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**THIS DISPOSITION
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OF THE T.T.A.B.**

Paper No. 35
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sibley's Shoes, Inc.
v.
Propet USA, Inc.

Opposition No. 112,967
to application Serial No. 75/439,139
filed on February 23, 1998

John C. Blattner of Butzel Long for Sibley's Shoes, Inc.

Bruce A. Kaser of Davis Wright Tremaine LLP for Propet
USA, Inc.

Before Hanak, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal
Register of the mark TRAVELWALKER (in typed form) for
"sport shoes."¹

¹ Serial No. 75/439,139, filed February 23, 1998. The
application is based on intent-to-use, under Trademark Act
Section 1(b).

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Opposer has opposed registration on the ground that opposer has used TRAVELERS as a mark for shoes since January 1974, that opposer owns a federal registration² of the mark TRAVELERS, depicted in the form below, for "shoes,"



and that applicant's mark, as applied to applicant's goods, so resembles opposer's previously-used and -registered TRAVELERS mark as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the allegations in the notice of opposition which are essential to opposer's Section 2(d) claim. Applicant also alleged, as affirmative defenses, "laches," "unclean hands or fraud," "estoppel" and "acquiescence."³

² Registration No. 1,386,875, issued March 18, 1986; affidavits under Sections 8 and 15 accepted and acknowledged.

³ In its reply brief, opposer contends that these defenses were not pleaded in the answer and therefore may not be asserted by applicant. However, the defenses in fact are set forth (albeit summarily) at page 2 of the answer, as paragraphs 1-4 of Section II.

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Opposer has made of record status and title copies of its pleaded Registration No. 1,386,875, which show the registration to be subsisting and owned by opposer. The evidence of record also includes the materials submitted pursuant to the parties' May 14, 2001 stipulation under Trademark Rule 2.123(b), consisting of the parties' responses (and accompanying documents) to each others' discovery requests; the testimony deposition of opposer's president Hansel Artrip and exhibits thereto; the declaration of applicant's counsel Valerie DuLaney and exhibits thereto; and printouts from the Office's TESS database of certain third-party registrations of marks including some form of the root word TRAVEL.⁴ Opposer and applicant each filed main briefs, and opposer filed a reply brief. No oral hearing was requested.

We note that applicant, in its answer to the notice of opposition, asserted counterclaims for cancellation of

⁴ In its brief, opposer also cites to and relies on the summary judgment affidavit of Hansel Artrip, filed March 8, 2000 in connection with opposer's motion for summary judgment as to applicant's counterclaims. That affidavit was not included in the parties' May 14, 2001 evidentiary stipulation, nor is it otherwise of record as trial evidence. See TBMP §528.05(a). However, because the affidavit statements to which opposer cites are essentially duplicative of statements contained in Mr. Artrip's testimony deposition (which itself is properly of record pursuant to the parties' stipulation), and because applicant has not objected to opposer's reliance on this evidence, we have considered the affidavit statements to which opposer has cited in its brief.

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opposer's pleaded Registration No. 1,386,875 on the grounds of abandonment and genericness. Opposer filed an answer denying the counterclaim allegations. Applicant has stated in its brief on the case (at page 15) that it is unable to prove its counterclaims. In view thereof, we enter judgment against applicant and in favor of opposer on the counterclaims, and dismiss the counterclaims with prejudice. *Cf.* Trademark Rule 2.114(c), 37 C.F.R. §2.114(c).

We now consider opposer's Section 2(d) ground of opposition to registration of applicant's mark. In view of opposer's submission of status and title copies of its pleaded registration in support of its Section 2(d) claim, priority is not an issue in this case. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, in view of opposer's proof of ownership of its pleaded registration, and because opposer's likelihood of confusion claim is not frivolous or wholly without merit, we find that opposer has established its standing to oppose registration of applicant's mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

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Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that applicant's goods, "sport shoes," are encompassed within and therefore legally identical to opposer's goods, "shoes." Because the parties' goods are legally identical, and because there are no limitations or restrictions set forth in either applicant's application or opposer's registration, we also find that the parties' respective goods would be marketed in legally identical trade channels and to legally identical classes of potential purchasers. This is so, regardless of any differences in the actual trade channels currently used by the parties. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1

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USPQ2d 1813 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus, we find that the second and third *du Pont* factors⁵ favor opposer in this case.

