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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Von Dutch Originals, LLC

v.

Richard M. Betts

Opposition No. 91159477
against Serial No. 76524365

Donald S. Grier of Law Offices of Donald S. Grier for
Von Dutch Originals, LLC.

Thomas I. Rozsa of Rozsa Law Group LC for Richard M.
Betts.

Before Bucher, Holtzman and Drost, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Richard M. Betts seeks registration on the Principal
Register of the mark **UNCLE DUTCH** for goods recited in
the application as "jewelry" in International Class 14.¹

Registration has been opposed by Von Dutch Originals,
LLC. As its ground for opposition, opposer asserts that

¹ Application Serial No. 76524365 was filed on June 12, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

applicant's mark when used in connection with applicant's goods so resembles opposer's previously used and registered mark **VON DUTCH** as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act.²

Applicant, in its answer, has denied the salient allegations in the opposition. The parties have fully briefed this case but neither party requested an oral hearing.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer has also made of record by notice of reliance its pleaded registrations by submitting copies from the United States Patent and Trademark Office's Trademark Electronic Search System (TESS) of the following registrations, which applicant has treated as of record:

² While opposer used the word "dilution" in its notice of opposition, and in its supplemental brief, argued false suggestion of a connection with the late Kenneth Howard, also known as "Von Dutch" (Section 2(a) of the Trademark Act), neither ground was ever sufficiently pleaded by opposer nor tried by the parties and thus warrant no further discussion herein. Furthermore, while the notice of opposition alleged common law usage on "clothing, jewelry, fashion accessories, motor vehicles" and other "accessory products," as will be discussed *infra*, this has not been proven on this record.

VON DUTCH

for "men's, boy's, women's, girl's, and children's, shorts, dresses, jumpers, shirts, blouses, jackets, coats, T-shirts, sweatpants, sweatshorts, underwear, sleepwear, loungewear, swim wear, wet suits, overalls, coveralls, ski wear, vests, sweaters, leggings, neckwear, belts, suspenders, wristbands, footwear, and headwear" in International Class 25;³

VON DUTCH

for "sunglasses, protective eyewear, eye glasses, eye glass cases and eye glass frames" in International Class 9; and

"three-ring binders, stickers, stationery, pens, pencils, note pads, note books, address books, adhesive tape for stationery or household purposes, decals, artists' brushes, artists' pastels, artists' pencils, artists' pens, arts and craft paint kits, baseball cards, binders, postcards, book covers, bumper stickers, calendars, calendar desk pads, note cards, cards bearing universal greetings, bank checks, check book wallets, date books, drawing instruments, envelopes, erasers, highlighting markers, printed art reproductions, telephone calling cards not magnetically encoded, temporary tattoos, trading cards and wall calendars" in International Class 16;⁴



for "men's, boy's, women's, girl's, and children's, shorts, dresses, jumpers, shirts, blouses, jackets, coats, T-shirts, sweatpants, sweatshorts, underwear, sleepwear, loungewear, swim wear, wet suits, overalls, coveralls, ski wear, vests, sweaters, leggings, neckwear, belts, suspenders, baby bibs not of paper, wristbands, footwear, and headwear" in Int. Class 25;⁵

³ Registration No. 2380173 issued on August 29, 2000 claiming first use anywhere at least as early as February 18, 1996 and first use in commerce at least as early as June 1, 1996. Section 8 affidavit accepted and Section 15 affidavit acknowledged. The registration states that "The name in the mark does not represent that of a living individual."

⁴ Registration No. 2900014 issued on November 2, 2004 claiming first use anywhere in both classes at least as early as October 8, 1996 and first use in commerce in class 9 at least as early as January 1 2004 and first use in commerce in class 16 at least as early as October 8, 1996. The registration states that "the name 'Von Dutch' does not identify a living individual."

⁵ Registration No. 2901875 issued on November 9, 2004 claiming first use anywhere at least as early as February 18, 1996 and first use in commerce at least as early as June 1, 1996. The registration states that "'Von Dutch' does not identify a particular living individual."

