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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atico International USA Inc.

Serial No. 76/317,631

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Griffinger & Vecchione for Atico International USA Inc.

Monique C. Miller, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Atico International USA Inc. seeks registration on the
Principal Register for the mark as shown below:



for "sunglasses" in International Class 9, and "footwear, namely flip-flops and water shoes," in International Class 25.¹

This case is now before the Board on appeal from the final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has held that applicant's mark, as used in connection with these goods, would be likely to cause confusion, to cause mistake or to deceive consumers, in view of four prior registered marks owned by three different registrants. The cited marks are as follows:

SHORELINE



for "apparel - namely, rainwear" in International Class 25²

for "T-shirts" in International Class 25³

¹ Application Serial No. 76/317,631 was filed on September 26, 2001, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Registration No. 1,221,860 issued on December 28, 1982; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

³ Registration No. 1,671,827 issued on January 14, 1992; Section 8 affidavit accepted and Section 15 affidavit acknowledged; first renewal. Registrant herein, Abel Industries, Inc., claimed ownership of Registration No. 1,221,860, *supra*.



SHORELINE

for "retail store services in the field of sporting equipment," in International Class 42⁴

for "binoculars and parts therefore," in International Class 9⁵

Responsive to the refusal to register, applicant argues: that the various composite marks are quite dissimilar as to overall commercial impressions; that the Trademark Examining Attorney has improperly dissected the marks in her analysis; that beachwear and rainwear are not closely related and would not be placed in proximate areas in the retail setting; that there is no indication that "the goods sold via the identified retail services are sold under the same name" (applicant's response of April 26, 2002); that sunglasses are not closely related to precision optical instruments like binoculars; that each of these respective goods moves in a distinct channel of trade (or at the very least is located in markedly different sections of large retail outlets); that

⁴ Registration No. 1,575,736 issued on January 2, 1990; Section 8 affidavit accepted and Section 15 affidavit acknowledged; first renewal. The words "Board Shop" are disclaimed apart from the mark as shown.

⁵ Registration No. 2,304,844 issued on December 28, 1999.

items like surfboards⁶ and binoculars are purchased with great care; the third-party registrations submitted by the Trademark Examining Attorney with her Office actions of November 19, 2001 and of June 3, 2002 are of little probative value inasmuch as they do not show actual use in the marketplace; and the fact that three SHORELINE-formative marks for arguably related items of clothing have been permitted to coexist on the federal trademark register undercuts the Trademark Examining Attorney's position herein.

On the other hand, the Trademark Examining Attorney contends: that when applicant's mark is compared with the marks in the cited registrations, the literal element in each ("Shoreline") is significant and dominant, creating similar overall commercial impressions in all the marks; and that Lexis/Nexis excerpts and Internet evidence demonstrate that the several sets of goods under discussion herein are related, and that these respective goods will move through the same channels of trade to the same class of consumers.

Both applicant and the Trademark Examining Attorney have fully briefed the case on appeal; however, applicant did not request an oral hearing before the Board.

⁶ We note that none of the cited registrations has listed any goods identified as "surfboards," although the composite service mark image of the '736 registration does contain representations of two different surfboards, and includes the word "Board" among its literal elements.

Our determination under Section 2(d) is based upon 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 the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the similarities of the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by turning to a comparison of the respective marks. The literal portion of applicant's mark is the word "Shoreline." This is identical to the literal portions of the '860, '827 and '844 registrations. As correctly noted by the Trademark Examining Attorney, the literal elements of such marks are much more important than subordinate design features because consumers will call for the goods in the marketplace using that literal portion of the marks. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). While applicant correctly describes the design differences between its composite mark ("three ellipses of increasing size") and Abel Industries' composite mark ("setting sun" and "gulls or other waterfowl"), in each of these marks, the only way to call for the respective goods is

with the term "Shoreline." Hence, these marks are aurally identical. As to appearance, the literal portion is also the most prominent feature of each mark and will be the image consumers will remember of the composite marks. All have identical connotations suggestive of "the line where a body of water and the shore meet."⁷ Hence, applicant's mark has an overall commercial impression that is quite similar to that which each of these three cited marks has in connection with their associated goods.

