

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 78296792

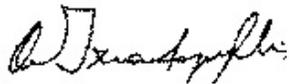
For the Mark: BORN IN TEXAS

Date Filed: September 5, 2003

George H. Zoes)	
Opposer)	Opposition No.: 91161124
)	
v.)	
)	
Brett Shevack)	
Applicant)	

OPPOSER'S TRIAL BRIEF

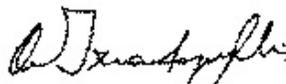
The undersigned hereby certifies that Opposer's Trial Brief is being electronically filed with the Trademark Trial and Appeal Board using the ESTAA on July 13, 2006.



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Respectfully submitted,



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SUMMARY OF THE RECORD

The evidence of record in this matter consists of the following:

- I. June 10, 2005, Opposer's Notice of Reliance including:
- (1) A true and correct copy of the U.S. Trademark Registration 2,922,037 ("ONR Exh. 1").
 - (2) A true and correct copy of Declaration of Nicholas Servos, dated March 17, 2005 ("ONR Exh. 2").
 - (3) A true and correct copy of Declaration of Melissa Young, dated March 17, 2005 ("ONR Exh. 3").
 - (4) A true and correct copy of Declaration of Lauren Morrow, dated March 17, 2005 ("ONR Exh. 4").
 - (5) A true and correct copy of Declaration of Kenneth Bart, dated March 17, 2005 ("ONR Exh. 5").
 - (6) Applicant's response to Opposer's First Set of Interrogatories, dated December 3, 2004 ("ONR Exh. 6").
 - (7) Applicant's Response to Opposer's Request for Production, dated December 3, 2004 ("ONR Exh. 7").
 - (8) Opposer's response to Applicant's First Set of Interrogatories, dated March 18, 2005 ("ONR Exh. 8").
 - (9) Opposer's Response to Applicant's Request for Production, dated March 18, 2005 ("ONR Exh. 9").
 - (10) Opposer's Supplemental Response to Applicant's First Set of Interrogatories, dated

April 12, 2005 (“ONR Exh. 10”).

- (11) Notice of Opposition, dated June 14, 2004 (“ONR Exh. 11”).
 - (12) Answer to Notice of Opposition, dated August 9, 2004 (“ONR Exh. 12”).
 - (13) Applicant’s Trademark Application, Serial No. 78296792, dated September 9, 2003 (“ONR Exh. 13”).
 - (14) United States Patent and Trademark Office Priority Action, dated March 21, 2004 (“ONR Exh. 14”).
 - (15) United States Patent and Trademark Office Examiners Amendment, dated March 31, 2004 (“ONR Exh. 15”).
 - (16) United States Patent and Trademark Office Notice of Publication Under 12(a), dated May 19, 2004 (“ONR Exh. 16”).
- II. February 8, 2006 Filing of Opposer’s Notice of Filing Certified Transcript of Testimonial Deposition of George H. Zoes which is the filing of the Testimonial Deposition of George H. Zoes taken on January 9, 2006 including Exhibits 1-9.
- III. February 8, 2006 Filing of Opposer’s Notice of Filing Amended¹ Certified Transcript of Testimonial Deposition of George H. Zoes which is the filing of the Testimonial Deposition of George H. Zoes taken on January 9, 2006 (“Zoes Testimonial Dep.”) including Exhibits 1-9 (“Zoes Testimonial Dep. Exh.”)
- IV. March 27, 2006 Applicant’s Notice or Reliance (Notice Under Rule 2.122) including:

¹. The transcript of the testimonial deposition was amended to include the notation “Oral Deposition of George Zoes” at the top of every page which was inadvertently omitted in the Certified Transcript of Testimonial Deposition of George H. Zoes filed on the same day. This was done to conform with the TTAB requirements.

- (1) U.S. Trademark Registration 2,860,793 (“March 27, 2006 ANR Exh. 1”).
 - (2) U.S. Trademark Registration 2,553,864 (“March 27, 2006 ANR Exh. 2”).
- V. March 30, 2006 Applicant’s Notice of Reliance including Applicant’s Answers to Opposer’s First Set of Interrogatories and Supplemental Responses of Applicant’s Answers to Opposer’s First Set of Interrogatories.
- V. June 20, 2006 Filing of Testimonial Deposition of Brett Shevack taken on March 23, 2006 (“Shevack Testimonial Dep.”) including Exhibits 1-9) (“Shevack Testimonial Dep. Exh.”).
- VI. The other pleadings contained in the Board’s file.

