

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 4/6/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Elan U.S.A., Inc.**

Serial No. 75/218,284

Michael B. Chesal of Kluger, Peretz, Kaplan & Berlin, P.A.,
for Elan U.S.A., Inc.

Douglas M. Lee, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before **Cissel**, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 24, 1996, applicant applied to register
the mark shown below

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on the Principal Register for "warm-up suits, jogging suits, casual shirts and pants, running pants and shirts, t-shirts, jackets, beach ensembles comprising shorts, bathing suits and men's jackets, men's and women's bathing suits and leotards," in Class 25. The basis for the application was applicant's claim of use in connection with these goods since December 15, 1996.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, finding that applicant's mark so resembles the mark "ELAN," which is registered¹ for "fur clothing, namely coats," in Class 25, that confusion is likely. The Examining Attorney also required applicant to disclaim exclusive rights in "U.S.A." apart from the mark as shown.

Applicant responded by amending the application to disclaim "U.S.A.," and presented arguments on the issue of likelihood of confusion. Attached to applicant's response was a photocopy of an advertisement applicant had retrieved from an Internet site selling furs at "closeout" prices. The fur coats in the advertisement range in price from two to four thousand dollars. Applicant submitted this advertisement in support of its contention that fur coats

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are expensive items, as distinguished from applicant's goods, which are not.

The disclaimer was entered into the record, but the Examining Attorney was not persuaded to withdraw the refusal to register under Section 2(d) the Act. Copies of print-outs from Office records of pending applications and registrations were submitted showing that various businesses have sought registration of their trademarks for both fur coats and clothing items of a more casual nature. The casual clothing items listed included many of the items applicant listed in its application, e.g., leotards, swim suits, jogging suits, bathing suits, t-shirts and sweat shirts. Also submitted with the final refusal were excerpts from the articles retrieved from an automated database of publications. The Examining Attorney asserted that these articles show that not all fur coats are expensive, just as not all casual clothes are inexpensive.

Applicant then filed a notice of appeal, along with a request for reconsideration. Attached to the request for reconsideration was a catalog in which applicant's clothing is promoted. Also submitted with the request for

¹ Reg. No. 1,579,110, issued on the Principal Register to John Mirkopoulis, Inc. on Jan. 23, 1990; combined affidavit under Sections 8 and 15 received and accepted.

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reconsideration was a declaration by one of applicant's sales executives to the effect that the catalog shows the

type of clothing sold under the "ELAN U.S.A." mark, although the catalog does not show the mark sought to be registered, which includes the elliptical design element shown in the drawing submitted with the application. The declaration also specifies that applicant's clothing is "tropical, lightweight and inexpensive clothing targeted to customers in southern climates." The declarant further gives the prices for typical items in applicant's clothing line, and compares them to what he states that investigation revealed to be the prices of fur coats sold under the registered mark. The most expensive items on applicant's list apparently cost thirty-five dollars, whereas he states that registrant's fur coats sell for amounts ranging from fifteen hundred dollars to a hundred and twenty-five thousand dollars.

The Examining Attorney was not persuaded by applicant's evidence or arguments, and the final refusal to register was maintained. Action on the appeal was resumed by the Board. Applicant and the Examining Attorney both filed briefs, and applicant filed a reply brief, but no oral hearing before the board was requested.

Based on careful consideration of the written materials and arguments before us, we find that the refusal to register is well taken. Confusion is likely because the

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registered mark is the dominant portion of the mark applicant seeks to register, and the record before us establishes that the goods set forth in the application and registration, respectively, are related products.

When we are determining whether confusion is likely under Section 2(d) of the Lanham Act, we must analyze all of the probative facts in evidence that are relevant to the factors the court identified as bearing on the likelihood of confusion issue in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563(CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24,(CCPA 1976).

Turning first to the marks, we note that applicant's mark creates a commercial impression which is very similar to the commercial impression created by the cited registered mark. In applicant's mark, the disclaimed letters "U.S.A." and the relatively simple design elements have little, if any, source-identifying significance. Plainly, the dominant portion of applicant's mark is the word "ELAN," which is prominently displayed in large lettering in the center of the mark. The same word, "ELAN," is the registered mark in its entirety.

