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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Master Italia SpA

Serial No. 79028103

Stewart L. Gitler of Hoffman, Wasson & Gitler, P.C. for Master Italia SpA.

Daniel Brody, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Master Italia SpA to register the mark **ATLANTIS** (in standard character form) for goods ultimately identified as "fashion headwear, namely hats, head wraps, visors, caps, bandanas, berets, scarves and gloves, none of which are for use as protective gear in marine and leisure

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sports nor sold in souvenir novelty shops adjacent to departure points of submarine sightseeing excursions" in Class 25.¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the registered mark shown below for "protective clothing for marine and leisure sports-namely, rainwear, pants, jackets, hats, shirts and sweaters" (in Class 25), as to be likely to cause confusion.²



When the refusal was made final, applicant appealed. Briefs have been filed.

¹ Serial No. 79028103, filed on May 30, 2006 under 66(a) of the Trademark Act. It is unclear how "gloves" fit into the category of "fashion headwear," but that is not an issue before us and we accept the identification of goods as written.

² Registration No. 1212225, issued October 12, 1982; renewed. The registration includes three additional classes of goods. However, registration has been refused solely on the basis of Class 25. The identification of goods in the application was amended to include the "novelty shop" restriction in response to the examining attorney's citation of two additional registrations, owned by the same entity: Reg. No. 1913234 for the mark ATLANTIS SUBMARINES (and design) and Reg. No. 1919223 for the mark ATLANTIS, both for "souvenir clothing; namely, men's, women's and children's t-shirts, hats, and visors sold in souvenir novelty shops adjacent to departure points of applicant's submarine sightseeing excursions." The refusals as to these registrations were subsequently withdrawn.

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. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the marks in their entireties in terms of sound, appearance, meaning and commercial impression. The two marks are identical in sound, both consisting of the identical word, ATLANTIS. Similarity in sound alone has been held sufficient to support a finding of likelihood of confusion. See Krim-Ko Corp. v. Coca-Cola Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968). In addition, these marks are identical in meaning, and they create virtually identical commercial impressions.

The only difference in the two marks is the stylized display of the word ATLANTIS in registrant's mark. However, this difference is not sufficient to distinguish one mark from the other as the stylization is not so distinctive that it affects the commercial impression created by registrant's ATLANTIS mark in any significant way. It is the word ATLANTIS itself, rather

than the particular display of the word, that is more likely to have a greater impact on purchasers and be remembered by them.

In addition, because applicant is seeking registration of the mark in standard character form, we must consider all reasonable manners in which applicant could depict its mark. See *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000) (typed drawings are not limited to any particular rendition of the mark). We recognize that a standard character drawing for ATLANTIS only affords protection for all reasonable manners of presentation, not all possible forms no matter how extensively stylized. Nevertheless, applicant could reasonably depict its mark in a wide variety of typefaces or fonts, including a display very similar to the stylized display of registrant's mark, thereby increasing the visual similarity of the two marks.

Applicant does not dispute that the marks are similar. It is applicant's contention that registrant's mark is not entitled to a broad scope of protection. In particular, applicant argues, without support, that there are nearly a hundred registrations incorporating the term ATLANTIS "covering almost all International classes that coexist on the register." Brief at 4. Applicant also argues that "numerous" third-party registrations that include or contain the term ATLANTIS for goods in Class 25

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coexist on the register. Applicant has submitted printouts of four such registrations:³ Reg. No. 2386713 for the mark JOURNEY TO ATLANTIS for "clothing, namely shirts, jackets and headwear"; Reg. No. 2205435 for the mark ATLANTIS RISING for "clothing, namely, caps and shirts"; and two registrations owned by the same entity, Reg. No. 1913234 for the mark ATLANTIS SUBMARINES (and design) and Reg. No. 1919223 for the mark ATLANTIS, both for "souvenir clothing; namely, men's, women's and children's t-shirts, hats, and visors sold in souvenir novelty shops adjacent to departure points of applicant's submarine sightseeing excursions."

To begin with, the factor to be considered in determining likelihood of confusion under *du Pont* is the number and nature of similar marks "in use on similar goods" (emphasis added). See *du Pont*, supra at 567. The alleged existence of numerous registrations for ATLANTIS for dissimilar goods, even if true, is irrelevant to the question of whether the marks applied to the goods involved herein are likely to cause confusion. Nor does it matter that similar third-party marks "coexist on the register." The relevant consideration is whether the marks are in use in commerce, and third-party registrations are not evidence of use

³ Applicant relies on two additional third-party registrations. However, one registration (Reg. No. 2364819) has been cancelled and is of no probative value; and the other registration (Reg. No. 3037461) is for services in an unrelated field.

