

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 14, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Old Navy (Apparel), LLC*  
*v.*  
*Gregory C. Blissman*

—  
Opposition No. 91234507

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David Donahue and Emily Weiss of  
Fross Zelnick Lehrman & Zissu, P.C. for Old Navy (Apparel), LLC

Gregory C. Blissman, Esq., *pro se*

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Before Thurmon, Deputy Chief Administrative Trademark Judge, and  
Adlin and Lynch, Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Gregory C. Blissman (“Applicant”) seeks registration on the Principal Register of  
OLD IVY in standard characters<sup>1</sup> for “clothing, namely, t-shirts, polo shirts, rugby

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<sup>1</sup> Application Serial No. 87256005 was filed on December 2, 2016 based on an alleged intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

shirts, sweaters, sweatshirts, hooded sweatshirts, hats, knitted caps” in International Class 25.

By its Notice of Opposition, Old Navy (Apparel), LLC (“Opposer”) opposes registration of the marks based on alleged dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and alleged likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s following live registered marks, shown below, status and title copies of which were submitted for the record:<sup>2</sup>

<b>Registration Number</b>	<b>Mark</b>	<b>Services</b>
Reg. No. 1928001	OLD NAVY (typed form) <sup>3</sup>	clothing, namely jeans
Reg. No. 2006872	OLD NAVY (typed form)	clothing, namely shirts, T-shirts, shorts, pants, skirts, sweaters, jackets, dresses, belts, hats, socks, gloves, vests, scarves, sleepwear, bathing suits, tights, leggings, rompers, overalls and shoes
Reg. No. 2207288	OLD NAVY (typed form)	Clothing, namely, jeans, pants, shorts, overalls, shortalls, leggings, rompers, khakis, jackets, coats, anoraks, sweatshirts, sweat pants, fleece tops and pants, sweaters, t-shirts, shirts, vests, skirts, dresses, scarves, gloves,

<sup>2</sup> 6 TTABVUE 664-700. Citations refer to TTABVUE, the Board’s online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Registration Number 1965488 for the mark **OLD NAVY**, which Opposer pleaded and introduced, was cancelled on April 22, 2019 for failure to file the required Section 8 affidavit of continued use. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).” *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”); *see also In Re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979). We therefore give the cancelled registration no consideration.

<sup>3</sup> A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

		caps, hats, socks, belts, shoes, boots, sneakers, tights, hosiery, neckties, sleepwear, bathing suits, beachwear, bathrobes, underwear, layettes, and infantwear
Reg. No. 2414675	OLD NAVY (typed form)	Computerized on-line retail services in the fields of clothing, clothing accessories, sunglasses, souvenir items, home products, linens, luggage and bags

In his Answer, Applicant denies most of Opposer’s allegations underlying the claims, except for certain admissions, including the following:<sup>4</sup>

It is admitted that the Opposer has used the mark OLD NAVY and various OLD NAVY-formative marks (collectively, the “OLD NAVY Mark or “Opposer’s Mark”) for many years in connection with a wide variety of goods and services.

It is admitted that Opposer is the owner of all right, title, and interest in and to the OLD NAVY Mark in connection with a wide variety of goods and services based on the first use in commerce in 1994. It is also admitted that Opposer is the owner of numerous U.S. trademarks for the OLD NAVY Mark as described in paragraph 2 of its Notice of Opposition.

It is admitted that the Applicant was on actual notice of Opposer’s prior rights in and to the OLD NAVY Mark.

It is admitted that Opposer’s OLD NAVY Mark is a famous mark, and became so prior to December 2, 2016.

In addition to the grounds set out in Opposer’s Notice of Opposition, Opposer subsequently moved to amend its Notice of Opposition to add the ground of mere descriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).<sup>5</sup> We

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<sup>4</sup> 4 TTABVUE.

<sup>5</sup> 24 TTABVUE.

sustain the opposition on likelihood of confusion grounds and do not reach any other grounds. Opposer's motion to amend, and the related motion to strike Exhibits ON32-35 of Opposer's Rebuttal Notice of Reliance, therefore are moot.<sup>6</sup>

The opposition is fully briefed.

## I. Evidentiary Record and Related Matters

The record includes the pleadings and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed application.

