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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re LS&S Retail, Inc.

Serial No. 77524535, 77525441 and 77525450¹

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105 (Thomas G. Howell, Managing Attorney).

Before Grendel, Zervas and Ritchie, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

LS&S, Retail, Inc. has appealed from the final refusal
of the trademark examining attorney to register the
following three applications, each filed on July 17, 2008:

1. Serial No. 77524535² for the mark LAGUNA SURF & SPORT
(in standard character form; SURF & SPORT disclaimed)
for "men's and women's clothing, namely, tee shirts,

¹ On March 29, 2010, the Board granted the examining attorney's
motion (filed March 15, 2010) to consolidate these three cases
for purposes of appeal. Accordingly, our decision addresses the
appeal in all three applications.

² Serial No. 77524535 claims first use and first use in commerce
on April 1, 1983.

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tank tops, hats, tops, and headwear" in International Class 25;

2. Serial No. 77525441 for the mark



(SURF AND SPORT disclaimed) for "men's, women's and children's clothing, namely, tee shirts, tank tops, hats, tops, bottoms and headwear" in International Class 25, and "online and retail store services featuring clothing, headwear, swimwear and related accessories, bags, backpacks, and sunglasses" in International Class 35;³ and

3. Serial No. 77525450 for the mark



(SURF AND SPORT disclaimed) for "clothing, namely, t-shirts, sweatshirts, tank tops and tops" in International Class 25.⁴

³ Application Serial No. 77525441 claims first use on April 1, 1983 and first use in commerce on May 1, 2003 for the goods in International Class 25; and first use and first use in commerce on May 1, 2003 for the services in International Class 35. The following description of the mark has been entered into the record; "The mark consists of a stylized version of the word 'LAGUNA' placed above the words 'SURF' and 'SPORT,' with a lightning bolt emblem set between the words 'SURF' and 'SPORT.'"

⁴ Application Serial No. 77525450 claims first use anywhere and first use in commerce on January 6, 2000. The following description of the mark has been entered into the record; "The mark consists of a stylized version of the word LAGUNA placed over the words SURF AND SPORT, all set within an oval border, with a decorative hibiscus flower to the left of the word LAGUNA."

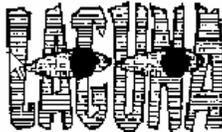
The examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that each of applicant's marks so resembles the following five previously registered marks (owned by the same entity), that, as used on applicant's identified goods and services, applicant's marks are likely to cause confusion or mistake or to deceive:

1. Registration No. 0606116 (three times renewed) for the mark

A stylized, cursive logo for the word "Laguna". The letters are thick and black, with a fluid, handwritten style. The 'L' is particularly large and prominent.

for "swim suits, swim suit ensembles, and men's and boys' sport shirts" in International Class 25;

2. Registration No. 1050106 (once renewed) for the mark

A stylized, blocky logo for the word "LAGUNA". The letters are thick and black, with a heavy, industrial feel. The 'L' is particularly large and prominent.

for "swimwear and t-shirts" in International Class 25;

3. Registration No. 1214052 (once renewed) for the mark

A stylized, bubbly logo for the word "Laguna". The letters are thick and black, with a rounded, bubbly style. The 'L' is particularly large and prominent.

for "men's boys' and juvenile clothing-namely, swim suits, swim suit ensembles, sport shirts, warm-up suits and t-shirts" in International Class 25;

4. Registration No. 1278096 (once renewed) for the mark



for "clothing-namely, swim suits, swim suit ensembles, sport shirts, warm-up clothing, shirts, and shorts" in International Class 25; and

5. Registration No. 1541125 (once renewed) for the mark LAGUNA (in standard character form) for "men's, and boys', [juvenile boys'] clothing, namely, swim suits, swim wear, sport shirts, [warm-up suits,] t-shirts, [jackets, suits, sportcoats,] underwear, [belts, hats,] shoes, [ties, and pajamas;] women's, and girls', [juvenile girls'] clothing, namely, [blouses, skirts, jackets, jogging suits,] shorts, pants, jeans, [socks, belts, swim suits, swim wear, hats, underwear, sleepwear, and pajamas]" in International Class 25.⁵

In addition, the examining attorney has refused registration of application Serial No. 77525450 under Trademark Act §§ 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the mark (containing the hibiscus) is ornamental.

Applicant has appealed the final refusal of its applications. Both applicant and the examining attorney have filed briefs. As discussed below, the refusals to register are affirmed.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

⁵ The goods in brackets have been deleted from the registration.