We note that with this notice of reliance, opposer also submitted copies of TESS records for at least three other, then-pending applications, which have since issued into registrations. These **VON DUTCH** marks, used in connection with toys (application Serial No. 78341169, now Reg. No. 2928360), motorcycles and motorcycle parts (application Serial No. 78325826, now Reg. No. 2961406) and wallets, travel bags and other items of luggage (application Serial No. 78295759, now Reg. No. 2994249), are not similarly treated as of record.⁶

Opposer, as part of its case-in-chief, has also submitted for the record, pursuant to a notice of reliance, opposer's magazine of September 2004; excerpts from applicant's answers to opposer's first set of requests for admissions, Nos. 7, 17, 21, 22, 23, 32 and 34; excerpts from applicant's answers to opposer's first Set of interrogatories, Nos. 9 and 13; excerpts from applicant's responses to opposer's first request for production of documents and things (Bates Stamp BETTS00001; BETTS00003; BETTS00004; BETTS00005 and BETTS00008); three Internet website articles; the declaration of Donald S. Grier, opposer's attorney of

⁶ We hasten to add that even if they had been considered, it would not have changed the outcome herein.

record; the declaration of Tonny Sorensen, opposer's managing member, and a copy of a TESS record of a now-abandoned application filed by applicant for the mark UNCLE VON DUTCH (application Serial No. 76524006).

Applicant's record consists of the testimony deposition of applicant, Richard M. Betts, with exhibits related thereto. Opposer's counsel appeared and cross-examined Mr. Betts during this deposition.

Procedural Matters

Before analyzing the merits of this case, we must discuss several preliminary matters. Turning first to the declarations of Donald S. Grier and Tonny Sorensen, we note that the parties may stipulate to the entry of testimony by affidavit or declaration. 37 CFR § 2.123(b); TBMP § 713.02 (2nd ed. rev. 2004). However, in the absence of such a stipulation, an affidavit or declaration is not admissible under a notice of reliance. See Boyds Collection, Ltd. v. Herrington & Company, 65 USPQ2d 2017 (TTAB 2003); Sports Authority Michigan Inc. v. PC Authority Inc., 63 USPQ2d 1782, 1801, n. 20 (TTAB 2001); and Hard Rock Cafe Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1403 (TTAB 1998). There is no record of any stipulation that witnesses could submit testimony in the form of an affidavit or declaration in this case, and the

declarations of Donald S. Grier and Tonny Sorensen are therefore inadmissible. As a corollary, this would also result in our striking the Internet evidence authenticated by the Grier declaration. Consequently, we find that applicant's several objections (e.g., issues of Mr. Grier's alleged lack of personal knowledge, opposer's alleged failure to disclose this information during discovery, hearsay objections, etc.) to the admissibility of portions of these statements and attached exhibits, pursuant to 37 CFR § 2.123(k), are rendered moot.

Finally, we note that opposer has attempted to introduce into the record a copy of its sales catalogue of September 2004 via a notice of reliance. However, not all printed matter is a "printed publication" within the meaning of 37 CFR § 2.122(e). Under that rule, "[p]rinted publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered." See also TBMP §§ 707, 708 (2nd ed. rev. 2004). Documents that constitute printed

publications are essentially self-authenticating, eliminating the usual requirement that evidence be authenticated prior to admission. See Hard Rock Café, *supra* at 1403-05. The Board has previously held that promotional material, catalogues, and the like are not admissible as printed publications, unless a foundation has been laid - by testimony, unless otherwise stipulated - demonstrating that the materials sought to be introduced are generally available to the public. See Boyds Collection, Ltd. v. Herrington & Company, *supra*; Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979); TBMP § 708 (2nd ed. rev. 2004); and 3 J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 20:125 (4th ed. 2001). As noted, however, opposer has submitted no testimony. Although applicant did not object to this sales catalogue on the basis that it does not qualify as a "printed publication," we strike this from the record *sua sponte*. "Evidence not obtained and filed in compliance with these sections will not be considered." 37 CFR § 2.123(1), and TBMP § 717 (2nd ed. rev. 2004) ["Evidence not obtained and filed in compliance with the rules of practice governing *inter partes* proceedings before the Board will not be considered by the Board."].

Factual Findings

Applicant was a nephew of the late Kenneth Howard, also known as "Von Dutch." Mr. Betts had long referred to his uncle as "Uncle Dutch." Applicant claims that inasmuch as his uncle was a big influence on him and helped him to develop his abilities in the creative arts, he decided to adopt "Uncle Dutch Authentics" as the mark for his jewelry items. Applicant clearly knew that his uncle's business alias was "Von Dutch," although the record is not as clear about just how knowledgeable he was about opposer's VON DUTCH trademark registrations prior to the filing of his own trademark application for UNCLE DUTCH.

