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July 31, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Salute LLC

Serial No. 78466753

Michael D. Hobbs, Jr. and Daniele E. Bourgeois of Troutman Sanders LLP for Salute LLC.

George M. Lorenzo, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Quinn, Hohein and Cataldo, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Salute LLC has filed an application to register on the Principal Register the mark "SALUTE" for "clothing, namely, shirts, pants, shorts, skirts, dresses, sweaters, vests, cardigans, jackets, coats, gloves, scarves, underpants, bath robes, hats, caps, [and] shoes" in International Class 25.¹

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, so resembles the mark "SALUTE OLEG CASSINI," which is registered on the Principal

¹ Ser. No. 78466753, filed on August 12, 2004, which is based on allegation of a bona fide intention to use the mark in commerce.

Register in standard character form for "wearing apparel, namely, shirts, pants, sweaters, jackets, shorts, warm-up suits and jeans" in International Class 25,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. 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). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). 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.³ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, inasmuch as applicant's articles of clothing are identical in part (i.e., shirts, pants, shorts, sweaters and jackets) and are otherwise

² Reg. No. 2,664,950, issued on December 24, 2002, which sets forth a date of first use anywhere and in commerce of December 1, 1997 and states that: "'Oleg Cassini' is the name of a living individual whose consent is of record."

³ 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 and differences in the marks." 192 USPQ at 29.

closely related in a commercial sense to registrant's items of wearing apparel, and therefore would be marketed and sold to the same classes of ordinary consumers through the same channels of trade (e.g., clothing stores, department stores and mass merchandisers),⁴ the primary focus of our inquiry is on the similarities and dissimilarities in the respective marks, when considered in their entirety, along with, as applicant also asserts, the additional *du Pont* factor of the number and nature of similar marks in use on similar goods.

Turning first to consideration of the respective marks, applicant contends in its initial brief that confusion is not likely because such marks differ in sound, appearance and commercial impression, due to "the inclusion of the Cited Registrant's well-known house mark OLEG CASSINI in the Cited Mark," and the weakness of the shared term "SALUTE." Applicant, while noting that the Examining Attorney "has focused on a line of cases that support the position that 'Where marks are virtually the same, the addition of a house mark is more likely to add to the likelihood of confusion that [sic] to distinguish the marks'," argues that the marks at issue are distinguishable because:

[A]s recognized in Section 1207[01.] (b) (iii) of the TMEP, the Federal Circuit has held that general exceptions to the above rule exist where: (1) the marks in their entirety convey significantly different impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source "because

⁴ Applicant, we note, does not contend otherwise in either its initial or reply briefs.

it is merely descriptive or diluted." See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, [393 F.3d 1238,] 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004). . . . The Appellant submits that in the instant matter, both exceptions apply[,] negating any likelihood of confusion between the respective marks.

First, the inclusion of the Registrant's well-known house mark "OLEG CASSINI" in the Cited Mark creates and conveys a different commercial impression than that of the Appellant's Mark and negates any likelihood of confusion between the respective marks. As demonstrated in Appellant's previous Responses, "OLEG CASSINI" is the name of a particular individual who enjoys world renown for his elegant fashion designs. In addition, the owner of the Cited Mark owns 16 other applications or registrations for "CASSINI" and/or "OLEG CASSINI" variant marks. . . . Clearly, therefore, consumers are readily familiar with the "OLEG CASSINI" portion of the Cited Mark and are likely to look to that portion as the dominant source identification component. As such, the connotation and commercial impression of the Cited Mark is that the terms identified thereby serve as a commemoration of or a note of respect to Mr. Cassini and his contributions to the fashion industry. The Appellant's Mark, on the other hand, is totally devoid of any suggestion of a connection with Mr. Cassini or any other person. As such, the marks convey significantly different commercial impressions and simultaneous use of SALUTE by the owner of the Cited Mark and the Appellant is not likely to result in consumer confusion between the respective marks.

Second, as demonstrated above, the Appellant submits that the use of the "salute" component in the respective marks is relatively common in conjunction with clothing and thus, does not function as the dominant portion of the Cited Mark. . . . Rather, based on Mr. Cassini's notoriety and the use of and registration for "CASSINI" and "OLEG CASSINI" variant marks by the owner of the Cited Mark, the "OLEG CASSINI" portion of the Cited Mark is much more likely to command the consumer's notice and power of recall than the term "salute." Thus, consumers are

not likely to encounter Appellant's Mark and the Cited Mark and focus solely on the common SALUTE component in the marks and be confused as to the source or sponsorship of the goods identified thereby.