INTRODUCTION

Opposer George H. Zoes (“Opposer”) has developed trademark rights in the term TEXAS BORN TEXAS PROUD and owns U.S. Trademark Registration No. 2,922,037 for TEXAS BORN TEXAS PROUD for, among other things, clothing, namely, t-shirts, hats, belts, caps, blouses, shirts, shorts and jackets in Class 25; and dissemination of Texas historical information in Class 41. (ONR Exh.1; Zoes Testimonial Dep. Exh.1).

Applicant Brett Shevack (“Applicant”) seeks registration of the mark BORN IN TEXAS in U.S. Trademark Application Serial No. 78/296,792 for men's, women's and children's clothing, namely, T-shirts, jackets, shirts, sweatshirts, hats, caps, sweat pants, coats, shoes, boxer shorts, underwear, shorts, sleepwear, socks, sweaters and necktie in Class 25; and arranging and conducting sports competitions of others; entertainment in the nature of stickball tournaments, softball tournaments, handball tournaments, punch ball tournaments, skully tournaments, basketball tournaments and film festivals; arranging and conducting athletic competitions, street fairs, live music events and concerts, class reunions, special events in the nature of organizing art exhibitions and live theatre performances; audio production services; production of television programs; television show production, live performances by a musical band, live performances by a rock group, music production services, night clubs, discotheques in Class 41. (ONR Exh.13-15) Because consumers are likely to be confused by Applicant’s use of a mark that is similar to Opposer’s TEXAS BORN TEXAS PROUD in connection with identical products, Applicant’s application must be refused registration.

STATEMENT OF THE ISSUE

Whether there is likelihood of consumer confusion between Applicant's Mark BORN IN TEXAS and Opposer's mark TEXAS BORN TEXAS PROUD.

STATEMENT OF FACTS

Opposer's Rights in the TEXAS BORN TEXAS PROUD Mark

Opposer uses TEXAS BORN TEXAS PROUD as a trademark for goods and services, including in connection with clothing and dissemination of Texas historical information and is the owner of U.S. Trademark Registration No. 2,922,037 for TEXAS BORN TEXAS PROUD for, among other things, clothing, namely, t-shirts, hats, belts, caps, blouses, shirts, shorts and jackets in Class 25 (first use since June 15, 2003); and dissemination of Texas historical information in Class 41 (first use since June 15, 2003). Opposer filed the application for registration of the said mark on May 6, 2003 and the mark was registered on February 1, 2005. (ONR Exh. 1; Zoes Testimonial Dep. at 5; Zoes Testimonial Dep. Exh. 1). Opposer is the rightful owner of the U.S. registration for the TEXAS BORN TEXAS PROUD mark which is valid and in force.

Opposer sells his goods and services through INTERNET websites where his products are displayed (Zoes Testimonial Dep. at 6, 14, 17, 33-35; Zoes Testimonial Dep. Exh.9), through a retail store (Zoes Testimonial Dep. at 14 and 18), through wholesale market shows (Zoes Testimonial Dep. at 8, 14 and 18; Zoes Testimonial Dep. Exh. 6) and retail marker shows (Zoes Testimonial Dep. at 14 and 18). He utilizes catalogues (Zoes Testimonial Dep. at 6; Zoes Testimonial Dep. Exh. 2) and brochures (Zoes Testimonial Dep. at 8; Zoes Testimonial Dep. Exh. 3). The goods sold prominently display thereon the mark TEXAS BORN TEXAS PROUD. The goods are low cost items. (Zoes Testimonial Dep. Exh. 5-7 and 9).

Opposer advertizes by attending trade shows that cost a substantial amount of money (Zoes Testimonial Dep. at 29-33); providing catalogues (Zoes Testimonial Dep. at 29; Zoes Testimonial

Dep. Exh. 2) and brochures (Zoes Testimonial Dep. Exh. 3), buying advertizing space in a magazine (Zoes Testimonial Dep. at 28); by purchasing click advertizing in the INTERNET (Zoes Testimonial Dep. at 35); and by providing free samples of his products (Zoes Testimonial Dep. at 35-36). Opposer's products have been sold in more than 300 retail stores in and outside Texas (Zoes Testimonial Dep. at 41).