Von Dutch Originals, LLC Has Standing

First, we note that with regard to the threshold inquiry as to the standing of Von Dutch Originals, LLC in this opposition proceeding, opposer has alleged and proven at trial a real commercial interest in the VON DUTCH mark, as well as a reasonable basis for the belief that opposer would be damaged by the registration of applicant's UNCLE DUTCH mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Von Dutch Originals, LLC has presented evidence of its ownership and validity of

prior issued registrations for the VON DUTCH mark. We find that opposer has also demonstrated that it could well be in competition with applicant in the sale of clothing and accessories.

Priority

We turn then to the issue of priority in relation to the goods set forth in opposer's pleaded registrations. As noted above, Von Dutch Originals, LLC has established its ownership of valid and subsisting registrations for the VON DUTCH mark for clothing, eye wear products, stationery items, and the like. Therefore, there is no issue as to opposer's priority. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to a consideration of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). While opposer argues that the word "DUTCH, is an essential, if not dominant feature of Opposer's composite mark," applicant contends that this position "is simply a violation of the anti-dissection rule." Estate of P. D. Beckwith Inc. v. Comm'r. of Patents, 252 U.S. 538 (1920); and In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986).

Indeed, when these two marks are considered in their entireties, the difference between the two marks is apparent. While we are reluctant to make a generalized statement about placement determining dominance, often within a two-word mark, the first word is the more prominent of the two - both to the eye and to the ear. See Presto Products, Inc. v. Nice Pak Products, Inc., 9 USPQ2d 1895 (TTAB 1988) ["[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." KID-WIPES held confusingly similar to KID STUFF, both applied to baby wipes]. In this case, the prominent first words in these

marks create critical differences between the respective marks. The first word in applicant's mark (the word "Uncle" in UNCLE DUTCH) is obviously quite different from the first word in registrant's mark (the word "Von" in VON DUTCH). If the sound test is applied, the difference is sharply accentuated. If the sight test is applied, the first word at once distinguishes the marks.⁷

As to connotation, applicant argues as follows:

'VON DUTCH' effectively functions as a surname of German origin and gives the impression of a person's name as 'VON DUTCH.' In complete contrast, 'UNCLE DUTCH' is the name that the Applicant gave to his uncle and in fondness for his uncle, sought to register the name ...

We agree that UNCLE DUTCH sounds like an informal name for a family member while VON DUTCH sounds like a Germanic surname. Hence, the commercial impression created in the mind of the ordinary consumer by these two marks would be one of contrast rather than of similarity.

⁷ We do note that applicant's mark is depicted in a standard character drawing, and hence he is not limited to any particular depiction. Hence, applicant could conceivably adopt lettering [*Uncle Dutch*] having characteristics reminiscent of opposer's mark [*Von Dutch*], and/or could adopt trade dress that would further diminish this difference in commercial impression. See e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 USPQ 1281 (Fed. Cir. 1984) ["But the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression. Applicant's labels support rather than negate that of which opposer complains: that SPICE VALLEY inherently creates a commercial impression which is confusingly similar to that of SPICE ISLANDS."].

Accordingly, we find that in their entirety, the mark UNCLE DUTCH is so different in meaning, appearance, sound and commercial impression from VON DUTCH, that even if the goods upon which opposer uses the mark VON DUTCH were more closely related to applicant's goods, opposer still would not prevail due to the dissimilarity of the marks.

As to the du Pont factor focusing on the number and nature of similar marks in use on similar goods, applicant argues that opposer's mark is relatively weak. In support of this position, during applicant's testimony deposition, he introduced a computer printout from CCH-Corsearch showing that as of January 24, 2005, there were 646 federal trademark applications and registrations having marks containing the word "Dutch." Richard M. Betts, testimony deposition, Exhibit 11. However, this single-page result of a query of the term "Dutch" contains no information about individual applications or registrations, and therefore it is impossible to draw any meaningful conclusions from this document.

By contrast, opposer argues that its mark is quite strong. Opposer contends that applicant's use of his UNCLE DUTCH mark will necessarily create associations with the late Kenneth Howard a/k/a Von Dutch. Yet opposer has

not demonstrated that it has exclusive rights to the word DUTCH within any composite mark in connection with items of clothing, stationery, eyewear, etc.

Accordingly, on this record, we find no evidence suggesting either that registrant's mark is a weak mark as applied to registrant's goods, or contrariwise, that it is especially strong.⁸ Hence, this is a neutral factor.

