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June 28, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Abercrombie & Fitch Trading Co.

Serial No. 76516814

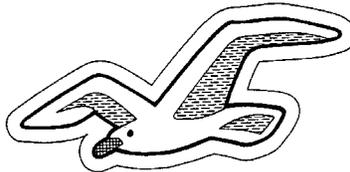
Katherine M. Basile and Allison G. Olmsted of Howrey LLP for
Abercrombie & Fitch Trading Co.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115
(Tomas V. Vlcek, Managing Attorney).

Before Hohein, Hairston and Cataldo, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Abercrombie & Fitch Trading Co. has filed an
application to register on the Principal Register the design mark
reproduced below



for "clothing, namely, beachwear, belts, boxer shorts, jackets,
jeans, knit shirts, knit tops, pants, shirts, shorts, skirts,

socks, sweat shirts, sweaters, swim wear, t-shirts and tank tops, sold exclusively in Hollister Co. stores, catalogs, and online web-site" in International Class 25 and "retail clothing store services" in International Class 35.¹

Registration has been finally refused 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 goods and services, so resembles the mark "SEAGULL," which is registered on the Principal Register in standard character form, by the same registrant, for the following goods and services, as to be likely to cause confusion, or to cause mistake, or to deceive:

(i) "men's underwear shorts, children's shorts, and gym shorts" in International Class 25;² and

(ii) "backpacks, fanny packs, tote bags, roll bags, straw bags, umbrellas, and plastic carrying cases for money, cigarettes, and keys" in International Class 18; "clothing, namely, rain ponchos, rainwear, rain suits, hats, caps, gloves, ear muffs, ski snow masks, shoes, men's underwear shorts, children's shorts, and gym shorts, boys' jeans, and slacks and boxer longies, and men's and boys' shirts, bandana scarves, [and] aprons" in International Class 25; and "import-export agencies in the fields of clothing, accessories, gift items, bags and swim accessories; mail order catalog services in the field of clothing, clothing accessories, gift items, bags and swim accessories" in International Class 35.³

¹ Ser. No. 76516814, filed on May 16, 2003, which is based on allegation of a bona fide intention to use the mark in commerce. The mark is lined for the colors gray and yellow.

² Reg. No. 824,938, issued on February 28, 1967, which sets forth a date of first use anywhere and in commerce of July 1, 1918; renewed.

³ Reg. No. 2,141,843, issued on March 10, 1998, which for each class sets forth a date of first use anywhere and in commerce of 1975; combined affidavit §§8 and 15.

Applicant has appealed. Briefs have been filed, but an oral hearing was not held.⁴ We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods or services at issue and the similarity or dissimilarity of the respective marks in their entireties.⁵

As to the former, it is obvious that although "sold exclusively in Hollister Co. stores, catalogs, and online website," applicant's "boxer shorts" and "shorts" are otherwise legally inclusive of and thus identical in nature to registrant's "men's underwear shorts, children's shorts, ... gym shorts" and "boxer longies." Similarly, except for the limitation in their channels of trade, applicant's other articles of "clothing, namely, beachwear, belts, ... jackets, jeans, knit shirts, knit tops, pants, shirts, ... skirts, socks, sweat shirts, sweaters,

⁴ Although applicant filed a request for an oral hearing with its initial brief, it subsequently filed a withdrawal of such request.

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." 192 USPQ at 29.

swim wear, t-shirts and tank tops," are closely related in their nature to registrant's remaining items of "clothing, namely, rain ponchos, rainwear, rain suits, hats, caps, gloves, ear muffs, ski snow masks, shoes, ... boys' jeans ... and slacks ..., and men's and boys' shirts, bandana scarves, [and] aprons." Furthermore, applicant's "retail clothing store services" clearly are commercially related to registrant's "mail order catalog services in the field of clothing, clothing accessories, gift items, bags and swim accessories" since, to ordinary consumers, the respective services are simply alternative means of shopping for clothing and related accessories. Plainly, if these particular goods and services were to be marketed under the same or legally equivalent marks, confusion as to the source or sponsorship of such goods and services would be likely to occur.

