

This Opinion is not a  
Precedent of the TTAB

Mailed: October 21, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Nautica Apparel, Inc.*

v.

*Christine P. Palmerton d/b/a Par Yacht Charters, LLC*

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Cancellation No. 92056754

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

Eve J. Brown of Suffolk University Law School  
for Christine Palmerton.

Before Rogers, Chief Administrative Trademark Judge, Richey, Deputy Chief  
Administrative Trademark Judge, and Heasley, Administrative Trademark Judge.

Opinion by Heasley, Administrative Trademark Judge:

On January 16, 2008, Christine Palmerton (“Registrant” or “Respondent”)  
applied to register the following mark in design plus words format:



Respondent's application (Serial No. 77373724), based on Section 1(a) of the Trademark Act, claimed first use of the mark in commerce since January 4, 2008, on tote bags for boating supplies in class 18, mugs and beverage glassware in class 21, and playing cards in class 28. Published on August 11, 2009, the application encountered no opposition, and matured into Registration No. 3700731 on October 27, 2009.

**I. The Parties' Pleadings.**

On January 30, 2013, four years after the registration issued and five years after Respondent's claimed date of first use, Nautica Apparel, Inc. ("Petitioner") petitioned to cancel Respondent's registration on the grounds of priority of use and likelihood of confusion, Trademark Act § 2(d), 15 U.S.C. § 1052(d), as well as dilution, Trademark Act § 43(c), 15 U.S.C. § 1125(c), and false suggestion of a

connection with Petitioner, Trademark Act § 2(a), 15 U.S.C. § 1052(a).<sup>1</sup>

Petitioner bases its petition on forty-seven (47) federally registered trademarks for NAUTICA or variations thereof. The most pertinent and representative of these are:

1. Registration No. 1580007 for the mark **NAUTICA** in stylized form, for *inter alia* “umbrellas, luggage, trunks, duffle bags, garment bags for traveling, travel kits and leather boxes in the nature of jewelry boxes” in class 18.<sup>2</sup>
2. Registration No. 1873011 for the mark NAUTICA, in standard character format, for *inter alia* “wallets, hipfold wallets, trifold wallets, key cases, tie cases for travel, shoulder bags, tote bags; clutch bags, carry-on bags” in class 18.<sup>3</sup>
3. Registration No. 2306324 for the mark NAUTICA in standard character format, for “glass and plastic beverageware; dinnerware; candlesticks not of precious metal” in class 21.<sup>4</sup>
4. Registration No. 1613918 for the mark

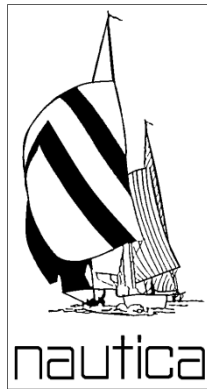
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<sup>1</sup> Petitioner did not pursue the § 2(a) claim in its trial brief, so this claim is deemed waived. TBMP § 801.01 (2015). *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) *aff’d* 565 F. Appx. 900 (Fed. Cir. 2014).

<sup>2</sup> Issued January 30, 1990, based on use in commerce since at least as early as January 5, 1987. Renewed, March 10, 2010.

<sup>3</sup> Issued January 10, 1995, based on use in commerce since at least as early as April 1991. Renewed, May 1, 2015.

<sup>4</sup> Issued January 4, 2000, based on use in commerce since at least as early as January 1998. Renewed, January 23, 2010.



in design plus words format, for “men, women and children’s wearing apparel namely, hosiery, shoes, undershirts, undershorts, shirts, blouses, trousers, pants, jackets, coats, suits, bathing suits, bathrobes, slippers, and shorts” in class 25.<sup>5</sup>

5. Registration No. 3076794 for the mark NAUTICA COMPETITION, in standard character format, for “luggage, carry-on bags garment bags for travel, duffle bags, shoulder bags, tote bags, clutch bags, wallets and key cases” in class 18.<sup>6</sup>

Each of Petitioner’s registrations states that the English translation of the word “NAUTICA” is “nautical.”

Respondent’s Answer denied the salient allegations in the Petition, and further asseverated that Petitioner’s claims were barred by the doctrines of laches, estoppel, and waiver.<sup>7</sup> Other affirmative defenses amplified upon the denials in the body of the Answer.

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<sup>5</sup> Issued on September 18, 1990 based on use in commerce since at least as early as May 3, 1985. Renewed, October 12, 2010.

<sup>6</sup> Issued on April 4, 2006 based on use in commerce since at least as early as January 1996. Renewed, April 29, 2015.

<sup>7</sup> 9 TTABVue.

## II. Preliminary Issues.

As a preliminary matter, Petitioner objects that Respondent's trial brief "is almost devoid of any citations to the trial record" in violation of Trademark Trial and Appeal Board Manual of Procedure (TBMP) §801.03 (2015).<sup>8</sup> While it is true that the record is large (primarily due to Petitioner's filings), and Respondent's citations to that record are sparse, we are nonetheless able to discern the sections to which the brief refers, and therefore overrule this objection. Second, Petitioner objects that Respondent's brief, "misstates facts or conveniently paraphrases them for her benefit," by claiming, for example, that Petitioner is a seller of "classic, traditional menswear."<sup>9</sup> We are aware of the goods and services identified in Petitioner's registrations, and base our decision on the record evidence, not the parties' characterizations thereof. Third, Petitioner objects that Respondent relies upon "items from Internet searches that are not made of record."<sup>10</sup> We will only consider evidence properly made of record during the parties' testimonial periods, and sustain this objection to the extent that Respondent alludes to matters outside the trial record. Fourth, Petitioner objects that Respondent's trial brief impermissibly contains references to settlement discussions between the parties.<sup>11</sup> Such communications are privileged under Fed.R.Evid. 408, so this objection is sustained and the communications will not be considered. Fifth, Petitioner objects that Respondent filed a trial brief without a table of authorities, which is required by

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<sup>8</sup> 134 TTABVUE 6; Petitioner's Reply Brief, p. 4.

<sup>9</sup> Id.

<sup>10</sup> Id. citing Respondent's Brief at 9n.7, 29n.21, and 31n.23.

<sup>11</sup> Id. See 131 TTABVUE and 132 TTABVUE 12-13; Respondent's Trial Brief, pp. 11-12.