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of the marks therein. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973).

Third-party registrations may, however, may be used to indicate that a commonly registered term has a suggestive meaning for particular goods or services such that differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). Considering the third-party registrations for that purpose, the evidence is still not persuasive. The existence of four third-party registrations, two of which are owned by the same entity, is insufficient to show that the term "Atlantis" has been frequently adopted and registered as a trademark or part of a trademark for goods related to those in the cited registration. Furthermore, the marks in this case consist solely or substantially of the word ATLANTIS. There is no other matter to distinguish them.

Also unpersuasive is applicant's argument that the cited registration "has not reached any level of distinctiveness to be afforded a broad scope of protection." Brief at 3. The cited mark is registered on the Principal Register and is entitled to a presumption of distinctiveness. Applicant has presented no evidence that ATLANTIS is commonly used or highly suggestive of

the goods, or any other evidence that the mark is weak and entitled to only a limited scope of protection.

In fact, the mark by its nature is relatively strong. We take judicial notice of the definition of "Atlantis" from The American Heritage Dictionary of the English Language (Fourth Edition 2000) as meaning "*Mythology* A legendary island in the Atlantic Ocean west of Gibraltar, said by Plato to have sunk beneath the sea during an earthquake."⁴ The term appears to be essentially arbitrary for the goods, with at most some vague suggestive meaning as to registrant's clothing for "marine" activities. This makes it even more likely that the marks, if used on related goods, would cause confusion. See *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

We turn then to the goods. Applicant's goods are identified as "fashion headwear, namely hats, head wraps, visors, caps, bandanas, berets, scarves and gloves, none of which are for use as protective gear in marine and leisure sports nor sold in souvenir novelty shops adjacent to departure points of submarine sightseeing excursions." Registrant's goods are defined as "protective clothing for marine and leisure sports-namely, rainwear, pants, jackets, hats, shirts and sweaters." The goods

⁴ From the website www.bartleby.com. The Board may take judicial notice of dictionaries, including online dictionaries, which exist in printed format. See, e.g., *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); and *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

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are in part identical and/or legally identical ("hats" and "caps") and otherwise closely related clothing items. We note that the examining attorney has submitted a number of use-based, third-party registrations covering, in each instance, items listed in both the application and the cited registration. For example, Reg. No. 2381885 for the mark PURE DIRT lists headwear, as well as shirts and pants; Reg. No. 3143399 for the mark DEAN MILLER lists gloves and "headwear, namely, visors, hats...bandanas," as well as shirts, pants, jackets and sweaters; and Reg. No. 3095220 for the mark THE LAZY TURTLE (and design) lists caps, scarves, gloves and hats," as well as shirts, jackets, sweaters and pants. These third-party registrations, although not evidence of use of the marks in commerce, serve to suggest that the respective goods are of a type which may emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The examining attorney has also submitted printouts from various retail websites showing that the respective items of apparel in fact emanate from the same source. For example, www.aeropostale.com sells both caps and jackets under the AEROPOSTALE mark; www.bercrombie.com sells caps, as well as shirts and jackets under the AMBERCROMBIE & FITCH or A. FITCH

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marks; and www.polo.com sells both caps, as well as sweaters and shirts under the POLO RALPH LAUREN mark.

Applicant maintains that its identification of goods, which is "fashion headwear" excluding headwear used as "protective gear" used in leisure sports, "expressly distinguishes" its goods from those in the cited registration, and that "protective clothing" for marine and leisure sports "is not the same as 'fashion headwear.'" Brief at 4.

Contrary to applicant's contention, the limitations do not serve to distinguish the goods. First, applicant cannot effectively exclude "protective" headwear from its identification of goods because headwear, such as hats, caps, visors and scarves, by its nature performs a protective function. The examining attorney has submitted a dictionary listing from www.askoxford.com defining "visor" as "a stiff peak at the front of a cap" and "a screen for **protecting** the eyes from unwanted light"; and a listing from www.encarta.msn.com defining "cap" as "hat: a covering for the head, usually soft and close fitting and **often with a visor** and no brim" and as "**protective** covering for hair." (Emphasis added.) Further, applicant's exclusion of headwear for leisure sports is an unnatural restriction. We must assume that consumers will use applicant's headwear for all the usual purposes, and that would include use for engaging in leisure sports activities such as walking, or playing golf or

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tennis. There is nothing inherent in the goods, as described, which would make applicant's headwear unfit or unsuitable for this purpose.

