

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
October 2, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Facton Ltd., G-Star Raw C.V., and G-Star Inc.
v.
CTS Wholesale, LLC
—

Opposition No. 91199733
Opposition No. 91203141
—

Laura Popp-Rosenberg of Fross Zelnick Lehrman & Zissu, P.C. for Facton Ltd.,
G-Star Raw C.V., and G-Star Inc.

John E. Russell of Allmark Trademark for CTS Wholesale, LLC.
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Before Bergsman, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

CTS Wholesale, LLC (“applicant”) filed intent-to-use applications to register
the mark GSTER, in standard character form (Serial No. 85114667), and GSTER
(stylized), shown below (85361259), both for “sunglasses,” in Class 9.



Gster

Facton Ltd., G-Star Raw C.V., and G-Star Inc. (“opposers”) opposed the registration of applicant’s marks on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Opposers pleaded ownership of registrations for the mark G-STAR. The most pertinent registration for purposes of these proceedings is Registration No. 3264258 for the mark G-STAR, in typed drawing form, for, *inter alia*, “spectacles; sunglasses, sunglass accessories, namely, head straps and sunglass retainers to restrain sunglasses from movement, eyeglass cases, and sunglass cases,” in Class 9.¹ Because opposers attached to the notices of opposition copies of the pleaded registrations printed from the electronic database records of the USPTO showing current status and title, the pleaded registrations are of record. See 37 CFR § 2.122(d)(1).

Applicant, in its answers, denied the salient allegations in the notices of opposition.

The parties stipulated to resolving these proceedings using the Board’s accelerated case resolution (“ACR”) procedure, and are commended for doing so.² As part of their ACR stipulation, the parties agreed that documents produced in response to a request for production of documents are authentic and may be

¹ Issued July 17, 2007 based on an application filed under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). Although opposer Facton Ltd. was required to file a declaration of use by July 17, 2013, Section 8(a)(3) of the Trademark Act, 15 U.S.C. § 1058(a)(3), allows opposer a six-month grace period immediately following the end of the six year expiration period, or until January 17, 2014, to file the required declaration of use. The registration will be cancelled only if opposer does not file a declaration of use before the end of the grace period. See 37 CFR § 2.160(a). Accordingly, Registration No. 3264258 is valid.

² TTABVue 11.

introduced through a notice of reliance and that testimony may be introduced through declarations or affidavits.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the application files for applicant's marks.

The record also includes the following testimony and evidence:

A. Stipulation of facts.³

1. Opposer Facton Ltd. is the owner of opposers' pleaded registrations. G-Star Raw C.V. is Facton Ltd.'s exclusive licensee for the marks in the pleaded registrations. G-Star Inc. is G-Star Raw C.V.'s exclusive sub licensee in the United States for the use of the marks in the pleaded registrations;

2. Opposers have used the mark G-STAR in commerce to identify clothing, footwear, bags and accessories since at least as early as 1994;

3. Applicant did not use its GSTER mark to identify sunglasses prior to August 2010;

4. The earliest priority date upon which applicant may rely is August 24, 2010, the filing date of its application Serial No. 85114667 for the mark GSTER, in standard character form;

5. "The goods set forth in the Applications – namely, 'sunglasses' in International Class 9 – are identical to the goods set forth in [opposers'] Registrations Nos. 3,21,683 and 3,624,258 for the G-STAR mark";⁴

³ TTABVue 18.

6. “Applicant’s consumers for sunglasses under the GSTER mark are not sophisticated, as that term is defined in trademark law.”

