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Oral Hearing: December 5, 2006

Mailed: March 8, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Invista North America S.A.R.L.

Serial Nos. 78598843 and 78610808[1]

Patricia Smink Rogowski of Connolly Bove Lodge & Hutz LLP for Invista North America S.A.R.L.

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Before Hairston, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Invista North America S.A.R.L. seeks registration on the Principal Register of the mark XTRA LIFE LYCRA(standard character claimed) for goods ultimately identified as "fabric for the manufacture of clothing" in International Class 24[2] and the mark shown below for goods ultimately

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[1] On April 27, 2006, the Board consolidated these appeals for purposes of briefing and oral argument.

[2] Application Serial No. 78598843, filed March 31, 2005, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b). 15 U.S.C. §1051(b).

identified as "fabrics for the manufacture of clothing" in International Class 24.[3]

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used with its identified goods, so resemble the registered mark XTRALIFE (in typed form) for "textile fabrics made of natural and/or synthetic fibers and combinations thereof for use in the manufacture of napery" in International Class 24[4] as to be likely to cause confusion, mistake or deception.[5]

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[3] Application Serial No. 78610808, filed April 18, 2005, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b). 15 U.S.C. §1051(b).

[4] Registration No. 1653115, issued August 6, 1991; renewed.

[5] Both applications originally also contained goods in International Class 22 ("synthetic fibers and filaments for the manufacture of clothing") and International Class 25 ("swimwear; bodysuits; girdles; exercise apparel, namely, sports bras, leotards, bike shorts, ski-wear, track suits, sweat pants, sweatshirts; t-shirts, shirts, vests, jumpers, trousers, sweaters; athletic uniforms; socks; stockings; pantyhose; sportswear, namely, shirts, t-shirts, vests, jumpers, sweatshirts, sweat pants; trousers; shorts; jackets; coats; hats; lingerie and headwear"). The examining attorney issued the Section 2(d) refusals only against the goods in International Class 24 in each application. On August 16, 2005, the USPTO granted applicant's divisional request and placed the goods in these two classes in corresponding child applications.

When the refusal was made final, applicant filed this appeal and requested reconsideration. The examining attorney denied the request for reconsideration and the appeal was resumed. Briefs have been filed and an oral hearing was held upon applicant's request. We reverse the refusal to register.

As a preliminary matter, the examining attorney has objected to the material attached to applicant's main brief as untimely. Inasmuch as this material was not submitted prior to briefing it is untimely and has been given no consideration. Trademark Rule 2.142(d). With regard to the printouts of applicant's prior registrations attached to applicant's reply brief, although applicant listed these registrations as prior registrations in its applications, applicant did not specifically reference them in its responses to the office actions. Moreover, applicant has submitted them with its reply brief in support of its argument that its LYCRA mark is well-known, which is for a different purpose than the listing in the applications to assert ownership of prior registrations, and, thus, the examining attorney has not had an opportunity to address these prior registrations in the context of this new

purpose. Therefore, these printouts are untimely and have not been considered.[6]

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We begin with the first du Pont factor, i.e., whether applicant's XTRA LIFE LYCRA marks and registrant's mark XTRALIFE are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. The analysis is not whether the marks can be distinguished when compared side-by-side.

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[6] This is not a case where an applicant submitted a listing of registrations in its response to a refusal and the examining attorney failed to advise applicant that a mere listing of registrations is insufficient to make such registrations of record. See TBMP §1207.03 (2d ed. rev. 2004).

Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975). Finally, we note that it is appropriate to accord greater importance to the more distinctive elements in the marks than to the less distinctive elements in determining whether the marks are similar. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The examining attorney argues that applicant's marks are "essentially a combination of its house mark with a registered mark," (br. p. 2) and that "[w]hen viewing the presentation of the registered mark in applicant's mark, the similar elements are not presented in a manner where the source-identifying significance of registrant's mark becomes lost in a new commercial impression." Br. pp. 3-4. The examining attorney further argues, with regard to the mark in application Serial No. 78610808, that the word portion is more likely to be impressed upon a purchaser's memory than the design.

In response, applicant argues that the term LYCRA is the dominant element in its marks. Further, applicant argues that "LYCRA is a well known mark and has meaning to consumers, as it would be associated with applicant and particular types of stretch and recovery fabric" and the "LYCRA component has a significant effect in reinforcing the differences between the goods." Br. p. 11. Applicant argues that in view of the LYCRA element its marks create a different connotation and commercial impression than registrant's mark. Applicant also asserts that XTRALIFE is a weak mark and should be accorded only a limited protection.

In support of its position that XTRALIFE is a weak mark, applicant submitted several third-party registrations that include XTRA LIFE or EXTRA LIFE in the mark. None of these registrations are for fabric. Applicant also submitted printouts of two of its active prior registrations as set out below:

> Registration No. 2780953 for XTRA LIFE for "nylon fibers sold as an integral component of upholstery fabrics for industrial, commercial, and residential applications, fibers" in International Class 24; and
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> Registration No. 2485680 STAINMASTER XTRA LIFE for "carpets" in International Class 27.

