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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PPHU "SELF" Spółka Cywilna, Andrzej Kucharski, Pawel
Szczeniak and Kamil Kucharski

Serial No. 79023019

Jan Tamulewicz of Katten Muchin Rosenman LLP for PPHU
"SELF" Spółka Cywilna, Andrzej Kucharski, Pawel Szczeniak
and Kamil Kucharski.

W. Wendy Jun, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Hohein, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

PPHU "SELF" Spółka Cywilna, Andrzej Kucharski, Pawel
Szczeniak and Kamil Kucharski (applicant), a partnership
organized under the laws of Poland, has applied to register
the mark shown below for, among other goods and services,
"women's, men's, and children's clothing, namely swim

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suits, beachwear, swimwear and underwear" in International Class 25.¹



The application includes the following statements: (1) "The mark consists of of two concentric circles resembling a life float in the colors blue and white. In the center of the circles is a dolphin in the colors blue and white jumping over blue wavy lines, resembling water. Between the concentric circles on top is the wording SELF in the color blue. Between the concentric circles on the bottom is the wording COLLECTION in the color blue." and (2) "The color(s) blue and white is/are claimed as a feature of the mark." Applicant has also disclaimed "COLLECTION."

The Examining Attorney has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with two registrations owned by different parties:

¹Application Serial No. 79023019, filed February 27, 2006, under Trademark Act Section 66, 15 U.S.C. § 1141, based on International Registration No. 0802368. The application also covers International Classes 16, 20, 26, 35 and 40 which are not relevant here because the refusal is limited to International Class 25.

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Registration No. 1663404 for the mark shown below for "women's magazines" in International Class 16 and "T-shirts and bodyshirts" in International Class 25.² The registration issued on November 5, 1991 and has been renewed.

SELF

and

Registration No. 877048 for the mark SELF in typed form for "babies' knitted pullovers, cardigrans (sic), dresses, rompers; infants' dresses, knitted jumpers, cardigans, rompers, leggings; knitted girls' blouses; ladies' knitted shell blouses, knitted cardigans, knitted sweaters, coats, and shift dresses" in International Class 25. The registration issued on September 16, 1969 and has been renewed.

Applicant has appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

LIKELIHOOD OF CONFUSION

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion ..." 15 U.S.C. § 1052(d). In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), the Court set forth the factors

² The Class 16 goods are not relevant to the refusal at issue here. Therefore, we will not discuss those goods further.

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to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of applicant and registrants. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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."). Below we will consider each of the factors as to which applicant or the Examining Attorney presented arguments or evidence.

The Goods

The goods of applicant and the registrants need not be identical to find a likelihood of confusion under Trademark Act Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). See also *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods we must consider the goods as identified in the application and cited registrations. See *Octocom Systems, Inc. v. Houston*

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Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application [and registrations] regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Applicant addressed the relationship between its goods and the goods in the cited registrations for the first time in its reply brief. Applicant argues that its goods are not related to those in the cited registrations because "... beachwear is most often marketed seasonally, and is often physically set apart from other clothing displays." Reply Brief at unnumbered page 2. Applicant also disputes the Examining Attorney's contention that bodyshirts are a substitute for underwear or swimwear.

The Examining Attorney argues that applicant's goods are related to the goods in both cited registrations. To

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support her position, the Examining Attorney has submitted numerous third-party registrations for marks for goods of the same kinds as applicant's goods, as well as the goods identified in the two cited registrations. However, none of the third-party registrations the Examining Attorney provided for this purpose were based on use, nor have any of them matured to a point where an affidavit of use has been filed. Accordingly, these registrations are not probative of the issue before us, that is, whether the same marks are used on the types of goods at issue here. *Cf. In re TSI Brands Inc.*, 67 USPQ2d 1657, 1659 (TTAB 2002); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). Therefore, we have not relied on these registrations in our decision here. The Examining Attorney has also provided statistical information regarding the numbers of records the Examining Attorney located in searches of USPTO records where both applicant's goods and the goods in either of the cited registrations also appeared. These statistics are likewise not probative of the issue before us, and we have also not relied on this evidence in our decision here.

