

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Nautica Apparel, Inc.  
v.  
Brian Carlucci

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Opposition No. 91165909  
to application Serial No. 75695360  
filed on May 25, 1999

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Stephen L. Baker of Baker and Rannells, PA for Nautica  
Apparel, Inc.

Lori M. Stockton of Blakely, Sokoloff, Taylor & Zafman, LLP  
for Brian Carlucci.

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Before Hairston, Bucher and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On May 29, 1999, Brian Carlucci filed an intent-to-use  
application (Serial No. 75695360) to register the mark  
NAUTIGIRL, in standard character format, for goods  
ultimately identified as follows:

Spectacles and their parts and accessories, namely  
replacement eyeglass lenses, eyeglass frames, eyeglass  
earstems, eyeglass nose pieces and foam strips;  
sunglasses; eyeglass and sunglass cases specially  
adapted for protective and/or anti-glare eyewear and  
parts therefore; protective or safety helmets for  
skiing, snowboarding, and bicycling; diving suits and  
diving gloves, in class 9; and,

Wet suits for water skiing, sailing, windsurfing, surfing, kayaking, canoeing, and personal watercrafting, jogging suits for triathlons, water resistant jackets and pants for water skiing, sailing, windsurfing, surfing, kayaking, canoeing, and personal watercrafting, thermal underwear, water sport boots, gloves, water sport headwear, namely caps and hoods; men's, women's and children's clothing, namely hats, baseball caps, visors, t-shirts, pajamas, bathing suits, sweatshirts, sweat pants, tank tops, gaiters, shorts, pants, jackets, dresses, sweaters, gloves, belts for clothing, shoes, athletic shoes, sandals, boots, beach footwear, and ski and snowboard clothing, namely ski pants, ski jackets, ski bibs, ski gloves and ski masks, in Class 25.

Nautica Apparel, Inc. opposed the registration of applicant's mark on the grounds of priority of use and likelihood of confusion and dilution. Opposer claimed ownership of thirty-seven (37) federally-registered trademarks for NAUTICA or variations thereof. The most relevant registrations are set forth below:

1. Registration No. 1464663 for the mark NAUTICA, in standard character format, for "hosiery, shoes, undershirts, undershorts, shirts, blouses, trousers, jackets, pants, coats, suits, bathing suits, bathrobes, slippers and shorts," in Class 25;<sup>1</sup>

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<sup>1</sup> Registration No. 1464663, issued November 10, 1987; Sections 8 and 15 declarations accepted and acknowledged. Opposer included a statement in its registration that the English translation of the word "Nautica" is "nautical." On February 20, 2007, opposer amended the drawing of the mark to standard character form from a lower case block letter form. The original display of opposer's mark is identical to the display in Registration No. 1553539 *infra*. The original lower case block format display of opposer's mark is not so distinctive as to be a factor in our decision.

2. Registration No. 1553539 for the mark NAUTICA, shown below, for "spectacles, namely eyeglasses and sunglasses, and accessories, namely cases and straps," in Class 9;<sup>2</sup> and,

nautica

3. Registration No. 3168753 for the mark NAUTICAKIDS, in standard character format, for "coats; dresses; footwear; gloves; headwear; jackets; jeans; pajamas; pants' raincoats; robes; scarves; shirts; shorts; skirts; sweaters; swimsuits; t-shirts; trousers; underwear; vests," in Class 25.<sup>3</sup>

Although not pleaded in the Notice of opposition, during the prosecution of the opposition, opposer also claimed prior use of the mark NAUTICA GIRL on girls' clothing.

#### Evidentiary Issues

##### A. Opposer's "Family" of "Nautica" Marks.

In its brief, opposer asserts for the first time that it has a family of marks:

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<sup>2</sup> Registration No. 1553539, issued August 29, 1989; Sections 8 and 15 declarations accepted and acknowledged. Opposer included a translation statement that "Nautica" means "nautical."

<sup>3</sup> Registration No. 3168753, issued November 7, 2006.

Considering the parties' respective marks in their entirety, NAUTIGIRL is practically indistinguishable in look, sound, meaning, and/or commercial impression from Nautica's NAUTICA GIRLS mark and is similar to all of opposer's NAUTICA Family of Marks, especially on goods directed to women or girls. Applicant's mark leaves the impression of a "Nautica" line of clothing and eyewear targeted to women/girls.<sup>4</sup>

The Court of Appeals for the Federal Circuit has defined a family of trademarks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. . . . Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

In order to create the requisite recognition of the common element of the marks or "family surname," the common element must be so extensively advertised that the public recognizes the "family surname" as a trademark. *Reynolds &*

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<sup>4</sup> Applicant's Brief, p. 11.