TBMP § 801.3. Respondent timely filed the trial brief on February 17, 2015,<sup>12</sup> inadvertently omitting the table of authorities, then re-filed the brief the next day, admitting the error and curing the omission.<sup>13</sup> Absent any prejudice (and none has been shown), we overrule this objection and will consider Respondent's trial brief as submitted with the table of authorities.<sup>14</sup>

Sixth, Petitioner objects that Respondent (a businesswoman in Washington State) submitted a third notice of reliance containing, in part, an article from a local Washington State paper, the *Bellingham Herald*, entitled "David vs. Goliath – Whatcom County business owner fights trademark battle with Nautica." The article recounted the origins of the instant case, with quotes from Respondent and her counsel, and announced an online "Reader Poll," asking whether Petitioner was right in claiming that Respondent's mark "is too similar in name and logo."<sup>15</sup> Petitioner moved to strike this article because the notice of reliance failed to describe its relevance, as required by Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), and because the contents of the article, including the online poll, constituted hearsay and were irrelevant to the Board's determination of likelihood of confusion under the *DuPont* factors.<sup>16</sup>

On consideration of the motion, the Interlocutory Attorney required Respondent to state the relevance of the article, and deferred until trial the Board's

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<sup>12</sup> 131 TTABVUE 3.

<sup>13</sup> 132 TTABVUE, 133 TTABVUE.

<sup>14</sup> 132 TTABVUE.

<sup>15</sup> 119 TTABVUE, Section 2.

<sup>16</sup> 120 TTABVUE; *In re E.I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

determination of its admissibility.<sup>17</sup> Respondent accordingly submitted an amended third notice of reliance, arguing that the article—including the results of the reader poll, which purportedly polled 1,200 readers—was relevant to show the dissimilarity of the marks in the mind of the general public, the lack of any likelihood of confusion between the marks, and concurrent use of the parties' marks without actual confusion in the marketplace.<sup>18</sup> Petitioner renewed its motion to strike concurrently with its trial brief.<sup>19</sup>

Petitioner's motion is well taken. The views of Respondent and her counsel are admissible via testimonial deposition and trial brief, not by newspaper article. TBMP §§ 703, 801.02(b). And the views of the public, if any, should be obtained by an impartial survey conducted by a qualified expert, not by an unscientific poll, conducted in an undisclosed method, of potentially biased local citizens who were introduced to the dispute by newspaper coverage of Respondent and her counsel. *See Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1091 (TTAB 2012). Accordingly, section two of Respondent's third notice of reliance lacks probative value, and will not be considered.

Finally, Petitioner objects that Respondent's third notice of reliance, section four, consists of search results for the term "NAUTI" under Google.com's "Shopping Tab,"<sup>20</sup> which Respondent has introduced to show extensive third party use of

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<sup>17</sup> 124 TTABVUE.

<sup>18</sup> 125 TTABVUE.

<sup>19</sup> 126 TTABVUE 55.

<sup>20</sup> Petitioner's Motion to Strike, p. 5; 126 TTABVUE 59.

‘NAUTI’ in commerce.<sup>21</sup> Petitioner argues that, “[I]nternet search summaries, which essentially are links to the website pages, are not admissible by notice of reliance.”<sup>22</sup> *Citing* TBMP § 704.08(b) and *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1219 (TTAB 2011). *Calypso Technology*, however, dealt with “search summaries, which are more in the nature of listings of documents, i.e., the website pages that the summary links to, than to the documents per se.” *Id.* The search results from Google’s “Shopping Tab,” in contrast, display the landing pages of the websites in thumbnail format.<sup>23</sup> Moreover, Petitioner did not raise this issue in its prior motion to strike,<sup>24</sup> which would have afforded Respondent the opportunity to cure the deficiency. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013); TBMP § 707.02(b). Accordingly, we will not strike this evidence, but will consider Petitioner’s outstanding objection in evaluating its probative value. TBMP § 707.02(c). Petitioner argues, with some merit, that these search results are at best of limited probative value, as they do not show the context in which the “NAUTI” term is used is used on the web pages, if the goods depicted are actually being offered for sale, and if they can actually be purchased.<sup>25</sup> *See Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1360 (TTAB 2014). For the reasons stated, we agree that this evidence is of limited probative

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<sup>21</sup> Respondent’s Amended Third Notice of Reliance, section four, 125 TTABVUE 58 et seq.

<sup>22</sup> Petitioner’s Motion to Strike, p. 5; 126 TTABVUE 59.

<sup>23</sup> Respondent’s Amended Third Notice of Reliance, section four, 125 TTABVUE 58 et seq.

<sup>24</sup> 120 TTABVUE.

<sup>25</sup> Petitioner’s Motion to Strike, p. 5; 126 TTABVUE 59.



value; it does not show that third party use of ‘NAUTI’ in commerce is extensive; it merely shows that third parties may choose to use “NAUTI” on or in connection with certain goods. This evidence does not affect our determination of Petitioner’s claims.

### **III. Evidence of Record.**

The trial record includes the following testimony and evidence:

#### **A. Petitioner’s evidence.**

1. The testimony deposition of Nina Flood, Vice President of Marketing for VF Sportswear, Inc., the parent company of petitioner, with exhibits.<sup>26</sup>
2. The testimony deposition of Margaret Bizzari, Director of Intellectual Property and Product Liability for VF Sportswear, Inc., with exhibits.<sup>27</sup>
3. Notices of reliance on certain interrogatory responses and excerpts from the deposition of Respondent.<sup>28</sup>
4. Notices of reliance on TESS and TSDR printouts showing the status and title of Petitioner’s pleaded registrations for the mark NAUTICA and variations thereof for the identified goods and services.<sup>29</sup>
5. Notices of reliance on third party registrations.<sup>30</sup>
6. Notices of reliance on dictionary definitions of “naut” and “nauti.”<sup>31</sup>

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<sup>26</sup> 27-79 TTABVUE.

<sup>27</sup> 81-105 TTABVUE.

<sup>28</sup> 23 TTABVUE.

<sup>29</sup> 24 TTABVUE.

<sup>30</sup> 24 TTABVUE.

<sup>31</sup> 25 TTABVUE.

**B. Respondent's evidence.**

1. The testimony deposition of Christine Palmerton with exhibits.<sup>32</sup>
2. A first notice of reliance on the discovery deposition of Mark DiMuro, Vice President/Licensing Controller of VF Sportswear, Inc., with exhibits; the discovery deposition of Nina Flood, Vice President of Marketing for VF Sportswear, Inc., with exhibits; and the discovery deposition of Jennifer Sacco, Petitioner's Director of Global Marketing and Licensing, with exhibits.<sup>33</sup>
3. A second notice of reliance with Petitioner's answers to certain interrogatories and responses to certain requests for admission.<sup>34</sup>
4. An amended third notice of reliance with (1) pages from Respondent's website at [www.nautigirl.biz](http://www.nautigirl.biz), (2) a newspaper article in the *Bellingham Herald* dated August 3, 2014, (3) pages from Petitioner's website at [www.nautica.com](http://www.nautica.com), and (4) Google Shipping search results for the search term "nauti," revealing third party use of "nauti" in commerce.<sup>35</sup>

**IV. Standing and Priority.**

Petitioner has standing to bring this cancellation proceeding. It has pleaded and proven its ownership of registrations for the NAUTICA marks,<sup>36</sup> thus

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<sup>32</sup> 107-116 TTABVUE.

