

8/9/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:
June 21, 2001

Paper No. 15
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Calzaturificio Ennesport and Style S.N.C., a
partnership of Nevio Spadetto and Ornella Pellizzon

Serial No. 75/571,988

Martin P. Hoffman of Hoffman, Wasson & Gitler, PC for
Calzaturificio Ennesport and Style S.N.C. Di Spadetto Nevio
E Pellizzon Ornella.

Jacqueline A. Lavine, Trademark Examining Attorney, Law
Office 109 (Ronald Sussman, Managing Attorney).

Before **Cissel**, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On December 16, 1998, applicant, a general partnership
under the laws of Italy, filed the above-identified
application to register the mark "HBS" on the Principal
Register for "sporting shoes, namely, snowboard boots," in
International Class 25. The application was based on
applicant's assertion that it possessed a bona fide

intention to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that if applicant were to use its mark in connection with snowboard boots, the mark would so resemble the mark shown below,

which is registered¹ for "clothing, namely-ladies (sic) suits and dresses," in International Class 25, that confusion would be likely. She based this conclusion on her finding that the marks "are virtually identical and the goods are related."

Applicant responded to the refusal to register with argument that confusion would not be likely in view of the fact that snowboard boots are expensive items of athletic footwear, sold to sophisticated purchasers in ski shops and high-end sporting goods shops, whereas ladies' suits and

¹ Reg. No. 1,515,404, issued on the Principal Register to E. H. Woods Fashions Inc. on December 6, 1988. Combined affidavit under Sections 8 and 15 of the Act accepted and acknowledged.

dresses are ordinary clothing items, not expensive sporting goods. Applicant further argued that ladies' dresses and suits are not sold through the same channels of trade as snowboard boots are.

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register was made final in her second Office Action. Submitted in support of the refusal to register were copies of thirteen third-party registrations and applications for registration. The Examining Attorney contended that these registrations and applications show "that applicant's (sic) and registrant's (sic) sell ladies (sic) dresses and suits and other clothing and snowboard boots all under the same trademark[s]."

Applicant responded with further argument that confusion would not be likely. Submitted with this response were copies of clippings from Transworld Snowboarding Business magazine and pages from applicant's web site on the Internet. The magazine article notes that the average price paid by a consumer for snowboard boots in 1999 was \$157.00, that snowboard boots are sold in specialty stores and in conjunction with bindings, snowboards, parkas and pants, and that snowboarding equipment may be sold in concert with skis and other

related winter outdoor sports equipment. The pages from applicant's web site demonstrate that substantial distinctions can be drawn between snowboard boots and ladies' dresses and suits.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed appeal briefs², and both presented their arguments at the above-referenced oral hearing.

The sole issue before the Board in this appeal is whether applicant's mark, if used in connection with snowboard boots, would be likely to cause confusion with the cited registered mark for ladies' suits and dresses. Based on careful consideration of the record in this application, the arguments made by applicant and the Examining Attorney, and the relevant legal precedent with regard to likelihood of confusion, we hold that the Examining Attorney has not met her burden of proof in establishing a proper basis for refusing registration.

In the case of *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to

² In her brief, the Examining Attorney objects to applicant's submission with its brief of "some new evidence regarding its goods and the marketing of said goods," but the attachments to applicant's brief all appear to have been previously made of record with applicant's timely response to the second Office Action. The objection is therefore not well taken.

our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods or services as set forth in the application and cited registration, respectively. The Examining Attorney has the burden of proof to establish that the refusal to register is justified. In re 3Com Corp., 56 USPQ2d 1060 (TTAB 2000).

In the instant case, notwithstanding applicant's contention to the contrary, the marks are in fact quite similar. The dominant portion of the registered mark is the same as the mark applicant seeks to register, "HBS." Neither the minor stylization of the lettering nor the presence of the abbreviation "LTD." in the registered mark significantly alters the commercial impression of that mark. Because the commercial impressions created by applicant's mark and the registered mark are substantially the same, if these two marks were used on similar or commercially related goods, confusion would plainly be likely.

The record in this application does not establish that confusion is likely, however, because it does not show that a viable relationship exists between ladies' dresses and

suits, on the one hand, and snowboard boots, on the other, such that the use of the same or similar marks on both types of goods would lead to the mistaken belief that they come from the same source. As noted above, it was the burden of the Examining Attorney to establish this, but the record falls short of doing so.

The evidence made of record by applicant shows that snowboard boots are expensive goods sold as sporting goods in specialty ski shops and sporting goods stores. The only evidence proffered by the Examining Attorney in support of her contention that snowboard boots are related to ladies' dresses and suits is the thirteen third-party registrations and applications referred to above.

In *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1983), citing *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988), the Board stated that although third-party registrations are not evidence that the marks shown therein are in commercial use or that the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.

One problem with the evidence submitted by the Examining Attorney in the instant case, however, is that much of it relates to applications, rather than to registrations. Moreover, the actual third-party registrations the Examining Attorney refers to either do not list both the goods set forth in the application and those specified in the cited registration or they are not registrations based on use. Several list "snowboard boots" and "clothing" or "women's clothing," but the clothing is then specified with a list of the specific items, such as "gloves," "winter hats" or "ear muffs," without mention of ladies' dresses or suits. These registrations hardly establish that other entities have registered their marks for both ladies' dresses and suits and snowboard boots. Furthermore, neither an application based on the assertion of an intention to use a mark nor a registration issued under Section 44 of the Act based on a registration in a foreign country satisfies the use requirement in the rule set forth in the Trostel case, supra.

In short, none of the evidence submitted by the Examining Attorney shows a use-based registration listing both the goods for which applicant seeks to register its mark and the specific goods set forth in the cited registration. Especially in view of the materials

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submitted by applicant, which show these goods to be intrinsically different and that applicant's goods are sold through different trade channels from those in which ordinary clothing items like those listed in the registration are sold, we have no basis upon which to reach the conclusion asserted by the Examining Attorney, that the use of these similar marks on these products would be likely cause confusion as to source.

DECISION: The refusal to register under Section 2(d) of the Act is reversed.

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