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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nautica Apparel, Inc.
v.
Martanna LLC

Opposition No. 91177192
to Application Serial No. 78610037
filed on 4/15/2005

Stephen L. Baker and John M. Rannells of Baker and Rannells,
PA for Nautica Apparel, Inc.

Howard G. Slavit and John Totaro, of Saul Ewing LLP for
Martanna LLC.

Before Hairston, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Nautica Apparel, Inc. (opposer) has opposed the
application by Martanna LLC (applicant) to register the mark
GET NAUTI in standard characters on the Principal Register
for goods identified as:

perfumes, colognes, and essential oils for
personal use; deodorants and antiperspirants for
personal use; cleaning preparations for personal
hygiene purposes, namely, skin cleansers, facial
cleansers, shower gels, shower wash, body scrubs,
facial scrubs, and facial masks; hair care
preparations, namely, hair shampoo, hair

Opposition No. 91177192

conditioner, styling gel, hair spray, hair cream, hair mousse; sunscreen cream and sun block preparations; shaving preparations, namely, non-medicated shaving balm, shaving cream, shaving foam, shaving gel, shaving lotion, shaving soap, after-shave gel, and after-shave lotion; cosmetics, namely, foundation and powder make-up, concealers, blush, eye shadow, eyeliners, eyebrow pencils, mascara, lip gloss, lip liner, and lipstick; nail care preparations, namely, nail enamel, nail cream, and nail polish; toiletries, namely bar and liquid skin soaps, body lotions, body cream, body powder, hand cream, eye cream, and skin moisturizers, in International Class 3;

and

men, women and children's clothing, namely shirts, T-shirts, tank tops, jerseys, polo shirts, blouses, sweatshirts, shorts, pants, slacks, sweatpants, jeans, suits, blazers, coats, jackets, overalls, warm-up suits, skirts, dresses, hosiery, undershirts, underwear, boxer shorts, bras, sports bras, socks, belts, suspenders, hats, gloves, scarves, earmuffs, neckties, neckbands, armbands, headbands, sportswear, namely, shirts, shorts, pants, sweatshirts and jackets, sleepwear, nightgowns, pajamas, lingerie, and robes; footwear, namely, shoes, boots, sneakers, slippers, beach footwear, and sandals; swimwear, namely bathing trunks, bathing caps, beach wraps, bikinis, and bathing suits, in International Class 25.

The application is based on applicant's statement of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. 1051(b), as to both classes.

The Grounds

As grounds for the opposition opposer asserts priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and likelihood of dilution under Trademark Act Section 43(c), 15 U.S.C. § 1123(c).

Opposition No. 91177192

In particular, opposer has pleaded and placed in evidence copies of certain active registrations owned by opposer for its NAUTICA mark and certain variations on that mark, including the following which are most relevant:

Registration No. 1862585 for the mark NAUTICA in typed form for "footwear" in International Class 25;¹

Registration No. 3109967 for the mark NAUTICA BEACH in typed form for "clothing, namely, men's, women's and children's bathing suits, swim trunks, swim suits, beach cover-ups, shorts, pants, woven and knitted shirts, warm-up suits, sweat shirts and pants and bathing caps" in International Class 25;

Registration No. 3170055 for the mark NAUTICA BLUE in standard characters for "perfumery, after shave lotions" in International Class 3;

Registration No. 2993023 for the mark NAUTICA BLUE in standard characters for "men's, women's and children's wearing apparel, namely, hosiery, shoes, sneaker, boots, moccasins, undershirts, boxer shirts, shirts, blouses, trousers, pants, jackets, coats, suits bathing suits, bathrobes, slippers, shorts, ties, neckwear, scarves, socks, hats and caps, gloves and mufflers, belts and suspenders and foul weather gear" in International Class 25;

Registration No. 2987139 for the mark NAUTICA BLUE in typed form for "men's, women's and children's wearing apparel, namely, undershirts, t-shirts, shirts, blouses, pants, shorts bathing suits and swimwear" in International Class 25;

Registration No. 3076597 for the mark NAUTICA COMPETITION for "cosmetics and toiletries for men and women, namely, colognes, skin cleansers, skin toners, cosmetic skin creams and lotions, shaving cream, after-shave lotion, after-shave cream,

¹ This registration and other registrations which include NAUTICA as a separate term include a translation of NAUTICA as "nautical."

