

Hearing:

November 4, 1998

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

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OCT. 19, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Next PLC

v.

Nextec Applications, Inc.

Opposition Nos. 102,929 and 104,583
to application Serial Nos. 74/707,547 and 74/707,526
both filed on July 26, 1995

Paul F. Kilmer and Stephen J. Jeffries of Gadsby & Hannah
LLP for Next PLC.

Elizabeth A. Langworthy, Patricia B. Cunningham and John L.
North of Sutherland, Asbill & Brennan LLP for Nextec
Applications, Inc.

Before Hohein, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Nextec Applications, Inc. has filed applications to
register the mark NEXTEC as shown below,

for "silicone-treated fabrics for the following uses: floor coverings; industrial applications, namely automotive fabrics, architectural fabrics, awnings, canopies, tents, tarps, banners, flags, geosynthetic fabrics, marine products, and protective wear; home textiles, namely, towels, curtains, draperies, upholstery, and bedding materials; consumer apparel, namely coats, raincoats, bathing suits and accessories, jackets, pants, shorts, skirts, shirts, blouses, underwear, uniforms, gloves and shoes; and medical and laboratory products, namely gowns, masks, and gloves,"¹ and "material treatment services, namely silicon fabric coating services to the order or specification of others."²

Registration has been opposed by Next PLC, a United Kingdom corporation. As grounds for opposition, opposer alleges, in each opposition, that since prior to the filing date of applicant's application, opposer has used the mark NEXT in connection with clothing and accessories, retail clothing stores, home furnishings, and home textiles; that it is the owner of Registration No. 1,692,188 (issued June 9, 1992) for the mark NEXT DIRECTORY for "publications; namely, catalogues featuring clothing, leather goods and

¹ Serial No. 74/707,526 filed July 26, 1995 under Section 1(b) of the Trademark Act.

² Serial No. 74/707,547 filed July 26, 1995 under Section 1(b) of the Trademark Act.

accessories and mail order catalogue services featuring clothing, leather goods and accessories;" and that applicant's mark NEXTEC and design so resembles opposer's previously used and registered marks as to be likely to cause confusion, mistake or deception.

Applicant, in its answers, denied the salient allegations of likelihood of confusion.³

The record consists of the pleadings; the parties' stipulated evidence (with exhibits)⁴; and notices of reliance filed by both parties.

Both parties filed briefs on the case and were represented by counsel at the oral hearing.

The record shows that opposer is a source and retailer of men's, women's, children's and infant's wearing apparel, footwear and accessories, jewelry, fragrances and bedding articles, such as bedspreads, covers and quilts. Opposer sells its products by mail order catalogues and in its own retail stores. Opposer began selling wearing apparel in the United States through catalogs around January 1991 and opened its first retail apparel and accessories store in the United States in Boston, Massachusetts in September 1993. Opposer currently operates five U.S. retail stores and has expanded its line of products to include jewelry, fragrances

³ We note that the oppositions were consolidated by the Board in an order dated April 29, 1997.

Opposition Nos. 102,929 and 104,583

and bedding articles. Opposer advertises and promotes its merchandise through newspaper advertising and in-store displays. Opposer's sales of its products have totaled over \$20 million and its advertising expenses over \$1.5 million.⁵

Applicant is a specialty finisher of fabrics for use in apparel, medical, household, marine and industrial applications. Applicant applies a silicone encapsulation process to a variety of textile materials. Applicant promotes its material treatment services and its treated fabrics by distributing brochures at trade shows.⁶

Inasmuch as the parties have stipulated that opposer is the owner of pleaded Registration No. 1,692,188 as well as five additional registrations set forth below, there is no issue with respect to opposer's priority. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The five registrations are:
Registration No. 1,766,454 for the mark NEXT DIRECTORY for "leather goods; namely wallets and hand bags, clothing, namely blouses, sweaters, jumpers, dresses, shirts,

⁴ The parties agreed to submit evidence in this manner in lieu of taking testimony.

⁵ Opposer's annual sales and advertising figures have been made of record under seal. While this kind of evidence is properly deemed confidential, we note that the parties marked a significant portion of the evidence in this case confidential, much of which the Board otherwise would not consider to be confidential.

⁶ Although the involved applications were filed under the intent-to-use provisions of the Trademark Act, it appears that applicant has begun to use the involved mark.

