

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 28, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Antonio Sanchez

Serial No. 75/306,107

Kit M. Stetina of Stetina Brunda Garred & Brucker for Antonio Sanchez.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 109
(Ronald Sussman, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Antonio Sanchez to register the mark "PAOLO DE MARCO" and design, as shown below,

for "leather apparel, namely shoes".¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 75/306,107, filed on June 10, 1997, which alleges dates of first use of December 1993. The name "PAOLO DE MARCO" does not identify a particular living individual.

applicant's mark, when applied to his goods, so resembles the mark "DE MARCO CREATIONS" and design, as reproduced below,

which is registered for "men's and boys' neckties and hosiery,"² as to be likely to cause confusion, mistake or deception.

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

Turning first to consideration of the respective goods, applicant concedes in his reply brief that he "cannot deny the potential relatedness between shoes and hosiery in that both items are produced for the feet." Nevertheless, and while further acknowledging the absence of any restrictions with respect to the goods listed in registrant's registration, applicant urges that men's and boys' neckties and hosiery "are likely to be sold through retail department stores, women's fashion stores and the like." Leather shoes, applicant

² Reg. No. 827,195, issued on April 4, 1967, which sets forth dates of first use of December 1, 1961; renewed. The word "CREATIONS" is disclaimed.

³ While the Examining Attorney, contending that a "mere listing of third-party registration is insufficient to make them of record," has for the first time objected in his brief to various third-party registrations referred to by applicant during the prosecution of the application, such objection has not only been waived by the failure to so advise applicant in a timely manner, but the Examining Attorney in any event treated the information in his final refusal as forming part of the record. Accordingly, we have considered the information pertaining to third-party registrations to be of record for whatever probative value it may have.

maintains, on the other hand "are likely to be sold in shoe stores or segregated sections of department stores," thereby dictating a finding of no likelihood of confusion.

We admit that there is no per se rule that all items of wearing apparel are considered to be related for purposes of assessing whether a likelihood of confusion exists. Each case, instead, must be decided on its own particular facts and circumstances. See, e.g., In re Shoe Works Inc., 6 USPQ2d 1890, 1891 (TTAB 1988) ["PALM BAY" and design for women's shoes sold solely through producers's own retail shoe store outlets not likely to cause confusion with "PALM BAY" for men's, women's and children's shorts and pants] and In re British Bulldog, Ltd., 224 USPQ 854, 855-56 (TTAB 1984) ["PLAYERS" for men's underwear not likely to cause confusion with "PLAYER'S" for shoes].

However, we note that in instances involving both items of footwear and clothing worn as outerwear, such goods have generally been found to be so closely related that their sale under the same or substantially similar marks would be likely to cause confusion. See, e.g., In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991) ["ESSENTIALS" for women's pants, blouses, shorts and jackets versus "ESSENTIALS" for women's shoes]; In re Pix of America, Inc., 225 USPQ 691, 692 (TTAB 1985) ["NEWPORT" for outer shirts versus "NEWPORTS" for women's shoes]; In re Alfred Dunhill Ltd., 224 USPQ 501, 504 (TTAB 1984) ["DUNHILL" for men's hosiery v. "DUNHILL" for shoes]; In re Kangaroos U.S.A., 223 USPQ 1025, 1026 (TTAB 1984) ["BOOMERANG" and design for men's

shirts versus "BOOMERANG" for athletic shoes]; In re Tender Tootsies Ltd., 185 USPQ 627, 629 (TTAB 1975) ["TENDER TOOTSIES" for women's and children's shoes and slippers v. "TOOTSIE" for ladies' nylon hosiery]; B. Rich's Sons, Inc. v. Frieda Originals, Inc., 176 USPQ 284, 285 (TTAB 1972) ["RICH'S CHEVY CHASERS" for shoes versus "FRIEDA'S CHEVY CHASE ORIGINALS" for women's knitwear, namely, dresses, suits, skirts and blouses]; and U.S. Shoe Corp. v. Oxford Industries, Inc., 165 USPQ 86, 87 (TTAB 1970) ["COBBIES" for shoes versus "COBBIES BY COS COB" for women's and girls' shirt-shifts].

Furthermore, as correctly pointed out by the Examining Attorney, neither applicant's nor registrant's goods contains any limitation as to their channels of trade or classes of purchasers. It must therefore be presumed that the respective goods encompass all goods of the types described, that they travel in all normal channels of trade for such goods and that they are available to all potential customers. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). The Examining Attorney, in addition, has made of record as support for his position over 25 use-based third-party registrations for marks which, in each instance, are registered for hosiery and/or socks, on the one hand, and shoes on the other. Moreover, at least seven of such registrations also list ties or neckties. Although such registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of a kind

which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

In view thereof, and in light of well settled authority, we concur with the Examining Attorney that applicant's leather shoes, including those for men and boys, and registrant's hosiery and neckties for men and boys are closely related goods which would be sold through the same channels of trade to the identical classes of purchasers. Confusion as to source or sponsorship thereof would plainly be likely to occur if such goods were to be sold under the same or substantially similar marks.

