

Oral Hearing:
April 11, 2000

**THIS DISPOSITION
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Paper No. 28
CEW

9/20/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

FALC S.p.A.

v.

H. H. Brown Shoe Company, Inc.

Opposition No. 107,431
to Application No. 75/265,213
filed on March 27, 1997

Robert J. Patch and Eric Jensen of Young & Thompson for
opposer.

Timothy A. French and Cynthia E. Johnson of Fish &
Richardson for applicant.

Before Quinn, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

FALC S.p.A. filed its opposition to the application of
H. H. Brown Shoe Company, Inc. to register the stylized
mark NATUR, shown below, for "footwear" in International
Class 25.¹

¹ Application Serial No. 75/265,213, filed March 27, 1997, based upon an
allegation of a bona fide intention to use the mark in commerce in
connection with the identified goods.



As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered stylized mark NATURINO, shown below, for "clothing, namely, trousers, pants, dungarees, sports-jackets, polo-neck sweaters, T-shirts, shirts, blouses, socks, hats and gym-suits; footwear, namely, shoes, boots and slippers"² as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

² Registration No. 2,117,472, issued December 2, 1997, in International Class 25, from application Serial No. 75/111,067, filed May 28, 1996, alleging ownership of a subsisting registration in Italy. The notice of opposition pleads ownership of the then-pending application, which matured to registration during the pendency of this opposition. We deem the notice of opposition amended to assert Registration No. 2,117,472, a certified status and title copy of which is of record.



Applicant, in its answer, denied the salient allegations of the claim.

The Record

The record consists of the pleadings; the file of the involved application; a certified status and title copy of Registration No. 2,117,472; certified status and title copies of registrations owned by third parties,³ made of record by applicant's notice of reliance; the testimony deposition by applicant of Thomas Eldon McClaskie, president of H. H. Brown International & Born, with accompanying exhibits; and the testimony deposition upon written questions by opposer of Maurizio Carradori, opposer's administrative manager, with accompanying

³ There is no specific evidence in the record establishing the nature of the relationship between applicant, H. H. Brown International & Born, the company for whom Mr. McClaskie is president, and The Brown Group, Inc., owner of the NATURALIZER and NATURE SOLE registrations made of record by applicant. We conclude, however, from Mr. McClaskie's testimony that the companies are related in some manner.

exhibits. Both parties filed briefs on the case and an oral hearing was held.

The Parties

Mr. Carradori testified that opposer manufactures footwear that has been sold in the United States since 1994; that less than 1.5% of its footwear sales in the United States have been of shoes for children up to eleven years old⁴; and that "INO" is a suffix in the Italian language that means "small."⁵

Mr. McClaskie testified that applicant and its related companies manufacture shoes sold under various brands, including NATURALIZER, NATURALSPORT and VIA NATURE. Mr. McClaskie stated that its NATUR shoes were first shown at a trade show in New York in December 1997; and that applicant planned "a full roll out" of the NATUR brand shoe in the summer of 1999. Mr. McClaskie stated that the sun and moon design element of applicant's mark, appearing over the "U" are intended to indicate a German umlaut, and that NATUR is

⁴ Opposer asserts in its brief that the vast majority of its footwear is for children up to eleven years old. However, the evidence of record, namely, Mr. Carradori's testimony, establishes exactly the opposite. Opposer's exhibits to Mr. Carradori's testimony include six invoices written in English for children's shoes. The remaining exhibits are all in the Italian language and are of no probative value.

⁵ Opposer supports Mr. Carradori's stated definition of "INO" with an excerpt from an Italian dictionary; however, no English translation of the excerpt has been made of record. Therefore, the excerpt is of no probative value.

"German nomenclature for 'natural.'"⁶ Mr. McClaskie stated that he attends numerous trade shows each year on behalf of applicant, and that he is not familiar with opposer or its NATURINO shoes.

Analysis

Inasmuch as a certified copy of opposer's registration is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Key considerations in this case are the similarities between the marks, the similarities between the goods, the channels of trade, and the class of purchasers. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

⁶ This statement regarding the German meaning of the word NATUR is entitled to little probative value, as applicant has neither established the extent of Mr. McClaskie's knowledge of the German language nor made of record an excerpt from a German/English dictionary.

Considering, first, the goods, it is clear that while opposer's footwear is limited to shoes, boots, and slippers, applicant's broadly identified footwear encompasses opposer's specified footwear. Thus, these goods are legally identical.

