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Paper No. 14
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Calzeus - Calcados, LDA.

Serial No. 75/342,379

Kaushal R. Odedra of Wenderoth, Lind & Ponack for applicant.

Kathryn Waters-Perez, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Hanak, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Calzeus - Calcados, LDA. has filed a trademark
application to register the mark shown below for "footwear,
namely, leather shoes, leather boots and leather sandals."¹



¹ Serial No. 75/342,379, in International Class 25, filed August 18, 1997, based on use in commerce, alleging first use as of May 1995 and first use in commerce regulable by Congress as of April 1997.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for various articles of clothing,² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.



Applicant has appealed. Both applicant and the Examining Attorney have filed briefs,³ but an oral hearing was not requested. We affirm the refusal to register.

² Registration No. 1,997,417, issued August 27, 1996, to Sophir International Co., Ltd., in International Class 25. The goods are identified as "articles of clothing and knitted articles of clothing, namely, underwear, undershirts, panties, lingerie, negligees, chemises, foundation garments, brassieres, corsets, corselets, girdles, garter belts, jerseys, sweaters, jumpers, cardigans, and sleepwear."

³ Applicant submitted with its brief evidence regarding its sales; an article about its success; and a photocopy of a British registration. However, the record must be complete prior to appeal. Trademark Rule 2.142(d). In this case, applicant filed a request for reconsideration with its notice of appeal, but did not include this evidence at that stage, as would have been appropriate; and the Examining Attorney has objected to the evidence as untimely. Because there is no question that the evidence is untimely, we have not considered it. Even if we had determined that this evidence was properly of record, it is of no persuasive value. Registrability in Great Britain is of no relevance to registrability in the U.S. Similarly, applicant's reputation, sales and use are of little consequence except to the extent that this information

Our determination under Section 2(d) is 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. See, *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *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.

We turn, first, to the marks. The Examining Attorney contends that the dominant portion of each mark is the word SWEAR; that the differences in the design elements of the two marks are insufficient to distinguish the marks; and that the word SWEAR is arbitrary in connection with each party's goods.

Applicant contends that the marks are dissimilar because the design elements of each mark are integral to the commercial impressions of the marks. Applicant argues that the registered mark "contain[s] fanciful feminine styling

pertains to use in the U.S. and helps us understand the nature of the goods as identified and normal channels of trade for such goods.

appropriate for female underwear/sleepwear/casual wear ... [and] a script letter S in a dark oval background immediately followed by the word SWEAR also in similarly feminine script lettering to give an elegant overall impression"; and that applicant's mark "is presented in an aggressive razor edged lettering with a sharp arrow bisecting the mark from top to bottom in a clockwise arched motion thus giving a youthful/hip/urban impression." Applicant further argues that the third-party registration⁴ submitted by applicant comprises a "crowded field" of SWEAR marks.

We find that applicant's mark and the registered mark, when viewed in their entireties, are substantially similar, if not the same, in terms of sound and connotation, and similar in terms of appearance and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the

⁴ Registration No. 2,274,822 for the mark "YOU'LL LOVE IT. WE SWEAR." for, inter alia, T-shirts and hats. Applicant also submitted a copy of a pending application (Serial No. 75/641,043 for the mark THE PINKY SWEAR CLUB for various clothing items). This application was abandoned and is now the subject of a petition to revive. Regardless of whether it remains abandoned or is revived, it is of no value in evaluating what marks are coexisting on the Register.

average purchaser, who normally retains a general rather than a specific impression of trademarks. *See, Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

While both marks contain design elements, we find that the word portion of each mark is predominant and, thus, the marks are similar in appearance. The word portion of a mark comprised of both a word and a design is normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and 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). In registrant's mark, the principal design element is the "S" in an oval, which emphasizes the initial letter of the word portion of the mark - SWEAR. In applicant's mark, the principle design element is the curved arrow dissecting the mark, which, although arbitrary, we find to be of lesser significance than the word SWEAR for

the reasons noted above. The style of print in which SWEAR appears in each mark is relatively simple and does not contribute significantly to the overall commercial impression of either mark.

We find applicant's discussion of the significance of the design features of each mark to be pure conjecture. Similarly, we do not find a "crowded field of swear marks." Certainly one other registration containing the word "swear" does not render it a weak term in connection with clothing and footwear. Further, the third-party registered mark "YOU'LL LOVE IT. WE SWEAR." creates an entirely different commercial impression than either of the marks involved in this case.

Clearly the identical word SWEAR in each mark is subject to the same pronunciation and connotation - the stylization of the words does not alter these factors. We find the overall commercial impressions of the two marks to be substantially similar.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods recited in the registration, rather than what the evidence shows the goods actually are. *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). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The Examining Attorney contends that applicant's identified goods are within the natural field of expansion for registrant; and that, based on third-party registrations in the record, consumers are accustomed to seeing items of clothing of the type listed in the registration and footwear identified by the same marks and coming from the same source. Applicant argues that this evidence does not establish that the goods are "similar," and that the six registrations submitted by the Examining Attorney are

insufficient to establish that the goods are within registrant's "natural field of expansion."

We find that we need not address what goods are "within registrant's natural field of expansion." Rather, we are convinced by the third-party registrations made of record by applicant that consumers are accustomed to seeing various clothing items, including items the same as registrant's, and leather footwear from the same source and identified by the same trademarks. Thus, we find that applicant's and registrant's goods are sufficiently related that, if identified by confusingly similar marks, confusion as to source or sponsorship is likely.

Finally, with regard to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant, we note that, while a factor to be considered, the absence or presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-1471 (TTAB 1992).

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Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on the goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

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