely goggles and replacement parts therefor since November 1980; that opposer has used the mark M FRAME for various protective eyewear items since September 1990; that opposer "uses a family of single letters or sounds either alone or in combination with other words or trademarks for various eyewear products. For example, Opposer uses the letters A, E, J, L, M, O, T, V, W and X in connection with eyewear products. ... This family of single letters or sounds is seen on packaging for Oakley's eyewear products. Thus, consumers readily associate single letters with Oakley eyewear." (paragraph 10); that opposer owns registrations for the marks M FRAME, O FRAME, E FRAME, E WIRE, T WIRE, J EYE JACKET, .4²S, O MATTER, PRO M FRAME, and X METAL; and that applicant's mark, when used on or in connection with its goods, so resembles opposer's previously used and registered marks, as to be likely to cause confusion, mistake, or deception.

² Application Serial No. 75542083, filed August 20, 1998, based on applicant's claimed date of first use and first use in commerce of October 1, 1996.

Opposition No. 91120006

In its answer applicant denies the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of applicant's application; the stipulation of the parties (filed May 30, 2002, via certificate of mailing) that certain documents be entered into evidence; opposer's testimony, with exhibits, of (i) Scott Eilertson, opposer's eyewear brand manager, and (ii) Daniella Gasaway, its director of advertising; and opposer's notice of reliance on (i) status and title copies of nine registrations, and (ii) certain discovery materials (i.e., opposer's requests for admission (unanswered by applicant), applicant's responses to certain of opposer's interrogatories and portions of opposer's discovery deposition of William Ed Moody, applicant's executive vice president.

Only opposer filed a brief on the case. Neither party requested an oral hearing.

The Parties

Opposer, Oakley, Inc., was established in 1975 and it is a manufacturer and distributor of a variety of products-- eyewear, prescription eyewear, footwear, clothing and time pieces. Opposer's target markets for its eyewear products are retailers of general eye care services and related products, and retailers of sunglasses, including in the area of outdoor sports (e.g., skiing, motorcycling, surfing,

Opposition No. 91120006

hunting and fishing). Opposer sells its eyewear products through its approximately 3,000 optical accounts (e.g., Eyecare Associates), hundreds of sunglass specialty shops (e.g., Sunglass Hut), general sports stores (e.g., Cabela's, Bass Pro Shops and Hibbet's Sporting Goods) and through kiosks in malls. Opposer has sold polarized sunglasses since 1998 and is trying to expand this market, particularly by having its field sales representatives pursue the shooting, fishing, hunting and all outdoor retail segments, and by opposer sponsoring athletes in those markets (e.g., Scott Robertson, Rich Tauber).

Opposer has sold goggles under the marks O FRAME and E FRAME since 1980, under the mark PRO FRAME since 1986, and under the mark A FRAME since 1998. It has sold goggles and sunglasses under the mark M FRAME since 1990, under the mark E WIRE since 1993, under the mark T WIRE since 1994, under the mark PRO M FRAME since 1996, and under the mark X METAL since 1997.

Opposer's total sales (1998 - early 2002) for all of the goods sold under all of these marks are around \$280 million.

Opposer advertises through printed publications (e.g., "North American Fisherman," "Surfing," "TW Skateboarding") and it has a website on the Internet; and opposer attends

Opposition No. 91120006

and exhibits at trade shows such as ASR (Action Sports Retailer), Outdoor Retailer, and Surf Expo.

Applicant, Costa Del Mar Sunglasses, Inc., was incorporated around 1983, and it manufactures and wholesales sunglasses (in approximately 34 models) through optical accounts (opticians, optometrists, ophthalmologists), sunglass specialty shops, through an exclusive distributor for fishing and hunting shops (e.g., Cabela's, Bass Pro Shops), and retail via its website on the Internet.

Applicant's sunglasses range in price from about \$110 to \$300, and its total annual sales for 2000 were about \$8.9 million. Approximately 95% of its sales are through the retailers--optical accounts and sunglass specialty stores.

