

Hearing:  
July 27, 2010

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
August 20, 2010  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diane R. Gunter

Serial No. 77227513

Erik M. Pelton of Erik M. Pelton & Associates, PLLC for  
Diane R. Gunter

Renee McCray, Trademark Examining Attorney, Law Office 111  
(Craig D. Taylor, Managing Attorney).

Before Seeherman, Bucher and Bergsman, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Diane R. Gunter seeks registration on the Principal  
Register of the mark **Wish you were here** (*in standard character  
format*) for "underwear" in International Class 25.<sup>1</sup>

The Trademark Examining Attorney issued a final refusal  
to register this designation based upon Section 2(d) of the  
Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining  
Attorney has taken the position that applicant's mark, when  
used in connection with the identified goods, so resembles  
the following mark:

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<sup>1</sup> Application Serial No. 77227513 was filed on July 11, 2007  
based upon applicant's claims of first use anywhere at least as  
early as May 1, 2006 and first use in commerce at least as early  
as May 31, 2007.



registered for "women's dresses, shirts, skirts and apparel" also in International Class 25,<sup>2</sup> as to be likely to cause confusion, to cause mistake or to deceive.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board. Applicant and the Trademark Examining Attorney filed briefs in this matter, and appeared at a hearing held before this panel of the Board. We reverse the refusal to register.

In support of her refusal, the Trademark Examining Attorney argues that consumers are generally more inclined to focus on the first portion of a mark; that applicant's mark is substantially similar to the registrant's mark as to appearance, pronunciation, meaning and commercial

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<sup>2</sup> Registration No. 3129654 issued to Jetsy, Inc. on August 15, 2006.

impression; that the courts and this Board have specifically found underwear to be related to clothing items included within the rubric of outer clothing; and that the respective goods will move through the same channels of trade to the same classes of ordinary purchasers.

By contrast, in urging registrability, applicant contends that the differences between applicant's and registrant's goods, combined with the stark differences in the marks as to appearance, connotations and overall commercial impressions, prevent any likelihood of confusion between its mark and the cited mark.

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or

services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the *du Pont* factor focusing on the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The Trademark Examining Attorney concludes her brief with the following summary:

The substantial similarities in appearance, sound, connotation and commercial impression engendered by the dominant identical wording in the marks outweigh the slight differences created by the additional wording and design elements in registrant's mark.

Applicant, in turn, argues that "the Examining Attorney does not place proper emphasis on the dominant elements of the cited design mark that are not shared with Applicant's mark, namely the phrase Love Jetsy and the unshared postcard design element, both of which are the dominant features of the cited design mark." Applicant's reply brief at 1.

On this point, we agree with applicant. Registrant's mark is a composite where the image of a postcard is significant, and this postcard serves as background for the arbitrary and prominent words "Love, Jetsy." Yet the Trademark Examining Attorney focuses primarily on the phrase

"Wish you were here!" She argues that because this phrase is the first portion of registrant's mark, it is more likely to be impressed upon a purchaser's memory than words found later in the composite.

However, we cannot agree with the Trademark Examining Attorney's position that the phrase "Wish you were here!" is the dominant element of applicant's mark. As depicted in the drawing, the words "Love, Jetsy" are prominently displayed, comprising the largest element on the card. The words "Love, Jetsy" and the overall postcard design are very noticeable and they have the effect of catching the eye and engaging the viewer before the viewer even looks at the phrase "Wish you were here!" In this context, the "Wish you were here!" phrase is a postcard cliché that acts merely to reinforce the design element of the postcard, and would not otherwise make an impression on the viewer. Because of the strong visual impact of the words "Love, Jetsy" and the postcard design in the cited mark, we find that applicant's mark "Wish you were here" differs significantly in appearance, pronunciation, connotation and commercial impression from registrant's composite mark. *See Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007).

We turn next to the *du Pont* factor of the relatedness of the respective goods. In this regard, the Trademark Examining Attorney argues as follows:

Clearly, shirts and apparel could encompass underwear, as well as t-shirts which may be worn under outerwear. Thus, the goods are similar in nature ...

Again, we are not persuaded by the Trademark Examining Attorney's position. We are not prepared to equate the "shirts" identified in the registration with T-shirts that are worn as underwear, such that the identification of "shirts" encompasses "underwear." Although the term "t-shirt" may identify clothing items that are worn as underwear or as outerwear, the term "shirts" in this case cannot be read so broadly as to include underwear.