Turning, then, to consideration of the marks at issue, applicant argues in his initial brief that:

Registrant's mark consists of the stylized words "de Marco", with the fanciful design of the "M" surrounding the word "CREATIONS" in an elliptical format. As will be readily apparent, the prominence of the term "CREATIONS" within the ellipse stands out in such mark, where such term appears to be of equal importance with the term "[d]e Marco", which appears in a scripted font. However, Appellant's mark is for the block letters "PAOLO DE MARCO", combined with its fanciful design. Due to the block lettering, the presence of the first word "PAOLO", as well as Appellant's design, Appellant's mark has an entirely different appearance to consumers. Due to these differences, as well as the additional term "CREATIONS" in Registrant's mark, the consuming public will be left with a different commercial impression of these marks. In the same manner, the sound and connotation of the respective marks is substantially different, and consumers are

not likely to believe that goods bearing these marks emanate from a common source of origin. In view of this fact, and because conflicting composite marks should be taken as a whole rather than broken into component parts, Registrant's mark has a very different overall impression upon prospective buyers than does Appellant's mark.

Furthermore, although third-party registrations are not evidence that the marks which are the subjects thereof are in use and that consumers have learned to distinguish such marks on the basis of the differences therein,⁴ applicant asserts in his reply brief that:

Because there are substantial trademark registrations on the Principal Register ... which contain the term "MARCO" for wearing apparel items, which have been previously cited in the record (i.e., U.S. Registration No. 1,648,889 for the mark MONDO DI MARCO, U.S. Registration No. 2,075,382 for the mark SALVATORE I MARCO and U.S. Registration No. 771,924 for the mark MARCO DI ROMA), the existence of such third-party registrations in [sic] indicative of Registrant's non-exclusive right to use the term "MARCO" for wearing apparel. Given the substantial differences between Registrant's and Appellant's mark[s], including the presence of Appellant's "PAOLO" in its [sic] mark and the fanciful fleur-de-lis design, Appellant maintains that there can be no likelihood of confusion between these respective marks.

While applicant is correct that the respective marks must be compared in their entirety, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in

⁴ See, e.g., *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

Here, not only is the disclaimed term "CREATIONS" in registrant's "DE MARCO CREATIONS" and design mark merely descriptive of its goods, and thus the dominant and principal source-indicative element of such mark is the fanciful term "DE MARCO," but as the Examining Attorney points out in his brief, "the disclaimed 'CREATIONS' term appears below the 'DE MARCO' term and in a smaller font," such that "[t]he larger font 'DE MARCO' term clearly dominates the mark." As the Examining Attorney also persuasively notes, "none of the third-party registrations include the 'DE MARCO' term of the registered mark" as does applicant's "PAOLO DE MARCO" and design mark. Additionally, we observe that overall it is the literal portions of applicant's mark, rather than the subordinate design feature, which, like registrant's mark, would be regarded by customers and prospective purchasers as the principal source-signifying portions of the particular marks since it is the literal elements thereof which typically would be utilized when such consumers ask about or call for the associated goods. See, e.g., In re Appetito Provisions Co., Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

In consequence thereof, and while differences admittedly exist between the respective marks when viewed on the basis of a side-by-side comparison,⁵ we agree with the Examining Attorney that, when considered in their entirety, applicant's "PAOLO DE MARCO" and design mark is substantially similar in sound, appearance, connotation and commercial impression to registrant's "DE MARCO CREATIONS" and design mark. Moreover, even if consumers were to notice the differences in the respective marks, it is still the case that, in light of the substantial overall similarities therein, customers could readily believe for example that, due to the shared fanciful term "DE MARCO," the leather shoes offered by applicant under his "PAOLO DE MARCO" and design mark represent a new or expanded line of wearing apparel from the same source or sponsor as the producer of the men's and boys' neckties and hosiery marketed by registrant under its "DE MARCO CREATIONS" and design mark.

Finally, applicant makes much of the assertion in his initial brief that "there is no evidence of any actual instances of confusion, despite nearly five years of concurrent use of Appellant's mark and Registrant's mark," and that such is

⁵ Such a comparison, however, is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); and *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

therefore "probative that there exists no likelihood of confusion between the respective marks." The Examining Attorney, in his brief, accurately points out, however, that "[i]n this instance no such evidence exists." Specifically, there is no affidavit or declaration from applicant or anyone else associated with applicant who has first-hand knowledge of applicant's sales and advertising of his goods under his mark, nor does the record reflect what registrant's experience has been. Absent evidence demonstrating appreciable and continuous use of his mark for a significant period of time in the same markets as those actively served by registrant, the length of time during and conditions under when there has been contemporaneous use of the respective marks without any reported incidents of actual confusion is simply not a meaningful factor. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992).

We accordingly conclude that purchasers and prospective customers, familiar with registrant's "DE MARCO CREATIONS" and design mark for men's and boys' neckties and hosiery, could reasonably assume, upon encountering applicant's substantially similar "PAOLO DE MARCO" and design mark for leather apparel, namely shoes, that such closely related items of wearing apparel emanate from, or are sponsored by or affiliated with, the same source.

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

T. J. Quinn

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board