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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85262306
Applicant	Saga Swimwear LLC
Applied for Mark	SAGA
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Matter:	In re Saga Swimwear, LLC
Applicant:	Saga Swimwear, LLC
Mark:	

Serial No.:	85262306
Filed:	March 9, 2011
Class:	025
Examining Attorney	Erin Falk Law Office 101

APPLICANT'S APPEAL BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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I. DESCRIPTION OF THE RECORD

Applicant hereby submits this brief in support of its appeal from the final refusal to register Applicant's mark:

for "beach cover ups; beach coverups; beachwear; swimwear" in International Class 25. The application for Applicant's mark, United States Trademark Application Serial Number 85262306 was filed with the United States Patent and Trademark Office on March 9, 2011.

Upon reviewing United States Trademark Application Serial Number 85262306, in an Office Action dated June 9, 2011, the Examining Attorney initially refused registration of Applicant's mark SAGA + DESIGN under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), citing United States Registration Number 3833361 for the standard character word mark SAGA covering "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 International Class 025. The Examining Attorney also required that Applicant amend the description of Applicant's mark to provide a more complete description, and to amend the color claim to claim the colors in Applicant's mark as a feature of the mark. The Examining Attorney submitted evidence of third party websites and TARR information about Registrant's mark.

Applicant responded to the first Office Action on December 9, 2011, by submitting the required amendments with regard to the description and color claims on Applicant's mark. Applicant also argued against the likelihood of confusion refusal, submitting printouts from Applicant's website, Registrant's website, and third party use of the word SAGA. After considering Applicant's arguments, the Examining Attorney issued an Office Action, dated January 6, 2012, which made the likelihood of confusion refusal final.

On July 5, 2012, Applicant filed a Request for Reconsideration of the final refusal, including additional website information about Applicant and Registrant, as well as a Notice of Appeal of the refusal to register its mark with the Trademark Trial and Appeal Board (hereinafter "the TTAB") of the United States Patent and Trademark Office.

The Examining Attorney denied Applicant's Request for Reconsideration on July 16, 2012. The Examining Attorney attached links to third party websites that sell a wide variety of clothing.

Pursuant to the TTAB's Order dated July 24, 2012, Applicant now files its brief in support of the appeal to register its composite mark.

II. STATEMENT OF THE ISSUES

At issue is whether consumers are likely to confuse Applicant's mark for "beach cover ups; beach coverups; beachwear; swimwear" 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."

III. RECITATION OF THE FACTS

Applicant Saga Swimwear, LLC, is a limited liability company created under California law. It operates in San Francisco, California, and manufactures and sells swimwear for women exclusively in specialty clothing boutiques and through its own website. Applicant's designs originate in San Francisco, and its products are manufactured in Los Angeles, California.

Applicant is creating a lifestyle brand targeting women who are well educated, independent, and who appreciate high-end, designer clothing made with strong attention to detail. Because Applicant is aware that its target audience places such a premium on design, it deliberately emphasizes this quality in its marketing. For instance, on its website "About" section, submitted with Applicant's Request for Consideration, Applicant explains its philosophy by emphasizing modernity and fashion, while appealing to the romantic aspects of travel:

> We design for the modern jetsetting woman, inspiring her to travel the beautiful world, and to fully experience life within it. From one season to the next, LAX to NRT, our swimsuits carry her free spirit from her flight to the beach, and beyond. At SAGA, we are defining a new era of worldwide mobility, with adventure at the epicenter of it.
>
> Manufactured in Los Angeles, California, with fabrics imported from Italy, SAGA swimsuits are cutting edge modern, hinting at the exotic stories of the world. We are in love with color, form, and connecting our customer to the energy of her lifestyle, the inimitable quality of true spirit she possesses, and the world around her. Style is a reflection of the selves we project onto the world, and ours believes in inspiring epic tales of love, life, and adventure.
>
> At SAGA, it is not the destination that matters, but the journey we take to get there. And we dress women for the journey.

