

This Opinion is Not a  
Precedent of the TTAB

Mailed: July 12, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Texas A&M University*  
*v.*  
*Washington Soap Company*  
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Opposition No. 91223136  
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John C. Cain of Fleckman & McGlynn, PLLC,  
for Texas A&M University.

Washington Soap Company, pro se.  
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Before Wellington, Adlin, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Washington Soap Company (“Applicant”), appearing pro se, seeks registration on the Principal Register of the mark 12TH MAN HANDS in standard characters for “handmade loofah soap bar or puck,” in International Class 3.<sup>1</sup>

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<sup>1</sup> Application Serial No. 86445864 was filed on November 5, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claim of first use of the mark and first use in commerce at least as early as December 1, 2013.

Texas A&M University (“Opposer” or “Texas A&M”) has opposed registration on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on four pleaded registrations of 12TH MAN-formative marks and alleged common law use of 12TH MAN marks, and of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

Only Opposer submitted trial evidence and filed a brief. We sustain the opposition based on Opposer’s likelihood of confusion claim.

## **I. Evidentiary Record**

The record consists of:

1. the pleadings;
2. the file history of Applicant’s application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1);
3. Opposer’s Notice of Reliance, 15 TTABVUE, on:
  - (a) its four pleaded registrations;<sup>2</sup>
  - (b) Third-party registrations covering both soap and towels;<sup>3</sup>
  - (c) Internet webpages displaying the marketing of soap and towel combinations or sets;<sup>4</sup>
  - (d) The declarations of Karla L. Bynum, one of Opposer’s counsel, and Amy B. Smith, Opposer’s Senior Vice President and Chief Marketing and Communications Officer, and exhibits thereto, which were originally

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<sup>2</sup> 15 TTABVUE 6-53.

<sup>3</sup> 15 TTABVUE 54-112.

<sup>4</sup> 15 TTABVUE 113-129.

filed in support of Opposer's motion for summary judgment, and were resubmitted at trial;<sup>5</sup> and

4. The testimony deposition of Shane Hinckley, Opposer's Vice President of Brand Development, and exhibits thereto.<sup>6</sup>

In denying Opposer's motion for summary judgment, we held that Applicant was deemed to have admitted Opposer's requests for admission. 14 TTABVUE 3.<sup>7</sup> Accordingly, the record contains a number of admitted facts, some of which are relevant to our decision.

## II. Factual Background

Opposer is a large public university in College Station, Texas. Its intercollegiate athletic teams are known as the "Aggies," Tr. 35:16-24; Ex. 1 (17 TTABVUE 11), and it has fielded a football team for more than 100 years. Tr. Ex. 1 (17 TTABVUE 11).

### **The Origin of Opposer's 12th Man Mark**

Applicant admitted the basic facts regarding the origin of the term "Twelfth Man" by failing to deny the pertinent allegations in Opposer's Notice of Opposition. 1

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<sup>5</sup> 15 TTABVUE 130-207. The Trademark Rules do not provide for the filing of a declaration under notice of reliance. *See* Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g) (identifying materials that may be made of record under notice of reliance). Trademark Rule 2.123(a), 37 C.F.R. § 2.123(a), as amended, provides for the filing of trial testimony "in the form of an affidavit or declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence," subject to "the right of any adverse party to elect to take and bear the expenses of oral cross-examination of that witness . . ." The declarations of Ms. Bynum and Ms. Smith satisfy the requirements of amended Trademark Rule 2.123(a), and we will consider them.

<sup>6</sup> 16-21 TTABVUE. Mr. Hinckley's testimony deposition may be accessed at 16 TTABVUE. We will cite his testimony by reference to numbered pages and lines of his transcript (e.g., Tr. 39:15-20) and exhibits thereto by their assigned number and the location of the entire exhibit or relevant portion(s) on TTABVUE (e.g., Ex. 3 (17 TTABVUE 20)).

<sup>7</sup> Opposer's Requests for Admission are attached to the Bynum Declaration as Exhibit C3. 15 TTABVUE 155-165.

TTABVUE 5 (Not. of Opp. ¶ 2); 8 TTABVUE 5-6 (Ans. ¶ 2). As described in excerpts from the 1974 book *The Twelfth Man A Story of Texas A&M Football*, Tr. 35:16-38:11; 46:23-47:1; Ex. 1 (17 TTABVUE 2-18), and in a 1983 *Sports Illustrated* article entitled “Texas A&M: The Twelfth Man Theme,” Tr. 92:25-94:10; Ex. 30 (18 TTABVUE 69-76), both authenticated by Mr. Hinckley,<sup>8</sup> the term “Twelfth Man” was first associated with Texas A&M in January 1922, when its football team was playing Centre College in a post-season game called the Dixie Classic, the forerunner to the modern day Cotton Bowl game. The team had suffered a series of injuries during the season and had a limited number of available players. Near halftime, head coach Dana Bible sent a yell leader to summon E. King Gill, a former reserve football player who was then a member of the Texas A&M basketball team, and who was in the stadium that day. The coach asked Gill to suit up and be available in case he was needed. Gill complied, put on the uniform of a player who had been injured earlier in the game, and stood ready on the sideline for the remainder of the game, although he was never sent into it. Gill was subsequently referred to by the yell leader as the “Twelfth Man.”<sup>9</sup> Tr. Ex. 1 (17 TTABVUE 11-18). Since 1980, a statue of Gill has stood outside Kyle Field, the Texas A&M football stadium, Tr. 44:18-46:22; 53:19-54:21

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<sup>8</sup> We may consider these materials for the truth of their contents under the ancient document exception to the rule against hearsay. Fed. R. Evid. 803(16); see *Blackhorse v. Pro Football, Inc.*, 111 USPQ2d 1080, 1086 n.20 (TTAB 2014).

<sup>9</sup> We take judicial notice under Rule 201(b) of the Federal Rules of Evidence, Fed. R. Evid. 201(b), that football is played with 11 players from each team on the field at a time.

Exs. 5-6, 10 (17 TTABVUE 27-28, 30, 43-44),<sup>10</sup> and he has been immortalized in university lore as the “original 12th Man.” Tr. 40:3-22.

