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

Proceeding	91177192
Party	Plaintiff NAUTICA APPAREL, INC.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NAUTICA APPAREL, INC.,

Opposer,

v.

MARTANNA LLC,

Applicant.

Opposition No. 91177192

Mark: GET NAUTI

Serial No. 78610037

**OPPOSER'S REPLY BRIEF IN RESPONSE TO APPLICANT'S
RESPONSE TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

INTRODUCTION / OPENING STATEMENT

Opposer Nautica Apparel Inc. ("Nautica"), respectfully submits this brief in reply to Applicant's response to Opposer's Motion for Summary Judgment.

The "determinative" issue on the parties' respective motions for summary judgment is whether the moving party has demonstrated the lack of any genuine issues of fact, with all ambiguities and inferences resolved against the movant. See, *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157 (1970).

While one or more of the *duPont* factors may be a dominant factor in a particular case, the Board cannot disregard any relevant factors of record, and certainly cannot disregard a primary factor that has long been held to be a dominant factor. The cases indicate that dominant factors include the fame factor and the similarity factor, followed closely by and directly affected by the similarity of goods/services factor and the channels of trade factor.

ARGUMENT

The facts support summary judgment in Nautica's favor.

A. Fame Is A Dominant Factor

At page 2 of its brief, the Applicant asserts that Nautica has placed an "exaggerated emphasis" on the fame of Nautica's mark and name and further asserts that Nautica's evidence and argument is nothing more than a "distraction." However, nothing in the Applicant's papers provides a reason for overturning established rule of law, namely that the fame factor "plays a dominant role in cases featuring a famous or strong mark." *See, Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (CAFC 1992). In fact, it is error to discount the import of a "famous" mark. *Id.*, at 1456. *See also, Specialty Brands v. Coffee Bean Distribs.*, 748 F.2d 669, 671, 223 USPQ 1281, 1282 (Fed. Cir. 1984).

As stated in *Kenner v. Rose Art.*, *supra*, 22 USPQ2d at 1456:

Thus the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls. . . . The driving designs and origins of the Lanham Act demand the standard consistently applied by this court – namely, more protection against confusion for famous marks.

B. The Board Must Consider Each and Every DuPont Factor of Record

The Applicant would also have the Board ignore and discount all the *duPont* factors except "similarity of marks." Nothing in the Applicant's responding papers, however, provides a reason for overturning established rule of law. In *In re E.I. duPont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973), the decision whose factors govern this proceeding, thirteen (13) factors were propounded, each of which must to be considered when there is sufficient evidence of record and where the same are relevant. [Emphasis added]. *See also, Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000).

1st duPont Factor. The Similarity or Dissimilarity Of The Marks

The Applicant's arguments concerning the alleged lack of similarity between the parties' respective marks are abstractions. The Applicant has not provided any evidence of consumer impression to support its arguments.

There are a number of undisputed facts of record concerning this *duPont* factor:

The term "naut" is an abbreviation for the term "nautical." See, e.g., *Merriam-Webster Online dictionary*, *MSN Encarta dictionary*, and *Dictionary.com Unabridged* (v 1.1); The term "nauti" is a prefix for numerous words all of which pertain to things nautical; The primary meaning of the root "naut" and/or "nauti" is of things nautical; Opposer, has always been closely involved in marketing and promotional activities of a nautical nature and involving nautical themes. See, Bizzari Decl. ¶14 (e.g., sponsorship of regattas and other boating events, including the U.S. Sailing Team), and all exhibits attached to said declaration (showing Nautica's use of sail/sailboat logo and sea themes on products, promotions, advertisements, catalogs, etc.); Various of the goods recited in the application in issue concern the beach, water, boating and the like; The dominant portion of Applicant's mark is the term "NAUTI"; The dominant portion of the parties' respective marks ("NAUTI" and "NAUTICA") look similar, sound similar, and share similar meanings and commercial impressions.

The Applicant's response analysis of this factor is an exercise in side-by-side comparison. The test, however, is not whether the marks can be distinguished when subjected to a side-by-side comparison. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992)

("The proper emphasis is thus on the recollection of the average customer, who retains a general rather than specific impression of trademarks . . .").

