

This Opinion is not a
Precedent of the TTAB

Mailed: July 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Athleta, Inc.

v.

David Sales

Opposition No. 91218461

James D. Weinberger and Jennifer Insley-Pruitt of Fross, Zelnick, Lehrman & Zissu,
P.C. for
Athleta, Inc.

Dr. David Sales, appearing *pro se*.¹

Before Wellington, Lykos and Hightower,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Dr. David Sales (“Applicant”) has filed applications for registration of the standard
character marks **ATHLETIKA** and **ATHLETIKA SP** for:²

¹ Applicant was represented by counsel earlier in the proceeding. When the counsel withdrew representation, the Board allowed Applicant time to appoint new counsel or to inform the Board that he wishes to represent himself. Applicant chose to represent himself. See 21 TTABVUE.

² Applications Serial Nos. 86097195 (for the mark ATHLETIKA) and 86098697 (for the mark

Analgesic balm; Medical adhesive tape in International Class 3; and

Body rehabilitation apparatus for medical purposes; Compression socks for medical or therapeutic use; Exercise machines for therapeutic purposes; Foam rollers for use in physical therapy; Manually-operated exercise equipment for physical therapy purposes; Manually-operated resistance bands for physical therapy purposes; Manually-operated resistance tubing for physical therapy purposes; Medical and therapeutic device and apparatus, namely, a force and motion sensing apparatus and assisted exercise machine for the rehabilitation of hands and wrists, feet and ankles, knees and shoulders affected by neuromuscular diseases, disorders, or injuries for home or clinical use; Medical braces for hands and wrists, feet and ankles, knees and shoulders; Medical ice packs; Physical exercise apparatus, for medical purposes; Protective sleeves used with orthopedic bracing systems to protect skin from abrasions; Therapeutic hot and cold compression wraps; Therapeutic hot and cold therapy packs; Thermal packs for first aid purposes in International Class 10.

Athleta, Inc. (“Opposer”) opposes registration of Applicant’s marks in both classes on the ground of likelihood of confusion with its previously-used and registered mark, ATHLETA, under Section 2(d) of the Trademark Act. Specifically, Opposer pleads prior common law rights in the mark in connection with women’s sports and active apparel, and related goods and services, and ownership of the following eleven registrations for the standard character mark ATHLETA:

Reg. No. 2427769 for: mail order services featuring sportswear apparel and computerized online retail services in the field of sportswear apparel in International Class 35;³

ATHLETIKA SP) were filed on, respectively, October 21 and 22, 2013. Both applications are based on Applicant’s allegation of a bona fide intent to use the marks in commerce, pursuant to Section 1(b) of the Trademark Act.

³ Issued on February 13, 2001, renewed.

Reg. No. 2427933 for: mail order services and computerized online retail services in the field of athletic apparel, athletic accessories, and athletic equipment in International Class 35;⁴

Reg. No. 2474894 for: athletic apparel, namely, caps, shorts, pants, shirts, jackets, vests, bras, swimwear, and under wear in International Class 25;⁵

Reg. No. 3931195 for: handbags; purses; backpacks; book bags; tote bags; messenger bags; all-purpose sport bags; beach bags; duffel bags; general purpose bags for carrying yoga equipment in International Class 18;⁶

Reg. No. 3931215 for: personal exercise mats in International Class 28;⁷

Reg. No. 3931221 for: retail store services in the field of athletic apparel, athletic accessories, athletic equipment, sportswear, clothing, namely, tops, t-shirts, shirts, blouses, bottoms, shorts, pants, jackets, sweaters, shorts, vests, bras, swimwear, and underwear; headwear; footwear, headwear, athletic bags, tote bags, sports bags, backpacks, duffel bags and all-purpose carrying bags in International Class 35;⁸

Reg. No. 3971029 for: advertising and marketing services, namely, issuing gift cards and gift certificates that may then be redeemed for goods; customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; retail store services featuring clothing, footwear, headwear, accessories, bags, athletic accessories and athletic equipment; On-line retail store services and mail order services featuring clothing, footwear, headwear, accessories, bags, athletic accessories and athletic equipment in International Class 35;⁹

Reg. No. 4202561 for: bags and cases specially adapted for sports equipment in International Class 28;¹⁰

⁴ Issued on February 13, 2001, renewed.

⁵ Issued on August 7, 2001, renewed.