Nor do we read the term "apparel" in the identification as encompassing "underwear." We take judicial notice of various dictionary definitions of the word "apparel":

**ap·par·el** -noun

1. clothing, esp. outerwear; garments; attire; raiment.

—**Synonyms** clothes, dress, garb, costume, habiliments, vesture. <sup>3</sup>

**apparel** -n

1. something that covers or adorns, esp outer garments or clothing.<sup>4</sup>

These definitions support the conclusion that "apparel" is not a synonym for "clothing," but rather, that apparel is generally read as meaning "outer garments." This is consistent with the balance of registrant's identification of goods, namely, "dresses, shirts, skirts" - all clearly

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<sup>3</sup> *RANDOM HOUSE DICTIONARY*, 2010.

<sup>4</sup> *COLLINS ENGLISH DICTIONARY*, 10<sup>th</sup> Edition, 2009.

intended to be worn as external/outer items of "street clothing." Further, this interpretation is consistent with Office practice as to the identification of goods. The term "clothing" *per se* is not permitted as an identification of goods as it is considered too broad and indefinite a term. If "apparel" were merely a synonym for "clothing," it would suffer the same infirmity. Thus, we do not treat the registrant's identification of goods as encompassing applicant's goods, and must consider the evidence submitted by the Trademark Examining Attorney to show that the goods are related.

The Trademark Examining Attorney attached to the Office action of October 14, 2008 multiple pages of screenprints from two different websites - one of "MacRAE'S Blue Book - America's Original Industrial Directory Since 1983," as well as "Underwear-Loungewear Factory Directory (CMT Clothing Factories)."

The Internet evidence drawn from these directories relates to clothing manufacturers. These listings indicate that these vendors make, or can make upon request, both underwear and outer clothing. However, this evidence is of very limited probative value as there is no indication that the goods are sold under the same marks, or that the general public would be aware of these listings or of the

manufacturers, the majority of which are not located in the United States.

The Trademark Examining Attorney has also submitted web pages from two online retailers - **OLD NAVY** and **dELiA's**.

The **OLD NAVY** webpage has the following listing:



This left-sidebar menu on Old Navy's online sales page for "Women" shows that Old Navy sells outer (or exterior) clothing and outerwear (e.g., coats, jackets, etc.), as well as women's underwear (e.g., bras, panties, etc.). However, on this record, we cannot know whether, for example, **OLD NAVY** sells both types of goods under different product marks, or whether it uses its house mark with all such clothing items. At most, we view this evidence as showing that underwear and apparel are sold in the same channels of trade to the same classes of purchasers.

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<sup>5</sup> <http://oldnavy.gap.com/browse/division.do?cid=5360>.

Similarly, while it is difficult to decipher, it appears as if the **dELiA's** ad does include the category of "undies" under the Apparel heading.<sup>6</sup>

Either because of an oversight in drafting, or as a means of emphasizing the point, the Trademark Examining Attorney lists twice in her brief (at unnumbered 10 and 12) many of the same cases in the clothing field which have held that many different types of clothing are related under Section 2(d) of the Lanham Act, including Board cases concluding that on the facts of the particular case, underwear is related to street clothes. However, we cannot take judicial notice of facts in earlier reported decisions where the Board may have found goods or trade channels to be related under the facts presented during the litigation of that case.

Thus, the strongest pieces of evidence supporting the position of the Trademark Examining Attorney are the excerpts from the **OLD NAVY** and **dELiA's** websites. However, these two instances of a trade channel overlap between underwear and "women's dresses, shirts, skirts and apparel" is not sufficient to demonstrate that underwear is closely related to registrant's listed goods.

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<sup>6</sup> <http://store.delias.com/browse.do?categoryID=1233&sidenavTrack=apparel.bestof>

We do not suggest that underwear and items of apparel are not related goods. Clearly one might buy underwear to fit under a particular dress or shirt. However, on this record we cannot say that applicant's underwear and the registrant's goods are so closely related that - especially when considered in connection with the strong differences in the marks - consumers are likely to be confused into believing that applicant's underwear and the registrant's items of apparel emanate from the same source.

*Decision:* The refusal to register under Section 2(d) of the Trademark Act is hereby reversed.