

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 16, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Nautica Apparel, Inc.

v.

Nauti Marine
—

Opposition No. 91205138
—

Stephen L. Baker of Baker & Rannells for Nautica Apparel, Inc.

Bruno Tarabichi of Owens Tarabichi for Nauti Marine.
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Before Quinn, Cataldo and Gorowitz, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Nauti Marine (“Applicant”) filed, on December 12, 2011, an intent-to-use application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register on the Principal Register the mark NAUTI LIFE (in standard characters) for “bathing suits; beachwear; beanies; board shorts; flip flops; hats; shirts; tank tops” in International Class 25.

Nautica Apparel, Inc. (“Opposer”) opposed registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant’s

mark, when applied to Applicant's goods, so resembles Opposer's numerous previously used and registered and famous NAUTICA and NAUTICA formative marks for clothing, including beachwear, fragrance products, beach and boating goods, furniture, watches, accessories and various other goods and services, as to be likely to cause confusion. Opposer raised two additional grounds: that Applicant's mark is likely to dilute Opposer's mark through dilution by blurring and tarnishment pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c); and that Applicant's mark falsely suggests a connection with Opposer under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).¹

Applicant, in its answer, denied the salient allegations in the notice of opposition.

The record consists of the pleadings; the file of the involved application; and Opposer's testimony deposition of Margaret Bizzari, Opposer's director of intellectual property, with voluminous related exhibits. Applicant neither took testimony nor offered any other evidence. Only Opposer filed a brief at final hearing.

FINDINGS OF FACT

Opposer established ownership of fifty-eight valid and subsisting registrations of NAUTICA or variations thereof. The most relevant registrations are set forth below.

¹ Opposer did not mention the Section 2(a) claim in its brief. Accordingly, we deem this claim to be waived. *See Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).

Registration No. 1862585 for the mark NAUTICA, in typed form,² for “footwear” in International Class 25;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. 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. 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. 3591811 for the mark NAUTICA OPTIONS, in standard characters, for “dress shirts; jackets; men’s suits; neckwear; overcoats; pants” in International Class 25;

Registration No. 3837562 for the mark NAUTICA, in standard characters, for “bathing suits; belts for clothing; belts made from imitation leather; blouses; dress shirts; dresses; foul weather gear; gloves; hats; jackets; jeans; men’s suits; outer jackets; over coats; pajamas; pants; rain coats; robes; scarves; shirts; shorts; skirts; socks; sport

² Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (April 2014).

³ This registration and other registrations which include NAUTICA as a separate term include a translation of NAUTICA as “nautical.”

coats; sweaters; swim trunks; swimwear; T-shirts; ties; underwear; vests” in International Class 25;

Registration No. 3841455 for the mark NAUTICA, in standard characters, for “retail store and on-line retail store services featuring wearing apparel, fashion accessories, home fashions, eyewear, luggage, watches and personal care products” in International Class 35;

Registration No. 3850360 for the mark NAUTICA, in standard characters, for “wet suit gloves; wet suits; wet suits for water-skiing and sub-aqua” in International Class 25; and

Registration No. 3888149 for the mark NAUTICA ISLAND, in standard characters, for “blazers; caps; coats; hats; jackets; pants; shirts; shorts; sweaters; swimsuits; T-shirts” in International Class 25.

We will focus our attention on Registration Nos. 1862585 and 3837562.

Opposer also has previously used (but not registered) a variety of other variations of its NAUTICA mark in connection with clothing. (Bizzari dep., pp. 16-22, Ex. 4; see examples in Opposer’s Brief, pp. 11-13). For purposes of this proceeding, Opposer’s claim of common law rights is unnecessary and we have not considered it in making our decision.

Opposer is the source of a wide variety of consumer products, ranging from clothing and footwear to fragrances and toiletries. All are sold under the mark NAUTICA and variations of that mark. NAUTICA is what is known as a “lifestyle brand”:

They’ve [Opposer] grown in the sense that first they came out with a fragrance. Then they came out with eyewear, then watches. Then they moved into home goods such as beddings, furniture, luggage. What a lifestyle brand is you want the consumer to live a NAUTICA lifestyle, so they

will smell like NAUTICA, wear NAUTICA, sleep in NAUTICA, use NAUTICA in cooking, in every aspect of their lives.