Additionally, Applicant's specialized swimwear products are made with careful attention to aesthetics, often including purely visual, and not functional, design details such as large bows, embellishments, bright colors, and unusual cuts of fabric. *See* Applicant website attached to December 9, 2011, Office Action Response.

To market to its target audience of fashion-conscious, educated, women, Applicant has created an account on popular social media sites such as Facebook, Twitter, and Pinterest. Applicant also maintains a blog and sends monthly newsletters to subscribers. Applicant plans to remain exclusively in the realm of designer swimwear, and is careful to limit growth to maintain the integrity of the brand and its philosophy as described above.

IV. LEGAL ARGUMENT

Applicant's and Registrant's marks and goods are significantly different from each other, so that consumers are not likely to be confused as to their source of origin. The visually dominant design portion of Applicant's mark is likely to leave a distinct impression that is highly distinguishable from Registrant's mark. Moreover, Applicant's and Registrants goods are so unique and specialized that they are not likely to be perceived by

consumers as originating from the same source. Because their respective goods are so unique, they are likely to be marketed to consumers in a way that consumers are not likely to confuse the source of origin of the goods. In addition, Applicant's and Registrant's customers are discriminating purchasers who carefully select the goods provided by Applicant and Registrant so as to prevent any likelihood of confusion between the respective marks. For these reasons, Applicant's mark is entitled to registration.

A. The Likelihood of Confusion Standard

In *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973), the Court of Customs and Patent Appeals described the relevant factors to be considered in a Section 2(d) likelihood of confusion analysis. In its likelihood of confusion analysis, the TTAB must consider all *du Pont* factors for which there is evidence in the record. *Han Beauty Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557 (Fed. Cir. 2001). Although the weight given to the relevant *du Pont* factors may vary, the following two factors are key considerations in any likelihood of confusion determination: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the relatedness of the goods or services as described in the application and registration. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (CCPA 1976). Additionally, in this case, the TTAB should consider the marketing strategies of Applicant and Registrant, and conditions under which sales are made, i.e., "impulse" versus careful, sophisticated purchasing. *See* TMEP § 1207.01(d)(vii).

There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *Du Pont*, 476 F.2d at 1361, 177 USPA at 157. TMEP § 1207.01. In a particular case, any one of the means of comparison may be critical in finding the marks to be similar or dissimilar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987).

i. Applicant's and Registrant's mark are dissimilar in their entireties, thus supporting a finding of no likelihood of confusion.

The marks at issue must be compared in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 73 USPQ2d 1689 (Fed. Cir. 2005). Furthermore, it is the impression that the mark creates as a whole on an average consumer, and not the parts of a mark, that is important. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985).

If, in a comparison of two marks, there is additional material in one mark that is not found in the other, this additional material may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. *See Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USP2d 1844, 1857-58 (TTAB 2008) (finding that although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording, this similarity was outweighed by differences of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In*

re Loew's Theatres, Inc., 218 USPQ 956, 956 (TTAB 1983) (no likelihood of confusion between HERITAGE and DISTINCT BY HERITAGE and Design, both for cigarettes). TMEP § 1207.01(b)(iii). In this case, the Applicant's mark contains a visually dominant and distinctive sail design and sailboat concepts that Registrant's mark does not possess.

When analyzing a composite mark such as Applicant's mark, "there is no general rule as to whether letters or designs will dominate in composite marks, nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Moreover, the comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. *See, e.g., Spice Islands, inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974) (reversing TTAB's holding that SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices, is not likely to cause confusion). TMEP § 1201.01(c)(ii).

When Applicant's and Registrant's marks are examined in their entireties, it is evident that the marks are significantly different. It is also apparent that the Examining Attorney's determination that the word portion of Applicant's mark is the more significant portion was faulty. Applicant's mark is dominated by a sail design element in metallic rose gold with the word SAGA in stylized text underneath. When taken in its entirety, the mark resembles a sailboat with the word portion acting as the boat. In contrast, Registrant's mark consists of the standard character word mark SAGA, with no design element.