*Reynolds Co. v. I.E. Systems, Inc.*, 5 USPQ2d 149, 1751 (TTAB 1987). The Board has made the following requirements:

In order to establish a "family of marks," it must be demonstrated that the marks asserted to comprise its "family" or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

*American Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978). In the absence of direct testimony by purchasers, we must place ourselves in the position of average consumers and attempt to understand their reaction to the marks as they are encountered in the marketplace.

*Id.* In this regard, the mere fact that opposer has registered many of the purported "family" members is not sufficient to prove that a family of marks exists.

*Consolidated Foods Corp. v. Sherwood Industries, Inc.*, 177 USPQ 279, 282 (1973) ("the registrations, per se, are manifestly incompetent to establish the extent of use of the registered marks, whether one or more of the registered marks have been promoted, advertised, used or displayed in any manner likely to cause an association or 'family' of marks, or that, at the least, a good number of the registrations have become known or familiar of frozen confections and the like").

Opposer's evidence fails to establish that opposer has created a family of "Nautica" marks. First, the evidence does not show that the different "Nautica" marks have been promoted, advertised, used or displayed together in any manner likely to cause an association among the marks or that there is a "family" of marks. Second, the record is silent as to the extent of any advertising of the different marks. Therefore, the record in this case falls short of presenting the type of evidence necessary to support an allegation of a "family" of "Nautica" trademarks. Accordingly, opposers' claim of likelihood of confusion must be based solely on its use of its individual "Nautica" trademarks.

B. Opposer's Objections to Applicant's Notices of Reliance.

1. Applicant's second notice of reliance.

Applicant filed a notice of reliance on printouts of articles retrieved from the LexisNexis database that reference Nautilus, Inc. According to applicant, "Each of the excerpts are relevant to the continued use of the mark NAUTILUS, to the weakness and dilution of Opposer's mark, to the differences in the parties' respective marks, the fact that opposer does not own the exclusive right to all uses of marks containing the prefix 'NAUTI,' and other Dupont factors." Opposer objected to the LexisNexis articles

referencing Nautilus, Inc. to show use of the NAUTILUS trademark as constituting hearsay.

The newspaper articles are admissible and probative only for what they show on their face, not for the truth of the matters contained therein. TBMP §704.08 (2<sup>nd</sup> ed. rev. 2004).

While excerpts from newspapers are properly made of record by notice of reliance, such excerpts do not establish the truth of the statements contained therein. Rather, newspaper excerpts, considered in the context of the record and the issues in this case, are evidence only of the manner in which the term is used therein and of the fact that the public has been exposed to the articles and may be aware of the information contained therein.

*Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.52 (TTAB 1999). See also *Otis Elevator Co. v. Echlin Mfg. Co.*, 187 USPQ 310, 312 n.4 (TTAB 1975) (newspaper articles are admissible to show that opposer's mark was the subject of an article that appeared in newspapers and magazines); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (newspaper articles introduced by a notice of reliance are admissible to show that the articles appeared in the respective newspapers or magazines, on a specific date, and referenced applicant or its mark). Accordingly, we have considered the articles in applicant's second notice of reliance only for establishing that Nautilus, Inc. or the NAUTILUS trademark was referenced in an article, the manner

in which it was used, and that the public may have been exposed to the terms and, therefore, may be aware of the information in the articles.<sup>5</sup>

2. Applicant's third and fourth notices of reliance.

Applicant filed notices of reliance on printouts of news articles retrieved from the LexisNexis database that reference the term "nautical clothing." According to applicant, "Each of the excerpts are relevant as to the generic nature of Opposer's marks, to the weakness of Opposer's marks, to the differences in the parties' respective marks, and other Dupont factors." Opposer objects to these notices of reliance to the extent that applicant is attacking the validity of its registrations on the ground that NAUTICA is generic for a type of clothing without having filed counterclaims for cancellation.

To the extent that applicant is asserting that "Nautica" means "nautical clothing," and is therefore a generic term, such an attack is impermissible in the absence of counterclaims to cancel opposer's pleaded registrations. However, it is clear that applicant is not attempting to attack opposer's registrations. Thus, we regard applicant's arguments as going only to the scope of protection to be accorded opposer's NAUTICA trademarks in terms of

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<sup>5</sup> The same holds true for the articles referencing the NAUTICA trademark that opposer introduced through its notices of reliance.

determining whether there is a likelihood of confusion between the marks NAUTICA and NAUTIGIRL when applied to their respective goods.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. The testimony deposition of Margaret Bizarri, the trademark manager of the legal department of VF Sportswear, Inc., the parent company of opposer, with attached exhibits;

2. Notices of reliance on certified copies of opposer's pleaded registrations for the mark NAUTICA and variations thereof for clothing, spectacles, and other goods and services showing that the title to the registrations is in opposer's name and that the registrations are subsisting;

3. Notices of reliance on articles from publications retrieved from the LexisNexis database referencing opposer and its NAUTICA trademarks; and,

4. Notice of reliance on printouts from the TTABVUE database to show that opposer filed petitions to cancel Registration No. 1641348 for the mark FASHION NAUTIQUE

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(Cancellation No. 92046670) and Registration No. 1478791 for the mark SKI NAUTIQUE (Cancellation No. 92046665).