<sup>33</sup> 117 TTABVUE.

<sup>34</sup> 118 TTABVUE.

<sup>35</sup> 119 TTABVUE; in accordance with our ruling on Petitioner's motion to strike, section 2 of the third notice of reliance will not be considered.

<sup>36</sup> 24 TTABVUE.

demonstrating a direct and personal stake in the outcome of this proceeding, and has sufficiently alleged that it believes it will be damaged by the continued registration of Respondent's mark. 15 U.S.C. § 1064. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Because both parties own registrations, Petitioner must prove priority of use in order to prevail. *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010) (in a cancellation proceeding where both parties own registrations, priority is always an issue because both parties are entitled to the presumptions accorded a registration under Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c)). *See also, Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) ("Of course, petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date."). Petitioner, which has properly introduced its pleaded registrations into the trial record,<sup>37</sup> prevails on the priority issue on the basis of its earlier filing date of the underlying applications for the registrations made of record in this proceeding, as those dates establish constructive use.

## **V. Likelihood of Confusion.**

The issue before us is whether the mark in Respondent's registration consists of or comprises a mark that so resembles one or more of Petitioner's registered NAUTICA marks as to be likely, when used on or in connection with the goods identified in Respondent's registration, to cause confusion, mistake, or deception. 15

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<sup>37</sup> 24 TTABVue.

U.S.C. § 1052(d). In determining this issue, based on the evidence and arguments presented, we consider the relevant factors bearing on likelihood of confusion enunciated in *In re E.I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) and more recently in *In re Majestic Distilling Co. Inc*, 315 F.3d 1311, 1314-15, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Petitioner bears the burden of proving likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). As detailed below, we conclude that likelihood of confusion has not been established.

**A. Similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.**

To determine whether Respondent's mark resembles one or more of Petitioner's marks within the meaning of Section 2(d), we turn to the first *DuPont* factor, focusing on the similarity or dissimilarity of the marks in their entirety, as to appearance, sound, connotation, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371-72, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Petitioner claims that the parties' marks are "virtually identical" in appearance, sound, and commercial impression.<sup>38</sup> Respondent's registered mark appears as follows:

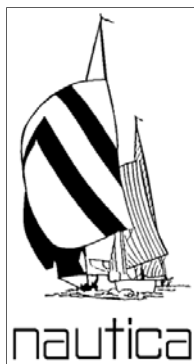
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<sup>38</sup> 126 TTABVue 20, Petitioner's trial brief, p. 15.



Its design depicts a determined-looking woman with blue 1920's style hair, wearing a sailor's cap, her scarf flying in the wind, standing at the helm of a boat, holding a martini with olives in one hand and the ship's wheel in the other. A sign in front of the ship's wheel bears the word portion of the mark, "NAUTIGIRL DARE TO BE NAUGHTY."<sup>39</sup>

Petitioner's marks, on the other hand, are either NAUTICA word marks in standard character or stylized form: **NAUTICA** or word and design marks containing a fairly staid and conservative depiction of a sailboat logo over the word NAUTICA:



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<sup>39</sup> Registration No. 3700731.

In appearance, then, the parties' marks are markedly different.

Petitioner argues that the parties' marks share the prefix NAUTI, and that the word portions of the respective design-plus-words marks should predominate because they would be used by purchasers to request the goods.<sup>40</sup> While the words in a composite word and design mark are often considered dominant, that is not always the case. *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014)(design predominant in word and design mark). In *Covalinski*, graphic devices in the REDNECK RACEGIRL word and design mark drew attention to the very large, prominently displayed letters "RR," filled with a checkerboard pattern resembling a racing flag; this led in turn to an elongated horizontal "leg" of each R, containing the smaller letter strings "edneck" and "acegirl." The Board therefore found that the mark's word portion was dominated by its design features. *Id.* at 1168. Accordingly, where, as here, a mark such as Respondent's contains a prominent, highly distinctive design that catches the consumer's eye, then leads it to the word portion, the design can be the dominant element of the mark. *Id.* citing *Parfums de Coeur Ltd v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007); *Ferro Corp. v. Ronco Labs, Inc.*, 356 F.2d 123, 124, 148 USPQ 497, 498-99 (CCPA 1966).

Moreover, the sound of the marks is dissimilar. The NAUTI element of NAUTICA is more likely to be pronounced with a short "i" sound, as a shortening of the word "nautical," given the use by Petitioner of sailboat imagery. The same

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<sup>40</sup> 126 TTABVue 25; Petitioner's trial brief, p. 20.

element of Respondent's mark is likely to be pronounced with a long "e", sounding like "naughty."

As Respondent testified at deposition:

Q. How do you pronounce the N-A-U-T-I element in your mark?

A. Naughty.<sup>41</sup>

Consumers are prompted to adopt this intended pronunciation by the mark's full wording: NAUTIGIRL DARE TO BE NAUGHTY. Ordinarily, such a minor distinction in the pronunciation of a vowel would be inconsequential, except that in this case, it affects the connotation of the marks.

The brand NAUTICA, a truncated form of "nautical," connotes, in Petitioner's words, "a lifestyle brand that takes its inspiration from the water and the nautical lifestyle. Nautica's brand message promises to take you to the water, making you feel buoyant whether you're at the water or not. The brand conveys a love of the water and a passion for being in a community of people that love the water, a bit of adventure, a bit of exploration, confidence. Nautica's products—whether for the home, the body or an accessory, all speak to a nautical lifestyle, being spirited and carefree—which emulates the sensation almost all people have when they get to the water."<sup>42</sup>

Respondent's NAUTIGIRL DARE TO BE NAUGHTY mark plays on two words—nautical and naughty. In one sense, the prefix NAUTI connotes things

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<sup>41</sup> 107 TTABVUE 12; Testimonial Deposition of Christine Palmerton, p. 11.

<sup>42</sup> 126 TTABVUE 10, Petitioner's trial brief at 5; citing deposition testimony from Nina Flood, Vice President of Marketing for Petitioner's parent company, VF Sportswear, Inc.

nautical—a connotation reinforced by the design elements of ship’s helm, sailor’s cap, and water background.



Respondent adopted the mark because she wanted to create a brand that appeals to the female boater. As she testified, ““Nauti representing the boating lifestyle, and the girl, the brand was designed for female boaters. And I wanted a fun playful name. And I wanted a tag line, dare to be naughty.”<sup>43</sup> This tag line—reinforced by the martini glass in the design—conveys the other sense of “NAUTI”: that “She’s having fun along the way.”<sup>44</sup> Respondent’s registered mark is thus “a fun play on words,”<sup>45</sup> bearing both connotations.