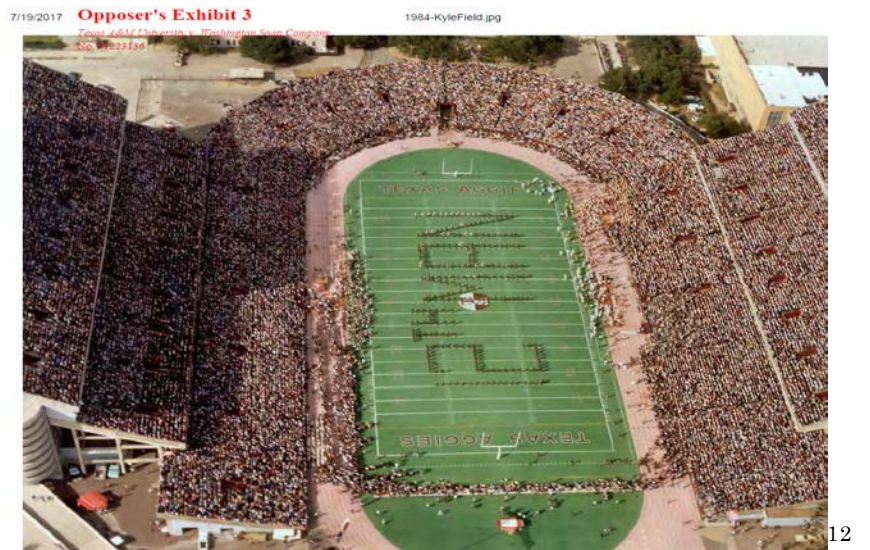
The term “12th Man” subsequently came to refer to the entire Texas A&M student body, which since the late 1930s has stood throughout home football games to honor the tradition of standing ready to support the team. Tr. 38:5-8; 46:11-20; Ex. 6 (17 TTABVUE 28-30). The history of the association of “12th Man” with Texas A&M is chronicled on the website at 12thman.tamu.edu, Tr. 55:5-57:9; Ex. 159 (19 TTABVUE 511-533), on a video that is available at various places on the Internet, Tr. 60:13-61:22; Ex. 17 (17 TTABVUE 93-99), and in various media articles and numerous other materials in the record. Tr. 40:3-45:8; 14-52:3; 53:19-54:12, 22-55:3; 68:14-69:16; 71:1-21; 72:10-13; 73:18-25; 92:25-94:10; Exs. 4-10, 19, 30 (17 TTABVUE 21-44, 116, 119; 18 TTABVUE 69-76).

**Use of and Public Exposure to the 12th Man Mark in Connection with the Texas A&M Football Program**

The record establishes longstanding use of and public exposure to the term 12TH MAN in a variety of ways at Texas A&M home football games, and in connection with the Texas A&M football program. As shown below in aerial photographs of the stadium, the term has been spelled out on the field by the Texas A&M marching band since about 1930.

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<sup>10</sup> Mr. Hinckley testified that the statues of Gill have been the number one fan and visitor picture destinations on the Texas A&M campus. Tr. 54:5-21.



In 1968, the Texas A&M student body unveiled a banner in the stadium stating “The Twelfth Man is Here”:

<sup>11</sup> Tr. 38:22-39:13; Ex. 2 (17 TTABVUE 19).

<sup>12</sup> Tr. 39:15-40:2; Ex. 3 (17 TTABVUE 20).



13

In 1988, permanent signage reading “HOME OF THE 12<sup>TH</sup> MAN” was placed in the student section at Kyle Field:



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The signage is visible, and is often prominently featured, when Texas A&M home games are broadcast on national television on ESPN, CBS, ABC, Fox Sports, and the

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<sup>13</sup> Tr. 56:9-16; Ex. 159 (19 TTABVUE 514-515).

<sup>14</sup> Tr. 57:14-17; Ex. 159 (19 TTABVUE 518).

SEC Network, Tr. 51:21-52:1; 74:1-13; 75:9-22, and it has been seen by tens of millions of people on television and at Kyle Field, where Texas A&M home football games have the third-highest attendance among United States colleges. Tr. 72:17-73:17; 74:1-13; 75:9-76:22; 86:1-6; Ex. 24 (18 TTABVUE 45). Mr. Hinckley testified that he first became aware of the term “Twelfth Man” as a teenager in Nebraska in the early 1980s, when he saw a Texas A&M home football game on television. Tr. 33:10-25.

The 1983 *Sports Illustrated* article entitled “Texas A&M: The Twelfth Man Theme” included a reference to a new “12th Man Kickoff Team” composed entirely of walk-on players (non-scholarship athletes) from the general student body. Tr. 56:22-57:5. In 1990, that part of the 12th Man tradition was changed to have one walk-on player from the student body, who always wears the number 12, play on the kickoff team. Tr. 57:18-58:3. Mr. Hinckley testified that the walk-on player on the kickoff team is frequently mentioned when Texas A&M games are televised, and is often singled out on camera during kickoffs. Tr. 57:22-58:3.

When Texas A&M quarterback Johnny Manziel won the Heisman Memorial Trophy in December 2012, he mentioned the 12th Man in his acceptance speech, which was the second-most watched Heisman ceremony and was reportedly viewed by nearly 5,000,000 people. Tr. 107:21-109:8; Exs. 38-39 (18 TTABVUE 103-104).<sup>15</sup>

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<sup>15</sup> The record contains a video of Manziel’s acceptance speech, but it is not accessible in the public TTABVUE file. The video was played during Mr. Hinckley’s testimony and a transcription appears in his transcript. Tr. 108:4-16.



### **The 12TH MAN Towel**

In 1985, officers of the 12th Man Student Aggie Club created the “12th Man Towel,” which has been waived ever since by the Texas A&M student body at every home football game, and by students and fans at away games, to show support for the team:



<sup>16</sup>

Tr. 51:15-20; 52:4-8; 53:2-17; 92:3-23. The towels bear 12<sup>TH</sup> MAN or HOME OF THE 12<sup>TH</sup> MAN, in combination with other Texas A&M trademarks and sometimes the marks of sponsors, licensees, and others:

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<sup>16</sup> Ex. 29 (18 TTABVUE 69).



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Tr. 52:8-53:1. Hundreds of thousands of 12th Man towels are produced each year, and they are both sold and given away. Tr. 53:9-13; Bynum Decl. ¶ 9; Ex. G (15 TTABVUE 180-181).

**Opposer's Use, Marketing, and Exploitation of 12TH MAN and HOME OF THE 12TH MAN**

The phrases 12TH MAN and HOME OF THE 12TH MAN are used inside and outside Kyle Field, Tr. 87:8-17; 88:11-89:3; Ex. 25 (18 TTABVUE 58-61), and elsewhere on the Texas A&M campus, Tr. 69:21-23; 70:3-8; 87:3-8, 18-22; 89:10-91:7;

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<sup>17</sup> Tr. 91:9-92:1; Ex. 28 (18 TTABVUE 66-67).