B. Applicant's evidence.

1. Notice of reliance on certified copies showing status and title of ten (10) third-party registrations for marks beginning with "Nauti" in Class 25 and one third-party registration for a mark beginning with "Naut" in Classes 9 and 25;

2. Notice of reliance on printouts of articles retrieved from the LexisNexis database that reference Nautilus, Inc.; and,

3. Notices of reliance on printouts of news articles retrieved from the LexisNexis database that reference the term "nautical clothing."

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

However, with respect to opposer's claim of prior use of the mark NAUTICA GIRL for girls' clothing, because opposer does not own a registration for that mark, opposer must prove its first use of NAUTICA GIRL. For purposes of establishing priority, opposer must show that it used its NAUTICA GIRL trademark prior to May 25, 1999, the filing date of applicant's application. In an opposition, applicant may rely on the filing date of his application. *Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Intersat Corp. v. Int'l Telecomm Satellite Org.*, 226 USPQ 154, 156 n.5 (TTAB 1985).

Opposer based its claim of prior use solely on the testimony of Margaret Bizarri, opposer's trademark paralegal. Ms. Bizarri testified that opposer had been using NAUTICA GIRL on clothing since July 1994.<sup>6</sup> However, Ms. Bizarri is not involved in the marketing or sales of opposer's products. Ms. Bizarri is responsible for trademark application filings, searches, post registration filings, and reviewing sponsorship agreements, licenses,

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<sup>6</sup> Bizarri Dep., p. 28.

color boards, and advertising.<sup>7</sup> Moreover, because Ms. Bizarri started working for opposer in March 2001,<sup>8</sup> her testimony regarding opposer's first use of the mark NAUTICA GIRL is not based on first-hand knowledge, but upon a review of company records. In that regard, Ms. Bizarri testified that she maintains copies of all the advertisements and all the color boards from opposer's inception to the present.<sup>9</sup> In preparing for her deposition, she reviewed the color boards from 1991 through the present and compiled a representative sample to introduce into evidence.<sup>10</sup> Despite the facts that color boards are created seasonally and that she reviewed all of the color boards and compiled a representative sample in preparation for her deposition, she was unable to document any use of the mark NAUTICA GIRL prior to 2005.<sup>11</sup>

Q. And in any documents that you reviewed and presented here today,

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<sup>7</sup> Bizzari Dep., p. 7.

<sup>8</sup> Bizarri Dep., p. 6.

<sup>9</sup> Bizarri Dep., pp. 9-10. Ms. Bizarri explained that color boards are presented to the buyers to show the products. (Bizarri Dep., p. 34). Applicant's counsel characterized the color boards as "wholesale catalogues. (Bizarri Dep. P. 33). Based on the preceding exchange at the deposition and a review of Exhibits 2 and 5, it appears as though color boards are presentation boards that opposer uses to present its products to its distributors (*i.e.*, the retail stores that sell NAUTICA clothing and eyewear). The color boards display samples, photographs or renderings of the products. Ms. Bizarri testified that the color boards are created seasonally. (Bizarri Dep., p. 30).

<sup>10</sup> Bizarri Dep., p. 12.

<sup>11</sup> Bizarri Dep., pp. 29-30; Exhibit 5.

do any of those demonstrate that the mark [NAUTICA GIRL] was being used back as early as July of 1994?

A. No.<sup>12</sup>

Moreover, Ms. Bizarri could not confirm that opposer had continuously used the mark NAUTICA GIRL.

Q. Did your company ever stop using Nautica Girl at any point for any period of time after July of 1994?

A. I don't know the answer to that.<sup>13</sup>

Nor could she provide the revenues relating to sales of NAUTICA GIRL products.

Q. Are you aware of your company's sales volume of products bearing the Nautica Girl term?

A. No. I don't - - if you mean individually, no.

Q. With respect to products bearing that term.

A. No.<sup>14</sup>

In view of the foregoing, we are not persuaded that opposer has made either prior or continuous use of NAUTICA GIRL. Accordingly, opposer's claim of likelihood of

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<sup>12</sup> Bizarri Dep., pp. 28-29.