The primary focus of our inquiry, therefore, will be on the similarities and dissimilarities in the respective marks when considered in their entireties. Specifically, in the light of the circumstances of this case, we must among other things decide whether applicant's design mark is in essence a legal equivalent of registrant's "SEAGULL" mark, keeping in mind that, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [of the marks] 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), *cert. denied*, 506 U.S. 1034 (1994). See also *ECI Division of E-Systems, Inc. v. Environmental*

Communications Inc., 207 USPQ 443, 449 (TTAB 1980). Moreover, as stated in TMEP Section 1207.01(c)(i) (4th ed. 2005):

Under the doctrine of legal equivalents, a pictorial representation and its literal equivalent may be found to be confusingly similar. This doctrine is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers. See, e.g., *In re Rolf Nilsson AB*, 230 USPQ 141 (TTAB 1986) (design comprising the silhouette of the head of a lion and the letter "L" for shoes held likely to be confused with LION for shoes); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064 (TTAB 1984) (designs of mountain lion, for shirts and tops, held confusingly similar to PUMA, for items of clothing; the design of a puma, for items of sporting goods and clothing; and PUMA and design, for T-shirts); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974) (design of eagle lined for the color gold, for various items of sports apparel, held likely to be confused with GOLDEN EAGLE and design of an eagle, for various items of clothing).

Applicant, in this regard, nonetheless contends in its brief that the Examining Attorney has misapplied the doctrine of legal equivalents, arguing that (footnotes omitted):

The fundamental consideration to be made in evaluating the likelihood of confusion between a word mark and a design mark is not simply whether the design is an equivalent representation of the word mark, but whether: a) the pictorial representation would be readily recognized by the average purchaser of the goods [and/or services] involved as the equivalent of a literal term; and b) the design mark is of such a nature that the purchaser would be prone to "translate" and not accept it for what it is, namely, a design mark in the marketing environment for the goods [and/or services] with which it is used. See *Spaulding Bakeries Inc. v. Interstate Brands Corp.*, 209 USPQ 355, 356 (TTAB 1980) (dismissing petitioner's cancellation action alleging that respondent's ... design of a mill for bread

resembled its registered mark OLD MILL for bread).

Applicant, citing *In re Harry N. Abrams, Inc.*, 223 USPQ 832, 835 (TTAB 1984) in addition to *Spaulding Bakeries Inc. v. Interstate Brands Corp.*, supra, further asserts that, "[i]n fact, the Board has cautioned that the doctrine of legal equivalents must not be literally and indiscriminately applied without regard to the particular mark and record involved."

In particular, applicant contends that "the Examining Attorney has "disregarded facts and circumstances in the record which illustrate that the average consumer of Applicant's and Registrant's goods and services as they are encountered in the marketplace ... would not be likely to equate Applicant's Design Mark with the term 'seagull' and, more significantly, are not likely to be confused as to the source or origin of the Registrant's and Applicant's goods and services." According to applicant, the Examining Attorney "ignores (1) the marketplace reality that consumers will view Applicant's mark as a logo designating the source of the good[s and services] as coming from a HOLLISTER CO. retail venue; (2) the marketplace reality that Applicant only sells its goods in its HOLLISTER CO. retail venues; and (3) the crowded field of multiple third-party registrations of SEAGULL word marks and bird design marks in the nature of seagulls on the Principal Register for related goods and services."

In claiming that its "use of its Design Mark is highly intertwined with its HOLLISTER CO. house mark and brand,"

applicant argues that its "HOLLISTER CO. stores, catalogs and website and clothing convey a distinctive image" in that:

As stated in Applicant's response dated May 3, 2004, the image conveyed by Applicant's HOLLISTER CO. retail services and clothing is that of a youthful West Coast surfer's lifestyle. In line with that image, Applicant's HOLLISTER CO. retail venues are designed to look like a surfer's shack on the beach. Applicant's use of its Design Mark in the context of its HOLLISTER CO. house mark and brand draws on the quintessential beach lifestyle inherent in the design of its stores and clothing.

As to its contention that consumers will not translate its design mark into the word "SEAGULL," applicant insists that (underlining in original):

As the Board instructed in *Spaulding Bakeries*, in applying the doctrine of legal equivalents to bar registration, one must find that the design mark is of such a nature that the purchaser would be prone to "translate" the design and not accept it for what it is, namely, a design mark in the normal marketing environment for the goods with which it is used.