Exs. 26-27 (18 TTABVUE 63-65), but the exposure of the marks extends far beyond College Station, Texas.

The fundraising arm of Texas A&M athletics, which is responsible for ticket sales and athletic donations, is called the 12th Man Foundation, and uses its name under license from Opposer. Tr. 51:10-14; 56:2-8; 79:4-83:8, 21-85:25 Exs. 21-24 (18 TTABVUE 5-58). The 12th Man Foundation annually gives the E. King Gill award to important ambassadors of the Texas A&M athletic program, Ex. 24 (18 TTABVUE 46), and publishes a monthly magazine called 12th Man that features Texas A&M athletics and the importance of donors to the academic and athletic experience of students. Tr. 81:11-18; 83:10-21; Exs. 21, 24 (18 TTABVUE 10-20, 26-31).

In 2014, the Texas A&M athletics website became identified by the URL 12thman.com. Tr. 59:6-7; 63:23-66:13; Exs. 15, 158 (17 TTABVUE 91; 19 TTABVUE 502-507). Opposer also uses “12th Man” extensively in its social media accounts, Tr. 87:23-88:4; 116:5-9, which Mr. Hinckley testified are among the top university social media accounts nationwide, with fans and followers interacting through them on a worldwide basis. Tr. 124:9-125:8. Uses of the mark include in the “@12thMan” handle for the Texas A&M athletics Twitter account, which has more than 100,000 followers, its athletics Facebook page, which has more than 230,000 followers, its Instagram account, which is entitled “12th Man” and has almost 100,000 followers, its Pinterest account, which is the most followed such account of any institution of higher education, its hashtags, which include #12thMan, and on its YouTube page, which has over 29,000 subscribers. Tr. 116:11-22; 117:6-124:8; Exs. 46-57 (18 TTABVUE

131-142). The Texas A&M athletics mobile app is called 12th Man. Tr. 67:6-68:12; Ex. 18 (17 TTABVUE 99-100). The Texas A&M athletic video, photography and content production team is known as “12th Man Productions,” and it hosts studio shows, programs, and networking for national broadcasts in the “12th Man Studios.” Tr. 65:6-19; Ex. 158 (19 TTABVUE 509).

### **Licensing of Opposer’s 12TH MAN Marks**

Opposer has licensed the 12TH MAN and HOME OF THE 12TH MAN marks for use on numerous goods and services as part of a licensing program of the sort that has been engaged in by colleges and universities for decades.<sup>18</sup> *See generally Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182 (TTAB 2014); *Univ. Book Store v. Univ. of Wis. Bd. of Regents*, 33 USPQ2d 1385, 1401 (TTAB 1994) (discussing development of collegiate licensing in the 1970s and 1980s). Opposer currently has about 600 licensees around the United States, as well as dozens of corporate sponsors. Tr. 125:23-25; 136:8-10; 137:14-22. Mr. Hinckley authenticated and testified about Exhibit 58, which comprises nearly 300 pages showing what he described as samples of uses of the 12TH MAN mark on a wide variety of currently available licensed goods, including both the goods and services for which Opposer has registered its marks and other goods and services. Tr. 125:18-23; 131:19-24; 133:9-16.

Goods bearing the 12TH MAN mark and depicted in Exhibit 58 include towels, flags, pins, numerous types of apparel, replica football jerseys, bracelets, banners,

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<sup>18</sup> Before his employment with Texas A&M, Mr. Hinckley oversaw a similar licensing program at the University of Utah, and he served as president of and on the board of directors of the International Collegiate Licensing Association. Tr. 17:1-5; 18:6-22:11.

signs, puzzles, hats, fabrics, mobile phone cases, ornaments, food trays, necklaces, decals, tattoo sheets, mirrors, wall art, plaques, collages, license plate frames,<sup>19</sup> scarves, earrings, trailer hitches, parking signs, magnets, blankets, pillows, stoneware, toggle charms, platters, glassware, money clips, cufflinks, and coffee. Tr. 125:18-126:21; 127:3-129:17; Ex. 58 (18 TTABVUE 140-433).<sup>20</sup> Mr. Hinckley testified that Opposer has licensed other Texas A&M marks for additional goods and services such as soaps, perfumes, financial services, boots, belt buckles, mailbox covers, and air conditioner covers. Tr. 31:2-15. He explained that Opposer's licensing of its marks for such a wide variety of goods and services is driven by consumers' desire to be able to display their affinity for Texas A&M "in every facet of everyday life." Tr. 135:1-13.

Licensed goods bearing Opposer's marks are available in the campus bookstore, on the Internet, through regional and national retailers, and through other outlets. Tr. 31:16-25; 141:17-142:3. The vast majority of sales of goods bearing the 12TH MAN mark occurs through a channel other than the campus bookstore. Tr. 141:17-142:3. For the fiscal year ending June 2016, the volume of retail sales of licensed merchandise bearing all of Opposer's marks was approximately \$85,000,000. Tr. 32:1-12; 126:21-25. Opposer does not currently have the ability to separately track retail

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<sup>19</sup> In 2013, Opposer auctioned off a personalized "12th Man" license plate to generate funds for the university and the state of Texas. It was purchased by a Texas A&M alumnus for \$115,000, by far the highest price ever paid at the time for a Texas license plate. The winning bidder gifted the plate to a decorated veteran who was a student at Texas A&M to honor his military service. Tr. 112:25-115:2; Exs. 43-44 (18 TTABVUE 116-123). The plate was presented to the veteran during a Texas A&M football game. Tr. 114:12-115:2.

<sup>20</sup> Mr. Hinckley explained that Exhibit 58 consists of a collection of pictures and website screenshots collected by a team of six persons operating at his direction. Tr. 40:23-41:25; 127:3-129:17.

sales of merchandise bearing the 12TH MAN mark, Tr. 32:13-20, but Mr. Hinckley testified that the majority of licensed goods bear the 12TH MAN mark in addition to the Texas A&M logo, Tr. 126:16-127:2, 7-12, suggesting that retail sales of goods bearing the 12TH MAN mark for fiscal year 2016 were in excess of \$40,000,000.

