

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB NOV. 9, 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 **RRF Industries, Inc.**

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Serial No. 75/136,710

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**Myron Amer** of Myron Amer, P.C. for applicant.

**George M. Lorenzo**, Trademark Examining Attorney, Law Office 109  
(**Deborah Cohn**, Managing Attorney).

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Before Quinn, Hohein and Walters, Administrative Trademark  
Judges.

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

An application has been filed by **RRF Industries, Inc.**  
to register the mark "WINDBREAKER REGATTA" and design, as



reproduced below,

for "men's, women's, boys' and girls' jackets".<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "WINDBREAKER," which is registered for, inter alia, "men's, young men's, boys', women's, misses' and girls' apparel for sportswear, dress wear, work wear, and uniforms; namely, jackets and coats of various stylings and lengths for outdoor and/or indoor wear, vests, trousers (slacks, pants, shorts, and breeches), suits, shirts, blouses; said articles of apparel include those specifically adapted for particular uses; namely, golf and ski jackets, parkas, suburban and car overcoats and top coats, hunting and riding wear, rainwear, and swimwear; said articles of apparel may be comprised in whole or in part of woven, non-woven, and knitted fabrics (uncoated, coated, and/or impregnated) . . .,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

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<sup>1</sup> Ser. No. 75/136,710, filed on June 19, 1996, which alleges a bona fide intention to use the mark in commerce. The term "WINDBREAKER" has been voluntarily disclaimed. Moreover, although applicant initially identified its goods as "men's, women's, boys' and girls' jackets, shirts (knit and woven)[,] pants and shorts," in its request for reconsideration applicant requested that, "[i]f permitted, please amend the description of the goods by deleting therefrom 'shirts (knit and woven), pants and shorts'." While such request appears not to have been considered and entered by the Examining Attorney (despite the fact that applicant, in its initial brief, plainly states in the first paragraph thereof that the goods identified in the application have been "limited by amendment to 'men's, women's[,], boys' and girls' jackets'," we hereby deem the application to be so amended. We also note, however, that regardless of whether or not such items as "shirts (knit and woven)[,] pants and shorts" form part of the goods set forth in the application, our decision in this case would be the same since, like jackets, such items plainly are closely related to registrant's articles of wearing apparel.

Applicant has appealed. Briefs have been filed,<sup>3</sup> but an oral hearing was not requested. We affirm the refusal to register.

Applicant, notably without citation to a specific dictionary, argues in its initial brief that:

Since 1972 the word WINDBREAKER is noted in the dictionary as meaning "a short sports jacket ... having a tight-fitting band at the waist and cuffs, used for outdoor wear." ([U]nderlining added[.]) As such, it is descriptive of [the] "jackets" recited in applicant's present description of goods" [and has been disclaimed]....

....

In the [initial] Office Action ... the trademark attorney contends:

"The dominant element[s] of the marks are identical in appearance, sound, connotation and commercial impression, namely WINDBREAKER."

There is no support of record for holding that a word, namely WINDBREAKER, [which is] highly descriptive of "jackets" would be dominant over REGATTA, which is totally devoid of descriptiveness of the goods involved ....

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<sup>2</sup> Reg. No. 941,015, issued on August 15, 1972, which sets forth dates of first use of February 15, 1915; renewed. The registration also covers "plastic films and foams; natural and synthetic leather; [and] natural and synthetic fur".

<sup>3</sup> Applicant, with its reply brief, has submitted certain excerpts from various "DIALOG computer information sources" in the form of a "printout evidencing the generic use of WINDBREAKER [consisting] of 58 pages with plural citations on each page." Such evidence, however, not only is untimely under Trademark Rule 2.142(d) but, in any event, constitutes a collateral attack upon the validity of the cited registration which will not be considered in the context of an ex parte appeal. Instead, if applicant believes the mark of the cited registration to be generic for some of registrant's goods, its remedy lies in the commencement of a petition to cancel such registration as to those goods. See, e.g., Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3), and In re Calgon Corp., 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

Logic dictates that in applicant's two-word mark ... REGATTA not WINDBREAKER is the dominant word.

To a purchaser, the connotation of applicant's mark is that the product, if a jacket, is a REGATTA-labelled "short sports jacket ... having a tight-fitting band at the wrist [sic] and cuff [sic], used for outdoor wear."

Applicant, in view thereof, contends that there is simply no likelihood of confusion.

