ESTTA Tracking number: **ESTTA211122**
Filing date: **05/13/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177192
Party	Defendant Martanna LLC
Correspondence Address	HOWARD G. SLAVIT SAUL EWING LLP SUITE 1000, THE WATERGATE WASHINGTON, DC 20037-1922 UNITED STATES hslavit@saul.com, sbates@saul.com, okolawole@saul.com
Submission	Reply in Support of Motion
Filer's Name	Olamide Kolawole
Filer's e-mail	okolawole@saul.com,srutngamlug@saul.com,hslavit@saul.com
Signature	/olamide kolawole/
Date	05/13/2008
Attachments	int887F.PDF (13 pages)(205250 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NAUTICA APPAREL, INC.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91177192
v.	)	
	)	
MARTANNA L.C.,	)	
	)	
Applicant.	)	

APPLICANT MARTANNA L.C.'S REPLY IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND OPPOSITION TO NAUTICA APPAREL, INC.'S COUNTERMOTION FOR SUMMARY JUDGMENT

Applicant Martanna L.C. ("Martanna" or "Applicant"), by counsel, submits its reply in further support of its motion for summary judgment and opposition to Nautica Apparel, Inc.'s ("Opposer" or "Nautica") Countermotion for Summary Judgment.[1] Martanna states the following in support of its reply and opposition:

I. Nautica Has Improperly Attempted to Shift the Board's Focus Away from the Determinative Issue in this Proceeding

The most notable feature of the brief that Nautica Apparel, Inc. (hereinafter "Nautica" or "Opposer") filed[2] in response to the motion for summary judgment filed by Martanna L.C. (hereinafter "Martanna" or "Applicant")[3] is its many pages devoted to establishing the fame of Nautica's marks, an argument which Nautica chose to supplement with perhaps six thousand

---

[1] Opposer served its *Response Brief* on Applicant by first-class mail, and the date of mailing for that document was April 23, 2008. Consequently, the instant document is timely filed pursuant to the filing period for reply briefs described at 37 C.F.R. §2.127(a) and the additional time permitted by 37 C.F.R. §2.119(c) for actions in response to documents served by first-class mail. In addition, because the instant document is both a reply brief and an opposition/response to Opposer's countermotion for summary judgment, Martanna respectfully submits that the page length of this document complies with the relevant rules.

[2] *Opposer's Brief in Response to Applicant's Motion for Summary Judgment and Opposer's Countermotion for Summary Judgment* (April 23, 2008) ("*Opposer's Response Brief*").

[3] *Applicant Martanna L.C.'s Motion for Summary Judgment and Memorandum in Support Thereof* (March 20, 2008) ("*Martanna's Motion for Summary Judgment*").

pages of exhibits. Martanna can only conclude that Nautica has placed such an exaggerated emphasis on this argument in an attempt to distract the Board's attention from what is in fact the dispositive issue in this proceeding: the dissimilarity between Martanna's GET NAUTI mark and any of the marks cited by Nautica in its opposition.[4] As demonstrated herein, Nautica's arguments on this central issue, when considered without the smoke and mirrors Nautica has employed, are weak.

In essence, Nautica contends that any mark which incorporates the letters NAUT or NAUTI – regardless of how or in what context it is used – is likely to confuse prospective consumers into thinking that Nautica is the source of the relevant goods.[5] While the group of letters NAUT appears at the beginning of all of the marks Nautica cites in its opposition, and while the group of letters NAUTI appears at the beginning of all but one of these marks, an objective observation demonstrates that the common prefix of Opposer's marks is, in fact, the group of letters NAUTICA.[6] Not surprisingly, Opposer's claim that its marks are famous is limited to the mark NAUTICA.[7] The letters NAUT or NAUTI are no more source-identifying prefixes for Nautica's marks than the letters NA. (If they were, Nautica surely would have bolstered its likelihood of confusion argument by claiming that one of these shared "prefixes" established a "family of marks," but it has not, and the facts do not support such a claim.) Clearly, Martanna's GET NAUTI mark does not share the prefix NAUTICA with Nautica's

---

[4] *See In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563, 567 (C.C.P.A. 1973)* ("*DuPont*") ("In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." This statement is referred to hereinafter as the "first *DuPont* factor.")