As to the asserted weakness of the marks at issue, applicant maintains that:

In the instant matter, the term "salute" is commonly used in connection with clothing and wearing accessories to suggest a "tribute" or homage. Specifically, the Appellant has provided evidence of three registrations and applications incorporating the word "salute," owned by different entities, currently co-existing on the PTO register. In each of these instances, the word "salute" suggests a tribute to something or someone--in one case, to America's heroes, and in another to American designers and in yet another to an indiscriminate reference. Likewise, the use of "salute" in the Cited Mark refers to the famous designer Oleg Cassini. The PTO has thus determined that the public can distinguish between various uses of "salute" based on the context in which they are used.

....

The Appellant submits that the significant recurrence of registered and approved SALUTE variant marks that exist on the Principal Register confirms that the PTO has recognized that although entitled to some protection, the Cited Mark is entitled to a relatively narrow scope of protection and that no one owner should be allowed to appropriate SALUTE for exclusive use in connection with clothing.

We agree, however, with the Examining Attorney's conclusion that confusion is likely. As set forth in TMEP Section 1207.01(b)(iii) (4th ed. 2005), "[i]t is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark" See, e.g., In re Dennison Mfg. Co., 229 USPQ 141, 144

(TTAB 1986) and cases cited therein. Indeed, it has been held in this regard that "[w]here the marks are otherwise virtually the same, the addition of a house mark or ... a surname ... is more likely to add to the likelihood of confusion than to aid to distinguish the marks" at issue. Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co., 216 USPQ 168, 170 (TTAB 1982). The same would likewise be true where one of the respective marks includes, as a house mark or otherwise, the name of a fashion designer or other notable person. See, e.g., In re Riddle, 225 USPQ 630, 632 (TTAB 1985), in which the Board, in finding that confusion was likely between the mark "RICHARD PETTY'S ACCUTUNE" and design for "automotive service centers specializing in engine tune-ups and oil changes" and the mark "ACCUTUNE" for various items of "automotive testing equipment," pointed out that:

Applicant urges that, because of the fame of Richard Petty in conjunction with automobile racing, it is the "RICHARD PETTY'S" portion of applicant's mark which dominates the mark and which would cause it to be easily distinguishable from the mark shown in the cited registration. The problem with applicant's argument is that, while the name "Richard Petty" might well be a famous one in connection with automobiles and automobile racing, that fact does not diminish the likelihood of confusion in this case. In particular, those who encounter both the "ACCUTUNE" automotive testing equipment and the automotive service centers offered under applicant's mark would likely believe that Richard Petty endorsed or was in some way associated with both the goods and the services, in that both marks contain the designation "ACCUTUNE."

Although the Examining Attorney, in this case, insists in his brief that "the identical 'SALUTE' portion dominates each mark," we need not decide whether the registrant's "SALUTE OLEG

CASSINI" mark is dominated by such term or by the house mark and/or fashion designer name "OLEG CASSINI."⁵ Rather, at a minimum, it is plain that the term "SALUTE," as the first portion of the registrant's mark, constitutes a prominent and significant element thereof and that the meaning of such term is not altered by the presence of the house mark and/or fashion designer name "OLEG CASSINI." See, e.g., Presto Products, Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ["[i]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"]. We therefore concur with the Examining Attorney that, "[i]nsofar as meaning is concerned, the word 'SALUTE' would convey the same meaning" in registrant's mark as it does in applicant's "SALUTE" mark.

Specifically, while the evidence made of record by applicant plainly demonstrates that "OLEG CASSINI" is the name of a renowned fashion designer and that registrant has registered such name as a mark or as part of a mark for various goods, including Reg. No. 2,701,647 for the mark "BLACK TIE OLEG CASSINI" for toiletries and women's clothing and Reg. No. 1,371,426 for the mark "THE COMPETITOR COLLECTION BY OLEG

⁵ Nonetheless, as properly pointed out by the Examining Attorney:

Because the registered mark is in a typed drawing format, the registrant is free to use any possible different stylizations, fonts and arrangements in the presentation of its mark. Hence the registrant may use its mark where the wording "OLEG CASSINI" is merely one-tenth the size of the wording "SALUTE."

See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark in typed or standard character form is not limited to the depiction thereof in any special form].

CASSINI" for men's and women's clothing,⁶ we simply do not agree with applicant's assertion that "the connotation and commercial impression of the Cited Mark is that the terms identified thereby serve as a commemoration of or a note of respect to Mr. Cassini and his contributions to the fashion industry." Rather, the word "SALUTE" in registrant's "SALUTE OLEG CASSINI" mark would be perceived as having the same connotation as such word has in applicant's "SALUTE" mark, especially since the name "OLEG CASSINI" in the registrant's mark clearly conveys the impression of a house mark and there is nothing therein which suggests that the mark is meant to be a brand for a line of clothing which "salutes" or otherwise commemorates registrant's renowned fashion designer, Mr. Cassini. Consumers, instead, would perceive registrant's mark as identifying a line of "SALUTE" brand products from the maker and designer of "OLEG CASSINI" fashions. Therefore, if consumers were to encounter applicant's "SALUTE" mark for identical or closely related items of apparel, they would be likely to assume that such goods originate from or are at least affiliated with, the clothing offered under the mark "SALUTE OLEG CASSINI." See, e.g., In re Christian Dior, S.A., 225 USPQ 533, 535 (TTAB 1985) ["purchasers familiar with registrant's 'CACHET' [clothing and toiletry] products would, upon encountering [applicant's] 'LE CACHET DE DIOR' shirts, assume that DIOR is the source of the CACHET products" and thus

⁶ The information made of record by applicant with respect to various pending applications by registrant, including Ser. No. 75182998 for the mark "ICON BY OLEG CASSINI" for perfume, cologne and eau de toilette, evidence only that such applications have been filed.