Opposition No. 91177192

toilet soap, talcum powder, bath oil, personal deodorants, shampoo and conditioner" in International Class 3;

Registration No. 3076796 for the mark NAUTICA COMPETITION in standard characters for "men's, women's and children's wearing apparel, namely, shoes, sneakers, boots, undershirts, shirts, pants, jackets, coats, bathing suits, bathrobes, pajamas, slippers, shorts, ties, socks, hats, caps, gloves and foul weather gear" in International Class 25;

Registration No. 1523565 for the mark NAUTICA and design shown here for "hosiery, shoes, undershirts, undershorts, shirts, blouses, trousers, pants, jackets, coats, suits, bathing suits, bathrobes, slippers and shorts" in International Class 25;



Registration No. 3272760 for the mark NAUTICA GOLF in typed form for "men's (sic), namely, shirts, tops, sweaters, jackets, pants, bottoms, hats and caps" in International Class 25, with GOLF disclaimed;

Registration No. 2474154 for the mark NAUTICA JEANS COMPANY in typed form for "men, women and children's wearing apparel, namely, hosiery, shoes, sneakers, boots, moccasins, undershirts, boxer shorts, shirts, blouses, trousers, pants, jackets, coats, suits, bathing suits, bathrobes, slippers, shorts, ties, neckwear, scarves, socks, hats and caps, gloves and mufflers, and foul weather gear, belts and suspenders" in International Class 25, with JEANS COMPANY disclaimed;

Registration No. 2523102 for the mark NAUTICA JEANS COMPANY in typed form for "men, women and children's wearing apparel, namely, hosiery,

Opposition No. 91177192

shoes, undershirts, boxer shorts, shirts, blouses, trousers, pants, jackets, coats, bathing suits, bathrobes, shorts, scarves, socks, hats and caps, gloves and foul weather gear" in International Class 25, with JEANS COMPANY disclaimed;

Registration No. 1557528 for the mark NAUTICA in typed form for "perfumes" in International Class 3;

Registration No. 1882757 for the mark NAUTICA in typed form for "toiletries for men, namely shaving cream and toilet soap" in International Class 3;

Registration No. 3170094 for the mark NAUTICA VOYAGE in standard characters for "perfumery, after shave lotions" in International Class 3;

Registration No. 3168753 for the mark NAUTICAKIDS in standard characters for "coats; dresses; footwear; gloves; headwear; jackets; jeans; pajamas; pants; raincoats; robes; scarves; shirts; shorts; skirts; sweaters; swimsuits; t-shirts; trousers; underwear; vests" in International Class 25;

Registration No. 3445949 for the mark NAUTICARE in standard characters for "dress shirts; jackets; men's suits; neckwear; overcoats; pants" in International Class 25.

Notice of Opposition and Opposer's First Notice of Reliance.

Applicant has objected to opposer's reliance on certain of these registrations on the grounds that opposer's notice of opposition only refers to the serial numbers and particulars of the relevant applications before the applications proceeded to registration. The registrations related to these applications issued during the pendency of this proceeding and opposer submitted status and title copies of the relevant registrations in a timely manner under a notice of reliance with its evidence. Applicant's

Opposition No. 91177192

objection is not well taken. The notice of opposition provided adequate notice to applicant of opposer's intention to rely on any registrations which might issue from the pleaded applications during the pendency of the proceeding. Under the circumstances, we deem the pleadings amended to include these registrations. *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045-1046 (TTAB 2009).

Opposer also claims common law rights in NAUTICA for goods in International Classes 3 and 25 and other goods. For purposes of determining priority and likelihood of confusion in this proceeding opposer's claim of common law rights is unnecessary and we have not considered it.

Applicant has denied the essential allegations in the notice of opposition.

Pending Motions

Before proceeding to the merits, we must address a number of pending motions.

Applicant has moved to strike certain arguments in opposer's reply brief which refer to the Board's decisions in prior cases involving the NAUTICA marks, Opposition Nos. 91165909 and 91113893. Opposer had made the decisions in these cases of record through a notice of reliance wherein opposer explains that the copies of these decisions are evidence of opposer's efforts to police its NAUTICA marks. Applicant argues that opposer's arguments related to these

Opposition No. 91177192

decisions are not proper rebuttal because the arguments do not reply to any arguments in applicant's brief.

Opposer counters that its arguments in the reply brief are proper rebuttal because they relate to certain assertions by applicant as to the commercial impressions of the respective marks at issue here.

We conclude that opposer's arguments in its reply brief cited by applicant, based on the prior decisions, are misplaced and we reject them. We would do so whether or not the arguments were appropriate for rebuttal. In its arguments opposer refers to the "instructive" value of those opinions on issues of fact and law in the case before us. The prior cases involved different parties, different marks and different records than we have before us in this case. As applicant notes, we must decide the case before us based on its unique facts and record. Accordingly, we will consider the prior decisions only for the limited purpose for which they were offered, that is, as evidence that opposer has policed its marks. We have not relied on the findings with regard to facts or law in the prior decisions in our determination of the issues in this case. Rather, we have restricted our consideration to the record before us.

Opposer also objects to certain evidence. First, opposer objects to our consideration of three articles applicant submitted under Applicant's Third Notice of

Opposition No. 91177192

Reliance which refer to *Nauti Dreams*, *Nauti Nights* and *Nauti Boy*. Opposer states, "The three documents are admissible solely for the fact that in August of 2008 three publications mention a book or books with the term "NAUTI" in the title. Anything beyond that is hearsay." Opposer's Motion to Strike, dated May 26, 2009, at 2. Opposer asks that we strike the articles, that is, exclude them from consideration entirely.

