

This Opinion is Not a
Precedent of the TTAB

Mailed: April 8, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lahana Pty Ltd.

Serial No. 79237803

Eric J. Perrott and Joshua Gerben of Gerben Law Firm, PLLC
for Lahana Pty Ltd.

Deborah L. Meiners, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

Before Wolfson, Adlin, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Lahana Pty Ltd. (“Applicant”) seeks registration on the Principal Register of the mark LAHANASWIM in standard characters for “Clothing namely, bikinis and

swimwear” in International Class 25 and “Wholesale and retail store services featuring swimwear” in International Class 35.¹

The Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark LAHANA in standard characters for “jewelry” in International Class 14.² The registration states that the English translation of LAHANA in the mark is “Brightly created.” After the Examining Attorney made the refusal final, Applicant appealed.

For the reasons set forth below, we affirm the refusal to register.

II. Evidentiary Objection

As a preliminary matter, the Examining Attorney objects to Applicant’s inclusion in its Brief of quotes from online articles, purportedly from the Patch, Corey Egan and Bold Accents websites, for which Applicant only cited hyperlinks. The Examining Attorney correctly notes that the underlying web articles were not part of the record. Although Applicant included the same quotes and hyperlinks (but not copies of the articles) in its June 18, 2019 Request for Reconsideration,³ providing hyperlinks to Internet materials is insufficient to make such materials of record. *In re Powermat Inc.*, 105 USPQ2d 1789 (TTAB 2013) (citing *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269 (TTAB 2012)). Accordingly, we sustain the objection and do not

¹ Application Serial No. 79237803 was filed June 27, 2018 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, requesting an extension of protection under the Madrid Protocol of International Registration No. 1415723.

² Registration No. 4743487 issued on May 26, 2015.

³ June 18, 2019 Request for Reconsideration at 25.

consider these website articles or the quotes allegedly therefrom because they were not included in the record.⁴

III. Likelihood of Confusion

Our determination under Section 2(d) involves 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) (setting forth factors to be considered, referred to as “*DuPont* factors”); *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 In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (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.”).

⁴ Applicant’s Brief also includes hyperlinks to other websites for which Applicant did timely and properly submit screenshots for the record. The screenshots in the record will be considered, but not any additional content potentially available through the hyperlinks. As explained in *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010), because of the transitory nature of Internet postings, websites referenced only by links may later be modified or deleted, and therefore links are not the appropriate way to submit evidence.

A. Similarity of the Marks

We first compare LAHANASWIM to LAHANA “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *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)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

We find that the marks look and sound similar in large part because of the identical word “LAHANA” that forms the entirety of the cited mark, and the beginning of Applicant’s mark. As the first part of Applicant’s mark, LAHANA is its dominant term. *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (first part of a mark “is most likely to be impressed upon the mind of a purchaser and remembered.”); *see also Palm Bay Imps.*, 73 USPQ2d at 1692. The dominance of LAHANA in Applicant’s compound mark is reinforced because the second word, SWIM, is merely descriptive or generic for Applicant’s swimwear goods

and swimwear-focused services.⁵ This reduces its significance in the likelihood of confusion analysis because consumers are less likely to rely on descriptive or generic wording to indicate source. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (in comparing THE DELTA CAFÉ to DELTA, the generic term CAFÉ lacks sufficient distinctiveness to create a different commercial impression). We are not persuaded by Applicant's contention that consumers would not perceive the distinct words within its mark LAHANASWIM, especially when the mark is used for swimming-related products and services.

As to the marks' connotations and commercial impressions, we also find them similar. Because the record contains no indication otherwise, we find that consumers would attribute the same meaning to the shared word, LAHANA in Applicant's mark as they would in the cited mark.⁶ The additional word SWIM in Applicant's mark merely refers to the nature of the goods and services, does not change the meaning or impression of the shared dominant term LAHANA, and only minimally contributes to the overall meaning and connotation. Thus, the addition of the descriptive or generic word SWIM does not significantly distinguish the marks in terms of meaning or impression.

⁵ TSDR April 12, 2019 Office Action at 86 (definition of "swim" as "of, relating to, or used in or for swimming"); *see also* TMEP § 1213.05(a) (Oct. 2018), which provides that "If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required." Thus, SWIM would not be subject to a disclaimer requirement, even though it is descriptive or generic.

⁶ As noted above, the registration contains a translation of "lahana." The application, which includes "lahana" in a compound word mark in which two distinct words are represented as one word, TMEP § 1213.05(a), does not include a translation.