With respect to the overall commercial impression conveyed by the parties’ marks, Petitioner’s Vice President of Marketing, Nina Flood, was asked at deposition:

Q. So is it your position then as marketing manager, as VP of marketing that brands that have N-A-U-T and have water-related imagery would be confusing to consumers?

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<sup>43</sup> 107 TTABVUE 8; Testimonial Deposition of Christine Palmerton, p. 7.

<sup>44</sup> 107 TTABVUE 9; Testimonial Deposition of Christine Palmerton, p. 8.

<sup>45</sup> 107 TTABVUE 59-60; Testimonial Deposition of Christine Palmerton, p. 58-59.



A. Yes.<sup>46</sup>

That epitomizes Petitioner's position. It charges that, "The Registrant selected the term "Nauti" in her mark as a term associated even in its truncated form with things nautical. The meaning of the root 'naut' and/or 'nauti' is of things nautical. There can be no valid argument to the contrary."<sup>47</sup> "The Nautica marks and the variations used by Nautica similarly refer to things that are nautical and are advertised, marketed, and promoted as such."<sup>48</sup> The breadth of Petitioner's position becomes clear when it describes the expanse of goods and services it claims are covered by its marks:

The NAUTICA brand has developed and evolved into what is commonly referred to as a "lifestyle brand" that extends across a broad range of consumer products used by people in their normal day-to-day lives, including without limitation, clothing, fragrances, bedding, tabletop, mugs, bags, eyewear, watches, home goods, furniture, automobiles, etc. The core DNA of the brand extends into many different categories of business and different product lines. With a lifestyle brand the customer is asked to live a NAUTICA lifestyle, so they smell like NAUTICA, wear NAUTICA, sleep in NAUTICA, use NAUTICA in cooking, in every aspect of their lives.<sup>49</sup>

As Respondent puts it, this "is an attempt by Petitioner to secure a monopoly over the generic prefix "NAUT" and the entire nautical theme."<sup>50</sup> In effect, it covers the waterfront.

Unfortunately for Petitioner, its position runs afoul of the anti-dissection rule. This rule requires that marks be considered in their entirety in determining

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<sup>46</sup> 117 TTABVUE 78; Deposition of Nina Flood, p. 50.

<sup>47</sup> 126 TTABVUE 25; Petitioner's trial brief, p. 20.

<sup>48</sup> 126 TTABVUE 28; Petitioner's trial brief, p. 23.

<sup>49</sup> 126 TTABVUE 9; Petitioner's trial brief, p. 4.

<sup>50</sup> 132 TTABVUE 5; Respondent's trial brief, p. 4.

likelihood of confusion. “It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.” *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007, 212 USPQ 233, 234 (C.C.P.A. 1981) quoted in *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1340, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015). *Accord In re National Data Corp.*, 753 F.2d 1056, 1058n.3, 224 USPQ 749, 751n. 3 (Fed. Cir. 1985).

The rule recognizes that consumers do not parse marks into their elemental details, but retain an overall, general impression of marks as a whole. This overall commercial impression must be compared to determine whether confusion is likely. *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 1340, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007)(“It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.”).

Here, Petitioner’s position violates the anti-dissection rule by focusing on the shared prefix NAUTI. Since this common element is, it admits, an abbreviation of the descriptive word “nautical,”<sup>51</sup> it is no wonder that Respondent’s mark evokes, at least in part, a nautical theme.

That, however, does not demonstrate that Respondent’s mark, considered in its entirety, creates the same overall commercial impression as Petitioner’s marks. The mere fact that parties’ marks share commonplace terms does not *ipso facto* render them confusingly similar. For example, in *Ferro Corp. v. Ronco Labs., Inc.*,

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<sup>51</sup> 126 TTABVue 25; Petitioner’s trial brief, p. 20.

356 F.2d 122, 148 USPQ 497 (C.C.P.A. 1966) the opposer, Ferro Corporation, owned, at one point, nine federal registrations for marks containing the prefix FERRO or a variation thereof. Nonetheless, its opposition to an application for the mark FERRO-GARD and design was dismissed, and the dismissal was affirmed by the Federal Circuit, which observed, “It is not believed that appellant is, by virtue of prior registrations, entitled to the sole possession of the term ‘ferro.’” *Id.*, 356 F.2d at 124, 148 USPQ at 499. Similarly, in *Sports Authority Michigan, Inc. v. PC Authority, Inc.*, 63 USPQ2d 1782 (TTAB 2002) the shared laudatory term AUTHORITY did not render THE SPORTS AUTHORITY and THE PERSONAL COMPUTER AUTHORITY confusingly similar. In those cases, as here, the shared dissected terms, though overlapping, were not sufficiently distinctive to be source-indicating, and did not engender a likelihood of confusion; consumers had to look to the parties’ marks in their entireties to determine the sources of goods and services.

Respondent’s mark, considered in its entirety, with all design and word elements taken together, creates a wholly different commercial impression from Petitioner’s marks. It is design-dominant, featuring the NautiGirl, captain of her own ship. Its wording, NAUTIGIRL DARE TO BE NAUGHTY reinforces this image, conveying a nautical and naughty double meaning that transcends the mere nautical theme to which Petitioner lays claim. Its words and design thus complement and reinforce one another, creating, on the whole, an entirely different

commercial impression than Petitioner's marks.<sup>52</sup>

In sum, the marks are dissimilar in their entireties as to appearance, sound, connotation, and commercial impression. This weighs heavily against Petitioner's claim of likelihood of confusion. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). A single *DuPont* factor "may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998), quoted in *Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 1346-47, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010).

#### **B. Fame of the Prior Marks.**

Petitioner has submitted record evidence of continuous use of the NAUTICA mark since 1983;<sup>53</sup> sales of NAUTICA goods averaging over \$833 million per year in the United States for the last thirteen years;<sup>54</sup> advertising and promotional

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<sup>52</sup> Petitioner points to a number of prior proceedings before the Board in which it has, for example, successfully opposed intent-to-use applications for marks such as NAUTIGIRL in standard character format for eyewear and apparel, Opposition No. 91165909, and GET NAUTI in standard characters for *inter alia* fragrances and apparel, Opposition No. 91177192. 103 TTABVUE 1-214. The nonprecedential decisions to which Petitioner alludes, however, concerned different marks from Respondent's NAUTIGIRL DARE TO BE NAUGHTY word and design mark, different evidentiary records, and different arguments of counsel, and were decided on their own merits, on a case-by-case basis. In this proceeding, based on careful application of the *DuPont* factors, in light of the evidentiary record, the arguments of the parties' counsel and controlling precedential authority, we find the parties' marks, considered in their entireties, dissimilar.