Opposition Nos. 102,929 and 104,583

swimwear, lingerie, belts and shoes"; Registration No.
2,095,429 for the mark NEXT for "men's, women's and

Opposition Nos. 102,929 and 104,583

children's clothing, namely shirts, jumpers, cardigans, pants, jeans, suits, ties, socks, shorts, underwear, scarves, gloves, coats, jackets, pajamas, dresses, blouses, skirts, leggings, sweaters, tights, stockings, bras, slippers, body stockings, night gowns, dressing gowns, boots, shoes, belts, hats, t-shirts, coveralls, jumpsuits, jogging pants, sweatshirts, and waistcoats; retail store services in the field of clothing, footwear, jewelry, cosmetics and accessories"; Registration No. 2,074,798 for the mark NEXT for "clothing, namely blouses, sweaters, jumpers, dresses, shirts, swimwear, lingerie, belts and shoes"; Registration No. 2,077,785 for the mark NEXT INTERIORS for "bedspreads, duvet covers, pillow cases, sheets, quilts and duvets"; and Registration No. 2,116,498 for the mark NEXT BOYS & GIRLS for "children's clothing, namely dresses, shirts, blouses, skirts, t-shirts, shorts, leggings, suspenders, shoes, socks, tights, cardigans, jumpers, hats, coveralls, jumpsuits, scarves, gloves, jogging pants, sweatshirts, coats, waistcoats, jackets, pajamas and dressing gowns."⁷

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) of the Trademark Act must be based on an analysis of

⁷ Although opposer did not plead ownership of these five registrations in the notices of opposition, we deem the opposition pleadings to be amended under Fed. R. Civ. P. 15(b) to include such registrations, in view of the parties' stipulation.

all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to a consideration of the parties' respective goods and services. We note, in this regard, that the parties, in their briefs, have focused on a comparison of opposer's wearing apparel and bedding articles, i.e., bedspreads, covers and quilts, and applicant's silicone-treated fabrics for use in the manufacture of consumer apparel and home textiles, i.e., bedding materials. We would agree that these are the most pertinent of the parties' goods/services.

With respect to these goods, it is obvious that applicant's silicone-treated fabric is to be used in the manufacture of the very goods which opposer markets. Also, the record shows that manufacturers of wearing apparel and home textiles often practice "co-branding." That is, the finished wearing apparel or home textile item bears the mark of the manufacturer as well as the mark of the fabric utilized in the manufacture of the item. Under the circumstances, we find that opposer's wearing apparel and bedding articles, on the one hand, and applicant's silicone-treated fabric for use in the manufacture of consumer apparel and bedding materials, on the other hand, are

closely related goods. See *Dan River, Inc. v. Apparel Unlimited Inc.*, 226 USPQ 186 (TTAB 1985) and cases cited therein.

This case turns, therefore, on a comparison of the marks. The most pertinent of opposer's marks is NEXT. Because the word portion of applicant's mark, NEXTEC, encompasses opposer's mark NEXT, there are consequent similarities in appearance and sound. Nonetheless, we agree with applicant that the marks have quite different commercial impressions. As applicant points out, NEXT is a recognized word, whereas NEXTEC is a coined term. Contrary to opposer's argument, we do not believe that purchasers would perceive NEXTEC as a "simple contraction" of NEXT. Rather, when applied to silicone-treated fabric, NEXTEC suggests "high tech" fabric. Also, in comparing the marks, we cannot overlook the stylized "X" and fabric swatch design in applicant's mark. These elements aid in distinguishing applicant's NEXTEC and design mark from opposer's NEXT mark. In sum, the differences between the marks in commercial impression clearly outweigh any similarities in appearance and sound.

We find, therefore, that the marks are not so similar that, when used on wearing apparel and bedding articles, on the one hand, and silicone-treated fabrics for use in the manufacture of consumer apparel and bedding materials, on

Opposition Nos. 102,929 and 104,583

the other hand, confusion is likely. Compare: Dan River, Inc., *supra* [The marks DAN for fabric and DAN'ELLE for clothing create similar commercial impressions such that confusion is likely].

Several other matters require comment. Although opposer argues that its NEXT mark is entitled to "an expansive scope of protection over a wide range of related products and services" (Brief, p. 28), the evidence falls short of establishing the fame of opposer's mark. While it appears that opposer has enjoyed some success with its products, we cannot conclude, based on the present record, that its mark has become famous. Compare: Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

On the other hand, in reaching our decision, we have given little weight to applicant's argument that opposer's NEXT mark is weak and, therefore, entitled to a limited scope of protection. In support of this argument, applicant submitted a list of retail clothing and/or shoe stores with NEXT in their names; labels and hang tags from the garments of three manufacturers bearing marks which include the term NEXT; and over twenty third-party registrations for marks which include the term NEXT for clothing. As to the third-party registrations, they are entitled to little weight on the question of likelihood of confusion. In re Hub

Opposition Nos. 102,929 and 104,583

Distributing, Inc., 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the marks listed therein. National Aeronautics and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975). As to the list of retail clothing and/or shoe stores, this is not particularly probative on the issue of likelihood of confusion with respect to the particular goods involved herein. We are left, then, with three instances of actual third-party use of marks which include the term NEXT for goods of the type involved herein, which is certainly not a substantial number.

Finally, the fact that there have been no instances of actual confusion has been given no weight in view of the lack of evidence concerning the level and scope of distribution and sales of applicant's fabrics, and therefore the opportunity for possible confusion.

Opposition Nos. 102,929 and 104,583

Decision: The oppositions are dismissed.

G. D. Hohein

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board