Given their resemblance in sound, appearance, connotation and commercial impression, we find the marks very similar. This factor strongly weighs in favor of a likelihood of confusion.

B. The Goods and Services

“[L]ikelihood of confusion can be found ‘if the respective goods [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). In analyzing the second *DuPont* factor, we look to the identifications in the application and cited registration. See *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Examining Attorney argues that the goods and services in the application and cited registration are related. She introduced third-party retail websites on which swimwear and jewelry are offered together under the same mark used for the retail store services. For example:

- The American Eagle/Aerie retail website offers necklaces and bikinis under the AERIE mark, as shown below:⁷

⁷ TSDR October 24, 2018 Office Action at 10-16.

erie

Women Men Jeans Aerie Bras Swimsuits Tailgate Cleara



Aerie / Accessories & Shoes /

Jewelry

ACCESSORIES & SHOES

- Scarves & Kimonos
- Hats
- Hair Accessories
- Socks & Tights
- Shoes
- Jewelry**
- Gifts
- Sleep Accessories
- Sunglasses
- Bags
- Swim Accessories

FILTER + SORT



New
AERIE NAME NECKLACE
\$15.95

New
AERIE NAME NECKLACE
\$15.95

Bikini Tops

Free Shipping & Returns



Online Only

AERIE LIGHTLY LINED UNDERWIRE BIKINI TOP



Online Only

AERIE LIGHTLY LINED UNDERWIRE BIKINI TOP

- The HaleyRaye Swimwear retail website promotes under the same mark its “HaleyRaye Jewelry” as well as its “HaleyRaye Swimwear” that includes bikinis.⁸
- The Venus retail website features a variety of jewelry as well as swimwear, including bikinis. The jewelry webpage encourages consumers to “Shop VENUS for bright, beautiful and eye catching jewelry,” while the swimwear webpage invites consumers to “Discover the perfect paradise and pair it with VENUS swimwear.”⁹
- The Nina Sharae Resort & Swimwear retail website promotes “The Nina Sharae exclusive jewelry collection for a touch of luxury and class,” including a “Choker Dress Necklace” on a bikini-clad model, and also features its line of “High-end resort & swimwear for plus size women! All Swimsuits are made in the USA.”¹⁰
- The Tara Grinna retail website features jewelry and swimwear that includes bikinis, and several swimwear models are shown wearing jewelry.¹¹ One page explains that “All Tara Grinna swimwear is currently manufactured at the company owned facility in the USA from Italian fabrics,” but “Tara Grinna is

⁸ TSDR July 8, 2019 Denial of Reconsideration at 76-80.

⁹ TSDR April 12, 2019 Office Action at 35-39.

¹⁰ TSDR July 8, 2019 Denial of Reconsideration at 33-37.

¹¹ TSDR July 8, 2019 Denial of Reconsideration at 81-90.

no longer only swimwear and has expanded into a luxury resort brand...,” whose products include “handmade jewelry.”¹²

This evidence establishes a relationship between Applicant’s bikinis, other swimwear and retail store services featuring swimwear, and Registrant’s jewelry. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”).

The Examining Attorney also introduced third-party retail websites that specialize in swimwear, and also offer jewelry. For example:

- The Everything But Water retail website offers earrings, bracelets and necklaces as well as swimwear, including bikinis.¹³
- The Beverly Beach retail website offers jewelry and swimwear under its trade name,¹⁴ and its jewelry offerings are modeled by women wearing bikinis, as shown in the excerpts below.¹⁵ The necklace featured below is described as “the ultimate beach-to-bar accessory.”¹⁶

¹² TSDR July 8, 2019 Denial of Reconsideration at 92.

¹³ TSDR October 24, 2018 Office Action at 34-50.

¹⁴ The swimwear is captioned with style names (using various women’s first names) and the jewelry is captioned with descriptors such as “swing by tassel necklace rose gold” and “scattered gem bodychain rose gold.” TSDR April 12, 2019 Office Action at 9-14.

