

THIS DISPOSITION IS NOT
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Paper No. 10
RLS/King

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Russell-Newman, Inc.**

Serial No. 74/**532,461**

Elisabeth A. Evert of Sidley & Austin for Russell-Newman,
Inc.

Stephen G. Leahy, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney)

Before **Simms, Cissel** and **Seeherman**, Administrative Trademark
Judges.

Opinion by **Simms**, Administrative Trademark Judge:

Russell-Newman, Inc. (applicant), a corporation of the
state of Texas, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark CALIFORNIA
DESIGN BY NIGHT ("CALIFORNIA DESIGN" disclaimed) for women's
and girls' apparel, namely dresses, skirts, pants, jackets,
vests, blouses, shorts, evening dresses, intimate apparel,
namely, panties, slips, bras, half-slips, camisoles,
lingerie, undergarments, sleepwear, namely, pajamas,

nightgowns, robes, caftans and T-shirts, stocking and hosiery, swimwear, beachwear, coverups, exercisewear, namely, sweatsuits, leotards, tights and leggings.¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC 1052(d), on the basis of Registration No. 1,558,940, issued October 3, 1989 (Section 8 affidavit accepted), for the mark NIGHT for clothing, namely, blouses, skirts, sweaters, slacks, evening gowns, jackets, scarves, hats, stockings, boots, shoes and slippers; purses and hand bags; and jewelry. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

The Examining Attorney argues that the respective marks are so similar that, as applied to the respective goods, confusion is likely. The Examining Attorney notes that applicant's goods and registrant's goods both include jackets, skirts, blouses and stockings, and that other items listed in applicant's application are closely related to registrant's clothing. These goods will be found in the same channels of trade, the Examining Attorney argues, such as department and clothing stores. It is the Examining Attorney's position, brief, 3, 6, that:

Thus the dominant portion of the applicant's mark is BY NIGHT. This dominant portion is virtually identical to the registrant's mark. The

¹ Application Serial No. 74/532,461, filed June 2, 1994, based upon applicant's bona fide intention to use the mark in commerce under Section 1(b) of the Act, 15 USC 1051(b).

commercial impression created by both marks is the same. A purchaser of women's clothing is likely to mistakenly believe that the goods sold under the mark, CALIFORNIA DESIGN BY NIGHT, are a line of clothing, perhaps a more casual "California style" of clothing, that come from the same source as the goods sold under the mark NIGHT...

...Hence, a consumer viewing the mark NIGHT and then seeing the term CALIFORNIA DESIGN BY NIGHT on identical and highly related goods would mistakenly believe that those "California design" style clothing emanated from Night, the same source as the NIGHT Clothing.

Applicant, on the other hand, argues that its mark is different in sight and sound from the registered mark and that the marks in their entireties convey different commercial impressions. In this regard, applicant argues, brief, 6:

The Examiner's argument that consumers may believe that the respective goods emanate [sic] from the same design (i.e. "BY NIGHT") is without merit, as the commercial connotation generated by Applicant's mark is of clothing to be worn "by night" as opposed to "by day". Accordingly, the respective marks are entirely dissimilar and generate completely distinctive commercial impressions and connotations such that **no** likelihood of confusion will result.

With respect to the goods, applicant argues that the goods in its application are "specific and narrow" and that registrant offers distinctly different goods including shoes, hats, purses, hand bags and jewelry. Applicant also argues that consumers of the respective goods are "sophisticated, with a high degree of brand awareness." (Brief, 7) Finally, referring to a listing of third-party

registrations, applicant argues that the cited mark is "weak."²

Upon careful consideration of this record and the arguments of the respective attorneys, we find that, at least with respect to certain goods, confusion is likely. As noted above, the Examining Attorney argues that purchasers will perceive applicant's mark as an indication that its goods emanate from the same source as the entity that offers NIGHT clothing, because applicant's mark includes the phrase "BY NIGHT," meaning that the goods are made by the NIGHT company. Applicant, on the other hand, argues that the connotation of its mark is that its clothing is to be worn "by night" as opposed to "by day." While it is entirely possible that this may be the connotation that one may glean from applicant's mark as used in connection with such goods as dresses, evening dresses, intimate apparel, sleepwear, etc., we do not believe that this connotation will be the one which is likely to be perceived by purchasers when applicant's mark is used in connection with such items as swimwear, beachwear, coverups, etc.,

² With respect to this listing of third-party registrations, the Examining Attorney states that the mere listing does not make them of record. While this may generally be true, here, in the action following applicant's presentation of this listing, the Examining Attorney, while arguing that these registrations are entitled to little weight on the question of likelihood of confusion because they are not evidence of what happens in the marketplace, did not object on the basis that this was merely a listing rather than copies of those registrations until his appeal brief. Accordingly, because the Examining Attorney did not raise this objection until that time, we shall consider this objection to have been waived.

clothing which is clearly intended to be worn during the day. With respect to these items of clothing, therefore, it is difficult to believe that the average purchaser would perceive applicant's mark in the way applicant's attorney contends he or she would. Rather, when applicant's mark is used in connection with clothing clearly intended to be worn during the day, it is more likely that the average purchaser will view applicant's mark in the manner suggested by the Examining Attorney. When so perceived, that is, that applicant's clothing is "California design" clothing "BY NIGHT"--made or produced by the same entity that puts out the NIGHT line of clothing--confusion is clearly likely. Because applicant's mark, used on some of the items in applicant's single-class application, so resembles the registered mark used on closely related articles of clothing as to be likely to cause confusion, we must affirm the refusal. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)("[L]ikelihood of confusion must be found if the public...seeing the mark on *any item* that comes within the description of goods set forth by appellant in its application, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item." (Emphasis in original)).³

³ It is noted that the Examining Attorney has argued that the descriptive wording CALIFORNIA DESIGN BY "clearly has no importance to the mark as a whole" (brief, 2). While, of course, descriptive matter is entitled to less weight in the likelihood-of-confusion analysis, we by no means subscribe to

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Decision: The refusal to register is affirmed.

R. L. Simms

R. F. Cissel

E. J. Seeherman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

the belief that such words are of "no importance to the mark as a whole."

Clearly, applicant's mark as a whole must be compared to the registered mark. Indeed, the Examining Attorney appears to so consider these marks in his final refusal.

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