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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Anita Dr. Helbig GmbH

Serial No. 76/148,491

Mark P. Stone, Esq. for Anita Dr. Helbig GmbH.

Daniel F. Capshaw, Trademark Examining Attorney, Law Office
109 (Leslie Bishop, Managing Attorney).

Before Walters, Chapman and Holtzman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Anita Dr. Helbig GmbH has filed an application to
register the stylized mark "Amadea"¹ on the Principal

¹ In response to a query by the Examining Attorney, applicant stated that its mark, appearing in the drawing in upper and lower case letters in a type font very similar to what is shown above, is a stylized mark (applicant response of September 27, 2001). However, the USPTO records have not been changed to show that the application contains a special form drawing rather than a typed drawing (See Trademark Rule 2.52(a)). If applicant ultimately prevails in this appeal, the Examining Attorney is directed to ensure that the USPTO records are corrected before this mark publishes for opposition.

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Register for "women's clothing, namely, bras, panties and corselets," in International Class 25.²

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark AMADEO, previously registered for "ladies, men's and children's shoes,"³ that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in

² Serial No. 76/148,491, filed October 16, 2000, based on German Registration No. 300 33 647.0 under Section 44(e), 15 U.S.C. §1126(e), with a claim of priority under Section 44(d), 15 U.S.C. §1126(d), based on the underlying German application filed April 28, 2000.

³ Registration No. 809,581 issued June 6, 1966, to Miami Shoe Factory, Inc., in International Class 25. [Renewed for a period of twenty years from June 7, 1986.]

the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Examining Attorney contends that the marks are "nearly identical" because "the marks share all lettering but for a final vowel, [thus] creat[ing] a strong similarity in sound"; and that the stylization of applicant's mark is minimal and does not serve to distinguish the marks. Regarding the goods, the Examining Attorney contends that the goods are related, citing several cases in which a likelihood of confusion was found for identical marks for various items of clothing⁴; and that the evidence of excerpts of articles retrieved from the LEXIS/NEXIS database includes many references to ladies' shoes and ladies undergarments originating from the same retailer,⁵ thus, establishing that the channels of trade for these products are the same. While these excerpts do not indicate whether these types of products are marketed under the same mark, the Examining Attorney also submitted copies of third-party registrations wherein the same mark is registered for numerous clothing items, including shoes and underwear.

⁴ The most relevant case cited is *Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549 (CCPA 1961) ("WINTER CARNIVAL" for women's boots as well as men's and boys' underwear).

Applicant contends that the marks are not identical and, given the differences in the goods, the marks are sufficiently different to avoid likelihood of confusion; and that the different vowels at the ends of the two marks create different commercial impressions. Applicant cites numerous cases involving various clothing items and shoes wherein no likelihood of confusion was found.⁶ Applicant contends, further, that, while shoes and underwear may be sold in the same large department stores, such items will be sold in different departments or sections; that the purchase of women's undergarments is of a personal or intimate nature and, therefore, the purchasers are discriminating and careful.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to

⁵ There is no indication in these articles that the respective goods, while sold in the same stores, are marketed under the same trademarks.

⁶ The most relevant case is *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (no likelihood of confusion for PLAYERS for shoes as well as men's underwear because PLAYERS has different connotation with respect to the different goods).

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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).

We agree with applicant that the marks are not identical, but it is clear that the only difference between the two marks is the final letter of each, which, in both marks is a vowel and, if pronounced softly, would sound very similar. There is no evidence indicating that either mark is other than arbitrary in connotation. The marks are sufficiently similar in overall commercial impression that, if viewed in time or place apart from one another and in connection with similar or related goods, confusion as to source is likely.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Both applicant and the Examining Attorney have cited numerous cases finding both likelihood of confusion or no likelihood of confusion for similar marks for various clothing and footwear products. This demonstrates the well established principles that each case must be decided on its own specific set of facts and that there is no per se rule for likelihood of confusion with respect to clothing and footwear items.

The third-party registrations of record indicate that numerous parties have registered the same mark for wide

varieties of clothing, including footwear and undergarments.⁷

The excerpted articles support the fact that retailers, whether stores, catalog sales, or Internet sales sites, often sell a wide variety of all types of clothing items. The majority of the excerpted articles refer to single entities, largely retail establishments, selling various types of clothing, including undergarments and footwear. The following are two examples:

In an effort to sell more athletic **shoes and jog bras** in an increasingly competitive marketplace, the maker of Air Jordans [Nike] said it would soon barrage the market with high- and moderate-priced items for sports-minded women. [*Daily News (New York)* August 23, 2000.]

Berkshire Hathaway Inc. owns subsidiaries that sell jewelry, boots and **shoes. Now, add to that list underwear.** ... Berkshire ... announced late Thursday its agreement to purchase the apparel operations of troubled Fruit of the Loom for \$835 million in cash. [*Omaha World-Herald Company* November 2, 2001.]

Neither article is explicit as to what trademarks are used on the various items. However, we infer from the first excerpt that the NIKE mark will be used on both athletic shoes and sports bras; and we equally infer from the second excerpt that Berkshire Hathaway, through various subsidiaries, will be selling jewelry, boots, shoes and

⁷ For example, the following registrations are among 14 registrations in this record for various items of clothing including "shoes" and "underwear": Reg. No. 2,475,698 for DU BLUE; Reg. No.2,504,070 for MELANO; Reg. No.2,498,301 for DARASJA JEAN COLLECTION; and Reg. No. 2,520,105 for OCEAN TRAVELERS.

apparel. Thus, we find this evidence, along with the third-party registrations, sufficient to establish a clear connection between the specific goods involved in this case.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, "Amadea," and registrant's mark, AMADEO, their contemporaneous use on the related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Finally, it is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The refusal under Section 2(d) of the Act is affirmed.