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Subject: U.S. TRADEMARK APPLICATION NO. 85262306 - SAGA - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85262306

MARK: SAGA

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GENERAL TRADEMARK INFORMATION:
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TTAB INFORMATION:
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's FINAL refusal to register the mark SAGA and design for "Beach cover-ups; Beach coverups; Beachwear; Swimwear" in view of a likelihood of confusion of the mark **SAGA** for "Wearable garments and clothing not comprised in whole, or in part, of fur, namely, jackets, pants, ski-suits, shirts, hats, bandannas, sweatshirts and hooded sweatshirts, all for use in winter sports, including but not limited to, skiing and snowboarding" in U.S. Registration No. 3833361. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* It is respectfully requested that the refusal be affirmed.

FACTS

On March 9, 2011, applicant filed an application to register the mark SAGA and design for "Beach cover-ups; Beach coverups; Beachwear; Swimwear," in Class 25. On June 8, 2011, the Examining Attorney refused registration of the applied-for mark in view of a likelihood of confusion with the mark that is the subject of U.S. Registration No. 3833361. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq*.

On December 9, 2011, applicant filed a response to the initial Office action arguing against the Section 2(d) refusal to register. On January 6, 2012, the Examining Attorney issued a FINAL refusal to register applicant's proposed mark based on the cited registered mark. On July 5, 2012, applicant filed a Request for Reconsideration and a Notice of Appeal, requesting reconsideration of the FINAL refusal. On July 16, 2012, the Examining Attorney denied applicant's Request for Reconsideration. Applicant filed its Appeal Brief on September 21, 2012 and the Appeal Brief was forwarded to the Examining Attorney on 9/23/12.

ISSUE

The issue on appeal is whether applicant's SAGA and design, when used on or in connection with "Beach cover-ups; Beach coverups; Beachwear; Swimwear" so resembles the registered mark SAGA for "Wearable garments and clothing not comprised in whole, or in part, of fur, namely, jackets, pants, ski-suits, shirts, hats, bandannas, sweatshirts and hooded sweatshirts, all for use in winter sports, including but not limited

to, skiing and snowboarding," such that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant.

ARGUMENTS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the

word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Applicant argues that the marks are dissimilar due to applicant's design feature. Specifically, applicant argues that its sail design conveys to consumers an impression of luxury, wealth and water in addition to a voyage. Moreover, applicant argues that the mark has personal significance since SAGA was the name of a sailboat owned by the parents of one of applicant's members, all of which results in the unique commercial impression of purchasing goods from a highly personalized boutique specializing in beach or swim related goods. Applicant also argues that the mark as a whole creates the impression of a sailboat and that the word portion of its mark is relatively small in comparison to the design portion thereby obviating any possibility of consumer confusion. The examining attorney respectfully disagrees and argues, to the contrary, and notwithstanding applicant's unsupported characterizations of its mark as depicting connotations of luxury and water, the fact remains that the marks are highly similar in view of both parties' usage of the term SAGA. Although marks must be compared in their entireties, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010). For this reason, greater weight is often given to the word portion of marks when determining

whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii).

COMPARISON OF THE GOODS

Applicant argues that the Examining Attorney has not given adequate consideration to the nature of applicant's and registrant's goods in her analysis. The Examining Attorney respectfully disagrees and would argue that to the contrary, the Examining Attorney has given careful consideration to the similarities between the goods of the parties and has provided ample evidence thereof. In fact the differences between the parties' goods was not overlooked in the Examining Attorney's submissions, but rather, was highlighted by the abundance of evidence offered in support of the similarities of the parties' respective goods and their channels of trade.

For example, the examining attorney attached the following website evidence, namely,

http://www.jcrew.com/womens-clothing.jsp

http://www.llbean.com/llb/shop/27

http://www.rei.com/category/4500013

all of which list “swimwear” and “outwear” in addition to items such as “shirts” and “pants” on the same page in their product listings. This type of evidence reflects that not only are such goods are sold or provided through the same trade channels but also that the same entity commonly manufactures, produces and provides the relevant goods, in this case, swimwear and outwear, shirts and pants and related goods **under the same mark**. Therefore, applicant’s argument that the respective goods would not be encountered by consumers through the same trade channels is simply misplaced. Applicant’s additional argument that its consumers are sophisticated is likewise misplaced. Applicant’s argument that “consumers are not likely to confuse Registrant’s mark with that of Applicant” and that “consumers searching for swimwear are not likely to confuse outwear with swimsuits and the like” is not well taken. On the contrary, it is the strong position of the Examining Attorney that consumers will likely be confused by swimwear and outerwear, shirts and pants and related goods, especially if they are marketed by the same manufacturers **utilizing identical word marks**, as has been shown by the evidence of record.

