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Paper No. 20

HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dr. Ing. h.c. F. Porsche AG

Serial No. 75/826,886

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for Dr. Ing. h.c. F. Porsche AG.

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109 (Ronald Sussman, Managing Attorney).

Before Wendel, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Dr. Ing. h.c. F. Porsche AG has filed an application
to register the mark CAYENNE for "clothing, namely,
anoraks, beachwear, belts, blazers, blouses, blousons, body
suits, cardigans, coats, dresses, footwear, foul weather
gear, gloves, headwear, infantwear, jackets, jeans, jogging
suits, leather coats, leather jackets, overalls, pants,
parkas, polo shirts, scarves, shirts, shorts, ski wear,

Ser No. 75/826,886

skirts, slacks, sleepwear, snow suits, socks, suits, sun visors, sweat bands, sweatshirts, sweaters, T-shirts, tennis wear, neckties, tights, tops, tracksuits, trousers, underwear, vests and wrist bands."¹

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark CAYENNE, in the stylized format shown below, which is registered for "ladies', men's and children's leather and suede clothing, namely, coats, jackets, dresses, skirts, pants, vest, belts, shawls and sweaters; and ladies', men's and children's cotton, wool, acrylic and man-made fiber sweaters."²

¹ Serial No. 75/826,886, filed October 19, 1999 under Section 44(e), claiming a right of priority under Section 44(d) based on a German application. The application as filed included 18 classes of goods and services but after two requests to divide, only the Class 25 goods remain in the original application and only these goods are involved in this appeal. Upon review of the German registration which has been submitted to perfect applicant's filing under Section 44(e), we note that there appears to be a discrepancy in that German Registration No. 399 30 713 does not correspond to application Serial No. 399 35 813.7/12. In the event this application goes forward after appeal, this discrepancy should be further investigated.

² Registration No. 1,573,488, issued December 26, 1989, first renewal.

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*³ factors that are relevant in view of the evidence of record. Two key considerations in any *du Pont* analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective goods, we find that both applicant's and registrant's goods include items which are identical as identified, namely, leather coats, leather jackets and sweaters, and that other items of applicant's could be also be made of leather so as to be the same as registrant's, such as dresses, pants, belts and the like. There is a definite overlap in the clothing items of applicant and registrant, with the remaining items of applicant falling within the category of being related

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

wearing apparel. For purposes of our analysis, we consider the goods in part identical and otherwise closely related.

Furthermore, in the absence of any limitations in the identification of goods in either the application or the registration, we must assume that that the goods of both applicant and registrant would travel in the same channels of trade and be available to the same class of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we assume that these clothing items would be available in the same retail outlets to the same purchasers for purchase on the same shopping trips. While applicant argues that certain of its goods would not be likely to be sold in close proximity to, or even in the same locations as, registrant's goods, there are many items which are identical and which could be sold not only in the same type of retail stores, but also in the same departments.

Turning to the respective marks, we find the CAYENNE marks of applicant and registrant to be identical in appearance, sound and connotation. Although registrant's mark is presented in a stylized cursive format, applicant is seeking to register its mark in typed form and thus is free to use the mark in any form it chooses, including one very similar to that of registrant's. See *Squirto Co. v.*

Tomy Corp., 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). In fact, from the materials submitted by applicant, it is apparent that applicant intends to use its mark in a similar cursive style.

Applicant's major contention is that the overall commercial impressions created by the marks are different, in view of the manner on which the marks will be used in the marketplace. Applicant argues that while registrant's mark will be viewed as a primary source identifier, applicant's mark will impact consumers as a secondary source identifier when applied to apparel. Applicant explains that it is a manufacturer of fine automobiles and sports cars; that the mark CAYENNE will be used in connection with its new sport utility vehicle which will be introduced in 2003; and that its mark as it will appear on clothing will be in a decorative or ornamental fashion. Thus, applicant argues its mark, as encountered by consumers in the marketplace, will identify applicant as the secondary source for the goods.

It is well settled that matter which serves as part of the aesthetic ornamentation of goods, such as clothing items, may be registered as a trademark for such goods, if it also serves a source-indicating function. See *In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993); *In re Dimitri's*

Inc., 9 USPQ2d 1666 (TTAB 1988). Ornamental matter may additionally serve as an indication of source, if, for example, it names the secondary source of the goods or if, it is already a recognized trademark of applicant for other goods or services. See *in re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982); *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973).