7. Neither party is aware of any instance of actual confusion.

B. Opposers' testimony and evidence.

1. Declaration of Richard Anthony Gomez II, sales manager of G-Star USA LLC which is “part of the same group of companies as Opposers,” with attached exhibits;⁵

2. Declaration of Gary Plunkett, licensing director of opposer G-Star Raw C.V., with attached exhibits;⁶

3. Notice of reliance on printed publications and Internet printouts;⁷

4. Notice of reliance on third-party registrations;⁸

5. Notice of reliance on applicant’s responses to opposers’ requests for admissions, interrogatories and document requests;⁹ and

⁴ Discovery was scheduled to close September 2, 2012 and the parties’ “deadline to agree on joint stipulated facts” was set as October 2, 2013. (TTABVue 15 and 16). Registration No. 3214683 for the mark G-STAR (stylized) for, *inter alia*, “sunglasses” registered on March 6, 2007. This is one of opposers’ five pleaded registrations in addition to Registration No. 3264258 discussed above. On August 8, 2013, opposer Facton Ltd. filed a Section 8 declaration of use deleting sunglasses from the registration. Thus, by the time the parties filed their stipulation of facts (October 2, 2013 (TTABVue 17) and October 10, 2013 (TTABVue 18)), applicant had the opportunity to take discovery regarding opposers’ use of its mark on sunglasses and opposers had deleted sunglasses from Registration No. 3214683. Nevertheless, applicant did not seek to file a counterclaim to cancel opposers’ pleaded registration for sunglasses on the ground of nonuse or abandonment.

⁵ TTABVue 31 and 33.

⁶ TTABVue 25.

⁷ TTABVue 30.

⁸ TTABVue 28.

⁹ TTABVue 21 and 40.

6. Notice of reliance on the definition of G-STAR from the Urban Dictionary website (urbandictionary.com), the SoSlang website (SoSlang.com), the Wiki Answers website (wiki.answers.com), and the Definition Of website (definition-of.net).¹⁰

C. Applicant's testimony and evidence.

1. Declaration of Kirk Bachelder, applicant's principal member and founder, with attached exhibits;¹¹

2. Notice of reliance on printed publications and Internet websites;¹² and

3. Notice of reliance on third-party registrations.¹³

Standing

Because opposer Facton Ltd. has properly made its pleaded registrations of record, that opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The stipulation that G-Star Raw C.V. is Facton Ltd.'s exclusive licensee for the marks in the pleaded registrations and that G-Star Inc. is G-Star Raw C.V.'s exclusive sub licensee in the United States for the use of the marks in the pleaded registrations is sufficient to establish standing for G-Star Raw C.V. and G-Star Inc.

¹⁰ TTABVue 39.

¹¹ TTABVue 37.

¹² TTABVue 37.

¹³ TTABVue 38.

Priority

Because opposers' pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative 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, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the 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 effect of differences in the essential characteristics of the goods and differences in the marks"). These factors, and any other relevant *du Pont* factors in the proceedings now before us, will be considered in this decision.

A. Similarity or dissimilarity of the goods, channels of trade and classes of consumers.

The goods in opposers' Registration No. 3264258 for the mark G-STAR include sunglasses and, therefore, opposers' goods and applicant's goods are in part identical. Because the goods described in the involved applications and opposers'

registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant argues that the goods of the parties move in distinct channels of trade.¹⁴ However, the scope of the registration applicant seeks is defined by its application (and not by its actual use); thus, it is the application (and not actual use) that we must look to in determining applicant’s right to register:

The authority is legion that 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 regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

¹⁴ Applicant’s Brief, pp. 24-26 (TTABVue 37, pp. 25-27).

Likewise, in considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958). Accordingly, because there are no limitations as to channels of trade or classes of purchasers in either applicant's or opposers' description of goods, it is presumed that the goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("What is more significant than appellee's failure to limit the description of goods to a particular channel of trade or market, is the absence of a limitation in appellant's registration which would exclude appellee's market. ... therefore, we give full sweep to appellant's registration description of goods and view the goods and modes of distribution the same."); *Kalart Co. v. Camera-Mart, Inc.*, 119 USPQ at 139; *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In view of the foregoing, we find that the goods are in part identical and, therefore, we must presume that they move in the same channels of trade and are sold to the same classes of consumers.

