

THIS OPINION IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Krisp

Mailed: March 10, 2016

Opposition No. 91212653

Nautica Apparel, Inc.

v.

Majestique Corporation

Before Cataldo, Kuczma and Greenbaum,  
Administrative Trademark Judges.

By the Board:

### **Background**

Majestique Corporation (“Applicant”) filed an application on March 22, 2013, to



register the design mark on the Principal Register for the following

International Class 25 goods:

adult novelty gag clothing item, namely, socks; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic footwear; belts; belts for clothing; bottoms; clothing shields, namely, pads applied to the underarms of shirts, blouses and sweaters; footwear; footwear for men and women; footwear not for sports; headbands for clothing; jackets; leather belts; short sets; ties; tops; travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; wearable garments and clothing,

namely, shirts; women's clothing, namely, shirts, dresses, skirts, blouses.<sup>1</sup>

Nautica Apparel, Inc. (“Opposer”) filed a notice of opposition on the grounds of 1) likelihood of confusion pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d); 2) false suggestion of a connection pursuant to Trademark Act § 2(a), 15 U.S.C. § 1052(a);<sup>2</sup> and dilution by tarnishment and dilution by blurring, pursuant to Trademark Act § 43(c), 15 U.S.C. § 1125(c). Opposer pleaded ownership of

1) fifteen registrations for the design mark  which, collectively, cover goods in International Classes 3, 6, 9, 12, 14, 16, 18, 20, 24, 25, 27 and 28;<sup>3</sup> and

2) one registration for the design mark



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<sup>1</sup> Application Serial No. 85883577 is based on Applicant’s allegation of use of the mark in commerce pursuant to Trademark Act Section 1(a). Applicant asserted a date of first use anywhere and date of first use in commerce of June 27, 2012.

<sup>2</sup> In the notice of opposition, Opposer does not sufficiently allege all required elements of a claim that Applicant’s mark falsely suggests a connection with Opposer’s name or identity, which are: 1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; 2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; 3) the person or institution identified in the mark is not connected with the goods sold by Applicant under the mark; and 4) the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when Applicant’s mark is used on its goods. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508-10 (Fed. Cir. 1983); *Buffet v. Chi Chi’s, Inc.*, 226 USPQ 428 (TTAB 1985).

<sup>3</sup> Registration Nos. 2730498, 2730499, 2767263, 2769600, 2769601, 2769603, 2769608, 2769609, 2830338, 2832351, 2872026, 3512345 3861194, 3861195 and 3864888.

for “men's clothing; namely, jackets and knit and woven shirts” in International Class 25.<sup>4</sup>

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

On December 2, 2015, Applicant filed a motion for summary judgment, pursuant to Fed. R. Civ. P. 56(a), with respect to likelihood of confusion. The motion is fully briefed.

At the outset, we note Applicant’s January 4, 2016 motion (“motion requesting resolution of motion for summary judgment”) requesting that the Board grant its motion for summary judgment as conceded. Applicant’s motion is denied. By operation of Trademark Rules 2.127(e)(1) and 2.119(c), Opposer’s brief in opposition filed on January 4, 2016, is timely.

### **Analysis**

Summary judgment is appropriate where the movant demonstrates that there is no genuine dispute as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great Am. Music Show Inc.*,

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<sup>4</sup> Registration No. 1871390.

970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The party seeking judgment in its favor carries the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986).

Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. TBMP § 528.01 (2015), and cases cited therein.

To prevail on summary judgment, Applicant must demonstrate that there is no genuine dispute of material fact that contemporaneous use of the parties' respective marks on or in connection with their respective goods or services would not be likely to cause confusion, mistake or to deceive consumers. *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

### **Priority**

In its motion, Applicant does not address priority as between the parties' use of the involved design marks.<sup>5</sup> Priority is an essential element of Opposer's claim. Inasmuch as Opposer made of record with its brief status and title copies of its sixteen pleaded registrations, from the USPTO's Trademark Electronic Search System

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<sup>5</sup> Applicant summarily addresses priority vis-à-vis the marks SAILOR and "Nautica brand." (28 TTABVUE 18). As explained herein, the SAILOR mark is not at issue in this proceeding.

(TESS),<sup>6</sup> priority is not an issue on summary judgment as to Opposer's two pleaded marks for the goods identified in its pleaded registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

### **Likelihood of confusion**

The determination of likelihood of confusion on summary judgment is based on an analysis of all of the probative facts that are properly in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Regarding the similarity of the marks, we note that certain of Applicant's arguments are inherently faulty. Applicant discusses dissimilarities between Opposer's pleaded marks and Applicant's mark SAILOR (the latter being the subject of two of Applicant's registrations that are *not* involved in this proceeding); similarly, Applicant compares its mark SAILOR with Opposer's mark NAUTICA, ostensibly emanating from its assertions that the parties' labels include both their designs *and* the words NAUTICA and SAILOR, respectively, and that each party's involved mark is a composite mark comprised of "both a word and a design."<sup>7</sup> To be clear, this proceeding involves only the parties' respective *design* marks (as set forth

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<sup>6</sup> 33 TTABVUE 60-123; Declaration of Margaret Bizzari, ¶ 6.

<sup>7</sup> 28 TTABVUE 17-18.

hereinabove). Applicant's arguments focused on the marks SAILOR and NAUTICA are inapposite.

