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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alpina, tovarna obutve, d.d., Žiri

Serial No. 79015585

Marsha G. Gentner of Jacobson Holman PLLC for Alpina, tovarna obutve, d.d., Žiri.

Morgan L. Wynne, Trademark Examining Attorney, Law Office 117 (Loretta C. Beck, Managing Attorney).

Before Walters, Kuhlke and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On August 31, 2005, Alpina, tovarna obutve, d.d., Žiri filed application Serial No. 79015585 under the provisions of Section 66 of the Trademark Act of 1946, 15 U.S.C. §1141f, seeking to register the mark ALPINA and Design, shown below, for goods ultimately identified as "footwear of all kinds, including sport shoes" in Class 25.

In response to an inquiry from the Examining Attorney, applicant submitted a statement explaining that "Alpina" "has no significance in the relevant trade or industry as applied to the goods/services listed in the application, no geographical significance, nor any meaning in a foreign language." Applicant also claimed ownership of the following registrations:

1. Registration No. 1029662 for the mark shown below for ski boots and mountaineering boots;[1]

2. Registration No. 1307127 for the mark ALPINA, in typed drawing form, for mountaineering boots and hiking boots;[2]

3. Registration No. 1580171 for the mark ALPINA and design, shown below, for sports footwear;[3] and,

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[1] Registration No. 1029662, issued January 6, 1976; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.
[2] Registration No. 1307127, issued November 27, 1984; Sections 8 and 15 affidavits accepted and acknowledged; renewed.
[3] Registration No. 1580171, issued January 30, 1990; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

4. Registration No. 1596521 for the mark ALPINA and design, shown below, for sports footwear;[4]

The Trademark Examining Attorney finally refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with "footwear of all kinds, including sport shoes," so resembles the mark L'ALPINA, shown below, for "men's and women's cardigans, pullovers, shirts, caps, berets, gloves, socks, stockings, underwear, stretch suits and scarves," as to be likely to cause confusion.[5] The registration includes the statement that "the drawing of the mark is lined for the colors red and blue but no claim is made as to color."

[4] Registration No. 1596521, issued May 15, 1990; Sections 8 and 15 affidavits accepted and acknowledged; renewed.
[5] Registration No. 091894, issued August 24, 1971, Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

Evidentiary Issues

As indicated above, in response to a request from the Examining Attorney during the prosecution of the application, applicant submitted a statement explaining that "Alpina" "has no significance in the relevant trade or industry as applied to the goods/services listed in the application, no geographical significance, nor any meaning in a foreign language." In his brief, the Examining Attorney submitted the definition of the Italian word "Alpina" meaning "mountain," citing Collins Mondadori Nuovo Dizionario Inglese, p. 22 (1995).[6] In addition, the Examining Attorney submitted the definition of "La" from the Zanichelli New College Italian and English Dictionary (1990), which according to the Examining Attorney, shows

[6] This is an Italian-English dictionary.

that the letter "L" before the word "Alpina" in "L'Alpina" "is an abbreviated version of the Italian article 'LA' which translates to 'THE' in English."[7] Based on this evidence, the Examining Attorney argued that the words L'ALPINA and ALPINA have the same or similar meanings. The Examining Attorney requested that the Board take judicial notice of the definitions.

In its Reply Brief, applicant objected to the Board's consideration of the dictionary definitions. Applicant argued that the Board should not consider this evidence or the arguments based on it for the following reasons:

1. The Examining Attorney never argued that L'ALPINA and ALPINA had the same or similar meanings until his brief;
2. The Board should not take judicial notice of the dictionary definitions because the record in a file should be complete before the appeal;
3. The definitions of "Alpina" and "L'Alpina" are not proper subjects for judicial notice because (i) there is no evidence to support the assertion that the definitions are generally known in the United States, and (ii) applicant has had no

[7] Examining Attorney's Brief, pp. 3-4.

opportunity to check the reliability of the sources submitted by the Examining Attorney.

