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UNITED STATES: North Face Partially Beats Opponent to SUMMIT at TTAB

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In the precedential decision *The North Face Apparel Corp. v. Sanyang Indus. Co.*, Opp'n No. 91187593 (TTAB Sept. 18, 2015), the Trademark Trial and Appeal Board (the Board) partially sustained an opposition against two applications filed by Sanyang Industry Co., Ltd. (Sanyang), a Taiwanese manufacturer and seller of motorcycles, motorized scooters and ATVs. One application included Classes 11, 12 and 37, and the other included Classes 7, 16, 25 and 35, for this color logo:



The North Face Apparel Corp. (North Face), an activewear and outdoor sports gear company, opposed on the basis of likelihood of confusion, arguing that Sanyang's logo was merely North Face's registered "S" logo (also used with SUMMIT SERIES), turned on its side:





Sanyang contended that North Face's mark suggested a mountain, alluding to its outdoor goods, while Sanyang's own mark suggested a wheel in motion. Applying the *du Pont* factors to assess the likelihood of confusion with North Face's "S" logo (without SUMMIT SERIES), the Board found that the marks' similarities outweighed their dissimilarities.

The opposition was sustained for Class 25 for clothing because the items in the parties' identifications of goods were considered equivalent. It was also sustained for Class 35 as certain goods to be sold by Sanyang's retail stores were considered related to North Face's goods.

However, the opposition was dismissed in Classes 7, 11, 12, 16 and 37 because (i) the evidence of relatedness was insufficient, (ii) North Face was not able to show that the goods were complementary, and (iii) North Face failed to outweigh these considerations by proving fame. North Face's photographs of five celebrities wearing apparel with the "S" design were unpersuasive as the mark was not highlighted (instead it was obscured in three of the five photographs), and there was no proof of where the photographs appeared or their level of exposure. North Face's sales and advertising figures in the millions of dollars were equally unavailing as North Face failed to provide context against other brands, or show which were for the "S" design alone (without SUMMIT SERIES), and failed to provide breakdowns by specific goods. Moreover, the advertising figures were not limited to the United States.

In light of this opinion, opposers, hoping to prove fame in the United States, may wish to ensure that the evidence they produce carefully delineates sales and advertising information for specific goods and specific geographic regions, and to feature their marks prominently in advertising materials in the United States.

Although every effort has been made to verify the accuracy of items in the *INTA Bulletin*, readers are urged to check independently on matters of specific concern or interest.

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