

9/21/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 27
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nautica Apparel, Inc.

v.

Kevin Crain.

Opposition No. 113,893
to application Serial No. 75/328,137
filed July 21, 1997

Carol A. Witschel of White & Case LLP for Nautica
Apparel, Inc.

Kevin Crain, pro se.

Before Hanak, Chapman, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Kevin Crain (applicant) filed an application to
register the mark NAUTI BODY (typed drawing) for goods
ultimately identified as "men's and women's clothing,
namely, T-shirts, swimwear, sweatshirts, elastic tops and
bottoms, tank tops, hats, and caps"¹ In International
Class 25.²

¹ Opposer incorrectly refers to the application's original
identification of goods in its discussion of likelihood of

On February 16, 1999, Nautica Apparel, Inc. (opposer) filed a notice of opposition to the registration of applicant's mark alleging that applicant's mark was confusingly similar to various trademark registrations it owned under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). Opposer ultimately based its opposition on its ownership of the following nine registrations.

Opposer's first registration is for the mark NAUTICA for "footwear" in International Class 25.³ Opposer also relies on registrations for the mark shown below for the following goods:



nautica

confusion. The identification of goods was amended during the prosecution of the application as indicated above.

² Serial No. 75/328,137 filed on Jul 21, 1997, and based on an allegation of a bona fide intent to use the mark in commerce.

³ Registration No. 1,862,585 issued November 15, 1994. Section 8 and 15 affidavits have been accepted and acknowledged, respectively.

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"umbrellas, luggage, trunks, duffle bags, garment bags for traveling, travel kits and leather boxes in the nature of jewelry boxes" and "notebooks, desk top organizers, calendars, and phonebook covers made of leather or imitation leather" and "belts and suspenders" in International Classes 16, 18, and 25.⁴ Opposer's third registration is for the same mark for "hosiery, shoes, undershirts, undershorts, shirts, blouses, trousers, jackets, pants, coats, suits, bathing suits, bathrobes, slippers and shorts" in International Class 25.⁵ Opposer's fourth registration is for the same mark for "ties, neckware [sic], scarfs, socks, hats and caps, foul weather clothing" in International Class 25.⁶

Opposer's fifth registration is for the following mark:



⁴ Registration No. 1,580,007 issued January 30, 1990. Renewed.

⁵ Registration No. 1,464,663 issued November 10, 1987. Section 8 and 15 affidavits have been accepted and acknowledged, respectively.

⁶ Registration No. 1,687,919 issued May 19, 1992. Sections 8 and 15 affidavits have been accepted and acknowledged, respectively.

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for "caps and hats, robes, loungewear, T-shirts and knit shirts, jackets, sweaters, ties, hosiery, sport jackets and slacks" in International Class 25.⁷ Opposer's sixth registration is for the same mark for "men's suits" in International Class 25.⁸

Opposer's seventh registration is for the mark:

NAUTICA

COMPETITION

for "men['s], women['s] and children's wearing apparel, namely, hosiery, shoes, sneakers, boots, moccasins, undershirts, undershorts, shirts, blouses, trousers, pants, jackets, coats, suits, bathing suits, bathrobes, slippers, shorts, ties, neckware [sic], scarfs, socks, hats and caps, gloves and mufflers, and all weather (foul weather) gear, belts and suspenders" in International Class 25.⁹

Opposer's eighth registration is for the mark:

⁷ Registration No. 2,043,895 issued March 11, 1997.

⁸ Registration No. 1,988,708 issued July 23, 1996.

⁹ Registration No. 2,104,034 issued October 7, 1997.



"fabric for use in the manufacture of wearing apparel, namely, shirts, vests, jackets, coats, and outerwear" and "clothing, namely, shirts and vests and outerwear, namely, jackets, coats, and anoraks" in International Classes 24 and 25.¹⁰

Opposer's ninth registration is for the mark:



for "clothing, namely, jackets, vests, pants and woven and knit shirts" in International Class 25.¹¹

Applicant denied that its marks and opposer's marks are confusingly similar.

The Record

The record consists of the file of the involved application; the trial testimony deposition, with accompanying exhibits, of Shira Berger, opposer's legal

¹⁰ Registration No. 2,028,278 issued January 7, 1997.

¹¹ Registration No. 2,110,027 issued October 28, 1997.

counsel; and the trial testimony deposition, with accompanying exhibits, of applicant.

Both parties have filed briefs, but no oral hearing was requested.

