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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Circa Footwear

Serial No. 75/682,656

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LLP for Circa Footwear.

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110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Chapman, and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Circa Footwear (a California corporation) filed on
April 14, 1999 an application to register the mark
CIRCAFOOTWEAR for "clothing, headwear and footwear," based
on applicant's assertion of a bona fide intention to use
the mark in commerce. Applicant later amended the
identification of goods to "athletic footwear"; and filed
an amendment to allege use, accepted by the Examining

Attorney, asserting a date of first use and first use in commerce of April 1999.

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark shown below



for "belts,"¹ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was requested and scheduled, but applicant then withdrew its request for an oral hearing.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court 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

¹ Registration No. 1,202,134, issued July 20, 1982, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Turning to a consideration of the respective goods, it is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978).

In support of the refusal to register, the Examining Attorney has made of record copies of pages from several catalogs (e.g., Cabela's, Patagonia, and the Jack Nicklaus Collection), and copies of several Internet web sites (e.g., Fogdog Sports, REI, and Foot Locker) showing that the same entity sells both athletic footwear and belts. In addition, the Examining Attorney submitted over forty third-party registrations which issued on the basis of use

in commerce, to demonstrate the close relationship between athletic footwear and belts, by showing that a single entity has registered a single mark for goods including both footwear and belts.

Third-party registrations are not evidence of commercial use of the marks shown therein, 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 have some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

The Examining Attorney also submitted several representative excerpted articles retrieved from the Nexis database to show that athletic footwear is commonly worn as casual footwear, and not just for athletic or sports events, and belts are a normal accessory for casual wear.

We agree with applicant that there is no per se rule that goods in the same general field and bearing the same or similar mark must invariably result in a likelihood of confusion. Rather, cases must be determined individually on their own facts and circumstances. See *In re The Shoe*

Works Inc., 6 USPQ2d 1890 (TTAB 1988). However, the facts and circumstances in the Shoe Works case, supra, included a specific restriction to that applicant's trade channels in the identification of goods ("sold solely through applicant's retail shoe store outlets"); a consent agreement between that applicant and cited registrant; and an affidavit from one of that applicant's officers reiterating the absence of knowledge of any instances of actual confusion by applicant and registrant. These facts and circumstances are not present in the application now before this Board.

Based on the record before us, we readily conclude that applicant's goods, "athletic footwear," are commercially related to the cited registrant's goods, "belts." See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) (Court affirmed Board holding of likelihood of confusion between KangaROOS and a kangaroo design for clothing, namely, athletic shoes, sweatsuits and athletic shirts and KANGOL and a kangaroo design for golf shirts having collars); General Shoe Corporation v. Hollywood-Maxwell Co., 277 F.2d 169, 125 USPQ 442 (CCPA 1960) (Court affirmed Board holding of likelihood of confusion for the same mark INGENUE used on shoes and hosiery, and brassieres); In re Melville Corp.,

18 USPQ2d 1386 (TTAB 1991) (ESSENTIALS in stylized form for women's shoes against ESSENTIALS for women's clothing, namely, pants, blouses, shorts, and jackets); In re Apparel Ventures, Inc., 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS in stylized form for women's separates, namely blouses, skirts and sweaters against SPARKS in stylized form for shoes, boots and slippers); In re Pix of America, Inc., 225 USPQ 691 (TTAB 1985)(NEWPORTS for women's shoes against NEWPORT for outer shirts); In re Alfred Dunhill Limited, 224 USPQ 501 (TTAB 1984)(DUNHILL in stylized lettering for various items of men's clothing including belts against DUNHILL for shoes); and In re Kangaroos U.S.A., 223 USPQ 1025 (TTAB 1984) (BOOMERANG for athletic shoes against BOOMERANG and design for men's shirts).