B. The conditions under which and buyers to whom sales are made (i.e., "impulse" vs. careful, sophisticated purchasing).

While the parties have stipulated that applicant's customers are not "sophisticated," applicant argues that because opposers' goods are expensive and are being marketed to "a very 'fashion conscious' and sophisticated consumer base"

who “are very likely to make careful decisions about the clothing items they purchase and ultimately wear,” opposers’ customers “are very unlikely to be confused by the respective marks.”¹⁵ However, as noted above, we cannot resort to extrinsic evidence to restrict opposers’ trade channels or classes of consumers. Likewise, we may not limit the prices of applicant’s or opposers’ goods if those restrictions or limitations are not reflected in the description of goods. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Accordingly, for purposes of these proceedings, we find that the sunglasses identified by both marks include all types of sunglasses, sold at all price points to ordinary consumers who exercise ordinary care when purchasing sunglasses.

C. The number and nature of similar marks in use on similar goods.

The sixth *du Pont* factor requires us to consider evidence pertaining to the number and nature of similar marks in use on similar goods. “The purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

¹⁵ Applicant’s Brief, pp. 23-24 (TTABVue 37, pp. 24-25).

Applicant argues that the term “Star” “is extremely commonplace in the clothing field,” citing to over 40 registrations it introduced into evidence.¹⁶ However, opposers’ mark is G-STAR not “Star” and none of the registrations applicant introduced into evidence is similar to opposers’ mark G-STAR. In fact, only three registrations comprise letters and the word “Star”: (i) Registration No. 4030414 for the mark A-STAR; (ii) Registration No. 3535352 for the mark A-STAR DENIM COMPANY; and (iii) Registration No. 3144038 E.C. STAR.

Moreover, absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any, of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

¹⁶ Applicant’s Brief, p. 21 (TTABVue 37, p. 22) and TTABVue 38, pp. 11-156.

In re Hub Distributing, Inc., 218 USPQ at 286. *See also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given *any* weight”).

Applicant also introduced into evidence screen shots from the ASTARS website (astarswomen.com), B.Star website (bstarfashion.com), Big Star website (buckle.com), Kill Star website (killstarclothing.com), the Little Star Clothing FACEBOOK page (facebook.com), and the No Star website (nostarclothing.com).¹⁷ The third-party websites are not persuasive. First, as indicated above, opposers’ mark is G-STAR, not just STAR, and the third-party websites are for marks that are not as similar to opposers’ mark G-STAR as GSTER. Second, the third-party websites are not accompanied by any other evidence indicating the length of time said marks have been in use, the degree of exposure, or the popularity of such marks vis-a-vis the relevant purchasing public. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1693-94.

On this record, we cannot conclude that the third-party use of marks similar to opposers’ G-STAR mark is so widespread as to “condition” the consuming public that as a result of the mark G-STAR being widely used in connection with clothing and sunglasses it should be accorded only a narrow scope of protection or exclusivity of use.

¹⁷ TTABVue 37, pp. 88-93.

D. The strength of opposers' mark.

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (“In assessing the overall strength of Top's CLASSIC CANADIAN mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); **McCarthy on Trademarks and Unfair Competition** § 11:83 (4th ed. 2013) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's [registration].”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness.

1. Inherent strength.

Opposers' mark is G-STAR used on clothing and sunglasses. According to the Urban Dictionary (urbandictionary.com), G-STAR is a slang abbreviation for “gangster.”¹⁸ Nevertheless, applicant argues that G-STAR is suggestive because

¹⁸ TTABVue 39, p. 5. *See also* the SoSlang website (SoSlang.com), the Wiki Answers website (wiki.answers.com), and the Definition Of website (definition-of.net) (TTABVue 39, pp. 7-11). We note that the parties stipulated that when opposers selected the mark G-

“star” is the dominant portion of opposers’ mark, the word “star” is a part of numerous third-party registrations for clothing, the word “star” connotes something famous or special, and that opposers promote their products as having “star quality.”¹⁹ We find that G-STAR as applied to clothing and sunglasses is fanciful or arbitrary because it signifies nothing other than source. However, even assuming *arguendo* that we found G-STAR suggestive, it would not follow that the mark’s inherent strength obviates the likelihood of confusion of purchasers encountering G-STAR and GSTER on identical products. *Maytag Co. v. Luskin’s Inc.*, 228 USPQ 747, 750 (TTAB 1986). *See also King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (“The likelihood of confusion is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.”).