Applicant's advertising costs for the year 2000 were \$288,000, mostly done through printed publications (e.g., "Fly Fishing Retailer," "Outdoor Retailer"); sponsoring about 40 fishing tournaments per year; and about 7 or 8 sports people who are paid endorsers. Applicant attends and exhibits at trade shows such as Outdoor Retailer, Surf Expo, Florida Boat Show. Applicant sends its catalogs and point-of-purchase materials to its retailers, and when direct customer inquiries are received, applicant sends brochures directly to those consumers.

Applicant adopted the mark EX-FRAME because of the "'X' things in the air [e.g., 'X' games] and it sounded really

Opposition No. 91120006

cool.” (Moody discovery dep., p. 37.) Mr. Moody was aware of opposer and some of its marks, e.g., X METAL, O FRAME, E WIRE. He was aware of no instances of actual confusion.

Standing

There is no question that opposer, as a major manufacturer and seller of sunglasses and goggles, has standing to bring this opposition. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Priority

In view of opposer’s ownership of nine valid and subsisting registrations³ for various marks for goggles

³ Registration No. 1701476 issued July 21, 1992 for M FRAME for, inter alia, sunglasses and goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed; Registration No. 1952458 issued January 30, 1996 for T WIRE for, inter alia, sunglasses and goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; Registration No. 1973974 issued May 14, 1996 for E WIRE for, inter alia, sunglasses and goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; Registration No. 2087464 issued August 12, 1997 for O FRAME for, inter alia, goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; Registration No. 2087465 issued August 12, 1997 for PRO FRAME for, inter alia, goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; Registration No. 2087466 issued August 12, 1997 for E FRAME for, inter alia, goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; Registration No. 2155819 issued May 5, 1998 for X METAL for, inter alia, sunglasses and goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; Registration No. 2168402 issued June 23, 1998 for PRO M FRAME for, inter alia, sunglasses and goggles, Section 8 affidavit accepted, Section 15 affidavit acknowledged; and Registration No. 2280758 issued September 28, 1999 for A FRAME for goggles.

(In each registration which includes the word “frame,” it was disclaimed.) (footnote continued)

Opposition No. 91120006

and/or sunglasses, the issue of priority does not arise in this opposition proceeding. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, at footnote 6 (CCPA 1972); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Likelihood of Confusion

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities of the marks and the similarities of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative

The Board notes that opposer did not plead ownership of its Registration Nos. 2087465 and 2280758 in its notice of opposition. However, applicant made no objection to the status and title copies of these two registrations included in opposer's notice of reliance. Accordingly, we hold that the pleadings are considered amended under Fed. R. Civ. P. 15(b) to conform to the

Opposition No. 91120006

effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Initially, we consider opposer's assertion of a "family" of marks consisting of "single letter marks in combination with the word 'frame' or 'wire'" (brief, p. 6). The "family" of marks doctrine has applicability in those situations where, prior to a defendant's first use of its challenged mark containing a particular feature, the plaintiff had established a family of marks characterized by that feature, so that the defendant's subsequent use of its mark containing the feature for goods or services which are similar or related to plaintiff's will cause the relevant purchasing public to assume that defendant's mark is yet another member of plaintiff's family. See *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); and *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307 (TTAB 1978).

It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar or related goods or services is insufficient to establish, as against a defendant, a claim of ownership of a family of marks characterized by the feature. Rather, it

evidence, specifically, to include opposer's Registration Nos.

Opposition No. 91120006

must be demonstrated that prior to defendant's first use of its challenged mark, the various marks said to constitute the plaintiff's family, or at least a good number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 403, 164 USPQ 43 (CCPA 1969); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); and *Dan River, Inc. v. Apparel Unlimited, Inc.*, 226 USPQ 186 (TTAB 1985).

Opposer's first problem is that it has no clearly defined "family" with a single "surname." That is, there is no specific particular feature which characterizes its asserted "family." Rather, opposer asserts a "family" of different single letter (or single sound) marks in combination with different words such as "frame" or "wire" (or "metal"). There is no specific "surname" and there is no "family" of "single letter or sound" marks. We find that opposer's various marks do not constitute a "family" of marks. To find otherwise would be to allow parties to claim a "family" of marks which consist of different single syllable words (e.g., pro, ex); or based on the use of a few

2087465 and 2280758.