Priority

Priority is not an issue here in view of opposer's ownership of nine registrations for marks containing the word NAUTICA or similar terms. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).¹²

Bona Fide Intention to Use the Mark

Opposer alleges that applicant lacked a bona fide intention to use the mark in commerce because he has not

¹² Opposer has not introduced current status and title copies of the nine registrations discussed above. However, applicant has discussed these registrations on the merits in his Answer and his Brief. Therefore, inasmuch as applicant has treated the registrations as being of record, they are "deemed by the Board to be of record in the proceeding." TBMP § 703.02. See also Tiffany and Company v. Columbia Industries, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) ("Since appellee had fair notice of the case it had to meet, it would work an injustice on appellant to deprive it of the right to rely on the statutory presumptions flowing from [the] registration" that was not properly submitted.); Crown Radio Corp. v. Soundsciber Corp., 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) ("Appellee did not submit copies of its aforementioned registrations with the verified petition for cancellation ... We agree with the Board that appellant has admitted the existence of appellee's registrations. Therefore, we agree with the board that the sole issue to be determined in this proceeding is whether there is a likelihood of confusion"). Nonetheless, we will not consider Registration Nos. 1,765,287, 1,802,504, and 2,117,012, which have been cancelled. In addition, we will not consider

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produced any objective evidence to support his claim of a bona fide intention to use the mark as indicated in the application. "[A]bsent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce." Commodore

Registration No. 1,523,565, a copy of which was attached for the first time to opposer's appeal brief.

Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503, 1507 (TTAB 1993).

In this case, the application was filed on July 21, 1997, and opposer first requested an extension of time to oppose on January 21, 1999. We are concerned with this period because it would be expected that an applicant would be less likely to expend resources developing a mark that is being litigated. Applicant testified that he is not currently in the clothing business. Crain test. dep., pp. 12-13. He is an independent contractor doing appraisals after automotive collisions. Crain test. dep., p. 8. This is applicant's first trademark application. Crain test. dep., pp. 13-14. Applicant testified that he obtained a sales permit from the State Board of Equalization to sell used goods and clothing throughout Southern California, that he obtained domain names for "nautibody.com," "nautibody.net" and "nautibody.org," and that he educated himself about the apparel business. Crain test. dep. pp. 18, 19, 23, and 24. Applicant also contacted individuals and companies who might be able to help him in setting up his business. Crain test. dep., pp. 31-47. While applicant's activities regarding attempting to begin using his mark are minimal and not documented, we are not convinced that

these activities demonstrate a lack of intention to use the mark. We take into consideration applicant's lack of experience in the apparel business and his presumably reasonable belief that when "his name is lawfully released," he would begin more extensive activities involving the mark. Crain test. dep., pp. 42 and 68.

There is also no evidence that applicant has in any way abused the intent to use process by filing multiple applications for the same mark for many goods, filing many marks for the same goods, reserving many descriptive terms, filing an excessive number of applications, or filing applications lacking in specificity. 3 McCarthy on Trademarks and Unfair Competition § 19:15 (4th ed.). Considering applicant's circumstances and the fact that this is his first trademark application, we do not find that applicant lacks a bona fide intent to use the mark in commerce. While we consider opposer's unpled ground that applicant lacked a bona fide intention to use the mark in commerce as tried by the implied consent of the parties (TBMP § 507.03(b)), we find that opposer is not entitled to relief on this ground.

Likelihood of Confusion

We now turn to the issue of likelihood of confusion. We analyze this issue in light of the factors set forth

in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

The first factor we will consider is the fame of opposer's mark because "a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark." Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Applicant testified that he was unaware of opposer's marks prior to filing his trademark application. Crain test. dep., p. 50. Interestingly, applicant now admits that after the opposition was filed "I see them [ads for Nautica clothing] everywhere now." Crain test. dep., p. 50. Applicant also acknowledges that "everyone seems to have heard of Nautica, except for me. So, my friends are pretty well informed about Nautica. It seems that everyone that I talked to is familiar with the company." Crain test. dep., p. 52.

The record indicates that in years 1998-2000 opposer spent between approximately \$20 and \$26 million advertising and promoting its products. Berger test. dep., p. 30. Opposer advertises on radio, television, and billboards and in magazines. Berger test. dep., p. 29. These magazines include *Esquire*, *Details*, *GQ*, *Elle*,

Glamour, Vanity Fair, Harper's Bazaar, Sports Illustrated, Rolling Stone, House Beautiful, Travel & Leisure, and In Style. Id. Also, in 1998, it had sales of almost one half billion dollars and, by 2000, opposer's sales reached \$621 million. Berger test. dep., p. 38.

The Federal Circuit "has acknowledged that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21, 23 USPQ2d at 1701, quoting, Kenner Parker Toys, 22 USPQ2d at 1456. "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for "natural agricultural products, namely, edible dog treats" confusingly similar to FRITO-LAY for snack foods). Here, the opposer's evidence shows that it has now reached the one half billion dollar mark in sales combined with a multimillion dollar advertising budget. The fame of opposer's mark is further supported by applicant's own admission that his friends and nearly everyone he talked to was familiar with the NAUTICA mark. The fame of opposer's NAUTICA mark is a factor, therefore, that strongly favors opposer.