The Examining Attorney, on the other hand, asserts in his brief that "[w]hile the wording WINDBREAKER is found in the dictionary, Webster's clearly defines it as "[a] **trademark** for an outer jacket having close-fitting often elastic cuffs and waistband."<sup>4</sup> Accordingly, and in light of TMEP §1213.10,<sup>5</sup> the Examining Attorney maintains that "applicant may not simply

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<sup>4</sup> Citing Webster's II New Riverside University Dictionary (1994) at 1320, the Examining Attorney "requests that the Board take judicial notice of the definition from Webster's cited above." Inasmuch as it is well settled that the Board may properly take judicial notice of dictionary definitions, we have considered the definition of "Windbreaker" furnished by the Examining Attorney as well as the asserted dictionary definition thereof offered by applicant. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>5</sup> Specifically, such section, entitled "Mark of Another May Not Be Registered with Disclaimer," provides that:

Normally, a mark which includes a mark registered by another person must be refused registration. Disclaiming another person's mark does not normally justify registration. However, one can incorporate the entire mark of another if there is no resulting likelihood of confusion. A party who incorporates the entire mark of another with resulting likelihood of confusion may not avoid such a finding by disclaiming the mark of another. Cf. *In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662 (C.C.P.A. 1979) (permitting disclaimer of informational

disclaim the registered mark WINDBREAKER and escape a finding of likelihood of confusion."

The Examining Attorney, besides noting the general principle that "the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion," also contends in support of his position that:

[T]he typed-face [sic] of applicant's mark for WINDBREAKER REGATTA is relatively similar in size and appearance. That is, the word portion of the applicant's mark appears to employ the same font size and style. As such, neither the wording WINDBREAKER, nor the wording REGATTA[,] dominate applicant's mark. Thus, applicant's assertion that the wording REGATTA is the dominant word over the wording WINDBREAKER is unfounded.

Although applicant's ... mark also includes a design, that design is merely decorative and a background embellishment and does not obviate the similarity of the marks. When a mark consists of a word portion and a design portion, as in the applicant's mark, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *In re Appetito Provisions Co. [Inc.]*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). For this reason, ... greater weight [must be given] to the literal portions of the marks in determining whether there is a likelihood of confusion. In this case, the wording WINDBREAKER REGATTA is the dominant part of applicant's mark.

In view thereof, and inasmuch as both applicant and registrant utilize their respective marks in connection with the same types of clothing, namely, jackets, the Examining Attorney concludes that "a likelihood of confusion exists between the two marks."

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phrase indicating that applicant's employees are represented by certain labor organizations).

We agree with the Examining Attorney that confusion is likely. In this case, the respective goods are identical in part (jackets) and are otherwise closely related articles of wearing apparel (e.g., vests, trousers, suits, shirts and blouses) which would be sold to the same classes of purchasers through the identical channels of trade. Applicant, as the Examining Attorney accurately points out, does not contend to the contrary. Consequently, if applicant's jackets, as well as registrant's jackets, vests, trousers, suits, shirts, blouses and other closely related items of clothing, were to be sold under the same or substantially similar marks, it is plain that confusion as to the source or sponsorship of such products would be likely to occur.

Turning, therefore, to consideration of the respective marks, we disagree with applicant that the term "REGATTA" must be considered the dominant or primary source-signifying element of applicant's mark. Instead, given the nautical theme conveyed by the background design of a ship's decorative or signaling flag in applicant's mark and the same size and style of lettering used for the wording, we concur with the Examining Attorney that it is the literal elements of applicant's mark, namely, the words "WINDBREAKER REGATTA," which form the principal source-indicative portion of applicant's mark and which would be used in calling for or otherwise inquiring about applicant's goods. Thus, when considered in their entirety, applicant's "WINDBREAKER REGATTA" and design mark is substantially similar in sound, appearance, connotation and overall commercial impression to registrant's

"WINDBREAKER" mark, which must be regarded on this record as an arbitrary or fanciful mark for registrant's goods, particularly in the absence (as noted earlier) of a petition by applicant for partial cancellation of the cited registration on the ground that such mark is generic for jackets.

In light thereof, we conclude that purchasers and prospective customers, familiar with registrant's "WINDBREAKER" mark for jackets, vests, trousers, suits, shirts, blouses and other clothing items closely related to jackets, could reasonably believe, upon encountering applicant's substantially similar "WINDBREAKER REGATTA" and design mark in connection with jackets, that such products are a new or additional line of wearing apparel produced or sponsored by registrant.

**Decision:** The refusal under Section 2(d) is affirmed.

T. J. Quinn

G. D. Hohein

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