[5] *Opposer's Response Brief* at 2 and 7.

[6] The fact that one mark (NAUTEX) out of the scores of marks that Nautica has cited in this proceeding does not include all of the letters NAUTICA cannot reasonably be said to affect this observation.

[7] Consistent with its "distraction-by-bluster" approach in this proceeding, Nautica cited twenty-five (25) separate registrations and applications for the word mark NAUTICA in its Notice of Opposition.

marks. Moreover, while GET NAUTI includes some of the same letters as Nautica's marks, it uses those letters in a wholly different manner that creates a commercial impression that is unique and unrelated to that of any of Nautica's marks. Nautica's reams of exhibits regarding the claimed fame of its mark fail to undermine the significance of the many and substantial differences between these marks, which is the matter at the heart of this proceeding.

Considering the facts presented in this preceding,[8] because the mark GET NAUTI is so substantially different than any of Opposer's marks, the first *DuPont* factor unquestionably favors Martanna and outweighs any of the other factors that might be in dispute or weigh in Nautica's favor.[9] Summary judgment should be granted in Martanna's favor, and Opposer's countermotion for summary judgment should be denied.

II. Opposer Does Not Have Priority in All of the Marks Cited in Its Opposition

Opposer states it its *Response Brief* that it "has proven ownership of a number of incontestable registrations for NAUTICA in Classes 3 and 25, registered long-prior to the filing of the ITU application at issue, thus making priority of use of Nautica's Marks a moot point."[10] Of course, this is an overstatement, and fails to address the legal authority that Applicant cited on the issue of priority based on date of constructive use. For example, as Applicant discussed in its motion and brief,[11] nine of the marks that Nautica cited as support for its likelihood of confusion argument were the subject of pending intent-to-use applications filed after Applicant's

---

8 "[E]ach case must be decided on its own facts." *DuPont*, *476 F.2d at 1361, 177 U.S.P.Q. at 567.*

9 Opposer argues that the Board should view several of the *DuPont* factors in its favor. However, even if Nautica were able to prove its assertions under these factors at trial, "that evidence would be insufficient to show likelihood of confusion because 'the first *DuPont* factor simply outweighs all of the others which might be pertinent to this case.'" *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2D 1142, 1146.

10 *Opposer's Response Brief* at 5, *emphasis added.*

11 *Martanna's Motion for Summary Judgment* at 5-6.

application. These nine marks include the one mark cited by Nautica that arguably could be said to incorporate a prefix of "nauti", NAUTICARE.[12] Thus, far from being a moot point, Nautica simply does not have priority in its marks whose dates of use fall after the constructive date of use established by the GET NAUTI application. We ask that the Board take this fact into account and appropriately discount Opposer's broad claims. Because Nautica does not have priority in these marks, we submit that Applicant is entitled to summary judgment with respect to Opposer's claims of priority and likelihood of confusion based on these marks.

III. Opposer Has Failed to Introduce Reasonable Arguments to Challenge the Determinative Significance of the Dissimilarity between Nautica's Marks and Martanna's GET NAUTI Mark to the Likelihood of Confusion Analysis

A. Opposer Has Not Countered Martanna's Arguments Regarding the Differences in Appearance, Sound, Meaning, and Commercial Impression Between GET NAUTI and Any of Nautica's Marks

Opposer begins its attempt to rebut the several elements of Martanna's analysis of the first *DuPont* factor with a disjointed argument regarding the supposed meaning of Applicant's mark. According to Nautica, GET NAUTI prescribes an instruction to the consumer to get, that is, obtain, some thing, namely "NAUTI (NAUTICA)". The concessions and logical leaps incorporated in this proposition should be examined individually.