That this dominant word appears in applicant's mark in a stylized script is not determinative of the issue in favor of applicant. We must interpret the registration to encompass registrant's use of the mark in any style and presentation, which could include the same depiction of it that applicant's mark shows. *Vornado, Inc. v. Breuer Electric Manufacturing Co.*, 390 F.2d 724,156 USPQ 340,(CCPA 1968).

Although we have considered these two marks in their entirety, it is well settled that there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. In re *National Data Corp.*, 753 F.3d 1056, 224 USPQ 749,(Fed. Cir. 1985). Because the dominant portion of applicant's mark is the registered mark in its entirety, these marks are quite similar.

Confusion is likely when these similar marks are used in connection with the related the goods specified in the application and registration, respectively. The third-party registration and application information made of record by the Examining Attorney shows that different businesses have sought registration of their trademarks in connection with both fur coats and casual clothing items of the type listed in this application. This evidence tends to show that these goods are related, i.e., it establishes

that consumers would have a basis upon which to assume that the use of similar trademarks on these goods indicates that a single source is responsible for them all. In re Albert Trostel & Sons Co., 29 USPQ2d 1783(TTAB 1993).

Applicant cites two decisions as the primary support for its argument that confusion is not likely. In Ex parte Maya de Mexico, 103 USPQ 158(Comm'r Pats. 1947), the Commissioner found that there was no likelihood of confusion between "Maya de Mexico," for women's tropical light-weight clothing, and "Maya" for women's fur coats, fur-trimmed coats, and cloth coats. This forty-six-year-old decision is only four paragraphs long, and does not specify how the record provided the basis upon which the Commissioner reached her conclusions. It does appear, however, that her finding that "Maya de Mexico" was a unitary term as applied to clothing was a significant factor. Further, she concluded that "manufacturers of fur coats, fur-trimmed coats and cloth coats do not in the usual course of business manufacture and sell tropical light-weight clothing..., and it is believed that women, who would be the customary purchasers of the involved items, are aware of this fact." Again, we are not provided with the evidentiary basis for these conclusions of fact.

In the case at hand, we have evidence establishing that makers of fur coats also sell casual clothing of the types specified in this application. As noted above, the application and registration information made of record by the Examining Attorney shows that consumers have a basis upon which to expect these items to emanate from a common source.

The second decision cited by applicant in support of its position is also an older case, *The Crown Overall Manufacturing Co. v. People's Outfitting Co.*, 73 USPQ 187(Comm'r Pats. 1947). In that case, which was not even resolved under the Lanham Act, the Commissioner affirmed the decision of the Examiner of Interferences dismissing the opposition to registration of the graphic representation of a crown and the words "Crown Jewel" in an oval for "women's fur coats, women's fur jackets, women's fur hats, and women's fur scarfs," brought by the owner the mark combining the word "Crown" with the representation of a crown, and the word mark "Crown Adjust-Alls," for "overalls, union-suit working garments for boys, young men, and men." The decision was based in part on the Commissioner's conclusion that the goods of the parties did not have "the same descriptive properties," as well as on the fact that the marks differed considerably in meaning as

well as in appearance and sound. As with the Maya de Mexico case, supra., the relatedness of the goods in question was not the sole basis for the decision. No basis was apparently provided for the conclusion that the goods would not be expected to come from a single entity.

In the case now before us, however, the third-party registration and application information made of record by the Examining Attorney establishes that consumers have a reason to expect that the use of similar marks on the goods at issue indicates a common source for all such products. In view of this, and in light of the fact that the dominant portion of applicant's mark is the registered mark in its entirety, confusion is likely.

Moreover, even if we had doubts on this issue, such doubts would necessarily be resolved in favor of the owner of the prior registration, and against applicant, who had a duty to avoid selecting a mark which even approaches the registered mark. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191(TTAB 1979).

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Accordingly, the refusal to register under Section 2(d) of the Act is affirmed.

R. F. Cissel

C. E. Walters

T.E. Holtzman
Administrative Trademark Judges
Trademark Trial & Appeal Board

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