Regarding the respective trade channels and purchasers, applicant's argument that its goods are sold to "athletic or sports type stores, such as surf shops" (brief, p. 9); and its speculation that registrant's goods are sold in different trade channels is irrelevant because the goods are identified with no restrictions as to trade channels or purchasers in either the application or the registration. The Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration. See

Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, the Board must consider that the parties' respective goods could be offered and sold to the same class of purchasers through all normal channels of trade. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994).

Turning next to a consideration of the respective marks, the cited registrant's mark consists of the word CIRCA in stylized lettering, while applicant's mark is CIRCAFOOTWEAR in typed form. It is generally accepted that when a composite mark incorporates the arbitrary mark of another for closely related goods or services, the addition of suggestive or descriptive words or other matter is insufficient to avoid a likelihood of confusion as to source. See The Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

Moreover, it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser. See Presto Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The

proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). In the current case before us, applicant's addition of the generic term "footwear" does not serve to distinguish applicant's mark from that of the registrant.

Applicant's argument that the marks are different due to the "highly stylized lettering" (brief, p. 5) of the registrant's mark is not persuasive. Because applicant seeks registration of its mark shown in plain typed form, applicant is not limited to the mark depicted in any special form and applicant could alter the presentation of the lettering of its mark CIRCAFOOTWEAR at any time. Thus, it is irrelevant that the registrant's mark appears in a particular stylized lettering. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 1307, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971).

In terms of connotation, the Examining Attorney submitted The American Heritage Dictionary (Third Edition 1992) definition of "circa" as "in approximately; about."

There is no evidence that the word "CIRCA" is anything other than arbitrary with respect to the involved goods. Thus, the word "CIRCA" in both applicant's and registrant's marks would connote the same idea. Applicant argued that "CIRCA" with regard to registrant's mark connotes the idea of "in approximately" relating to the variable length of belts, and the idea of "about" as belts go about a person's waist; while applicant's mark would be perceived by consumers as meaning "in approximately the time of footwear." While these interpretations may be remotely possible, there is no evidence regarding purchasers' and/or potential purchasers' understanding of either applicant's or registrant's marks. We do not agree that purchasers of these general consumer goods would go through a complicated thought process first to define the term "CIRCA" and then apply that definition in the two differing manners suggested by applicant. Further, we do not agree that the term "footwear," as used in applicant's mark, and considered in the context of applicant's goods, would add anything unique or different to consumers' perception of "CIRCA."

To the extent that purchasers notice the differences in the marks, they may believe that applicant's mark is a revised version of registrant's mark, now used on athletic

footwear. Thus, we find that the marks are substantially similar in sound, appearance, connotation and overall commercial impression.

Finally, applicant's argument regarding "third [-] party use and registration of similar marks on similar goods" (brief, p. 9) is unsupported. There is no evidence of use of any other mark including the word "CIRCA" on any type of wearing apparel.

Applicant did introduce one third-party registration (Registration No. 1,229,991, issued March 8, 1983, Section 8 affidavit accepted, Section 15 affidavit acknowledged) for the mark CIRCA NOW for "female apparel, namely, sweaters, T-shirts, jackets, and shirts," arguing that for the Examining Attorney to maintain this refusal when there exists another registration for a mark which includes the word CIRCA for wearing apparel is inconsistent on the part of the USPTO.

The USPTO strives for consistency of examination, but as often noted by the Board, each case must be decided on its own merits. We are not privy to the record of this single third-party registration file, and moreover, the determination of registrability of that particular mark by a Trademark Examining Attorney cannot control the merits in

the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Suffice it to say that the several cases cited by applicant during the ex-parte prosecution and appeal of this case (including the case of *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984)) are all distinguishable from the facts of this case and do not require a different result herein.

Although we have no doubt in this case, any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the similarities of the marks; the close relationship of the goods; and the similarity of the trade channels, we find that there is a likelihood that the purchasing public would be confused when applicant uses CIRCAFOOTWEAR as a mark for athletic shoes.

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