### **Opposer's Enforcement Activities and NFL Licenses**

In 2006, Opposer sued the Seattle Seahawks of the National Football League over the team's use of 12TH MAN in connection with various merchandise and promotions. Tr. 163:7-14; 168:1-169:17; Ex. 85 (19 TTABVUE 61-76). The parties entered into a settlement agreement in May 2006, pursuant to which Opposer licensed the Seahawks to make limited use of the 12TH MAN mark for five years in exchange for royalty payments, with an option to extend the agreement for another five years, which the parties subsequently exercised. Tr. 165:13-23; 170:1-6; 172:22-175:23; Ex. 87 (19 TTABVUE 80-88).<sup>21</sup> The license required the Seahawks to attribute ownership of the 12TH MAN mark to Texas A&M, and prohibited the Seahawks' use of the mark on merchandise. Tr. 166:2-22; 167:3-13; 170:7-21; Exs. 88-89 (19 TTABVUE 86, 94). In 2016, Opposer entered into a new agreement with the Seahawks permitting more limited use of 12TH MAN for five more years, but at a higher annual royalty, and requiring the Seahawks to cease use of the term "Home of the 12th Man." Tr. 200:18-201:25; Ex. 101 (19 TTABVUE 152-168). The 2016 license specifically recited that all use of the 12TH MAN mark by the Seahawks inured to the benefit of Texas A&M.

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<sup>21</sup> One year after signing the license with the Seahawks, Opposer signed a license with the Buffalo Bills of the NFL permitting limited use of the 12TH MAN mark within the Bills' stadium. Tr. 58:16-19; 182:4-6.

Ex. 101 (19 TTABVUE 159). Opposer's litigation with the Seahawks, and the licenses subsequently granted to the team, generated considerable national media coverage of Opposer's 12TH MAN mark. Tr. 163:15-165:11; 178:15-182:19; 184:17-187:14; 202:13-206:24; Exs. 86; 90-96; 98 102-107 (19 TTABVUE 77-79, 102-130, 143-147, 172-198).

In 2015, Opposer sued the Indianapolis Colts of the NFL over the team's use of 12TH MAN. Tr. 187:15-190:1; Ex. 97 (19 TTABVUE 131-142). The Colts settled the litigation by agreeing to cease all such use. Tr. 199:17-200:17; Ex. 100 (19 TTABVUE 148-153). The suit against the Colts and its settlement generated additional national media coverage of Opposer's 12TH MAN mark, including on a segment of the CBS Sports show "Inside College Sports." Adam Zucker, the show's host, opened the segment by stating that "When you hear the 12th Man, you think Texas A&M and the loyal and loud fans of the Aggies," Tr. 191:13-15, and the segment proceeded to discuss the history of the 12TH MAN mark and Opposer's litigation with the Colts. Mr. Hinckley appeared on camera at Opposer's 12th Man Studios to discuss the mark's significance to Opposer. Tr. 190:2-199:16; Ex. 98-99 (19 TTABVUE 140-143).<sup>22</sup> Mr. Hinckley testified that the segment had several million viewers. Tr. 199:9-16.

The record also establishes Opposer's aggressive enforcement of its trademarks, including the 12TH MAN mark, against unauthorized users through correspondence from Opposer's licensing agency, the Collegiate Licensing Company (now known as

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<sup>22</sup> The record contains a video of the segment, but it is not accessible in the public TTABVUE file. The video was played during Mr. Hinckley's testimony deposition and a transcription appears in his transcript. Tr. 191:12-197:21.

IMG Collegiate Licensing), or Opposer's outside counsel. Tr. 142:9-162:21; 207:13-215:21; Exs. 59-84 (18 TTABVUE 433-507; 19 TTABVUE 2-60); 109-156 (19 TTABVUE 198-497). Mr. Hinckley estimated that a majority of Opposer's overall trademark enforcement matters have involved the 12TH MAN mark. Tr. 209:23-210:7. In addition to the suits discussed above, Opposer's enforcement activities have involved numerous cease-and-desist letters, domain name proceedings, and oppositions or challenges to the registration of marks.<sup>23</sup> The record establishes that Opposer has been successful in securing numerous formal or informal agreements to cease unauthorized uses of, and attempts to register, 12TH MAN, or similar marks. Tr. 214:15-215:4; Exs. 59, 64-65, 69-70 (18 TTABVUE 436, 452, 455, and 474); 74, 76-77, 81, 109-110, 113, 115-122, 124-126, 128-130, 132-133, 135, 140, 142, 145-154, 156 (19 TTABVUE 4, 12, 15, 26, 201, 202-206, 226-228, 230-235, 240-245, 247-283, 286-291, 298-314, 326-342, 349-354, 356-368, 377-383, 412-474, 493-497). The record is devoid of evidence of any significant unlicensed or unchallenged use of the 12TH MAN mark in connection with goods or services.

Mr. Hinckley testified that Opposer's enforcement efforts have involved collaboration with the Seattle Seahawks from time to time, Tr. 208:6-209:22, and many of the settlements in the record pertain to unauthorized uses of marks that

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<sup>23</sup> Opposer obtained default judgments in Opposition No. 91219957 to registration of THE 12TH KID for clothing and in Opposition No. 91220626 to registration of 12TH FAN for clothing, Exs. 141, 144 (19 TTABVUE 369-376, 405-411), and secured the abandonment of other applications without filing oppositions. *See, e.g.*, Exs. 150, 154 (19 TTABVUE 446-450, 475-479).



referenced the Seahawks' use of 12TH MAN under license from Opposer. *See, e.g.*, Exs. 145, 147-148 (19 TTABVUE 412-417, 426-438).

**Applicant's 12TH MAN HANDS Handmade Loofah Soap Bar or Puck**

Applicant sells what its application identifies as "handmade loofah soap bar or puck."<sup>24</sup> We reproduce below a display showing Applicant's goods, including one bearing the applied-for 12TH MAN HANDS mark in the lower right-hand corner:



The record establishes that Applicant intended to associate its claimed 12TH MAN HANDS mark with football and specifically the Seattle Seahawks, Opposer's licensee of the 12TH MAN mark when Applicant adopted and commenced use of the applied-for mark in 2013. 15 TTABVUE 157 (Opposer's Req. for Adm. No. 5). Applicant's

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<sup>24</sup> The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed form or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). We take judicial notice that a "loofah" is "an object with a rough surface that is used to rub the body when washing. Loofahs are made from the dried fruit of a tropical plant, also called a loofah." *Cambridge Dictionary* ([dictionary.cambridge.org/us/dictionary/English](http://dictionary.cambridge.org/us/dictionary/English), accessed on July 10, 2018). According to Applicant's website, its soap "[h]as the natural loofah sponge built right in." Smith Decl. ¶ 12; Attachment 2 (15 TTABVUE 201, 206).