Concurrently with its Brief, Opposer submitted a separate statement of evidentiary objections,<sup>7</sup> to which Applicant filed a response,<sup>8</sup> and Opposer replied.<sup>9</sup> In his Brief, Applicant attempts to rely on certain websites, screenshots of which are not included in the record, simply by including their URLs.<sup>10</sup> Applicant also cites to dictionary entries not in the record for "glory" and "navy" for purposes of establishing

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<sup>6</sup> Both motions were deferred by prior order of the Board. 30 TTABVUE.

<sup>7</sup> 33 TTABVUE.

<sup>8</sup> 34 TTABVUE.

<sup>9</sup> 36 TTABVUE. After that, Applicant moved "to strike extraneous comments in" Opposer's reply, 39 TTABVUE, to which Opposer filed an "opposition," 42 TTABVUE, and Applicant then submitted a "rebuttal." 44 TTABVUE. These submissions are outside the options provided under the rules, 37 C.F.R. § 2.128, and we decline to consider the additional filings at 39 TTABVUE, 42 TTABVUE, and 44 TTABVUE. *Cf. Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Federal Circuit found that the Board did not abuse its discretion in applying the plain language of the TBMP and excluding defendant's reply brief); *United Foods Inc. v. United Airlines Inc.*, 33 USPQ2d 1542, 1542 (TTAB 1994); *see also Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1216 n.1 (TTAB 2007) ("the Board does not consider sur-replies").

<sup>10</sup> 35 TTABVUE 20, 22-23.

their pronounciation.<sup>11</sup> In its Reply Brief, Opposer objects to Applicant's introduction of new evidence in his Brief.<sup>12</sup>

Once the scheduled trial periods have closed, further evidence will not normally be accepted or considered, unless the party seeking to offer the evidence moves to reopen the relevant trial periods and shows that its failure to timely submit the evidence was the result of excusable neglect. *See* TBMP § 509.01(b)(1) (2019) (citing Fed. R. Civ. P. 6(b)(1)(B)). Applicant has not requested reopening of his trial period, nor has he shown excusable neglect. TBMP § 704.05(b) provides that “[e]xhibits and other evidentiary materials attached to a party’s brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.” We therefore decline to consider the untimely evidence, and regardless, the Board has “made clear that providing hyperlinks to Internet materials is insufficient to make such materials of record.” *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013) (citing *In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (“a reference to a website’s internet address is not sufficient to make the content of that website or any pages from that website of record.”)). As to the dictionary entries to which Applicant refers, we need not rely on the dictionary for the undisputed proper pronounciation of the common English language words “glory” and “navy,”

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<sup>11</sup> 35 TTABVUE 22.

<sup>12</sup> 37 TTABVUE 7-8. We consider the submissions at 41 TTABVUE and 43 TTABVUE because of this unusual situation where the evidence in question was offered for the first time in Applicant’s Brief, and Opposer’s objections could not have been made earlier.

Opposer also objects to various portions of Applicant's trial declaration and the accompanying exhibits on grounds including hearsay, irrelevance, or lack of foundation due to no personal knowledge of certain matters.

As to the testimony itself, "the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing." *Bd. of Regents v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014) (citations omitted). We therefore overrule Opposer's objections to the testimony, but will weigh its relevance, appropriate foundation or lack thereof, and strength or weakness, including any inherent limitations therein. Thus, for example, to the extent Applicant offers testimony about Opposer's business without establishing any underlying personal knowledge of it, we give such testimony little or no probative value.

Turning to the exhibits objected to on hearsay grounds, "[a]s a general matter, we do not treat testimony as to third-party out-of-court statements as proof of the truth of the matter asserted. The same is true for published articles [and internet website printouts]. However, such materials are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false. Accordingly, they will not be excluded outright, but considered for what they show on their face." *Harry Winston*, 111 USPQ2d at 1427-28.

In short, as indicated, “the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence. Thus, we have considered the evidence, keeping in mind the objections, and have accorded whatever probative value the testimony and evidence merits.” *United States Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006).

As noted above, we need not decide Applicant’s motion to strike Exhibits ON32-35 of Opposer’s Rebuttal Notice of Reliance because the Notice states that these exhibits relate only to descriptiveness, an issue we do not reach.