First, in offering this explanation, Opposer concedes that a consumer would read GET NAUTI as an imperative expression, an instruction exhorting the consumer to do something. As Applicant argued in its motion and brief, "none of Opposer's Marks contain a verb, none of Opposer's Marks are structured as a sentence, and none of Opposer's Marks, therefore, are

[12] It appears that after Martanna filed its Motion for Summary Judgment, the U.S. Patent and Trademark Office accepted a statement of use regarding Opposer's application to register its NAUTICARE mark. However, the date of use cited by the Opposer was February 2008, so Martanna's point remains valid: this mark does not have priority because Martanna's constructive use date for GET NAUTI precedes both the application and actual use date for NAUTICARE. *Id.*

structured as an imperative sentence."[13] Nautica has not attempted to deny these facts, which highlight several of the fundamental differences in appearance, sound, meaning and commercial impression between GET NAUTI and any of Opposer's marks.

Second, Opposer implies that a consumer reading the mark GET NAUTI would understand that the thing that it should get is NAUTI, which the consumer would further understand is another word for NAUTICA. This is preposterous. Opposer has provided absolutely no support for a contention that customers associate NAUTI – particularly when used as a stand-alone 5-letter word – to have any connection to NAUTICA, much less that consumers do or would understand the meaning of NAUTI to be goods bearing the NAUTICA mark.

Third, on one hand, Opposer asserts that the meaning of Applicant's mark is an instruction to a consumer to get "NAUTI(NAUTICA)," which Opposer argues is a thing that "could be obtained, for example, by purchase." On the other hand, Opposer argues that "nauti" is an adjective meaning "nautical" -- but it stops short of making the absurd statement, which would follow from its previous analysis, that a consumer would read GET NAUTI to mean "obtain nautical." Opposer cannot have it both ways.

A fundamental and irrefutable difference in the appearance, sound, meaning and commercial impression of GET NAUTI – viewed in its entirety -- as compared to any of Nautica's marks is the fact that NAUTI is used as a separate word, the second of two words that Opposer concedes would be read as a short imperative sentence.[14] We reiterate that, in viewing

---

[13] *Martanna's Motion for Summary Judgment* at 11. These statements are true, as well, with respect to the 19 "challenged marks" that Opposer referenced in the *Declaration of Neil B. Friedman* which it attached to its *Response Brief* ("*Friedman Declaration*"), and which are addressed further, *infra*.

[14] Other fundamental differences in the appearances and sounds of these marks include (1) that in contrast with GET NAUTI, all of Nautica's multi-word marks begin with the word NAUTICA and (2) that all of Nautica's single-word marks, with the exception of NAUTEX, either consist of or begin with the letters NAUTICA. These differences, as well, greatly reduce the likelihood that a consumer would mistakenly understand that goods bearing the GET NAUTI mark have any connection to Nautica or its marks.

the mark GET NAUTI, prospective customers would pronounce the second word as "naughty", that is, with a long "E" sound.[15] Opposer did not and could not reasonably challenge Applicant's argument on this point, nor did it challenge our statement that "of the 43 of Opposer's Marks that include the letters N-A-U-T-I, the letter 'I' is pronounced as a short 'i' or schwa sound."[16] Nevertheless, and inexplicably, Opposer states that the second word in GET NAUTI and the mark NAUTICA are "pronounced in a similar fashion."[17] This is plainly incorrect.

Thus, the context in which the word NAUTI appears in Applicant's mark (as a stand-alone word) determines its sound (whether actually spoken or understood), and it is this sound that conveys its meaning. This is not, as Opposer claims, "[t]he Applicant's assertion regarding what it intended its mark to mean."[18] Rather, we submit that no English-speaking consumer encountering the mark GET NAUTI would pronounce these words in any other way but "get naughty." Opposer states, without support, that "'NAUTI' draws a first and primary connection with the term 'nautical'",[19] but this simply is not true in every potential context in which those letters appear. In reading GET NAUTI, prospective customers hear "get naughty", and the meaning of this call to action carries a commercial impression that is unrelated to that conveyed by any of Nautica's marks. Consequently, any confusion as to the source of Applicant's goods is highly unlikely.