<sup>25</sup> 12 TTABVUE 3 (Applicant's Answer ¶ 1; Ex. A).

principal, Jeffrey C. Sellentin, described himself in Applicant's answer as a "[f]ormer Nebraska Cornhusker Football player," 8 TTABVUE 9 (Ans. ¶ 7), and Applicant admitted awareness "that the Seattle Seahawks professional football team is using Texas A&M's 12TH MAN mark in connection with professional football services under license and authorization from Texas A&M." 15 TTABVUE 160 (Opposer's Req. for Adm. No. 16). Applicant also admitted that its 12TH MAN HANDS mark was adopted to "call to mind the professional football team the Seattle Seahawks," *id.* at 159 (Opposer's Req. for Adm. No. 11), that the "label on Applicant's products intentionally combines Applicant's mark with a football image," *id.* at 161 (Opposer's Req. for Adm. No. 24), and that "Applicant's target consumer base is Seattle Seahawk fans." *Id.* at 163 (Opposer's Req. for Adm. No. 36). A football appears on the loofah soap shown above, which is depicted in Applicant's specimens of use. November 5, 2014 Application.

Applicant did not "clear" its 12TH MAN HANDS mark, or obtain legal advice regarding possible conflict with Opposer's 12TH MAN mark, prior to adopting or seeking registration of its mark. 15 TTABVUE 158 (Opposer's Req. for Admission Nos. 7-10).

### **III. Standing**

A threshold issue in every inter partes case is the plaintiff's standing to challenge registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). The plaintiff must show that it possesses a real interest in the proceeding beyond that of a mere

intermeddler, and that it has a reasonable basis for its belief of damage resulting from registration of the involved mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer has standing because it properly made of record its pleaded registrations of 12TH MAN and HOME OF THE 12TH MAN, which give Opposer a real interest in the proceeding and a reasonable belief of damage from registration of Applicant's mark, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000), based on a likelihood of confusion claim that is not wholly without merit. *See, e.g., Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

#### **IV. Opposer's Section 2(d) Claim**

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[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 on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its mark and that use of Applicant's mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant's goods, *Cunningham*, 55 USPQ2d at 1848, even in the absence of contrary evidence or argument. *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010).

**A. Priority**

Because Opposer's pleaded registrations are of record and Applicant did not counterclaim to cancel any of them, priority is not at issue with respect to the goods and services identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 n.7 (TTAB 2012).

**B. Likelihood of Confusion**

Our determination of the issue of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In every likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the goods or 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."). Opposer discusses these two key factors, as well as the claimed conceptual and commercial strength and fame of its 12TH MAN mark, under the fifth *du Pont* factor, 21 TTABVUE 24-27; the channels of trade and classes of customers for the parties' goods, under the third and fourth *du Pont* factors, *id.* at 28-34; the nature and number of similar marks in use on similar goods, under the sixth *du Pont* factor, *id.* at 34; the absence of instances of actual confusion, under the eighth *du Pont* factor, *id.* at 34-35; and the variety of goods on which Opposer's mark is used, under the ninth *du Pont* factor. *Id.* at 35.

We will focus on Opposer’s standard character mark 12TH MAN in Registration No. 1612053 for “towels,” in International Class 24.<sup>26</sup> If we find a likelihood of confusion as to that mark and those goods, we need not find it as to the 12TH MAN mark for other goods or services, or as to Opposer’s HOME OF THE 12TH MAN mark; conversely, if we do not find a likelihood of confusion as to Opposer’s 12TH MAN mark for towels, we would not find it as to the 12TH MAN mark for other goods or services, or as to Opposer’s HOME OF THE 12TH MAN mark. *See, e.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

### 1. The Strength of the 12TH MAN Mark

The fifth *du Pont* factor, the fame of the prior mark, and the sixth *du Pont* factor, the number and nature of similar marks in use for similar goods and services, *du Pont*, 177 USPQ at 567, are considered in tandem to determine the strength of Opposer’s mark and the scope of protection to which it is entitled. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).<sup>27</sup> Opposer argues that its “12TH MAN mark is an extremely strong mark when used on branded merchandise such as towels or soap,” 21 TTABVUE 25, and that the “strength and

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<sup>26</sup> 15 TTABVUE 6-19. Registration No. 1612053 issued on September 4, 1990 and was last renewed in 2010. It also covers various goods in International Classes 16 and 25 and services in International Class 36, but those goods and services are less pertinent to our *du Pont* analysis than the towels identified in the registration.

<sup>27</sup> The Federal Circuit recently reiterated that “[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)). Because we do not reach Opposer’s dilution claim, we need not determine whether Opposer proved “either/or” dilution fame.

fame of the mark 12TH MAN weigh heavily in favor of a determination that a likelihood of confusion exists.” *Id.* at 27. “[I]t is the duty of the party asserting fame to clearly prove it.” *Bd. of Regents, Univ. of Tex. Sys.*, 110 USPQ2d at 1194.

“In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.” *Bell’s Brewery*, 125 USPQ2d at 1345 (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTABS 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

There is no dispute regarding the conceptual strength of the 12TH MAN mark for towels. Registration No. 1612053 issued on the Principal Register without a requirement of a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.” *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). The term 12TH MAN has no meaning or significance in connection with towels other than as a source identifier for the goods. “There is no evidence that the phrase [12TH MAN] is used in everyday parlance or is used by other providers in conjunction with similar goods or services to impart the same kind of information,” *Bell’s Brewery*, 125 USPQ2d at

1346, and no evidence of any third-party use or registration of 12TH MAN that might suggest that 12TH MAN is conceptually weak because it has “a normally understood and well recognized descriptive or suggestive meaning . . . .”<sup>28</sup> *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (quoting 2 MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 11:90 (4<sup>th</sup> ed. 2015)). On this record, we find that 12TH MAN is an arbitrary term, and thus a conceptually strong mark, as applied to the towels identified in Opposer’s Registration No. 1612053.