2. Acquired strength.

Opposers have used the mark G-STAR in commerce to identify clothing, footwear, bags and accessories since at least as early as 1994.²⁰ As of November 2012, there are 15 franchised G-STAR RAW stores in 11 cities in the United States, including New York City, Boston, Washington, D.C., Chicago, San Francisco, Los Angeles and San Diego. Additionally, there are over 200 other retail stores selling

STAR, they did not intend for G-STAR to connote the term “gangster.” (TTABVue 18, p. 5). However, what opposers intended may not be what the customers perceived, which is what we are concerned with here.

¹⁹ Applicant’s Brief, pp. 22-23 (TTABVue 37, pp. 23-24).

²⁰ Stipulation of facts (TTABVue 18).

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G-STAR products in the United States, including Nordstrom, Bloomingdale's, Kitson, DNA 2050, Universal Gear and Politix.²¹

Opposers' sales revenues and units, as well as advertising expenditures, were designated confidential so we may reference them in only general terms. These figures indicate that opposers are operating a successful company.²² Opposers' success is corroborated by the media attention opposers' G-STAR brand has garnered,²³ including an article entitled "G Major" in the May 2009 *Time Style & Design* supplement.²⁴

While mindful that there is no evidence that opposers have used their G-STAR mark to identify sunglasses, we find that opposers' G-STAR mark is a strong mark that has become recognized by the public, at least when used in connection with clothing.

E. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d

²¹ Gomez Declaration ¶12 (TTABVue 31, page illegible).

²² Gomez Declaration ¶¶ 16-18 (TTABVue 31, pages illegible).

²³ TTABVue 32, pp. 143-254.

²⁴ TTABVue 32, pp. 179-181.

1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are sunglasses, we are dealing with ordinary consumers.

The fact that one of applicant's marks is presented in an "Old English" font does not avoid likelihood of confusion with opposers' mark because opposers' mark is in standard character form and, therefore, it may be presented in the same font

as applicant's mark as shown below. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (the argument concerning a difference in type style is not viable where one party asserts rights in no particular display).

☉-star

Therefore, we must assume that both parties may employ the same stylization or display of the letters in the involved marks. *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992).

We also disagree with applicant's argument that the word "Star" is the dominant element of opposers' mark.²⁵ First, we note that this argument is inconsistent with applicant's argument that the word "Star" "is extremely commonplace in the clothing field," citing to over 40 registrations it introduced into evidence.²⁶ If "Star" were a weak term in the clothing [or sunglass] field, then consumers would look to the other elements of the mark to identify source. Supporting the supposition that the letter "G" is the dominant element in opposers' mark is the principal that consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay*, 73 USPQ2d at 1692; *see also L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012) *citing Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be

²⁵ Applicant's Brief, p. 15 (TTABVue 37, p. 16).

²⁶ Applicant's Brief, p. 21 (TTABVue 37, p. 22) and TTABVue 38, pp. 11-156.

impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Here, the first part of opposers’ mark and the first part of applicant’s marks are the letter G, which is the part of the mark most likely to be impressed upon the minds of consumers.

In any event, G-STAR and GSTER are similar in terms of appearance and sound. The only difference between the marks is the letter “e” in applicant’s mark in lieu of the letter “a” in opposers’ mark. Slight differences in marks do not normally create dissimilar marks. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Moreover, although there are certain differences between the [marks’ CAYNA and CANA] appearance, namely, the inclusion of the letter ‘Y’ and the design feature in applicant’s mark, there are also obvious similarities between them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions”). *See also Hercules Inc. v. National Starch & Chemical Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) (“it is a fundamental tenet of our trademark law that exact similitude is not required to conclude that two marks are confusingly similar. Thus, when there are small differences between the marks, the differences may be insignificant in obviating the likelihood of confusion when compared to the marks’ overall similarities”); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 306

(TTAB 1977) (“AFCO’ and ‘CAFCO,’ which differ only as to the letter ‘C’ in USM’s mark, are substantially similar in appearance and sound.”).