---

15 *Martanna's Motion for Summary Judgment* at 10 and 11.

16 *Id.* at 10.

17 *Opposer's Response Brief* at 7.

18 *Id.*

19 *Id.* at 7. Opposer attempts to support this view by stating that "various of the goods recited in the application in issue concern the beach, water, boating and the like." However, the great majority of Applicant's goods do not.

B. Opposer Argues that its Mark NAUTICA Is Famous, but Any Such Fame Cannot Overcome the Dissimilarity Between GET NAUTI and Opposer's Marks Including NAUTICA

Opposer's *Response Brief* (and its several boxes of exhibits) focuses on the fame that Nautica claims one of its marks – NAUTICA – has acquired. Opposer has not claimed or provided evidence indicating that any of its other marks are famous, and Applicant submits that they are not. Consequently, to the extent that the Board accepts Opposer's argument regarding the fame of NAUTICA[20] and considers this fame as a *DuPont* factor in favor of the Opposer, Martanna requests that the Board only consider this factor when evaluating the likelihood of confusion between Applicant's mark GET NAUTI and the mark NAUTICA.

To support its argument regarding the fame of its NAUTICA mark, Opposer cites to *Kenner Parker Toys v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992) ("*Kenner*"). In particular, Opposer references that court's statements that "[t]he fifth *DuPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark," and that "a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark." *Id.* at 352-53. However, the *Kenner* court does not state, as Opposer implies, that if the prior mark is demonstrated to be famous, that fame is dispositive in any analysis of likelihood of confusion under the *DuPont* factors. Rather, the court explained that a mark's fame merely serves to magnify the significance of any of the similarities that might exist between the marks being compared. In *Kenner*, unlike the instant proceeding, the similarities between the marks were great.

[20] Contrary to Opposer's statement, Martanna did not "assume" that "the NAUTICA mark is famous" in its motion for summary judgment and brief, except for the sake of argument. *Id.* at 4.

The two marks at issue were Kenner's mark PLAY-DOH and the applicant, Rose Art's mark FUNDOUGH, both used for modeling compound. The court found in analyzing these marks that

> PLAY and FUN, in the overall context of these competing marks, convey a very similar impression. Both are single syllable words associated closely in meaning. Particularly in the context of a child's toy, the concepts of fun and play tend to merge.[21]

The court also observed that

> [t]he single-syllable suffixes DOH and DOUGH sound the same. In light of a modern trend to simplify the spelling of "gh" words, consumers may even perceive one as an interchangeable abbreviation for the other,[22]

and found that there were "dangers that consumers may receive the same commercial impression from both marks."[23]

In contrast to *Kenner*, Opposer has failed to present a convincing argument that its mark NAUTICA is similar in any substantial manner to Martanna's mark GET NAUTI. As Applicant has explained in detail in its motion and brief, these marks look different, sound different, have different meanings (the applicant's meaning being conveyed by its different sound) and convey different commercial impressions. Consequently, even if the fame of NAUTICA affected the Board's analysis by magnifying the insignificant degree of similarity that may exist between these two marks, we submit that the marks remain so dissimilar that the first *DuPont* factor remains dispositive in favor of Martanna.

This conclusion, that dissimilarity in other *DuPont* factors can overcome a finding of fame, is supported by the opinion in *Burns Philp Food, Inc. v. Modern Products, Inc.*, 28

---

21 *Kenner* at 354.

22 *Id.* at 355.

23 *Id.* (footnote omitted).