The commercial strength of the 12TH MAN mark “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 mark[]; and the general reputation of the [goods].” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017). As discussed above, the record contains evidence of Opposer’s extensive use of the 12TH MAN mark, over many decades, to identify Texas A&M University and its athletic program. The mark has been exposed to wide swaths of the relevant purchasing public for the parties’ goods through multiple means, including television broadcasts of football

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<sup>28</sup> Applicant’s answer defined the “12th Man” as “the one that comes off the bench to ignite the team to victory when the players on the field or floor are not able to carry the load themselves,” 8 TTABVUE 6 (Ans. ¶ 3), and averred that “12th Man” is used in that manner at all levels of sports: “The 12<sup>th</sup> Man is a Spirit of a Fan Base. It’s the Cheering Crowd of Support. The Spirit lives in many towns across the [U]nited [S]tates. From high school, college and even to the Pro’s [sic].” *Id.* Applicant admitted that it did not have evidence to support these assertions, 15 TTABVUE 161 (Opposer’s Reqs. for Adm. Nos. 27-28), and the record is devoid of such evidence, but even if Applicant’s assertions were true, the 12TH MAN mark as applied to towels is at worst suggestive.

games at which 12th Man towels have been waived, social media, alumni and fan outreach, and collateral licensing of the mark for use on a wide variety of goods and services, including towels, which has generated many millions of dollars in retail revenues. The record also reflects considerable coverage of the mark in the media,<sup>29</sup> including coverage expressly associating the mark with Opposer. Finally, the record shows that Opposer has aggressively and successfully enforced its rights in the 12TH MAN mark, and there is no evidence of unlicensed third-party uses that might show commercial weakness. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *cf. Univ. Book Store*, 33 USPQ2d at 1392-1402 (rejecting evidence of third-party use of University of Wisconsin's BUCKY BADGER and similar marks as proof of University's loss of rights). On the basis of the record as a whole, we find that Opposer clearly showed that its 12TH MAN mark is very strong commercially. The *du Pont* fame factor strongly supports a finding of a likelihood of confusion. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35; *Tao Licensing*, 125 USPQ2d at 1056.

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<sup>29</sup> The record does not contain information regarding Opposer's expenditures for advertising and promotion of the 12TH MAN mark, or any such expenditures by Opposer's licensees. Given the nature of Opposer's 12TH MAN mark as an identifier of a university and its athletic programs, and the accompanying exposure of the mark as such, we find that the absence of such figures does not detract materially from Opposer's proof of the commercial strength of the 12TH MAN mark. For example, Mr. Hinckley testified, on the basis of an analysis of media coverage of Johnny Manziel's Heisman Trophy-winning season, that Opposer received approximately \$30,000,000 worth of such media coverage, which he described as "a lot of marketing dollars [t]hat would dwarf any college's marketing budget" and was in the range of "Fortune 500 companies." Tr. 106:4-107:19.



## 2. Similarity or Dissimilarity of the Marks

This *du Pont* factor considers “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). “The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018).<sup>30</sup>

Opposer’s mark is 12TH MAN in standard characters, and Applicant’s mark, 12TH MAN HANDS in standard characters, incorporates Opposer’s mark in its entirety. “Likelihood of confusion often has been found where the entirety of one mark is incorporated within another,” *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014), because “the presence of an additional item in the mark does not

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<sup>30</sup> As discussed below, the average purchaser of Applicant’s goods is a member of the general public who purchases handmade loofah soap for use in washing the hands.

necessarily eliminate the likelihood of confusion if some terms are identical.” *In re Mighty Tea Leaf*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

Confusing similarity between the parties’ marks may be avoided if the words 12TH MAN in the marks are not likely to be perceived by purchasers as distinguishing source because they are merely descriptive or diluted, or if the word HANDS in Applicant’s mark causes the two marks to convey significantly different commercial impressions. *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1207.01(b)(iii) (Oct. 2017) and cases cited therein. Neither condition exists here.

As discussed above, the 12TH MAN mark is not descriptive of the towels identified in Registration No. 1612053, and the record also establishes that the term 12TH MAN is not diluted as a source identifier. The presence of the word HANDS in Applicant’s mark does not cause the marks to have significantly different meanings. Applicant admitted that “[t]he term ‘12TH MAN’ is the dominant feature of Applicant’s Mark,” 15 TTABVUE 157 (Opposer’s Req. for Adm. No. 3), an admission that is consistent with the general principle that it is often the first part of a mark that is most significant and memorable. *See, e.g., Hunter Indus.*, 110 USPQ2d at 1660 (citing *Palm Bay Imps.*, 73 USPQ2d at 1692). Applicant also admitted that “[t]he word ‘HANDS’ in Applicant’s Mark merely describes that Applicant’s soap product is specifically designed for washing hands.” 15 TTABVUE 163 (Opposer’s Req. for Adm. No. 35). As a descriptor of a feature of Applicant’s goods, the word HANDS is “less significant or less dominant when comparing [the] marks.” *Hunter Indus.*, 110

USPQ2d at 1660; *see also In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). The source-identifying portion of Applicant's mark, the words 12TH MAN, is identical to Opposer's mark 12TH MAN, and we find that the shared term 12TH MAN gives the marks the same connotation and commercial impression. *See id.* at 1660-61 (the word PRECISION has the same meaning in the marks PRECISION and PRECISION DISTRIBUTION CONTROL, even if it is suggestive of a feature of the goods).

The marks 12TH MAN and 12TH MAN HANDS are very similar in appearance, sound, and connotation and commercial impression, and this *du Pont* factor also strongly supports a finding of a likelihood of confusion.

### **3. Similarity or Dissimilarity of the Goods**

This *du Pont* factor assesses the similarity or dissimilarity of the parties' goods as identified in Opposer's Registration No. 1612053 and Applicant's involved application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). "When analyzing the similarity of the goods, 'it is not necessary that the products of the parties be similar or even competitive to support a finding of a likelihood of confusion.'" *Davia*, 110 USPQ2d at 1815 (quoting *Coach Servs.*, 101 USPQ2d at 1722 (citation omitted)). "The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source." *Id.*

The identification of goods in Applicant's application is "handmade loofah soap bar or puck." The identification of goods in Opposer's Registration No. 1612053 includes "towels." These broadly identified goods are deemed to include "all the goods of the nature and type described therein," *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006), including loofah soap such as Applicant's, which "is specifically designed for washing hands," 15 TTABVUE 163 (Opposer's Req. for Adm. No. 35), and hand towels used in connection with washing hands.

