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THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Orvis Company, Inc.

Serial No. 78276739

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Minnich & McKee for The Orvis Company, Inc.

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111 (Craig D. Taylor, Managing Attorney).

Before Walters, Holtzman and Wellington, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

The Orvis Company, Inc. has filed an application to
register the mark STREAMLINE on the Principal Register for
"fishing vests," in International Class 25.¹

The 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 STREAMLINE, previously registered for "women's and

¹ Serial No. 78276739, filed July 21, 2003, based on use of the mark in
commerce, alleging first use and use in commerce as of January 31, 2002.

girls' swimwear, leotards and girdles,"² 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. We reverse the refusal to register.

Preliminary Matter

The examining attorney objected to the evidence submitted by applicant with its brief. Applicant responded that all evidence attached to its brief had been previously made of record prior to appeal and requested that the evidence attached to the examining attorney's brief be stricken. All evidence must be made of record prior to appeal or in connection with a request for reconsideration or a remand. Therefore, we have considered only that evidence submitted by either the examining attorney or applicant prior to appeal or in connection with the request for reconsideration and the remand herein.³

² Registration No. 2350414 issued May 16, 2000 from an application filed April 12, 1996, to A & H Sportswear Co., Inc. Section 8 (6-year) accepted & Section 15 acknowledged.

³ For example, we have not considered the website directories submitted by applicant for the first time with its brief, even though they pertain to websites excerpted by the examining attorney during examination.

Analysis

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). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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 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 identical and the goods are closely related, noting that both fishing vests and swimwear are "clothing items ... primarily for recreational purposes for both sexes and may be simultaneously purchased in retail or department stores." (Brief, p. 7.) The examining attorney contends that "all

clothing goods such as swimwear and fishing vests are related as to marketing"; that "both sexes purchase the goods in issue"; and that "decisions in the clothing field have held many different types of apparel to be related under Section 2(d)." ⁴ (Id., p. 8.) The examining attorney contends that the respective goods travel through the same trade channels to the same class of purchasers, noting that the issue is not whether purchasers will be confused as to the nature of the goods, but whether confusion is likely as to the source of those goods. ⁵

In support of its position, the examining attorney submitted excerpts from three Internet websites and copies of twenty-six third-party registrations or applications. The websites, Dick's Sporting Goods, Fog Dog Sports and Modell's, each offer a wide variety of goods, including fishing vests, swimwear and leotards. However, we note that these retail sites offer these goods under a wide variety of brand names, none of which are the store name; and there are

⁴ The examining attorney cites numerous cases involving clothing, but none involves the goods in this case. We emphasize that there is no per se rule that clothing items are related for the purpose of determining likelihood of confusion.

⁵ The examining attorney also made an argument regarding expansion of trade, but he not only did not support this argument with any evidence, but the specific argument itself was less than coherent and is not well-taken. *In re First Realty Professionals, Inc.*, ___ USPQ2d ___, Serial No. 78553715 (TTAB, August 7, 2007) ["the concept of expansion of trade is generally addressed in the context of the issue of priority in an inter partes proceeding."] The doctrine, in an ex parte context, essentially requires application of the traditional related goods and services analysis.

no brands identifying fishing vests that also identify swimwear or leotards on these sites.

The examining attorney submitted six applications, which are proof only of their filing and, thus, are of no probative value for determining any relationship between the respective goods. Similarly, of the twenty third-party registrations submitted, eleven registrations are based on foreign registrations under Section 44 with no showing of use and, thus, are of no probative value herein. Of the remaining fifteen registrations, three are owned by the same entity and, thus, two of these registrations are redundant for purposes of exemplifying the goods registered by that entity. Therefore, we find that the examining attorney has submitted thirteen third-party registrations that may be probative of the issues herein.

Applicant contends that the mark in this application should register based upon applicant's ownership of Registration No. 3074283 for the mark STREAMLINE for fishing tackle, arguing that the goods, i.e., fishing tackle and fishing vests, are closely related and USPTO "Examination Guide 1.01 dated April 3, 2001 states that related applications should be treated consistently." (Brief, p. 3.) In support of the contention that fishing vests and fishing tackle are closely related, applicant submitted excerpts from online sites offering both items for sale in close

proximity to each other, and two third-party registrations that include both items in the identification of goods for each mark.

Applicant contends, further, that its fishing vests and the goods in the cited registration, i.e., women's and girl's swimwear, leotards and girdles, are different and unrelated and makes the following statement in this regard (brief, p. 5):

Fishing vests are technical, utilitarian items that are part of the fly fisherman's standard equipment. Applicant's fishing vests are not form fitting or sleek - rather, they are somewhat boxy and offer plenty of fishing tackle storage for fishermen. The fishing vest is, in a sense, a wearable tackle box.

In contrast, the cited registrant's goods ... are specifically limited to "women's and girls'" merchandise. Moreover, they are comprised of "clingy" materials and designed to fit snugly against the female body."

Applicant adds that its goods are more like tools than garments; that the respective goods are purchased by entirely different consumers (fly fishermen versus women and girls)⁶; and that the purchases of both applicant's and registrant's goods are made with care given the nature of the goods and their prices.

