

This Opinion Is Not a
Precedent of the TTAB

Mailed: November 4, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Orlando Bathing Suit, LLC

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Serial No. 97782597

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Kevin S. Tuttle of Spencer Fane LLP, for Orlando Bathing Suit, LLC.

William Verhosek, Trademark Examining Attorney, Law Office 114,
Nicole Nguyen, Managing Attorney.

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Before Goodman, Thurmon and Myles, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Orlando Bathing Suit, LLC (“Applicant”) seeks registration on the Principal Register of the mark VITAMIN SEA, in standard characters, for: “Swimwear,” in International Class 25.¹ The Examining Attorney finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), finding a likelihood of confusion, based on the registered mark VITAMIN SEA, in standard characters, for, among other things, “scarves,” in International Class 25.² Applicant and the

¹ Application Serial No. 97782597 was filed on February 6, 2023, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 7065826 issued on May 30, 2023.

Examining Attorney have filed briefs and the appeal is ready for final decision. We affirm the refusal to register.

I. Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379-80 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686 1689 (Fed. Cir. 2018). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods or services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98

USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

II. Likelihood of Confusion – Analysis

In this appeal, we will address *DuPont* factors one, two and six. Applicant did not present its arguments according to the factors, but addressed the substance of these three factors, as did the Examining Attorney.