We agree with opposer's characterization of the status of this evidence. We regard the articles in questions, as we would any similar evidence filed under a notice of reliance, as hearsay. As such, this evidence may not be used to prove any facts asserted in the articles. We limit the use of the articles merely to show that the subject matter appeared in the relevant publications and that the public was exposed to the subject matter. While we decline to exclude the articles from consideration entirely, we will consider the content of the articles only as hearsay and for whatever probative value they may possess when viewed in that light.

Opposer also objects to our consideration of one exhibit, A-5, which applicant introduced during its cross examination of opposer's witness, Margaret Bizzari. The exhibit consists of eleven Internet pages, copies of pages from web sites or results of Internet searches. Opposer

Opposition No. 91177192

objects on the grounds that applicant failed to authenticate the documents by presenting the witness who conducted the searches which generated these pages. We agree with opposer. Accordingly, we strike Exhibit A-5. For completeness we note that we would not reach different conclusions in this case if we had considered this evidence.

The Record

By rule, the record includes the pleadings and the file for the opposed application. Trademark Rule 2.122, 37 C.F.R. § 2.122. Opposer's evidence consists of the testimony of Margaret M. Bizzari (Bizzari) with numerous exhibits and twenty-four notices of reliance. Applicant's evidence consists of three notices of reliance. There are no disputes regarding the evidence other than those issues we addressed immediately above.

Standing

Because opposer has pleaded and shown that it owns registrations for NAUTICA and variations of that mark, including those identified above and below, and that opposer has used the NAUTICA mark in commerce, opposer has established standing. *See generally Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

Priority

Opposition No. 91177192

Priority is not at issue in this proceeding, again because opposer has made of record status and title copies of valid and subsisting registrations for its NAUTICA mark and variations of that mark. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Applicant has argued that it has priority as to certain of the marks in opposer's registrations because applicant applied to register its mark before opposer obtained the registrations. Applicant argues, "Nine of the marks that opposer alleged and referred to in support of its priority and likelihood of confusion claim were marks for which intent-to-use based applications were filed after Martanna filed its application. ... However, Nautica does not have priority in its marks whose actual and constructive dates of use fall after the constructive date of use established by the GET NAUTI application." Applicant's Brief at

In so arguing applicant cites no authority and disregards the mandate of the Trademark Act, as explained in the *King Candy* case. The Court states:

In an opposition, the board must consider existing registrations of subsequent-user opposers, because (1) the statute, 15 U.S.C. 1051-1127, requires such considerations; (2) the basic question in an opposition is applicant's right to register (not merely, as the board says, whether the opposer "will be damaged"); (3) in determining applicant's right to register, the entire statute, including Section 2(d), must be considered; (4) Section 2(d) says an applicant can register, *unless* his mark is

likely to cause confusion with a mark "registered in the Patent Office or * * * previously used * * *" (emphasis added); (5) the board's requirement that the registrant-opposer also be a prior user impermissively negates the statutory distinction ("or") in Section 2(d) between a registered mark and a previously-used-but-unregistered mark, would permit simultaneous registration of the same mark for the same goods to different parties....

Id. at 110-111.

The fact that opposer's marks are registered relieves opposer of the burden of showing priority; the filing dates of the underlying applications or the stated date of first use in commerce for the registered marks are irrelevant. Accordingly, we reject applicant's arguments and conclude that opposer has priority with respect to the marks in the registrations opposer properly asserts here.

Findings of Fact

Opposer is the source of a wide range of consumer products which it offers under the NAUTICA mark and variations of that mark. Opposer argues at some length that the NAUTICA mark is a "lifestyle brand" and Ms. Bizzari testifies that it is. Bizzari at 9. For our purposes, whether NAUTICA is or is not a "lifestyle brand" is not relevant. More importantly, the full record does establish that opposer has engaged in the coordinated marketing of a wide range of products under the NAUTICA brand using a consistent concept or image. *Id.* at Ex. H. The NAUTICA concept or image is characterized by nautical themes. *Id.*

Opposition No. 91177192

The NAUTICA products include apparel and personal care items, including personal fragrances, as well as other products for the person or home.

The core products in applicant's NAUTICA line are apparel. Opposer began to use the NAUTICA mark on apparel, including the goods identified in its Class 25 registrations, in 1983. *Id.* at 7-8. As detailed above, opposer has registered the NAUTICA mark and certain variations on that mark for a wide range of apparel.

Opposer began to use the NAUTICA mark on personal fragrances, including those identified in its Class 3 registrations, in 1987. *Id.* at 32. As detailed above, opposer has registered the NAUTICA mark and certain variations on that mark for personal fragrances.

Opposer has used the NAUTICA mark and variations on that mark through its licensees on a wide range of other products, including: eye wear, watches, luggage, wallets, inflatable boats, life jackets, bedding, mattress pads, indoor and outdoor furniture, fabric, umbrellas, including beach umbrellas, and other products. *Id.* at 13. Opposer has not provided evidence as to the dates on which it began to use the NAUTICA marks on the "other products" noted here.