Opposition No. 91120006

single letters, essentially grant a party rights to the entire alphabet of single letters. In both circumstances this would amount to finding a "family" of marks without a particular single feature characterizing the marks, that is, a "family surname."

The second problem with opposer's claim of a "family" of marks is that even if its various single letter (or single sound) marks with differing second words were considered a "family" (which they are not), there is insufficient evidence showing use of these marks together as a "family" of marks.

Because there is no "family" of marks here, the issue of likelihood of confusion must be determined by comparing applicant's mark with each of opposer's registered marks individually. Although opposer has relied on nine registrations for various marks, in considering the similarities/dissimilarities between applicant's mark EX-FRAME and opposer's various marks, we will focus on opposer's mark X-METAL. Further, in our analysis of the similarities/dissimilarities of the various involved goods, we will focus on opposer's "sunglasses" (one of the items listed in its Registration No. 2155819 for the mark X METAL), and applicant's "sunglass frames."⁴

⁴ We note that applicant's specimens, and the discovery testimony of applicant's executive vice-president, Mr. Moody, all indicate

Opposition No. 91120006

Turning first to a consideration of the goods, the issue of likelihood of confusion must be determined in light of the goods as identified in the involved application and registration and, in the absence of any specific limitations therein, on the presumption that all normal and usual channels of trade and methods of distribution are or may be utilized for such goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

As explained previously, the goods we shall consider herein are opposer's "sunglasses" and applicant's "sunglass frames." As identified, we find that these goods are substantially identical, and applicant has not contended to the contrary. Our primary reviewing Court has stated that "when marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Inasmuch as neither applicant's application nor opposer's registration includes any type of restriction as

that applicant's products are sold as sunglasses, that is, the

Opposition No. 91120006

to trade channels or purchasers, we must presume in this administrative proceeding that the involved goods are sold in all normal channels of trade to all usual classes of purchasers for such goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, supra. In fact, here there is evidence that the parties exhibit at the same trade shows (e.g., Outdoor Retailer, Surf Expo) and they sell their products through some of the same retail stores (e.g., Cabela's and Bass Pro Shops).

Turning next to a consideration of the similarities/dissimilarities of applicant's mark EX-FRAME and opposer's mark X METAL, it is well settled that marks must be considered in their entirety because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). That is, the proper test

frames including the lenses therein.

Opposition No. 91120006

in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks.

In this case, both applicant's mark EX-FRAME and opposer's mark X METAL consist of a beginning which is "EX" or "X" followed by a generic or highly descriptive word. Thus, the beginning sounds are identical and the structure of the marks is similar. The connotation of both marks is that of "x" as it relates to the younger generation such as "x" games and "extreme" sports. (Applicant's executive vice president testified in his discovery deposition as to this intended connotation of applicant's mark. Disc. dep., p. 37. See also, opposer's 2001 catalog--opposer's Exhibit Y.)

Although the parties' marks are not identical, when considered in their entirety, we find that the respective marks EX-FRAME and X METAL are similar in sound, appearance, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). Their differences, even if recognized, may be attributed by consumers to one source of goods. Their contemporaneous use, on and in connection with these substantially identical goods, would be likely to cause confusion as to the source or sponsorship of such goods. See *Cunningham v. Laser Golf Corp.*, supra.

Opposition No. 91120006

Although opposer argues that its mark is famous, fame is clearly not proven in this record. Sales figures for 1998-2002 include sales of opposer's sunglasses sold under various marks, and even when coupled with its use of certain marks on sunglasses and goggles since 1980, this does not establish the fame of opposer's involved marks.⁵

On balance, and considering all of the evidence on the relevant du Pont factors, and giving each such factor its appropriate weight in the circumstances of this case, we find that confusion is likely between applicant's mark EX-FRAME and opposer's mark X METAL when used on these substantially identical goods.

If we had any doubt in this case, we must resolve it in registrant's favor. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The opposition is sustained and registration to applicant is refused.

⁵ We are aware that in the discovery deposition of Mr. Moody, he was asked by opposer's attorney "Would you consider Oakley a famous brand in the marketplace?" and he answered "They're number one, so, yes." (Disc. dep., p. 46.) This is not evidence that the individual marks relied on by opposer in this opposition proceeding, (e.g., X METAL), are famous.