At the outset, we note that applicant's contention that it has not had an opportunity to check the reliability of the sources submitted by the Examining Attorney rings hollow in light of the fact that during the prosecution of the application, applicant submitted a statement that the word "Alpina" has no meaning in a foreign language. Applicant had to have a reasonable basis, presumably with evidentiary support, to make that statement. Moreover, if applicant had evidence that it wished the Board to consider regarding the meaning of its mark in reply to the definitions submitted by the Examining Attorney, the proper course of action would have been for applicant to ask the Board to suspend the appeal and remand the application to the Examining Attorney with the evidence sought to be admitted into the record. Trademark Rule 2.142(d), 37 CFR §2.142(d). *See also In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984); TBMP §1207.02 (2nd ed. rev. 2004).

Also, we find nothing inherently wrong with the Examining Attorney addressing the meaning of the marks at issue for the first time in the brief. It is well settled that in analyzing the similarities or dissimilarities of

the marks, the Board is required to consider the marks in their entireties in terms of appearance, sound, **connotation** and overall commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). By referring to the meaning of the marks, the Examining Attorney was explaining why he thought the marks were similar. He was not asserting a new claim or ground for refusal. Accordingly, it is not surprising and, in fact, applicant should have anticipated, that the Examining Attorney would have addressed each of the four factors regarding the similarity of the marks in his brief.

Finally, the Board may take judicial notice of the meaning of words, and may refer to dictionaries or other recognized authorities for the common meaning of language. *Hancock v. American Steel & Wire Co. of New Jersey,* 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953). *See also In re Johanna Farms Inc.,* 222 USPQ 607, 610 n.8 (TTAB 1984) ("We also take judicial notice of French and English language dictionaries"); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.,* 213 USPQ 594, 596 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Mark A. Gould, M.D.,* 173 USPQ 243, 244 (TTAB 1972)

(Board may take judicial notice of the use of a term in dictionaries or recognized textbooks).

In view of the foregoing, applicant's objection is overruled, and the Board will take judicial notice of the dictionary definitions submitted by the Examining Attorney and accord them the probative value to which they are entitled.

Likelihood of Confusion

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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co., supra. See also, In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

The first *du Pont* likelihood of confusion factor focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co., supra.* In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.,* 6 USPQ2d 1041, 1042 (TTAB 1988). *See also, In re White Swan Ltd.,* 9 USPQ2d 1534,

1535 (TTAB 1988). In comparing the marks, we are mindful that 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 impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.,* 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.,* 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.,* 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106, 108 (TTAB 1975).

In analyzing the marks in their entireties, a particular feature or portion of the mark may be given greater weight if it makes an impression upon purchasers that would be remembered and relied upon to identify the products. *In re Appetito Provisions Co.,* 3 USPQ2d 1553, 1554 (TTAB 1987). *See also In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("there is nothing improper in stating that, for rational reasons,

more or less weight has been given to a particular feature of the mark, provided the ultimate conclusion rests on consideration of the marks in their entireties"). In this case, the word portions of the marks (*i.e.,* L'ALPINA and ALPINA) are the dominant portions of the marks because consumers will refer to the products by the words. *Helene Curtis Industries Inc. v. Suave Shoe Corp.,* 13 USPQ2d 1618, 1621 (TTAB 1989); *In re Appetito Provisions Co., supra; Kabushiki Kaisha Hattori Tokeiten v. Scuotto,* 228 USPQ 461, 262 (TTAB 1985).

The words L'ALPINA and ALPINA are visually similar. Registrant's mark L'ALPINA incorporates applicant's entire mark ALPINA. In fact, in the Italian language, "before words beginning with a vowel *la* often becomes *l'*."[8] Thus, registrant's mark is essentially "THE ALPINA." *See In re Bonnie Keller Collections Ltd.,* 6 USPQ2d 1224, 1226-1227 (TTAB 1987) ("the only significance of 'la' [in LA LINGERIE] . . . is that it is the feminine definite article

[8] The Sansoni Dictionaries: English-Italian Italian-English, p. 1761 (3rd ed. 2002). "La" is the article "the." *Id.* "Italian nouns and adjectives are marked for gender, either masculine or feminine, and number, either singular or plural. Masculine singular nouns typically end in *–o* with the plural form ending in *–i* (*piatto/piatti* 'dish/dishes'); feminine singular nouns usually end in *–a* with plural form ending in *–e* (*casa/case* 'house/houses')." Facts About The World's Languages: An Encyclopedia of World' Major Languages, Past and Present, p. 343 (2001).