<sup>13</sup> Bizarri Dep., p. 29. See also p. 30.

<sup>14</sup> Bizarri Dep., p. 30.

confusion must be based solely on its NAUTICA trademark registrations.

### Likelihood Of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Lanham Act is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

#### A. Fame

We turn first to the factor of fame, because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* Indeed, "[a] strong mark . . . casts a long shadow which competitors must avoid." *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose Corp. v. QSC Audio Products Inc.*, *supra*.

We note that fame for likelihood of confusion purposes and for dilution are not the same, and that fame for dilution purposes requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, *supra*; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame "varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition - sufficient fame for dilution either exists or does not exist. *Id.* See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of confusion "Fame is relative . . . not absolute"). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for

dilution fame. *Toro Co. v. ToroHead Inc.*, *supra*, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1<sup>st</sup> Cir. 1998) (“[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection”). In order to help keep the concepts of likelihood of confusion fame and dilution fame distinct, we will refer to “public recognition and renown” when referring to likelihood of confusion fame. *Toro Co. v. ToroHead Inc.*, *supra*.

The evidence of public recognition and renown consists of the following testimony and evidence:

1. Opposer began using its NAUTICA trademark for clothing in 1983;<sup>15</sup>
2. Opposer began using its NAUTICA trademark for eyeglasses in 1987;<sup>16</sup>
3. Opposer advertises its products through sponsorship agreements, television advertising, billboards, store fliers, company mailers, and through the Internet;<sup>17</sup>
4. Opposer has sponsored numerous and varied events, including triathlons, volleyball tournaments, and sailing events. At these events, opposer displays the NAUTICA

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<sup>15</sup> Bizarri Dep., pp. 10, 17-18.

<sup>16</sup> Bizarri Dep., p. 18.

<sup>17</sup> Bizarri Dep., p. 18.

trademark on signage at the events on tents, flags, uniforms, and equipment;<sup>18</sup>

5. Between 2000-2005, opposer averaged \$28 to \$29 million annually in advertising and promotional expenses in the United States;<sup>19</sup>

6. Between 2000-2005, opposer's annual wholesale sales in the United States averaged approximately \$1 billion;<sup>20</sup>

7. Opposer sells its products through retail stores such as Lord & Taylor, Macys, and Bloomingdales and through the Internet by Amazon.com;<sup>21</sup>

8. Opposer licenses retailers such as Linens-N-Things and Bed, Bath & Beyond to sell NAUTICA products;<sup>22</sup>

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<sup>18</sup> Bizarri Dep., pp. 19-20.

<sup>19</sup> Bizarri Dep., pp. 21-22; Exhibit 7. We have some concern regarding the source of opposer's advertising expenses in the United States. Ms. Bizarri testified that she compiled the advertising and revenues from annual reports, other financial records, and discussions with personnel from accounting. (Bizarri Dep., pp. 38, 40-45, 47). Exhibit 7 is a summary of the revenues and advertising expenses. The advertising expenses are set forth in terms of worldwide advertising. Nevertheless, Ms. Bizarri testified as to advertising expenses in the United States without any explanation how she derived those figures. However, we accept Ms. Bizzari's testimony regarding advertising expenses in the United States because opposer has substantial sales that indicate that there has been substantial advertising, and there is no reason to doubt Ms. Bizzari's veracity.

<sup>20</sup> Bizarri Dep., p. 21-22; Exhibit 7. Ms. Bizarri testified that the average sales in the United States were \$800 million. However, the data on which Ms. Bizarri relied indicates that the average sales were actually \$1 billion. Ms. Bizarri also testified that retail sales should be approximately double the wholesale sales, or in this case \$2 billion. (Bizarri Dep., p. 22)

<sup>21</sup> Bizarri Dep., p. 16.

<sup>22</sup> Bizarri Dep., p. 16.

9. Opposer has between 135-140 freestanding NAUTICA retail stores in the United States, and eight (8) NAUTICA KIDS retail stores in the United States;<sup>23</sup>

10. Opposer has received substantial media attention referencing the NAUTICA trademark. A sampling of the articles referencing opposer include the following:

Repp Premier Big & Tall, a new chain of stores across the country, features lines from top American designers, such as Ralph Lauren and Nautica's David Chu, who've discovered big and tall guys have money, too.

*The Boston Herald* (December 9, 1999).

Fortunately for OP [Ocean Pacific] and other image-based brands, Baker says, "the major power brands - - Tommy, Ralph and Nautica - - have begun to give licensing a whole new arena to play in because it's become for them a new opportunity for brand extension and revenue growth."