<sup>53</sup> 81 TTABVUE 12-14; Bizarri testimonial deposition, pp. 8-10.

<sup>54</sup> 27 TTABVUE 42-44; Flood testimonial deposition, pp. 41-43.

expenditures in excess of \$31 million per year for that same time period for goods other than fragrances;<sup>55</sup> advertising and promotions in well-known publications, such as *People*, and *Cosmopolitan*, in newspapers such as the *Boston Globe*, *New York Times*, *Wall Street Journal*, and *Washington Post*, and on major networks such as CBS, NBC, ABC, and A & E;<sup>56</sup> and receipt of unsolicited media attention from publications such as *Forbes*, the *Chicago Sun-Times*, *Harper's Magazine*, and the *Boston Globe*. (This last category, of unsolicited media coverage, weighs in as the most voluminous bulk of Petitioner's evidence, occupying approximately 33 TTABVUE filings and several bankers' boxes full of print copies.)<sup>57</sup> For reasons such as these, Respondent admits, "Registrant does not dispute that Petitioner has achieved fame in its primary product lines of apparel, fragrances, and eyewear."<sup>58</sup> See e.g., *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 1371, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 352-53, 22 USPQ2d 1453, 1456 (Fed.Cir. 1992); *Palm Bay Imports*,

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<sup>55</sup> 27 TTABVUE 46-47; Flood testimonial deposition, pp 45-46.

<sup>56</sup> 27 TTABVUE 24; Flood testimonial deposition, p. 23.

<sup>57</sup> 34-79 TTABVUE.

<sup>58</sup> 132 TTABVUE 32-33; Respondent's trial brief, pp. 31-32. Respondent argues that NAUTICA's fame is limited to its primary product lines of apparel, fragrances, and eyewear." 132 TTABVUE 33; Respondent's trial brief, p. 32. Petitioner rejoins that it is a "lifestyle brand" that transcends product lines, as do other famous brands, such as Ralph Lauren, Eddie Bauer, and Tommy Hilfiger—brands that have branched out from their apparel-based, class 25 origins into products in a multiplicity of classes. 126 TTABVUE 38; Petitioner's trial brief, p. 33. We will consider this issue in the context of Petitioner's dilution claim, *infra*, to determine whether Petitioner's marks are widely recognized by the general consuming public of the United States as a designation of source. For our present purposes, though, even if we assume, without deciding, that Petitioner's NAUTICA marks are broadly famous for purposes of a Section 2(d) likelihood-of-confusion analysis, the determinative issue is whether, as Respondent argues, "...Petitioner's evidence of fame is also limited to its word mark 'NAUTICA,' and has not extended to any of its claimed variations." 132 TTABVUE 35, Respondent's trial brief, p. 34.

396 F.3d at 1374, 73 USPQ2d at 1694 (Fed. Cir. 2005).

It is well established, though, that evidence sufficient to prove fame for purposes of a 2(d) likelihood of confusion analysis may nonetheless be insufficient to establish likelihood of confusion. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1367, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012). As the Federal Circuit has declared, the likelihood of confusion standard:

...means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 USC § 1052(d).

*Univ. Of Notre Dame v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1374, 217 USPQ 505, 507 (Fed. Cir. 1983).

Here, Petitioner's evidence of fame extends to its full mark, NAUTICA—not the dissected prefix NAUT or NAUTI. Even if, by some stretch of the imagination, Respondent's NAUTIGIRL DARE TO BE NAUGHTY design-plus-words mark called one of Petitioner's NAUTICA marks to mind (an assumption that has not been proven), there is no reason to believe that the public would, in consequence, attribute Respondent's products to Petitioner.

In *Kellogg Co. v. Pack'em Enterprises, Inc.*, for example, the Board found on summary judgment that despite a shared prefix, the opposer's FROOT LOOPS mark was indisputably dissimilar from the applicant's FROOTEE ICE with elephant design:

The only similarity between these marks is that opposer's mark begins with the word 'FROOT', a misspelling of the descriptive term 'fruit,' and applicant's mark begins with the word 'FROOTEE', a misspelling of the descriptive word 'fruity.' Considering the marks in their entirety, we are of the opinion that they differ so substantially in appearance, sound, connotation and commercial impression that there is no likelihood that their contemporaneous use by different parties will result in confusion. We would be of this opinion even if opposer offered evidence at trial establishing that it has made prior and continuous use of its mark on goods, such as fruit-flavored frozen confections, which are very closely related to the goods identified in applicant's application; that the goods move through the same channels of trade to the same classes of purchasers; that the goods are purchased casually rather than with care; and that opposer's mark "FROOT LOOPS" has become a very strong and well known, indeed, famous, mark as applied to its goods in commerce. ... The first *Dupont* factor simply outweighs all of the others which might be pertinent to this case.

*Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990), *aff'd*, 951 F.2d 330, 333 (Fed.Cir. 1991). Here, as in that case, even if we assume that Petitioner's NAUTICA marks are famous for 2(d) purposes, Respondent's mark has nothing more in common with them than the prefix NAUTI and a nautical theme. It differs so substantially, when viewed in its entirety, that there is no likelihood of confusion.

The claim that any mark beginning with N-A-U-T and containing water imagery is confusingly similar to the NAUTICA marks, because of the degree of fame we discuss above, is tantamount to claiming that Petitioner has superior rights to all NAUT- or NAUTI- prefix marks for nautical-themed goods. We disagree. To hold otherwise would be to recognize in Petitioner the very sort of

right in gross that the Federal Circuit has warned against. *Univ. Of Notre Dame*, 703 F.2d at 1374.

Put another way, Petitioner's position tacitly asserts rights in a family of NAUT- or NAUTI- marks. While Petitioner does not explicitly claim ownership of such a family of marks, that is the implicit assumption on which its claims against Respondent are predicated. That exceeds the reach of its rights. According to the Federal Circuit:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). *Accord McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1275 (TTAB 2014).

Petitioner's mere registration of multiple NAUTICA marks is insufficient to establish the existence of a family of marks. In *Consolidated Foods Corp. v. Sherwood Medical Industries, Inc.*, 177 USPQ 279 (TTAB 1973), the opposer, owner of over 45 registrations for marks such as CREAMSICLE, FUDGSICLE, FRUITSICLE, NUTSICLE, CAKESICLE and the like, claimed to own the family of "SICLE" marks. The Board held, however, that, "[W]e are not persuaded on the record before us that opposer possesses a family of marks characterized by the term "SICLE" that is recognized as such by the general public. ... While the number of



these registrations is impressive, ... the registrations, per se, are manifestly incompetent to establish the extent of use of the registered marks, whether one or more of the registered marks have been promoted, advertised, used or displayed in any manner likely to cause an association or “family” of marks.... “ *Id.* at 282.

