

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
December 9, 2004

Mailed: March 2, 2005
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Surf Line Hawaii, Ltd.
v.
Robert Charles White

Opposition No. 91152639
to application Serial No. 76244120
filed on April 20, 2001

Anthony L. Fletcher and Irene Hudson of Fish & Richardson
P.C. for Surf Line Hawaii, Ltd.

Todd Stockwell of Stockwell & Associates for Robert Charles
White.

Before Hohein, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Robert Charles White has filed an application to
register the mark TOE JAMS for "clothing, namely, socks,
shoes, shirts, pants, underwear and ties."¹

¹ Application Serial No. 76244120, filed on April 20, 2001, which
is based on an allegation of a bona fide intention to use the
mark in commerce.

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Surf Line Hawaii, Ltd. has opposed registration of applicant's mark. In its notice of opposition, opposer alleges that prior to the filing date of applicant's application, opposer has continuously used the marks JAMS and JAMS WORLD for brooches, sports bags, clothing, and retail store services; and that applicant's mark TOE JAMS for applicant's identified goods so resembles opposer's JAMS and JAMS WORLD marks as to be likely to cause confusion. Opposer has pleaded ownership of the following registrations:

- (1) Registration No. 920, 266 issued September 14, 1971 (renewed) for the mark JAMS for "men's swimming trunks."
- (2) Registration No. 1,537,352 issued May 2, 1989 (Section 8 affidavit accepted; Section 15 affidavit received) for the mark JAMS for "watches and costume jewelry, namely, brooches; sports bags, namely, back packs, hip packs, handbags, wallets and key holders; wearing apparel, namely, shirts, shorts, sport coats, T-shirts, sweatshirts, sweatpants, jerseys, and tank tops; candy and chewing gum."
- (3) Registration No. 1,497,797 issued July 26, 1988 (Section 8 affidavit accepted; Section 15 affidavit received) for the mark JAMS for "men's, women's and

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children's pants, shirts, walking shorts, swimming trunks, underwear, hats, belts and scarves."

(4) Registration No. 1,766,979 issued April 20, 1993 (Section 8 affidavit accepted; Section 15 affidavit received) for the mark JAMS WORLD for "retail clothing store services."

(5) Registration No. 1,888,564 issued April 11, 1995 (Section 8 affidavit accepted; Section 15 affidavit received) for the mark JAMS WORLD for "men's, women's and children's casual wear, namely pants, shirts, walking shorts, swimming shorts, sports shorts, running shorts, jackets, blazers, vests, shirts, sweatshirts, T-shirts, hats, ties, belts, dresses, blouses, slacks, pantsuits, jumpsuits, sports jackets, warm-up suits and workout wear, namely running suits."

As an additional ground for opposition, opposer alleges that applicant lacked a bona fide intent to use the applied-for mark at the time of filing the application.

Applicant, in his answer, has denied the essential allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; the declaration (with exhibits) of opposer's president, David Y. Rochlen, Jr.; the declaration of applicant, Robert Charles White; and the cross-

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examination testimony deposition (with exhibits) of Mr. White taken by opposer.²

Briefs have been filed and an oral hearing was held before the Board.

The record shows that in the early 1960's opposer's president David Y. Rochlen opened a small surf shop in Honolulu. Mr. Rochlen noticed that there was no colorful clothing suitable for surfers and he introduced long, bright colored, baggy print shorts under the mark JAMS. The first pair of JAMS shorts was sold in Hawaii in 1964. The shorts were highly successful and distribution of JAMS shorts was expanded to the mainland United States. Because of the success of the shorts, they were the subject of a "Fashion" page in Life magazine. Opposer has grown from a small surf shop to a business that today employs 102 persons, operates its own factory and warehouse and sells clothing internationally. The JAMS brand has expanded to include a full line of active and leisure wear and items such as backpacks and sunglasses. The JAMS brand enjoyed a surge in popularity in the mid-1980's with wholesale sales totaling in excess of \$35 million. In 1987 opposer introduced a line of men's, women's and children's casual wear clothing under

² The parties stipulated to the submission of testimony by affidavit or declaration.

