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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spy Optic, Inc.

Serial No. 75/294,219

Kit M. Stetina of Stetina Brunda Garred & Brucker for Spy Optic, Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Cissel, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Spy Optic, Inc., a California corporation, has filed an application for registration of the mark "SPY and design" as shown below, on the Principal Register for "wearing apparel, namely, shirts, T-shirts, shorts, pants, sweatshirts, sweatpants, hats, visors, shoes and belts," in International Class 25¹:



¹ Serial Number 75/294,219, filed on May 19, 1997, based upon the assertion of a *bona fide* intention to use the mark in commerce.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, "SPY and design," when used on its goods, so resembles the mark, "FASHION SPY!" which is registered for "clothing, namely tops, skirts, shorts, skorts, pants, shirts, dresses, jumpers, jackets," as to be likely to cause confusion, or to cause mistake, or to deceive.²

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that the two marks are different as to sight, sound and connotation, and that these collective dissimilarities weigh against finding likelihood of confusion. Furthermore, applicant argues that the allowance of registrant's "FASHION SPY!" mark for clothing over applicant's "SPY" mark for sunglasses shows that the United States Patent & Trademark Office has already made the determination that there is no likelihood of confusion between the word portions of the marks at issue herein.

By contrast, the Trademark Examining Attorney argues that confusion is likely if these respective marks, both

² Registration No. 1,981,264 issued on June 18, 1996. The registration sets forth dates of first use of January 4, 1995.

having the arbitrary term "Spy" as their predominant element, are applied to these identical goods.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors, which if relevant, should be considered in determining likelihood of confusion. In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to an examination of the goods. As noted by the Trademark Examining Attorney, some of the clothing items identified in the application and registration are identical (e.g., shirts, shorts and pants), and even though there are differences in the listings, all these goods are very closely related items of apparel.

Turning then to the marks, as our principal reviewing court, the Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion

declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

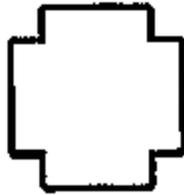
As applied to clothing, the word "Fashion" must be deemed to be at least highly suggestive, if not descriptive. On the other hand, the word "Spy" is an arbitrary designation for these items of clothing. Accordingly, in spite of the extra word in registrant's mark, the single strongest source indicator therein is the word "SPY."

As to the similarity in overall commercial impressions, both marks create imagery tied to the generally understood, dictionary meaning of the word "spy." Hence, both "Fashion Spy" and "Spy," as applied to items of clothing, connote clandestine activities, watching someone (or something) in secret.

The addition of "FASHION" in registrant's mark is insufficient to distinguish the two marks when applied to identical and closely related goods. In finding that the marks are similar, we have kept in mind the fallibility of human memory over time and the fact that the average consumer retains a general rather than a specific impression of trademarks encountered in the marketplace. Further, we note that the record is devoid of any evidence

of third-party uses of other "SPY" marks for goods similar to the types of goods involved in this case.

In support of applicant's position that the "shield" design is a prominent part of its mark, applicant has made of record its earlier registration for sunglasses,³ for the mark shown below:



We accept that applicant considers this matter to be a separate source indicator for sunglasses. However, when this device becomes a carrier for applicant's house mark, "SPY," and is applied to items of clothing, as is the case with the composite mark herein, the "shield" design becomes less important as a source indicator. The addition of a background device not easily described will not obviate confusion created by similar word marks. Rather, we agree with the Trademark Examining Attorney that the word "SPY" is the dominant portion of the mark and the portion that will be relied upon by consumers in calling for the goods in the marketplace, or in recommending the goods to others.

³ Reg. No. 2,157,268, issued on May 12, 1998, claiming dates of first use of October 1996 on "sunglasses" in International Class 9.

As a general rule, design elements of a mark are of lesser import, because it is the word portion of a mark, rather than any design feature, unless highly distinctive, which is more likely to be remembered and relied upon by customers in calling for the goods. See Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A., 32 USPQ2d 1192 (TTAB 1994); In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

As to applicant's contention that it has a "family" of SPY marks, again we agree with the Trademark Examining Attorney's contention to the contrary. While applicant may own several registrations where the marks contains the word "SPY," there has been no showing in this record that this limited number of registrations support a finding of a "family of marks."

As to applicant's argument that the United States Patent & Trademark Office has already made the determination that there is no likelihood of confusion between the word portions of the marks at issue herein, we disagree with this conclusion. Given the cumulative differences in the respective goods (sunglasses versus clothing) and those differences applicant points out in the marks, it would have been extremely difficult for a Trademark Examining Attorney to have refused registrant's

"FASHION SPY!" mark based solely on applicant's "SPY" mark for eyeglasses. Unfortunately from applicant's perspective, registrant adopted its mark for clothing items in International Class 25 before applicant expanded to these collateral goods.⁴

Decision: The refusal to register is affirmed.

R. F. Cissel

D. E. Bucher

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁴ In reviewing other possible du Pont factors, certainly if applicant had obtained a consent agreement from the owner of the cited registration, the Trademark Examining Attorney and this Board would surely have been constrained to give it serious consideration in accordance with legal practice and precedent in this regard. However, in spite of its arguments that confusion was most unlikely, applicant did not present the Office with such an agreement.