Petitioner admits that the full word NAUTICA appears on every product sold by Petitioner.<sup>59</sup> It does not license products with just NAUT or NAUTI.<sup>60</sup> It presents nothing that would lead consumers to consider either prefix—NAUT or NAUTI—a “family surname” for the NAUTICA marks. Indeed, according to reputable dictionaries, such as Merriam-Webster, or Webster’s Encyclopedic Unabridged Dictionary of the English Language, the prefix “naut” denotes things nautical, not necessarily NAUTICA.<sup>61</sup>

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<sup>59</sup> 118 TTABVUE 9, Petitioner’s response to Request for Admission No. 3. We note that Petitioner owns Registration No. 2697078 for NAUTEX for “fabrics for use in the manufacture of wearing apparel” and “jackets, coats, and foul weather gear, namely rain and snow jackets.” Petitioner has not adduced evidence of the extent of advertising, sales, promotion, and other forms of exposure of this particular mark to the purchasing public.

<sup>60</sup> 117 TTABVUE 12-13; deposition of Mark DiMuro, Vice President of Licensing/Controller of VF Sportswear, pp. 8-9.

<sup>61</sup> 126 TTABVUE 25; Petitioner’s trial brief, p. 20; 25 TTABVUE, Petitioner’s sixth notice of reliance. In its seventh notice of reliance, 25 TTABVUE, Petitioner submitted a webpage from [www.UrbanDictionary.com](http://www.UrbanDictionary.com), purporting to define “Nauti” as “The abbreviation Of The Word Nautica (Clothing Apparel and Accesories).” [sic] Unlike the *Merriam-Webster* and *Webster’s Encyclopedic Unabridged Dictionary of the English Language*, cited in Petitioner’s sixth notice of reliance, this entry, submitted by an unidentified person using the handle “JodieeOhBaby” on March 4, 2009, lacks probative value. Its source is unidentified, there is no evidence of review by a qualified editorial panel, and there is no corroborating proof that the term has that accepted meaning in common parlance. Cf. *In re IP Carrier Consulting Grp.*, 84 U.S.P.Q.2d 1028, 1032 (TTAB 2007)(inherent problems in reliability of entries in collaborative website). Purchasers have a propensity to shorten some names, e.g. *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992), but the evidentiary record does not demonstrate such a general propensity with regard to Petitioner or Respondent’s marks.

Respondent's word and design mark bears the prefix NAUTI, as part of NAUTIGIRL DARE TO BE NAUGHTY, but the NAUTI prefix interacts with the design elements—the sailor's cap, the ship's helm, the water background—to reinforce the nautical theme.



The NAUTI prefix also interacts with the slogan DARE TO BE NAUGHTY, which makes express its *double entendre*. In sum, while Petitioner has shown the fame of its marks for purposes of Section 2(d), that fame avails it naught, for even if some members of the public, viewing the NAUTI prefix in Respondent's mark, may recall one of Petitioner's marks, that does not establish that they would reasonably attribute the goods bearing Respondent's mark to Petitioner. *See Univ. Of Notre Dame*, 217 USPQ at 507.

### **C. The Nature of the Goods**

Respondent's registration covers tote bags for boating supplies in class 18, mugs and beverage glassware in class 21, and playing cards in class 28. Petitioner's cited marks cover men, women and children's apparel, tote bags, and

glass and plastic beverageware, among other products.<sup>62</sup> There is a direct overlap in the parties' tote bag goods and their glass beverageware. Even though Respondent has expressly limited her description to "tote bags for boating supplies," as Margaret Bizzari, Director of Intellectual Property and product liability for VF Sportswear, testified, "You could use [Respondent's tote bag] for anything.... It's a pretty standard tote bag. It does have a nautical theme to it, but you could use that for books. You could use that for groceries. You could use that for travel."<sup>63</sup>

Respondent's last identified category of goods, playing cards in class 28, does not overlap Petitioner's cited registrations, which cover such items as sport balls and flotation devices.<sup>64</sup> Petitioner attempts to bridge this gap by asserting "common law rights" for games and playthings in class 28, including poker card sets, based on testimony from Nina Flood, Vice President of Marketing and Strategy for VF Sportswear.<sup>65</sup> Her testimony, however, fails to demonstrate the duration and extent of use of Petitioner's marks on playing cards or similar goods sufficient to establish common law rights. Moreover, the Petition for Cancellation is predicated upon Petitioner's federal registrations, not common law use.<sup>66</sup> See *Odom's Tennessee Pride Sausage*, 93 USPQ2d at 2031(Fed. Cir. 2010)(Board need not consider unpleaded common law use); TBMP § 314 ("A plaintiff may not rely on an unpleaded claim.") Even though some of those registrations are in class 28, that,

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<sup>62</sup> 24 TTABVUE, Petitioner's cited registrations.

<sup>63</sup> 81 TTABVUE 75, Bizzari testimony, p.71.

<sup>64</sup> Registration Nos. 2865229 and 3850361.

<sup>65</sup> 126 TTABVUE 32; Petitioner's trial brief, p. 27, citing testimony of Nina Flood, Vice President of Marketing and Strategy for VF Sportswear, 27 TTABVUE 9.

<sup>66</sup> 1 TTABVUE.

standing alone, does not establish that the parties' goods in that class are related for purposes of determining likelihood of confusion. *Jean Patou, Inc. v. Theon Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed.Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216n. 5 (TTAB 1990)(goods in the same class are not necessarily related).

On the whole, though, most of Respondent's goods are either identical to or closely related to Petitioner's goods, and Petitioner has used its NAUTICA marks on a wide variety of goods. *See Chicago Bears Football Club, Inc. v. 12<sup>th</sup> Man/Tennessee LLC*, 83 USPQ2d 1073 (TTAB 2007). This *DuPont* factor favors Petitioner.

#### **D. Channels of Trade.**

Respondent asserts that, "it is literally impossible to encounter Respondent's and Petitioner's goods in the same place," because she sells her goods exclusively through her website, at specialty boating trade shows, and at select independent boutiques in the Pacific Northwest, whereas Nautica sells its goods at major department stores, through its own outlets, and through third-party sellers such as Linens N' Things and Amazon.<sup>67</sup> The standard, though, is not only established, but "likely-to-continue" trade channels. *DuPont*, 476 F.2d at 1361. Respondent's current channels of trade are more attributable to the start-up nature of her business than any inherent or permanent limitation on her means of offering her goods to the public. Her registration places no limitation on the means by which

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<sup>67</sup> 132 TTABVue 29-30; Respondent's trial brief, pp. 28-29.

she offers her goods for sale, and since the goods are, for the most part, identical or closely related to Petitioner's, we must presume that they would—or could in the future—travel in many of the same or similar channels of trade. *Genesco Inc. and Genesco Brands, Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003).