Opposer also distributed men's boxer shorts which included a label displaying BE NAUTI in 2007. *Id.* at 21. There is no registration for BE NAUTI of record in this

Opposition No. 91177192

case. Consequently, opposer has not established priority with regard to the BE NAUTI mark relative to applicant's GET NAUTI application which is at issue here.

Opposer has pleaded and placed in evidence copies of certain active registrations owned by opposer for its NAUTICA mark for goods and services in addition to the goods in International Classes 3 and 25, including the following which are most relevant²:

Registration No. 2865299 for the mark NAUTICA for "pillows" in International Class 20;

Registration No. 2731466 for the mark NAUTICA for "mattress pads and bed vests" in International Class 24;

Registration No. 2865229 for the mark NAUTICA for "sporting goods, namely, sport balls" in International Class 28;

Registration No. 3114379 for the mark NAUTICA for "financial sponsorship of sporting events, tournaments, competitions and contests" in International Class 36 and "organizing and operating sporting events, tournaments, competitions and contests" in International Class 41;

Registration No. 2304411 for the mark NAUTICA "lamps" in International Class 11;

Registration No. 1580007 for the mark NAUTICA for "notebooks, desk top organizers, calendars, and phonebook covers made of leather or imitation leather" in International Class 16, "umbrellas, luggage, trunks, duffle bags, garment bags for traveling, travel kits and leather boxes in the nature of jewelry boxes" in International Class 18, and "belts and suspenders" in International Class 25;

² The registrations noted here also include a translation of NAUTICA as "nautical."

Opposition No. 91177192

Registration No. 2246317 for the mark NAUTICA for "outdoor furniture; living room furniture; bedroom furniture; furniture, namely wall units; furniture tables; bookcases; and picture frames" in International Class 20;

Registration No. 2306324 for the mark NAUTICA for "glass and plastic beverage ware; dinnerware; coasters (not of paper or linen); paper plates; paper cups; candlesticks not of precious metal" in International Class 21;

Registration No. 1553539 for the mark NAUTICA for "spectacles, namely eyeglasses and sunglasses, and accessories, namely cases and straps" in International Class 9;

Registration No. 3233030 for the mark NAUTICA for "watches" in International Class 14;

Registration No. 3114862 for the mark NAUTICA for "drapery fabrics; and textile fabrics for use in the field of home furnishings" in International Class 24;

Registration No. 3232846 for the mark NAUTICA for "retail store services in the field of wearing apparel, fashion accessories, home fashions, eyewear, luggage and personal care products" in International Class 35;

Registration No. 2242969 for the mark NAUTICA for "rugs, wall paper, and vinyl wall covering" in International Class 27;

Registration No. 2247914 for the mark NAUTICA for "table napkins not of paper, table cloths not of paper; kitchen towels; upholstery fabrics; and textile wall hangings" in International Class 24;

Registration No. 1873011 for the mark NAUTICA in stylized letters for "key rings, key fobs, key holders and money clips" in International Class 6, "wallets, hipfold wallets, trifold wallets, key cases, tie cases for travel, shoulder bags, tote bags; clutch bags, carry-on bags" in International Class 18, and "buttons for clothing" in International Class 26; and

Opposition No. 91177192

Registration No. 2292976 for the mark NAUTICA in stylized letters for "tableware, namely forks, knives and spoons" in International Class 8.

Applicant markets the NAUTICA products through 2,400 retail and department stores in the United States, including 115 of its own stores. *Id.* at 26-28. In the case of some department stores, applicant operates a "store within a store" where its products are offered in a distinct department within the store identified by the NAUTICA mark. Applicant also markets the NAUTICA products over the Internet and through catalogues. *Id.* Applicant's store designs feature water themes. *Id.* at 30.

Applicant has provided sales figures for the NAUTICA products sold in the United States from 2001 through 2007. *Id.* at 50, Ex. J. The annual sales amounts are as follows:

2001	-	\$886,574,000
2002	-	\$920,570,000
2003	-	\$920,058,000
2004	-	\$877,320,000
2005	-	\$862,738,000
2006	-	\$929,648,000
2007	-	\$924,621,000

These figures represent sales at the wholesale level; retail sales would be approximately twice these amounts. *Id.* at 51. Apparel sales are most significant in volume, and personal fragrance sales are also significant. *Id.* at Ex. J. According to *NPD Fashion World*, which tracks and ranks brand sales through retailers, NAUTICA is second in sales among men's sportswear brands. *Id.* at 52-53. Ralph Lauren

Opposition No. 91177192

is number one. This ranking excludes private label brands, that is, department store or retailer brands, such as, Bloomingdale's, Lord & Taylor or Macy's. *Id.* Opposer's NAUTICA JEANS COMPANY brand ranks 19. *Id.*

Opposer has also provided figures for its U. S. advertising expenditures related to the NAUTICA products from 2000 through 2007. The advertising expenditures are as follows:

2000	-	\$40,568,881
2001	-	\$35,537,565
2002	-	\$35,111,056
2003	-	\$37,683,943
2004	-	\$37,643,000
2005	-	\$39,904,000
2006	-	\$35,686,000
2007	-	\$35,184,000

Opposer's NAUTICA advertising appears in a variety of types of media, including, billboards, national television and print media.

