

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

MAY 18, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 175413 Canada Inc.

Serial No. 75/126,056

Walter Ames of Watson Cole Stevens Davis, P.L.L.C. for
applicant.

Angeli M. Micheli, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

175413 Canada Inc. has filed an application to
register the mark RUGBY for "leather and suede articles,
namely, back packs, clothes bags, pouches, shopping bags,
small valises, valises, and school bags."¹

¹ Serial No. 75/126,056, filed June 6, 1996 under Section 44(e),
based on Canadian Reg. 386,641, issued July 12, 1991.

Registration has been finally refused under Section 2(d) of the Trademark Act, on the ground of likelihood of confusion with the registered mark RUGBY CLUB for luggage.² Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

We first consider the du Pont factors³ most relevant under the present circumstances, namely, the similarity or dissimilarity of the marks, the similarity or dissimilarity of the goods and the similarity or dissimilarity of the channels of trade.

The Examining Attorney argues that, although the marks must be considered in their entirety, the term RUGBY is the dominant component of the registered mark, as well as applicant's mark in its entirety. Thus, the Examining Attorney contends that similar commercial impressions are evoked by the marks, applicant's mark suggesting the sport of rugby itself, and the registered mark suggesting a group who participate in this sport.⁴

² Reg. No. 1,651,491, issued July 7, 1991, Section 8 affidavit accepted.

³ See *In re du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

⁴ We find the Examining Attorney's further argument that use of the term "rugby," a demanding and punishing game, on luggage connotes that the goods are durable and able to endure punishment to be rather tenuous.

Applicant, on the other hand, argues that the word CLUB in the registered mark cannot be disregarded, that it is not a descriptive word as used in the mark, but rather functions to change the meaning of the mark from a sport to a club and the degree of exclusivity connected therewith. Applicant has made of record specimens from the registration file showing use of the registered mark in conjunction with the mark MEMBERS ONLY, which applicant claims emphasizes the exclusivity connotation of the registered mark. In its supplemental brief, applicant has pointed to the recent decision by our chief reviewing court in Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) as being highly similar. In that case, the court affirmed the Board's holding that the second word in applicant's mark CRYSTAL CREEK served to create a totally different commercial impression from the one created by opposer's mark CRISTAL.

While it is true that marks must be considered in their entirety in determining likelihood of confusion, it is also well established that there is nothing improper in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

In the present case, we agree with the Examining Attorney that the word RUGBY, applicant's entire mark, is the dominant component of the registered mark RUGBY CLUB. While CLUB may bring to mind a group of persons who play the sport, still the key focus is on the particular sport, RUGBY. Any secondary connotation of exclusivity would most reasonably be on the basis of participation in this sport, and not on the basis of membership in a club per se. Furthermore, although not pointed out by the Examining Attorney, there is another possible interpretation of the word CLUB in the registered mark which would render its trademark significance even less. This arises from the fact that the mark RUGBY CLUB is being used on luggage and "club bag" is a term used to describe a particular type of luggage.⁵

We do not see the parallel which applicant has attempted to draw with the *Roederer* case, *supra*. There the Board found, and the court agreed, that the mark CRISTAL evoked the image either of the clarity of the wine with which it was being used or of the bottle in which it was

⁵ Inasmuch as the Board may take judicial notice of dictionary definitions, we note the following:

club bag n. a rectangular usu. leather traveling bag that tapers to a purselike opening at the top and that is often zippered. *Webster's New International Dictionary* (1976). See *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981).

contained, whereas the mark CRYSTAL CREEK suggested a clear creek or stream. The word CREEK played a major part in the commercial impression being created.

Here, however, the word CLUB is clearly secondary in importance and its inclusion in the mark does not detract from the dominant significance of the word RUGBY. Even if the word is perceived as an indication of an exclusive group, the primary focus of this group or CLUB remains RUGBY. Thus, we find the marks as a whole create highly similar commercial impressions.

Turning to the goods involved, we can see little distinction between the general category of "luggage" as covered by the registration and the named items in applicant's recitation of goods. While applicant argues that the designation "luggage" encompasses goods such as steamer trunks and bulky suitcases which are distinct from applicant's goods, this is not the determinative factor. In the first place, the designation "luggage" reasonably would be interpreted to specifically cover at least some of applicant's goods, such as clothes bags, pouches and valises. Even if this were not the case, we find that the Examining Attorney has introduced adequate evidence, in the form of third-party registrations, that goods such as backpacks, school bags, clothing bags and luggage are often

marketed under a single mark by a particular entity. Thus, it might well be assumed that applicant's goods and registrant's luggage emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Finally, applicant argues that the channels of trade for the respective goods differ in that applicant's goods are "high fashion leather and suede articles" which would not be sold in the same retail outlets as registrant's "more mundane" luggage. There are no limitations, however, in either the registration or the application with respect to the channels of trade, and thus it must be presumed that the goods of both travel in all the normal channels of trade for goods of this type. See *Kangol Ltd. v. Kangaroo U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) and the cases cited therein. Nor is there any limitation as to the nature or composition of registrant's luggage, which would distinguish it from the leather and suede articles of applicant. Thus, we must make our determination on the assumption that the goods of both would be encountered by the same potential purchasers in the same stores.

On the basis of these factors, we find that because of the similar commercial impressions created by the marks, and the high degree of similarity of the respective goods and of the channels of trade in which they would travel, there is the likelihood of confusion with applicant's use of the mark RUGBY for its named leather and suede articles and registrant's use of the mark RUGBY CLUB for luggage.

We have not ignored the additional issue raised by applicant with respect to consistency of practice within the Office. Applicant has pointed out that its earlier-filed application to register the mark RUGBY NORTH AMERICA for goods very similar to those involved here was passed to publication by a different Examining Attorney without any citation of the registered mark RUGBY CLUB; that the mark was not opposed by the registrant; and that the application has now issued as a registration.

The present Examining Attorney has responded by relying upon the long standing principle that each case must be decided on its own merits and that the action of another Examining Attorney with respect to a different application is not binding here. We obviously concur with this principle. We would also point out, however, that there are specific reasons for a distinction to be made between the marks involved in the two applications filed by

Ser No. 75/126,056

applicant. In the first application the mark was RUGBY NORTH AMERICA; in the present application the mark is simply RUGBY. The cited mark is RUGBY CLUB. There are obvious differences between the two composite marks, RUGBY NORTH AMERICA and RUGBY CLUB, in appearance and sound alone. Even though applicant has disclaimed the geographic term NORTH AMERICA, it remains a part of the mark as viewed by the public and adds to the impression created thereby. Thus, we cannot agree with applicant's argument of inconsistency on the part of the Office. Although we admit that there is a certain degree of subjectivity involved in any determination of likelihood of confusion, there is a clear basis in this instance for a distinction to be drawn between the two marks of applicant.

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

R. F. Cissel

T. J. Quinn

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board