

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

AUG 4, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Warnaco, Inc.

Serial No. 74/501,471

Karen Ash of Amster, Rothstein & Ebenstein for Warnaco, Inc.

Diane Melnick, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 18, 1994, Applicant filed an application to register the mark "OLGA SCOOP" on the Principal Register for "women's intimate apparel, namely panties," in Class 25. The identification-of-goods clause was subsequently amended to state the goods simply as "women's panties," and applicant claimed ownership of a number of prior registrations of marks consisting of or including the name "OLGA." The basis for the application was applicant's claim of use of the mark on these goods since September of 1965.

This application is now before us on appeal from the Examining Attorney's refusal to register under Section 2(d) of the Lanham Act on the ground that applicant's mark, as applied to women's panties, so resembles the mark "SCOOP," which is registered¹ on the Principal Register for "clothing, namely tops, shirts, T-shirts, sweatshirts, dresses, skirts, pants, shorts, skeggings, leggings, sweatpants, jackets, cardigans, leotards, unitards, tights, bodysuits, short sets, tank sets, [and] beach cover-ups," that confusion is likely.

Based on careful consideration of the record before us and the relevant legal principles and precedents, we hold that the refusal to register is proper. Confusion is likely because the marks are similar and the goods are commercially related.

Women's panties are related to several of the clothing items specified in the cited registration, particularly leggings, leotards, unitards, tights, t-shirts and bodysuits, all of which are knit products for wear with or without additional clothing over them. As the Examining Attorney points out, the goods of applicant and registrant do not need to be identical or even directly competitive in order for confusion to be found likely. All that is necessary is for the goods to be related in some manner, or

¹ Reg. No. 1.964,866, issued to Spectravest, Inc., a California

for the conditions surrounding their marketing to be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that they emanate from a single source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Corning Glass Works, 229 USPQ 65 (TTAB 1985).

This record includes evidence that the goods are related. The Examining Attorney made of record a sample of more than a dozen registrations, (from a total of more than six hundred registered marks), wherein the goods listed include both ordinary clothing and intimate apparel. This establishes a reasonable basis for reaching the conclusion that the use of similar marks on both women's panties and the clothing items listed in the cited registration is likely to lead consumers to believe, mistakenly, that a single source is responsible for all such products. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Additionally, the Examining Attorney made of record copies of articles retrieved from the Nexis® database. These articles demonstrate that the goods set forth in the registration are sold in the same departments in stores as women's panties are. These items are purchased by ordinary consumers, who normally retain general impressions

corporation, on April 2, 1996.

of marks, rather than specific details of them. Ordinarily, these people do not get the chance to compare the marks on a side-by-side basis, so if the general commercial impressions the marks create are similar, then confusion is likely to occur.

Turning then to the marks themselves, we note the obvious, that applicant has simply taken the registered mark, in its entirety, and added to it applicant's house mark, "OLGA." The Examining Attorney concedes that the house mark is well known in the field, but does not agree with applicant's argument that "SCOOP" is diluted and descriptive, and therefore weak in trademark significance, such that the addition of the house mark is sufficient to allow purchasers to distinguish between the two marks.

To begin with, applicant has not established that the common element in both marks, the word "scoop," is weak. There is only one registration in the clothing class for the word, and that one is the one cited here as a bar to registration.

In the past, there were apparently other registered marks which included the term, but now there is only the one cited here. Applicant argues that two applications to register the word "scoop" are pending, but applicant admits that the goods there are hair products, on one hand, and sunglasses and sports goggles, on the other.

Notwithstanding applicant's assertion to the contrary, this record does not include "ample evidence that the[se] goods are related to clothing." Even if there were several registrations and pending applications to register the term, the registrations and applications themselves would not establish weakness, in that they would not constitute evidence of use, and therefore could not show that the consuming public has become so familiar with marks using the term "scoop" that other elements are looked to in order to distinguish among such marks.

Further, there is no evidence that the term is merely descriptive of the goods in either the application or the cited registration. Given the ordinary meaning of the word, we can conclude that the term has a certain suggestiveness in connection with women's lingerie and clothing, but this record does not establish anything more than that. Applicant's arguments that "scoop" is weak because it is diluted and descriptive are simply unsupported.

Applicant's principal argument in favor of registration appears to be that the addition of its house mark to the registered mark eliminates the likelihood of confusion. As pointed out by the Examining Attorney, however, there is a substantial body of case law to the contrary. Citing *In re Dennison Manufacturing Co.*, 220 USPQ 1015 (TTAB 1983), for the proposition that adding a house mark or trade name to a

mark may actually increase the likelihood of confusion, rather than reduce it, she argues that by adding its house mark to the previously registered mark, applicant has appropriated the registered mark under the umbrella of the house mark, resulting in the likelihood that consumers will incorrectly assume that applicant is responsible for the goods sold under the registered mark.

Applicant cited a number of cases for the proposition that combining one's own house mark with the mark of another does not necessarily lead to confusion, but the Examining Attorney readily distinguished each such case. Most involved goods which were not as closely related as the goods in the case at hand. Others dealt with terms which were found to be either descriptive or weak from widespread use in a particular field.

We agree with the Examining Attorney that there is no per se rule that mandates either finding confusion to be likely or finding that there is no likelihood of confusion where a house mark has been added to a registered mark. Rather, the specific facts of each case must be evaluated in order to determine the effect of combining the two elements.

When we do this in the instant case, we find that confusion is likely because the goods listed in the registration have been shown to be closely related to those identified in the application, and the two marks are still

Ser No. 74/501471

similar, even after applicant's house mark has been placed in front of the registered mark. We can see no reason why a typical purchaser of women's apparel would not think that leotards sold under the mark "OLGA SCOOP" emanate from the same source as women's panties bearing the "SCOOP" mark.

Accordingly, the refusal to register under Section 2(d) of the Lanham Act is affirmed.

R. F. Cissel

G. D. Hohein

C. E. Walters
Administrative Trademark Judges
Trademark Trial & Appeal Board

Ser No. 74/501471