The televised advertising appeared on ABC, CBS, NBC, FOX, Comcast, CW, My Network and Comedy Central, among others. *Id.* at 38 and Ex. H. The NAUTICA products were advertised on major shows, such as, *48 Hours*, *60 Minutes*, *the Tony Awards*, *Friends*, *Jeopardy*, *Law & Order*, *The Office*, *Wheel of Fortune*, *Grey's Anatomy*, *Everybody Loves Raymond*, *The Daily Show*, *House* and others. *Id.* These advertisements emphasized apparel and included personal fragrances and other products. *Id.* at Ex. H.

Opposition No. 91177192

The print advertising for the NAUTICA products appeared in a wide range of national publications, including, *Cosmopolitan, Vogue, Elle, Sports Illustrated, GQ, Fortune, Rolling Stone, The New York Times Magazine, DC Comics, Esquire, ESPN, INSTYLE, House and Garden, Marie Claire, SPIN, Teen People, The New Yorker, Vanity Fair, WWD* and others. *Id.* at Ex. H. The NAUTICA advertising in these publications emphasizes apparel and also includes personal fragrances and other products. *Id.* The number of impressions generated by this advertising, that is, the estimated number of individual consumer views of the ads was in excess of one billion for each of the years from 2004 through 2007. *Id.* at Ex. H.

Opposer also promotes its NAUTICA products through sponsorships of major events, such as, triathlons, including the Malibu and NYC Triathlon, and tennis tournaments, including the Legg Mason Tennis Classic, and through the U.S. Sailing Team. *Id.* 44-50 and Ex. I.

Opposer has also provided extensive evidence of media attention with regard to the NAUTICA products including references to the NAUTICA marks. See Notices of Reliance 2 through 23. In evaluating this evidence, we have not considered the examples from sources outside the United States. The examples from U.S. media indicate widespread exposure to the NAUTICA marks in the United States in a wide

range of publications over an extended period of time, for example: *Orange County Register; News & Record* (Greensboro NC); *Seattle Post-Intelligencer; The Post Standard* (Syracuse); *The Los Angeles Times; The New York Times; The Palm Beach Post; Forbes; Newsday; USA Today*; and scores of other similar publications. *Id.*

Likelihood of Confusion

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..."³ 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors to consider in determining likelihood of confusion. We will discuss below each factor which is relevant in this case.

Fame

Opposer asserts that its NAUTICA mark is famous. If an opposer is able to show that its mark is famous, fame plays a dominant role in the likelihood-of-confusion analysis because famous marks enjoy a broad scope of protection. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63

³ As we indicated above, for purposes of this proceeding we rely on opposer's prior rights based on registration and not the common law rights opposer has asserted.

Opposition No. 91177192

USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Accordingly, we consider the fame factor first.

We may consider evidence of sales, advertising expenditures, and the length of time the mark has been used, among other things, when determining whether or not a mark is famous. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309; *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005).

To clarify, fame for dilution purposes differs from fame in the context of likelihood of confusion; the former requires a stronger showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, *supra*; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood-of-confusion fame "... varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition - sufficient fame for dilution either exists or does not exist. *Id.*

With respect to the Class 25 goods, we conclude that opposer has established a significant degree of fame for its NAUTICA mark. Opposer has used NAUTICA on apparel for an extended period of time, its sales and market share are impressive, and opposer has promoted its NAUTICA mark in the

apparel field extensively through major national media. Furthermore, the evidence of public recognition, as reflected in media attention, is significant. Therefore, we conclude that the NAUTICA mark has achieved a significant degree of fame in the apparel field. As we indicated, fame is a dominant factor. Accordingly, this factor strongly favors opposer in the likelihood of confusion analysis for Class 25.

With respect to the Class 3 goods, we conclude that opposer has established fame for its NAUTICA mark. The record includes significant evidence with regard to long use, sales and advertising for the Class 3 goods. Furthermore, the record, including evidence regarding the marketing of the NAUTICA products, such as apparel and personal fragrances, jointly in applicant's own stores and the "stores within a store" bolster the conclusion that the NAUTICA mark has achieved fame with regard to the Class 3 goods, most notably, personal fragrances.

The Goods

In comparing the goods and the channels of trade for the goods we must consider the goods as identified in the application and pleaded registrations. *See Octavo Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ 1783, 1787 (Fed. Cir. 1990). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ

Opposition No. 91177192

76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

In this case, the goods of the parties in both classes are identical, at least in part.