Opposer argues that "[c]ommon experience suggests that soaps and towels are inherently related products" because "[o]ne generally needs a towel after using soap to wash one's hands," 21 TTABVUE 21, and we take judicial notice under Rule 201(b) of the Federal Rules of Evidence, Fed. R. Evid. 201(b), that hand towels are commonly used to dry the hands after they are washed with soap and water. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) ("tak[ing] notice that the products 'bread' and 'cheese' are often used in combination"). Where goods "are commonly used together, [such] 'conjoint use is a fact proper to be considered along with other facts present in particular cases.'" *Davia*, 110 USPQ2d at 1815 (quoting *Sholl Dental Lab. Co. v. McKesson & Robbins, Inc.*, 150 F.2d 718, 66 USPQ 223, 226 (CCPA 1945)). *See also Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 511 (TTAB 1984) (finding "applicant's bath sponges to be complementary in nature to a number of the personal products sold by opposer" and concluding "that these respective products would go hand in hand and would be sold to the same

customers through the same marketing channels”). At the same time, as the Federal Circuit has explained,

[t]hat two goods are used together . . . does not, in itself, justify a finding of relatedness. “The test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue . . . can be related in the mind of the consuming public as to the origin of the goods.”

*Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355-56 (Fed. Cir. 2004) (finding that the relatedness of kitchen textiles, including towels, to cooking classes could not be based merely on the fact that the goods would necessarily be used in providing the services) (quoting *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1355 (Fed. Cir. 2000)). We must determine whether “aside from the fact that [hand towels and handmade loofah soap] are used together . . . the consuming public would perceive them as originating from the same source” when they are sold under similar marks. *Id.* at 1356.

Opposer offered various types of evidence to show relatedness. Mr. Hinckley testified that Opposer has licensed its other marks for use on soaps, Tr. 31:2-15, and the Smith Declaration authenticates an advertisement for the “Texas A&M Soap Collection”:



**Texas A&M Soap Collection**

*Past, present, and future Aggies can show their college pride with this designer soap that's both fun to use and great for the skin. The A&M logo will last throughout the entire bar, so your school spirit lasts as long as your soap does. Gig 'Em!*

The University name and logo on this product are registered trademarks of Texas A&M University.

Mama Says Wash!™ handcrafts our soaps to produce a luxurious lather that leaves your skin feeling soft and clean. What makes our soap so special? The answer is simple... it's what is **not** in our soap. Did you know that most store-bought soaps aren't really even soap? They are detergents that are chemically manufactured with ingredients whose names you can't spell or pronounce. How great does that sound for your skin? Our soaps are made with all-natural plant-based oils and contain high percentages of glycerin, a natural moisturizer. Our soaps are great for all skin types, even sensitive skin.

No animals are harmed in the production of our soap as we never, ever test on animals.

**A great gift for all those future Aggies!**  
Our softly-scented baby soaps are individually wrapped and packaged in a white organza bag with gift tag. Available in pink or blue.

**Mama Says Wash the Dog!**  
Never tried a bar soap for dogs? You'll drop that slippery shampoo bottle forever once you've tried our all-natural soap for dogs. This hefty 7 ounce bar is loaded with shea butter, oatmeal, aloe and other oils to moisturize the skin and coats and leave your pup fresh and clean.

**Terms & Pricing:**  
See attached sheet for more information.

  
GO TEXAN.  
Crafted with Texas Pride

512.789.4789  
info@mamasayswash.com

**Mama Says Wash!**

**www.mamasayswash.com**  
TAMU1554

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Mr. Hinckley testified that consumers expect collateral licensing of the sort engaged in by Opposer to encompass products that are complementary in use, such as soap and hand towels, and sporting apparel and sporting goods, Tr. 134:5-24, because consumers “absolutely want to see a wide range of products” and they want to be able to “display their association with the school in every facet everyday life.” Tr. 135:8-13. Opposer’s use of its Texas A&M logo on both towels and soaps is evidence that such goods may emanate from a single source under the same mark.

Opposer made of record Internet webpages showing the sale of soap and towel sets:

<sup>31</sup> Smith Decl. ¶ 9; Attachment 1 (15 TTABVUE 199-204).

### College Soap & Guest Towel Set by Personalized Gifts

\$40.50



32

## WILLIAMS SONOMA HOME

Registry Stores New Shop By Room Shop The Look Design Inspiration Gifts eCatalog Sale

SEARCH

EXTENDED! EXTRA 20% OFF WAREHOUSE SALE!  
USE CODE EXTRA

UNLIMITED FLAT RATE DELIVERY  
FURNISH EVERY ROOM FOR ONE LOW RATE, STARTING AT \$99

Williams Sonoma Home > Search Results > Greek Key Soap and Towel Gift Set

### Greek Key Soap and Towel Gift Set

\$59

1

ADD TO CART

ADD TO REGISTRY

#### SUMMARY

A delightful gift to refresh the home, our exclusive set pairs luxurious soaps with guest towels in a modern Greek key motif. Crafted by artisans in Vermont, the vegetable-based soaps have a rich lather and a gentle, clean scent. The soft, linen-like disposable towels are custom-embossed with gold leaf.

- Set includes three guest soaps and twelve guest towels.
- Soaps and towels are embossed with a Greek key motif.
- Antique-white square soaps are triple-milled and infused with a fresh, water-based fragrance.
- Soaps are 100% plant-based, non-GMO, and contain no parabens, sulfate, phosphorus or phthalate; not tested on animals.
- Disposable towels are made of a thick, heavy paper that looks and feels like linen.
- Beautifully boxed and ready for gift-giving.

#### DIMENSIONS & MORE INFO

#### SHIPPING



SHARE YOUR STYLE | #MYWILLIAMSSONOMA

Add A Photo

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<sup>32</sup> 15 TTABVUE 115 (morethanpaper.com). The record shows that the “GT” mark that appears on the goods stands for “Georgia Tech,” and this use is thus another example of the collateral licensing of college and university marks. The other soaps and towels bear personalized monograms, personal names, or decorative insignia, not marks, *id.* at 116-129, but all of them are offered under marks such as Williams Sonoma and Bed Bath & Beyond.

<sup>33</sup> *Id.* at 119 (williams-sonoma.com).

**AmericanMoments**  
Favorite shop

93 items

Favorite **Like this item?**  
Add it to your favorites to revisit it later.