A. Similarity of the Marks

To evaluate the similarity of the marks, we consider the marks in their entireties as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d

1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019). *Accord*, *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“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). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic*, 127 USPQ2d 1627, 1630 (TTAB 2018).

The marks are identical. This fact increases the likelihood of confusion, and weighs heavily in our analysis.

B. Similarity or Relatedness of the Goods

Our evaluation of the second *DuPont* factor is based on the goods identified in the Application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A likelihood of confusion may be found if any goods recited in the identification of goods in a particular class in an application are related to any of the goods identified in the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *see also Double Coin Holdings Ltd. v. Tru Dev., Pro.*

No. 92063808, 2019 TTAB LEXIS 347, at *18; *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015).

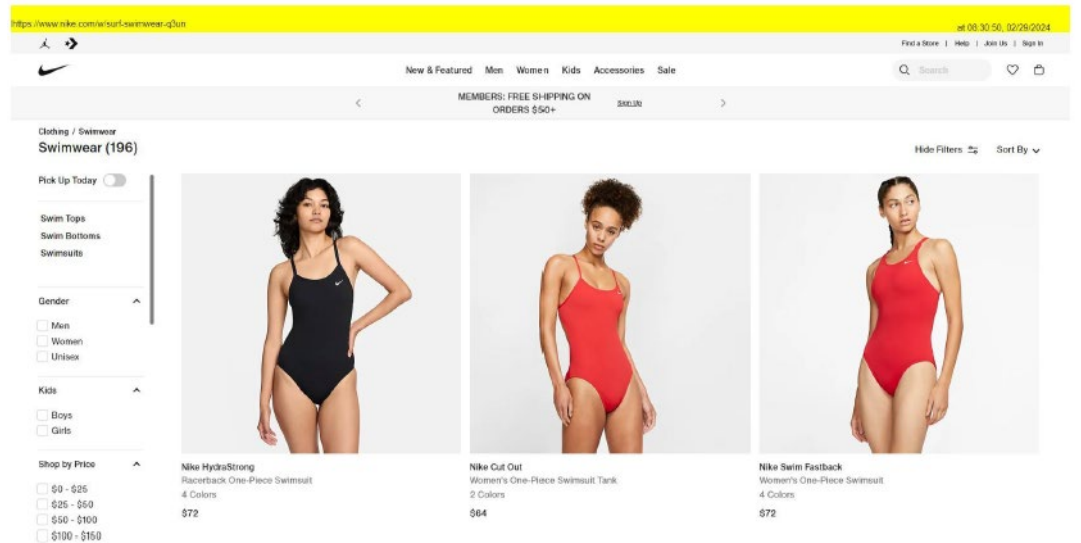
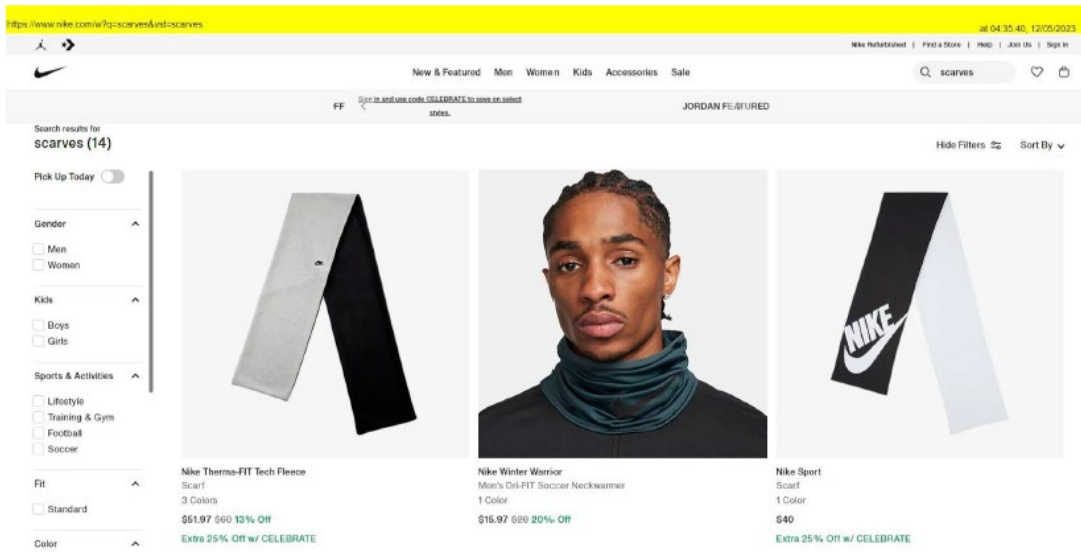
In addition, the goods need only be sufficiently related such that a consumer would be likely to assume, upon encountering the goods marketed under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1492 (TTAB 2007). A key inquiry under this factor is whether the evidence “suggests that consumers are accustomed to seeing a single mark associated with a source that sells both” types of goods. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018).