## II. Standing

Opposer must prove standing by showing a real interest in the outcome of the proceeding and a reasonable basis for believing that it would suffer damage if the mark is registered. *See* 15 U.S.C. § 1063; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Opposer’s pleaded registrations, for which it has proven status and title, establish its standing. *See Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Applicant concedes Opposer’s standing.<sup>13</sup>

## III. Priority

Because Opposer has made its registrations set out above of record, which Applicant has not counterclaimed to cancel, priority is not an issue as to the marks

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<sup>13</sup> 35 TTABVUE 14 (Applicant’s Brief).

and goods and services covered by the registrations. *See Top Tobacco LP v. N. Atl. Op. Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (citing *King Candy, Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974)). *See also Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) (“prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation.”); *Itel Corp. v. Ainslie*, 8 USPQ2d 1168, 1169 (TTAB 1988) (“because of the existence of opposer’s valid and subsisting registration, it need not prove prior use as to the services recited therein”).

#### IV. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods. *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.”). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. Each of Opposer’s registrations is for the identical OLD NAVY mark. For purposes of the likelihood of confusion analysis, we focus on Opposer’s



Registration Numbers 2006872 and 2207288 that cover, *inter alia*, shirts, T-shirts, sweaters, sweatshirts, and hats, which overlap with Applicant's goods. If the registrations with overlapping goods do not result in likely confusion, the other registrations that cover other goods and services would not either. And if the registrations with overlapping goods result in likely confusion, we need not rely on the other registrations to sustain the opposition. We therefore consider Registration Numbers 2006872 and 2207288 most relevant to the likelihood of confusion analysis. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Goods, Trade Channels and Classes of Consumers

Our comparison of the goods must be based on the identifications in the application and Opposer's registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A finding of likely confusion must be made with respect to at least one item in the application to establish likely confusion as to that class of goods. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). As identified, the goods are in-part identical, as both Opposer's registrations and the application include shirts, T-shirts, sweaters, sweatshirts, and hats.

Applicant suggests that its clothing will be higher-end<sup>14</sup> than Opposer's, but, as Applicant acknowledges,<sup>15</sup> his identification of goods contains no such restrictions.

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<sup>14</sup> 35 TTABVUE 32-34 (Applicant groups himself with "other high-end luxury brands").

<sup>15</sup> 35 TTABVUE 33-34 (acknowledging that Applicant did not want to forego opportunities to sell at more moderate price points and therefore "he did not put any restrictions or limitations

Opposer's identification is similarly broad. Given the absence of restrictions, *see Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000), we cannot consider these alleged actual marketplace differences. *Stone Lion Capital Partners*, 110 USPQ2d at 1162 ("It was proper, however, for the Board to focus on the application and registrations rather than on real world conditions, 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.'" (quoting *Octocom Sys.*, 16 USPQ2d at 1787)); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) ("Indeed, the owner of an unrestricted registration is entitled to change its current trade channels at any time").

Because the goods in the pleaded registrations are identical in part to Applicant's, we presume that they travel through the same channels of trade to the same classes of purchasers, considerations under the third *DuPont* factor. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also Viterro*, 101 USPQ2d at 1908 (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

These factors weigh strongly in favor of likely confusion.

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in the Application regarding the identity of goods, channels of commerce, or price points that would affect the types of consumers who could buy Old Ivy products.").

## B. The Strength of Opposer's Mark

Before we turn to the similarity of the marks, we consider the strength of Opposer's mark, as that will affect the scope of protection to which it is entitled. As noted above, Applicant's Answer explicitly admits the fame of Opposer's mark.<sup>16</sup> However, in his Brief, Applicant contends that OLD NAVY is descriptive of some of Opposer's goods because it refers to the color of the goods (one pair of pants has a color described on the website as "in the navy,"<sup>17</sup> while the website shows "Color: Old Navy" for a T-shirt emblazoned with the wording OLD NAVY<sup>18</sup> and "Color: Old Navy San Francisco" for a T-shirt emblazoned with the wording OLD NAVY San Francisco) and is "suggestive of a nautical theme."<sup>19</sup>

Applicant introduced definitions of "old" and "navy" which on their face do not refer to clothing, but "navy" can refer to a shade of blue.<sup>20</sup> However, we do not find the evidence Applicant relies on from Opposer's website persuasive to show that OLD NAVY merely describes a feature of the goods, including their color. We find that the references in the T-shirt descriptions appear to refer to the wording – Opposer's mark – emblazoned across the shirts. *See In re LuluLemon Athletica*, 105 USPQ2d 1684 (TTAB 2013) (recognizing that clothing industry practice includes having logos and marks prominently emblazoned across a garment). We also find that Applicant has

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<sup>16</sup> 4 TTABVUE 7.