Although opposer and applicant trade arguments about whether opposer's shoes are primarily children's shoes, or whether one party's shoes are superior in quality, we note that the identifications of goods contain no such limitations. "The question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be." *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Both parties' goods are broadly worded and must be presumed to include the

identified footwear for all ages and in all styles and qualities.⁷

Moreover, neither opposer's nor applicant's identification of goods contains any limitations as to channels of trade or classes of purchasers. We must presume that the goods of applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo, supra*. In other words, we conclude that the channels of trade and class of purchasers of the parties' goods are the same.

Turning to the marks, we note that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Opposer contends that applicant's mark is identical to the first two syllables of opposer's mark, and that it is this portion of both marks that is likely to be impressed upon the purchaser and remembered. Opposer contends, further, that the "INO" suffix of opposer's mark means

⁷ In view of the identity of the parties' footwear, it is not necessary to consider what relationship, if any, opposer's identified clothing products may have to applicant's goods.

"small" and, thus, purchasers will believe that opposer's mark identifies small versions of the NATUR shoes, or children's shoes. Opposer argues that both marks have a European appearance and sound.

Applicant contends that the parties' marks are substantially different in appearance, sound, connotation and commercial impression, placing emphasis on the design elements and the differences in the word portions. Applicant argues that both NATUR and NATURINO "suggest or connote the shoes are 'Natural' or have comfortable properties akin to those found in 'Nature'"; and that there are "a myriad of other marks for footwear incorporating the term 'Natur-.'" Of the third-party registrations submitted by applicant, two registrations for the marks, respectively, NATURALIZER and NATURE SOLE for footwear are owned by applicant's purportedly related company, The Brown Group, Inc. Only five of the other third-party registrations are for footwear. These registrations are for the marks NATUREWALK, NATUREVELDT, NATURE-HIDE (stylized), NATURAL TREAD, and NATURE COLLECTION.

Considering the marks, while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a

conclusion on the issue of confusion, "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).

In this case, both opposer's and applicant's marks contain design elements that are quite minor relative to the word in each mark. Notwithstanding Mr. McClaskie's statements regarding the significance of the "waves" across the "A" and the "sun and moon" over the "U," these design elements are very small and serve principally as accent or decoration for the word NATUR. Similarly, the "tail" above the "A" in opposer's mark is quite small in comparison to the word NATURINO and the stylization of the lettering is minimal. We conclude that the word portions of both opposer's and applicant's marks are predominant. Such a conclusion is further warranted in this case because the word portion of a mark comprised of both a word and a design is normally accorded greater weight because it would be used by purchasers to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and

Kabushiki Kaisha Hattori Tokeiten v. Scutto, 228 USPQ 461, 462 (TTAB 1985).

Considering the word portion of opposer's mark, NATURINO, the evidence of record does not support the conclusion that "INO" would be understood by purchasers in the United States as meaning "small." Likewise, the evidence does not support the conclusion that applicant's mark, NATUR, would be understood by purchasers as the German word for "natural." Rather, we find it likely that purchasers would see both marks as variations of the American-English words "nature" or "natural." As such, we conclude that the two marks, considered in their entirety, are substantially similar in sound, appearance, connotation and commercial impression.

We are not convinced otherwise by applicant's argument that "nature" and "natural" are highly suggestive in connection with footwear. This contention is essentially conjecture that is not supported by the record. With respect to the five third-party registrations submitted in support of this contention, third-party registrations by themselves do not show that the marks are in actual use, much less that the actual use has been so extensive that consumers have become accustomed to distinguishing between various NATUR- marks. *See Smith Bros. Mfg. Co. v. Stone*

Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973)

["But in the absence of evidence showing the extent of use of any such marks . . . [the registrations] provide no basis for saying the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion."]. Further, these registrations for footwear are insufficient to establish that NATUR- has a particular significance for those in the footwear industry, or that the term has been adopted by those in the field to convey that significance. See *Mead John & Company v. Peter Eckes*, 197 USPQ 187 (TTAB 1977).

Moreover, even if we had concluded that NATUR- or NATURINO is suggestive in connection with footwear, suggestive marks are entitled to protection against likelihood of confusion.

In conclusion, in view of the substantial similarity in the commercial impressions of applicant's stylized mark, NATUR, and opposer's stylized mark, NATURINO, their contemporaneous use on the identical goods is likely to cause confusion as to the source or sponsorship of such goods. This is particularly true in view of the fact that, due to the consuming public's fallibility of memory, the emphasis is on the likely recollection of the average customer, who normally retains a general rather than a

specific impression of trademarks or service marks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353 (TTAB 1975).

It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The opposition is sustained.

T. J. Quinn

C. E. Walters

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial and Appeal Board