To the extent that Applicant addresses the similarity or dissimilarity of the *involved* marks as to appearance, sound, connotation and commercial impression, its arguments are mainly based on a side-by-side comparison, and center in large part on technical differences between sailboat sails and types of boats.<sup>8</sup> Conversely, Opposer advances the position that consumers in the marketplace will perceive each mark as generally consisting of a design of a sail boat and its sails.<sup>9</sup> In this regard, Opposer properly focuses on the overall commercial impressions created by the marks and the recollections of the average purchasers who normally retain a general impression of trademarks. Such an approach is appropriate. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

To show that Opposer's mark is weak, Applicant states that "sailboats and sails are commonly used by many merchants" and that "there are 1,831 sailboats design marks registered at the USPTO;"<sup>10</sup> it submits TESS printouts for 26 registrations for marks that include designs, for various goods and services, wherein the term

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<sup>8</sup> 28 TTABVUE 13-14, 17. In pertinent part, Applicant argues that its mark "resembles a sailboat with a hull, and multiple sails, in the old Schooner type boat ... (that) resembles the type of sailboat used by Christopher Columbus, not the modern type of rig used in sloops or racing sailboats," whereas Opposer's mark "resembles a Sloop type of sails and shows no hull and it is not a sailboat."

<sup>9</sup> 33 TTABVUE 10.

<sup>10</sup> 28 TTABVUE 6.

“sailboat” appears in the description of the mark.<sup>11</sup> For its part, Opposer states under the declaration of counsel that his search of TESS for live registrations covering Class 25, and having design code 18.07.05, yielded only 49 records, 4 of which are owned by Opposer, and submits the record list display that shows the terms searched and the list of search results.<sup>12</sup>

On the similarity or dissimilarity of the goods as described in the application and registrations, Applicant argues that Opposer’s pleaded marks are registered “for different classes which are irrelevant to the issues in this case,”<sup>13</sup> and that Applicant only sells products in Class 25 and does not compete with Opposer in any other class. For its part, Opposer states that certain of the parties’ goods are identical - socks, pants, hats and caps, belts, footwear, footwear for men and women, jackets, ties, shirts, blouses - and that the remaining goods are highly similar and related; it points to the identifications of goods in its pleaded registrations.<sup>14</sup> Opposer is correct. The parties’ goods need not be identical, but need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Applying that here, Opposer’s goods outside of International Class 25 are not irrelevant to the likelihood of confusion analysis.

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<sup>11</sup> 28 TTABVUE 147-197.

<sup>12</sup> 33 TTABVUE 26 - 30; Declaration of John M. Rannells, ¶ 4, Exh. 1.

<sup>13</sup> 28 TTABVUE 7.

<sup>14</sup> 33 TTABVUE 11; 33 TTABVUE 32, Bizzari Decl., ¶ 6, Exh. 2.

Regarding trade channels, Applicant, who is a corporation of and located in Puerto Rico, argues that the parties' goods are sold at different stores, stating that Opposer's goods "are sold in Puerto Rico only in (Opposer's) specialized stores" and that the parties' goods are not sold at the same outlets in the United States.<sup>15</sup> In response, Opposer delineates, by store name, thousands of stores in the United States in which its goods are sold, names various third-party retailers in Puerto Rico at which its goods are sold, and states that at least one store in Puerto Rico has sold both parties' goods.<sup>16</sup>

Addressing another *du Pont* factor, Opposer maintains that its mark is famous,<sup>17</sup> submits annual sales figures and advertising expenditures for 2008 through 2014, states that it had the No. 2 market share in menswear from 2004 through 2007, and identifies the thousands of stores in which it offers its goods.<sup>18</sup>

### **Findings**

In summary, on this record there is a genuine dispute with respect to, at a minimum, the similarities between the parties' involved and pleaded marks, the similarities between the parties' identified goods, and the trade channels for the parties' goods.<sup>19</sup> Applicant has not carried its burden of demonstrating that it is

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<sup>15</sup> 28 TTABVUE 16.

<sup>16</sup> 33 TTABVUE 34-35; Bizzari Decl., ¶ 9-10.

<sup>17</sup> 33 TTABVUE 13-15.

<sup>18</sup> 33 TTABVUE 34-36, Bizzari Decl., ¶ 9-13.

<sup>19</sup> We further note that some of Applicant's exhibits on summary judgment suffer from infirmities that greatly limit their probative value. Exhibits 1 and 7 are not self-authenticating under Trademark Rule 2.122(e) and are not properly authenticated (*e.g.* by affidavit or declaration). TBMP § 528.05(e) (2015). Additionally, these exhibits are not accompanied by an English translation. TBMP § 104 (2015). *Cf. Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012)

entitled to judgment as a matter of law pursuant to Fed. R. Civ. P. 56(a). In view of the findings herein, Applicant's motion for summary judgment is denied.

The evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Moreover, the fact that we have identified certain issues that are in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

### **Schedule**

Proceedings are resumed. Remaining trial dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	<b>5/2/2016</b>
Defendant's Pretrial Disclosures due	<b>5/17/2016</b>
Defendant's 30-day Trial Period Ends	<b>7/1/2016</b>
Plaintiff's Rebuttal Disclosures due	<b>7/16/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>8/15/2016</b>

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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(printed publications submitted in a foreign language without translations are of limited probative value).