Further, the term "fashion" simply refers to the latest style of clothing. We take judicial notice of the definition of "fashion" as "Something, such as a garment, that is in the current mode: *a swimsuit that is the latest fashion.*" The American Heritage Dictionary of the English Language (Fourth Edition 2000). The term does not limit the use of applicant's headwear. We also take judicial notice of the definition of "hat" in Microsoft Encarta College Dictionary at 656 (2001) as "a covering for the head, worn for **protection** from the weather or as a **fashion accessory.**" Similarly, a listing from www.infoplease.com defines "scarf" as "a long, broad strip of wool, silk, lace, or other material worn about the neck, shoulders, or head, **for ornament or protection** against cold, drafts, etc." It is clear that the same "headwear" including applicant's hats and scarves, can be both stylish as well as functional.

Indeed, applicant's website (www.masteritaliasrl.com), which contains photographs of golf courses and sailboats and a description of applicant's ATLANTIS products, shows that applicant touts its own "fashion" headwear as both stylish and functional. The following are just a few examples:

...Atlantis has risen throughout the years, conceptually inspired by the world of sport, to become a leader in its own right... . The brand, like sportswear, has become a must have item for the day-to-day urban wardrobe - **a combination of functionality and style... .**

...on a setting for street culture with its diverse influences of sport, urban and youth couture. Atlantis stands "here" **a fashion and sports label** in its own right... .

Functional, high performance, light-weightness are the aims of this brand. The spirit is definitely **sportive but the hats also very hip.**

Our collections are in many ways fairly unpretentions [sic], in that, they bridge the gap between the **sporting world and that of high street trends.**

In addition, the examining attorney has introduced evidence showing that other companies also sell "fashion" headwear for use in leisure sports activities. For example, the website of RALPH LAUREN (www.polo.com) sells a "driving cap," "golf sport cap," "tennis sport cap," "tennis sport visor," and "golf sport visor," as well as "golf shirts" and "tennis jackets," all imprinted with the company's various "fashion" marks and logos; and the BURBERRY website (www.burberryusaonline.com) sells "baseball caps" and "golf" wear under the BURBERRY mark.

Purchasers would naturally assume, if they encounter applicant's and registrant's identical hats and caps, and their other closely related apparel items under the near identical ATLANTIS marks, that such products come from or are associated with the same company.

Because the goods are in part identical and otherwise closely related, and given the absence of legally effective restrictions in the application, we must presume that the respective goods are sold in the same channels of trade, including all the usual retail outlets, with the narrow exception of "souvenir novelty shops adjacent to departure points of submarine sightseeing excursions." See, e.g., *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002). The third-party websites mentioned above, as well the additional examples of retail websites in the record such as www.gap.com, www.abercrombie.com, www.guess.com, and www.benetton.com, all show that so-called "fashion" headwear and other items of apparel that can be used in leisure sports are in fact advertised and sold together on the same online catalogs.

Furthermore, we must also presume that the purchasers for these identical and closely related goods are the same, or at least overlap to the extent that they both will be sold to ordinary consumers who engage in leisure sports. Again, applicant's attempt to exclude those who engage in leisure sports from the group of potential purchasers for its "fashion headwear" must fail.

Applicant's argument that purchasers of "fashion headwear" and "protective clothing" for use in leisure sports are "sophisticated and well educated" is unsupported and

unpersuasive. Applicant and registrant are both providing ordinary items of wearing apparel, notwithstanding that this apparel may also be used as protection from the elements when walking, playing golf or engaging in other leisure sports. We have no evidence that purchasers would exercise anything other than ordinary care in selecting such products. In any event, even sophisticated or careful purchasers would be confused as to source where, as here, nearly identical marks are used on identical goods. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible.").⁵

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

⁵ It is clear from the above discussion, that this case is readily distinguishable from *In re W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007) on which applicant relies. Unlike the facts of *Henry*, the present case involves nearly identical, essentially arbitrary marks, as well as identical goods, trade channels and purchasers.