As to the cited service mark (SHORELINE BOARD SHOP and surfer design), it clearly contains two additional literal elements not present in applicant's mark. However, the highly descriptive (or generic) terminology, "Board Shop," is disclaimed apart from the mark as shown. For this reason, the Trademark Examining Attorney correctly places less emphasis on this portion of the composite when comparing the marks in their entireties. Moreover, as to connotation, the active surfer motif within this composite mark serves to reinforce the suggestive term "Shoreline" - the surfer has caught a wave towards the shoreline, which also happens to be the optimal location for such a shop. Accordingly, we find

⁷ Merriam Webster's Collegiate Dictionary, <<http://www.m-w.com/cgi-bin/dictionary>>

then that applicant's mark is confusingly similar in overall commercial impression to each of the cited marks.

We turn then to the similarity or dissimilarity and nature of the goods or services as described in the instant application and in connection with which the cited marks are registered. The instant application identifies goods in two classes: footwear, namely flip-flops and water shoes (in Class 25) and sunglasses (in Class 9).

We begin our discussion of this du Pont factor by comparing applicant's casual footwear, specifically flip-flops and water shoes, with the clothing items listed in the first two cited registrations. Properties of the same registrant, one lists rainwear (Registration No. 1,221,860) and the second lists T-shirts (Registration No. 1,671,827).

Applicant points out that its footwear and registrant's rainwear are used in "climatically diametrically opposed" environments (a sunny beach versus a rainstorm?). However, this is a distinction without a difference. The Trademark Examining Attorney has demonstrated that national retailers like L.L. Bean and Old Navy sell both rainwear and water shoes in close proximity. Moreover, we presume that flip-flops and water shoes could well be worn at the beach or during a summer thunderstorm. See also In re Dexter Shoe Company, 158 USPQ 684 (TTAB 1968). Furthermore, other than

rainwear, all the other relevant items of apparel are on the casual end of the clothing spectrum. In this vein, the Trademark Examining Attorney submitted Lexis/Nexis excerpts repeatedly referring to individuals who are wearing "T-shirts and flip-flops." This relationship between the respective goods is supplemented with evidence from Internet webpages showing that T-shirts and flip-flops are marketed on the same page, and with third-party registrations where the same mark is registered for both types of casual apparel.

The services in cited Registration No. 1,575,736 are recited as follows: "retail store services in the field of sporting equipment." While the words BOARD SHOP, the outline of a surfboard and the picture of an active surfer may suggest the sale of surfing goods, the actual recital of services is clearly not limited to the sale of surfboards. In fact, the Trademark Examining Attorney has shown from registrant's own webpage that its retail merchandise includes eyewear, footwear and other beach clothing. Accordingly, we find that this recital of services would include the sale of specific items like sunglasses, flip flops and water shoes.

We turn then to a determination of the relatedness of sunglasses and binoculars. The Trademark Examining Attorney has introduced into the record nine third-party registrations where the same mark is registered for both sunglasses and

binoculars. Copies of screen prints from a number of Internet websites show that sunglasses and binoculars are promoted side by side as two types of "optics" or "optical goods." Like large telescopes, sports scopes and microscopes, a person's eyeglasses, sunglasses and binoculars incorporate optical glass lenses as key components. Clearly, applicant's sunglasses are designed to protect one's eyes from the sun's glare and resulting fatigue, while the registrant's goods are designed to focus clearly on images that are relatively far away. However, given the realities of the marketplace, this distinction as to the function or application of these optical goods is not a critical difference in making a likelihood of confusion determination under the Lanham Act herein.

As to a related du Pont factor, it is clear from the record - i.e., actual retail advertisements drawn from the real marketplace and placed into the record by the Trademark Examining Attorney - that it is not unusual for sunglasses and binoculars to move through the same channels of trade. Furthermore, as noted above, flip-flops, T-shirts and rainwear are also frequently available through the same retail channels of trade.

Finally, applicant argues, without any proof, that "binoculars and parts therefor are purchased with a high

degree of care" (applicant's response of April 26, 2002). Presumably this argument is based on the logic that the expense of a pair of binoculars prompts a greater degree of care in the purchase of such items. However, this conclusion certainly does not follow from the evidence placed into the record by the Trademark Examining Attorney. For example, one pair of binoculars the Trademark Examining Attorney found advertised on the Internet retails for less than twenty-five dollars.⁸

In conclusion, we find that applicant's mark is confusingly similar to each of the cited marks, that applicant's listed items of footwear are related to the clothing items and retail sporting good services of the cited registrations, that sunglasses are related to binoculars, and that in each of these cases, the respective goods move through the same channels of trade to the same class of ordinary consumers.

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

⁸ <<http://www.ems.com/navigation/>> accessed on April 26, 2002. On this website, the Celestron binoculars are advertised at \$24.⁹⁸.