

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

AUG. 4, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re James A. Metcalf

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Serial No. 75/084,742

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L. Craig Metcalf of Madson & Metcalf for applicant.

Katherine Stoldes, Trademark Examining Attorney, Law Office  
109 (Deborah S. Cohn, Managing Attorney).

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Before Seeherman, Hohein and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

James A. Metcalf has filed a trademark application to register the mark SKI GULL for "clothing, namely, caps, hats, headwear, T-shirts, sweatshirts, sport shirts, shorts, pants, sweaters and jackets."<sup>1</sup> The application includes a disclaimer of SKI apart from the mark as a whole.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15

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<sup>1</sup> Serial No. 75/084,742, in International Class 25, filed April 8, 1996, based on an allegation of a bona fide intention to use the mark in commerce.

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U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "clothing, namely, wet suits for use in surface water sports, jackets, T-shirts, tracksuits and trousers, footwear, headwear, mittens and gloves,"<sup>2</sup> that, if used on



or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both the applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Both the application and registration identify clothing items, several of which are either identical or essentially the same (i.e., in both the

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<sup>2</sup> Registration No. 1,482,439 issued March 29, 1988, to Gul International Limited Company, in International Class 25. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

application and the registration - headwear, T-shirts and jackets; in the application - caps, hats, and pants; and in the registration - trousers). Except, perhaps, for registrant's "wet suits," the remaining items of clothing identified in both the application and the registration are closely related items of clothing.

Turning to consider the marks, we note the well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Further, a lesser degree of similarity between two parties' marks is required when the marks are applied to identical goods. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989). As the Board stated in *In re J.M. Originals*, 6 USPQ 1393 (1987):

A finding of likelihood of confusion need not necessarily be premised on a finding that prospective purchasers would not be able to distinguish the two marks when used on identical or closely related goods. Even if prospective purchasers could distinguish the two marks, a finding of likelihood of confusion may nevertheless be premised on a finding that these prospective consumers would erroneously believe, because of the similarities in the marks, that

goods bearing the two marks emanate from the same, albeit perhaps anonymous, source.

Registrant's mark consists of the word GUL in a simple script and, directly above the word, the darkened outline of a bird with its wings outstretched. The visual impression, as well as the connotation, created by the word and bird design combination is that of a type of bird known as a "gull."<sup>3</sup> The word portion of registrant's mark is a minor misspelling of the word "gull" which does not alter its connotation. The word and design elements of registrant's mark reinforce each other so that the overall commercial impression of the mark is also of a type of bird known as a "gull."

The GULL portion of applicant's mark is identical in sound and connotation, and substantially similar in appearance, to the GUL portion of registrant's mark. The word SKI in combination with GULL calls to mind, and presents a clever play on, the term "sea gull," which is a type of "gull."<sup>4</sup> Thus, both parties' marks evoke images of birds which are gulls. While applicant's goods are not limited as to their use, in view of applicant's disclaimer of the word SKI, we presume that at least some of the

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<sup>3</sup> We take notice of the definition, in *Webster's II New Riverside Dictionary*, 1984, of "gull" as "any of various chiefly coastal aquatic birds of the subfamily Larinae, with long wings, webbed feet, and usu. gray and white plumage."

<sup>4</sup> We take notice of the definition, in *Webster's II New Riverside Dictionary*, 1984, of "sea gull" as "a gull, esp. one frequenting coastal areas."

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clothing identified in the application is for use while skiing. It is very likely that consumers familiar with registrant's mark in connection with the identified clothing items will, upon encountering applicant's mark in connection with the same or closely related clothing items, believe that applicant's mark identifies a line of ski-related clothing emanating from, or authorized by, registrant.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, SKI GULL, and registrant's mark, GUL and design, their contemporaneous use on the same and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal under Section 2(d) of the Act is affirmed.

E. J. Seeherman

G. D. Hohein

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board