

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Michael D. Mathes

Serial No. 85892299

Steven E. Eisenberg of Lipscomb Eisenberg & Baker PL,
for Michael D. Mathes.

Simon Teng, Trademark Examining Attorney, Law Office 105,
Susan Hayash, Managing Attorney.

Before Bucher, Kuhlke and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Michael D. Mathes (“Applicant”), an individual, has filed an application¹ to register on the Principal Register the mark set forth below for “Swimsuits; Swimwear excluding T-shirts, polo shirts, tank tops, hats, visors, aprons,” in International Class 25.



¹ Application Serial No. 85892299, filed April 1, 2013, under Trademark Act § 1(a), 15 U.S.C. § 1051(a), claiming May 11, 1994, as the date of first use and the date of first use in commerce.

Applicant has disclaimed the exclusive right to use the word “Swimwear” apart from the mark as shown. Color is not claimed as a feature of the mark. Applicant claims that the mark has become distinctive of the goods through Applicant’s substantially exclusive and continuous use in commerce for at least five years.² See Trademark Act § 2(f), 15 U.S.C. § 1052(f).³

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as used in connection with Applicant’s goods, so resembles the registered mark SOUTH BEACH WINE & FOOD FESTIVAL. The cited mark is registered in standard characters for “T-shirts, polo shirts, tank tops, hats, visors, aprons” in International Class 25 and “posters” in International Class 16.⁴ When the refusal was made final, Applicant filed a notice of appeal and a request for reconsideration. Upon the Examining Attorney’s denial of the request for reconsideration, this appeal resumed. Applicant and the Examining Attorney have filed briefs and Applicant has filed a reply brief.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

² Response filed October 29, 2013.

³ Applicant entered its claim under Section 2(f) in response to the Examining Attorney’s refusal to register the mark under Trademark Act § 2(e)(2), 15 U.S.C. § 1052(e)(2), on the ground that the mark is primarily geographically descriptive. The Examining Attorney has withdrawn that refusal.

⁴ Registration No. 3864216 issued October 19, 2010. The cited registration issued on the basis of a claim of acquired distinctiveness under Section 2(f).

1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In the present case, Applicant and the Examining Attorney also have presented evidence and arguments relating to trade channels, classes of customers, conditions of sale, and existence of similar third-party marks.

(a) The goods.

We will consider first the similarity or dissimilarity of the goods of Applicant and Registrant. The goods at issue are not identical, but the Examining Attorney contends that Applicant's swimwear and Registrant's apparel are closely related. The Examining Attorney has submitted substantial evidence in the form of Internet webpages⁵ demonstrating that goods of the types identified in the application and the registration have been offered by a single company under the same trademark. For example, the evidence shows swimsuits and T-shirts offered under the marks NIKE, UNDER ARMOUR, ADIDAS, GAP, HOLLISTER, and OAKLEY. Moreover, it is apparent that swimwear and T-shirts are both commonplace, casual apparel items known to most ordinary consumers, and that they are types of apparel that might be worn together. The Examining Attorney's evidence is sufficient to persuade us that if customers were to encounter swimwear and T-shirts offered

⁵ Office Action of July 15, 2013 at 13-28; Office Action of November 19, 2013 at 9-76; Office Action of June 5, 2014 at 7-124.

under highly similar marks, they would be likely to believe that such goods emanate from a single source.

There is no need for us to consider whether Applicant's swimsuits and swimwear are similar to the other goods listed in the registration (*i.e.*, polo shirts, tank tops, hats, visors, aprons, and posters). In the context of an analysis under Section 2(d) where all of the goods in the application are within one International Class, it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Accordingly, we find that the *du Pont* factor of the similarity or dissimilarity of the goods favors a finding of likelihood of confusion.

(b) Trade channels.

The Examining Attorney argues that since the application and registration "contain[] no limitations or restrictions as to trade channels, the identified goods of both parties are 'presumed to travel in the same channels of trade to the same class of purchasers.'"⁶ We question whether the goods at issue are sufficiently closely related to justify such a presumption in this case. However, the Internet evidence cited above demonstrates that swimwear moves through at least one trade channel in which T-shirts, tank tops, and other shirts similar in general nature to those of Registrant are also present, namely online retail stores featuring apparel or

⁶ Examining Attorney's brief, 25 TTABVUE 7.

sporting goods. For example, the evidence shows that such goods are offered together on the retail websites of GAP, Kohl's, Target, JCPenny and Macy's.⁷ Such evidence is sufficient to persuade us that the trade channels for the goods of Applicant and Registrant are, at least in part, the same.

Applicant has argued:

... Applicant's trade channels are limited to a person by person basis. Registrant's trade channels are sales via the festival event and through one unaffiliated website, neither of which sells swimwear. ... Because Applicant does not advertise or sell his goods via the Registrant's website or at the Registrant's annual festival, their goods are not likely to be found in close proximity of each other. ... [The goods of Applicant and Registrant] will not cross paths as far as the channels of distribution.⁸

These arguments are unavailing. The relevant question is not whether the specific goods of Applicant and Registrant are actually marketed in the same trade channels. It is whether goods of the types identified in the application and the registration are typically marketed in the same or related channels. *See Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."). As the Examining Attorney noted, neither the application nor the cited registration indicates any limitations as to channels of

⁷ Office Action of November 19, 2013 at 22-31; Office Action of June 5, 2014 at 21-60.