Applicant identifies “swimwear,” in International Class 25 and the cited registration identifies “scarves,” also in International Class 25.³ These are different products and the class of clothing and accessories is too broad to assume that consumers are accustomed to seeing all types of goods from this class sold under a single mark. We need evidence to determine whether these two types of clothing are related in a relevant manner, that is, whether consumers are accustomed to seeing both scarves and swimwear sold under a single mark.⁴

³ The Examining Attorney focused on scarves, one of the items identified in the cited registration. We note the registration also identifies “beach bags,” in International Class 18 and “towels,” in International Class 24. Despite the different classes, these goods appear to be complementary to the “swimwear” identified in the Application.

⁴ The original application identified “Footwear; Hats; Pareos; Rompers; Sarongs; Swimwear; Beach cover-ups; Bottoms as clothing; Tops as clothing,” in International Class 25. In its Request for Reconsideration, Applicant amended the identification of goods, limiting it to swimwear. Because the other goods were at issue during examination, the first Office Action and the final Office Action included evidence showing footwear, hats, pareos, and so on. When

There is evidence in the record showing both scarves and swimwear sold under the same mark, including the following examples from Nike.

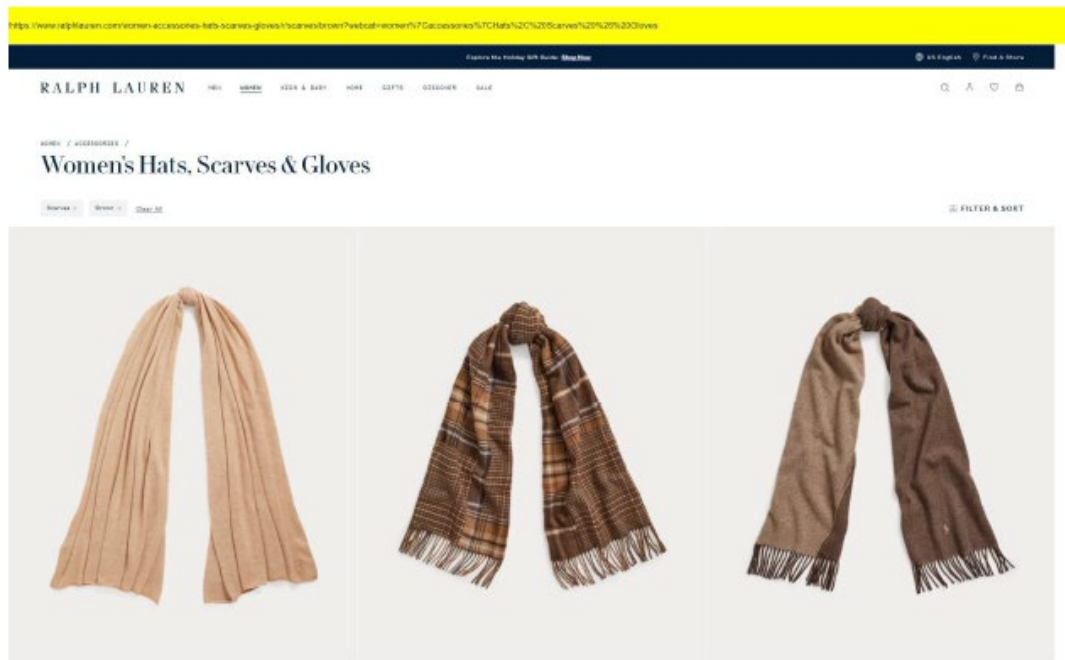


Applicant limited the identification to swimwear, the Examining Attorney submitted more evidence relating to swimwear.

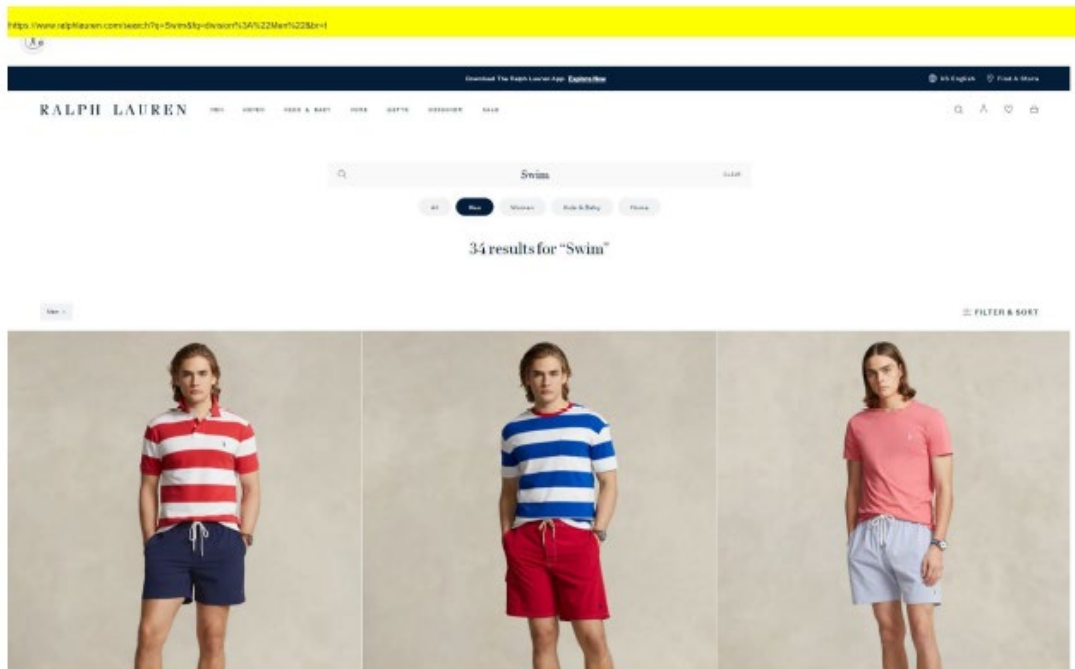
⁵ Final Office Action dated December 14, 2023, at 20.

⁶ Denial of Request for Reconsideration dated February 29, 2024, at 4.

There is similar evidence for the Ralph Lauren brand, as shown below.