Applicant's Application to Register the Mark BORN IN TEXAS

On September 5, 2003, Applicant applied to register the mark BORN IN TEXAS for several goods and services. The application was an intend to use application. (ONR Exh. 13-15). On May 19, 2004, the mark was published for opposition through a Notice of Publication. (ONR Exh. 16). The application, as published, was for men's, women's and children's clothing, namely, T-shirts, jackets, shirts, sweatshirts, hats, caps, sweat pants, coats, shoes, boxer shorts, underwear, shorts, sleepwear, socks, sweaters and necktie in Class 25; and arranging and conducting sports competitions of others; entertainment in the nature of stickball tournaments, softball tournaments, handball tournaments, punch ball tournaments, skully tournaments, basketball tournaments and film festivals; arranging and conducting athletic competitions, street fairs, live music events and concerts, class reunions, special events in the nature of organizing art exhibitions and live theatre performances; audio production services; production of television programs; television show production, live performances by a musical band, live performances by a rock group, music production services, night clubs, discotheques in Class 41. (ONR Exh. 13-15). As of March 23, 2006, Applicant had not sold any goods or services under the mark BORN IN TEXAS. (Shevack Testimonial Dep. at 13).

Applicant is also the owner of the U.S. Trademark Registration No. 2,860,793 for BORN IN BROOKLYN and U.S. Trademark Registration No. 2,553,864 for BORN IN THE BRONX. (March 27, 2006 ANR Exh. 1 and 2). He is also the owner of several other applications for “BORN IN [place]” where [place] is a state or a city. (Shevack Testimonial Dep. at 5). Applicant has sold and continues to sell goods such as t-shirts, hats, coffee mugs, bumper stickers, postcards, etc. (Shevack Testimonial Dep. at 9) bearing the marks BORN IN BROOKLYN and BORN in the BRONX through the INTERNET where the goods are displayed in websites. (Shevack Testimonial Dep. at 5, 6 and 9). Applicant has also sold the goods through street fairs and retail stores. (Shevack Testimonial Dep. at 6). Applicant advertizes his products in the INTERNET by utilizing websites and med-tags. (Shevack Testimonial Dep. at 12). Applicant has indicated that he intends to sell the same types of products under the mark BORN IN TEXAS name as he has with the mark BORN IN BROOKLYN. (Shevack Testimonial Dep. at 13).

ARGUMENT

I. GROUNDS FOR OPPOSITION

To succeed in an opposition, an opposer must plead and prove, by a preponderance of the evidence, that: (1) he has standing to oppose the mark; and (2) there are valid grounds why the applicant is not entitled under law to register the mark it claims. *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 187 (C.C.P.A. 1982). As detailed below, Opposer has standing to oppose Applicant's attempt to register BORN IN TEXAS by virtue of its ownership of the TEXAS BORN TEXAS PROUD mark. Opposer opposes Applicant's application on the grounds that Section 2(d) of the Lanham Act precludes Applicant's registration of BORN IN TEXAS because the proposed mark is so similar to the Opposer's TEXAS BORN TEXAS PROUD mark as to be likely to cause confusion.

II. OPPOSER HAS STANDING TO OPPOSE APPLICANT'S APPLICATION

Under the Lanham Act, "[a]ny person who believes that he would be damaged by the registration of a mark" may file an opposition. Lanham Act § 13(a), 15 U.S.C. § 1063(a). This threshold standing requirement is an essential element of proof in any opposition proceeding and is satisfied where the opposer possesses a "real interest" in the proceeding. *Compuclean Mktg. & Design v. Berkshire Prods. Inc.*, 1 U.S.P.Q.2d 1323, 1324 (T.T.A.B. 1986) (citing cases). As the owner of the TEXAS BORN TEXAS PROUD mark and TEXAS BORN TEXAS PROUD Registration, Opposer has standing to challenge an application for a mark confusingly similar to the TEXAS BORN TEXAS PROUD mark. 15 U.S.C. § 1063; 15 U.S.C. § 1052(d).

III. THE BORN IN TEXAS MARK IS NOT ENTITLED TO REGISTRATION UNDER SECTION 2(d) OF THE LANHAM ACT

Section 2(d) of the Lanham Act provides that a proposed mark should be refused registration if it:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d).

