

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

Paper No. 9  
JQ

9/26/00

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Arden Cravats, Inc.

---

Serial No. 75/457,263

---

F. Michael Sajovec of Myers Bigel Sibley & Sajovec for applicant.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

---

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Arden Cravats, Inc. to register the mark ARDEN CRAVATS ("CRAVATS" disclaimed) for "ties."<sup>1</sup>

The Trademark Examining Attorney has refused registration on two bases. First, registration has been refused under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's

---

<sup>1</sup> Application Serial No. 75/457,263, filed March 26, 1998, alleging dates of first use of December 18, 1974.

**Ser No.** 75/457,263

goods, so resembles the previously registered mark ARDEN for "outer shirts" as to be likely to cause confusion.<sup>2</sup> Second, registration has been refused under Section 2(e)(4) on the ground that the applied-for mark is primarily merely a surname.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

#### LIKELIHOOD OF CONFUSION

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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 first turn to consider the marks. Although we stress that we have considered the marks in their entirety, including the disclaimed portion, "there is nothing improper in stating that, for rational reasons,

---

<sup>2</sup> Registration No. 405,940, issued February 29, 1944; twice renewed.

more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. at 751. In this connection, "ARDEN" is clearly the dominant part of applicant's mark, with the disclaimed generic term "CRAVATS" being relegated to a subordinate role because it has no source-identifying function. The term "ARDEN" alone would likely be used in calling for applicant's goods. This dominant portion is identical to the entirety of the registered mark. In re Denisi, 225 USPQ 624 (TTAB 1985)[while not ignoring the caveat that marks must be considered in their entireties when evaluating the chances of their being confused in the marketplace, where a newcomer has appropriated the entire mark of a registrant, and has added to it a non-distinctive term, the marks are generally considered to be confusingly similar]. In comparing the marks, we further note that the record is devoid of evidence of any third-party uses or registrations of the same or similar marks in the clothing field.

With respect to the goods, it should be noted that it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Moreover, the Board has stated that the degree of similarity in the goods need not be as great where the marks are essentially identical. Warnaco Inc. v. Adventure Knits, Inc., 210 USPQ 307, 315 (TTAB 1981).

Notwithstanding specific differences between shirts and ties, we find them to be sufficiently related that, when sold under substantially identical marks, purchasers are likely to mistakenly assume that applicant's mark identifies a line of ties emanating from registrant. Shirts and ties form an important fashion combination in men's wearing apparel, a fact shown by the way they are marketed in the catalogs relied upon by the Examining Attorney. Such items are complementary, and because they

will be worn together, they are often purchased together during the same shopping trip.

Shirts and ties are bought by the same classes of purchasers, that is, members of the general public. There is nothing in the record to support applicant's assertion that its goods and those of registrant are not bought on impulse, but rather only after some consideration. Given that the source-identifying portion of applicant's mark is identical to the cited mark, even careful purchasers are likely to view the trademarks as essentially identical, and to indicate origin with a single source. We would also point out that inasmuch as the identifications of goods are not limited, they are broad enough to cover inexpensive shirts and ties.

In finding that applicant's ties are related to registrant's outer shirts, we have considered the several third-party registrations based on use which the Examining Attorney has submitted. The registrations show marks which are registered for both shirts and ties. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods listed therein, including shirts and ties, are of a kind which may emanate from a

single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

The absence of evidence of actual confusion does not mandate a different result in this case. Given the lack of specifics bearing on the extent of use of the involved marks, we are at a great disadvantage in assessing whether there has been a meaningful opportunity for confusion to occur in the marketplace. In any event, the test in deciding this appeal is likelihood of confusion.

We conclude that consumers familiar with registrant's outer shirts sold under its mark ARDEN would be likely to believe, upon encountering applicant's mark ARDEN CRAVATS for ties, that the goods originated with or are somehow associated with or sponsored by the same entity.

PRIMARILY MERELY A SURNAME

Whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname. *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). The Office has the burden of establishing a prima facie case that a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Provided that the Examining Attorney

establishes a prima facie case, the burden shifts to the applicant to rebut the showing made by the Examining Attorney. In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975). The Board, in the past, has taken into account various factual considerations in making a determination whether a mark is proscribed by Section 2(e)(4). In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

With respect to the surname significance of ARDEN, the Examining Attorney has made of record a printout retrieved from the PHONEDISC POWERFINDER USA ONE 1998 (4<sup>th</sup> ed.) database. This evidence shows listings for over 900 individuals having the surname "Arden." As stated in the past, there is no minimum or "magic" number of directory listings required to establish a prima facie case for refusal of registration under Section 2(e)(4). In re Cazes, 21 USPQ2d 1796 (TTAB 1991). Further, even uncommon surnames are not registrable on the Principal Register. In re Industrie Pirelli per Azioni, 9 USPQ2d 1564 (TTAB 1988), aff'd unpublished opinion, No. 89-1231 (Fed. Cir. July 17, 1989).

Applicant contends that the term "ARDEN" has significance other than as a surname. However, it was not until the appeal brief when applicant, for the first time,

pointed to the geographic area known as the Forest of Arden which is the setting for Shakespeare's play *As You Like It*. In this connection, applicant points to a "famous quotation" from the play which refers to the area as "Arden."

Applicant's contentions do not overcome the Examining Attorney's prima facie case. Although we certainly recognize the fame of Shakespeare and the fact that he wrote the play *As You Like It*, there is no evidence of record bearing on the extent of exposure among consumers that the play is set in the Forest of Arden. Nor is there any evidence that consumers in the United States would be aware that there is a forest in England called "Arden." "Unless there is a readily recognized meaning for a term apart from its surname significance, the fact that other meanings for the term exist does not necessarily indicate that the term would have a primary meaning to the purchasing public other than that of its ordinary surname significance." *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1942 (TTAB 1993).

We note that it does not appear that "Arden" is the surname of anyone connected with applicant. Although we have considered this factor, we view it to be less

probative than the evidence relied upon by the Examining Attorney.

Lastly, we find that "Arden" has the "look and feel" of a surname. In re Sava Research Corp., 32 USPQ2d 1380, 1381 (TTAB 1994). In this connection, we take judicial notice that "Arden" is the surname of the cosmetician Elizabeth Arden. *The Random House Dictionary of the English Language* (2<sup>nd</sup> ed. Unabridged 1987). Further, the inclusion of the generic term "CRAVATS" in applicant's mark does not detract from the primary surname significance of the mark. In re E. Martinoni Company, 189 USPQ 589 (TTAB 1975).

Because applicant has failed to sufficiently set forth persuasive evidence or arguments to rebut the prima facie showing by the Examining Attorney, we conclude that ARDEN is primarily merely a surname under Section 2(e)(4) of the Act.

**Ser No.** 75/457,263

Decision: The refusals to register are affirmed.

E. J. Seeherman

T. J. Quinn

G. D. Hohein  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

**Ser No.** 75/457,263