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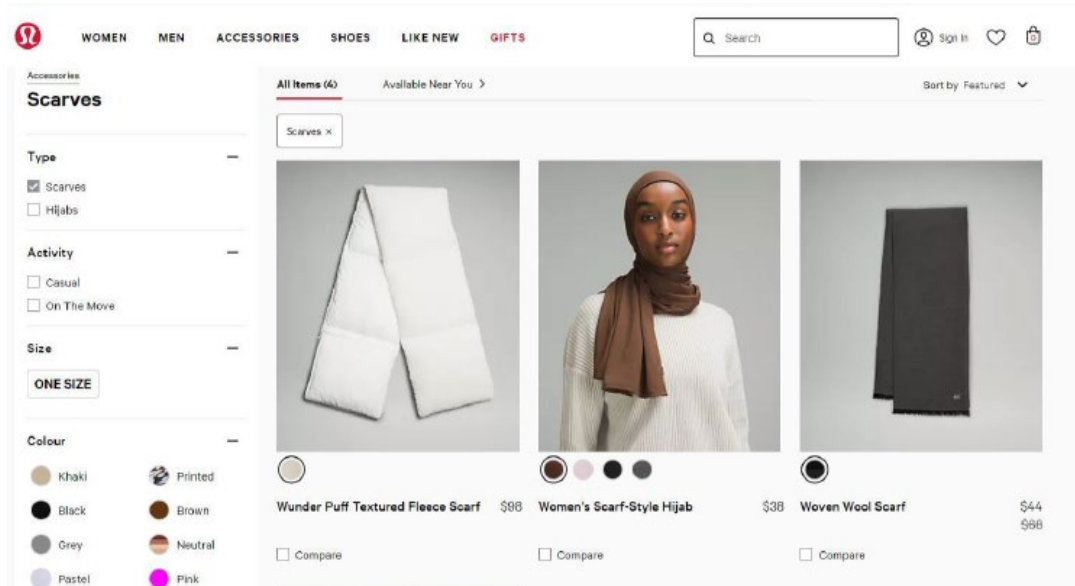


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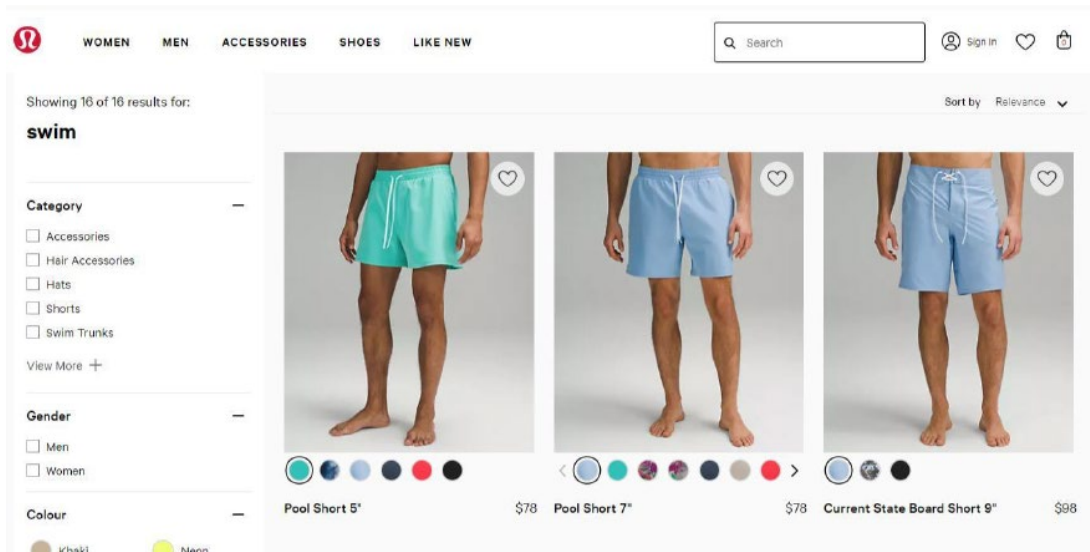
⁷ Office Action dated November 6, 2023, at 15.

⁸ Denial of Request for Reconsideration dated February 29, 2024, at 12.

And more of the same from the Lululemon brand.



