
Federal Circuit: Paw Design Not Confusingly Similar to Brand Name Plus Different Paw Design

Jack

Wolfskin Ausrüstung fur Draussen GmbH & Company KGaA v. New Millennium Sports, S.L.U., 797 F.3d 1363 (Fed. Cir. 2015)

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On August 19, 2015, Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA (“Jack Wolfskin”), represented by Fross Zelnick, won a reversal by the United States Court of Appeals for the Federal Circuit of a ruling by the Trademark Trial and Appeal Board (“TTAB”) in favor of New Millennium Sports, S.L.U. (“New Millennium”) on New Millennium’s opposition to an application filed by Jack Wolfskin.

The case involved Jack Wolfskin’s application to register this mark for various clothing items. New Millennium opposed based solely on its registered mark shown below for clothing items:

In defense of the opposition, Jack Wolfskin argued that KELME, the dominant portion of New Millennium’s mark, was entirely absent from Jack Wolfskin’s mark, and that the paws in the two

marks had many differences, such that consumer confusion was not likely. Jack Wolfskin also submitted many examples of third-party marks on the register and in use for clothing items that consisted of or contained paws, and argued that this dilution meant that consumers knew they needed to look for differences in clothing marks consisting of or containing paws. Under these circumstances, consumers would not be confused between the parties' marks.

The TTAB had ruled for New Millennium for essentially two reasons: First, it stated that “[c]ompanies that use marks consisting of a word plus a logo often display their logos alone, unaccompanied by the literal portions of their trademarks.” It then stated that consumers could interpret Jack Wolfskin’s mark “as a display of [New Millennium]’s design apart from [New Millennium]’s word element.” Based on this reasoning, the TTAB found that there was a likelihood of confusion between the paws in the two marks. Second, the TTAB stated that many of the third-party paw marks submitted by Jack Wolfskin were associated with college sports teams, that they were therefore secondary indicators of source, and that therefore they were less likely to have the dilutive effect that third-party usage of similar marks is generally found to have.

In reversing, the Federal Circuit found neither of these two points to be valid. It stated that the TTAB had improperly ignored part of New Millennium’s mark, namely, the word KELME, in comparing the two marks for purposes of determining whether there was a likelihood of confusion, and that the marks should instead have been compared in their entirety. It found that the Board’s statement that consumers might be confused into thinking that Jack Wolfskin’s mark was a display of the paw in New Millennium’s mark by itself was not based on substantial evidence, which is the standard of review. It stated: “At bottom, neither the Board nor New Millennium has pointed to anything in the record that indicates that consumers recognize solely the paw print portion of New Millennium’s registered mark as being associated with New Millennium’s products. The Board’s finding lacked substantial evidence for minimizing the relevance of the word element of New Millennium’s registered trademark. Indeed, the Board’s conclusion is even more untenable in light of the numerous examples of paw prints as source identifiers” that Jack Wolfskin submitted.

In surprisingly candid words for a reviewing court, the Federal Circuit stated that if the TTAB wanted to put special emphasis on the design portion of a composite mark when comparing marks to determine whether there is a likelihood of confusion, “it must provide a rational reason for doing so,” but that the TTAB had “failed” to do so.

As to Jack Wolfskin's evidence of third-party use of paw marks, the Federal Circuit called that evidence "voluminous." It stated: "In this case, Jack Wolfskin's evidence demonstrates the ubiquitous use of paw prints on clothing as source identifiers. Given the volume of evidence in the record, consumers are conditioned to look for differences between paw designs and additional indicia of origin to determine the source of a given product. Jack Wolfskin's extensive evidence of third-party uses and registrations of paw prints indicates that consumers are not as likely confused by different, albeit similar looking, paw prints. The Board's conclusion... is not supported by substantial evidence."

The Court found that the paw design portion of New Millennium's mark "is relatively weak" and concluded: "Balancing the factors, the Board's determination that Jack Wolfskin's mark would likely cause consumer confusion cannot be sustained."

As a backstop for its defense of New Millennium's opposition, Jack Wolfskin had also filed a counterclaim to cancel New Millennium's registered mark shown above on the ground that New Millennium had abandoned that mark by replacing it with this mark:

The Court affirmed the TTAB's dismissal of Jack Wolfskin's counterclaim on the ground that New Millennium's new mark "creates the same continuing commercial impression" as its registered mark, and therefore the registered mark had not been abandoned. However, since Jack Wolfskin prevailed in defending its application against New Millennium's opposition, the Court's ruling on the counterclaim did not negate the essential outcome of the case: Jack Wolfskin had won.

Primary Contacts

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