First with respect to International Class 3, the opposed application identified the following goods, among others: "perfumes, colognes, ... for personal use; ... cleaning preparations for personal hygiene purposes, namely, skin cleansers, facial cleansers, shower gels, shower wash, body scrubs, facial scrubs, and facial masks; ... shaving preparations, namely, non-medicated shaving balm, shaving cream, shaving foam, shaving gel, shaving lotion, shaving soap, after-shave gel, and after-shave lotion; ... toiletries, namely bar and liquid skin soaps" Opposer's Registration Nos. 1557528, 3170094 and 1882757 for the mark NAUTICA in typed form identify the following goods: "perfumes," "toiletries for men, namely shaving cream and toilet soap" and "perfumery, after shave lotions." Thus, the opposed application and opposer's asserted registrations for the NAUTICA mark in International Class 3 identify identical goods to the extent that both include personal fragrances, after shave lotions and personal soaps. The same is true for the registrations opposer asserts for variations on the

Opposition No. 91177192

NAUTICA mark, including, NAUTICA BLUE, NAUTICA COMPETITION, and NAUTICA VOYAGE.

Next, with respect to International Class 25, the opposed application identifies the following goods: "men, women and children's clothing, namely shirts, T-shirts, tank tops, jerseys, polo shirts, blouses, sweatshirts, shorts, pants, slacks, sweatpants, jeans, suits, blazers, coats, jackets, overalls, warm-up suits, skirts, dresses, hosiery, undershirts, underwear, boxer shorts, bras, sports bras, socks, belts, suspenders, hats, gloves, scarves, earmuffs, neckties, neckbands, armbands, headbands, sportswear, namely, shirts, shorts, pants, sweatshirts and jackets, sleepwear, nightgowns, pajamas, lingerie, and robes; footwear, namely, shoes, boots, sneakers, slippers, beach footwear, and sandals; swimwear, namely bathing trunks, bathing caps, beach wraps, bikinis, and bathing suits." Opposer's Registration No. 1862585 for the mark NAUTICA in typed form identifies "footwear"; Opposer's Registration No. 1523565 for the mark NAUTICA and design covers "hosiery, shoes, undershirts, undershorts, shirts, blouses, trousers, pants, jackets, coats, suits, bathing suits, bathrobes, slippers and shorts." Thus, the opposed application and opposer's asserted registration for the NAUTICA mark in International Class 25 identify identical goods to the extent that both include footwear. The opposed application

and the asserted registration for NAUTICA and design also overlap in that both identify footwear, shirts, blouses, pants, jackets, coats, shorts, swimwear and other items.⁴

The same is true for registrations opposer asserts for variations on the NAUTICA mark, including, NAUTICA BLUE, NAUTICA BEACH, NAUTICA COMPETITION, NAUTICA VOYAGE, NAUTICA GOLF, NAUTICA JEANS COMPANY, NAUTICAKIDS and NAUTICARE.

Therefore, we conclude that the goods of the parties in both International Classes 3 and 25 are identical, at least in part, and that this factor strongly favors opposer's position.

For the record many of the other items identified in the opposed application in both International Classes 3 and 25 are closely related to the goods identified in the registrations opposer asserts in those classes.

Channels of Trade

In addition, because the goods of the parties are identical, in part, we also conclude that the channels of trade for those goods are identical or otherwise related. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers,

⁴ In the case of this registration NAUTICA is the only literal element and the dominant element.

these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"). As in the *Genesco* case, here too, there are no trade-channel restrictions in the opposed application, nor in the registrations we have noted. Accordingly, this factor also strongly favors opposer's position.

The Variety of Opposer's Goods

Opposer also argues that the NAUTICA mark is used with a large variety of goods. Opposer's Brief at 18. The registrations opposer asserts, as noted above, in International Classes 8, 9, 11, 14, 16 20, 21, 24, 26, 27, 28, 35 and 41, in addition to International Classes 3 and 25, are sufficient to establish that opposer has used the NAUTICA mark on a wide variety of goods. *Chicago Bears Football Club Inc. v. 12TH Man/Tennessee LLC*, 83 USPQ2d 1073, 1075 (TTAB 2007). This factor also favors opposer.

The Conditions Applicable to Sales

Opposer argues that goods in its asserted registrations and those identified in the opposed application include goods which are offered to consumers generally and at various price points, and not exclusively expensive goods offered to sophisticated purchasers. We agree. The identified goods are apparel and toiletry items which include relatively inexpensive goods offered to the general public, not sophisticated or expensive goods which would be

purchased with extreme care. This factor favors opposer's position.

The Number and Nature of Similar Marks in Use on Similar Goods

Opposer argues that there is no evidence of third-party use of NAUTICA on goods similar to those at issue here. Opposer also argues that the record shows that opposer has policed its mark diligently. Applicant does not address these arguments directly. Nor has applicant made of record any evidence of third-party use of NAUTICA, or variations of NAUTICA, as a mark for the goods at issue here.

However, applicant has made of record published articles which refer to works with the titles, *Nauti Dreams*, *Nauti Nights* and *Nauti Boy* to show that "Nauti" is used and would be perceived as a misspelling of "naughty." Applicant's Third Notice of Reliance. For the record, this evidence in no way shows that opposer's NAUTICA mark is weak -- or for that matter anything other than strong -- as applied to the goods at issue here.