**Personalized Monogram Engraved Soap and Letterpressed Guest Towel Set - 2860\_O\_M**

**\$28.95** [Ask a question](#)

Ink Color  
Select an option

Quantity  
1

**Add to cart**

**Etsy Purchase Guarantee**  
Get what you ordered or your money back.  
[Learn more](#)

**Overview**

- Handmade item
- Holiday: Mother's Day
- Materials: 3 Oval Soaps, 15 Guest Towels
- Made to order
- Ships from United States to [select countries](#).
- Feedback: [81 reviews](#)
- Favorited by: [16 people](#)

This shop accepts Etsy gift cards


Item details (81) Shipping & Policies

Share Favorite Add to **34**

**VintageAndVictorian**  
Favorite shop

342 items

Favorite **Like this item?**  
Add it to your favorites to revisit it later.



**Vintage Mary Chess Soap and Towel Set, Vanity Decor, New Old Stock, Mary Chess Tapestry, Tapestry Soap, Soap Set, Vintage Fragrance**

**\$42.00** [Ask a question](#)

Only 1 available

**Add to cart**

**Overview**

- Vintage item from the 1960s
- Materials: tissue, soap
- Only ships within United States.
- Feedback: [519 reviews](#)
- Favorited by: [1 person](#)

This shop accepts Etsy gift cards

Item details (516) Shipping & Policies

Share Favorite Add to

**VintageAndVictorian**  
in Memphis, Tennessee

**35**

<sup>34</sup> *Id.* at 123 (etsy.com)

<sup>35</sup> *Id.* at 125 (etsy.com).





Personalization is required to add item to cart or registry.



Hover to zoom | Click to view larger

Personalization Available

### Carved Solutions Signature Spa Courtesy Gift Set in Gold

- Give the gift of luxury with the Carved Solutions Signature Spa Courtesy Gift Set
- Wet, lather, rinse, enjoy
- 100% vegetable based, triple milled soaps
- Vermont made
- Set Includes:
  - Three - 4 oz Square Verbena Bars
  - 12 Linen-like towels embossed in metallic color
- Oprah Favorite
- 30 day manufacturer's parts warranty
- Made in USA

SKU # 60309639

Vendor Shipping Details | Gift Packaging Unavailable



Part of the Carved Solutions Signature Spa Courtesy Gift Set Collection

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15 TTABVUE 113-129.

Opposer also made of record 26 subsisting use-based, third-party registrations of marks for both various types of “towels” and various types of “soaps.” 15 TTABVUE 54-82, 85-112.<sup>37</sup>

“[T]hird-party registrations which cover a number of different goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.”

*L’Oreal*, 102 USPQ2d at 1440 (third-party registrations, coupled with Internet evidence, showed relatedness of aloe vera drinks and various cosmetics) (quoting *In*

<sup>36</sup> *Id.* at 129 (bedbathandbeyond.com).

<sup>37</sup> An additional registration covers both sets of goods, but the subject mark was registered for soaps based on a foreign registration, not use in commerce. 15 TTABVUE 83-84 (Registration No. 4786371).

*re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *see also Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1431-32 (TTAB 2013). The large number of registrations here suggests that towels and soaps commonly emanate from a single source under the same mark.

The webpages and the third-party registrations are probative of the relatedness of towels and soap because they show that those goods are commonly offered under the same mark. *L'Oreal*, 102 USPQ2d at 1439-40; *Davia*, 110 USPQ2d at 1815-17. This evidence, which shows that towels and soap are commonly packaged together under the same mark, also reinforces the complementary nature and use of the goods.

We conclude from Opposer's evidence of relatedness that consumers would readily expect handmade loofah soap sold under the mark 12TH MAN HANDS to originate from the same source as towels sold under the mark 12TH MAN. The second *du Pont* factor also supports a finding of a likelihood of confusion.

#### **4. Channels of Trade and Classes of Customers**

The third *du Pont* factor considers "[t]he similarity or dissimilarity of established, likely-to-continue trade channels," *Stone Lion*, 110 USPQ2d at 1061, while the fourth *du Pont* factor considers the classes of customers to whom goods or services are sold. *Coach Servs.*, 101 USPQ2d at 1722-23. Neither Opposer's Registration No. 1612053 nor Applicant's application contain any restrictions or limitations, and their respective goods are thus presumed to travel through all usual channels of trade for the goods and to be sold to all usual classes of customers for the goods. *See, e.g., In re Thor Tech Inc.*, 90 USPQ 1634, 1639 (TTAB 2009). The record indicates that the usual class of customers of both loofah soap and hand towels are members of the general

public, including what Applicant describes on its website as “the Working Man! (and Woman).” Smith Decl. ¶ 12; Attachment 2 (15 TTABVUE 201, 206-207). Given the conjoint use of the goods, their classes of customers overlap by definition.

The record also shows that the channels of trade for soaps and towels overlap because both goods are offered on the same Internet websites, and we infer from the presence of the goods on the websites of retailers such as Bed Bath & Beyond and Williams Sonoma that the goods also appear together in the brick-and-mortar world. The third and fourth *du Pont* factors thus also support a finding of a likelihood of confusion.

#### **5. Other *du Pont* Factors**

As noted above, Opposer discusses the absence of instances of actual confusion, under the eighth *du Pont* factor, 21 TTABVUE 34-35, and the variety of goods on which Opposer’s mark is used, under the ninth *du Pont* factor. *Id.* at 35. We agree with Opposer that the admitted absence of evidence of actual confusion has little significance on this record because “there is no evidence that Applicant has made any appreciable sales that might engender known instances of actual confusion,” *id.* at 34, and this *du Pont* factor is thus neutral. We also agree with Opposer that the breadth of its demonstrated use of the 12TH MAN mark supports a finding of a likelihood confusion. *Id.* at 35.

#### **6. Conclusion**

All of the *du Pont* factors for which there is evidence either support a finding of a likelihood of confusion or are neutral. Opposer’s 12TH MAN mark is very strong, the marks are virtually identical, the relevant goods are complementary in use and

frequently emanate from the same source, and the channels of trade and classes of customers overlap. We thus find that Opposer proved, by a preponderance of the evidence, that Applicant's use of its mark 12TH MAN HANDS for handmade loofah soap bar or puck is likely to cause consumers of those goods to believe mistakenly that they originate with, or are licensed, sponsored, or authorized by, Opposer.

**Decision:** The opposition is sustained on the ground of likelihood of confusion, and we therefore need not reach Opposer's dilution claim.<sup>38</sup>

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<sup>38</sup> "Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . . [T]he Board's determination of registrability does not require, in every instance, decision on every pleaded claim." *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (citations omitted).