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facts 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Goods

The applications include goods that are identical to, or overlap with, registrant's goods:

t-shirts and tops are included in each application and t-shirts and/or sport shirts are included in each registration;

bottoms are identified in Serial No. 77525441 and shorts are identified in Registration No. 1541125; and

sweatshirts are identified in Serial No. 77525450 and sweatshirts and warm-up suits or warm-up clothing are identified in Registration Nos. 1214052 and 1278096.

Applicant's tank tops, as casual shirts, are otherwise related to registrant's t-shirts and sport shirts. In addition, the examining attorney has submitted webpages

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from the following websites showing the following goods for sale under the same mark:

gap.com - offering bathing suits and tops

anthropologie.com - offering bathing suits and hats

jcrew.com - offering bathing suits and tank tops

ocsurfsport.com - offering swimsuits and t-shirts

The examining attorney has made Registration Nos. 2346793 and 2325728 of record, which are use-based third-party registrations issued to the same owner. These registrations serve to suggest that the goods listed therein are of a kind that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Specifically, both registrations include swimsuits, hats, t-shirts, tank tops, headwear, bottoms and sweatshirts.

Although this internet and third-party registration evidence is not substantial, in light of the nature of the goods, we deem this evidence sufficient to demonstrate that the goods that are not identical to or overlap with registrant's identifications, nonetheless are related to registrant's goods.

As for applicant's on-line and retail services in application Serial No. 77525421, they involve goods that are identical, encompassed within, or closely related to

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registrant's goods. Therefore, we find applicant's services to be related to the registrant's goods. See *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (mark for retail women's clothing store services and clothing held likely to be confused with mark for uniforms); and *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (mark for distributorship services in the field of health and beauty aids held likely to be confused with mark for skin cream).

Applicant does not seriously contend that its goods are dissimilar to registrant's goods; it offers that its goods are "somewhat" related to registrant's goods.

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity of the goods against applicant.

Trade Channels and Classes of Purchasers

Applicant's and registrant's identifications of goods, and applicant's recitation of services, are broadly worded, without any limitations as to channels of trade or classes of purchasers. We presume that applicant's goods and services, and registrant's goods, are sold in all of the normal channels of trade to all of the usual purchasers for goods and services of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813

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(Fed. Cir. 1987). In other words, we conclude that the channels of trade and classes of purchasers of applicant's and registrant's goods and services are the same, and we reject applicant's arguments regarding differences in trade channels and classes of purchasers.

The Marks

We now turn to the *du Pont* factor regarding the similarities of the marks when considered in their entireties. We must consider whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). In cases such this case, where the applicant's goods are identical in part to the registrant's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than

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it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We are also guided by the well-established principle that although the marks must be considered in their entirety, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Applicant acknowledged that "dominant features of a mark must be given greater weight when assessing the overall commercial impression of a mark," citing *Giant Foods, Inc., v. Nation's Food-Services, Inc.* 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Turning first to applicant's marks, we agree with the examining attorney that LAGUNA is the dominant component of each of applicant's marks. The first parts of marks are often those most likely to be impressed on the minds of prospective purchasers and remembered, see *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988), and LAGUNA is the initial term that consumers will read or vocalize when perceiving each mark. Additionally, the terms SURF & SPORT are descriptive of a feature of applicant's goods and services. Specifically, Applicant

states that its goods "are geared towards surf enthusiasts," that its goods are sold in surf shops, and that its mark is "familiar and well-known to surf and sport consumers." Brief at 10 - 11. (Applicant disclaimed SURF & SPORT or SURF AND SPORT in its applications.) It is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services in comparing marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.").

Two of applicant's marks include design components. The design components in applicant's combination marks are not particularly distinctive and would not create a greater impression than the wording in the marks.⁶ Certainly, the lightning bolt in application Serial No. 77525441 is minor

⁶ Applicant contends at p. 5 of its brief that where the design element is "more conspicuous than the accompanying words, the design element is considered dominant." We do not find the design elements to be "more conspicuous" than the wording in the marks. We also disagree with applicant's subsequent statement at p. 5 of its brief that "LAGUNA is not the dominant portion of the respective marks, rather the design, stylization and other wording in the marks should be considered the dominant portion."

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and would not be pronounced.⁷ The flower in application Serial No. 77525450 simply gives the mark as a whole a tropical feel, in line with the "surf" portion of the word mark. Nevertheless, it does not overshadow LAGUNA as a dominant element in the mark. A purchaser would not likely articulate the flower portion of the mark when calling for goods under the mark of application Serial No. 77525450. When a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

As for registrant's marks, one of registrant's five marks is a standard character mark. This standard character mark is identical to the dominant component of each of applicant's marks. As for the four remaining marks, their stylizations are not so distinctive that they overshadow the included word LAGUNA. While the "eye" components of the marks in Registration Nos. 1050106 and 1278069 are unusual, the word LAGUNA is the only word in the mark and the eye components would not likely be spoken when articulating the mark, as would the term LAGUNA. With the term LAGUNA dominant in registrant's marks, consumers

⁷ The disclaimer made by applicant is for "SURF AND SPORT", not "SURF" and "SPORT."