Regarding Applicant's argument for a singular connotation for the term "NAUTI," the Applicant did not apply to register its mark as GET NAUGHTY but choose GET NAUTI. The Applicant clearly intended for the consumer to view the mark as "NAUTI". The spelling chosen clearly evidences that Applicant intended to make a nautical connection. It is undisputed that the term NAUTI has a nautical connotation as does NAUTICA.

In fact, if one Googles the phrase "get nauti," all the hits concern something of a "nautical" nature or theme. Attached to the accompanying Rannells Declaration is a representative printout of a Google search (including copies of the first pages from the representative hits described below) of the phrase "get nauti." With the exception of hits referencing a prior case involving Nautica¹, the remaining hits, notwithstanding any double entendres, refer to or are otherwise associated with something nautical / involving boating. This is obviously no accident. *See, e.g.*,

- www.julib.com/boston/getnauti112207BO_email.html - Restaurant review for "la voile" restaurant titled "get nauti": "a direct import from cannes, the brasserie meets bistro is serving up classic med food in a nautical-themed spot."
- www.sugarscape.com/main-topics/fashion-beauty/what-buy/366601/lets-get-nauti-cal - Fashion page titled "let's get nauti . . . cal" – discussing nautical themed fashion-wear.
- www.nauticalfishwife.com/apparel.aspx - The Nautical Fishwife "creative ideas for mariners } - T-Shirts - advertised in a nautical setting with the following logos:

GET NAUTI
Because Life's Better on the Water

GET NAUTI

¹ Nautica Apparel, Inc. v. Ella Davline Vickers (Mark: NAUTI GEAR), Canc. 92043887 – Judgment for Nautica; and Nautica Apparel, Inc. v. Get Nauti, Inc., Ella Vickers and Catchware, Inc. (Mark NAUTI GEAR), 2:07-cv—4462-KSH, withdrawn without prejudice subject to settlement agreement whereby defendants agreed to cease use of the mark.

Fair Winds, Calm Seas, and a
Mermaid Along to Guide You

- www.flickr.com/photos/hartini/2211312945/ - Photo titled “Get Nauti?” – “Pretty cool catch line to promote nautical activities though.”
- www.safyc.org.sg/news/officialopening/article.htm - (SAF Yacht Club 5/28/05) - Promotional line: “Get Nauti! – Official Opening 2005”
- www.straitstimes.com/Free/Story/STIStory_124657.html - Headline: “Sea Sports Extravaganza at SAF Yacht Club” - “Get ‘nauti’. Have fun trying our various sea sports . . . 40th anniversary celebrations of the SAF Yacht Club.”

The above is not presented for the truth of any matter in the exhibits, but is evidence of how the phrase is used, the phrase’s general commercial impression, and what potential consumers will find when seeking goods by using the phrase “get nauti” in their search.

On page 6 of Applicant’s brief, Applicant argues that there is only one way to pronounce the dominant portions of the parties’ respective marks (NAUTI and NAUTICA) (urging exclusive pronunciations of the letter “I” in the parties’ marks. The rule of law, however, has long been that, except in exceptional cases, there is no exclusive, singular or correct pronunciation of a mark. The question is how the terms “may” be pronounced. *See, The American Products Co. v. F. A. Leonard*, 53 F. (2d) 894, 11 USPQ 184 (CCPA 1931) (“There is no such thing as a correct pronunciation for a trade mark. It is pronounced in different ways by different people.”).

Further in that regard, cultural differences, spoken language letter pronunciation, and simple regional differences amongst people and regions of the country make the Applicant’s argument absurd. *See also, Barton Manufacturing Company v. Hercules Powder Company*, 33 USPQ 105, 107 (C.C.P.A. 1937) ([T]he public should not be required to analyze trade marks

with scrupulous care, nor should it be compelled to resort to a study of etymology in order to avoid confusion and mistake.”).

The dominant portions of the parties’ respective marks are similar in sight, sound, meaning and commercial impression. The Applicant’s abstractions cannot overcome the same.

5th duPont Factor. The Fame Of Opposer’s Marks

Nautica has proven that that the NAUTICA mark and name are famous through, *inter alia*, having achieved extensive general public recognition and renown. In fact, the Applicant does not refute this, but rather admits the same.