U.S.P.Q.2D 1687 (Fed. Cir. 1993) ("*Burns Philp Food*"). In that case, the court determined that the Board did not err in finding, after "giving great weight to the fame of the opposer's mark" that the marks SPICE ISLANDS and SPICE GARDEN, both for the identical product, spices, "were significantly different in sight, sound, appearance, meaning, connotation and commercial impression."[24] Based on these differences, the Board concluded that there was no likelihood of confusion. In upholding this conclusion, the court stated the following:

> [t]hat the fame of an opposer's mark can sometimes be dispositive as in *Kenner, 963 F.2d at 356, 22 USPQ2d at 1458*, does not mean that other factors are not significant or may not outweigh fame. Because the commercial impressions of the marks were found to be so different and because applicant's mark with design as sought to be registered is so limited in shape, color and appearance, greatly reducing any likelihood of confusion in the marketplace, the finding of dissimilar commercial impressions is entitled to great weight. Indeed, on the particular facts of this case, we are not persuaded that the Board erred in its finding that the difference in commercial impression of the marks, along with the factors of dissimilar sight, sound, connotation and meaning, is significant enough to outweigh the fame of opposer's mark.[25]

As Applicant argued in its motion and brief, in the instant proceeding as in *Burns Philp Food*, the first *DuPont* factor is dispositive and demonstrates that the likelihood of confusion between GET NAUTI and Opposer's marks is *de minimis*. This factor outweighs the fame that Opposer claims for its NAUTICA mark.[26]

---

[24] *Burns Philp Food* at 1702.

[25] *Id.* (*emphasis added*).

[26] *See Kellogg*, 951 F.2d at 332-333, 21 U.S.P.Q.2D at 1148 (holding that the Board considered the "preeminence of Kellogg in the cereal market and the large amounts Kellogg has spent on advertising and has collected in sales revenues," and still justifiably concluded that the "substantial and undisputed differences in the 'appearance, sound, connotation and commercial impression'" between Kellogg's FROOT LOOPS and the applicant's FROOTEE ICE mark warranted the grant of summary judgment that there was no likelihood that these marks' "contemporaneous use by different parties will result in confusion." The court stated explicitly that the Board correctly ruled that "a single *DuPont* factor – the dissimilarity of the marks -- was dispositive of the likelihood of confusion issue.")

IV. Opposer's Claim of Dilution Fails Due to the Dissimilarity of the Marks - a Fact that Fame Cannot Overcome

For purposes of both likelihood of confusion and dilution, Opposer argues that its mark NAUTICA "meets all the criteria for being a 'famous' mark."[27] However, we submit that Opposer's argument regarding dilution by blurring must fail because GET NAUTI is so dissimilar from NAUTICA. Opposer breezes past this first statutory criterion,[28] stating merely that "the marks are similar." This is neither accurate nor sufficient. As Applicant argued in its motion and brief, to succeed on a claim of dilution by blurring, an opposing party must show that the allegedly diluting mark is identical to, nearly identical to, or so similar to its mark that most customers would view the two marks as essentially the same.[29] None of these statements apply to GET NAUTI and NAUTICA. Consequently, as in the likelihood of confusion context, even if NAUTICA is a famous mark, this fact could not overcome the substantial differences between the marks GET NAUTI and NAUTICA. On this basis, Martanna requests that its motion for summary judgment be granted on the Opposer's claim of dilution.

V. The Board Must Disregard the *Friedman Declaration* as a Further Attempt to Distract the Board's Attention from the Core Issue in this Proceeding

In the *Friedman Declaration* which Opposer filed along with its *Response Brief*, Nautica/Mr. Friedman presented a table listing 19 proceedings (16 before the Board, 3 before a New Jersey court) regarding 20 "challenged marks", ostensibly for the purpose of identifying "legal proceedings instituted by Nautica which [are] indicative of Nautica's policing efforts."[30] However, this presentation is misleading, because its structure implies that not only did Nautica

---

27 *Opposer's Response Brief* at 12.

28 15 U.S.C. 1125(c)(2)(B)(i).

29 *Martanna's Motion for Summary Judgment* at 13.

30 *Friedman Declaration* at 1.

institute the listed proceedings to "police" its marks, but also that the Board and a New Jersey court reached substantive determinations on the merits of Nautica's opposition to a raft of marks.