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the mark JAMS WORLD. In September 1991 opposer opened a JAMS WORLD retail store in Santa Monica, California. Currently, more than 500 retailers throughout the U.S. carry JAMS and JAMS WORLD clothing.

Since 1964 opposer has spent more than \$6,000,000 advertising and promoting its clothing and sales have totaled more than \$200,000,000.

Applicant Robert Charles White is the owner of Charles White's Chevrolet, Cadillac, Inc., a car dealership in Martinsville, Virginia. According to Mr. White, he is "interested in developing, marketing, and selling various clothing products using different marks as an additional business and source of income." (Declaration, ¶3). He also stated that he continues to have a bona fide intent to use the mark but postponed use when this opposition was filed.

Opposer introduced copies of its pleaded registrations for JAMS and JAMS WORLD as exhibits to Mr. Rochlen's declaration. Mr. Rochlen attested to the status and ownership of the registrations as respectively being subsisting and owned by opposer. Thus, priority is not in issue in this case. *Kings Candy Co. v. Eunice Kings's Kitchen, Inc.*, 446 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer has used its JAMS and JAMS WORLD marks on clothing, sports bags, and retail

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store services since prior to the filing date of applicant's intent-to-use application.

This brings us to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In the present case, there is no question that opposer's goods and services are identical in part (shirts, pants, ties and underwear) and otherwise closely related to the goods on which applicant intends to use his mark. The parties' respective clothing is or will be sold in the same channels of trade, such as department stores, clothing stores and mass merchandisers. Also, opposer's clothing and retail clothing store services and applicant's clothing is or will be sold to the identical class of purchasers, namely, the general public. Thus, if the parties' respective goods and services are offered under identical or substantially similar marks, confusion is likely to result.

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We turn, therefore, to a consideration of the marks. We must keep in mind the well-established principle that "when 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).

We find that when considered in their entireties, applicant's mark TOE JAMS is highly similar to each of the opposer's marks JAMS and JAMS WORLD in sound, appearance, connotation and commercial impression. The JAMS portion of applicant's mark is identical to the entirety of opposer's JAMS mark and we view the addition of TOE in applicant's mark to be insufficient to distinguish the two marks when applied to identical and closely related goods. Further, because applicant's mark TOE JAMS and opposer's mark JAMS WORLD both share the word JAMS, there are consequent similarities in sound, appearance, connotation and commercial impression. Again, we view the differences in these marks to be insufficient to distinguish them when applied to identical and closely related goods and services.

Consumers may well believe, due to the similarity in the commercial impression formed by opposer's and applicant's marks, that TOE JAMS clothing is a new line of clothing from the owner of JAMS and JAMS WORLD clothing and

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retail clothing stores. This is especially the case in light of the arbitrary nature of the respective marks as applied to clothing and retail clothing store services.

In finding that applicant's mark is similar to each of opposer's marks, we have kept in mind the normal fallibility of human memory over time and the fact that purchasers retain a general rather than a specific impression of trademarks encountered in the marketplace. We find this to be the case especially in situations where, as here, the involved products and services are purchased by the general public who cannot be presumed to be particularly knowledgeable or sophisticated purchasers. In addition, some of opposer's and applicant's clothing items can be relatively inexpensive and purchased on impulse rather than after careful deliberation.

We conclude that consumers familiar with opposer's clothing and retail clothing store services offered under the marks JAMS and JAMS WORLD would be likely to believe, upon encountering applicant's mark TOE JAMS for clothing, that the respective clothing and retail clothing store services originate with or are somehow associated with or sponsored by the same entity.

In view of our finding of likelihood of confusion, we need not reach opposer's claim that applicant lacked a bona

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fide intent to use the applied-for mark at the time of filing the application.

Decision: The opposition is sustained on the ground of likelihood of confusion.