In this case, Applicant's mark is distinctive because the mark, in its entirety, creates the distinctive impression of a sailboat: (1) the sail design element dominates most of the mark area, (2) the sail design element conveys a distinct commercial impression independent of the word SAGA (3) the word SAGA is written underneath in small letters relative to the rest of the mark and complements the sail image to resemble a boat.

In Applicant's logo, the design element consisting of two metallic rose gold sails is visually distinctive and dominant. They are located at the top portion of the mark, and cover more than half of the area of the mark. In keeping with Applicant's concept of "American luxury" as expressed on its website, the sail design element conveys a sense of wealth and high social status through use of metallic rose gold coloring. The billowing form of the sail romanticizes the concept of travel, particularly travel related to water. These connotations of luxury and water, which are so critical to Applicant's mark, are noticeably absent from Registrant's standard character mark, which currently conveys only a generalized sense of travel and adventure, and no connotation of luxury.

The word SAGA written in stylized letters extends the sailboat imagery to the entire mark, and makes the word a secondary element of the mark. The word is relatively small in relation to the design element, and appears to compose the boat part of the sailboat that the mark evokes. Because the word SAGA is written in highly stylized lettering, upon quick

glance, it could be easily perceived to be another design element instead of text. Here, the specific stylization that Applicant has chosen for its mark is critical because it is not particularly distinctive in relation to the sail design element. The text stylization melds harmoniously with the sail design element, and the fact that it is text is easily overlooked.

Taken in its entirety, Applicant's mark creates the very distinct impression that it is of a luxury brand focused on dressing consumers for exotic beach- or pool- worthy climates, while Registrant's mark gives only a generalized impression of travel. As discussed above, because of the differences in the respective marks in this case, consumers are able to distinguish between Applicant's mark from that of the Registrant, and there is no likelihood of confusion based on this *du Pont* element.

ii. Applicant's and Registrant's respective goods are highly specialized for different activities, and are thus dissimilar. Consequently, there is no likelihood of confusion among consumers.

In considering whether the Examining Attorney was correct or incorrect in finding a likelihood of confusion, the TTAB should consider whether the Examining Attorney properly focused her analysis on the specific goods offered by Applicant and Registrant, as set forth in the identification for their respective marks, not the international class of goods/services. The Federal Circuit has stated that *the classification of goods and services has* ***no bearing*** *on the question of likelihood of confusion. See Jean Patou, Inc. v. Theon Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. *See*

Nat'l Football League v. Jasper Alliance Corp., 16 USPQ2d 1212, 1216 & n.5 (TTAB 1990). TMEP § 1207.01(d)(v).

The Examining Attorney provided evidence of websites where consumers could purchase both swimwear and outerwear. However, the Examining Attorney failed to note that Applicant's and Register's descriptions of goods are inherently different, despite being in the same class. The description of Applicant's goods is: "beach cover ups; beach coverups; beachwear; swimwear." Registrant's description of goods is "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. [emphasis on "winter sports" added.]"

Registrant's description makes it very clear that all of its apparel is appropriate for use in winter sports. Winter sports, such as skiing and snowboarding, are physically demanding activities, and as a result, require highly specialized apparel that can withstand extreme weather conditions and wear. It is important to note that Registrant does not list in its description just any type of outerwear, as the Examining Attorney seemed to imply in the attachment of third party websites selling outerwear and swimwear. Instead, Registrant's goods are highly specialized performance wear made to withstand extremely difficult conditions. This type of outerwear is likely to attract a certain type of discerning consumer, as discussed below, and diminishes the likelihood of confusion between the two marks.