Third-party registrations are not evidence of use and, thus, are of little probative value in an analysis of the strength of the marks. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Third-party registrations may be "useful to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those engaged in a certain field or industry and that said term has less than arbitrary significance with respect to certain goods or services." In re Dayco Products-Eaglemotive, Inc., 9 USPQ2d 1910, 1912 (TTAB 1988) (IMPERIAL adopted by others in the vehicular field to refer to that term's ordinary significance as a laudatory designation). While the third-party registrations are not particularly probative on the question of whether XTRALIFE has a particular significance in the field of fabric, we take judicial notice of the following dictionary definitions for EXTRA and LIFE:[7]

> EXTRA 1. More than or beyond what is usual, normal, expected, or necessary 2. Better than ordinary; superior. The American Heritage Dictionary of the English Language (4th ed. 2000);
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> LIFE 1. i. A specific, characteristic manner of existence. Used of inanimate objects. The

[7] The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

> American Heritage Dictionary of the English Language (4th ed. 2000); and
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> LIFE 7. the period of existence, activity, or effectiveness of something inanimate, as a machine, lease, or play: The life of the car may be ten years. Random House Unabridged Dictionary (2006).

Based on these dictionary definitions, it is clear that EXTRA LIFE suggests that the goods will exist or last for more than or beyond what is usual. There is also no reason or evidence to suggest that this meaning of "life" or "extra life" would not apply to fabric. Therefore, at a minimum, the mark XTRALIFE is highly suggestive of a characteristic of the goods and, thus, we find the mark XTRALIFE is not a particularly strong mark which would be entitled to the same scope of protection that a more arbitrary and less suggestive mark would receive.

In support of its argument that the LYCRA element of its marks is well-known, applicant provided a submission from what appears to be a webpage entitled Encylopedian noting that LYCRA is a well-known trademark for spandex and other webpages that discuss LYCRA and spandex.[8] We also take judicial notice of the following dictionary definitions for LYCRA and SPANDEX:

[8] These other printouts of record are not sufficiently legible to decipher what specifically is written there.

> LYCRA: a brand of spandex. Random House Unabridged Dictionary (2006);
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> LYCRA: a trademark used for a brand of spandex. The American Heritage Dictionary of the English Language (4th ed. 2000);
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> SPANDEX: a synthetic fiber composed of a long-chain polymer, used chiefly in the manufacture of garments to add elasticity. Random House Unabridged Dictionary (2006); and
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> SPANDEX: a synthetic fiber or fabric made from a polymer containing polyurethane, used in the manufacture of elastic clothing. The American Heritage Dictionary of the English Language (4th ed. 2000).

We agree with applicant that LYCRA is the dominant element in applicant's marks in view of its inherently distinctive and arbitrary nature in comparison to the suggestive XTRA LIFE element. We also note the strength of the LYCRA mark as evidenced by its entry in the widely known dictionaries and corroborated by the Encyclopedian printout. With regard to the appearance and sound of applicant's and registrant's marks, we find that they differ in view of the addition of LYCRA and, in the case of application Serial No. 78610808, the design element adds to the difference in appearance. As to connotation, the dictionary definition of record clearly shows that applicant's marks have the added meaning of a stretchy fabric or fiber used for clothing. Thus, while the marks share the phrase XTRA LIFE, given the dominant element of

LYCRA in applicant's marks, the overall commercial impressions of the marks are different.

The examining attorney advances the argument that the addition of a house mark does not obviate a likelihood of confusion, citing In re Dennison Mfg. Co., 229 USPQ 141, 146 (TTAB 1986). However, as the Board stated in Knight Textile Corp. v. Jones Investment Co., 75 USPQ2d 1313, 1315 (TTAB 2005), quoting from New England Fish Company v. The Hervin Company, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975):

> ...there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product mark. Rather, each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark. (citation omitted)

The Board further quoted from the underlying Board decision in New England Fish:

> In accordance with the reasoning in this decision, the Court of Customs and Patent Appeals and this Board have held that, where a party is seeking to register a composite mark consisting of a product mark in association with a housemark or a surname and registration is opposed by a prior user of a mark alleged to be similar to the said product mark and there are some recognizable differences in the asserted conflicting product marks *or* the product marks in question are *highly suggestive* or play upon commonly used or registered terms, the addition to applicant's mark of the housemark was sufficient to render the marks as a whole registrably distinguishable.

New England Fish Company v. The Hervin Company, 179 USPQ 743, 746 (TTAB 1973) (emphasis added).

In Knight Textile, the Board found that although applicant's mark NORTON MCNAUGHTON ESSENTIALS incorporated the whole of opposer's mark ESSENTIALS, because ESSENTIALS "is a highly suggestive term...under our case law, applicant's addition of its house mark...suffices to distinguish the two marks when viewed in their entireties." Knight Textile, supra, 184 USPQ at 1316.

Taking into consideration the somewhat limited scope of protection to be afforded registrant's mark XTRALIFE and the strength of applicant's LYCRA mark, we find that the dissimilarities outweigh the similarities and the factor of the similarity of the marks does not weigh in favor of a finding of likelihood of confusion.