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would likely view applicant's marks as variants of registrant's marks, particularly for the same or similar articles of clothing.

Thus, both applicant's and registrant's marks contain the dominant term LAGUNA. While the marks have obvious differences in appearance and pronunciation due in part to the inclusion of the descriptive terms SURF SPORT and SURF & SPORT in applicant's marks, these differences are not as significant as the similarities created by the identical, shared term LAGUNA. Further, in view of that shared term, we find that the meanings of the marks and their commercial impressions are similar - the addition of the descriptive terms SURF SPORT and SURF & SPORT does not alter the overall meaning and commercial impression of the marks and the differences in the meanings and commercial impressions of the marks are not very significant. There is nothing in the design elements of applicant's marks that provide its marks with a commercial impression different from that of registrant's marks, including the tropical tone of applicant's mark containing the hibiscus. When we consider these marks in their entireties, we conclude that the differences in appearance, pronunciation, meaning, and commercial impression are eclipsed by the similarities of

the marks. We therefore resolve the *du Pont* factor regarding the similarity of the marks against applicant.

Strength of Registrant's Marks

Applicant has submitted evidence to show that "the common element, LAGUNA, ... is weak because it is used by several other entities in the marketplace ...". The evidence applicant relies on is wholly unpersuasive. The listing of Google search results for LAGUNA is largely irrelevant; it shows hits for, e.g., Laguna Tools, Inc. for woodworking machinery, Laguna Beach Hotels and Restaurants, Laguna Clay Company for a clay working company with a kiln, potters wheel and clay, Laguna guitars, "Laguna Seca" raceway and Laguna Koi Ponds, identified as filtration design experts. These search result listings do not indicate whether the websites are active or, if so, whether the marks or names used therein are in use, and, of course, have nothing to do with applicant's goods. As for the abandoned applications and cancelled registrations submitted with applicant's request for reconsideration, applicant maintains that they "show that other applications featuring the term LAGUNA were approved for registration or registered in spite of the Cited Registrations which shows that the Trademark Office has historically only provided limited protection to the Cited Registrations due to the common use of the LAGUNA

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mark." Brief at 9. Expired registrations and pending and abandoned applications have no probative value. *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything"); and *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467 n.6 (TTAB 2003) (applications are only probative to show that the application has been filed). Even if they did have probative value, they are not persuasive because we must determine each case on its own record and prior decisions by examining attorneys are not binding on the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Applicant indicated too that it has "researched the presence of Registrant's marks in commerce via the Internet and included information regarding this research," concluding that "the Cited Registrations do not have a strong presence in the marketplace ... [and] that Registrant's clothing products are available only through sales representatives located in New York City or Battle Creek, Michigan areas." Brief at 10. Even if respondent's marks do not have a strong presence in the marketplace, in this ex parte proceeding, respondent is still entitled to all of the presumptions under Section 7(b) of the Trademark

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Act accorded to subsisting registrations, including the presumption of use throughout the United States. See *Amcors, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 77 (TTAB 1981) ("[T]he presumptions afforded the registrations under Section 7(b) include a presumption of use or the right to use the registered marks throughout the United States").

Applicant also makes the point that its mark is a strong one, has "acquired distinctiveness," and "is familiar and well-known to surf and sport consumers." Brief at 10. Even if this is the case, and consumers who are very familiar with applicant's mark encounter registrant's marks, the Trademark Act guards against the misimpression that the junior user is the source of the senior user's goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

Thus, we accord registrant's marks the normal scope of protection that is accorded to a distinctive mark.

No Actual Confusion

Applicant argues that there has been no consumer confusion for the past twenty-seven years, a period during which applicant maintains that applicant and registrant have coexisted in the apparel industry. A geographic separation between registrant and applicant may account for

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a lack of actual confusion. Also, there is no evidence in the record regarding the level of sales or advertising by registrant and applicant. The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur, as we have not heard from the registrant on this point. All of these factors materially reduce the probative value of applicant's argument regarding a lack of actual confusion, and applicant's contention that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. See *In re Majestic Distilling Co., supra*. Applicant's argument regarding actual confusion therefore is unpersuasive, and this *du Pont* factor is neutral.