In contrast, Applicant's description of its goods can be categorized as swimwear. This is a highly specialized type of apparel to be used under a specific set of conditions—at the pool, at the beach, on a boat, or other aquatic, usually warm, environments. The description for Applicant's goods includes no mention of any sport or performance, and certainly no mention of winter. Indeed, Applicant has no plans to ever branch out into high-performance apparel of any kind, or any outerwear at all. In fact, upon examination of Applicant's website, Applicant's goods could almost be considered "anti-performance" beachwear because of their value of aesthetics over function and attention to fine detail, such as the use of imported Italian fabrics, flouncy bows, and unusual cuts. *See* Applicant's website evidence attached to December 9, 2011, Office Action Response. Applicant's goods occupy a unique niche in the apparel industry—designer swimwear. An examination of Applicant's goods, combined with an analysis of Applicant's mark, shows that Applicant intends to occupy the very specific niche of designer swimwear alone. The Examining Attorney, when she submitted evidence of large brands that sell swimwear and outerwear, was incorrect in comparing the present situation to large retail websites. Due to the specialized nature of Applicant's goods and subsequent marketing, as will be discussed below, Applicant's mark will not extend to any area of goods that could be confused with Registrant. There is no relation between Applicant's swimwear and Registrant's performance outerwear.

In light of Registrant's and Applicant's distinct goods, the Examining Attorney was incorrect when she determined that Applicant's niche share was within Registrant's "normal field of expansion" or that consumers were likely to confuse the origins of these

goods. Given these significant distinctions between Registrant's and Applicant's goods, it is highly unlikely that consumers encountering both parties' sets of goods would be confused as to their origins. Even though Examining Attorney cited websites and marks where consumers may purchase both swimwear and outerwear as a reason for refusing registration of Applicant's mark, the highly specialized nature of Registrant's and Applicant's goods was overlooked, and was not given adequate consideration in her analysis.

iii. Applicant and Registrant provide different types of goods to different groups of consumers through different channels of trade, diminishing the likelihood of confusion of their marks.

The Examining Attorney was incorrect in determining that Applicant's and Registrant's goods would be encountered by consumers through the same channels of trade. In a likelihood of confusion analysis, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 21 USPQ2d 1388, 954 F.2d 713 (Fed. Cir. 1992) (no likelihood of confusion between two EDS marks for goods and services sold to different consumers within the same organization); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener not held confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986)

(QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field).

A review of Applicant's goods, Applicant's mark, and Applicant's website makes it apparent that Applicant focuses its marketing on independent, educated, fashion-conscious, young, urban women who enjoy foreign travel. Applicant's unique goods are likely to appeal to women who are aware of designer, luxury brands, and who assign a premium to independent designs and specialty products. Applicant achieves this in part by strongly evoking luxury in its mark, by using avant-garde fashion photography in its marketing, and by sharing its unique story with website visitors in its "About" section. Applicant's website, in its "About" section, also refers to itself as "an American luxury." *See* Applicant website printouts attached to Response to Office Action and Request for Reconsideration. Applicant makes its products available to consumers who are likely to share these values about designer, luxury clothing, such as through specialty boutiques, and fine clothing retailers.

In contrast, Registrant's goods and "Contact" page of its website show that its target audience is athletic, active, outdoor-loving consumers, , primarily males, including "the most demanding and active teams in snow." See registrant website evidence attached to Request for Reconsideration. Registrant also expressly states that "all of [its] gear maintains a focus on function and performance," a sharp contrast to the Applicant, who expressly states that it is "in love" with color and form. See website evidence attached to Request for Reconsideration. Registrant claims to have roots in Montana, Oregon, and Utah,

and to be inspired by the "Mountain-West" lifestyle. *Id*. These regions of the United States are known for their rugged natural terrain, often conducive to outdoor sporting activities. Registrant's products are thus more likely to be marketed differently from Applicant's, and focus on public relations and marketing outlets that attract athletic, outdoor-loving consumers. In contrast, for Applicant to attract its target audience of fashionable, urban, young women, its marketing tactics are more likely to focus on fashion events and publications in urban, fashion-conscious geographical areas, such as Los Angeles, San Francisco (where Applicant is based), New York, and similar cities.