To prevail in this opposition proceeding under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), Opposer must show that (1) he has valid, prior, proprietary rights in the TEXAS BORN TEXAS PROUD Mark; and (2) Applicant's use of the mark BORN IN TEXAS is likely to cause confusion among consumers as to the sponsorship, affiliation or connection of goods under the mark. *See Hilson Research Inc. v. Society for Human Res. Mgmt.*, 27 U.S.P.Q.2d 1423, 1429 (T.T.A.B. 1993); *See also* 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 20:14-20:18 (4th ed. 1998) (2004) (hereinafter "*McCarthy*"). As detailed below, Opposer has established the requisite proprietary rights and a substantial likelihood of confusion exists.

A. Opposer's Rights in the TEXAS BORN TEXAS PROUD Mark Are Superior to any Rights Applicant Can Claim in the BORN IN TEXAS Mark

There is no dispute that Opposer owns the TEXAS BORN TEXAS PROUD Mark. Opposer's TEXAS BORN TEXAS PROUD Registration is prima facie evidence of the validity of the registered

TEXAS BORN TEXAS PROUD mark and of Opposer's ownership of the mark for the goods and services specified therein. 15 U.S.C. §§ 1057(b), 1115(a), 1115(b). Moreover, Applicant has not filed a counterclaim or any affirmative defense concerning the validity of Opposer's TEXAS BORN TEXAS PROUD mark in this proceeding and, therefore, is precluded from challenging Opposer's ownership of the mark. *McCarthy*, § 20:65 at 20-118 ("In opposition proceedings, applicant cannot challenge the validity of Opposer's registration except in the context of a counterclaim for cancellation"). Thus, Opposer is the undisputed owner of federal rights in the TEXAS BORN TEXAS PROUD mark in connection with the goods and services identified in the TEXAS BORN TEXAS PROUD Registrations. (ONR Exh. 1). Even if Applicant was permitted to present argument against Opposer's rights in the TEXAS BORN TEXAS PROUD mark at this late stage of the proceeding, Applicant has offered no evidence to support such a hypothetical challenge.

Opposer's unchallenged rights in his TEXAS BORN TEXAS PROUD mark long predate any rights Applicant can claim in the BORN IN TEXAS Mark. Applicant's application for the BORN IN TEXAS mark was filed on September 5, 2003, as an intend to use application. As of March 23, 2006, Applicant had not used the mark. (Shevack Testimonial Dep. at 13). Opposer's Registration No. 2,922,037 for the TEXAS BORN TEXAS PROUD mark for, among other things, clothing was filed on May 6, 2003, and claims first use since January 30, 2001 and first use in commerce since June 15, 2003. This registration is prima facie evidence of Opposer's continuous use of the mark for these goods, prior to Applicant's use or application. *McCarthy*, § 16:20 at 16-37 (citing *Rolley, Inc. v. Younghusband*, 97 U.S.P.Q. 252 (9th Cir. 1953); *J. C. Hall Co. v. Hallmark Cards, Inc.*, 144 U.S.P.Q. 435 (C.C.P.A. 1965); *Harvey Aluminum, Inc. v. American Screen Products Co.*, 134 U.S.P.Q. 376 (C.C.P.A. 1962)). Opposer has used the mark TEXAS BORN TEXAS PROUD

continuously since June 2003. (Zoes Testimonial Dep. at 6).

Applicant has offered no evidence to refute Opposer's priority based on its registrations, its actual use in commerce, and its rights in the TEXAS BORN TEXAS PROUD Song. Applicant cannot dispute the constructive first use dates established by Opposer's above-enumerated registrations. Thus, Opposer has conclusively established its priority.

B. Likelihood of Confusion Under Section 2(d)

1. The Du Pont Test

The Board's determination of likelihood of confusion in opposition proceedings under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, *i.e.*, "impulse" vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use

without evidence of actual confusion;

(9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);

(10) The market interface between applicant and the owner of a prior mark;

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods;

(12) The extent of potential confusion, *i.e.*, whether *de minimis* or substantial;

(13) Any other established fact probative of the effect of use.