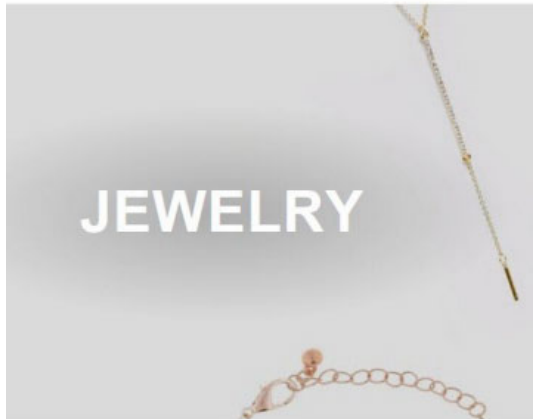
¹⁵ TSDR April 12, 2019 Office Action at 8-25.

¹⁶ *Id.* at 23.

Free Shipping within the US

BEVERLY BEACH
BY DORIT

ACCESSORIES



FREE SHIPPING WITHIN THE US

SWIMWEAR

COVER-UPS

MENS

KIDS

BEVERLY BEACH
BY DORIT

ACCESSORIES

ATHLEISURE

BRONZER

RHOBB



SWING BY TASSEL NECKLACE ROSE GOLD

\$16

COLOR

ROSE GOLD

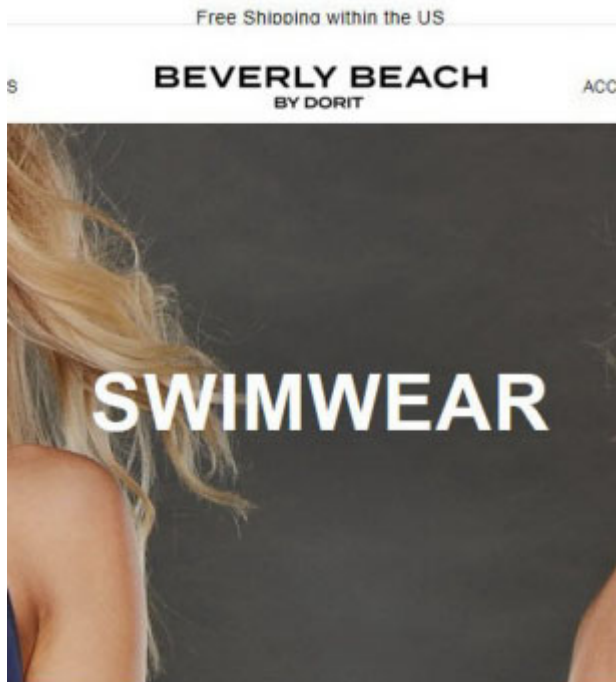
ADD TO CART

The Swing By Tassel necklace features a Y drop rose gold-tone chain with eye catching gem details and a flattering long hanging tassel. It instantly elevates your look and is the ultimate beach-to-bar accessory.

- Stone accent
- Long hanging tassel
- Jewelry pouch included
- Measures 18.5"

Also available in gold tone

Care notes – To prolong the life of your jewelry, avoid contact with salt water, chlorine and sunscreen



- The Bikini Crush retail website offers under its trade name both jewelry and bikinis, some of which are encrusted with jewels, including the excerpt below.¹⁷

¹⁷ TSDR April 12, 2019 Office Action at 26-34. The swimwear and jewelry are captioned with style names such as “Barely There Two Piece,” “Bad Gal Gold,” “Chandelier V Body Chain.” *Id.* at 27, 29.



NEW QUICK SHIP MADE TO ORDER SALE ORDER INFO SIZE CHART

HOME > A-Z MADE TO ORDER

ALPHABETICALLY: A-Z

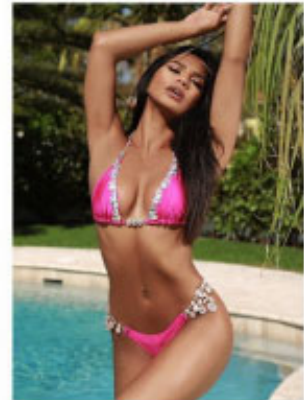
Search for your Crush from A-Z



ADORN ME
\$235.00 USD



ADORN ME
\$235.00 USD



ALEXIA
\$230.00 USD

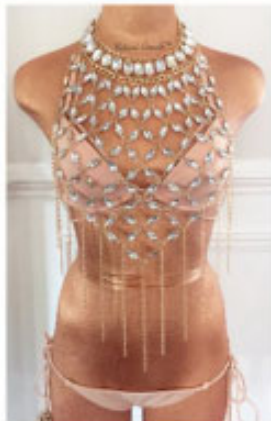


NEW QUICK SHIP MADE TO ORDER SALE ORDER INFO SIZE CHART

HOME > BODY JEWELRY

BEST SELLING

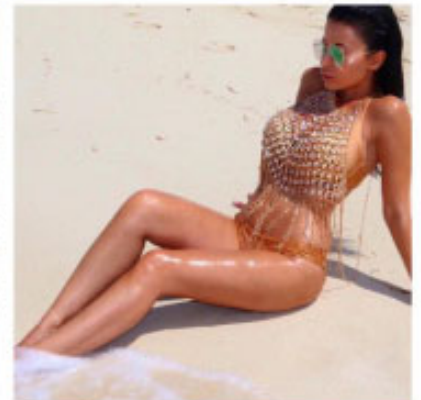
Drench Your Body In Lavish Jewelry!