(Bizzari dep., pp. 11-12)

Indeed, the record shows that Opposer has engaged in the coordinated marketing of a variety of products using a consistent concept or image characterized by nautical themes.

The core products in Opposer's NAUTICA line of products are apparel. Opposer began using its NAUTICA mark on apparel in 1983. Over the past thirteen years, Opposer's annual sales under its NAUTICA marks in the United States have averaged over \$840 million. (Bizzari dep., p. 40; Ex. 14). Opposer enjoys the fifth largest market share in the menswear category in the United States (excluding private label brands), behind the likes of Ralph Lauren and Levi's. (Bizzari dep., pp. 44-46; Ex. 16).

Opposer's goods are sold in department stores, specialty stores, NAUTICA free-standing stores, and discount stores (*e.g.*, Sams Club and Costco). (Bizzari dep., pp. 24-29). Further, the goods are sold in department stores like Macy's (with over 800 stores) in what is called a "store within a store"; in this setting, all NAUTICA branded clothing is displayed exclusively in a single area. (Bizzari dep., p. 26; Ex. 5). The goods also are sold through the Internet at <nautica.com> and <amazon.com>. (Bizzari dep., p. 25).

Opposer's annual expenditures in advertising and promotional efforts over the past thirteen years have averaged over \$31 million. (Bizzari dep., pp. 40-41; Ex. 14). The NAUTICA brand is advertised through television (60 Minutes, NCIS and

Wheel of Fortune), in radio commercials, and print ads (in national publications such as *Oprah*, *People*, *Vanity Fair* and *Elle*), as well as through the Internet and catalogs. (Bizzari dep., pp. 32-35; Exs. 8, 10, and 11). Opposer promotes itself and its products through sponsorship agreements for various athletic, musical and charitable events (Nautica Malibu Triathlon, NYC Triathlon, Legg Mason Tennis Classic, and U.S. Sailing Team). (Bizzari dep., pp. 38-40; Ex. 13). Market research puts annual consumer impressions or encounters with Opposer's marks at almost 2 billion per year. *Id.* Opposer also promotes its brand through social media, such as Facebook, Twitter and Instagram; on Facebook, Opposer has over 3.8 million followers or "friends." (Bizzari dep., pp. 32-33; Ex. 9). Opposer further enjoys substantial publicity by way of voluminous unsolicited references in the media to Opposer's products and NAUTICA marks. (Bizzari dep., pp. 41-43; Ex. 15). The examples of U.S. media articles indicate widespread exposure to the NAUTICA marks in the United States in a wide variety of publications over an extended period of time.

STANDING

Opposer has established its standing to oppose registration of the involved application. In particular, Opposer has properly made of record its pleaded registrations of its various NAUTICA marks. Thus, opposer has shown that it is not a mere intermeddler. Opposer's registrations of its marks establish that Opposer has standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir.

1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

PRIORITY

In view of Opposer's ownership of valid and subsisting registrations of its NAUTICA marks, Opposer's priority is not in issue with respect to the goods identified in those registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).⁴

LIKELIHOOD OF CONFUSION

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors in the proceeding now before us, are discussed below.

FAME

Opposer claims that its NAUTICA mark is famous. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir.

⁴ As indicated earlier, for purposes of this proceeding we rely on Opposer's prior rights based on its registrations and not the common law rights Opposer may have.

2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Because of the extreme deference accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); and *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). 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).

Opposer has continuously used its mark NAUTICA on clothing for thirty years. During this time, Opposer's sales under the mark have been impressive, and it has made substantial expenditures in advertising and promotional efforts through national media. Furthermore, the evidence of public recognition, as reflected in unsolicited media attention, is significant. By all accounts, Opposer, under its NAUTICA brand, is a market leader in the apparel field.

Therefore, we find 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.

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 Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 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.”). It is sufficient if a likelihood of confusion is found with respect to use of Applicant’s mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Applicant’s identification reads “bathing suits; beachwear; beanies; board shorts; flip flops; hats; shirts; tank tops.” Opposer’s Registration No. 1862585 for the mark NAUTICA in typed characters identifies “footwear”; Registration No. 3837562 for the mark NAUTICA in standard characters covers, *inter alia*, “bathing suits; swimwear; shorts; hats; and hats.” Thus, to the extent indicated, the parties’ goods are identical in part.⁵

In addition, the other Class 25 goods listed in Opposer’s Registration No. 3837562 are closely related to the goods identified in the present application.