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"Our goal as a branded company is to run the business like these power brands [Tommy, Ralph and Nautica] are run, by controlling the marketing, advertising, design and branding for the licensee," reveals Baker.

*Children's Business* (August 1, 1999).

David Chu hasn't reached the single-name recognition of a Ralph, Calvin or Tommy. But the designer behind the mega-successful and popular Nautica line continues to impress onlookers.

*Columbus Dispatch* (February 16, 1999).

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<sup>23</sup> Bizarri Dep., p. 17.

For today's teen-ager (sic), style means never wearing anything that looks like it fits just right or like something your parents or older sibling might have worn. "In" are oversized fleece pullovers, nylon windbreakers in black or some flashy color, and anything with the words Nike, Polo, Nautica, Structure or Tommy Hilfiger emblazoned on it."

*Portland Press Herald* (March 22, 1999).

"This is an ultra-modern Belk store," said store manager, Kenneth Jarman, listing famous names such as Nautica and Chaps, Tommy Hilfiger, Liz Claiborne and Jantzen.

*The Virginian-Pilot* (June 21, 1998).

Meanwhile, at NationsBanc Montgomery Securities, Susan B. Silverstein has been touting what she calls "Men's Wear's Triple Crown": Tommy Hilfiger, Nautica Enterprises and Polo Ralph Lauren. The trio's consistently good-looking product backed by strong advertising has driven sell-throughs at a high rate, she said, thus allowing them to maintain beefy margins.

*WWD* (May 14, 1998).

Top companies such as Polo Nautica, Tommy Hilfiger and Polo Ralph Lauren will continue to shine, providing the cachet of well-known brands combined with quality merchandise, according to the Street.

*Daily News Record* (August 29, 1997).

Millershor, whose dresses sell for between \$200 and \$350, is angling to open in-store boutiques throughout its network of more than 2,000 department store locations. This merchandising technique-made famous by powerful sportswear brands such as Nautica, Tommy Hilfiger and Donna Karan - is

practically unheard of in the dress business.

*Crain's New York Business* (May 5, 1997).

The turnaround has been accomplished by shutting down low-profit departments such as home electronics, stocking individual stores with merchandise that reflects local community tastes and playing up megabrands such as Ralph Lauren and Nautica as well as The Bon's own private labels.

*The Seattle Times* (March 13, 1997).

Tony Baptista, 17, of Boston stressed the importance of labels when it comes to donning the best duds.

"Strictly Nikes, Nautica shirts, Levis or Ralph Lauren jeans," he said. "And a leather coat. You gotta get the letha."

*The Boston Herald* (September 8, 1996).

Consistent with the task at hand, the inaugural issue achieved its most striking effects with the advertising, 175 pages of stylish photographs representing all the great and glorious names in the retail merchants' Hall of Fame, not only Armani and Ferragamo but also Tommy Hilfiger, Clinique, Ralph Lauren, Versace, Piaget, Nautica, Valentino, and Donna Karan - the immortals bringing the gifts of the Magi to a cradle of democracy.

*Harper's Magazine* (November 1995).

On a recent visit, a group of older, black, male students, who were gathered in the gym, stood out in their upscale, preppy attire. Tailored shirts in richly colored stripes and plaids were tucked neatly into chinos and Docker pants.

Labels with cachet - Tommy Hilfiger, Nautica, Polo, and Roundtree and Yorke - are considered essential among this crowd.

*The Commercial Appeal* (October 1, 1995).

Nautica International, a leading men's-wear company, has joined forces with Sailing World magazine in Newport as national sponsors of the regatta series, and ESPN commentator Gary Jobson, best known for his America's Cup broadcasts from Australia and San Diego, is the national spokesperson.

*Providence Journal-Bulletin* (August 13, 1995).

Younkers has the dominant market share in most if (sic) its 54 locations, competing against the likes of WalMart and Dillard as well as J.C. Penney and Sears. The company carries tried-and-true labels such as Liz Claiborne, Carol Little, Tommy Hilfiger, Ralph Lauren and Nautica, but nearly 20% of its apparel carries store labels.

*Forbes* (July 19, 1993).

"This could be her [Donna Karan] big breakthrough," said retail industry consultant Alan Millstein. "This could put her in the big leagues with Ralph Lauren, Tommy Hilfiger and Nautica. Only one other American designer has ever successfully produced both a men's and women's line, and that was Ralph Lauren. This is her ticket to the hundred-million-dollar club."

*The Atlanta Journal and Constitution* (March 21, 1993).