CHANDELIER V BODY CHAIN - BEST SELLER!



MASQUERADE (MASK)
From \$19.99 USD



AMREZY CHANDELIER BODY CHAIN
\$150.00 USD

- The Bikini Luxe retail website offers jewelry and bikinis, and features models in swimwear wearing jewelry.¹⁸ For example, it promotes the “Bikini Luxe – Star Body Chain.”
- The By Malka retail website offers bikinis and other swimwear, along with jewelry.¹⁹
- The Orchid Boutique retail website, whose “focus is to cherry-pick an elite selection of sexy swimwear,” including bikinis, and also offers bracelets, earrings, and necklaces.²⁰
- The Salt Swim retail website shows bikinis and jewelry.²¹
- The Beach Bunny retail website offers both bikinis and jewelry.²²

This evidence shows that consumers are accustomed to encountering swimwear-focused retail websites that also feature jewelry, apparently as an accessory to accompany the swimwear. *See Hewlett-Packard, Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Applicant attacks some of the Examining Attorney’s evidence, arguing that “major online retailers, including American Eagle, Burberry, Everything About [sic] Water,

¹⁸ TSDR July 8, 2019 Denial of Reconsideration at 10-18.

¹⁹ TSDR July 8, 2019 Denial of Reconsideration at 27-32.

²⁰ TSDR July 8, 2019 Denial of Reconsideration at 38-46.

²¹ TSDR July 8, 2019 Denial of Reconsideration at 64-70.

²² TSDR July 8, 2019 Denial of Reconsideration at 71-74.

Beverly Beach, Bikini Crush, Venus, and Francesca's ... are well-recognized as covering a wide variety of products, [and] that such evidence is of little value in showing that consumers will perceive the listed goods as emanating from a single source."²³ In support of this proposition, Applicant cites to cases involving evidence from a grocery store, a department store, and an amusement park, questioning the persuasiveness as to relatedness just because both types of goods at issue are sold by retailers of such diverse products. However, in our case, Applicant did not introduce evidence to support its allegations about the allegedly diverse nature of the goods offered by the retailers relied on by the Examining Attorney, and based on the record, the website evidence does not support a finding that swimwear retailers are analogous to retailers with such wide-ranging offerings. Rather, even the websites in the record that cannot be characterized as specializing in swimwear and jewelry involve retailers primarily of clothing and the typical line of accessories that accompany clothing. Thus, we do not find Applicant's criticism of the evidence well founded. Instead, we find the Examining Attorney's evidence convincing to show that consumers are accustomed to encountering the goods and services at issue emanating from the same source.

The Examining Attorney also introduced online articles to further support the relatedness of swimwear and jewelry. One from the Mark Schneider website, titled "How to Accessorize Swimwear," states that "swimwear is the perfect canvas for beautiful jeweled accessories. Because swimsuits boast minimal fabric, they are the

²³ 4 TTABVue 7 (Applicant's Brief).

perfect way to highlight exceptional jewelry.”²⁴ The Lacy Hint website features an article on “Fun Ways to Wear Jewelry with Swimwear,” and notes that its “guide for how to wear jewelry at the beach or the pool will allow you to strut in shiny jewels without needing to bury your face in the sand.”²⁵ The David Perry & Associates website features pages titled “Glam up your bikini! Jewelry to wear with swimsuits,” which state that “[d]ressing up swimwear with jewelry is nothing new.”²⁶

These articles show the complementary nature of swimwear and jewelry, in that they are worn together as part of a coordinated outfit, and so are likely to be purchased together -- and because the jewelry is used to “accessorize swimwear,”²⁷ it likely would be sold with swimwear. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (finding bread and cheese to be related because they are often used in combination, and stating: “Such complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's shoes are complementary to women's clothing because they may be part of a coordinated outfit). This corroborates the relatedness of these goods.

