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August 4, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re George R. Chaby, Inc.

Serial No. 76334833

Eric S. Marzluf of Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd. for George R. Chaby, Inc.

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Before Seeherman, Rogers, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 6, 2001, George R. Chaby, Inc. (applicant) applied to register the mark NEWPORT RAINGEAR (in typed form) on the Principal Register for goods ultimately identified as "umbrellas" in International Class 18 and "raingear, namely rain-resistant ponchos" in International Class 25.¹ Applicant disclaimed the word "Raingear."

¹ Serial No. 76334833. The application was based on applicant's assertion of a bona fide intention to use the mark in commerce.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of two registrations for the mark NEWPORT, both in typed form. The first registration is for "suitcases, valises, and travelling bags" in International Class 18.² The second registration is for "outer shirts" in International Class 25.³

After the examining attorney made the refusal final, this appeal followed.

When a mark has been refused registration under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences

² Registration No. 1,425,753, issued January 20, 1987. Affidavits under Section 8 and 15 accepted and acknowledged. The registrant is identified as Airway Industries, Inc.

³ Registration No. 639,730, issued January 8, 1957. USPTO records indicate that the registration was renewed for a period of ten years in 1997. The current owner is identified as Flag Sportswear, Inc.

in the marks.” Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we will address is the similarity of the applicant’s and registrants’ marks. Applicant’s mark is NEWPORT RAINGEAR while the cited registrations are for the same word, NEWPORT. All the marks are depicted in typed form and, therefore, the marks are identical except for applicant’s addition of the disclaimed term RAINGEAR. Inasmuch as applicant’s goods are identified as “*raingear*, namely rain-resistant ponchos,” the term raingear is highly descriptive, if not, generic for applicant’s goods.⁴ In a similar case, the Federal Circuit has held that the addition of the word “Swing” to registrant’s mark “Laser” did not result in the marks being dissimilar. “[B]ecause both marks begin with ‘laser,’ they have consequent similarities in appearance and pronunciation. Second, the term ‘swing’ is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.” Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted).

⁴ Applicant admits that the term “raingear” is at least descriptive of its goods. Applicant’s Brief at 7.

See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

Applicant's principal argument is that the term "Newport" is a very weak mark. As evidence of this alleged weakness, applicant has introduced numerous registrations including the term "Newport."⁵ Our principal reviewing court has explained that: "Much of the undisputed record evidence relates to third party registrations, which

⁵ Applicant points out that the Office has registered the marks NEWPORT OF CALIFORNIA and design (No. 1,155,674, issued May 26, 1981, cancelled), NEWPORT BEACH (No. 1,340,873, issued June 11, 1985, cancelled), CLUB NEWPORT (No. 1,355,488, issued August 20, 1985, cancelled), NEWPORT BLUE (stylized) (No. 1,452,234, issued August 11, 1987, cancelled), NEWPORT BEACH ATHLETIC CLUB (No. 1,476,925, issued February 16, 1988, "Newport Beach" disclaimed, cancelled), NEWPORT SURF & SPORT (No. 1,579,112, issued January 23, 1990, Section 2(f), cancelled), NEWPORT BAY (No. 1,727,728, issued October 27, 1992, active), NEWPORT NEWS (No. 1,892,686, issued May 2, 1995, active), NEWPORT POLO (No. 1,973,866, issued May 14, 1996, "Newport" disclaimed, cancelled), NEWPORT CASINO (No. 1,997,249, issued August 27, 1996, active), SALTY PAWS NEWPORT (No. 2,011,490, issued October 29, 1996, "Newport" disclaimed, active), NEWPORT REGATTA (No. 2,189,971, issued October 21, 1997, active), and NEWPORT AQUARIUM (No. 2,583,237, issued June 18, 2002, active) for various types of shirts. Applicant also notes a similar pattern regarding the Class 18 goods.

admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them"). While "third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987).

We start by noting, as applicant has also pointed out, that many of these registrations have been cancelled. "[A] canceled registration does not provide constructive notice of anything." Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989). The fact that various marks containing the term "Newport" with other non-generic terms have co-existed in the past does not support the registration of applicant's mark today. Inasmuch as our precedent is clear and

applicant has not introduced evidence of use of the term "Newport" by others,⁶ we cannot accept applicant's arguments that the mark in the cited registrations is weak.

Moreover, these third-party registrations do not show that the term "Newport" is descriptive or suggestive of any feature or characteristics of applicant's raingear or umbrellas.⁷

In this case, where the marks are NEWPORT and NEWPORT RAINGEAR, the addition of the descriptive/generic term RAINGEAR does not significantly change the commercial impression of the marks. Like the registered marks, we find that the dominant part of applicant's mark would also be NEWPORT. The additional word "raingear" would simply indicate the goods on which the mark is used. We also note that if "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." In re Denisi, 225 USPQ 624, 624 (TTAB 1985).

