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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

R. Josephs Licensing Inc.

v.

Laurie Porter

Opposition No. 91166220 to application Serial
No. 78469346 filed on August 18, 2004

Timothy T. Tyson of Freilich, Hornbaker & Rosen for
R. Josephs Licensing Inc.

Kit M. Stetina and Stephen Z. Vegh of Stetina Brunda Garred
& Brucker for Laurie Porter.

Before Bucher, Grendel and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On August 18, 2004, Laurie Porter ("applicant") filed
an application for registration of the mark OCEAN LAGUNA (in
standard character form) on the Principal Register for
"clothing, namely, T-shirts, shirts, jackets, pants,
sweatshirts, headwear, hats, swimsuits, surf trunks, [and]
wetsuits" in International Class 25. Applicant has asserted

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a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b) and has entered a statement into the application providing that the foreign wording in the mark, i.e., LAGUNA, translates to "lagoon."¹

R. Josephs Licensing Inc. ("opposer") has filed a timely notice of opposition to registration of applicant's mark. In the notice of opposition, opposer pleaded that it and its predecessors in interest began selling clothing in interstate commerce under the mark LAGUNA since at least as early as 1946 and has been selling clothing under the LAGUNA mark since then; and that opposer is the owner of Registration No. 1541125² for the mark LAGUNA (in typed form) for, among other goods,

men's, boys', and juvenile boys' clothing, namely swim suits, swim wear, sport shirts, warm-up suits, t-shirts, jackets, suits, sportcoats, underwear, belts, hats, shoes, ties, and pajamas; women's, girls', and juvenile girls' clothing, namely blouses, skirts, jackets, jogging suits, shorts, pants, jeans, socks, belts, swim suits, swim wear, hats, underwear, sleepwear, and pajamas.

Further, opposer has alleged that applicant's mark "so resembles marks previously registered ... and previously used by Opposer and not abandoned, as to be likely, when applied

¹ In her application, applicant claimed ownership of Registration No. 2852036 for the mark OCEAN LAGUNA, which registered on June 8, 2004 for "cosmetics, namely, bath soaps."

² Issued May 30, 1989. Section 8 declaration accepted and Section 15 declaration acknowledged.

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to the [goods] of the Applicant, to cause confusion, or to cause mistake, or to deceive" in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Applicant has denied the salient allegations of the notice of opposition, but has admitted that opposer is the owner of pleaded Registration No. 1541125. The parties have fully briefed this case.

The Record

Of course, the record includes the file of application Serial No. 78469346 and the pleadings. Additionally, opposer has filed (i) a notice of reliance submitting a status and title copy of Registration No. 1541125, (ii) the transcript of the August 24, 2006 testimonial deposition, with exhibits, of Ronald H. Josephs, President and owner of opposer; and (iii) the transcript of the December 6, 2006 rebuttal deposition of Mr. Josephs, with exhibits.³

Applicant has filed (i) a notice of reliance making applicant's Registration No. 2852036 for the mark OCEAN LAGUNA for "cosmetics, namely bath soaps" of record; and (ii) a transcript of applicant's testimonial deposition, with exhibits.

³ Citations to pages in Mr. Josephs' deposition in this opinion are to his testimonial deposition and not to his rebuttal deposition.

Standing/Priority

Because opposer has made a status and title copy of Registration No. 1541125 of record, showing that it is in full force and effect and owned by opposer, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The Goods

We first examine the similarity or dissimilarity of the parties' goods, considering the goods as they are described

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in the identification of goods in applicant's application and opposer's registration. See *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Applicant's identification of goods includes within its scope the men's, boys' and juvenile boys' T-shirts, jackets, hats and swim suits, and the women's, girls' and juvenile girls' jackets, pants, hats and swim suits, which are specified in registrant's identification of goods. Additionally, applicant's "surf trunks" are encompassed within opposer's "swim wear," and applicant's sweatshirts and wetsuits are otherwise related to opposer's casual clothing items. We therefore resolve this factor in opposer's favor.

Trade Channels

Given the absence of any restrictions or limitations in the parties' respective identifications of goods in the application and the registration, the parties' clothing items - some of which are legally identical - are deemed to be marketed in the same trade channels and to the same classes of purchasers. *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992) ("There is no evidence that opposer's and applicant's goods are currently being sold in the same channels of trade. Yet, in neither the applicant's application nor the opposer's registrations are the trade channels in any way

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restricted. The issue of likelihood of confusion is resolved by considering the 'normal and usual channels of trade and method of distribution.'" (Citations omitted). Thus, we must consider, for purposes of the likelihood of confusion analysis, that applicant could sell her goods in retail department stores such as Ross, Marshalls, Wal-Mart and K-Mart and sporting goods stores, the same outlets through which opposer's goods are sold. See Josephs dep. pp. 31 - 35. We must also consider that both parties advertise in the same newspapers and magazines, and attend the same trade shows and expos, including those referred to by applicant in her testimony at pp. 20 - 25. The presumptive common channels of trade therefore is a factor that weighs in opposer's favor.