in French, preceding the feminine French noun, 'lingerie'"); *In re Le Sorbet,* 228 USPQ 27, 29 (TTAB 1985) (" the only conceivable significance of "le" in the term sought to be registered [LE SORBET] is that it is the masculine definite article in French, preceding the masculine French noun, sorbet"). To the extent that the ordinary American purchaser would not recognize L'ALPINA as meaning "the Alpina," Italian-speaking consumers in the United States would. *In re Thomas,* 79 USPQ2d 1021, 1024 (TTAB 2006) ("the ordinary American purchaser who is knowledgeable in the foreign language," will translate the mark into its English equivalent).

Applicant argued that the word portion of registrant's mark looks more like LALPINA than L'ALPINA because the apostrophe appears to be part of the design element.[9] While there is merit to applicant's argument, we see registrant's mark as L'ALPINA because the apostrophe is located exactly where the apostrophe would be expected in an Italian word. Moreover, as discussed below, the mountain design and word "Alpina" conjure up an alpine image or commercial impression rather than the fanciful term LALPINA.

L'ALPINA and ALPINA also sound alike.

[9] Applicant's Brief, p. 7.

L'ALPINA and ALPINA have the same meaning (*i.e.*, Alpine or mountain).[10] The "alpine" or "mountain" meaning of the word portion L'ALPINA of the registered mark is emphasized by the design of the mountain in registrant's mark. The fact that the word portion of the mark appears in conjunction with a drawing of a mountain should put to rest applicant's argument that the word portion is the fanciful word "Lalpina" rather than the word "L'Alpina." Accordingly, the commercial impression engendered by the marks is similar because both marks conjure up an image of alpine or mountain clothing and shoes.

Applicant also argued that "there is nothing in the record to show that LALPINA, or L'ALPINA is particularly distinctive."[11] On the other hand, applicant has made no evidence of record to show that L'ALPINA, or mountain, is descriptive of registrant's clothing. On this record, we could at most conclude that L'ALPINA is suggestive that registrant's clothing products are designed for use in the mountains. However, even if we consider the cited registered mark as a weak mark, it would still prevent the

[10] Collins Mondadori: Nuovo Dizionario Inglese, p. 22 (1995). (2001).
[11] Applicant's Brief, p. 7.

registration of a similar mark used in connection with related goods (see the discussion *infra*). Likelihood of confusion "is to be avoided, as much between 'weak' marks as between 'strong' marks." *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

The marks at issue certainly have some differences. However, we find that the word L'ALPINA is the dominant element of the registrant's mark, and that it is entitled to more weight in the likelihood of confusion analysis because that is what consumers are likely to remember. Because the dominant element of the registered mark is similar in appearance, sound, and meaning with applicant's mark, and the overall commercial impression of both marks is similar, we conclude that the marks in their entireties are more similar than dissimilar.

B. <u>The similarity or dissimilarity and nature of the goods</u>.

It is well settled that the goods of the applicant and the registrant do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be

encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The goods in the cited registration are "men's and women's cardigans, pullovers, shirts, caps, berets, gloves, socks, stockings, underwear, stretch suits and scarves." The goods in the application are "footwear of all kinds, including sport shoes." "Footwear of all kinds" encompasses dress shoes and casual shoes.

In support of his argument that the registrant's clothing and applicant's footwear are related products, the Examining Attorney submitted copies of 25 third-party registrations comprising a small sample from the Trademark Office database in which the registered marks include both clothing and shoes in the description of goods.[12] Although third-party registrations are not evidence that the marks have been used in commerce, they have some probative value because they serve to suggest that the listed products may

[12] December 14, 2006 Office Action.

emanate from a single source. *In re Albert Trostel & Sons Co.*, *supra* at 1785-1786; *In re Mucky Duck Mustard Co., Inc.,* 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

In addition, we find persuasive the Examining Attorney's analysis that clothing and shoes are complementary products, derived from *In re Melville Corp.,* 18 USPQ 1386 (TTAB 1991). In that case, the Board explained why clothing, on the one hand, and shoes, on the other are complementary products.

