

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 16, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Deere & Company

v.

JD American Workwear, Inc.

Opposition No. 102,180
to application Serial No. 74/717,526
filed on Aug. 18, 1995

Michael W. Mihm for Deere & Company.

Keith F. Noe of Salter & Michaelson for JD American
Workwear, Inc.

Before Seeherman, Hanak and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

JD American Workwear, Inc. has filed an application to
register the mark JD AMERICAN WORKWEAR for "work clothing,
namely, pants, shirts, jackets, coveralls and uniforms".¹

¹ Ser. No. 74/717,526, filed Aug. 18, 1995, on the basis of a
bona fide intent to use. A disclaimer has been entered of the
words AMERICAN WORKWEAR.

Opposition No. 102180

Deere & Company has filed an opposition to registration of the mark under Section 2(d) of the Trademark Act, on the ground of likelihood of confusion. Opposer alleges prior and continuous use of the mark JD on clothing for more than ten years, and the likelihood of confusion with applicant's intended use of its JD AMERICAN WORKWEAR mark on goods very similar and directly competitive with opposer's goods.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

The record consists of the file of the involved application; the testimony affidavits of Deborah Taylor and Rheta Mueller and accompanying exhibits for opposer; opposer's notice of reliance introducing certain answers of applicant to opposer's interrogatories; the testimony affidavit of David DeBaene and accompanying exhibits for applicant; and applicant's notice of reliance introducing certain answers of opposer to applicant's interrogatories.² Both parties filed briefs on the case, but no oral hearing was requested.

Opposer has established through the affidavit of Deborah Taylor, a product manager with the Trademark Administration Group of opposer, that opposer has sold

² Both parties agreed to the submission of testimony in affidavit form. See Trademark Rule 2.123(b).

Opposition No. 102180

clothes bearing a stylized JD mark³ continuously since at least November 22, 1976, with only the particular clothing articles on which the mark was used being changed, e.g., on winterwear in the period of 1979-1983, on casual clothes such as sports shirts in 1978-79, and on sweatshirts and caps at the present time. Initially, opposer purchased the clothing from suppliers. Opposer in turn sold the clothes wholesale to its dealers who then sold the items to the general public. Currently, the dealers purchase the clothes directly by placing catalog orders with authorized licensees of opposer. One licensee also sells items directly to opposer's employees, retirees, and the public by catalog. The licensees, rather than opposer, advertise to the public through brochures available at the dealerships. The Florsheim Shoe Co. is a licensee which sells footwear such as work boots and socks in its retail shoe stores bearing John Deere marks, although no evidence has been submitted of use of the JD mark on these items.

Opposer has made of record copies of its registrations for the mark JD in either stylized or typed form for numerous types of farm machinery, snowmobiles, lawn and gardening machinery, and parts therefor, as well as for a magazine. Opposer has also testified to its use of the

³ The stylized form of the letters consistently used by opposer on clothing is as follows:

Opposition No. 102180

letters JD in connection with other terms as marks for products or services including, inter alia, a computerized information system available at its dealers (JDVision), a computer software product (JDMap), and its parts delivery services (JD Parts Express).

Applicant, in the testimony affidavit of David DeBaene, President and CEO of applicant, has established that the letters JD in its mark are an abbreviation of the name of its predecessor, Jacque DuBois, Inc.; that use of its mark was begun in August 1995⁴ and has been continuous since that time; that applicant's products are primarily sold through catalogs and direct mail orders; and that during the period between August 1995 and February 1996 total sales were approximately \$100,000, but between February 1996 and February 1997 increased to \$604,000. Applicant has introduced labels for its goods showing use of the mark JD AMERICAN WORKWEAR in a typed format together with a design featuring the letters JD.

Looking first to priority of use with respect to clothing, we find that opposer has established use of its JD mark on clothing since at least November 22, 1976, whereas the earliest use that applicant has shown of its mark is

⁴ An invoice dated Aug. 29, 1995 has been introduced into the record.

August 1995. Accordingly, opposer has proven priority of use.

Thus, we turn to the issue of likelihood of confusion and the du Pont factors which are most relevant to the circumstances at hand. See *In re du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

With respect to the marks themselves, opposer argues that opposer's mark JD and applicant's mark JD AMERICAN WORKWEAR are "strikingly similar." Opposer contends that since the words AMERICAN WORKWEAR have been disclaimed as descriptive, the dominant portion of applicant's mark is necessarily JD. Although acknowledging that the marks must be considered in their entirety, opposer insists that the significant portion of applicant's mark, and the portion to which purchasers would look, is virtually identical to opposer's JD mark.

Applicant strongly contends that in making any comparison we must consider the marks in their entirety, and not discount the descriptive portion of applicant's mark. As such, applicant maintains that JD AMERICAN WORKWEAR and JD are completely different in sound, sight and overall commercial impression. Applicant further points to third-party registrations which it has made of record as

evidence that the letter combination JD in itself is weak as applied to clothing.⁵

It is true that the filing of a disclaimer does not remove the disclaimed matter from consideration in determining the likelihood of confusion. The marks must be considered in the way they will be viewed by the relevant public. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). Furthermore, it is well established that marks must be compared in their entireties and that the likelihood of confusion cannot be predicated on only part of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). At the same time, however, there is nothing improper in giving more or less weight to a particular portion of a mark, particularly if descriptive matter is involved. See *In re National Data Corp.*, supra;

⁵ Status and title copies of the following registrations were introduced by the affidavit testimony of David DeBeane:

Reg. No. 1,566,074 for the mark J.D.DOLE(stylized) for T-shirts;
Reg. No. 1,567,298 for the mark JD(stylized) for footwear;
Reg. No. 1,602,411 for the mark JD SUN VALLEY and design (SUN VALLEY disclaimed)for clothing, namely, one piece ski suits, ski bibs, ski pants, parkas, head bands, sweaters, turtle neck sweaters, T-shirts and hats;
Reg. No. 1,825,210 for the mark J.D. DROVER and design for sportswear clothing for men and women, namely, men's shirts, women's blouses, T-shirts, jackets, coats, pants, shorts, skirts, belts, gloves, footwear including shoes and boots and headwear including hats and headbands;
and Reg. No. 1,854,721 for the mark JD JULIE DESIGNS (stylized)(DESIGNS disclaimed) for clothing, namely, lycra shirts for surfing, lycra competition vests for surfing, skiing and snowboarding.