We turn then to the du Pont factor focusing on the similarity or dissimilarity and nature of the goods as described in the application and cited registration. Opposer has claimed registrations covering items of clothing, stationery and eyewear, but not jewelry.⁹ Applicant's involved application is limited to jewelry. As a result, the goods involved herein are obviously not identical. Opposer has submitted no evidence in this record to demonstrate the relationship of jewelry to clothing, stationery or eyewear. Hence, we cannot presume

⁸ While opposer argues in its briefs that its mark is "well known," that it has gotten media coverage through celebrity endorsements, and that it had projected a substantial level of retail sales for the year 2004, none of this evidence was properly made part of this record.

⁹ In its notice of reliance, opposer submitted evidence of its ownership of application Serial No. 78295767 for the mark VON DUTCH for jewelry, which application is now abandoned. Applicant alleges that opposer later reapplied for the mark VON DUTCH for jewelry - almost two years after the involved application was filed [Application Serial No. 78633608, filed on May 19, 2005, that matured into Reg. No. 3055504 on January 31, 2006}, but neither party made this application or registration of record during this proceeding.

that they are related, and this factor favors the position of applicant.

In any likelihood of confusion analysis, the two key considerations are the similarities between the marks and the relationship between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). As noted above, we find that the marks are so distinctly different in appearance that they create separate and different commercial impressions. Accordingly, the contemporaneous sale of these different products under the dissimilar marks here is not reasonably likely to cause confusion. In particular, we find that purchasers are not likely to regard applicant's mark as a variant mark of opposer.

Applicant argues in its briefs that it markets its products to specialty stores, while applicant testified he intended to sell his jewelry to anyone who wanted to buy it. Given that neither registrant nor applicant has placed any restrictions on their respective channels of trade, we must presume that applicant's goods and registrant's goods will move through all of the normal channels of trade to all of the usual consumers of goods of the types identified. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank,

811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

However, in the absence of any specific evidence as to the channels of trade or classes of consumers for these respective goods, this would be nothing more than a matter of opinion on which we would be unwise to speculate. In re Mars, Incorporated, 741 F2d 395, 222 USPQ 938 (Fed. Cir. 1984).

Finally, we look to the thirteenth du Pont factor focused on any other established fact probative of the effect of use. Opposer alleges that applicant is clearly trying to trade off the good will associated with the VON DUTCH mark and that he filed the involved application in bad faith. In addition to specific portions of applicant's deposition, opposer points to the contents of applicant's sales literature and a now-abandoned application for the mark UNCLE VON DUTCH that applicant filed on the same day as this UNCLE DUTCH application.

It is clear that applicant had a special relationship with his late uncle, who he referred to as "Uncle Dutch." On the other hand, he was not a beneficiary under his uncle's will, and apparently does not have any commercial rights to his late uncle's intellectual property.

Nonetheless, opposer argues from the record that: applicant's sales brochure shows that he features jewelry

items incorporating into them symbols such as his uncle's distinctive "flying eye"; these symbols are surrounded by multiple textual references to the work and legacy of "Von Dutch"; the visually dominant symbols and motifs on Mr. Betts' advertised items of jewelry and clothing explicitly draw on his uncle's style and history;¹⁰ at times, applicant presents his "Uncle Dutch" mark in a font that mimics opposer's distinctive lettering (see Reg. No. 2901875, for example); and, on the same date that he filed the instant application, applicant also filed a now-abandoned application for the mark UNCLE VON DUTCH. This latter combination is a name he admittedly never used with his uncle, and most obviously incorporates opposer's mark in its entirety.

While our decision herein should not be read as approving of Mr. Betts' business practices, our determination focuses only on the registrability of the mark UNCLE DUTCH for jewelry in light of claims of likelihood of confusion with three of opposer's federal registrations. Another tribunal - having broader jurisdiction over acts of unfair competition and faced

¹⁰ We provide a brief sample from applicant's sales brochure: "A bold line of silver jewelry with Dutch's personal artwork intricately placed on each piece of unique jewelry, custom-made leathers and apparel. All dedicated to the legacy of Von Dutch."

with a different record - might well hold differently based upon some of applicant's specific actions enumerated above. However, we cannot determine on this record that applicant's adoption of his UNCLE DUTCH mark was in bad faith, or that applicant intentionally sought to trade on opposer's good will. Cf. Big Blue Products Inc. v. International Business Machines Corp., 19 USPQ2d 1072, 1076 (TTAB 1991). In addition, given the combined differences in the marks and the unclear relationship between the respective goods before us in this narrow registrability proceeding, we find that applicant's behavior has not been shown to be sufficiently egregious to swing the balance under the du Pont factors in opposer's favor.

Decision: The opposition is dismissed and the application will be forwarded for the issuance of the notice of allowance.