Applicant has also made of record a copy of an office action in Application Serial No. 78885472, an application filed by opposer for the NAUTICA mark, wherein the Examining Attorney required opposer to insert a translation of 'NAUTICA' as "nautical." Applicant's Second Notice of Reliance. In fact, we noted above that each of opposer's

registrations, which include "NAUTICA" as a separate term in the mark, also includes this translation. Based on the full record, we find that this evidence in no way establishes that NAUTICA is a weak mark as applied to the goods at issue here. To the contrary, based on the full record, we have concluded that NAUTICA is a famous mark as applied to apparel and personal fragrances.

Opposer has also included a few examples of its efforts to police its mark, for example, evidence regarding the two prior Board proceedings we discussed above. The evidence of policing is not significant, however. We would find NAUTICA to be a strong mark with or without this evidence because of the showing opposer submitted regarding the fame of the NAUTICA mark as applied to the goods at issue here. Accordingly, this factor strongly favors opposer's position.

Other Factors

Opposer has presented arguments in summary fashion as to certain other factors, including actual confusion, factors as to which we have no evidence. We find that each of these factors is neutral for purposes of this case. Applicant, in fact, has offered little in the way of argument or evidence as to any factor other than the comparison of the marks. We will proceed to discuss that factor.

The Marks

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods are identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992). The goods in this case are identical. We also note our determination that NAUTICA is a famous mark as applied to apparel and personal fragrances. In particular, we note once again that fame, once established, is a dominant factor in the overall likelihood of confusion analysis.

Opposer argues that there is a likelihood of confusion between its NAUTICA mark and applicant's GET NAUTI mark. In asserting its arguments opposer points not only to its registration and use of NAUTICA, but also to the many variations on the NAUTICA mark which it has registered and/or used, including NAUTICARE, NAUTICAKIDS and NAUTEX. Applicant also disputes the importance of opposer's examples

Opposition No. 91177192

of some uses of opposer's NAUTICA marks where the marks are displayed in a manner which arguably separates NAUT or NAUTI from the other letters in the full mark, either by spacing or the appearance of segments of NAUTICA on different lines. Opposer's Brief at 9-11.

With regard to applicant's mark opposer also argues:

With "get" used in the intransitive form, Applicant's mark means to become or to grow to be NAUTI, which could mean either that one would somehow become associated with a consumer's impression of NAUTI (e.g., things of the water/things nautical, or Opposer, Nautica), or it could be a play on the word "naughty." Regarding the first meaning, and given Nautica's use of variations of its mark for particular product lines, and given Nautica's presence as a "lifestyle brand," GET NAUTI may be perceived as a NAUTICA variant and as a way to associate oneself with the NAUTICA brand and lifestyle.

Id. at 13.

Opposer also argues that NAUT is an abbreviation for NAUTICAL, that both NAUT and NAUTI could be perceived as meaning NAUTICAL in the context of applicant's mark and that NAUTI is the dominant element of its NAUTICA mark.

On the other hand, applicant argues that its "... GET NAUTI Mark differs substantially in appearance, sound, connotation and commercial impression from Opposer's Marks." Applicant's Brief at 10.

Applicant points out that the marks opposer asserts here include numerous variations on opposer's NAUTICA mark. Applicant is correct. However, contrary to applicant's

Opposition No. 91177192

argument, in this case the fact that opposer has used numerous variations of the NAUTICA mark is helpful to opposer. For purposes of our comparison, however, we will focus on the NAUTICA mark itself, the mark we have found to be famous.

Applicant argues that GET NAUTI differs from NAUTICA in appearance because GET NAUTI neither begins with nor incorporates NAUTICA, because GET NAUTI is two words and NAUTICA is one, because NAUTICA does not begin with either GET or G, and because none of opposer's marks incorporate NAUTI either alone or as a prefix or suffix. Applicant also argues more generally that the respective marks differ because they begin differently. Furthermore, applicant argues that it would be improper to treat the letters "N A U T I" as a prefix used in the NAUTICA marks.

As to sound, applicant argues that the marks differ in sound because its mark begins with "GET" and because NAUTI as used in its mark differs in sound from the NAUTI... component in opposer's mark - applicant's mark would be pronounced as "naughty" while the "I" in NAUTICA would be pronounced as a soft "I".

As to connotation and commercial impression, applicant argues that its mark is in the form of an imperative statement consisting of the verb get and the adjective "NAUTI" (naughty). Applicant argues that the understood

Opposition No. 91177192

subject is "you," apparently referring to the potential purchaser. Applicant submits that the only connotation or commercial impression which GET NAUTI could project is that of GET NAUGHTY. In posing this argument applicant relies, in part, on the appearance of the erotic book titles, *Nauti Dream*, *Nauti Nights* and *Nauti Boy* in the articles referenced above as evidence that the public would perceive "NAUTI" only as "get naughty" in encountering its mark. Applicant contends further that none of opposer's asserted marks, including NAUTICA certainly, convey any similar impression. Applicant asserts that opposer's argument that potential purchasers may perceive "get" as meaning "obtain" and "NAUTI" as referring to opposer's goods as "preposterous." Applicant's Brief at 18.