**E. Conditions of Sale and Classes of Consumers.**

Respondent's brand is designed for women, but targets men, as well. As Respondent states in an interrogatory answer, "The end users for Registrant's products are typically women and men between the ages of 35 and 75."<sup>68</sup> That is a broad segment of the market, and one that encompasses Petitioner's target consumers, as well. As Petitioner puts it, "Nautica's consumer base for lifestyle goods ... is very broad and is directed to both men and women with an affinity for the nautical lifestyle."<sup>69</sup>

Respondent's goods are sold at moderate prices for the most part—e.g., \$6.95 for playing cards, coffee mugs and travel mugs at \$14.95, and tote bags ranging from \$24.95 to \$198.00.<sup>70</sup> These are, according to Petitioner, similar to price points for NAUTICA goods.<sup>71</sup> Neither the prices nor the nature of the goods would impel ordinary consumers to engage in careful, sophisticated consideration of their purchases. *See ProMark Brands Inc. and H.J. Heinz Co. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1243 (TTAB 2015). This factor therefore favors Petitioner.

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<sup>68</sup> 23 TTABVUE, Respondent's answer to interrogatory no. 14.

<sup>69</sup> 126 TTABVUE 36; Petitioner's trial brief, p. 31; 27 TTABVUE 14-15; Flood testimony, pp. 13-14.

<sup>70</sup> 23 TTABVUE, Respondent's answer to Interrogatory No. 15 and Deposition exhibit displaying goods for sale at price points.

<sup>71</sup> 27 TTABVUE 60; Flood testimony, p. 59.

**F. Concurrent Use Without Evidence of Actual Confusion.**

Respondent began using her mark in commerce in January 2008, and applied to register it that month. Petitioner first learned of Respondent's application on or about January 28, 2008, through a trademark watch service.<sup>72</sup> Since then, the parties' marks have coexisted for over seven years. Yet when Petitioner was asked by interrogatory to describe "every instance of any inquiry or comment regarding an association between Petitioner's products on the one hand, and Respondent's products bearing Respondent's mark on the other hand," it admitted that, "Petitioner has not yet become aware of any such incident."<sup>73</sup>

Respondent's experience has been the same. At deposition, she was asked:

Q. So in the last six-and-a-half years that you've been using your mark, has anyone confused your brand with Nautica?

A. No.

Q. Has anyone contacted you wanting to purchase a Nautica item?

A. No, never.

Q. Has anyone ever asked you if you were affiliated with Nautica?

A. No, never.<sup>74</sup>

Petitioner first argues that the standard is likelihood of confusion, not actual confusion, and this is correct. As we have observed:

No one disputes the fact that the test under Section 2(d) of the statute is a likelihood of confusion and not the occurrence of actual confusion. But, actual confusion is obviously the best evidence of a likelihood of confusion, and the absence of actual confusion over a reasonable period

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<sup>72</sup> 118 TTABVUE, Petitioner's Answer to Interrogatory No. 2.

<sup>73</sup> 118 TTABVUE, Petitioner's Answer to Interrogatory No. 13.

<sup>74</sup> 107 TTABVUE 23; Testimonial Deposition of Christine Palmerton, p. 22.

of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.

*Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981).

Petitioner argues further that Respondent's sales from 2008 through 2013 were so *de minimis*-- 340 tote bags, 773 mugs, 299 glass beverage articles, and an unknown number of playing card decks—that the opportunity for actual confusion did not arise.<sup>75</sup> See *Gillette Canada, Inc. v. Ranir, Corp.* 23 USPQ2d 1768, 1774 (TTAB 1992). Further, Respondent has admitted that, due to differing channels of trade, “it is literally impossible to encounter Registrant's and Petitioner's goods in the same place.”<sup>76</sup> Thus if Respondent's sales alone were considered, apart from advertising, this factor would carry little weight.

Yet during that same period of time, Petitioner advertised and promoted its famous NAUTICA brand products extensively throughout the country, in print media, in regional newspapers, on national and regional broadcast television, generating billions of consumer impressions and substantial unsolicited media attention.<sup>77</sup> Petitioner touts the nationwide scope of its brand promotion:

Nautica's products are offered for sale and sold throughout the entire United States in many different channels of trade and distribution, including department stores, specialty stores (inclusive of mom and pop sized shops and marine goods stores (e.g., West Marine)), Nautica's own store which operate under the NAUTICA and NAUTICAKIDS marks (of which there are over 80 collectively), and over the Internet

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<sup>75</sup> 23 TTABVUE, Respondent's Answers to Interrogatories 1-4.

<sup>76</sup> 132 TTABVUE 29-30; Respondent's trial brief, pp. 28-29.

<sup>77</sup> 126 TTABVUE 39-46; Petitioner's trial brief pp. 34-41.

via Nautica's own websites and third party websites such as amazon.com and zappos.com.<sup>78</sup>

Further, even though Respondent's sales have been modest, Respondent maintains that she has engaged in extensive promotion and advertising of her brand at boat shows, at trade shows, through magazine and TV ads, and via her website, and estimates that her mark has been seen by hundreds of thousands of consumers.<sup>79</sup> Even though this estimate is unscientific, it is reasonable to infer that promotion and advertising have exposed Respondent's registered mark to appreciably more consumers than sales alone would reflect.

Even though Petitioner has extensively advertised and promoted its famous NAUTICA brands throughout the entire United States, and even though Respondent has engaged in concurrent advertising and promotion over the course of seven years, neither party can report even one instance of consumer confusion. This factor therefore weighs slightly in favor of Respondent.

#### **G. Weighing the Factors**

The parties' marks, viewed in their entirety, are far more dissimilar than similar. This factor takes on even greater significance when it is weighed together with the factors we have already considered: despite the fame of Petitioner's NAUTICA marks, despite some overlapping goods, despite the similar actual price points, despite the years of concurrent advertising to the same classes of consumers, Respondent's distinctive word and design mark, taken in its entirety, is so

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<sup>78</sup> 126 TTABVUE 39; Petitioner's trial brief, p. 34.

<sup>79</sup> 132 TTABVUE 30; Respondent's trial brief, p. 29.



dissimilar in appearance, sound, connotation, and commercial impression that it is unlikely to engender confusion with Petitioner's marks.