In re E.I. Du Pont de Nemours & Co., 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Significantly, not every *Du Pont* factor is relevant or of similar weight in every case, and an opposer need not prevail on every single factor. *In re Dixie Restaurants Inc.*, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997). The “fundamental inquiry goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *Id.* As discussed more fully below, these, together with the fame and distinctiveness of the marks, the similarity of customers / sophistication of customers, the similar channels of trade, and the nature and extent of any actual confusion are the key considerations in the likelihood of confusion analysis presented by this case. *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 233 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984) (considering only the relevant *du Pont* factors). Opposer should prevail on many of these factors, and can readily establish that the differences in the essential characteristics of the marks and the goods offered thereunder are minimal.

a. Similarity of the Parties' Goods

The second *Du Pont* factor requires “consideration of the similarity or dissimilarity of the goods or services as described in an application.”² *In re Dixie Restaurants*, 41 U.S.P.Q.2d 1531, 1534 (Fed. Cir. 1997); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (“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”). This factor favors rejection of Applicants’ application if the goods or services at issue “are related in some manner,” or if “the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances that could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties’ goods or services.” *In re Melville Corp.*, 18 U.S.P.Q.2d 1386 (T.T.A.B. 1991); *In re International Telephone & Telegraph Corp.*, 197 U.S.P.Q. 910, 911 (T.T.A.B. 1978).

In the case at bar, the identity or similarity and relatedness of the parties’ respective goods is apparent from the wording of the identifications of goods on Applicant’s application and on the Opposer’s issued registrations. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002) (requiring such a comparison where the evidence is available). Applicant has claimed rights for use with BORN IN TEXAS for “men's, women's and children's clothing, namely, T-shirts, jackets, shirts, sweatshirts, hats, caps, sweat pants, coats, shoes, boxer

² Opposer addresses the second *DuPont* factor, similarity of goods or services, before the first factor, similarity of the marks themselves, because as discussed below, a finding that the marks at issue would be used on similar goods or services affects the analysis of whether the marks themselves are sufficiently similar as to make consumer confusion likely. *See, e.g., In re Johnson Products Co., Inc.*, 220 U.S.P.Q. 539, 540 (T.T.A.B. 1983).

shorts, underwear, shorts, sleepwear, socks, sweaters and necktie” in Class 25; and “arranging and conducting sports competitions of others; entertainment in the nature of stickball tournaments, softball tournaments, handball tournaments, punch ball tournaments, skully tournaments, basketball tournaments and film festivals; arranging and conducting athletic competitions, street fairs, live music events and concerts, class reunions, special events in the nature of organizing art exhibitions and live theatre performances; audio production services; production of television programs; television show production, live performances by a musical band, live performances by a rock group, music production services, night clubs, discotheques” in Class 41. *See* App. Ser. No. 78/296,792. Opposer owns rights for use of the TEXAS BORN TEXAS PROUD mark in connection with “clothing, namely, t-shirts, hats, belts, caps, blouses, shirts, shorts and jackets” in Class 25; and dissemination of Texas historical information in Class 41. *See* Reg. No. 2,922,037. The similarity between these items and the goods claimed in Applicant’s BORN IN TEXAS is evident.

Further, the testimony of Applicant referred to in the Statement of Facts section above clearly shows the that the goods sold by Applicant under his marks are similar to those sold by Opposer under his mark TEXAS BORN TEXAS PROUD.

Further, the evidence shows that the parties’ market their respective goods and services in a manner that makes it virtually certain that the same persons would encounter advertisements for both parties’ goods and services under circumstances that could give rise to consumer confusion. Indeed, the parties advertise their goods and services under the respective marks in the INTERNET through websites. (Shevack Testimonial Dep. at 12; Zoes Testimonial Dep. 6 et. seq. and 35). It is practically inconceivable that the same individuals would not encounter these websites when they look for the particular products.

This second *Du Pont* factor therefore favors a likelihood of confusion, and rejection of Applicant's application.

b. Similarity of the Parties' Marks

It is well-established that in evaluating the similarity of Applicant's and Opposer's marks, the Board must determine whether the marks, "when compared in their entireties in terms of appearance, sound, and connotation, are similar or dissimilar in their overall commercial impressions." *Time Warner Entm't. Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1659-60 (T.T.A.B. 2002); see also *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 42 U.S.P.Q.2d 1348, 1355-56 (2d Cir. 1997).