<sup>17</sup> 6 TTABVUE 58.

<sup>18</sup> 6 TTABVUE 143.

<sup>19</sup> 35 TTABVUE 19.

<sup>20</sup> 21 TTABVUE 9-10.

not supported his argument that OLD NAVY is suggestive of nautical-themed clothing with any evidence other than Opposer's naming clothing colors such as "A Shore Thing," "Majestic Sea," and "New Navy Anchors," which does not establish that the clothing is nautical in nature or that OLD NAVY suggests or describes a feature of it. Based on the record in this case, we find OLD NAVY arbitrary. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173 (Fed. Cir. 2004) (defining an arbitrary mark as a "known word used in an unexpected or uncommon way" and observing that such marks are typically strong); *see also Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks).

The commercial strength of a mark under the fifth *DuPont* factor rests on the extent to which "a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps.*, 73 USPQ2d at 1694). This factor involves assessing the mark "along a spectrum from very strong to very weak." *Id.* (internal citations omitted). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis. *See Palm Bay Imps.*, 73 USPQ2d at 1694 (strong marks "enjoy wide latitude of legal protection" and are "more attractive as targets for would-be copyists").

Commercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other

factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the marks; and the general reputation of the goods. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength).

Opposer points to a wide variety of evidence of commercial strength, some of which is confidential, so we discuss it only in general terms. Opposer's evidence shows annual revenue figures for clothing sold under the mark in the billions of dollars and its status among the leading apparel retailers.<sup>21</sup> Opposer has invested a very substantial sum advertising its mark.<sup>22</sup> The probative value of the high revenue and advertising figures is enhanced by Opposer providing details and representative examples of the nature of the advertising,<sup>23</sup> *see Bridgestone Ams. Tire Ops., LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063-64 (Fed. Cir. 2012) ("many commercial examples in which the marks ... are prominently featured"), and comparative information about the industry.<sup>24</sup> *See Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("some context in which to place raw [sales and advertising] statistics is reasonable"). For example, Opposer has run print advertisements in well-known newspapers and magazines such as the

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<sup>21</sup> 6 TTABVUE 7; 7 TTABVUE (confidential).

<sup>22</sup> 6 TTABVUE 6; 7 TTABVUE (confidential).

<sup>23</sup> 6 TTABVUE 167-201.

<sup>24</sup> 6 TTABVUE 7; 7 TTABVUE 7 (confidential).

San Francisco Chronicle, Vogue, Elle, US Weekly, People, Cosmopolitan, and InStyle.<sup>25</sup> Opposer's television advertisements, screenshots of which were provided, have aired on various major networks during, for example, Super Bowl and Olympics broadcasts.<sup>26</sup> Opposer has almost a thousand retail stores throughout the United States bearing the mark on signage and on the goods sold in the stores.<sup>27</sup> Opposer also provided evidence establishing significant visitor traffic to its website, as well as its extensive social media presence and impact,<sup>28</sup> its digital advertising on websites such as YouTube and Yahoo!,<sup>29</sup> and its high volume of email marketing.<sup>30</sup>

Opposer introduced articles recognizing Opposer's notable advertising, for example for its celebrity stars, or as especially creative or amusing. Articles appeared in Adweek and HuffPost TV,<sup>31</sup> as well as The Wall Street Journal, BuzzFeed Business and others.<sup>32</sup> Other articles have recognized Opposer's advertising activities more generally or its corporate performance, such as in the online San Francisco Chronicle Business Report and Forbes.<sup>33</sup>

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<sup>25</sup> 6 TTABVUE 4.

<sup>26</sup> 6 TTABVUE 4.

<sup>27</sup> 6 TTABVUE 4-5, 7-8, 123-36, 320-24.

<sup>28</sup> 6 TTABVUE 5; 7 TTABVUE 5 (confidential); *see also* 6 TTABVUE 14-122 (excerpts from website).

<sup>29</sup> 6 TTABVUE 5; 7 TTABVUE 5 (confidential).