⁵ The same is true for registrations Opposer asserts for variations of the NAUTICA mark, including NAUTICA BLUE, NAUTICA COMPETITION, NAUTICAKIDS and NAUTICA ISLAND.

We find that the parties' goods are identical in part, or otherwise closely related. This *duPont* factor strongly favors Opposer's position.

TRADE CHANNELS

Because the goods of the parties are identical, in part, we presume 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, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade."). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehoffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). As in these cases, here too, there are no trade-channel restrictions in the opposed application, nor in the registrations we have noted.

Accordingly, this factor strongly favors Opposer's position.

THE VARIETY OF OPPOSER'S GOODS ON WHICH MARK IS USED

Under the ninth *duPont* factor Opposer argues that the NAUTICA mark is used with a large variety of goods. (Opposer's Brief, pp. 18-20). The registrations Opposer asserts, including ones not specifically mentioned in this decision, 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 the goods in its asserted registrations and those identified in the opposed application include goods which are offered to consumers generally at various price points, and are not exclusively expensive goods offered to sophisticated purchasers. We agree. The identified goods are apparel 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 MARKS

We now direct our attention to the *du Pont* factor of the similarity/dissimilarity between the marks. We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1960 (Fed. Cir. 2005), quoting *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567. "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Moreover, in comparing

the marks, we are mindful that where, as here, Applicant's goods are identical to Opposer's goods in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The marks are similar in sound and appearance. Although Applicant's mark includes the additional term "LIFE," purchasers in general are inclined to focus on the first word or portion in a trademark; in Applicant's mark, "NAUTI" is the first word. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("It is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered."). See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. This first word is very similar in sound and appearance to Opposer's mark NAUTICA.

As to meaning, "naut" is defined as an abbreviation for the term "nautical." (<m-w.com>); thus, Applicant's mark, when used in connection with bathing suits, flip flops, and the like, conveys the idea of "nautical life" or a nautical lifestyle. As indicated earlier, Opposer's mark NAUTICA means "nautical." Thus, the marks are similar in meaning.

We find that NAUTICA and NAUTI LIFE are similar in sound, appearance, and meaning, and overall commercial impression, taking into account the fact that

NAUTICA is a famous mark, and the fact that the parties' goods are, at least in part, identical. In this case the addition of the suggestive term "LIFE" in Applicant's mark is not sufficient to distinguish it from Opposer's NAUTICA mark, but more likely to be viewed as identifying a variation or subset of clothing lines offered by the source identified as NAUTICA. Although we have focused on Opposer's famous mark NAUTICA for purposes of our analysis, the fact that Opposer has registered numerous variations of this mark for clothing and related items, as the record establishes, confirms our conclusion here. The evidence of registration of NAUTICA in varying forms shows that consumers are conditioned to see NAUTICA in varying forms. That is, consumers are likely to perceive Applicant's mark as identifying a variation of or a line of NAUTICA products and, thus, are likely to be mistaken that Applicant's goods are licensed or sponsored by, or are in some way connected, related or associated with Opposer.

The similarity between the marks is a factor that weighs in Opposer's favor.

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 marks on goods similar to those at issue here. Opposer also argues that the record shows that Opposer has policed its mark. We agree. We would find NAUTICA to be a strong mark with or without this evidence because of the evidence establishing the fame of Opposer's NAUTICA mark for wearing apparel.

Accordingly, this factor favors Opposer's position.

CONCLUSION

We conclude, after considering all evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments that we have not specifically discussed herein, that there is a likelihood of confusion between Opposer's NAUTICA mark and Applicant's mark NAUTI LIFE for identical clothing items.

As a final note, the case law is clear that famous marks enjoy a wide latitude of protection. "Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark When an opposer's trademark is a strong, famous mark, it can never be of little consequence." *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1897, quoting *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1456.

DILUTION

Having determined that Opposer is entitled to prevail in this opposition proceeding based upon its Section 2(d) claim of likelihood of confusion, we need not reach the merits of Opposer's dilution claim. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990).

DECISION

The opposition is sustained, and registration to Applicant is refused.