Applicant next contends that the USPTO has recognized that the goods and services at issue are unrelated, based on the co-existence on the Register of the same registered mark owned by two different entities, one for jewelry and the other for

²⁴ TSDR July 8, 2019 Denial of Reconsideration at 94.

²⁵ TSDR July 8, 2019 Denial of Reconsideration at 96.

²⁶ TSDR July 8, 2019 Denial of Reconsideration at 98-99.

²⁷ TSDR July 8, 2019 Denial of Reconsideration at 93.

swimwear and/or retail services featuring swimwear. Applicant's Brief points to 22 pairs of such registrations, and also mentions others "for general apparel products, footwear, and more."²⁸ The Examining Attorney responds, first, that the third-party registrations are not evidence that the marks are in use or that the public is familiar with them, citing *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013). Second, she notes alleged deficiencies, such as that one of the EURYNOME registrations issued based on a co-existence agreement with the other registrant; one of the ULTIMATE DIVA registrations is cancelled, *see Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016); and some marks are weak or include additional matter beyond the common wording that creates a different commercial impression. Third, the Examining Attorney emphasizes that prior registrations do not bind the USPTO and lack probative value as to the refusal in this case, because each case must be decided on its own facts.

Applicant replies that the record lacks evidentiary support that any of the third-party marks are weak, and that the co-existence agreement actually supports Applicant's argument because those in the marketplace agree that use of the same mark on jewelry and swimwear is unlikely to cause consumer confusion. Applicant also cites *In re Thomas*, 79 USPQ2d 1021, 1028 (TTAB 2006), a case involving jewelry and clothing in which the Board held: "[w]e cannot conclude on the basis of the evidence of record that jewelry and clothing are so closely related that,

²⁸ 4 TTABVUE 12.

notwithstanding the differences in the marks, purchasers would naturally expect these goods to emanate from the same source.”

We are not persuaded by Applicant’s third-party registration evidence and argument, and do not agree that the registrations necessarily reflect a USPTO policy that the goods and services at issue are unrelated. First, as noted in *In re Thomas*, the co-existence of marks “on the register does not prove that they coexisted during that time without confusion in the marketplace.” *Id.* at 1028. In addition, “Applicant’s attempt to equate those co-existing registrations, for each of those marks, with the situation herein is not persuasive. Suffice it to say that each case must be decided on its own set of facts.” *L’Oreal S.A. and L’Oreal USA, Inc. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (“each case must be decided on its own facts and the differences are often subtle ones.”). We are not bound by the allowance of prior registrations, even if they have some characteristics that may appear relevant to this case. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). As the Examining Attorney pointed out, there may be other reasons for the co-existing pairs. Also, the third-party registrations do not present a complete picture of the USPTO’s examination practice regarding these types of goods. As for *In re Thomas*, the decision demonstrates that a proper likelihood of confusion determination depends on the overall balancing of the relevant *DuPont* factors and particular evidence of record, and in that case, the degree of similarity between the marks and the quantity of relatedness evidence were considerably less than in this case. *In re Thomas*, 79

USPQ2d at 1028. Nonetheless, even on the basis of only third-party registrations covering both clothing and jewelry, the Board in that case actually found the goods related, but when balanced with the other key factor, not “so closely related that, notwithstanding the differences in the marks, purchasers would naturally expect these goods to emanate from the same source.” *Id.*

The second *DuPont* factor weighs in favor of likely confusion.

C. The Trade Channels and Classes of Consumers

Turning to the trade channels and consumers, the third-party retailer relatedness evidence discussed above also demonstrates that goods and services such as Applicant’s and the goods in the cited registration are featured together on the same swimwear websites and clothing websites, and would be encountered by the same consumers.

Applicant attempted to rebut the Examining Attorney’s third-party retailer websites with third-party retail evidence of “swimwear shops that only sell swimwear” and “jewelry shops that only sell jewelry.”²⁹ However, we do not agree that the existence of specialized retailers that sell only one or the other product somehow negates or undermines the persuasiveness of the Examining Attorney’s proof of consumer exposure to retailers who sell both jewelry and swimwear. Thus, the third *DuPont* factor weighs in favor of likely confusion.

²⁹ 4 TTABVue 7-8.

IV. Conclusion

The overall similarity of the marks for related goods and services that move in some of the same channels of trade to the same classes of customers renders confusion likely.

Decision: The refusal to register Applicant's mark is affirmed.