Applicant also argues that, even if we regard NAUTICA as a famous mark, the differences between the respective marks are such that the marks should not be considered confusingly similar.

We conclude that NAUTICA and GET NAUTI are similar, taking into account the fact that NAUTICA is famous and the fact that the goods of the parties are identical, at least in part. While there are obvious differences between the respective marks in appearance and sound, we find that similarities in connotation and commercial impression are

overriding and that the marks are confusingly similar when viewed overall.

The parties agree that one potential perception of GET NAUTI is as the phrase GET NAUGHTY. We agree. However, we reject applicant's contention that this is the one and only way in which potential purchasers for the relevant goods might perceive GET NAUTI.

We have no evidence as to why applicant chose to misspell NAUGHTY -- and to do so in a particular way, that is, as NAUTI. Nonetheless, we must address the fact that applicant's mark includes this particular misspelling and that it is part of a mark applicant intends to apply to goods identical to those of opposer.

We find applicant's evidence regarding the apparent use of NAUTI in the titles of erotic books lacking in probative value in the context at hand. The evidence falls short in both quality and quantity. Furthermore, we reject applicant's larger argument that the relevant public is likely to perceive its mark only as a misspelling of the phrase GET NAUGHTY. We find that potential purchasers of apparel and fragrances are likely to perceive a second meaning, that is, a reference to opposer's famous mark NAUTICA, more specifically, as an invitation to purchase (obtain) opposer's goods. We not only reject applicant's

assertion that such a possibility is preposterous, but we find it likely.

We reject applicant's arguments based purely on an analysis of the syntax of the term GET NAUTI; these arguments border on the hypertechanical. In this case the fact that GET NAUTI is two words or that GET comes first are not controlling. Opposer has argued, based on dictionary evidence, that NAUT is an abbreviated form of NAUTICAL. We have confirmed this; *Merriam-Webster's Collegiate Dictionary* (11th ed. 2003) includes the following entry: "**naut** abbr nautical."⁵ "NAUTI," as used in applicant's mark, conveys a similar impression, that is, as a shortened form of NAUTICA, a famous mark.

We also reject applicant's argument that we must find that the marks are not similar even if we find that NAUTICA is famous, as we have. Applicant urges an overly narrow view of the scope of protection the law affords a famous mark, precisely the view the Court of Appeals for the Federal Circuit explicitly rejected. The Court stated:

The fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d

⁵ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

158, 160, 117 USPQ 295, 296 (CCPA 1958). This court's predecessor stated:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.

Id. at 160. Thus, a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

A competitor can quickly calculate the economic advantages of selling a similar product in an established market without advertising costs. These incentives encourage competitors to snuggle as close as possible to a famous mark. This court's predecessor recognized that a mark's fame creates an incentive for competitors "to tread closely on the heels of [a] very successful trademark." *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 920, 134 USPQ 504, 508 (CCPA 1962). Recognizing the threat to famous marks from free riders, this court's predecessor allowed "competitors [to] come closer" to a weak mark. *Sure-Fit Prods.*, 254 F.2d at 160. A strong mark, on the other hand, casts a long shadow which competitors must avoid. *See, e.g., Nina Ricci*, 889 F.2d at 1074.

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. For this reason, this court emphasizes:

When an opposer's trademark is a strong, famous mark, it can never be "of little consequence". The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

Specialty Brands, 748 F.2d at 675; see also *B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 730, 6 USPQ2d 1719, 1722 (Fed.Cir. 1988) (Nies, J. now C.J., dissenting) ("a purchaser is less likely to perceive differences from a famous mark.") (emphasis in original). In accord with the same principles, this court states:

[T]here 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, 889 F.2d at 1074 (quoting *Planter's Nut*, 305 F.2d at 924-25).

Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 22 USPQ2d at 1456. In this case applicant's GET NAUTI mark treads too close to the famous NAUTICA mark.

Accordingly, in this case we have considered the appearance, sound, connotation and commercial impressions of NAUTICA and GET NAUTI, as well as the fame of the NAUTICA mark and the fact that the goods of the parties are identical, and conclude that the marks are confusingly similar. For the record, while we have focused on opposer's

famous NAUTICA for purposes of this analysis, the fact that opposer has used numerous variations on this mark, as the record establishes, confirms our conclusion here. The evidence of the use of NAUTICA in varying forms shows that relevant consumers are conditioned to see NAUTICA used in varying forms.

Conclusion

Finally, after considering all evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments which we have not specifically discussed here, we conclude that there is a likelihood of confusion between opposer's NAUTICA mark as applied to the goods identified in its registrations in International Classes 3 and 25 and applicant's GET NAUTI mark as applied to the goods in International Classes 3 and 25 identified in the opposed application.

Dilution

In view of our finding for opposer on its likelihood-of-confusion claim, we need not reach opposer's dilution claim.

Decision: We sustain the opposition as to both International Classes 3 and 25.