The presence or absence of the hyphen is an inconsequential difference that even if noticed or remembered by consumers will not serve to distinguish these marks. *Goodyear Tire & Rubber Company v. Dayco Corporation*, 201 USPQ 485, 489 n.4 (TTAB 1978) (“Fast-Finder” with hyphen is in legal contemplation substantially identical to “Fastfinder” without hyphen). *See also Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) (MAGNUM and MAG-NUM are essentially identical); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2042 (TTAB 1989) (PRO-PRINT is similar to PROPRINT).

The marks have similar meanings. As indicated above, opposers introduced a definition from the Urban Dictionary (urbandictionary.com) to show that G-STAR means gangster.²⁷ Applicant adopted the mark GSTER as an alternative to “Gangster” or “Gangsta.”²⁸

In view thereof, when we compare the marks in their entireties, we find that that they are more similar than dissimilar.

Applicant argues that in the “vast majority of Opposers’ web and online marketing materials, the term ‘G-Star’ is paired with the term ‘RAW’” and,

²⁷ TTABVue 39, p. 5. *See also* the SoSlang website (SoSlang.com), the Wiki Answers website (wiki.answers.com), and the Definition Of website (definition-of.net) (TTABVue 39, pp. 7-11).

²⁸ Bachelder Dec. ¶ 11 (TTABVue 37, p. 41) (“GSTER’ was the next best available variant of the term ‘GANGSTER.’”).

therefore, consumers are “comparing GSTER to ‘G-STAR RAW.’”²⁹ However, opposers’ pleaded registration is for the mark G-STAR alone; not G-STAR RAW. The registrability of an applicant’s mark is determined on the basis of how the applicant’s mark and the opposers’ marks are set forth in their respective application and registration. *See Kimberly-Clark Corporation v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541, 543 (Fed. Cir. 1985); *Vornado, Inc. v. Breuer Electric Mfg., Co.*, 390 F.2d 724, 156 USPQ 340, 343 (CCPA 1968) (“the display of the mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of the mark.”). Thus, it is irrelevant to the issue of likelihood of confusion in these proceedings whether opposers use other words when they display their mark.

F. Actual confusion.

Applicant argues that there have been no reported instances of actual confusion. This is not surprising as opposers have not sold and are not selling sunglasses.³⁰ Accordingly, there have not been any meaningful opportunities for confusion to have occurred. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

²⁹ Applicant’s Brief, pp. 17-18 (TTABVue 37, pp. 18-19).

³⁰ Opposers’ Brief, pp. 11-12 (TTABVue 22, pp. 12-13).

Even when we consider opposers' use of its mark on clothing, there has been little opportunity for confusion to have occurred. Applicant began using its mark GSTER on sunglasses in January 2011.³¹ Since that time, applicant has sold only a small number of sunglasses and expended a minimal amount on advertising.³² Moreover, those sunglasses that applicant has sold have been sold in channels of trade that are different than the channels of trade in which opposers' goods move. According to applicant, it "specifically targets its wholesale sunglasses to vendors who sell these sunglasses at venues such as gas stations, convenience stores, fairs and festivals, and swap meets."³³ On the other hand, opposers' products are more upscale. They are sold in 15 franchised G-STAR RAW stores in 11 cities in the United States, including New York City, Boston, Washington, D.C., Chicago, San Francisco, Los Angeles and San Diego. Additionally, there are over 200 other retail stores selling G-STAR products in the United States, including Nordstrom, Bloomingdale's, Kitson, DNA 2050, Universal Gear and Politix.³⁴

In view of the foregoing, we find that the lack any reported instances of actual confusion is a neutral factor.

G. Balancing the factors.

Because the marks are similar, the goods are identical and presumed to move in the same channels of trade and be sold to the same classes of consumers, we find

³¹ Bachelder Dec. ¶ 12 (TTABVue 37, p. 42).

³² *Id.* Applicant submitted the Bachelder Declaration under seal and, therefore, we may only refer to applicant's sales and advertising expenditures in general terms.

³³ *Id.* at ¶ 5 (TTABVue 37, p. 39).

³⁴ Gomez Declaration ¶12 (TTABVue 31, page illegible).

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that applicant's mark GSTER and GSTER and design for "sunglasses" is likely to cause confusion with opposers' mark G-STAR for sunglasses.

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