The clothing makers are hearing from women and men, in their 20's, 30's, 40's and beyond who are asking for good-looking, casual clothes. Cases in point are Ralph Lauren's Polo and Donna

Karan's DKNY, as are the ubiquitous Nautica and Tommy Hilfiger lines. All four collections of sporty denims, tweeds, parkas and handknit-looking sweaters are so popular with retailers and customers that they take up a good deal of the selling-floor space in area department stores.

*St. Louis Post-Dispatch* (October 18, 1992).

Downtown's Warehouse Row, eight handsomely renovated turn-of-the-century railroad warehouse buildings, has 30 factory outlet shops selling the names you know, including Albert Nippon, Perry Ellis, Ralph Lauren, Adrienne Vittadini, Bass, J. Crew, Nautica, and Johnston & Murphy.

*The Atlanta Journal and Constitution* (April 29, 1992).

On the other hand, opposer's testimony and evidence regarding its sales revenues and advertising lack context. For example:

1. Opposer has not provided any information regarding its market share;
2. Opposer has not provided any information regarding the identity of the television shows and television networks on which it advertises (e.g., nationally broadcast television shows on major networks versus specialty shows or local shows on cable networks);
3. Opposer has not provided any information regarding the identity of the newspapers and magazines where it places its print advertising;

4. Opposer has not provided any information regarding how many people visit its Internet site; and,

5. Opposer has not provided any information regarding how many people participated in and attended its numerous and varied sponsored events, including triathlons, volleyball tournaments, and sailing events.

Nevertheless, in view of opposer's long use of its NAUTICA mark in connection with clothing and spectacles, its extensive sales and advertising expenditures, as well as the unsolicited media attention it has received, we find that opposer's mark has a high degree of public recognition and renown. In particular, with respect to the unsolicited media attention, Opposer's NAUTICA mark is listed in the same context as many other well-known clothing trademarks (e.g., Donna Karan, Ralph Lauren, and Tommy Hilfiger), and the NAUTICA line of products is described as "ubiquitous," "names you know," "big leagues," "tried-and-true labels," "labels with cachet," "Hall of Fame," and "megabrand."

In view of the foregoing, the fame (or public recognition and renown) of the NAUTICA trademark is a factor that favors finding that there is a likelihood of confusion.

B. The similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its mark for a variety of products in Classes 9 and 25, including spectacles and eyeglass cases (Class 9) and clothing, namely, athletic

shoes, sandals, boots, beach footwear, t-shirts, shorts, pants, bathing suits (Class 25). Opposer has registered the NAUTICA trademark for spectacles and cases (Class 9) and clothing, namely, shoes, shirts, pants, shorts, and bathing suits (Class 25). Although the description of goods in the application and opposer's registrations are not identical, many of the products listed therein are the same. The fact that some of the applicant's goods are either identical or closely related to opposer's goods is sufficient to support a finding of likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fund Group, Inc.*, 648 F.2d 1335, 209 UPSQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application). The fact that the description of goods in the application and opposer's registrations include other items that may not be related does not obviate the relatedness of the identical products. *Id.*

C. The similarity or dissimilarity of likely-to-continue trade channels.

Because the goods are in part identical, we must presume that the channels of trade and purchasers would be the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade

channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

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

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety 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 where, as here, the goods are in-part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of*

*E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

In addition, 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).

Opposer argues that applicant's mark NAUTIGIRL is similar to its NAUTICA and NAUTICAKIDS marks for the following reasons:

1. Applicant's mark and opposer's marks share the prefix "Nauti";

2. The prefix "Nauti" is the dominant portion of applicant's mark because the suffix "girl" is descriptive;<sup>24</sup> and,

3. Consumers encountering applicant's NAUTIGIRL mark will believe that it is part of opposer's well-known NAUTICA line of clothing and eyewear.

On the other hand, applicant contends that its mark NAUTIGIRL does not resemble opposer's NAUTICA marks for the following reasons:

1. Opposer's mark conveys the commercial impression of something nautical. In fact, opposer's registrations include a statement that the word "Nautica" means "nautical";

2. Opposer's mark is inherently weak, and therefore entitled to only a narrow scope of protection or exclusivity of use because the word "Nautica" means "nautical," and "nautical clothing" is a recognized type of clothing; and,

3. The prefix "nauti" in applicant's mark is a fanciful abbreviation for the word "naughty," and when combined with the suffix "girl" conveys the commercial impression of a naughty girl.

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<sup>24</sup> Margaret Bizarri, opposer's trademark paralegal, testified that other companies use "girl," "boy," or "kids" as part of their marks (e.g., Tommy Girl, Brooks Brothers Boys, Talbot Kids and Gap Kids). (Bizarri Dep., p. 48).

