

9/30/02

THIS DECISION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Paper No. 20  
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Warnaco U.S., Inc.

Serial No. 75/661,184

Simon Bock of Katten Muchin Zavis Rosenman for Warnaco  
U.S., Inc.

Rudy R. Singleton, Trademark Examining Attorney, Law Office  
109 (Ron Sussman, Managing Attorney).

Before Cissel, Quinn and Seeherman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Warnaco Inc. applied to register WARNER'S SIMPLE  
LUXURIES for "intimate apparel and figure enhancing  
garments, namely, bras, panties, underwear, underpants,  
undergarments, underclothes, teddies, slips, sarongs,  
negligees, lingerie, foundation garments, girdles, corsets,  
camisoles, body slips and body suits, sleepwear and

nightgowns."<sup>1</sup> The application was filed based on an asserted bona fide intent to use the mark in commerce. After the mark was published for opposition Warnaco U.S., Inc., as successor-in-interest to Warnaco Inc., submitted a statement of use. The Examining Attorney objected to the specimen filed with the statement of use because it did not evidence use of the mark which appears in the drawing of the application, and required an acceptable specimen of use. Although applicant then submitted a substitute specimen, the Examining Attorney found this specimen also to be unacceptable, and made the requirement for an acceptable specimen final.

Applicant then filed the instant appeal. The appeal has been fully briefed, but an oral hearing was not requested.<sup>2</sup>

---

<sup>1</sup> Application Serial No. 75/661,184, filed March 16, 1999.

<sup>2</sup> In its reply brief applicant states that it has submitted copies of registrations as "Exhibit A". However, no exhibit was found with the reply brief. In any case, such registrations would have been untimely and, even if they were attached to the brief, they would not have been considered. See Trademark Rule 2.142(d). The Board notes that in the original application, applicant claimed ownership of certain registrations, and the Examining Attorney indicated that a claim of ownership of two of these registrations should be printed. Thus, we deem Registration No. 50,062 for WARNER'S, and No. 1,952,806 for LACY LUXURIES, as well as three other registrations for WARNER'S or WARNER'S in script form to be of record. However, the fact that applicant may own registrations for various WARNER marks, alone or even with additional wording, does not mean that any use of the word WARNER'S with additional wording would create a unitary term.

It is the Examining Attorney's position that the drawing depicts the mark as WARNER'S SIMPLE LUXURIES, but as used in both the original and substitute specimens the words WARNER'S and SIMPLE LUXURIES are so separated that they would not be perceived as a single mark.

We agree. The original specimen<sup>3</sup> is a hangtag on which the words "Simple Luxuries", depicted in upper and lower case and with a "TM" symbol after the word "Luxuries", appears at the top of the hangtag. At the bottom of the hangtag is the word "WARNER'S" depicted in all capital letters in bold type, with a "®" symbol after the word. Between these elements is a large picture of a woman, along with several lines of text, e.g.:

Seamless.  
Sleek.  
Sophisticated.  
And superb  
Stretch-to-fit  
comfort

The manner in which the term "WARNER'S" and "Simple Luxuries" are depicted on the hangtag clearly conveys the impression that they are two separate marks, and applicant

---

<sup>3</sup> Applicant also submitted pages from its Spring 1999 catalog. These catalog pages are very similar to those in its substitute specimens, and we will therefore not discuss this particular specimen in detail, but only note that it suffers the same problems as does the substitute specimen.

does not argue otherwise, but relies instead on its substitute specimen.

The substitute specimen consists of pages from applicant's "WARNER'S® Spring 2000" catalog. The bulk of the relevant page, which is printed with the 11-inch size as the horizontal side, consists of pictures of models wearing bras, with text describing those bras. At the top of the page is a 10-inch black bar on which the word "WARNER'S" appears at the left margin, and the term "Simple Luxuries" appears at the right. "WARNER'S" is less than two inches long; "Simple Luxuries" is approximately two and one half inches long, and the space between these two terms is five inches. As with the hangtag specimen, "WARNER'S" is depicted in all capital letters, and is followed by the "®" symbol; "Simple Luxuries" is in a combination of upper and lower case, and is followed by a "TM" symbol.

These various factors—the difference in type format, the symbols after each term, and most importantly, the physical separation between the terms, which is striking, combine to convey the commercial impression that "WARNER'S" and "Simple Luxuries" are separate marks, not the single mark, WARNER'S SIMPLE LUXURIES, which appears on the drawing page. This impression is further emphasized by the additional page from the catalog which applicant submitted.

It, too, has the format of a black bar across the top of the page, but on this page, while "WARNER'S" appears in the same location and type style as on the other page, the term "Administrative Information" appears on the right side of the bar, in the same location and type style as "Simple Luxuries" does on the earlier page.

We have considered applicant's various arguments, for example, that the black bar unifies the mark's components, and that the viewer's eyes will move from left to right and therefore, with the aid of the solid bar, will immediately go from "WARNER'S" to "Simple Luxuries", but have found them to be unpersuasive for the reasons given above. Although it is true that applicant has depicted its mark as a typed drawing, and therefore is not limited to particular type style, we may look to the type style(s) shown in the specimen to determine whether the specimen evidences usage of the mark shown in the drawing. We also acknowledge that the "®" and "TM" symbols may be used with a mark without causing the mark to be nonunitary. However, what we must do in determining whether a specimen evidences use of a trademark depicted in the drawing is to look at the specimen as a whole, and not necessarily consider whether or not a specific feature changes the commercial impression from unitary to nonunitary, and vice versa. The overall

**Ser No.** 75/661,184

commercial impression created by the usage in the specimens, taking into consideration the black bar but also the physical separation, the different type styles, and the symbols, is that two marks, "WARNER'S" and "Simple Luxuries", are shown, rather than the mark WARNER'S SIMPLE LUXURIES for which applicant has sought registration.

We are also not persuaded by the various cases which applicant has cited. In determining whether specimens show use of the mark depicted in the drawing, it is the particular usage in the specimens at hand that controls, and other decisions, in which the Board has considered different specimens, are of little guidance.

The refusal of registration is affirmed.