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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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Applicant during the testimony deposition of Nautica's witness, Margaret Bizzari. Accordingly, Nautica's objection stands and the exhibit should be stricken.

Nautica hereby replies to certain statements made by Applicant in Applicant's Brief.

### ***ARGUMENT***

#### ***Applicant's Facts Concerning Prosecution of its Application***

As indicated on page 4 of its brief, Applicant filed its trademark application on April 15, 2005. On pages 4-6 of its Brief, the Applicant set forth its personal summary of the prosecution record of its application before the Examining Attorney. On page 5, Applicant refers to the Office Action (issued 11/22/2005) refusing registration to Applicant based upon Reg. No. 2706636 for NAUTI GEAR for goods in class 18 (e.g., handbags) and the Applicant's response thereto (i.e., Applicant deleted class 18 from its application). As the record indicates, notwithstanding the above, the Examining Attorney issued a Notice of Suspension.

Applicant fails to mention that prior to the above Office Action and Applicant's response thereto (i.e., on November 17, 2004), Nautica Apparel, Inc. instituted a cancellation proceeding against Reg. No. 2706636 (i.e., the registration cited against Applicant in prosecuting its application). See Nautica's 24<sup>th</sup> Notice of Reliance (Nautica Apparel v. Ella Davline Vickers, Canc. No. 92043887 – Mark: NAUTI GEAR and Design). Applicant also fails to mention that Nautica was successful in its petition to cancel Reg. No. 2706636 and that Nautica's petition to cancel was granted on August 5, 2007.

Further, Applicant fails to set forth certain contradictory statements made by Applicant in its Response to the above Office Action, facts which are relevant to Applicant's argument concerning the meaning and commercial impression of its mark:

1. On page 14 of its Trial Brief, the Applicant refers to the term NAUTI as an adjective. On page 5 of Applicant's Office Action Response, Applicant states: "Applicant's Mark, however, uses NAUTI as an adverb, modifying GET."

2. On pages 13-14 of its Trial Brief, the Applicant states: "See the Office Action Response . . . in which Martanna confirmed the obvious, i.e., that the word NAUTI, as used in its GET NAUTI Mark, has the meaning "naughty"." Besides being a self serving statement, the Applicant's Office Action Response at p. 4 states: "The word NAUTI has multiple meanings which are further highlighted by the additional part of each mark." Applicant then refers to the mark cited against it by stating: "The Registered Mark [NAUTI GEAR] uses NAUTI as a shortened version of "nautical". . . This is even more apparent because the design element of the Registered Mark, namely a woman in a bathing suit, fully supports the commercial impression that goods associated with this combined mark are connected to nautical activities and matters."

Nautica reiterates here, that the goods listed in Applicant's application in the present case include "sunscreen cream and sun block preparations, sandals, swimwear, namely bathing trunks, bathing caps, beach wraps, bikinis, and bathing suits." It is fair to say that Applicant made a conscious decision to register NAUTI rather than "naughty" to take advantage of the fact that, as Applicant stated in its Response to Office Action: "The word NAUTI has multiple meanings." It is also fair to state that the above referenced goods listed in Applicant's application support the commercial impression that the term NAUTI is, *inter alia*, "connected to nautical activities and matters."

### ***Applicant's Mark Separation Argument***

On page 12 of its Brief, Applicant uses, as an example, Nautica's NAUTICAKIDS mark to argue that it would be nonsensical to separate said mark as NAUTI CAKIDS, but fails to

argue why Nautica's NAUTICARE mark could be separated in any way other than:  
NAUTI CARE (NAUTICA RE obviously being nonsensical).

***Applicant's Argument Concerning Similarity/Dissimilarity in Sound and Meaning***

The Applicant's arguments on pages 13-14 of its Brief concerning dissimilarity in sound and concerning "intended meaning" are self-serving statements based solely upon conjecture. It would appear that Applicant's attorney's are unaware that in the United States, different geographic areas use different dialects and pronounce terms differently (e.g., New York and New Yawk, New Jersey and New Joysee, "you say potāto and I say potahto," etc.). In fact, the Applicant's argument is belied by its own dictionary evidence (see pp. 16-17 of Applicant's Brief): indicating that the term GET in Applicant's mark may be pronounced as "GIT" which, according to the cite "remains in widespread and unpredictable use in many dialects." The reference states that when the word "get" is used in certain grammatical manners, that it is pronounced as "git" in certain American dialects (and in widespread use). Opposer agrees that words are pronounced differently in different sections of the country. That is the nature of dialects.

Regarding Applicant's references to the book titles referenced in Applicant's Third Notice of Reliance, the same is the subject of Opposer's objection / motion to strike. In the event that the Board does not strike the Notice of Reliance, Opposer argues that the contents of the Notice of Reliance are meaningless on their face, conjectural, and contradict the Applicant's own arguments in its Response to the Office Action in prosecution of its application (i.e., how can NAUTI GEAR connote only nautical meaning (as per Applicant's own argument) and NAUTI DREAMS connote only "naughty?"). Applicant's arguments flip-flop depending on their purpose rather than their meaning.

Applicant has not presented any evidence of consumer perception. Yet, Applicant has no problem making unsupported statements throughout its Brief, such as: “purchasers, without question, will recognize GET NAUTI as . . .” [p. 15, Applicant’s Brief].