Opposition No. 102180

Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

In the present case, opposer has consistently used the letters JD in a stylized form such that the back of the "J" and the front of the "D" are joined together. Its proprietary rights are thus so defined. Applicant's mark, on the other hand, includes not only the letters JD and the words AMERICAN WORKWEAR, but also is unlimited as to style of use, being presented for registration in a typed drawing.

Nonetheless, we find that the marks, when considered in their entireties, would create similar commercial impressions. While purchasers would also see the words AMERICAN WORKWEAR in applicant's mark, we cannot overlook the fact that the mark is being used in connection with "work clothing". Even though these purchasers would be unaware that a disclaimer has been made of these words, they would not be oblivious to the fact that the words are descriptive of the goods on which they are being used, namely, workwear made in America. As such, the source-indicating significance of the words AMERICAN WORKWEAR would be minimal in comparison to the letters JD. See Hilson Research Inc. v. Society for Human Resource Management, supra.

Reg. No. 1,005,365 was also cited, but this registration has expired and thus will not be considered.

Opposition No. 102180

Furthermore, the labels submitted by applicant show actual use of the mark JD AMERICAN WORKWEAR in conjunction with a stylized "JD", although the latter is not part of the mark sought to be registered. While this design feature, or perceivably second mark, may be changed or deleted at the whim of applicant, still it can be taken into consideration as evidence that a confusingly similar commercial impression may be created. See *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240 (TTAB 1985)[evidence of context in which mark is used on labels, etc. is probative of significance mark is likely to project to purchasers]. As such, we consider this to be evidence of applicant's emphasis on the "JD" portion of the mark sought to be registered. Although opposer's letters JD are in a stylized form which is not the same as either the JD used by applicant in its mark or in its JD design, in each stylization the letters "J" and "D" are discernible. Thus, the overall commercial impression to the average purchaser for each mark would most likely be the same, that is, the letters JD.

Insofar as third-party use of the letters JD in connection with clothing is concerned, we find that little weight can be accorded to the third-party registrations introduced by applicant. As often stated, third-party registrations are not evidence of use of the marks or that consumers are familiar with such marks in the marketplace

Opposition No. 102180

and thus are of little value in determining the likelihood of confusion. See *Hilson Research Inc. v. Society for Human Resource Management*, supra. Furthermore, in all but one registration, the letters J.D. are only a portion of the mark, with non-identical words being added thereto. The one registration for the letters JD alone is in a different specific stylized form, and the goods are restricted to footwear. This is clearly insufficient evidence to hold that the letters JD are weak when used in connection with clothing in general.

Turning next to the similarity or dissimilarity of the goods, we can find little distinction to be drawn between the work clothes of applicant and the casual clothing items upon which opposer uses its JD mark. Even though not identified as work clothing, the sweatshirts and caps of opposer might well be worn as work clothing, in the same manner as applicant's shirts, jackets, and the like. Thus, the goods, although not identical, are closely related and might well originate from the same source.

Applicant further contends that the channels of trade differ for the respective goods and that the trades persons who buy its work clothing are a different type of purchaser than the types of purchasers of opposer's clothing at John Deere dealers.

We first note that there are no limitations in the identification of applicant's goods to any specific channels of trade or means of sale. Thus, the goods are presumed to travel through all the normal channels of trade for goods of this nature. See *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973). Although applicant's work clothes are presently sold through catalogs and direct mail orders, including a catalog of J.C. Penney,⁶ these channels of trade are open to expansion or change. On the other hand, opposer's clothing is primarily sold at John Deere dealerships or by catalog to former employees of John Deere.

Despite this present disparity in markets, we are persuaded that, contrary to applicant's arguments, the type of potential purchasers of the goods of the two parties might well be the same. We agree with opposer that many persons who purchase work clothes would also be likely to frequent John Deere dealerships and to purchase clothing being marketed there. As pointed out by opposer, persons involved in the trades such as construction work are not only purchasers of work clothing but also would be likely to be familiar with, and purchasers of, John Deere equipment. Although these same consumers may come in contact with

⁶ While this specific catalog sale has only been described in applicant's brief and not verified for the record, we find it appropriate to use the information for exemplary purposes.

opposer's casual clothing at its dealerships and with applicant's work clothing in a catalog, they are likely to be confused upon seeing JD marks on both.

The other factors raised by applicant also favor opposer. Although opposer acknowledges that its JD mark is not as famous or well-known as its other marks, this does not detract from its established use of the JD mark over a period of years. Furthermore, although no instances of actual confusion have been noted since applicant began use of its mark two years ago, this minimal period of concurrent use without actual confusion can be accorded little weight in determining the likelihood of confusion.

Accordingly, we find the similarities in the marks and the goods, and particularly the potential for the same consumers to view these marks, sufficient to resolve the determination of likelihood of confusion in opposer's favor. While we are not totally without doubt, this doubt must also be weighed in opposer's favor, as the prior user against the newcomer. See *Giant Food Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

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

E. J. Seeherman

Opposition No. 102180

E. W. Hanak

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board