In this case, the normal marketing environment involves the use of the subject Design Mark in conjunction with the distinctive HOLLISTER CO. house mark, as is common in the branded retail clothing market, e.g., Lacoste's alligator design, Brooks Brother's golden fleece design, Ralph Lauren's horse design, and Baby Gap's teddy bear design, among others. Such use of a design mark as a primary logo that is highly connected to a house mark typically leads the consumer to mentally translate the logo into the house mark, rather than into the generic name of the image in the design mark. Consumers do not view the Lacoste alligator design and say, "I am buying an alligator shirt" -- rather, they know they are purchasing an IZOD shirt. Similarly, consumers do not say, "I am buying a golden fleece shirt" -- rather, the golden fleece indicates that the shirt originated at Brooks

Brothers. These design marks -- just like Applicant's Design Mark, -- are used in close connection with a larger concept and as such consumers will recognize the design mark in connection with that concept.

The Board in *In re Harry N. Abrams, Inc.*, 223 USPQ at 835, recognized that when a design mark is used in close association with a larger and more overarching concept, consumers may be more likely to recognize the design mark in connection with that concept (rather than translate it to its legal equivalent) and, hence, would not be confused as to source.

Similarly, because Applicant's use of its Design Mark is highly intertwined with its HOLLISTER CO. name and mark and its distinctive brand image, the Design Mark is likely to trigger a strong association with Applicant's HOLLISTER CO. house mark. Consumers are far more likely to view Applicant's Design Mark as a logo designating source from HOLLISTER CO. retail venues, rather than to relate it to Registrant's goods and services. Accordingly, consumers are not likely to be confused as to the source of the mark.

With respect to its related assertion that confusion is avoided by the marketplace reality that applicant only sells its goods in its HOLLISTER Co. retail venues, applicant reiterates its contention that, as reflected in the identification of its goods, it "does not sell any of its various HOLLISTER CO. brand goods, including goods bearing the subject Design Mark, in any third-party retail venues, such as department stores or other specialty stores." Rather, applicant maintains, "[c]onsumers are only able to purchase such goods through Applicant's HOLLISTER CO. stores and/or its HOLLISTER CO. web site." In consequence thereof, applicant stresses that "[r]egistrant's goods bearing its SEAGULL word mark have *not* and will *not* be sold in

Applicant's HOLLISTER CO. retail venues" (italics in original)
and that:

This clear demarcation in the distribution and provision of Applicant's and Registrant's goods and services sold and provided under their respective marks sends an unambiguous message to consumers that the goods and services emanate from different sources. Furthermore, because Applicant's goods bearing the subject Design Mark are solely available through Applicant's HOLLISTER CO. retail venues, consumers will first make a conscious decision to purchase from Applicant's stores, web site or catalog when purchasing goods bearing the subject Design Mark. Based on this record, it is clear that the Examining Attorney's literal application of the doctrine of equivalents did not adequately consider the facts in the record, and was in error.

Lastly, as to its argument that "the crowded field of multiple third-party registrations of SEAGULL word marks and bird design marks in the nature of seagulls on the Principal Register for related goods and services" demonstrates that similar marks are not barred by the doctrine of legal equivalents, applicant specifically maintains that (footnotes omitted):

The Examining Attorney improperly dismissed the existence of the numerous third-party registrations ... for seagull and other bird designs and word marks in International Classes 25 and 35.

The records of the Trademark Office reveal numerous registrations of SEAGULL word marks and bird designs bearing resemblance to a seagull for related goods and services. Notably, all of these third-party registrations -- which include both marks with the word SEAGULL and pictorial depictions of seagulls -- registered on the Principal Register notwithstanding [cited] Registration No. 824,938 of the word mark SEAGULL and, in most cases, notwithstanding [cited] Registration No. 2,141,843, also of the word mark SEAGULL.

....

The co-existence of numerous related marks on the Principal Register demonstrates that the Trademark Office has implicitly recognized seagull/bird marks in Classes 25 and 35 represent a diluted field of marks. In this diluted field, marks are afforded only a narrow scope of protection. Variations among the marks, including different design features, the use of word versus design elements, or slight differences among the goods and services distinguish the marks. Consumers rely on these variations and are able to successfully distinguish between the related bird marks When marks such as these have a narrow scope of protection, other uses in the same or similar field may come close to a weak mark and co-exist therewith. See *In re The Lucky Company*, 209 USPQ 422, 432 (TTAB 1980).