***Prior Board Decisions Concerning Opposer***

Reference is made to Nautica’s 24<sup>th</sup> Notice of Reliance evidencing Nautica’s efforts in policing its marks and the strength of Nautica’s marks. While the cases, are not precedent, the Board’s prior rulings are instructive. The following are excerpts from two of the cases which respond directly to statements made by Applicant in its Brief [See Nautica’s 24<sup>th</sup> Notice of Reliance].

1. *Nautica Apparel, Inc. v. Brian Carlucci*, Opp. No. 91165909 -- Mark in issue: **NAUTIGIRL** (Classes 9 and 25). Opposition sustained.

[I]n view of the public recognition and renown of the NAUTICA marks, opposer’s marketplace strength of its NAUTICA marks outweighs any inherent weakness in opposer’s marks created by the translation of “Nautica” as “nautical”. [At p. 33].

Because opposer has established that its NAUTICA marks are entitled to a high degree of public recognition and renown, they are more likely to be remembered and associated in consumers’ minds than weaker marks and accorded more protection. In addition, to the high degree of public recognition and renown, applicant’s mark is proposed for use in connection with goods which are identical in part to the goods in opposer’s registrations. Therefore it is more likely that consumers will be confused when purchasing applicant’s products when applicant’s products are identified by a mark [NAUTIGIRL] that is similar to opposer’s famous marks. Recot Inc. v. M.C. Becton, 214 F. 3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In reaching this decision, we note that there is “no excuse for even approaching the well-known trademark of a competitor . . . and that 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). [At, 34-35].

2. *Nautica Apparel v. Kevin Crane*, Opp. No. 91113893 -- Mark in issue: **NAUTI BODY** for Class 25). Opposition sustained.

The fame of opposer's NAUTICA mark is a factor, therefore, that strongly favors oppose. [At, p. 10].

Applicant argues that:

Nautica's name(s) and associated product lines, implies water related or boating clothes, with a seafaring theme to their items... Applicant's proposed mark of NAUTI BODY implies sensual, naughty, or sexy garments. "NAUTI" is a homonym for "NAUGHTY." Naughty means "bad, disobedient, mildly indecent."

... applicant's argument is not without merit that the marks may have different meanings. The deletion of the letters "ca" from opposer's mark and the addition of the word "body" can create the meaning of "naughty body." However, there are similarities between the marks. Both begin with the same five letters "NAUTI." Applicant chose to use a misspelling of the word "naughty," and that misspelling obviously makes the appearance of the marks more similar. A famous mark "casts a long shadow which competitors must avoid." Recot, 54 USPQ2d at 1897, quoting, Kenner Parker Toys, 22 USPQ2d at 1457. This spelling also dilutes the meaning applicant claims he was trying to create of "naughty body." If the correct spelling of the word "naughty" was used the meaning that applicant was trying to create would be more readily apparent to purchasers. By misspelling the word, applicant's mark, at first glance, suggests a connection with the word "nautical" and then requires the potential purchaser to reevaluate the word in light of the incongruous word "body." [At, pp. 12-13].

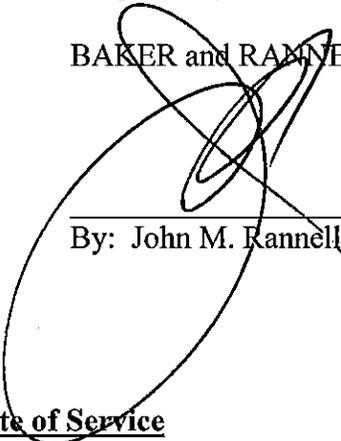
In addition, opposer's registrations show that it is using more than just the mark NAUTICA. Opposer also uses the mark NAUTECH for clothing items as well as N NAUTICA and NAUTICA COMPETITION. Thus, potential purchasers would more likely believe that applicant's term NAUTI BODY is in some way related to, or sponsored by, opposer. [At, p. 13].

In addition, when we consider the fame of opposer's mark, the identical nature of the goods, the strength of opposer's mark, the fact that applicant choose the misspelling of his mark making it appear even more similar to opposer's marks, the number of variations of opposer's marks, and the wide variety of goods on which opposer uses its marks, we hold that the balance tips in opposer's favor.

Finally, while our determination that confusion is likely is not free from doubt, we must resolve doubts about confusion against the newcomer, which we do here. Kenner Parker Toys, 963 F.2d at 355, 22 USPQ2d at 1458. [At, p. 15].

Respectfully submitted,

BAKER and RANNELLS, PA



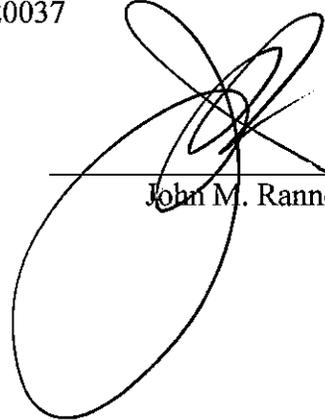
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By: John M. Rannells

**Certificate of Service**

I hereby certify that a true and complete copy of the foregoing Opposer's Trial Reply Brief has been served on counsel for Applicant by mailing said copy on July 14, 2009, via First Class Mail, postage prepaid to:

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