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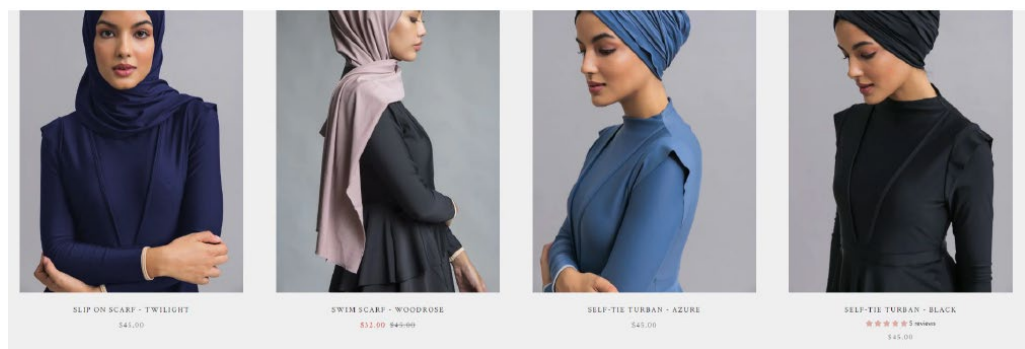
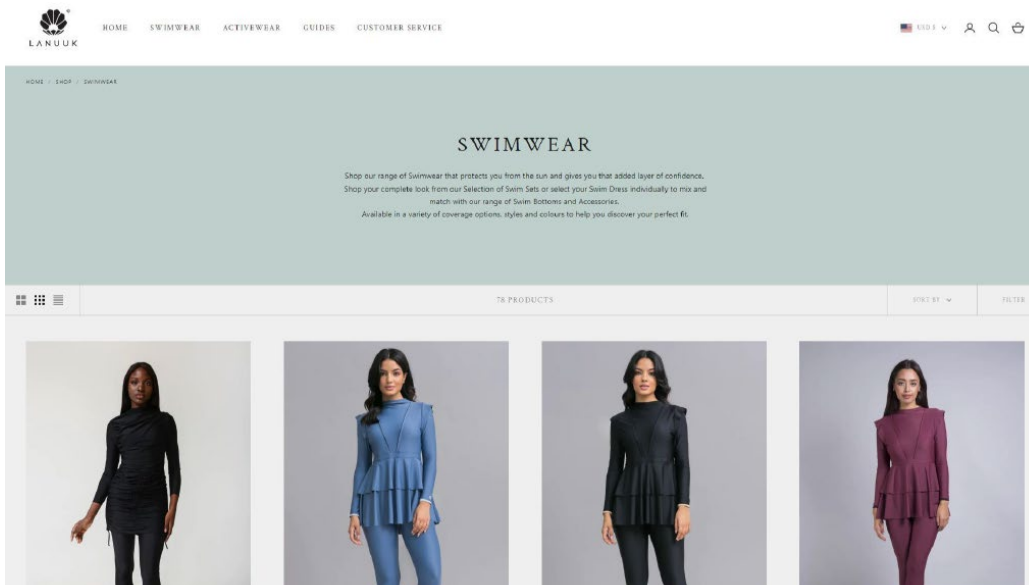


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⁹ Office Action dated November 6, 2023, at 35.

¹⁰ Denial of Request for Reconsideration dated February 29, 2023, at 28.

Lanuuk, another business selling swimwear, also sells scarves under its mark.



There is evidence of similar product offerings from three other businesses. We find this evidence shows that both swimwear and scarves are sold by the same business and under the same mark. Despite this evidence, Applicant argues “the goods are sufficiently different,” to avoid confusion.¹³ We disagree. The evidence is sufficient to

¹¹ *Id.* at 32.

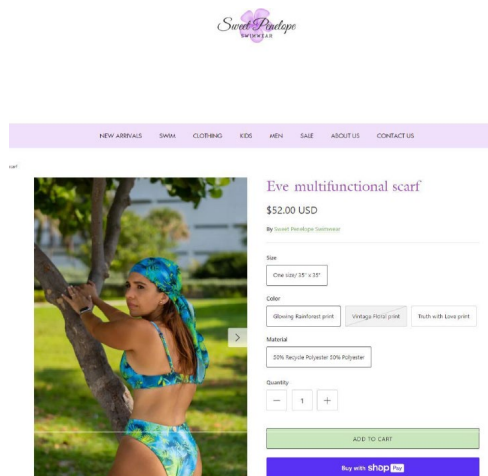
¹² *Id.* at 44. Note the second product is identified as a “swim scarf.”

¹³ 4 TTABVUE 16.

show that swimwear and scarves are related in the sense that consumers are accustomed to seeing both products sold under a single mark.

The main argument Applicant makes against the evidence is that it fails to show that scarves and swimwear are “worn together.”¹⁴ Applicant cites no authority for requiring such a connection between the goods and we will not adopt such a standard here. When a consumer sees Nike scarves and Nike swimwear, that consumer will know that these types of goods emanate from the same source and are both sold under the Nike brand. The evidence shows this practice of offering scarves and swimwear under the same mark is at least somewhat common. Whether the goods are actually used together by consumers is not the standard.

The record, however, shows at least two instances that refute even Applicant’s misguided argument. That is, there is evidence showing these goods used together. One is the “swim scarf” shown above. The second is more direct, as seen below.