⁸ Applicant's reply brief at 4, 26 TTABVue 5.

trade. We therefore presume that the identified goods move in all channels of trade normal for those goods. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Those channels of trade would include clothing stores, department stores, sporting goods stores, and the types of online retail stores shown in the Examining Attorney's evidence. Accordingly, we find that the *du Pont* factor of "established, likely-to-continue trade channels" weighs in favor of a finding of likelihood of confusion.

(c) Customers and conditions of sale.

Applicant contends that its customers are sophisticated and exercise a sufficient degree of care to obviate any likelihood of confusion. "Applicant's products specifically target consumers interested in swimwear and nothing else. These consumers are considered to be detail oriented consumers looking for swimsuits; as opposed to Registrant's consumers who are interested in t-shirts, aprons and the like in connection with a festival that happens once a year." Other than Applicant's argument, there is no evidence of record to suggest that the relevant customers are more sophisticated or careful than average consumers. Nor is there any evidence to suggest that the customer classes for Applicant's goods are distinct from the customer classes for Registrant's goods. We also cannot assume that Registrant's goods would be sold only in connection with a festival, or that they would be sold only once a year. Rather, we must presume that Registrant's goods would be sold

under normal retail conditions found in the types of stores that offer such goods. Accordingly, we find the *du Pont* factor of the customers to whom and the conditions under which sales are made to be neutral.

(d) The marks.

Next we consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). While we consider each mark in its entirety, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The Examining Attorney contends that SOUTH BEACH is the “dominant and most significant feature of applicant’s and registrant’s marks, not only because it appears first in the marks ... , but also it has stronger source-identifying potential than the other elements of the marks.”⁹ He points out that Applicant has disclaimed SWIMWEAR, and that WINE & FOOD FESTIVAL “immediately conveys to consumers that registrant’s products are sold at a social event, namely, festivals about wine and food.”¹⁰ Applicant, for his part, points out the obvious visual and phonetic differences between the marks and contends that they create different commercial impressions.

⁹ Examining Attorney’s brief, 25 TTABVUE 4.

¹⁰ *Id.*

We note initially, as to both marks, that the record shows that SOUTH BEACH is inherently a weak source indicator because it is geographically descriptive, identifying a well-known neighborhood of Miami Beach, Florida.¹¹ Customers would therefore readily entertain the possibility that the term SOUTH BEACH might be adopted by any merchant located in the South Beach neighborhood.

Nonetheless we agree that SOUTH BEACH is the dominant portion of Applicant's mark, because SWIMWEAR is the generic name of the goods and, alone, has no source-indicating capacity.

We do not agree, however, that SOUTH BEACH is necessarily the dominant portion of Registrant's mark. We note that SOUTH BEACH is the initial term of the registered mark and, accordingly, will be noticed by customers. *Palm Bay Imports*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). However, the designation WINE & FOOD FESTIVAL is *not* the generic name of Registrant's identified goods, which are primarily items of apparel; and to the extent that this phrase is descriptive (as noted above, the entire mark is registered under Section 2(f)), it conveys information not about the nature of the goods, but about the goods' association with an event, a festival featuring not apparel, but wine and food. In this regard, Registrant's mark differs from Applicant's mark, in which SOUTH BEACH is combined with the generic term SWIMWEAR, a term that, in itself, is utterly incapable of indicating the source of Applicant's swimwear. The added wording in

¹¹ Office Action of July 15, 2013 at 28-38.

Registrant's mark is not as weak as the added wording in Applicant's mark; WINE & FOOD FESTIVAL plays a more important function in identifying the source of Registrant's goods than does the word SWIMWEAR in Applicant's mark. We find that SOUTH BEACH and WINE & FOOD FESTIVAL, as applied to Registrant's goods, are of roughly equal distinctiveness, such that SOUTH BEACH does not merit more weight in our consideration of the mark in its entirety.

Even though the two marks at issue have obvious similarities, we find that they create very different commercial impressions when they are considered in their entireties in the context of the offered goods. Applicant's mark would be perceived as a brand of swimwear identified by the designation SOUTH BEACH. Registrant's mark would be perceived as identifying apparel that is offered in association with a festival, focusing on wine and food, that ostensibly takes place in the neighborhood of South Beach. Because of these differences in commercial impression, the distinction between the wording SWIMWEAR and WINE & FOOD FESTIVAL warrants attention in our determination of whether the marks are likely to engender confusion. We agree with Applicant's argument that "consumers will not expect to find [swimwear] in a food related event."¹² One would not expect swimwear to be on sale – or featured in any way – at a wine and food festival and there is no evidence to the contrary. Moreover, in the context of swimwear the words WINE & FOOD are arbitrary and incongruous. There is sufficient disjunction between the ideas suggested by the plain meaning of the words SOUTH BEACH

¹² Applicant's reply brief at 2, 26 TTABVUE 3.

SWIMWEAR and SOUTH BEACH WINE & FOOD FESTIVAL that we think it highly unlikely that customers of apparel would perceive a commercial relationship between these two brands. Accordingly, we find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

(e) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein,¹³ and all relevant *du Pont* factors. In view of the different commercial impressions created by the marks at issue when considered in the context of the identified goods, we find that Applicant's mark is not likely to cause confusion, mistake or deception as to the source of Applicant's goods.

Decision: The refusal to register is reversed.

¹³ In view of our determination, we find it unnecessary to consider Applicant's arguments and evidence relating to the existence of purportedly similar registered marks.