There is no specific evidence in the record as to the sophistication of the purchasers of these goods nor as to the care taken in their purchase; opposer's argument that purchasers are "apt to be indiscriminating" is as unsupported by evidence as applicant's argument that such purchasers "may carefully consider factors such as style, comfort, and durability in comparing brands and types of shoes." However, because "shoes" must be deemed to include relatively inexpensive shoes which are not necessarily purchased with a great degree of purchaser care or sophistication as to brand, we find that the fourth *du Pont* factor⁶ weighs slightly in opposer's favor.

Opposer contends that it has used its mark for over twenty years, with fifty million dollars in sales and eight-and-a-half million dollars in advertising

⁵ The second *du Pont* factor is "the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." The third *du Pont* factor is "the similarity or dissimilarity of established, likely-to-continue trade channels."

⁶ The fourth *du Pont* factor is "the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing."

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expenditures during that time. These figures do not suffice to establish that opposer's mark is a famous mark or even a particularly strong mark, for purposes of the fifth *du Pont* factor.⁷ Moreover, it appears from the record that opposer's sales and marketing activities primarily have occurred in only one state, Michigan. We conclude that this *du Pont* factor is neutral in this case.

The sixth *du Pont* factor is "the number and nature of similar marks in use on similar goods." Applicant has made of record numerous third-party registrations of marks which contain some form of the word TRAVEL. However, third-party registrations are not evidence of use of similar marks on similar goods, for purposes of the sixth *du Pont* factor. See, e.g., *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). Applicant also has submitted (as exhibits to the Declaration of Valerie DuLaney) a printout from the website of GearReview.com consisting of a press release from Lowa (which apparently is a footwear company) which states that "Lowa Introduces Spring 2000 Active Traveler Line" of footwear; a printout from the

⁷ The fifth *du Pont* factor is "the fame of the prior mark (sales, advertising, length of use)."

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GalaxSea Cruises website consisting of an advertisement for cruises with the wording "Put on your sailor's cap and your traveler's shoes, and let Windstar show you the word very few see"; and a printout from the website of the Southeastern Shoe Travelers Association consisting of an advertisement for the "Southeastern Shoe & Accessory Market February 19-21, 2000." These exhibits do not persuade us that "the number and nature of similar marks in use on similar goods" is significant. We find that the sixth *du Pont* factor does not weigh in applicant's favor in this case.

There is no evidence of any instances of actual confusion between applicant's and opposer's marks. However, neither is there any evidence that there has been any significant opportunity for actual confusion to have occurred. As noted above, opposer's sales and marketing efforts have occurred primarily in only one state, Michigan. Likewise, applicant's use of its mark apparently commenced only in 1999, and it does not appear that applicant's sales have been substantial; applicant admits that its marketing and promotional efforts have been "minimal." (Applicant's answer to opposer's Interrogatory No. 6.) On this record, we find that the

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absence of actual confusion is neither surprising nor is it of any significant probative value on the question of likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). The seventh and eighth *du Pont* factors⁸ accordingly are neutral in this case.

We are not persuaded by opposer's contention that applicant adopted its mark in bad faith with the intention of trading on opposer's goodwill. Even if applicant knew of opposer's mark when it adopted its own mark, such mere knowledge does not suffice to establish bad faith adoption by applicant. There is no evidence that applicant adopted its mark in the belief that confusion is likely and with the intent to take advantage of such likelihood of confusion.

Finally, we consider the first *du Pont* factor, i.e., "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are

⁸ The seventh *du Pont* factor is "the nature and extent of any actual confusion." The eight *du Pont* factor is "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion."

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sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Finally, where, as in the present case, the marks would appear on virtually identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

We find that when the marks are compared in their entireties in terms of appearance and sound, they are more dissimilar than similar. Although the marks look

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and sound similar insofar as they each begin with TRAVEL, they look and sound quite dissimilar in that applicant's mark, but not opposer's, includes and ends with the word WALKER. Opposer argues that TRAVELERS and TRAVELWALKER look and sound similar because they both begin with TRAVEL and end in ER (or its plural ERS), and that this similarity is not negated by applicant's mere insertion of the word WALK into opposer's mark. (Opposer's main brief at 9.) However, we are not persuaded that purchasers would view applicant's mark in such a manner, i.e., as consisting of the word TRAVELER with the word WALK dropped into the middle of it. We find that purchasers will readily see, and hear, applicant's mark as a combination of the common and familiar words TRAVEL and WALKER, and not as a variation on, or as being somehow derived from, the word TRAVELER (or TRAVELERS).

