

**THIS DISPOSITION IS NOT  
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OF THE TTAB**

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Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Spy Optic, Inc.

Serial No. 75/566,756

Kit M. Stetina of Stetina Brunda Garred & Brucker for Spy  
Optic, Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney).

Before Cissel, Bucher and Rogers, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Spy Optic, Inc., seeks registration on the Principal  
Register for the mark SPY for "wearing apparel, namely,  
shirts, T-shirts, shorts, pants, sweatshirts, sweatpants,  
hats, visors, shoes and belts," in International Class 25<sup>1</sup>.

The Trademark Examining Attorney issued a final refusal  
to register based upon Section 2(d) of the Trademark Act, 15

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<sup>1</sup> Application Serial Number 75/566,756 was filed on October 8,  
1998, based upon applicant's allegation of a *bona fide* intention to  
use the mark in commerce. While this application also contained a  
listing of jewelry items in International Class 14 at the time of  
filing, this class of goods was dropped during the course of  
prosecution in light of another cited registration.

U.S.C. §1052(d), on the ground that applicant's SPY mark, if used on its goods, so resembles the mark, FASHION SPY!, which is registered for "clothing, namely tops, skirts, shorts, skorts, pants, shirts, dresses, jumpers, jackets," as to be likely to cause confusion, or to cause mistake, or to deceive.<sup>2</sup>

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that the two marks are different as to sight, sound and connotation, and that these collective dissimilarities weigh against a finding of likelihood of confusion. Applicant also argues that its items of wearing apparel are different from those listed by registrant, as its goods are associated with extreme sporting events. As such, applicant contends that they move in different channels of trade. Furthermore, applicant argues that the allowance of registrant's FASHION SPY! mark for clothing over applicant's SPY mark for sunglasses shows that the United States Patent and Trademark Office has already made the determination that there is no likelihood of confusion between the word portions of the marks at issue herein.

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<sup>2</sup> Registration No. 1,981,264 issued on the Principal Register on June 18, 1996; Section 8 affidavit has been accepted.

By contrast, the Trademark Examining Attorney argues that confusion is likely when these respective marks, both having the arbitrary term SPY as their predominant element, are applied to the identified goods, which are in part identical.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). This case sets forth the factors, which if relevant evidence is of record, must be considered in determining likelihood of confusion. In any likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to an examination of the goods. As noted by the Trademark Examining Attorney, some of the clothing items identified in the application and registration are identical (e.g., shirts, shorts and pants). Applicant argues without proof that its goods are associated with "extreme sporting events such as surfing, dirt bike riding, snow boarding, motor-cross (sic), free-skiing, skating and the like." (Applicant's appeal brief, p. 14). Even if this were demonstrated to be the case, there is no such limitation in the identification of goods in the application. Hence, we must consider some of these listed goods to be legally

identical. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ["Indeed, the second du Pont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration"]. In addition, we find the other goods to be closely related. Moreover, based upon the identifications in the application and the cited registration, we must also presume that the goods of registrant and of applicant will move in the same channels of trade to the same classes of ordinary consumers. *Id.*

Turning then to the marks, as our principal reviewing court, the Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

As applied to clothing, the word "fashion" must be deemed to be at least highly suggestive. On the other hand, the word "spy" is an arbitrary designation for these items. Hence, in spite of the extra word in registrant's mark, the single strongest source indicator therein is the word SPY.

As to connotation, applicant argues as follows:

... Appellant's word mark "SPY" evokes the concept of evasiveness, cleverness, or a

variety of other similar qualities. This is consistent with the dictionary meaning of the term "spy" which relates to a person who acts secretly to obtain information...

In contrast with Appellant's mark, the word portion of Registrant's mark does not connote the concept of evasiveness, cleverness, or a variety of other similar qualities. Rather, Registrant's mark "FASHION SPY!" has a different connotation than that of Appellant's. More specifically, the term "FASHION" is highly effective in separating Registrant's mark from Appellant's mark as to the issue of connotation. Such lengthy term is present in Registrant's mark to provide a different connotation than that of Appellant's as it turns Registrant's mark to the concept of being fashion conscious or being more fashionable than others.

(Applicant's reply brief, pp. 3 - 4).

In spite of applicant's arguments to the contrary, we find a strong similarity in connotation inasmuch as both marks create imagery tied to the generally understood, dictionary meaning of the word "spy." Both FASHION SPY and SPY, as applied to items of clothing, connote clandestine activities, such as watching someone (or something) in secret.

Even as to sound and appearance, these two marks have strong similarities because they are both dominated by the word "SPY." It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark ... provided the ultimate

conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). A determination of likelihood of confusion is not made on a purely mechanical basis, counting the number of words, or even letters, that are the same or different. The proper test for determining the issue of likelihood of confusion is the similarity of the general commercial impression engendered by the marks - not specific differences one can identify when the marks are subjected to a side-by-side comparison. See Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972). Also, we must keep in mind the fallibility of human memory and the fact that the average consumer retains a general, rather than a specific, impression of trademarks encountered in the marketplace. In this context, we find that the word "fashion" at the beginning of registrant's mark and the exclamation point at its ending are insufficient to distinguish the two marks when they are applied to identical and closely related items of clothing.

Hence, we find that the two marks are quite similar as to connotation, sound and appearance, and that the differences identified by applicant are not sufficient to distinguish the two marks as to overall commercial impressions.

Furthermore, we note that the record is devoid of any evidence of third-party uses of other "SPY" marks for goods similar to the type of goods involved in this case.

As to applicant's argument that the United States Patent and Trademark Office has already made the determination that there is no likelihood of confusion between the word portions of the marks at issue herein, we disagree with this conclusion. Given the cumulative differences in the respective goods (sunglasses versus clothing), when combined with the various differences applicant points out in the respective marks, it would have been difficult to support a finding that likelihood of confusion exists with registrant's FASHION SPY! mark for clothing based solely upon applicant's SPY mark for sunglasses. Despite applicant's SPY mark for sunglasses, applicant does not have an unfettered right to expand use of its mark to these additional goods, and the intervening registration of registrant's mark must be considered in evaluating applicant's current application. In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994).

*Decision:* The refusal to register is affirmed.