⁶ Applicant's reliance on In re Broadway Chicken Inc., 38 USPQ2d 1559 (TTAB 1996), is misplaced because, unlike the applicant in that case, applicant here has not introduced any evidence of third-party use.

⁷ Applicant points out that the term "Newport" is a "geographically descriptive term." Reply Brief at 4. We take judicial notice of the fact that Newport is the name of cities in Wales, Rhode Island, the Isle of Wight, and Kentucky and that there is a city named Newport Beach in California and Newport News in Virginia. *The Random House Dictionary of the English Language (Unabridged)*, 2d ed. (1987). The mere fact that Newport is the name of several geographic locations does not, without more, indicate that it is a weak mark.

Here, the only difference between the marks is the presence of the word "Raingear" in applicant's mark. While we certainly have not disregarded this term in our analysis, we conclude that the marks in their entireties look and sound similar and the addition of "raingear" does not alter the meaning of the mark. Therefore, the marks are similar.

The next, often critical, factor we consider is whether the goods of the applicant and registrants are related. We must consider these goods as they are identified in the application and registrations. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Since there are two registrations cited against applicant's goods, we must determine whether applicant's umbrellas are related to the first registration's suitcases, valises, and travelling bags. The next question is whether applicant's rain-resistant ponchos are related to the second registration's outer shirts. The examining attorney relies on two types of evidence to demonstrate the relatedness of the goods. First, the examining attorney has introduced numerous registrations that suggest that the same source may provide umbrellas and luggage and other registrations to show the same for outer shirts and ponchos. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). See, e.g., Registration Nos. 2,649,478 (luggage and umbrellas); 2,644,628 (travel bags and umbrellas); 2,631,795 (luggage and umbrellas); 2,563,901 (luggage, suitcases, and umbrellas); 2,527,652 (luggage and umbrellas); 2,496,418 (luggage and umbrellas); 2,720,668

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(umbrellas and suitcases); and 2,721,844 (luggage and umbrellas). See also Registration Nos. 2,589,978 (ponchos and shirts); 2,610,703 (ponchos and shirts); 2,626,726 (ponchos and shirts); 2,584,568 (rainwear and shirts); 2,713,687 (rainwear, t-shirts, and sweatshirts); 2,699,100 (rainwear and shirts); 2,331,892 (rainwear and shirts); 2,453,944 (rainwear and shirts); 2,228,177 (rainwear and shirts); and 2,097,791 (rainwear and shirts). These registrations suggest that luggage and umbrellas are marketed by the same entity under the same mark and that rainwear, which would include rain-resistant ponchos, and shirts are similarly marketed.

Second, there is other evidence that supports the conclusion that these goods are related. For example, The American Tourister website shows umbrellas and luggage sold under the same mark. The Travelsmith website, in its luggage and accessories page, shows luggage and umbrellas. The K-12 Outfitters site shows sweatshirts and rain-resistant ponchos marketed together. The evidence suggests that potential customers are likely to believe that applicant's umbrellas and registrant's luggage as well as applicant's raingear, namely ponchos and registrant's outer shirts are associated with the same source. Potential purchasers already familiar with the mark NEWPORT for outer

shirts would likely believe that applicant's raingear, sold under the mark NEWPORT RAINGEAR, originate from, or are associated with, the same source. Similarly, potential customers would likely believe that umbrellas sold under the mark NEWPORT RAINGEAR emanate from or are associated with the same source as the NEWPORT luggage. In addition, the evidence also shows overlap in the channels of trade for umbrellas and luggage, as well as the channels of trade for ponchos and shirts.

One final point we address is applicant's argument that the examining attorney "has incorrectly applied the standard for refusing registration under Section 2(d)." Reply Brief at 2. In effect, applicant asserts that the examining attorney applied a "possibility" of confusion rather than a likelihood of confusion standard. We reiterate that our affirmance of the examining attorney's refusal is based on our conclusion that, under the applicable Majestic Distilling/du Pont factors, there is a likelihood of confusion. Second, we note that the examining attorney has, in fact, reached the same conclusion. See Examining Attorney's Brief at 7 ("Because the applicant's mark and the registrants' marks are similar in appearance and commercial impression, and it has been shown that applicant's and registrants' goods are related,

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consumers are likely to be confused if applicant's mark were to be registered") (emphasis added). The examining attorney's discussion of the "real possibility that purchasers ... may perceive..." does not detract from his conclusion that consumers "are likely to be confused."

Ultimately, when we view the evidence of record in relationship to the relevant factors, we conclude that confusion would be likely were applicant to use its mark on umbrellas and ponchos in view of the two cited registrations. While we admit that our determination is not free from doubt, we must resolve those doubts in favor of the registrants and against the newcomer. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.