Despite the Applicant’s urgings to the contrary, “fame” is a dominant factor in likelihood of confusion analysis. *See, Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (“Fame of an opposer’s mark, if it exists, plays a dominant role in the process of balancing the *DuPont* factors,” citing *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)).

In its attempt to discount the import and impact of Nautica’s fame, the Applicant places its reliance on the case *Burns Philp Food, Inc. v. Modern Products, Inc.*, 28 USPQ2d 1687 (Fed Cir. 1993), a 2/1 split decision with dissenting opinion. The case is distinguishable from the present case. The similarity of the marks in issue in *Burns Philp* was limited to the generic term “SPICE.” In the present case, neither party’s mark contains a generic term for the class 25 goods in issue. Also, in *Burns Philp*, the remaining non-generic portion of the marks in issue were the terms “ISLANDS” in standard format (with the Board taking into consideration the commercial impression associated with the specimen trade dress) and the mark “GARDEN” in stylized lettering, lined for the color green, presented in a semi circular form (with the Board also taking into consideration the specimen of record trade dress (garden scene with plants and leafy vines

climbing an arbor). In the present case, the marks before the Board are in standard format only, and trade dress is not in issue. Also, in *Burns Philp*, the CAFC and the Board recognized the fame factor and utilized “the counter-weighting of various *du Pont* factors.” Something the Applicant in the present case avoids.

There is no genuine issue of material fact as to the fame of Nautica’s mark.

Additional Primary duPont Factors of Record.

The Applicant offered no evidence to refute the established fact that the parties’ goods are, in large part, identical and otherwise related and/or complementary and describe a large variety of clothing/apparel. There is no genuine issue of material fact with regard to the same.

The Applicant offered no evidence to refute the legal presumptions that Applicant’s goods which are legally identical to Nautica’s goods, are presumed marketed in and to the same channels of trade and to the same class of consumer. *Warnaco, Inc. v. Adventure Knits, Inc.*, 210 USPQ 307, 314-315 (TTAB 1981), *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). Further, the Applicant’s goods are not limited in any way as to class of consumer (i.e., Applicant recites: “Men, women and children’s clothing . . .”). Accordingly, the Board must find that Applicant’s goods and Nautica’s goods are provided under any and all marketing conditions applicable to the recited goods, and under any price points applicable to such goods, and are provided to and purchased by all classes of consumers appropriate to the goods identified. *Id.* There is no genuine issue of material fact with regard to the above.

CONCLUSION

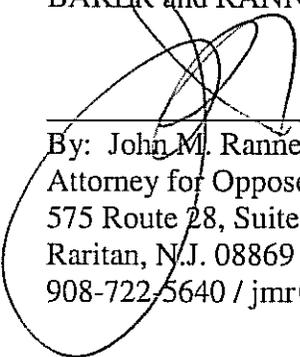
The only factor that the Applicant has seriously addressed is the “similarity of marks” *duPont* factor. As framed, the issue on Nautica’s motion for summary judgment is whether the Applicant by raising its abstract argument devoid of any real evidence and silent on consumer

perception raises a genuine issue of material fact capable of changing the outcome of this proceeding. Nautica respectfully submits that the marks are sufficiently similar so that when the Board considers the dominant fame factor which entirely supports Nautica, the identical nature of the goods in issue, and all of the other factors of record and governing presumptions, that the Board must grant Nautica's motion for summary judgment.

As oft said, there is "no excuse for even approaching the well-known trademark of a competitor . . . and all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989), quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co. Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

Respectfully submitted,

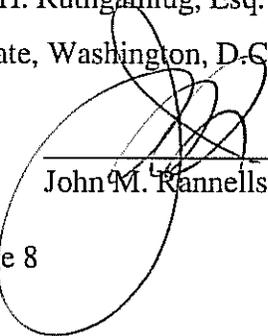
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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Opposer's Reply Brief in Response to Applicant's Response to Opposer's Motion for Summary Judgment has been served on counsel for Applicant by mailing said copy on June 2, 2008, via First Class Mail, postage prepaid to: Howard G. Slavitt, Esq. and Shannon H. Rutngamlug, Esq. of Saul Ewing, LLP, 2600 Virginia Avenue, NW, Suite 1000 – The Watergate, Washington, D.C. 20037.



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