By way of example, the examining attorney’s previously submitted evidence, namely, http://www.llbean.com/llb/shop/27, contains the following language regarding swim suits, namely, “[f]ind your perfect suit . . . [o]ver 40 flattering styles to choose from…” and in the same site, contains the following language evidencing that the company manufactures clothing items such as swim suits and outerwear for every occasion and

season (emphasis added): "Shop L.L. Bean for classic Women's clothing with colorful updates and comfortable styling **for every occasion**. Our versatile Women's apparel takes you from the weekdays right through the weekend, so it's easy to always look your best. **Whatever the season**, you'll find Women's clothes from L.L. Bean that are designed to flatter and finished with care, for value that lasts. We make it simple to put together great women's outfits **all year**, with versatile **tops, sweaters** with feminine detailing and great-fitting skirts, pants and shorts you'll reach for again and again. Our clothing for women includes long-time customer favorites and fresh new takes that make it easy to refresh your wardrobe, **any time**." As the above language indicates, this manufacturer produces clothing items for every season, from swimwear to outerwear, from summer wear to winter wear. Importantly, these items are marketed in the same trade channels utilizing the same mark, which imparts to consumers that they are marketed by the same company, namely, L.L. Bean. It is also important to note that "women's summer outfits" are listed in the same product listing as "outerwear."

Another website previously submitted by the Examining Attorney is that of REI, namely, http://www.rei.com/category/4500013, and contains the following statement: "[l]ook and feel great in women's clothing that keeps pace with your outdoor adventures. Shop women's hiking, travel, fitness and casual clothing from The North Face, REI, Marmont, Columbia, Petagonia, SmartWool and more top brands." This evidence reflects that both casual and summer wear are marketed in the same place as outerwear and therefore travel the same trade channels. For example, "**women's swimwear**" is listed in the same

product listing directly beneath "**women's snowboard jackets"; "women's ski pants"; and "women's snowboard pants**." Moreover, under the category of "Women's Clothing Shops" it is noted that "**Women's Snowboard Clothing**" is listed directly above "**Women's Swimming" items**. In addition to the offering of swimwear, the evidentiary submission reflects a section entitled "Expert Outdoor Advice" which contains sections such as "Expert Advice Articles"; "Outdoor Videos"; and "REI Outdoor School." Clearly, this evidence reflects that swimwear and outdoorwear travel the same trade channels and would be encountered by the same classes of customers.

Likewise, http://www.ralphlauren.com/family/index.jsp?categoryId=1903930&cp=1760781&ab=ln_men_cs1_swim reflects the "Cold Weather Shop"; "Jackets and Outerwear" and "Swim" all within the same product listing clearly traveling the same trade channels.

In addition, the evidentiary submissions taken from Oakley.com, store.Nike.com and Championusa.com all reflect swimwear and outerwear marketed together under the same mark and traveling the same trade channels. Specifically, this evidence supports the Examining Attorney's assertion that the same entity commonly manufactures and provides the goods of both applicant and registrant, namely, swimwear and outerwear, and markets said goods under the same mark. In addition, the evidence establishes that

the goods of applicant and registrant are provided through the same trade channels and used by the same classes of consumers.

It should be noted that evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Moreover, not all of registrant's goods are "highly specialized apparel that can withstand extreme weather conditions and wear," as expressed by applicant. For example, registrant's shirts, bandanas and sweatshirts would not be considered "extreme" type of outerwear as suggested by applicant in describing registrant's goods. Rather, these are more commonplace items that could cause consumer confusion with applicant's swimwear and coverups if marketed by the same company and/or utilizing the same mark thereon.

The goods and/or services of the parties need not be identical or even competitive to find a

likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56

USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d

1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not

related to, one another in kind, the same goods can be related in the mind of the consuming public

as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods and/or services need only be related in some manner or the conditions

surrounding their marketing be such that they will be encountered by the same consumers under

circumstances that would lead to the mistaken belief that the goods and/or services originate from

the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597

(TTAB 2012); TMEP §1207.01(a)(i); s*ee On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at

1086, 56 USPQ2d at 1475; *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68,

223 USPQ 1289, 1290 (Fed. Cir. 1984).

Decisions regarding likelihood of confusion in the clothing field have found many

different types of apparel to be related goods. *Cambridge Rubber Co. v. Cluett, Peabody*

& Co., 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women's boots related

to men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25

USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*,

18 USPQ2d 1386, 1388 (TTAB 1991) (women's pants, blouses, shorts and jackets

related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985)

(women's shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-

99 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

In addition, it appears that applicant has overlooked the abundant listing of third-party registrations submitted with the Examining Attorney's FINAL Office action dated January 6, 2012 wherein a number of smaller boutiques market the identical goods as those offered by applicant and registrant herein utilizing the same mark and clearly traveling the same trade channels.

CONCLUSION

For the reasons set out above, the Examining Attorney respectfully requests that the refusal to register the mark SAGA and design for "Beach cover-ups; Beach coverups; Beachwear; Swimwear" because of a likelihood of confusion with the registered mark SAGA for "Wearable garments and clothing not comprised in whole, or in part, of fur, namely, jackets, pants, ski-suits, shirts, hats, bandannas, sweatshirts and hooded sweatshirts, all for use in winter sports, including but not limited to, skiing and snowboarding" be affirmed.

Respectfully submitted,

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