⁶ Issued on March 15, 2011, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁷ Issued on March 15, 2011, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁸ Issued on March 15, 2011, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁹ Issued on May 31, 2011, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

¹⁰ Issued on September 4, 2012.

Reg. No. 4372492 for: catalogs in the fields of clothing, shoes, hats, clothing accessories, hair accessories, bags, exercise equipment and water bottles in International Class 16;¹¹

Reg. No. 4372624 for: hair accessories, namely, hair bands in International Class 26;¹² and

Reg. No. 4445489 for: Clothing, namely, tops, bottoms, skirts, jackets, vests, swimwear, hooded sweat shirts, dresses, tights, belts, gloves, loungewear, neckwear, undergarments, tennis wear; headwear in International Class 25.¹³

Applicant, in his answer, makes certain admissions with regard to his applications, but otherwise denies the salient allegations in the Notice of Opposition.

Only Opposer filed a brief.

The Record

The record includes the pleadings and, by way of Trademark Rule 2.122, 37 C.F.R. § 2.122, the files of the involved applications.

Opposer, during its trial period, filed a copy of the testimonial deposition transcript, with exhibits, of Allison Kelley, Opposer's vice-president of customer and business intelligence.¹⁴ Opposer also submitted notices of reliance on the following materials: copies of its pleaded registrations obtained from the Office's TSDR electronic database, showing status and title;¹⁵ printouts from the Internet from

¹¹ Issued on July 23, 2013.

¹² Issued on July 23, 2013.

¹³ Issued on December 10, 2013.

¹⁴ 28 TTABVUE. Opposer also submitted a "confidential" version (29 TTABVUE) which the Board has also reviewed and treated it as such in rendering our opinion. It is not available for public viewing.

¹⁵ 24 TTABVUE. These registrations were already of record in light of Opposer's submission of copies of the same from the Office's TSDR electronic database with its Notice of Opposition,

various websites, including articles involving Opposer;¹⁶ copies of six different articles from printed publications;¹⁷ a copy of Applicant's answers to Opposer's first set of interrogatories; a copy of Opposer's first set of requests for admission, dated February 17, 2016, along with a statement from Opposer that Applicant failed to respond to the requests; and a copy of Applicant's responses to Opposer's interrogatory nos. 4-5, 7-8, and 19.

With respect to Opposer's requests for admission and its assertion that Applicant did not respond to them, this has not been contested. Accordingly, the requests for admission are deemed admitted pursuant to Fed. R. Civ. P. 36; *see also* Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i); TBMP § 407.03(a) (TBMP) (June 2017).

The admissions include the following:

- Opposer has standing to oppose registration of Applicant's Marks;¹⁸
- Opposer's rights in Opposer's Mark [ATHLETA] predate any rights Applicant has in Applicant's ATHLETIKA [SP] marks;¹⁹
- The goods identified in the Applications are closely related to the goods and services bearing marks owned by Opposer;²⁰
- The first two syllables of the parties' marks are identical in sight and sound;²¹

pursuant to Trademark Rule 2.122(d).

¹⁶ 25 TTABVUE.

¹⁷ 26 TTABVUE.

¹⁸ 27 TTABVUE 7; Admission No. 1.

¹⁹ *Id.* at 7-8; Admission Nos. 3-4.

²⁰ *Id.* at 8; Admission No. 15.

²¹ *Id.* at 9; Admission Nos. 20-21.

- The SP in Applicant’s mark ATHLETIKA SP means “sport”;²²
- Opposer’s ATHLETA mark is “well-known” and “famous”;²³ and
- “Athletic clothing ... yoga mats ... accessories for use in sports” are offered under the same brand name as “goods for use in physical therapy.”²⁴

We underscore the importance of these admissions because all matters admitted are considered to be “conclusively established unless the court on motion permits withdrawal or amendment of the admission.” *See* Fed. R. Civ. P. 36(b). There is no such motion before us and Applicant has made no attempt to otherwise set aside the admissions. Thus, even if Applicant attempted to rebut the admissions with evidence, and it has not, it would be to no avail. *Texas Dep’t of Transportation v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010); *see also American Automobile Ass’n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (“An admission that is not withdrawn or amended cannot be rebutted by contrary testimony or ignored by the district court....”). Likewise, even if Applicant filed a brief arguing that we should not rely upon the admissions, we would disregard the arguments to avoid any prejudice to Opposer. *Id.* at 1145. That is, Opposer was entitled to rely on the admissions and may have forgone introducing additional evidence to support the issues that are conclusively established by the admissions.