The basic flaw in applicant's argument is that there is no restriction in the identification of goods in its application as to any particular manner of use of its mark. The question of likelihood of confusion must be determined on the basis of the goods as identified in the application, rather than on the basis of evidence of actual or intended use. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Even if we had evidence of use of applicant's CAYENNE mark in an ornamental or decorative manner, which we do not, it would be immaterial. The application simply seeks registration of CAYENNE as a trademark for various clothing items. Registrability is determined on the basis of the description in the application and restrictions on how the mark is intended to be used will not be inferred. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

Nor is there any indication in the mark itself of any secondary source of the goods. This is not a case similar to Michael Caruso & Co. v. Estefan Enterprises, Inc., 994 F. Supp 1454 (S. D. Fla. 1998) wherein the marks involved were BONGO for clothing and BONGOS CUBAN CAFE for souvenir merchandise sold by a restaurant. There is an obvious difference between the use of BONGO alone on clothing and the use of BONGOS as part of an explicit reference to the restaurant bearing this name on similar items of merchandise. Here we have no reference to applicant in the mark itself, nor to the sports utility van which will originate from applicant. Moreover, at this point in time there is no reason for consumers to recognize the mark as one for a particular model of car originating from applicant and thus recognize applicant as the secondary source of the goods; the vehicle bearing the mark CAYENNE has not yet been introduced on the market. While applicant argues the fame of the PORSCHE mark and the various vehicles sold thereunder, this is totally irrelevant inasmuch as the house mark is not part of the mark before us.

Applicant's attempt to draw a parallel to the Board's decision in In re Sydel Lingerie Co, Inc., 197 USPQ 629 (TTAB 1977) as to the effect of manner of use of the marks

on the commercial impression is to no avail. There the determinative factor was the nature of the mark itself, namely BOTTOMS UP, and the different commercial impression which was projected as used on the respective goods, underwear and men's suits, coats and trousers. Here no such distinction can be drawn; the term CAYENNE as used on both applicant's and registrant's clothing items would conjure up the same connotation, i.e., a spiciness or similar reference to the cayenne pepper condiment. While it is true that the Board also made reference to the marketing environment in which the marks, as applied to the goods, would be encountered, the Board did not reach beyond the normal marketing arenas for the respective goods nor the usual manner of sale for the clothing items as identified in the application and registration. Here applicant is asking us to make a distinction in marketing environments, despite the fact that no such limitation or restriction in manner of sale is reflected in the application.

Finally, even if we were to assume that applicant's wearing apparel will only be sold as promotional items in connection with its new vehicle, a likelihood of confusion still exists with registrant's use of the same mark on its clothing items. See *In re Phillips-Van Heusen Corp.*, 228

USPQ 949 (TTAB 1986)(applicant's use of mark 21 CLUB for shirts likely to cause confusion with registrant's mark THE 21 CLUB for restaurant services and towels, in view of known practice of use of marks by restaurants for collateral items including clothing items). If applicant's claim of fame for its vehicles is taken into account, the confusion which might arise could well be that of reverse confusion as the CAYENNE sports utility vehicle becomes known in the market. As explained by the Court in *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1688, 1690 (Fed. Cir. 1987):

The trademark law not only protects the consumer from likelihood of confusion as to commercial sources and relationships, but also protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer.

The term "reverse confusion" has been used to describe the situation where a significantly larger or prominent newcomer "saturates the market" with a trademark confusingly similar to that of a smaller, senior registrant for related goods or services. ... The junior user does not seek to benefit from the goodwill of the senior user; however, the senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user. [Citations omitted].

Thus, even under the circumstances which applicant has outlined for the intended use of its mark, confusion remains likely.

Ser No. 75/826,886

Applicant has also pointed to the sophistication of the purchasers as a significant factor in the avoidance of confusion. While we would agree that the purchase of items such as leather coats may entail a certain amount of care and deliberation, even sophisticated customers are not immune to source confusion. This is especially true when the marks being used on the goods are substantially the same, as is the case here, and the goods are either identical or closely related. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Accordingly, in view of the virtual identity of the respective marks and the intended use by applicant of its mark on clothing items either identical or closely related to those of registrant, we find confusion likely.

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

Ser No. 75/826,886