¹⁴ *Id.* at 8.

¹⁵ *Id.* at 46. The Sweet Penelope line features a variety of swimwear products for women and girls.

Applicant also argues that some of the evidence shows special purpose scarves. “The scarves on the Nike website are all sport theme that are intended for wearing to soccer matches ...”¹⁶ The cited registration identifies “scarves,” without any limitation, and therefore includes “sport theme” scarves and swim scarves and any other kind of scarf. *Detroit Athletic Co.*, 128 USPQ2d at 1053 (an applicant cannot restrict the breadth of the goods or trade channels described in the cited registration); *In re FCA US LLC*, 126 USPQ2d 1214, 1217 n.18 (TTAB 2018), *aff’d*, 778 Fed. Appx. 962 (Fed. Cir. 2019) (“[W]e may consider any such restrictions [about the actual goods, or channels of trade] only if they are included in the identification of goods or services.”). It is wholly irrelevant that some of the evidence shows special purpose scarves. The evidence also shows some strikingly different swimwear designs, but that does not reduce the relevance of the evidence, because Applicant also identified its goods without any limitations.

There is sufficient evidence in the record to show that swimwear and scarves are related goods. This fact increases the likelihood of confusion.

C. Conceptual Strength of the Cited VITAMIN SEA Mark

If properly made of record, third-party registrations alone may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS*

¹⁶ 4 TTABVUE 5.

Enters. LLC, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). *See also Jack Wolfskin*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). “[E]vidence of third-party registrations is relevant to ‘show the sense in which . . . a mark is used in ordinary parlance.’” *In re Guild Mortg. Co.*, 2020 TTAB LEXIS 17, at *10 (quoting *Juice Generation*, 115 USPQ2d at 1675).

Applicant relies on third-party registrations to challenge the conceptual strength of the cited VITAMIN SEA mark. Applicant took a multi-step approach. First, Applicant searched for marks with goods in International Class 25 that include the word “vitamin(s).”¹⁷ Applicant submitted twenty-six registrations that it alleges meet these criteria.¹⁸

The second step of Applicant’s approach was similar to the first, but this time Applicant searched for registrations identifying goods in International Class 25, that also include the word “sea.”¹⁹ This step resulted in 833 results. Applicant gave us the list, which, as the Examining Attorney noted, does not put the listed registrations into the record. *See, e.g., In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064

¹⁷ 4 TTABVUE 8-9 (explained search process and results).

¹⁸ Response to Office Action dated November 11, 2023, at 8-36.

¹⁹ 4 TTABVUE 10-11.

(TTAB 2013) (holding that copies of registrations or the electronic equivalent thereof must be submitted to make the registrations of record).

The third, and final, act in Applicant's approach involved a search for registered marks that include both "vitamin(s)" and "sea/C."²⁰ Applicant found fifty registrations that met these criteria, though at least forty of those results involve the letter "C," rather than the word "sea."²¹ And, when we limit the search to International Class 25, there is exactly one result: the cited registration. Applicant submitted all fifty of the registrations it found using the combined word search.²²

To recap, we have evidence of twenty-six third-party registrations that include the word "vitamin(s)" and that identify goods in International Class 25. We have no evidence of any third-party registrations with the word "sea" in International Class 25 because Applicant did not submit any. Finally, we have fifty registrations of marks that include the words "vitamin" and "sea/C."

We will follow Applicant's lead and take our own three-step approach to evaluating this evidence. First, we will check the counting. A single mark may be registered in different forms and for different goods. Variations may also be registered by a common owner. We need to pare down the group of registrations to those that represent distinct third-party marks.

²⁰ *Id.* at 11-12 (explaining that C was included because it sounds like sea). It also led to a lot of results with "vitamin C" that are entirely irrelevant to the issues in this appeal. Request for Reconsideration dated February 14, 2024, at 22-27 (providing a table of the results).

²¹ Request for Reconsideration dated February 14, 2024, at 22-27.

²² *Id.* at 28-77.

Second, we will compare the remaining marks to the cited VITAMIN SEA mark for similarity. Only marks that are at least somewhat similar are relevant, because our inquiry here is into the meaning of the mark or its component parts. *Juice Generation, Inc.*, 115 USPQ2d at 1675 (third-party registrations may be used “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.”). If a third-party mark is not similar to the cited VITAMIN SEA mark, or a part of it, the third-party mark cannot shed any light on what the cited mark, or a part of it, means to consumers.