However, contrary to the preceding argument in Applicant's Trial Brief (No. 3 *supra*), during the prosecution of its application, applicant argued that the commercial impression engendered by its mark NAUTIGIRL pertains to something nautical, not a naughty girl.

Contrary to the Examining Attorney's assertion, NAUGHTY GIRL! and NAUTIGIRL create an entirely different commercial impression.<sup>25</sup> The commercial impression created by the mark NAUGHTY GIRL! as applied to brassieres and bikini panties is clearly one of bad or immodest or illicit behavior, or behavior otherwise lacking in propriety . . .

\* \* \*

The mark NAUTIGIRL creates an entirely different commercial impression as a result of the spelling of the mark and the clothing on which the mark is used. "Nauti" as opposed to "Naughty" creates the commercial impression of pertaining to ships or the water. "Nauti" is the root of the words "nautical," which pertains to ships and navigation, and "nautilus," which is a genus of marine animal.

Further, the clothing and apparel covered in the application are clothing for water sports, other sports, and beachwear (i.e., shorts, t-shirts, swimwear). Applied to these goods, the commercial impression created by the mark NAUTIGIRL is clearly that it is nautical related clothing for girls.<sup>26</sup>

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<sup>25</sup> During the prosecution of applicant's application, the Examining Attorney refused registration because applicant's mark so resembles the mark NAUGHTY GIRL! for brassieres and bikini panties (Registration No. 1082710) as to be likely to cause confusion.

<sup>26</sup> Applicant's May 9, 2000 Response to the Office Action mailed November 9, 1999.

The file of an application involved in an opposition forms part of the record without any action by the parties, and the parties may make reference to the file for any relevant and competent purpose. Trademark Rule 2.122(b)(1), 37 CFR §2.122(b)(1). Allegations made by the applicant during the prosecution of its application may be used by the opposer as evidence against the applicant as an admission against interest. *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981). See also *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984), quoting *Interstate Brands Co. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (applicant's earlier contrary position before the Examining Attorney as to the meaning of its mark illustrates the variety of meanings that may be attributed to, and commercial impression projected by, applicant's mark).

We accept applicant's contention made during the prosecution of its application that the mark NAUTIGIRL conveys the commercial impression of nautical or water related clothing for girls.<sup>27</sup> In fact, some of applicant's goods are specifically water related (*i.e.*, diving suits and diving gloves, wet suits, water resistant jackets and pants

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<sup>27</sup> If we accept both of applicant's arguments, NAUTIGIRL could convey the commercial impression of a naughty girl on a boat.

for water skiing, sailing, windsurfing, surfing, kayaking, canoeing, and personal watercrafting, water sport boots, water sport headwear, namely caps and hoods, bathing suits, and beach footwear). Likewise, opposer's NAUTICA marks convey the commercial impression of nautical or water related products. Opposer has translated the word "Nautica" into English as "nautical."

Opposer's NAUTICA marks and applicant's NAUTIGIRL mark are similar in appearance and sound because they share the "nauti" prefix. Opposer's NAUTICAKIDS mark shares the same structure as applicant's NAUTIGIRL mark: both marks have the "nauti" prefix followed by a suffix describing the users of the products (*i.e.*, kids or girls). Thus, some consumers may mistakenly believe that NAUTIGIRL clothing is an expansion of the NAUTICAKIDS clothing line.

While there are obvious differences between opposer's marks and applicant's mark, we find that the similarities outweigh the differences, especially because opposer's marks have a high degree of public recognition and renown. In view of the foregoing, the similarity of the marks is a factor that favors finding that there is a likelihood of confusion.

E. The strength of opposer's mark.

Applicant introduced the following 11 third-party registrations owned by six (6) entities with a "Naut" or "Nauti" prefix for clothing products.<sup>28</sup>

Nautilus, Inc.

Mark	Registration No.	Goods
NAUTILUS	1086063	Hats
NAUTILUS	1084853	T-shirts and sports shirts
NAUTILUS	1391673	Shoes and athletic footwear
NAUTILUS	2970870	A wide variety of clothing

Correct Craft, Inc.<sup>29</sup>

Mark	Registration No.	Goods
SKI NAUTIQUE	1478791	Shirts, shorts, caps, hats, visors, sweat shirts, sweat pants and jackets
FASHION NAUTIQUE	1641348	Clothing, namely, shirts, jackets, pants, swimwear, and caps

<sup>28</sup> Applicant submitted one registration filed under Section 44(d) of the Trademark Act of 1946, 15 U.S.C. §1126(d), and not use in commerce. A registration issued solely on the basis of an application filed under Section 44(d) does not require use in commerce. Without use in commerce, the registration has very little probative value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

<sup>29</sup> Opposer has filed petitions to cancel the Correct Craft registrations.