As already noted, Applicant did not introduce any evidence. Nonetheless, as plaintiff in this proceeding, Opposer still bears the burden of proof.

²² *Id.*; Admission No. 22.

²³ *Id.*; Admission Nos. 23-24.

²⁴ *Id.*; Admission Nos. 25-29.

Opposer's Standing and Priority

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show “both a ‘real interest’ in the proceedings as well as a ‘reasonable basis’ for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing in Board proceedings. *Ritchie*, 50 USPQ2d at 1030.

Here, Applicant has admitted that Opposer has standing to bring this opposition. Even without this admission, we would find that Opposer has demonstrated it is more than a mere interloper and has a real interest in and standing to bring this proceeding. Particularly, Opposer made of record its ownership of the pleaded registrations for the mark ATHLETA and Opposer's vice-president of customer and business intelligence, Allison Kelley, has provided uncontroverted testimony that, since 1998, Opposer has used its ATHLETA mark in connection with women's athletic apparel that it sells through an “online channel, as well as in [Opposer's] stores” and that it has “a hundred twenty-plus stores” in the United States.²⁵

²⁵ 28 TTABVUE 12; Kelley Dep. 9:1-3.

Because Opposer's pleaded registrations are of record, priority is not at issue with respect to the goods and services covered by the registrations vis-à-vis the involved applications. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

With respect to Opposer's pleaded common law rights in the ATHLETA mark, Applicant has admitted that Opposer's rights predate any rights Applicant has in Applicant's ATHLETIKA [SP] marks. Moreover, through the testimony of Ms. Kelley, Opposer has established that Opposer began using its ATHLETA mark in 1998 in connection women's athletic apparel and related goods and accessories, and retail services featuring these goods. Opposer's online retail services involve the sale of its own goods as well as third-party goods that are "sold under the ATHLETA trademark," including compression socks.²⁶ Thus, in addition to Applicant's admission that Opposer has priority, Opposer has demonstrated use of its mark in connection with its goods and services before the filing dates of the involved applications, *i.e.*, October 21, 22, 2013, which are the earliest dates of use Applicant can rely upon given he did not submit any evidence.

Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of

²⁶ *Id.* at 31; Kelley Dep. 28:10-18.

likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services, the first two *du Pont* factors. *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 effect of differences in the essential characteristics of the goods and differences in the marks.”). Finally, although Applicant did not introduce any evidence or file a brief, we bear in mind that it is Opposer who bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence.

Similarity of the Parties’ Goods/ Trade Channels

The second and third *du Pont* factors involve an assessment as to the similarity or dissimilarity of the parties’ goods and services, and their established, likely-to-continue trade channels. “In comparing the parties’ goods [and services], ‘[t]he issue to be determined . . . is not whether the goods [or services] of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.’” *Anheuser-Busch, LLC v. Innvopak Sys. Pty. Ltd.*, 115 USPQ2d 1816, 1825 (TTAB 2015) (quoting *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989)).

We must focus on the wording of the applications and registrations, rather than what the record may reveal regarding the parties’ particular goods, because “the

question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

At the outset, we once again point out an admission made by Applicant – the relevant admission here is that “[t]he goods identified in the Applications are closely related to the goods and services bearing marks owned by Opposer.”²⁷ In addition to this admission, which is significant by itself, Opposer also demonstrated that it uses its ATHLETA mark in connection with the sale of compression socks via its online store. Applicant lists “compression socks” in one of the involved applications (Ser. No. 86098697). With respect to Applicant’s “analgesic balm” (in application Ser. No. 86097195), Opposer argues that these goods are similar to its exercise-related goods, such as personal exercise mats, and cites to a prior Board decision finding a relationship between a “liniment for external use” and sports equipment.²⁸

With respect to the channels of trade, there are no limitations in the applications or pleaded registrations as to channels of trade in the descriptions of goods and services. Therefore, we presume that both parties’ goods and services move in all channels of trade normal for those goods and services. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). As

²⁷ 27 TTABVUE 7; Admission No. 15.

²⁸ 32 TTABVUE 28; Opposer’s brief, citing to *Thermo-Flex, Inc. v. Sw. Drug Corp.*, 160 USPQ 47 (TTAB 1968).

noted, Opposer sells compression socks via its online store and compression socks are listed in Applicant's application Serial No. 86098697. Given that an online store, such as Opposer's, is one possible trade channel for Applicant's compression socks, we must assume that Applicant's compression socks may be found in this same trade channel.