<sup>30</sup> 6 TTABVUE 6; 7 TTABVUE 6 (confidential).

<sup>31</sup> 6 TTABVUE 540-44.

<sup>32</sup> 6 TTABVUE 551-75, 597-612.

<sup>33</sup> 6 TTABVUE 544-50.

Under the sixth *DuPont* factor, proof of recent consumer exposure to third-party use of similar marks in connection with similar services may show commercial weakness of a mark. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Applicant does not point to such third-party use evidence that could show that consumers are accustomed to distinguishing among marks with a particular shared component based on other matter. Instead, Applicant focuses on mere third-party registrations of marks that include OLD.<sup>34</sup> However, the record in this case includes only two third-party registrations for the marks OLD COUNTRY and OLD GLORY for clothing.<sup>35</sup> The other third-party registrations Applicant relies on are for goods or services distinct from the clothing at issue, such as cigars, food products, and whiskies.<sup>36</sup> Such registrations have no bearing on the strength of the term for clothing. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, ... support a finding that registrants’ marks are weak with respect to the goods identified in their registrations”).

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<sup>34</sup> Third-party registrations do not demonstrate use that could support commercial weakness, but nonetheless may be considered evidence of conceptual weakness of a term. *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”).

<sup>35</sup> 21 TTABVUE 117-19.

<sup>36</sup> 21 TTABVUE 111-21.

Thus, with Applicant's relevant evidence consisting only of two third-party registrations, with no accompanying use evidence, we do not find it sufficient to demonstrate the weakness of Opposer's mark. This record "falls short of the 'ubiquitous' or 'considerable' use of the mark components present in [*Juice Generation* and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015)]." *i.am.symbolic*, 123 USPQ2d at 1749; contrast *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

Considering all the evidence regarding strength, we find that Opposer's mark is conceptually and commercially strong. The evidence of revenue statistics, advertising expenditures and examples, unsolicited media coverage, the number of stores, and Internet and social media presence, reflects the renown of Opposer's mark and shows widespread consumer exposure to and recognition of this mark. Overall, consistent with Applicant's admission in his Answer, we find Opposer's OLD NAVY mark to be famous for likelihood of confusion purposes, weighing in favor of a likelihood of confusion. *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) ("Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark .... When



an opposer's trademark is a strong, famous mark, it can never be of little consequence.") (quoting *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984)).

### C. Similarity of the Marks

With respect to the marks, we must compare them "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Similarity in any one of the elements of sound, appearance, meaning, or commercial impression suffices to support a determination of likelihood of confusion. *See In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.").

The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). We also bear in mind that, given the identical-in-part goods, "the degree of similarity necessary to support a

conclusion of likely confusion declines.” *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

We compare Opposer’s OLD NAVY mark to Applicant’s OLD IVY mark. Both marks consist of two words, and have the identical first word, OLD. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (first part of mark is “most likely to be impressed upon the mind of a purchaser and remembered.”). In both marks, the second words have two syllables and share the common –VY ending. These common elements create both a visual resemblance and a phonetic similarity. Obviously, Applicant’s second word, IVY, differs in appearance and sound from Opposer’s second word, NAVY, but overall, we find that the similarities outweigh the differences, and the marks overall look and sound similar.

The connotations of the marks also have some similarity because of the shared term OLD. In each mark, however, we agree with Applicant that the adjective OLD appears to modify the noun that follows it, NAVY and IVY, respectively.<sup>37</sup> NAVY and IVY are not similar in meaning and therefore the additional wording creates a difference in the overall connotations of the marks.

Applicant emphasizes what he argues is the distinct commercial impressions of his mark. Although Applicant has submitted dictionary entries for “ivy” defining it as a plant or a feminine name,<sup>38</sup> according to Applicant, OLD IVY would call to mind

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<sup>37</sup> 35 TTABVUE 26-27.