We now turn to a consideration of the goods identified in the applications and the cited registration. It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the applicant's

goods and the cited registrant's goods as they are described in the applications and registration. See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

In support of his position, the examining attorney submitted evidence in the form of third-party use-based registrations that support his argument that applicant's fabric for use in the manufacture of clothing is related to registrant's fabric for use in the manufacture of napery. See, e.g., Reg. No. 1835887 (ECHO for, inter alia, textile piece goods; namely, cotton, wool, silk, linen and synthetics for use in the manufacture of bed linens, home furnishings, table linens and clothing); Reg. No. 1817969 (COLTEJER for fabrics for use in the manufacture of clothing, curtains, table cloths and bed covers); Reg. No. 2487892 (DEWTECH for, inter alia, non-woven fabric for the manufacture of clothing articles, bed and table covers ... table linen ...); Reg. No. 2522979 (OPTIMER for, inter alia, polyester and cotton blend fabrics for use in the manufacture of linens and clothing; bath, bed, and table linen); Reg. No. 2328602 (JESVRVM for, inter alia, fabrics for use in the manufacture of clothing articles, table

linen, bath linen, bed linen); and Reg. No. 2462890 (DRI-RELEASE for, inter alia, polyester and cotton blend fabrics for use in the manufacture of linens and clothing; bath, bed, and table linen). Third-party registrations which individually cover a number of different items, and which are based on use in commerce, may serve to suggest that the listed goods are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). In addition, the examining attorney submitted two webpages that show various types of fabric for sale, including "apparel" and "home décor" fabric. See, www.fashionfabricsclub.com and www.fabric.com. Finally, the examining attorney submitted the following dictionary definition of napery: Napery Household linen, especially table linen. The American Heritage Dictionary of the English Language (4th ed. 2000). The examining attorney also requests judicial notice be taken of the same dictionary definition that appears in Webster's Third New International Dictionary (1986).

In response, applicant argues that the identification of goods in its applications and the cited registration are each limited to different uses. Further, applicant argues that its fabrics have certain qualities for use in swimwear and active wear, essentially arguing that its mark LYCRA

further limits its goods to a stretchy fabric which is not a property consumers would associate with table linen.

We find the third-party registrations sufficiently persuasive to conclude that applicant's and registrant's goods are related. We cannot agree with applicant that the presence of LYCRA in the mark may serve to limit the goods; we must look to the identification to find any possible limitations. Nor do we think that, even given the implication of stretchy fabric based on the presence of LYCRA in the mark, consumer's would automatically exclude stretchy or resilient fabric from use for napery.[9] Thus, although applicant's and registrant's goods are not for the same purpose, they are related and the du Pont factor of the similarity of the goods favors a finding of likelihood of confusion.

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[9] We note that the prior cases cited by the examining attorney where finished clothing items were found to be related to fabric are not particularly persuasive inasmuch as the issue here involves different end uses, clothing and napery. The cases referenced by applicant are more on point. See, e.g., Goodall-Sanford, Inc. v. The Landers Corp., 89 USPQ 69, 70 (CCPA 1951) ("It is clear to us that while, broadly, the goods of the parties may be held to possess the same descriptive properties, they are so utterly different in quality, texture, appearance, and use that it would not be good sense to state that they possess such common properties as to bring them within the liberal interpretation referred to by the Commissioner."); Glen Raven Cotton Mills, Inc. v. Jayvee Brand, Inc., 165 USPQ 791 (TTAB 1970) (use of similar marks on fabric for upholstery, awnings and outdoor clothing, and on infant sleepwear not likely to cause confusion).

Considering the channels of trade, the examining attorney correctly states that absent limitations in the identifications we must consider all normal channels of trade and registrant's Section 8 declaration submitted by applicant cannot be used to limit the channels of trade. While there is no evidence on the question of whether table linen and clothing would be manufactured by the same entity, we must consider the normal channels of trade, and it is not clear that these goods would share the same normal channels of trade. Applicant states that its goods are purchased by clothing manufacturers and registrant's goods are purchased by table linen manufacturers. Further, applicant states that "[e]ven assuming one company purchased both types of fabrics, such fabrics would be purchased by difference [sic] divisions within a company for different uses." Br. p. 22. The examining attorney has submitted evidence of different types of fabric being sold on the same website; however, we do not find this evidence persuasive given the identification of goods specifically indicating the fabrics are for "manufacturing." "Manufacturing" implies as part of the conditions of sale that the purchasers are manufacturers and, in the case of the manufacturing of clothing or napery, that they are sophisticated purchasers who exercise

heightened care in their purchasing decisions. Thus, to the extent that applicant's and registrant's channels of trade would overlap, the purchasers would be sophisticated. Therefore, the factor of the conditions of sale weighs against a finding of likely confusion.

In conclusion, we find that because of the dissimilarities in the marks and the conditions of sale, which would necessarily involve sophisticated purchasers, confusion is not likely between applicant's marks and the mark in the cited registration.

Decision: The refusals to register under Section 2(d) of the Trademark Act are reversed in each application.