It is also well-established that a newcomer's addition, change or deletion of a term to alter its mark is not sufficient to overcome a likelihood of confusion. *Blansett Pharm. Co. v. Carmrick Labs., Inc.*, 25 U.S.P.Q.2d 1473, 1477 (T.T.A.B. 1992) (NALEX v. NOLEX for nasal decongestants, granting summary judgment for opposer); *Bon Arni Co. v. McKesson & Robbins, Inc.*, 93 F.2d 915, 946 (C.C.P.A. 1938) (BON AMI v. SHAV-AMI); *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985) (H1JGGIES v. DOUGIES); *Nikon Inc. v. Ikon Corp.*, 25 U.S.P.Q.2d 2021, 2024 (2d Cir. 1993) (NIKON v. IKON); *Bookman v. Oakland Chei'n. Co.*, 40 F.2d 1006, 1008 (C.C.P.A. 1930) (PEROXOGEN v. DIOXOGEN); *Simoniz Co. v. Permanizing Stations of America, Inc.*, 49 F.2d 846, 847 (C.C.P.A. 1931) (SIMONIZ v. PERMANIZE).

Further, "when marks would appear on virtually identical goods or services, the degree of similarity to support a conclusion of likelihood of confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992). As discussed above, the marks at issue in this proceeding are unquestionably used on identical or substantially similar goods.

Where word marks are used in connection with identical or substantially similar goods, the “most important factor” in the likelihood of confusion analysis is the overall commercial impressions created by the marks. *In re Johnson Products Co., Inc.*, 220 U.S.P.Q. 539, 540 (T.T.A.B. 1983).

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

If the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences. *See, In re Chatam International Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Viewed in their entireties with non-dominant features appropriately discounted, the marks GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical”); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (even though applicant’s mark PACKARD TECHNOLOGIES (with “TECHNOLOGIES” disclaimed) does not incorporate every feature of opposer’s HEWLETT PACKARD marks, similar overall commercial impression is created)

In the present case the overall commercial impression is created by the common dominant features “Texas Born” and “Born in Texas.” The “Texas Proud” is a peripheral term which signifies that a person born in Texas is proud of that. (Zoes Testimonial Dep. at 9). Further, the evidence submitted by Opposer clearly shows the fact that Texas Born or Born in Texas are the dominant features that essentially convey the overall commercial impression of the respective marks. (Zoes Testimonial Dep. at 11; Zoes Testimonial Dep. Exh. 4; ONR Exh. 2-5). More particularly, through their declaration, several individuals testified that when Opposer gave several people pins and

stickers as promotional products that displayed the mark TEXAS BORN TEXAS PROUD, many of the recipients of those products were happy to have those products because they were born in Texas.

Further, Applicant himself indirectly admitted through his testimony that the “Texas Born” part is the dominant feature because he admitted that the emphasis is on the Texas Born or Born in Texas element. (Shevack Testimonial Dep. at 20).

Thus, the Applicant’s mark BORN IN TEXAS is plainly similar in appearance, sound, connotation, and, most importantly, overall commercial impression, to Opposer’s mark TEXAS BORN TEXAS PROUD.

c. Distinctiveness of the TEXAS BORN TEXAS PROUD

Opposer’s TEXAS BORN TEXAS PROUD Registrations on the Principal Register create a presumption that the TEXAS BORN TEXAS PROUD mark is valid and distinctive. *Lane Capital Mgmt. Inc. v. Lane Capital Mgmt., Inc.*, 52 U.S.P.Q.2d 1094, 1098 (2d Cir. 1999). Moreover, the mark is an arbitrary and fanciful term, and thus inherently distinctive. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d 1081, 1083 (1992); *In re MBNA Am. Bank, N.A.*, 67 U.S.P.Q.2d 1778, 1780 (T.T.A.B. 2003). The term TEXAS BORN TEXAS PROUD is an arbitrary construction in the English language— with no inherent meaning. It does not describe or suggest anything about the goods and services offered under the mark. In sum, TEXAS BORN TEXAS PROUD is an arbitrary and inherently distinctive mark with enormous secondary meaning.

d. Sophistication of Consumers - Purchasers of the Goods and Services in Question are Prone to Impulse Purchasing