Third, we will cull the remaining registrations to only those that identify goods that are the same as or similar to the goods identified in the cited registration. *See Omaha Steaks*, 128 USPQ2d at 1694 (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration).

When we apply our first step to the twenty-six “vitamin” registrations, we find Applicant admits that fourteen of these registrations appear to be owned by a single entity.²³ If those fourteen are treated as a single mark, the number of different marks shown in Applicant’s evidence falls to thirteen. Another five registrations, all for the

²³ 4 TTABVUE 10. These registrations include VITAMINS, VITAMINS KIDS, VITAMINS BABY and other variations. The current owner is listed as Virtuoso Enterprises LLC. *See, e.g.*, Registration No. 2550905 for VITAMINS KIDS.

VITAMIN A mark and variations, are also co-owned, which further reduces the number of distinct third-party marks shown in Applicant's evidence to nine.²⁴ Finally, the cited registration is also in this group, which reduces the number of distinct third-party "vitamin" marks in International Class 25 down to eight.

Moving to step two, we find that three of the eight distinct third-party marks shown in Applicant's evidence are slightly similar to the cited VITAMIN SEA mark: the VITAMIN A registrations, the VITAMIN BLUE registration and the VITAMIN M registration.²⁵ These marks contain at least some elements of similarity beyond simply using the word "vitamin(s)" in the mark.

Of these three potentially probative "vitamin" registrations, only the registration for the VITAMIN M mark identifies scarves. The VITAMIN BLUE and some of the VITAMIN A registrations identify swimwear, which we found related to scarves. Applicant's evidence boils down to three third-party registrations that are only slightly similar to the VITAMIN SEA mark and that identify the same or related goods. This evidence falls far short of showing that the VITAMIN SEA mark is conceptually weak.

²⁴ The owner of the Vitamin A registrations is listed as VA International, LLC. *See, e.g.*, Registration No. 7012292.

²⁵ None of these three are very similar to the VITAMIN SEA mark, but because the cited mark sounds like "vitamin C," we have included the two third-party marks that resemble known vitamins and take a similar structure to "vitamin C," namely, the VITAMIN A marks and the VITAMIN M mark. We included the VITAMIN BLUE mark because it is a two-word mark consisting of VITAMIN followed by a somewhat abstract term. We are being generous in including these marks, in part, because even when they are considered, the evidence falls short.

When we turn to the value of the fifty registrations Applicant provided from its combination search, we reverse our process and begin by looking for those registrations that identify the same or similar goods to those identified in the cited registration. Indeed, our process collapses into one step, because there is only one registration in this group of fifty that identifies goods in International Class 25: the cited registration.²⁶

Furthermore, because the cited registration is “prima facie evidence of the validity of the registered mark,” *see* Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), we must assume that the cited mark VITAMIN SEA mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *See Tea Bd. of India*, 80 USPQ2d 1881, 1889 (TTAB 2006); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 TTAB LEXIS 199, at *29-30. We, therefore, give the cited mark “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017). We treat the conceptual strength factor (*DuPont* factor six) as neutral.²⁷

²⁶ Applicant’s combination searching revealed one registered mark that identified goods somewhat similar to the non-International Class 25 goods identified in the cited registration. The mark is VITAMINSEA, identical to the cited mark, except the space between the two words is omitted. Request for Reconsideration dated February 29, 2024, at 35. This registration identifies, among other things, “bath soaps,” which are somewhat similar to the “sponges impregnated with body wash,” identified in the cited registration. We don’t find this registration relevant, but even if it was, it would fail to show that the VITAMIN SEA mark is conceptually weak.

²⁷ While we found Applicant’s evidence failed to reduce the conceptual strength of the cited mark, there is no evidence in the record to indicate where the mark might fall within the range of inherently distinctive marks. For this reason, we treat the factor as neutral.

D. Conclusion: Weighing the Factors

The marks are identical and the goods are related. “Where identical marks are involved, as is the case here, the degree of similarity between the parties’ goods that is required to support a finding of likelihood of confusion declines.” *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015). Finally, the conceptual strength of the cited VITAMIN SEA mark is neutral. The two key factors—*DuPont* factors one and two—weigh heavily in favor of a finding that confusion is likely. The only other factor considered is neutral. There is a likelihood of confusion.

Decision: The Section 2(d) refusal is **affirmed**.