In terms of connotation and overall commercial impression, we find that the marks are similar to the extent that they both generally connote the concept of "travel" and, as applied to the respective goods, give the general commercial impression that the shoes are suitable for use while traveling. However, applicant has made of record some seventeen third-party registrations or applications for marks which include some form of the

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word "travel" covering shoes and footwear.⁹ These are probative to the extent that they show that the owners of these other marks have deemed the term "travel" or variations thereof to be suggestive of such goods. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ693 (CCPA 1976).

Moreover, we find that the respective connotations and commercial impressions of the two marks differ to the extent that opposer's mark TRAVELERS brings to mind the persons wearing the shoes, while applicant's mark TRAVELWALKER brings to mind the shoe itself.

Specifically, opposer's mark TRAVELERS connotes the wearers of the shoes, not the shoes themselves, inasmuch as "traveler" does not appear on this record to be the name of a type of shoe. By contrast, "walker" is defined, inter alia, as a type of shoe. See, e.g., Webster's Ninth New Collegiate Dictionary (1990) at 1326 ("**walker** *n* ... **2** : something used in walking: as... **b** : a walking shoe"). Although "walker" also can connote a person, i.e., "one that walks" (see *id.*), it does not

⁹ These marks include TRAVEL FOX, HAVE BLUES WILL TRAVEL, TRAVEL-SPORT, MEPHISTO TRAVEL'S, HABAND TRAVELERS, ISOTONER TRAVEL LITES, TRAVELTONER, TRAVELING MAN, AIR TRAVELER, TAVALONS, CONCOCRDE MAN TRAVEL FASHIONS, TRAVELER'S TREE, L.L. BEAN TRAVELERS, AVIA TRAVEL, THE AUTHENTIC TRAVELLER, and THE CASUAL TRAVELER.

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appear that a person who walks, or travels, or wears walking shoes is or would be referred to as a "travelwalker." Applicant's mark TRAVELWALKER therefore likely would be viewed as connoting the shoe, not the wearer of the shoe. In this regard, we also note that the record shows that opposer sells shoes it calls "Super Walkers" and "Comfort Walkers," in which "walker" would be perceived as connoting the shoe, not the wearer of the shoe. (See opposer's responses to applicant's second set of discovery requests, at Document Nos. SIS-018, SIS-019, SIS-022, SIS-024 and SIS-025).

After careful comparison of the marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that the dissimilarities between the marks outweigh their similarities. Essentially, the major point of similarity between the marks is the fact that they both use the word or some form of the word TRAVEL. We find that word to be somewhat suggestive as applied to shoes, and that its presence in the two marks is an insufficient basis for finding the marks to be confusingly similar. As discussed above, the marks have clear and readily perceived differences in appearance, sound and meaning

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which result from the presence in applicant's mark of the term WALKER and the absence of that term from opposer's mark. We find that these differences suffice to enable purchasers to distinguish the marks without source confusion.

In summary, we have carefully considered all of the evidence of record pertaining to the *du Pont* evidentiary factors, and we conclude that there is no likelihood of confusion in this case. We are not persuaded that opposer's TRAVELERS mark is sufficiently strong that the scope of protection to be afforded to it extends so far as to preclude applicant from registering the distinctly different mark TRAVELWALKER, even for legally identical goods. Accordingly, we find that opposer has failed to carry its burden of proving its Section 2(d) ground of opposition.¹⁰

Decision: Opposer's opposition to applicant's application Serial No. 75/439,139 is dismissed. Applicant's counterclaims for cancellation of opposer's Registration No. 1,386,875 also are dismissed.

¹⁰ In view of opposer's failure to make out its Section 2(d) claim, applicant's affirmative defenses are moot, and we need not and do not reach the parties' arguments with respect thereto.