Conditions of Sale

Because the clothing identified in the parties' identifications of goods may include inexpensive and frequently replaced items which may be purchased on impulse, and because clothing is purchased by virtually everyone, purchasers of both parties' clothing must be deemed to include impulse purchasers, and not exclusively those purchasers who exercise greater care than impulse purchasers, as posited by applicant for her goods. See *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) ("When products are relatively low-

priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care") (citations omitted). This factor too favors opposer.

Fame

In arguing that this *du Pont* factor should be resolved in opposer's favor, opposer relies on Mr. Josephs' testimony regarding the revenues opposer has received for sales of clothing bearing the LAGUNA mark. Specifically, when asked about such revenue, Mr. Josephs replied; "It's over half a million dollars, I can't say exactly. But it could be over a million, I'm sure, but I'm not positive for sure." This evidence is not particularly persuasive because it is not supported by documentary evidence, is not precise and does not reflect sizable revenues for clothing.⁴ Opposer has not introduced evidence directed to the other usual indicia of fame, such as advertising figures, sales figures or critical acclaim of any of opposers' products. See *Kenner Parker Toys, Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). Thus, even when we consider that opposer has used

⁴ Mr. Josephs' testimony regarding opposer's revenues from the sale of LAGUNA brand footwear is not probative because opposer has not alleged a likelihood of confusion between opposer's footwear and applicant's clothing items.

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the mark on clothing for sixty years, opposer's LAGUNA clothing has been sold in national retail chain stores, opposer has had over \$100,000,000 in sales of various LAGUNA branded goods, opposer has licensed its mark to others, and opposer obtains a minimum monthly royalty of \$11,000 per month, opposer has not established that its mark for clothing is famous or even well-known. The *du Pont* factor concerning fame hence is neutral.

The Marks

We now turn to the marks. We must determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

In arguing that the marks are similar, opposer maintains that LAGUNA is the dominant component of applicant's mark and that "[s]ince Opposer already has the registration for the word LAGUNA in the same class for the same goods and substantially the same goods, Applicant is precluded from receiving a registration for OCEAN LAGUNA." Brief at 9 - 10. Opposer states that LAGUNA is dominant because "LAGUNA is the noun and the word OCEAN is merely an adjective that tells what type of LAGUNA"; and that applicant's mark is well-known and famous and "a well-known and famous part of a composite will likely make the most

impression on the ordinary viewer [and be] treated as the dominant portion of conflicting marks and given greater weight in the comparison." Opposer emphasizes that its mark "has been in use since 1946 on clothing and has had over \$100,000,000 in sales at retail over the last five years."⁵

We have found earlier in our opinion that opposer's mark is not a famous or even a well-known mark and hence reject its argument that LAGUNA is the dominant portion of its mark on this basis. See discussion *infra*. We also are not persuaded by opposer's argument that OCEAN modifies LAGUNA and indicates what kind of LAGUNA. Opposer, by implication, maintains that the term LAGUNA would be recognized by the purchasing public as the foreign word "lagoon," and that purchasers would translate LAGUNA into English when seeing the composite OCEAN LAGUNA. There simply is no basis for us to accept that purchasers would translate LAGUNA to "lagoon," especially when LAGUNA has an association with Laguna Beach, California, which is a noted artist community. See entry for "Laguna Beach" in *The Columbia Encyclopedia* (2004), of which we take judicial notice, i.e., "A residential and resort community with a noted art colony and many cultural attractions, the city profited from the rapid growth and prosperity of Orange Co.

⁵ The \$100,000,000 figure includes sales of footwear, and is not limited to sales of clothing.

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in the 1980s and 90s.”⁶ See also references to “Laguna” in the record, e.g., applicant's statement at p. 17 of her deposition “I use plants that are native to the area of Laguna - they are not specifically from Laguna, but plants that are found along the coastline”; and Exhibit L to applicant's deposition including an article from *Laguna News Post* and a letter from “Laguna Board of Realtors.”

Applicant's analysis of the marks is equally unpersuasive. In her brief at p. 10, applicant argues that she has a line of bath and body products marketed under the OCEAN LAGUNA mark; and that she uses ingredients that are native to the coastline of Laguna Beach in such products and that they have the “salt air and scent of the ocean.” As a consequence, she concludes that “not only is the term ‘ocean’ not necessarily used as an adjective to describe ‘what type of laguna’, as suggested by Opposer, but that it is derived from the ‘ocean-inspired’ nature of the brand and the location from which components of the branded products may be found.” *Id.* at 10 - 11. She maintains that OCEAN and LAGUNA are “coequals in terms of the qualities featured in Applicant's cosmetic and clothing products”; and that

⁶ From the website credreference.com. The Board may take judicial notice of dictionary definitions and standard reference works which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *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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"[a]rguably, the first term 'OCEAN' is the 'salient feature' of Applicant's Mark in light of the 'ocean-inspired' derivation of all of Applicant's products, with the term 'LAGUNA' perhaps suggesting a geographically qualitative reference." *Id.* at p. 11. And, at p. 12 of her brief, she points out that "[t]ypically, Applicant's bath and beauty products are displayed and sold together with their apparel products, and in particular, t-shirts bearing Applicant's 'OCEAN LAGUNA' mark."