Nonetheless, applicant's goods are identified as "women's, men's, and children's clothing, namely swim suits, beachwear, swimwear and underwear." The relevant

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goods in the cited, special-form SELF registration are identified as "T-shirts and bodyshirts"; the goods in the cited, typed SELF registration are identified as "babies' knitted pullovers, cardigrans (sic), dresses, rompers; infants' dresses, knitted jumpers, cardigans, rompers, leggings; knitted girls' blouses; ladies' knitted shell blouses, knitted cardigans, knitted sweaters, coats, and shift dresses."

First, with regard to the cited, special-form SELF registration, we conclude that the goods in that registration overlap with applicant's goods. Applicant's goods include "underwear"; the cited registration includes "t-shirts." *The Merriam-Webster's Collegiate Dictionary* (11th ed. 2003) defines "t-shirt," in relevant part, as "... a collarless and short-sleeve or sleeveless usu. cotton undershirt..."³ Also, applicant's inclusion of both underwear and the other clothing items in its own application indicates that underwear, which encompasses t-shirts, is related to those other goods also. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). This contradicts applicant's assertion that

³ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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"beachwear" is a separate class of goods in no way associated with other types of clothing.

Also, as the Examining Attorney notes, the Board has often held various types of clothing related. See, e.g., *Jockey Intl., Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear and neckties held related); *In re Pix of America, Inc.*, 225 USPQ 691, 692 (TTAB 1985) (women's shoes and outer shirts held related) *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398 (TTAB 1982) (trousers and hosiery held related); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (ladies' pantyhose and hosiery held related to men's suits, coats and trousers). Accordingly, we conclude that applicant's goods encompass and are otherwise related to the goods identified in the cited special-form SELF registration.

Next, with regard to the cited, typed SELF registration, we also conclude that applicant's goods are related to the goods in that registration. All of applicant's goods are identified as being for men, women and children. In particular, applicant's beachwear and swimwear are related to the knitted girls' blouses, ladies' knitted shell blouses, knitted cardigans, knitted sweaters, and shift dresses identified in the cited registration. The respective items are similar items of casual clothing

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directed to the same wearers and purchasers. Similarly, applicant's items for children are related to the items in the cited registration for babies and infants simply because babies and infants are children and the respective items would thus be purchased under similar circumstances by the same potential purchasers. We do not find applicant's argument that beachwear is seasonal and sold separately persuasive. Applicant's goods are not limited to beachwear or like items; the goods also include underwear. Also, depending on the location, beachwear could be a year-round product, and the clothing identified in the cited registration could also vary by season. More importantly, applicant's goods and those identified in the cited registration are all common clothing items which would be purchased and worn by the same individuals. Again, the Board has often found such goods related. *See, e.g., Jockey Intl., Inc. v. Mallory & Church Corp.*, 25 USPQ2d at 1236 and cases cited therein.

Accordingly, we conclude that applicant's goods are related to the goods identified in the cited, typed SELF registration also.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of

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the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Also, "... it is well established that the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires us to consider the fallibility of memory over a period of time. That is to say, the emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific

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impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant argues that its mark is not similar to either of the cited marks in appearance, sound, connotation or commercial impression. Applicant argues further that the Examining Attorney failed to compare the marks in their entireties, and more specifically, that the design element is dominant in its mark and that COLLECTION is significant in distinguishing its mark from both cited marks. In particular, applicant argues that its mark differs from the cited marks in that "... Applicant's use of the word 'self' acts as a modifier of the COLLECTION portion of the mark, lending a connotation of a collection belonging to oneself." Reply Brief at unnumbered page 3.

The Examining Attorney argues that the marks are similar. The Examining Attorney also offers the same arguments with regard to both cited marks. Specifically, the Examining Attorney argues that SELF is the dominant element in applicant's mark and in both cited marks and that applicant's design and the presence of COLLECTION in its mark is insufficient to distinguish applicant's mark from either of the cited marks.

We conclude that applicant's mark is similar to both cited marks. Although there are specific differences in

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appearance and sound, we find that the similarities in appearance and especially in sound, connotation and commercial impression outweigh those differences when we consider the marks in their entireties.

The same essential analysis applies to both cited registrations. First, we disagree with applicant's assertion that the design element is dominant in its mark. While the design is prominent in appearance, it is still primarily the literal element, SELF COLLECTION, which potential purchasers will rely on to identify the source of the goods. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). In this case the common axiom regarding marks with both literal and design elements applies, that is, literal elements are more significant because purchasers use the literal elements in requesting the goods. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983).