<sup>38</sup> 21 TTABVUE 9-10.

the Ivy League, “elite and traditional universities” or as the name of a school.<sup>39</sup>

Applicant’s evidence includes:

An article from BusinessInsider.com on a company called Hillflint that is “bringing back the ‘old ivy’ vintage look.”<sup>40</sup>

An article from ivy-style.com titled “The Rise and Fall of the Ivy League Look” that refers in a descriptive manner to “the Ivy League Look” and “Ivy.”<sup>41</sup> However, the article quotes a 1971 source as stating that “[t]he Ivy League look as it used to be called died in the recent fashion revolution....”<sup>42</sup> And, “despite the efforts of the MFIT’s [Museum of the Fashion Institute of Technology’s] “Ivy Style” book and exhibit, not to mention Ivy-Style.com, preppy remains closer to the tongue, however bitter it tastes, than ‘Ivy League’ when describing this genre of clothing.”<sup>43</sup>

An article from GentlemansGazette.com titled “The Ivy Style Primer,” about “Ivy style, which unbeknownst to most, is actually a style of its own, separate and apart from prep and trad.”<sup>44</sup> “Ivy style is about two things. Representing yourself through your wardrobe as a member of one of the most elite universities or colleges in the world and dressing down when the authority figure such as your father would normally dress up.”<sup>45</sup> The article lists five books on “Ivy Style” that include the term “Ivy” in their titles.<sup>46</sup>

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<sup>39</sup> 35 TTABVUE 30.

<sup>40</sup> 20 TTABVUE 60.

<sup>41</sup> 20 TTABVUE 63-107.

<sup>42</sup> 20 TTABVUE 96.

<sup>43</sup> 20 TTABVUE 101.

<sup>44</sup> 20 TTABVUE 108.

<sup>45</sup> 20 TTABVUE 113.

<sup>46</sup> 20 TTABVUE 122-27.

Screenshots from ivyleague.com,<sup>47</sup> Harvard.edu,<sup>48</sup> Yale.edu,<sup>49</sup> Princeton.edu,<sup>50</sup> Upenn.edu,<sup>51</sup> Brown.edu,<sup>52</sup> Columbia.edu,<sup>53</sup> Dartmouth.edu,<sup>54</sup> Cornell.edu,<sup>55</sup> referring to the Ivy League comprised of these schools.

Applicant's somewhat limited evidentiary submissions do not necessarily reflect widespread consumer understanding of OLD IVY, but constitute some evidence that in the context of clothing, IVY or OLD IVY may point to a particular style.

Applicant then argues that Opposer's clothing in the marketplace is "low-end," but does not explain how that argument relates to the commercial impression of the OLD NAVY mark itself, particularly given that we consider Opposer's mark in the context of its unrestricted identification of clothing. *See Paula Payne Prods. Co. v. Johnson Publ'g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973) (Board must "give full sweep" to an identification of goods regardless of registrant's actual business). Thus, we find this contention irrelevant to our comparison of the marks.

Overall, regardless of whether OLD IVY may give some impression of particular schools or a particular style, which OLD NAVY does not, given the renown of the OLD NAVY mark and the partially identical wording and similar overall structure of the

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<sup>47</sup> 21 TTABVUE 13-26.

<sup>48</sup> 21 TTABVUE 28-33.

<sup>49</sup> 21 TTABVUE 34-59.

<sup>50</sup> 21 TTABVUE 60-76.

<sup>51</sup> 21 TTABVUE 77-79.

<sup>52</sup> 21 TTABVUE 80-84.

<sup>53</sup> 21 TTABVUE 85-90.

<sup>54</sup> 21 TTABVUE 91-95.

<sup>55</sup> 21 TTABVUE 96-99.

marks, we find that the OLD IVY mark still creates a similar commercial impression to OLD NAVY. Consumers likely could view OLD IVY as a variation on OLD NAVY, perhaps used to promote clothing with a more traditional style. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion”); *see also Kenner Parker Toys, Inc. v. Rose Art Ind., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (Opposer’s famous mark “casts a long shadow which competitors must avoid”).

We find the marks sufficiently similar in terms of appearance, sound, and commercial impression that this *DuPont* factor weighs somewhat in favor of a likelihood of confusion.

## V. Conclusion

Fame “plays a dominant role in the process of balancing the *DuPont* factors.” *Recot*, 54 USPQ2d at 1897. Applicant’s mark is for goods that are in part identical to Opposer’s goods, and travel in the same channels of trade. Given this, we find Applicant’s mark sufficiently similar to Opposer’s famous mark that a likelihood of confusion exists.

**Decision:** The opposition is sustained based on the likelihood of confusion. We therefore need not reach any other grounds for opposition.