In view of the above, we find that Applicant's goods identified in both Classes 3 and 10 are related to Opposer's goods and services. Aside from Applicant's clear admission that the involved goods and services are "closely related," Opposer has shown that it sells compression socks and their online store is one possible trade channel for Applicant's compression socks; thus, there is some overlap in trade channels for the parties' goods and services.

Accordingly, the *du Pont* factor involving relatedness of the goods and services supports a finding of likely confusion and the *du Pont* factor involving their trade channels, at least with respect to compression socks, favors the same finding.

Similarity of the Marks

We now turn to the first *du Pont* factor involving the similarity of the parties' marks. We evaluate the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation and overall commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely

to assume a connection between the parties.” *Coach*, 101 USPQ2d at 1721 (quotation omitted).

Applicant admits that the first two syllables in the marks are identical in sight and sound. We further find that the marks, ATHLETA and ATHLETIKA and ATHLETIKA SP, in their entireties, are visually and aurally very similar. All three marks begin with the same initial six letters – indeed, Applicant is essentially inserting the letters IK into Opposer’s mark, ATHLETA, and, in one instance, adding the letters SP.

In terms of meaning or commercial impression created by the marks, all three marks approximate the same words “athlete” and “athletic” and thus are likely to be perceived by consumers as being suggestive of athletic goods. To the extent that all three marks have a similar “athletic” connotation, this draws them closer. Furthermore, Applicant’s addition of the letters SP do little to change this connotation given Applicant’s admission that these letters mean “sport.” We further note there is no evidence of weakness based on consumer exposure to extensive third-party use of the same or similar marks in connection with the same or similar goods and services.

In sum, we find Applicant’s ATHLETIKA and ATHLETIKA SP marks to be overall similar to the Opposer’s ATHLETA mark. We make this finding based on the identity in sight and sound of the first two syllables and the final syllable in all three marks and the similar connotation created by the marks, with little to distinguish one mark from the other.

Accordingly, this *du Pont* factor also favors a finding of a likelihood of confusion.

Strength or Fame of Opposer's Mark

As a final matter, we address the *du Pont* factor involving the strength of Opposer's registered mark. In the likelihood of confusion context, fame "varies along a spectrum from very strong to very weak." *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (quoting *Palm Bay*, 73 USPQ2d at 1694).

Again, we must give appropriate consideration to Applicant's admissions that Opposer's ATHLETA mark is "well-known" and, indeed, "famous" and find these matters have been conclusively established. We also bear in mind that a famous mark "casts a long shadow which competitors must avoid." *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *see also Kenner Parker Toys, Inc. v. Rose Art Ind., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("[T]he Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark.").

In addition to Applicant's admissions, Opposer submitted evidence to help show that its ATHLETA mark has received some notoriety in connection with women's athletic apparel and related goods and accessories, as well as retail services featuring these goods. While some of the evidence has been designated as "confidential," we are able to note that its annual sales and advertising figures are significant and Opposer has been using its ATHLETA mark for a significant amount of time, nearly twenty

years.²⁹ Opposer also introduced evidence that it has received unsolicited exposure in national and local media outlets.³⁰

Accordingly, we find this *du Pont* factor favors Opposer and a finding that, because its mark is famous and commercially strong, it should be accorded a wider ambit of protection.

Conclusion

In sum, we have found that the *du Pont* factors involving the similarity of the marks, relatedness of the goods and services, and their trade channels (at least with respect to compression socks) all weigh in favor of a likelihood of confusion. That Opposer's mark is "well-known" and "famous" further creates a situation whereby the scope of the mark's protection is widened and the likelihood of confusion is thus enhanced. Ultimately, we find that Opposer has established by a preponderance of the evidence that Applicant's marks, ATHLETIKA and ATHLETIKA SP, are likely to cause confusion with Opposer's mark, ATHLETA, when these marks are used on or in connection with the respective goods and Opposer's services.

Decision: The opposition is sustained with respect to both applications (Serial Nos. 86097195 and 86098697).

²⁹ Much of the evidence involving the strength of Opposer's ATHLETA mark is contained in the confidential testimonial deposition, with exhibits, of Ms. Kelley (29 TTABVUE).

³⁰ 25-26 TTABVUE.