Further, these third-party registrations ... are evidence that the Trademark Office has repeatedly found that no likelihood of confusion exists with [cited] Registration Nos. 824,938 and 2,141,843.

[In particular,] Registration Nos. 1,394,127 and 1,175,261 each contain both a SEAGULL word mark (or a translation thereof [of the foreign word MOVE]) and a bird design that is clearly intended to be a seagull. These [r]egistrations --containing both a picture of a seagull and the word seagull -- were allowed to proceed to registration for goods related to [cited] Registration No. 824,938. If these three registrations can co-exist on the register it follows that Applicant's Design Mark should also be allowed to register.

The mere fact that Applicant's logo is a design mark and not a word mark should be sufficient to distinguish the marks in this manner and the doctrine of legal equivalents should not be applied.

We concur with the Examining Attorney, however, that the doctrine of legal equivalents should be applied and that applicant's design mark and registrant's "SEAGULL" mark are legal

equivalents. In this regard, we judicially notice⁶ that The American Heritage Dictionary of the English Language (4th ed. 2000) defines "seagull" as: "A gull, especially one found near coastal areas." According to an article under "gull" in the on-line edition of Grolier Multimedia Encyclopedia (2006):

Gulls are approximately 43 species of birds belonging to the family Laridae They are uniform in size and coloration Most have a gray or white mantle; some are black above (the black-backed and kelp gulls) and white below.

Gulls are primarily scavengers and prey on anything they can find. They forage along the shores of lakes, rivers, and oceans

Such article, *inter alia*, also contains an illustration, as shown below in color, of a "gull, common herring":⁷



Noting that, "[i]n this case, the applicant ... describes its design mark as a 'Seagull Design,'" the Examining Attorney accurately points out in her brief that:

⁶ It is settled that the Board may properly take judicial notice of dictionary definitions and articles in standard reference works. See, e.g., *In re Hartop & Brandes*, 311 F.2d 249, 135 USPQ 419, 423 n. 6 (CCPA 1962); *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

⁷ Illustration available at: [http://gme.grolier.com/cgi-bin/media?\[-\]templatename=/article/media.html&assetid=b063&assettype=0mp](http://gme.grolier.com/cgi-bin/media?[-]templatename=/article/media.html&assetid=b063&assettype=0mp).

The mark is colored in the same way as a seagull, *i.e.*, white and gray body and a yellow beak. There are no other literal or figurative elements in the mark. The mark consists solely of an accurate depiction of a seagull in flight. The average purchaser of the goods and services in this case would readily recognize the proposed mark as the equivalent of the word "seagull."

Given that applicant states that it intends to use its design mark exclusively in connection with its "HOLLISTER CO." retail venues, which applicant emphasizes feature the theme "of a youthful West Coast surfer's lifestyle" and thus, "[i]n line with that image, ... are designed to look like a surfer's shack on the beach," consumers in the context of such an ocean-side or beach themed environment would readily recognize the pictorial representation which constitutes applicant's mark to be the equivalent of the word "SEAGULL." Moreover, contrary to the assertion (made for the first time) in its reply brief that its "cartoonish design is not an 'accurate' depiction of any bird,"⁸ applicant's design mark is of such a lifelike and immediately recognizable nature that consumers would be prone to "translate" the mark and not accept it as just a design mark in the marketing environment for its goods and services.⁹

⁸ Such assertion is plainly at odds with applicant's statement, in its initial brief, that it "respectfully disagrees with the Examining Attorney that 'the birds shown in [third-party] Registration Nos. 1,394,127 and 1,294,097 are not accurate depictions of a seagull'" (footnote omitted). Clearly, if the abstract designs in the marks which are the subjects thereof are, in applicant's view, accurate depictions of seagulls, then applicant's design mark unquestionably qualifies as an accurate representation of a seagull and not just any bird.