Because Applicant's and Registrant's goods are geared to different consuming groups (fashion-loving, young women v. active, outdoor-loving athletes), they would clearly be promoted differently and sold through different channels of trade, weighing strongly against any likelihood of confusion.

iv. Applicant's and Registrant's goods are provided to sophisticated consumers making careful purchasing decisions who are not likely to confuse the origin of the parties' goods.

The conditions under which sales are made, and the buyers to whom those sales are made (i.e. "impulse" v. careful, discriminating purchasing), is another factor to be taken into consideration in determining the likelihood of confusion between two marks. The Federal Circuit has recognized the importance of the level of sophistication of purchasers in the likelihood of confusion analysis by stating, "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 21 USPQ2d 1388, 954 F.2d 713

(Fed. Cir. 1992). Circumstances suggesting care in purchasing tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). TMEP § 1201.01(d)(vii).

Applicant's and Registrant's consumers are discriminating purchasers who, only make their respective purchases after careful consideration of a number of factors, including: (1) the activities they intend to engage in wearing the relevant apparel, (2) their own preferences for fashion or functionality, (3) the level of physical athleticism involved in their chosen activities. Because Applicant and Registrant each offer unique, highly specialized apparel with different design and marketing objectives, consumers are likely to easily notice the differences between the two.

Because Applicant's and Registrant's goods are designed to appeal to different groups of consumers with strong, different sets of values and preferences, it is highly unlikely that they will be confused when they come across these dissimilar marks. Applicant's consumers—urban, educated, fashion-conscious women—are very likely to pay strong attention to the details of the clothing they purchase, including company and designer history. These consumers will search for, and Applicant does offer, a history of Applicant's development. Consumers will learn, for instance, that the sailboat design is

inspired by a sailboat owned by the family of one of Applicant's members. Knowing that Applicant takes such care in cultivating its collection and philosophy, consumers are not likely to confuse Registrant's mark with that of Applicant. Additionally, consumers searching for swimwear are not likely to confuse outerwear with swimsuits and the like.

Similarly, because Registrant offers performance-based apparel, consumers are likely to be highly discerning before purchasing. Consumers interested in Registrant's goods are physically active and seek apparel that will survive extreme weather conditions, falls, and strenuous athleticism. Because Registrant's consumers are engaging in such risky activity, they are more likely to research and compare the performance of a number of options before choosing any one. If they were to encounter both Applicant's and Registrant's marks and goods, they would easily be able to determine that Applicant's goods are swimwear, not outerwear, and that Applicant's goods do not meet the performance standards that Registrant makes a strong effort to convey in its marketing.

In light of a significant level of consumer discernment used when purchasing swimwear and outerwear, there is no likelihood of confusion between Applicant's and Registrant's marks.

V. SUMMARY

The Court of Customs and Patent Appeals, later quoted by the Federal Circuit in *Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation*, 21 USPQ2d at 1391,

954 F.2d at 717, has provided the TTAB with practical guidance for resolving the likelihood of confusion issues by stating:

> We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimus* situations but with the practicalities of the commercial world, with which the trademark laws deal. Witco Chem. Co. v. Whitfield Chem. Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

In the present case, a number of practical realities demonstrate there is no likelihood of confusion. First, the marks at issue are significantly different, and Applicant's mark creates a strongly distinct commercial impression as opposed to Registrant's generalized one. Second, Applicant's and Registrant's goods are highly specialized, and not likely to be confused by consumers. Third, Applicant's and Registrant's goods are marketed to two distinct consumer groups through nearly mutually exclusive trade channels, so consumers are not likely to encounter both companies' marks and goods together. Lastly, Applicant's and Registrant's respective consumers are highly sophisticated, either because of a strong awareness of brands and luxury designs, or because they seek performance wear for a highly athletic activity. In light of these considerations, Saga Swimwear respectfully requests that the TTAB reverse the Examining Attorney's refusal to register its mark.

Respectfully submitted,

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