Particularly troubling is the table's "Outcome" column. For example, in the first proceeding referenced, a TTAB challenge to the mark SPAUTICA, the outcome identified is "Judgment in favor of Nautica." While this characterization is technically correct, this was a proceeding in which the applicant never filed an answer in response to Nautica's Notice of Opposition, and thus the Board entered a default judgment against the applicant. The same is true (and in some cases the applicant also withdrew its application) for the referenced TTAB proceedings involving challenges to the following 11 marks: NAUTICA THORN, NAUTICALI, NAUTICAL TEASE, NAUTI-GAL, BENSON & THOMAS NAUTICWEAR, NAUTI-CREW, NAUTICA PAVILION, NAUSICAA, II NAUTI, NAUTICARD, and NATIKA. Also, in the referenced proceeding involving NAUTI GEAR, the Board entered judgment for Nautica based on a dispute at the discovery stage, not on a substantive analysis of the opposition. Finally, in the proceeding on NAUTICA (application by Dacor Corporation) the Board dismissed the proceeding after the applicant filed its answer but without further proceedings.

Only two of the 16 TTAB proceedings referenced in the *Friedman Declaration* actually resulted in a substantive judgment in Nautica's favor, and neither support Nautica's position in the instant matter. In *Nautica Apparel, Inc. v. Brian Carlucci* ("*Carlucci*"), Opp. No. 91165909 (2007) (unreported), the key issue of the meaning and commercial impression of the challenged mark (NAUTIGIRL) was distorted by the conflicting arguments that the applicant made on this point in its application prosecution and in the opposition proceeding, a factor that is not present in this case. *Carlucci* at 28. In the other TTAB proceeding, *Nautica Apparel, Inc. v. Kevin Crain* ("*Crain*"), Opp. No. 91113893 (2001) (unreported), applicant's NAUTI BODY mark shared a

significant visual similarity with Nautica's mark, in that it begins with the same five letters as NAUTICA, that Martanna's mark does not share with Opposer's marks. The Board also stated that "Applicant's argument that his mark would have a different meaning than opposer's [that is, that in the applicant 's mark, NAUTI means "naughty"] is a significant factor." *Crain* at 16.

The New Jersey proceedings referenced in the *Friedman Declaration* regarding the marks NAUTI-GEAR and NAUTIC SPORT were dismissed without prejudice to the challenged party; further, it is disingenuous for Nautica to describe the outcome of these proceedings as "Settlement in favor of Nautica," as a settlement does not favor one party or another. The one referenced New Jersey proceeding that actually did involve a judgment in favor of Nautica involved a challenge to marks that were identical to or nearly identical to Nautica's marks: NAUTICA and NAUTICAL.

It is well established that "each case must be decided on its own facts."[31] The table of legal proceedings presented in the *Friedman Declaration* clearly represents another "smoke and mirrors" attempt to distract the Board's attention from the fundamental issues in this proceeding and the patent weakness of Nautica's legal position in this proceeding.

WHEREFORE, for the foregoing reasons, Applicant Martanna L.C. respectfully reiterates its request that its motion for summary judgment be granted, and that Opposer's countermotion for summary judgment be denied, and that this matter be dismissed with prejudice.

---

30 *Crain* at 16.

31 *DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567.*

/Howard G. Slavit/

Howard G. Slavit, Esq.
John Totaro, Esq.
Saul Ewing LLP
2600 Virginia Avenue, NW
Suite 1000 – The Watergate
Washington, DC 20037
Telephone: 202-295-6604
Facsimile: 202-295-6704
Counsel for Applicant Martanna L.C.

CERTIFICATE OF SERVICE

I hereby certify that, on this 13th day of May, 2008, a true and correct copy of Applicant Martanna L.C.' Reply in Further Support of its Motion for Summary Judgment and Opposition to Nautica Apparel, Inc.'s Countermotion for Summary Judgment were served, via first-class United States mail postage prepaid, upon:

Stephen L. Baker, Esq.
Neil Friedman, Esq.
Baker and Rannells PA
575 Route 28
Suite 102
Raritan, NJ 08869
Counsel for Opposer Nautica Apparel, Inc.

/ Howard G. Slavit/
Howard G. Slavit