Furthermore, we reject applicant's arguments regarding the significance of COLLECTION in its mark. It is disclaimed, but more importantly, the Examining Attorney has demonstrated, through the submission of third-party registrations, that COLLECTION is commonly used in the clothing field and other fields descriptively. It merely identifies a grouping of related apparel. For example, *The*

Merriam-Webster's Collegiate Dictionary (11th ed. 2003) defines "collection," in relevant part, as "... a set of apparel designed for sale usu. in a particular season..."⁴

Therefore, we conclude that COLLECTION, which is descriptive in this context, is insufficient to distinguish applicant's mark from either of the cited registered marks. *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1534-35.

Furthermore, in view of this evidence, we reject applicant's argument that potential purchasers will perceive SELF COLLECTION as connoting a collection belonging to oneself. It is more likely that, in this context, potential purchasers would only perceive the common descriptive meaning of COLLECTION. Applicant's display, which separates SELF from COLLECTION, reinforces this impression.

Finally, when we consider applicant's mark and the two cited registered marks in their entireties, we conclude that applicant's mark is similar to both cited, registered marks.

⁴ *Id.*

Strength of the Cited Marks

In an attempt to show that SELF is diluted, and therefore weak, in the clothing field, applicant has submitted copies of the following Class 25 registrations:

Registration No. 0526196 for the mark "SELF-CONFORMING" in special form for "men's hats";

Registration No. 1663485 for the mark SELF HELP in typed form for "women's swimsuits";

Registration No. 1771562 for the mark SELF-EXPRESSION in typed form for "bras and panties";

Registration No. 2578967 for the mark OUTER SELF in typed form for "clothing, namely, vests, jackets, parkas, pants, Nordic and Alpine ski suits; accessories, namely, hats, gloves, mittens, scarves, neck gaiters, face masks and socks";

Registration No. 2311586 for the mark SELF ESTEEM in typed form for "clothing, namely jackets, sweaters, vests, blouses, shirts, tops, pants, shorts and skirts";

Registration No. 2736826 for the mark INNER SELF in typed form for "clothing, namely bras, panties, slips, girdles, lingerie; sleepwear and loungewear"; and

Registration No. 2600111 for the mark BU SELF in typed form for "clothing, namely t-shirts, caps and sweatshirts."

We find applicant's arguments, in this regard, unpersuasive. In the case of each of the marks in the registrations applicant submitted, "SELF" is combined with another term to create a phrase which has a distinctive meaning. The phrase, in each instance, is more than the

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sum of its parts; it has a known meaning which creates a distinctive commercial impression. In contrast, the addition of the descriptive, disclaimed term COLLECTION in applicant's mark does nothing to distinguish its mark from the cited, registered marks.

Also, in this case, the marks in these registrations do not demonstrate that "SELF" has a consistent descriptive or highly suggestive meaning in relation to the goods such that relevant purchasers would rely on other elements in the marks to distinguish the source of the goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991). Furthermore, there is no significant additional literal element present which would effectively distinguish applicant's mark from either of the cited, registered marks. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005). Accordingly, we conclude, on this record, that both cited registered marks are entitled to the ordinary scope of protection accorded registered marks.

Applicant has also argued that the coexistence of the two prior registrations cited here indicates that there would not be a likelihood of confusion between applicant's mark and either of the cited marks. However, we must decide each case on the record before us; decisions on

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prior applications do not dictate a particular decision here. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

CONCLUSION

Finally, based on all evidence of record in this case related to the *du Pont* factors, we conclude that there is a likelihood of confusion between applicant's SELF COLLECTION and Design mark when used in connection with "women's, men's, and children's clothing, namely swim suits, beachwear, swimwear and underwear" and the cited, special-form SELF mark when used in connection with "T-shirts and bodyshirts" and the cited, typed SELF mark when used in connection with "babies' knitted pullovers, cardigrans (sic), dresses, rompers; infants' dresses, knitted jumpers, cardigans, rompers, leggings; knitted girls' blouses; ladies' knitted shell blouses, knitted cardigans, knitted sweaters, coats, and shift dresses."

Decision: We affirm the refusal to register applicant's mark in Class 25 under Trademark Act Section 2(d) based on both cited registrations.