Conclusion

We have found the *du Pont* factors regarding the similarity of the marks, goods, classes of purchasers and trade channels to favor registrant. We also accord registrant's marks the normal scope of protection for registered marks presumed under the statute to be distinctive. The lack of any reported instances of actual confusion, argued by applicant, is neutral in our analysis. We therefore conclude that when potential purchasers encounter applicant's and registrant's respective marks for the clothing items identified in their respective identifications of goods, some items of which are identical, and applicant's online and retail store services and registrant's goods, they are likely to believe that the sources of these goods are in some way related or associated. We find the same to be true with respect to registrant's clothing items and applicant's internet and retail services involving clothing items. As a result, there is a likelihood of confusion.

Ornamental

As mentioned earlier in this decision, the examining attorney has also refused registration under Trademark Act §§ 1, 2 and 45 on the ground that the proposed mark in application Serial No. 77525450, as used on the specimen of

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record, depicted below, is merely decorative or an ornamental feature of the goods:



Specifically, the examining attorney maintains that the proposed mark is prominently displayed on the front of a t-shirt, is large, and it is common practice to place decorative designs on the front of clothing so that the proposed mark is not likely to be perceived as a source indicator by consumers. The examining attorney observes that applicant has "not proffered any evidence to support a Section 2(f) claim of acquired distinctiveness or a claim of secondary source." Brief at unnumbered 19.

Applicant counters that "[a]s pertaining to the instance [sic] goods, the appearance, location, and design of the mark creates a commercial impression which the public would clearly understand to be the source of the goods"; and the "mark indicates to consumers the source of the goods, namely, Applicant. Most consumers of Applicant's goods will recognize that Applicant owns and

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operates a retail store by the same name and therefore, will identify Applicant's mark with the source of the goods."

The mere fact that a term appears on a product does not necessarily make it a trademark. *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993). However, "[m]atter which serves as part of the aesthetic ornamentation of goods, such as T-shirts and hats, may nevertheless be registered as a trademark for such goods if it also serves a source-indicating function." *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988). "Where ... an alleged mark serves as part of the aesthetic ornamentation of the goods, the size, location, dominance and significance of the alleged mark as applied to the goods are all factors which figure prominently in the determination of whether it also serves as an indication of origin." *Pro-Line*, 28 USPQ2d at 1142.

In this case, the specimen shows the proposed mark prominently displayed in the upper center portion of the t-shirt. The proposed mark is displayed on the front of the shirt in a manner that immediately catches the eye. The size, location, and dominance of applicant's proposed mark on the t-shirt supports the conclusion that the proposed mark would serve an ornamental rather than a source-identifying function on the goods.

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In addition, the proposed mark is positioned in the specimen above the wording "Laguna Beach, California." Consumers would view "Laguna" in the depiction of the proposed mark as a reference to Laguna Beach, California. SURF AND SPORT, as applicant has indicated in its brief, would be perceived as referring to activities available in Laguna Beach. The depiction of a hibiscus does not serve as a source indicator; it merely offers a tropical beach feel to the proposed mark, appropriate for a southern California beach locale. Overall, the impression of applicant's proposed mark depicted in the specimen is not as a source indicator.

Further, there is no visible TM symbol on applicant's specimen. This suggests that potential customers would not be conditioned to recognize applicant's proposed mark as a trademark. *In re Wakefern Food Corp.*, 222 USPQ 76, 78-79 (TTAB 1984) ("The fact that no symbol, such as 'TM' or 'SM,' is used to designate an alleged mark is also some evidence that the phrase is not being used in a trademark or service mark sense"). See also *In re Astro-Gods Inc.*, 223 USPQ 621, 624 (TTAB 1984) (use of copyright notice with ornamentation not enough to make an association between the designation and applicant's name).

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The record is devoid of any evidence that consumers recognize that applicant's proposed mark has a source-identifying function or that it identifies a secondary source in addition to being ornamental. Ornamentation of "a T-shirt can be of a special nature which ... inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name 'New York University' and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-Shirt will also advise the purchaser that the university is the secondary source of that shirt." *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1112 (TTAB 1982). In *Paramount Pictures*, the Board found that the "primary significance of the words 'MORK & MINDY' to any prospective purchasers of a decal ... is to indicate the television series"; and noted that arbitrary terms such as KODAK and DREFT have obvious source-indicating characteristics because they "usually have no other perceived significance." *Id.* In this case, we cannot say that the proposed mark has other perceived significance and the record does not indicate that is an indicator of a secondary source such as MORK & MINDY and NEW YORK UNIVERSITY.

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In conclusion, it is our view that the proposed mark in application Serial No. 77525450 is primarily an ornamental feature of the goods and, therefore, it does not function as a trademark for the goods.

DECISION: The refusals to register the marks in application Serial Nos. **77524535, 77525441 and 77525450** under Section 2(d) of the Trademark Act are affirmed for all classes, and the refusal to register the proposed mark in application Serial No. **77525450** under Sections 1, 2 and 45 of the Trademark Act is also affirmed.