Du Pont also requires that the Board consider the sophistication of the target market segment to whom the applied-for goods or services are marketed. This analysis necessarily requires consideration of, *inter alia*, the price point at which the claimed goods are sold. “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000). Here, it is clear that the goods are not expensive, luxury goods requiring consumers to exercise great care or expertise in their purchase. *See In re Sailerbrau Franz Sailer*, 23 U.S.P.Q.2d 1719, 1720 (T.T.A.B. 1992). Opposer’s and Applicant’s products are inexpensive (Zoes Testimonial Dep. Exh. 5-7 and 9; Shevack Testimonial Dep. Exh. 5). It may therefore be readily inferred that purchasers of Opposer’s and Applicants goods likely do not exercise exceptional care in selecting their merchandise and ensuring that its origin. These facts inevitably lead to the conclusion that Applicant’s and Opposer’s customers exercise a low standard of purchasing care, thus increasing the likelihood of confusion between the TEXAS BORN TEXAS PROUD mark and BORN IN TEXAS mark. Further, the buyers of the products sold under the subject marks are impulse buyers. (Zoes Testimonial Dep. at 17 and 19).

In sum, because the customers are less sophisticated, and because the goods are inexpensive, consumers are less likely to distinguish between TEXAS BORN TEXAS PROUD and BORN IN TEXAS products.

e. Identical Channels of Trade

Opposer's TEXAS BORN TEXAS PROUD Registration No. 2,922,037 does not contain any limitation on the channels of trade in which the goods identified therein are offered. Therefore, the Board must presume that Opposer's goods and service are offered in all normal and usual channels of trade for such products and are available to all potential purchasers of such goods. *American Hygienic Labs Inc. v. Tiffany & Co.*, 12 U.S.P.Q.2d 1979, 1983 (T.T.A.B. 1989); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 U.S.P.Q. 937, 940 (Fed. Cir. 1983) ("where the likelihood of confusion is asserted with a registered mark, the issue must be resolved on the basis of the goods named in the registration and, in the absence of specific limitations in the registration, on the basis of all normal and usual channels of trade and methods of distribution").

Further, the evidence shows that Opposer's goods are sold through INTERNET websites, shows and retail stores. (See cited evidence in Statement of Facts section above). Similarly, the evidence shows that Applicant sells his products through INTERNET websites, street fairs and retail stores. (Shevack Testimonial Dep. 5 and 6). Thus, the goods are offered in the same channels of trade.

f. Extent of Actual or Potential Confusion

The evidence submitted by Opposer clearly shows that there is actual and potential confusion. More particularly, several individuals testified by declaration that when Opposer gave several people pins and stickers as promotional products that displayed the mark TEXAS BORN TEXAS PROUD, many of the recipients of those products were happy to have those products because they were "born in Texas." (Zoes Testimonial Dep. at 11; Zoes Testimonial Dep. Exh. 4; ONR Exh. 2-5).

CONCLUSION

All of the relevant likelihood of confusion factors powerfully favor Opposer. Opposer has valid, enforceable and superior rights in TEXAS BORN TEXAS PROUD. The TEXAS BORN TEXAS PROUD mark is strong and inherently distinctive. The parties' marks are virtually indistinguishable. The parties' goods are virtually identical and/or are closely related. The consumers are identical. The trade channels are identical. Thus, Opposer has conclusively demonstrated that the BORN IN TEXAS mark is likely to create confusion with the TEXAS BORN TEXAS PROUD mark, and Applicant has offered no evidence to the contrary. Accordingly, the Board must sustain the opposition on the basis of Section 2(d) and refuse registration to Application Serial No. 78/296,792 to register BORN IN TEXAS.

Date: July 13, 2006

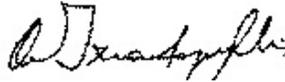
Respectfully submitted,



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CERTIFICATE OF SERVICE

I certify that a true and complete copy of the foregoing OPPOSER'S TRIAL BRIEF was mailed by First Class Mail, postage prepaid on the 13th day of July, 2006 to Cynthia L. Stewart, Frost Brown Todd LLC, 400 West Market Street, 32nd Floor, Louisville, Kentucky 40202-3363 and was served by Email to Cynthia Stewart at cstewart@fbtlaw.com and Bridget Papalia at bpapalia@fbtlaw.com on July 13, 2006.



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