We further note that many of the other du Pont factors favor opposer. Applicant seeks registration for goods that are identical (hats, caps, t-shirts) or virtually identical (swimwear vs. bathing suits) to opposer's goods. We must compare the goods as described in the application and the registration(s) to determine if there is a likelihood of confusion. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Because the marks are used on identical clothing items, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

In addition, we must assume that identical goods would be marketed in similar trade channels and that clothing items would often be purchased on impulse by all types of purchasers. There is no evidence of any third-party uses of similar marks so this factor also favors opposer. In addition, opposer has testified that it uses its mark on a wide variety of goods and services. Berger

test. dep., pp. 6-28. Furthermore, factors concerning actual confusion and use of the marks are not pertinent because applicant has not used its mark.

Another important consideration in any likelihood of confusion case is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. Opposer argues that applicant's mark NAUTI BODY "is virtually identical to opposer's NAUTICA marks." Opposer's Br., p. 5.

Applicant argues that:

Nautica's name(s) and associated product lines, implies water related or boating clothes, with a seafaring theme to their items... Applicant's proposed mark of NAUTI BODY implies sensual, naughty, or sexy garments. "NAUTI" is a homonym for "Naughty." Naughty means "bad, disobedient, mildly indecent." Clearly, Applicant's mark implies slightly indecent clothes to [be] worn out in public, rather than in the bedroom. There is nothing in the name that remotely suggests that it is related to Nautica.

Applicant's Br., p. 7 (reference omitted).

We cannot agree with opposer's position that the marks are "virtually identical." Also, applicant's argument is not without merit that the marks may have different meanings. The deletion of the letters "ca" from opposer's mark and the addition of the word "body" can create the meaning of "naughty body." However, there are similarities between the marks. Both begin with the

same five letters "NAUTI." Applicant chose to use a misspelling of the word "naughty," and that misspelling obviously makes the appearance of the marks more similar.¹³ A famous mark "casts a long shadow which competitors must avoid." Recot, 54 USPQ2d at 1897, quoting, Kenner Parker Toys, 22 USPQ2d at 1457. This spelling also dilutes the meaning applicant claims he was trying to create of "naughty body." If the correct spelling of the word "naughty" was used the meaning that applicant was trying to create would be more readily apparent to purchasers. By misspelling the word, applicant's mark, at first glance, suggests a connection with the word "nautical" and then requires the potential purchaser to reevaluate the word in light of the incongruous word "body." Only then would many prospective purchasers appreciate the meaning that applicant is suggesting.

Also, differences in type styles between opposer's mark and applicant's stylized mark are not significant here because applicant's mark and one of opposer's marks are in typed form and, thus, not limited to any special form. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983); Cunningham v. Laser Golf

¹³ Applicant testified that "naughty in a different language

Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000).

In addition, opposer's registrations show that it is using more than just the mark NAUTICA. Opposer also uses the mark NAUTECH for clothing items as well as N NAUTICA and NAUTICA COMPETITION. Thus, potential purchasers would more likely believe that applicant's term NAUTI BODY is in some way related to, or sponsored by, opposer.

While it is improper to dissect a mark and marks must be viewed in their entirety, In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993), more or less weight may be given to a particular feature of a mark for rational reasons. In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985).

Based on the above, we conclude that the marks have significant similarities in sound and appearance and their commercial impressions would likewise have significant similarities. National Data, 753 F.2d at 1060, 224 USPQ at 749.

Analysis of Likelihood of Confusion Factors

When we analyze the issue of likelihood of confusion under the du Pont factors, it is apparent that this is a

meant childish." Crain test. dep., p. 49.

close case. Likelihood of confusion is decided upon the facts of each case. Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ 1531, 1533 (Fed. Cir. 1997); Shell Oil, 992 F.2d at 1206, 26 USPQ at 1688. The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

Applicant's argument that his mark would have a different meaning than opposer's is a significant factor. However, merely because applicant's mark may have a different meaning from opposer's mark does not mean that there is no likelihood of confusion. Recot, 54 USPQ2d at 1899 (Board erred by considering that the different connotations of FRITO LAY and FIDO LAY avoided confusion). See also TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997) (GRAND SLAM confusingly similar to GRAND AM); Crown Radio Corp. v. Soundscriber Corp., 506 F.2d 1392, 184 USPQ 221 (CCPA 1974) (CROWNSCRIBER confusingly similar to SOUNDSCRIBER).

In addition, when we consider the fame of opposer's mark, the identical nature of the goods, the strength of opposer's mark, the fact that applicant choose the misspelling of his mark making it appear even more

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similar to opposer's mark, the number of variations of opposer's marks, and the wide variety of goods on which opposer uses its marks, we hold that the balance tips in opposer's favor.

Finally, while our determination that confusion is likely is not free from doubt, we must resolve doubts about confusion against the newcomer, which we do here. Kenner Parker Toys, 963 F.2d at 355, 22 USPQ2d at 1458.

Decision: The opposition is sustained and registration to applicant of his mark NAUTI BODY is refused.