⁹ Contrary to applicant's contention that, for instance, "[c]onsumers do not view the Lacoste alligator design and say, 'I am buying an alligator shirt,'" it is common knowledge that shirts bearing

Consequently, when encountered in "the quintessential beach lifestyle inherent in the design of its stores and clothing," consumers would specifically and unmistakably regard applicant's design mark as a seagull, rather than generally and ambiguously as a shorebird or even a bird of some kind. As such applicant's seagull design mark is the equivalent of registrant's "SEAGULL" mark. Confusion as to source or sponsorship would therefore be likely inasmuch as such marks, as the Examining Attorney properly notes, "create the same commercial impression" when respectively used in connection with the commercially related goods and services involved in this appeal.

Moreover, to the extent that applicant is nonetheless arguing that confusion is not likely to occur because applicant will be using its seagull design mark in connection with its "HOLLISTER CO." house mark, suffice it to say that, insofar as the registrability of applicant's mark is concerned, it is settled that the issue of likelihood of confusion must be determined solely on the basis of such mark and registrant's mark as they are respectively set forth in the application and cited registration(s). This is because Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion" Therefore, that applicant intends to use its seagull design mark solely in connection with its

such a design are typically referred to and known as "alligator" shirts. In the same manner, purchasers of applicant's goods would be inclined to refer to its various items of apparel as "seagull" shirts, etc.

"HOLLISTER CO." house mark is irrelevant and immaterial to the issue of likelihood of confusion. See, e.g., *Sealy, Inc. v. Simmons Co.*, 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); *Burton-Dixie Corp. v. Restonic Corp.*, 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (TTAB 1972).

Finally, with respect to applicant's contentions as to the "numerous" third-party registrations which it has made of record and which, by our count, consist of six subsisting registrations and six canceled registrations, the Examining Attorney correctly observes in her brief that:

Third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.* 18 USPQ2d 1386, 1388 (TTAB 1991). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered marks that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474[, 1477] (TTAB 1999).

The Examining Attorney, in her brief, also persuasively argues that (footnote omitted; italics in original):

Notwithstanding the foregoing, the examining attorney has reviewed the third-party registrations previously submitted by applicant. The applicant's mark is an accurate representation of a seagull in flight. The mark is colored in the same way as a seagull, *i.e.*, white and gray body and a yellow beak. None of the marks cited by applicant ... is an accurate representation of a seagull. The marks shown in those registrations are either not clearly seagulls

... or are highly stylized or fanciful representations of seagulls As such, the registrant's word marks would not have been cited against registration of those design marks or vice versa.

U.S. Registration No. 1,394,127 (SEAGULLS (and Design)) is the most similar of the third-party registrations to the cited registered marks, but even in that registration the seagull design element of the mark is highly stylized and is certainly not an accurate representation of a seagull.

....

Contrary to showing a "crowded field" for seagull designs in International Classes 25 and 35, the third-party registrations submitted by the applicant, by comparison, only enhance the accuracy of the seagull depicted in the applicant's mark. Assuming that the applicant submitted the best evidence of third-party registrations that contain seagull designs, the applicant's seagull design mark stands apart as an accurate depiction of a seagull in flight.

Additionally, it is well established that third-party registrations do not demonstrate use of the marks which are the subjects thereof in the marketplace or that the consuming public is familiar with the use of those marks and has learned to distinguish between them. See, e.g., *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Moreover, as our principal reviewing court noted in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court." See also, *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re*

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Pennzoil Products Co., 20 USQP2d 1753, 1758 (TTAB 1991).

Finally, even if applicant had shown that registrant's "SEAGULL" mark, as well as seagull design marks, are "weak" marks, such a mark would still be entitled to protection against registration by a subsequent user of the same or similar mark, including a legally equivalent mark, for the same or closely related goods or services. See, e.g., In re Farah Manufacturing Co., Inc., 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971); and Hollister Inc. v. Ident A Pet, Inc., 193 USPQ 439, 442 (TTAB 1976).

We accordingly conclude that customers and prospective consumers who are familiar or otherwise acquainted with the cited registrant's "SEAGULL" mark for its goods and services, including in particular its various items of apparel in International Class 25 and its "mail order catalog services in the field of clothing, clothing accessories, gift items, bags and swim accessories" in International Class 35, would be likely to believe, upon encountering applicant's legally equivalent seagull design mark for its various articles of clothing "sold exclusively in Hollister Co. stores, catalogs, and online web-site" in International Class 25 and its "retail clothing store services" in International Class 35, that such identical in part and otherwise commercially related goods and services emanate from, or are otherwise sponsored by or affiliated with, the same source.

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