However, "in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be." *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems Inc. v. Houston Computers Services Inc.*, 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 regardless of what the record may reveal as to the particular nature of an applicant's goods ..."). Thus, it is irrelevant what scents applicant's body soaps and lotions

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conjure up; applicant's identification of goods does not include body soaps and lotions. Further, it is irrelevant how applicant actually uses its mark; we must consider only those goods listed in the identification. As to those identified goods, i.e., items of clothing, there is no reason to believe that the scent of the ocean and salt air would come to mind when purchasers simply see the term OCEAN in OCEAN LAGUNA.

Additionally, we do not agree with applicant that OCEAN is the salient term in applicant's mark. Three of applicant's goods are well suited for use in oceans. Specifically, applicant's swimsuits could be used in oceans and applicant's surf trunks and wetsuits would primarily be used in oceans. Thus, the term OCEAN in applicant's mark, as applied to these goods, suggests a use for these goods and consumers could perceive applicant's mark as indicating that the LAGUNA brand swimsuits, surf trunks and wetsuits are specially constructed or intended for ocean use. We thus find that LAGUNA is the salient or dominant term in applicant's mark with OCEAN being a suggestive term that is less significant in creating the commercial impression of the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (although marks must be considered in their entirety, there is nothing improper, under

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appropriate circumstances, to give more or less weight to a particular portion of a mark).

In comparing applicant's mark to opposer's mark, we find that the term in applicant's mark which creates a greater impression on the purchaser is identical to registrant's mark. While the marks have obvious differences in appearance and pronunciation due in part to the inclusion of OCEAN in applicant's mark, these differences are not as significant as the similarities created by the identical common term. In view of the shared term, we find that the meanings of the marks and their commercial impressions are not dissimilar - the additional wording in applicant's mark does not alter the overall meaning and commercial impression of the marks and any differences in the meaning and commercial impression of the marks are not very significant. We conclude that, when we consider these marks in their entirety, the differences in appearance, pronunciation, meaning, and commercial impression are eclipsed by the similarities of the marks. In view thereof, and because (i) a "[s]ide by side comparison is not the test," *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973), (ii) the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks, *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB

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1975), and (iii) "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines," *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), we find that the marks are more similar than dissimilar.

This *du Pont* factor is resolved in opposer's favor.

*Similar Marks Used
On Similar Goods*

Applicant has introduced the following from the TESS database of the U.S. Patent and Trademark Office into the record: (i) search results for marks having only the wording OCEAN in all International Classes; (ii) search results for marks having only the wording LAGUNA in all International Classes; (iii) search results for all marks containing LAGUNA in International Class 25; and (iv) a printout of each application and registration identified in (i) and (ii). Most of applicant's evidence is of very limited probative value - the search results do not include the goods or services recited in the applications and registrations; the applications are only evidence of the fact that they were filed; the registrations are not evidence that the different marks shown therein are in use; and many of the registrations have expired or are for unrelated goods and/or services. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed.

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Cir. 1992) (regarding the "strength of a mark, however, registration evidence may not be given any weight"); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973) ("in the absence of any evidence showing the extent of use of any of such marks or whether any of them are now in use, they provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion"); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468, n. 6 (TTAB 2003) ("third-party applications are evidence only of the fact that they were filed; they have no other probative value"); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217 - 1218 (TTAB 2001) ("these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them"); *Sheller-Globe Corporation v. Scott Paper Company*, 204 USPQ 329, 336 (TTAB 1979) ("we need not comment on the third-party registrations placed in the record by applicant save to note that they pertain to completely unrelated goods and are therefore irrelevant.") Because the record does not show through proper evidence any third party uses of the same or similar marks, we accord opposer's mark the normal scope of protection otherwise afforded to registered marks. This factor is neutral in the likelihood of confusion analysis.

*Variety of Goods
on Which the Mark is Used*

Because there only is evidence that opposer's LAGUNA mark has been used on apparel and footwear, this factor too is neutral.

Absence of Actual Confusion

The record does not include any evidence of actual confusion. However, although applicant has testified that she has used the mark on T-shirts, there is no evidence as to the extent of such use. We cannot find on this record that there has been any meaningful opportunity for actual confusion to have occurred, and we therefore cannot conclude that the apparent absence of actual confusion is either factually surprising or legally significant. This factor is neutral in our likelihood of confusion analysis in this case.

Conclusion

After weighing each of the relevant *du Pont* factors, and considering the marks in their entirety, we find that there is a likelihood of confusion. Opposers have established that the marks are sufficiently similar, that the goods are legally identical or otherwise related, that the trade channels are identical, and that the goods may be purchased on impulse by the general public so that confusion as to source is likely to occur.

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