Applicant states that the channels of trade for the respective goods are different, alleging that its goods "are

⁶ At the same time, applicant acknowledges that women engage in fly fishing and that women purchase fly fishing vests and equipment.

sold through fly fishing catalogs, fishing stores and online fishing sites"; whereas, registrant's goods "are sold in women's apparel stores or departments, in women's foundations departments, and in dance stores" (brief p. 9); and that, to the extent some of these goods may be sold in large sporting goods stores, such stores sell a wide variety of unrelated goods in distinct departments, which would be quite different for the involved goods. Regarding the examining attorney's evidence consisting of excerpts from Internet websites of large sporting goods retailers, applicant notes that the products offered on those sites are identified by various different brands unrelated to the name of the retailer. Applicant also discounts the third-party registrations submitted by the examining attorney on the ground that they that contain long and greatly varied goods in the identifications, that some of the registrations are based on Section 44 and notes that the pending applications are of no probative value.

Finally, applicant argues that STREAMLINE is a relatively weak mark with respect to the identified goods and that STREAMLINE has a different connotation with respect to applicant's goods and registrant's goods. The definition of "streamline" in the record is as follows:

1. To construct or design in a form that offers the least resistance to fluid flow.
2. To improve the appearance or efficiency of; modernize.
3. To organize. To simplify.

Applicant states that "the suggested connotation of STREAMLINE associated with fishing vests is that of organization and simplification (i.e., the third definition). As applied to women's and girls' swimwear, leotards and girdles, there is a suggestion of improving one's appearance or resisting fluid flow (i.e., the first and second definitions)." (Brief, p. 15.)

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. There is no question that the marks are visually and phonetically identical. However, we agree with applicant that the connotation of the word STREAMLINE is slightly different in connection with the involved goods. With respect to women's and girls' swimwear, leotards and girdles, STREAMLINE is likely to connote both the form-fitting nature of these garments and the resulting look and performance of the garments. Regarding swimwear in particular, STREAMLINE is likely to also connote the possibility of improved performance in the water by the swimmer who wears this swimwear. With respect to a fishing vest, STREAMLINE is likely to connote not the look of the garment or wearer, but the organizational properties of the vest, permitting the wearer to simplify the activity of fishing by allowing the wearer to carry a

lot of his or her gear in or on the vest, rather than in a separate box or bag. Also, with respect to fishing, the compound word STREAMLINE carries the double entendre reference to fishing lines and streams. Therefore, while the marks are visually and phonetically identical, the connotations differ slightly. However, notwithstanding the differences in connotation, we conclude that the overall commercial impressions of the two marks are substantially similar.

Next, we consider applicant's goods and those of registrant. 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. The goods or services must be related in some manner or some circumstances surrounding their marketing must be 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 party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

We agree with applicant that fishing vests are more in the nature of utilitarian items than garments such as leotards, swimwear and girdles. There is no evidence in the record that girdles are in any way related to fishing vests and we find that the examining attorney has not established a relationship between girdles and fishing vests.

We also find the likelihood of confusion cases cited by the examining attorney to be inapposite because the cases pertain to clothing items wholly different from those herein and there is no per se rule regarding likelihood of confusion among clothing items. Nor do we find the mere fact that one "wears" a fishing vest to render it an article of clothing related to swimwear or leotards such that, as the examining attorney states, they are "all clothing goods [that] are related as to marketing" (supra). In fact, the Internet evidence excerpted by the examining attorney indicates that these items are not marketed under the same

marks or on the same Internet pages, even when offered by the same retailer.

Considering the thirteen third-party registrations considered to be of some probative value (see supra), we find that the vast majority of these registrations are analogous to house marks because the identifications of goods encompasses a broad range of clothing, accessory and sporting goods products. Therefore, the inclusion of fishing vests, swimwear and/or leotards in the identifications of goods is not particularly significant. Therefore, we do not find, on this record, that fishing vests on the one hand, and swimwear and/or leotards on the other hand, are related products which could be expected to emanate from the same source.

We disagree with applicant's contention that the channels of trade and classes of purchasers for the respective goods are quite different. The goods themselves are quite different; however, these are all items sold at retail to the general consumer and, thus, the class of purchasers is the same. While, as applicant contends, each of these items may be sold in different specialty stores, there is also evidence that large retailers carry all of the involved goods. Therefore, we must conclude that the channels of trade are at least overlapping.

We also note that applicant's contention is not well taken that, because its mark registered in connection with fishing tackle and fishing tackle and fishing vests are closely related, the mark should also register for fishing vests. While applicant correctly notes that applications should be treated consistently, this principle does not pertain to the issue of likelihood of confusion regarding different goods in different applications. The applicable principle herein is that the determination of registrability in each application must be made based upon the merits of that particular application. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court."].

In conclusion, despite the substantial similarity in the commercial impressions of applicant's and registrant's marks, and the overlapping trade channels and purchasers, we find that the examining attorney has failed to establish that the goods are related such that their contemporaneous use on the respective goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

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