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Mark	Registration No.	Goods
THE NAUTI DOLPHIN	2313902	Hats and shirts (and restaurant services)
THE NAUTI DOLPHIN and Design	2318607	Hats and shirts (and restaurant services)

Miscellaneous Entities

Mark	Registration No.	Goods
NAUTICUS	2124601	Clothing, namely, t-shirts, sweat shirts and hats sold at the National Maritime Center
NAUT-ON-CALL	2556304	Shorts, pants, shirts, shoes and hats
NAUTICAL LIVING	2744158	T-shirts, headbands, sweatshirts, pants, coats, jackets, hats, visors, belts, sweaters, neckerchiefs, socks

While the third-party registrations do not establish the use of the registered marks, that the registered marks are known to the public, or that the public is conditioned to reacting to portions of the marks, they may be used to show that the mark, or a portion of the mark has a specific meaning and that the mark has been adopted and registered to reflect that meaning. *Marcal Paper Mills, Inc. v. American Can Co.*, 212 UAPQ 852, 863 (TTAB 1981). In this case, applicant is using the third-party registrations to show that the marks have been adopted and registered to suggest

that the terms "naut" and "nauti" convey the commercial impression of "nautical clothing."

In this regard, applicant also introduced numerous LexisNexis database articles referencing the term "nautical clothing" for the purpose of showing that "nautical clothing" is recognized as a type of clothing. Because opposer's NAUTICA marks mean "nautical," opposer contends that the NAUTICA marks are inherently weak marks and are limited to a narrow scope of protection or exclusivity of use.

Under different circumstances, the third-party registrations and news articles might be sufficient to show that a "naut" or "nauti" prefix conveys a commercial impression engendering "nautical clothing" and, therefore, preclude a finding of likelihood of confusion. However, in view of the public recognition and renown of the NAUTICA marks, opposer's marketplace strength of its NAUTICA marks outweighs any inherent weakness in opposer's marks created by the translation of "Nautica" as "nautical."

Applicant introduced numerous articles retrieved from the LexisNexis database referencing Nautilus, Inc., the owner of the NAUTILUS trademark registrations listed above for the purpose of showing that opposer does not own the exclusive right to use marks with the "Nauti" prefix. However, these articles do not support applicant's premise.

The relevant articles reported that Nautilus was launching a fitness apparel line called RESPONSIV<sup>30</sup> and that the Nautilus fitness apparel business would feature the Pearl Izumi brand.<sup>31</sup> While a few articles reported that the Nautilus fitness apparel business would feature both the Pearl Izumi and Nautilus brands,<sup>32</sup> there were no articles that reported on Nautilus brand clothing and the impact that the product has made in the market. It is not even clear whether Nautilus has, in fact, launched a line of NAUTILUS clothing.

Finally, even were we to concede that "Nauti" marks are weak, it has been said that 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). See also, *Matsushita Electric Industrial Co., Ltd. v. National Steel Construction Co.*, 442 F.2d 1383, 170 USPQ 98 (CCPA 1971); *King Kup Candies Inc. v. King Candy Co.*, 288 F.2d 944, 129 USPQ 272 (CCPA 1961).

F. Balancing the factors.

The dominant factor in this case is the fame of opposer's NAUTICA marks. Because opposer has established that its NAUTICA marks are entitled to a high degree of

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<sup>30</sup> *The Columbian* (August 1, 2006); *Business Wire* (July 27, 2006).

<sup>31</sup> *Business Wire* (February 17, 2006).

<sup>32</sup> *The Oregonian* (August 1, 2006); *The Oregonian* (December 28, 2005).

public recognition and renown, they are more likely to be remembered and associated in consumers' minds than weaker marks and accorded more protection. In addition, to the high degree of public recognition and renown, applicant's mark is proposed for use in connection with goods which are identical in part to the goods in opposer's registrations. Therefore it is more likely that consumers will be confused when purchasing applicant's products when applicant's products are identified by a mark that is similar to opposer's famous marks. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In reaching this decision, we note that there is "no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989), quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

In view of the foregoing, we find that applicant's mark NAUTIGIRL, when used in connection with the products described in applicant's application, so resemble opposer's NAUTICA marks for clothing and eyeglasses as to be likely to cause confusion.

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Because we have found that there is a likelihood of confusion, we do not have to decide the issue of dilution.

Decision: The opposition is sustained and registration to applicant is refused.