"the addition of a house mark to one of two confusingly similar marks does not avoid likelihood of confusion between them"].

With respect to applicant's further and related argument that the term "SALUTE" is weak, and hence entitled only to a narrow scope of protection, because that term "is commonly used in connection with clothing and wearing accessories to suggest a 'tribute' or homage," suffice it to say that the evidence submitted by applicant is insufficient to establish such generalized usage.⁷ As the Examining Attorney accurately observes in his brief (footnote omitted):

[T]he applicant has provided only one currently live registration printed from the Patent and Trademark Office records which contain[s] the term "SALUTE" for the same or similar items of clothing. As such the applicant's claim that there is a

⁷ It is well settled that the 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). While applicant, therefore, has not furnished any evidence of actual third-party use of marks containing the term "SALUTE," it is nonetheless the case that third-party registrations may in general be given some weight to show the meaning of a mark in the same way that dictionary definitions would be so used. *See, e.g.*, *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). However, as the Examining Attorney correctly points out, applicant's reliance on Reg. No. 2,243,882 for the mark "SALUTE THAT!" for, *inter alia*, "clothing, namely, sweatshirts, t-shirts and hats" and "a promotional campaign used to gather fan support for a local football team," was cancelled on February 11, 2006" while Ser. No. 78383378 for the mark "SALUTE AMERICA'S HEROES" for, *inter alia*, "clothing, namely, t-shirts, shirts, sweatshirts and hat" and "promoting public awareness of the need for Americans to support members of the armed services and their families," has not yet matured into a registration. Thus, the sole subsisting third-party registration upon which applicant may rely is Reg. No. 2,699,394 for the mark "A SALUTE TO AFRICAN AMERICAN DESIGNERS MAGIC JOHNSON FOUNDATION" and design for "clothing, namely, t-shirts," "charitable fundraising" and "entertainment in the nature of fashion shows; [and] award shows to demonstrate excellence in the fields of fashion design and philanthropy."

"significant recurrence of registered ... SALUTE variant marks that exist on the Principal Register" is not established.

Moreover, even if applicant had shown that the term "SALUTE" was weak and that consequently "no one owner should be allowed to appropriate SALUTE for exclusive use in connection with clothing,"⁸ the Examining Attorney correctly points out that it is still the case that "such marks are ... entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods." 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).

Finally, as the Examining Attorney also properly observes, "[t]o the extent that applicant contends that the refusal to register the mark in this application is inconsistent with the ... registration of only one other live mark containing the term SALUTE, each case must be decided on its own unique set of facts." See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Thus, 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

⁸ Although applicant, in its reply brief, cites for the first time to *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ 1313 (TTAB 2005), in which the Board found no likelihood of confusion between the mark "NORTON MCNAUGHTON ESSENTIALS" for items of "ladies sportswear" and the mark "ESSENTIALS" for articles of "women's clothing," inasmuch as the record established that the term "ESSENTIALS" was weak in that it was highly suggestive of the respective goods as shown by 23 third-party registrations (owned by 21 different registrants) for women's apparel of marks which included the term "ESSENTIALS." Id. at 1314-17. Here, as indicated above, applicant has failed to establish that the term "SALUTE" is weak in the field of clothing.

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

We accordingly conclude that consumers who are familiar or acquainted with registrant's "SALUTE OLEG CASSINI" mark for "wearing apparel, namely, shirts, pants, sweaters, jackets, shorts, warm-up suits and jeans," would be likely to believe, upon encountering applicant's substantially similar "SALUTE" mark for "clothing, namely, shirts, pants, shorts, skirts, dresses, sweaters, vests, cardigans, jackets, coats, gloves, scarves, underpants, bath robes, hats, caps, [and] shoes," that such identical in part and otherwise commercially related articles of apparel emanate from, or are sponsored by or associated with, the same source. In particular, even though customers may indeed know of or otherwise be familiar with the fashion designer Oleg Cassini, they would still be likely to believe that, when used in connection with applicant's goods, applicant's "SALUTE" mark constitutes a separate or expanded line of clothing from the same fashion house and designer as registrant's "SALUTE OLEG CASSINI" line of apparel.

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