> A woman's ensemble, which may consist of a coordinated set of pants, a blouse and a jacket, is incomplete without a pair of shoes which match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered complementary goods. They may be found in the same stores, albeit in different departments.

Id. at 1388.

Applicant argued that the evidence submitted by the Examining Attorney to prove that clothing and shoes were related products did not meet the "something more" standard required by the Court of Customs and Patent Appeals, the predecessor to our primary reviewing court, in *Jacobs v. International Multifoods Corp.,* 668 F.2d 1234, 212 USPQ 641

642 (CCPA 1982) ("to establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services"). We disagree. We find that the complementary nature of shoes and clothing combined with the third-party registrations submitted by the Examining Attorney are sufficient to establish a *prima facie* showing of relatedness, particularly because registrant's description of goods includes socks and stockings. Moreover, applicant did not rebut the showing of the Examining Attorney with countervailing evidence demonstrating that clothing and shoes are not commercially related products by submitting other registrations, a declaration from someone with knowledge, or by other means. *In re Comexa Ltda.,* 60 USPQ2d 1118, 1121 (TTAB 2001).

In view of the foregoing, we find that registrant's clothing products and applicant's footwear are complementary products.

C. The similarity or dissimilarity of established, likely-to-continue trade channels and classes of customers.

With respect to these factors, neither the Examining Attorney, nor the applicant, submitted any evidence regarding how and to whom clothing and shoes are sold. However, because there are no restrictions in the

description of goods in the application or cited registration, we may presume that registrant's clothing and applicant's footwear may be sold in the same channels of trade and to the same classes of consumers. *Hewlett-Packard Co. v. Packard Press Inc.,* 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002). In addition, shoes and clothing are commonly sold in department stores and socks and stockings are sold in shoe stores. Moreover, as we discussed in the previous section, applicant's shoes and registrant's clothing are complementary products, and therefore they can be marketed to the same classes of customers. Because the channels of trade overlap and the classes of consumers are the same, these *du Pont* likelihood of confusion factors favor a finding of likelihood of confusion.

D. The nature and extent of any actual confusion.

Applicant argued that although it has used the mark sought to be registered in commerce with the United States since at least 1995, it is not aware of any instances of confusion.[13] To support this argument, applicant submitted the declaration of Andraž Kopač, applicant's President. Mr. Kopač testified to the following facts:

[13] Applicant's Brief, p. 10.

1. Applicant's footwear has been advertised in the United States;
2. Between 1995 and 2005, applicant has sold an average of 71,379 pairs of footwear, including 50,525 pairs in 2005;
3. Applicant's sales of its ALPINA footwear in 2005 was $1,668,375, presumably wholesale because Mr. Kopač testified that retail sales would be higher.

The fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative weight because the Board has no way to know whether the registrant is likewise unaware of any instances of confusion. In addition, it is not usually possible to determine whether there has been any significant opportunity for actual confusion to have occurred. *In re Opus One Inc.,* 60 USPQ2d 1812, 1817 (TTAB 2001). However, in the case of *In re General Motors Corp.,* 23 USPQ2d 1465, 1470 (TTAB 1992), the Board identified three factors in an *ex parte* proceeding that allow it to assess the probative value of the absence of any reported instances of actual confusion: (1) a long period of marketing success; (2) marketing a major or expensive purchase; and, (3) no reported instances of confusion.

We are not persuaded that the apparent absence of actual confusion is entitled to significant weight in this case. In *General Motors,* applicant had been selling automobiles for thirty years without any reported instances of actual confusion whereas applicant herein has used its mark for only eleven years. *See In re Opus One Inc., supra* (thirteen years operating a single restaurant in Detroit was not sufficient to demonstrate national renown and prominence). In addition, we do not find applicant's sales figures especially impressive such that they demonstrate sustained marketing success. Applicant has provided no evidence to put its sales figures into perspective. Nevertheless, we believe that it is safe to say that virtually the entire population in the United States wears and purchases footwear. Thus, applicant's sales of 50,525 in 2005 would constitute a small portion of the total shoe sales in that year.

With respect to the nature of the products at issue, applicant's footwear does not constitute a major or expensive purchase. According to applicant's witness, in 2005, applicant sold 50,525 pairs of shoes in the United States generating $1,668,375. That is $33 a pair (wholesale).