"In a particular case, any of the *du Pont* factors may play a dominant role." *Weider Publications, LLC v. D & D Beauty Care Company, LLC*, 109 USPQ2d 1347, 1361 (TTAB 2014) citing *In re E. I. DuPont de Nemours & Co.*, 177 USPQ at 567; *Kellogg Co. v. Pack'em*, 14 USPQ2d at 1550 (TTAB 1990), *aff'd*, 951 F.2d 330, 333 (Fed.Cir. 1991)(" We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive."). On balance, and taking into account the totality of the evidence of record, we find that Petitioner has failed to prove likelihood of confusion by a preponderance of the evidence.<sup>80</sup>

## VI. Dilution

Petitioner asserts that the NAUTICA marks are famous for purposes of protection against dilution by Respondent's mark, either by blurring or tarnishment, under 15 U.S.C. § 1125(c). A mark that achieves this level of fame is accorded a far greater swath of protection than one that is merely famous under Section 2(d) of the Trademark Act:

the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

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<sup>80</sup> We would reach the same conclusion even if we found the *DuPont* factor of actual confusion neutral, rather than to weigh slightly in favor of Respondent.

Trademark Act § 43(c)(1); 15 U.S.C. § 1125(c)(1).

Petitioner refers us to the same evidence of fame it adduced in support of its likelihood of confusion claim.<sup>81</sup> But “fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing.” 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:104 (4th ed.) (“The standard for the kind of ‘fame’ needed to trigger anti-dilution protection is more rigorous and demanding than the ‘fame’ which is sufficient for the classic likelihood of confusion test.”). Accordingly, a mark can acquire ‘sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.” *Coach Servs. Inc., v. Triumph Learning LLC*, 668 F.3d 1356, 1373, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012), quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007).

As our primary reviewing court has made clear, “It is well-established that dilution fame is difficult to prove.” *Coach*, 101 USPQ2d at 1724. A petitioner “must show that, when the general public encounters the mark ‘in almost any context, it associates the term, at least initially, with the mark's owner.” *Id.* at 1725. In other words, a famous mark is one that has become a ‘household name.” *Id.*

There are four non-exclusive factors to consider when determining whether a mark is famous:

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<sup>81</sup> 126 TTABVUE 50; Petitioner’s trial brief, p. 45. As noted in footnote 58, Respondent contends that the fame of Petitioner’s NAUTICA marks is limited to its product lines of apparel, fragrances, and eyeglasses, whereas Petition claims that NAUTICA is a “lifestyle brand,” transcending product lines.

- i. The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- ii. The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- iii. The extent of actual recognition of the mark.
- iv. Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A). *New York Yankees Partnership v. IET Products and Services, Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015); *McDonald's Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1286 (TTAB 2014).

Here, there is no doubt that Petitioner's NAUTICA marks are registered on the Principal Register.<sup>82</sup> Consumers recognize the NAUTICA marks most for apparel.<sup>83</sup> According to the record evidence, Petitioner Nautica Apparel's primary product lines are apparel and accessories,<sup>84</sup> which are important and large part of Nautica Apparel's offering to the public.<sup>85</sup> Its top product line in the United States is sportswear.<sup>86</sup> According to market research, Nautica Apparel was ranked as second in the menswear market share from 2004 to 2007, with about a 4% share, trailing Polo Ralph Lauren, which had about a 10% share; in December 2012, Nautica and Nautica Jeans had the third largest U.S. market share in the menswear category, with over 2.8% of the market.<sup>87</sup> Over the past thirteen years,

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<sup>82</sup> 24 TTABVUE.

<sup>83</sup> 117 TTABVUE 104; deposition of Jennifer Sacco, Director of Global Marketing and Licensing for Nautica, p. 15.

<sup>84</sup> *Id.*

<sup>85</sup> 27 TTABVUE 93; Flood testimonial deposition, p. 91.

<sup>86</sup> 117 TTABVUE 11; deposition of Mark DiMuro, Vice President of Licensing/Controller of VF Sportswear, p.7.

<sup>87</sup> 27 TTABVUE 48-49; Flood testimonial deposition, pp. 47-48; 126 TTABVUE 39; Petitioner's trial brief, p. 39. Ms. Flood was not aware of Petitioner purchasing market

Petitioner Nautica Apparel has invested an average of over \$31 million per year in advertising and promotion,<sup>88</sup> and has boasted U.S. sales averaging over \$833 million per year.<sup>89</sup> But the sales summaries on which Petitioner relies indicate that the lion's share of these sales still derives from apparel, such as men's sportswear, men's jeans and furnishings, and, to a lesser extent, women's sportswear, along with licensed fragrances.<sup>90</sup> Nautica claims 82% to 90% brand awareness among men and women, but that is limited to fashion consumers.<sup>91</sup> The summaries do not assist us in evaluating the general consuming public's recognition of the marks as a designation of source. Even the unsolicited third party publications adduced by Petitioner tend to group it with other makers of apparel:

*Forbes* 7/19/93: "Tried and true labels such as Liz Claiborne, Carole Little, Tommy Hilfiger, Ralph Lauren and Nautica."

*The Washington Post* 11/25/94: "This year, everybody's wearing Polo, Nautica and Tommy Hilfiger."

*Sun-Sentinel* 5/2/2002: "The sportswear apparel giant Nautica has become the official sunglass outfitter of the Stars & Stripes crew who are hoping to bring the America's Cup home."

*HFN* 12/15/2003: "The only textiles brands that mean anything are Ralph Lauren, Tommy Hilfiger and Nautica."<sup>92</sup>

Taken together, this record evidence tends to show that Nautica Apparel has achieved some level of fame for Section 2(d) purposes. But that fails to establish

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reports for product categories other than menswear. 27 TTABVUE 96-97; Flood testimonial deposition, pp. 93-94.

<sup>88</sup> 126 TTABVUE 40; Petitioner's trial brief, p. 35; 27 TTABVUE 46-47; Flood deposition, pp. 45-46.

<sup>89</sup> 126 TTABVUE 39; Petitioner's trial brief, p. 34.

<sup>90</sup> Sales summaries, Exhibit 21 to Flood testimonial deposition. 27 TTABVUE.

<sup>91</sup> 126 TTABVUE 38; Petitioner's trial brief, p. 33.

<sup>92</sup> 126 TTABVUE 44-45; Petitioner's trial brief, pp. 39-40.

that it is “widely recognized by the general consuming public of the United States as a designation of source,” which is the standard set by the dilution statute, 15 U.S.C. § 1125(c)(2)(A). By using the “general consuming public” as the benchmark, the Trademark Dilution Revision Act, which was signed into law on October 6, 2006, eliminated the possibility of “niche fame,” which some courts had recognized under the previous version of the statute. *Coach*, 101 USPQ2d at 1726. Under the current standard set by the TDRA, Petitioner has not established that it is a “household name,” and has not carried its burden of proving the NAUTICA marks are famous for purposes of protection against dilution.

**Decision:** The Petition for Cancellation is dismissed.