Finally, despite Mr. Kopač's testimony, we still do not know whether there has been an opportunity for confusion to occur. Mr. Kopač testified that applicant has exported footwear for distribution and sale into the United States, but we do not know where in the United States the footwear has been distributed and whether registrant distributes and sells its clothing in the same geographic markets. Mr. Kopač also testified that applicant has advertised its footwear in the United States. However, we do not know in what markets applicant has advertised its products and the extent of applicant's advertising.

To the extent that *General Motors* sets forth an exception to the general rule that the absence of actual confusion is entitled to little probative value in an *ex parte* proceeding, we find that applicant does not fall within that exception.

E. <u>The market interface between applicant and registrant</u>.

Applicant argued that its ownership of three prior ALPINA registrations for hiking boots, mountaineering boots, and sports footwear presents a laches and estoppel situation attributable to the registrant. Registration No. 1307127 for the mark ALPINA, in typed drawing form, issued on November 27, 1984, and therefore has coexisted with the cited registration for twenty-three years.

Applicant is essentially asserting a prior registration defense in an *ex parte* proceeding. The prior registration defense is an affirmative defense in an *inter partes* proceeding. It provides that if an applicant owns a registration for the same or substantially identical mark for the same or substantially identical goods, the opposer cannot be damaged by the registration of applicant's current application. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969). To be successful, the prior registration defense requires that goods in the application be identical, or nearly so, to the goods in the prior registration. *Morehouse Mfg. Corp. v. J. Strickland & Co., supra* ("there is no added damage from the second registration of the same mark if the goods named in it are in fact the same"). *See also Joseph & Feiss Co. v. Sportempos, Inc.*, 451 F.2d 1402, 172 USPQ 235, 236 (CCPA 1971) ("the goods specified in applicant's registration and application are in part identical and otherwise considered substantially the same, or so related as to represent in law a distinction without a difference").

Applicant's argument is not unique. The Board faced the same issue in the case of *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). In that case, the application for ULTRA for "gasoline, motor oil, automotive grease, general

purpose grease, machine grease and gear oil" was refused registration even though applicant owned two registrations for ULTRA for "motor oil" and for "gasoline for use as automotive fuel, sold only in applicant's automotive service stations." In affirming the refusal to register, the Board adopted the requirement from the prior registration defense that applicant's prior registration must encompass the same or substantially similar goods: "[t]he Office should not be barred from examining the registrability of a mark when an applicant seeks to register it for additional goods as it does here, even when the additional goods are closely related to those listed in a prior registration." *In re Sunmarks Inc., supra* at 1472. In this case, we find that "footwear of all kinds" is substantially different from hiking boots, mountaineering boots, and sports footwear because it includes dress shoes and casual shoes, and therefore extends the goods beyond the description of goods in the previous registrations. Therefore, we are not in a position to say that there would be no likelihood of confusion by the registration of applicant's mark for these additional types of footwear despite applicant's ownership of the prior ALPINA registrations.

F. Balancing the factors.

On the one hand, applicant's mark and the mark in the cited registration are similar, they are used on related products and those products move in the same channels of trade and are sold to the same customers. On the other hand, applicant asserted that despite over twenty years of concurrent use and registration, there have been no reported instances of confusion, and applicant is the owner of three ALPINA registrations for hiking boots, mountaineering boots, and sports footwear. We readily admit that it is troublesome to refuse registration when applicant already owns registrations for similar marks for related goods. However, as discussed above, the expansion of applicant's description of goods to encompass "footwear of all kinds" removed the penumbra of protection, if any, the prior registrations may have provided applicant. With respect to applicant's argument that there have been no reported instances of actual confusion, applicant has not made a sufficiently compelling case to persuade us to forego the general rule that the absence of actual confusion in an *ex parte* proceeding is entitled to little probative value. Accordingly, we find that applicant's mark ALPINA and design, when applied to "footwear of all kinds, including sports footwear," so resembles L'ALPINA

and Design for “men’s and women’s cardigans, pullovers, shirts, caps, berets, gloves, socks, stockings, underwear, stretch suits and scarves” as to be likely to cause confusion.

Decision: The refusal to register is affirmed and registration to applicant is refused.