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TTAB 9/8/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paris Seagul (Far East) Ltd.

Serial No. 75/059,887

Joseph Strabala for Paris Seagul (Far East) Ltd.
Jacqueline Lavine, Trademark Examining Attorney, Law Office
109, (Debbie Cohn, Managing Attorney).

Before Cissel, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 20, 1996, applicant, a Hong Kong
corporation, filed an application to register the mark
"RIVA" on the Principal Register for "clothing, namely,
women's shirts, jackets, pants, blazers, shorts, T-shirts
and under garments (sic)," in Class 25. The basis for the
application was applicant's assertion that it possessed a

bona fide intention to use the mark in connection with the specified goods in commerce.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's use of the mark "RIVA" on the clothing items listed in the application would be likely to cause confusion in view of the prior registration¹ of the same mark for "footwear."

Applicant responded by amending the list of its goods to change "under garments" to "underwear," and included a statement that the mark is the Italian word for "shore" or "beach."

Applicant also presented arguments on the issue of likelihood of confusion. Applicant contended that during the period from 1982 to 1990, while the registration cited against applicant was subsisting on the register, at least two other parties were using the mark "RIVA" on clothing. As evidence of this alleged use, applicant pointed to two registrations which the official records of the Patent and Trademark Office show were concurrently in effect with the cited registration. These registrations were subsequently

¹ Reg. No. 1,710,111, issued to Florsheim Group, Inc. on August 25, 1992; combined affidavit under Sections 8 and 15 accepted. Use since 1984 was claimed.

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canceled, but applicant argued that if they could coexist with the cited registration for footwear, confusion should

not be held likely with respect to applicant's mark either.

Further, applicant argued that its goods are "high end women's garments," principally made of silk, and are not competitive with footwear, which does not travel in the same channels of trade. Applicant contended that the shoes sold under the registered mark are sold in registrant's specialty shoe stores, which do not sell clothing items like those on which applicant uses its mark.

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register was made final in the second Office Action. Applicant responded to the final refusal with additional arguments, but the Examining Attorney remained convinced that confusion is likely and continued the refusal to register. Attached to her third Office Action were excerpts from Office records that show thirteen use-based registrations wherein the lists of goods for which the particular marks are registered include both clothing items and footwear. Additionally, copies of pages from three catalogues show that shoes and clothing are marketed together by the same businesses.

Applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

After careful consideration of the record and the arguments of applicant and the Examining Attorney, we find that the refusal to register is appropriate in this case. Confusion is likely because these marks are identical and the goods listed in the registration are closely related to the goods specified in the application.

The principles involved in determining whether confusion is likely in a case like this one are well settled. As identified in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the factors which should be considered in the case at hand include the similarity of the marks; the similarity of the goods, as they are identified in the application and the cited registration, respectively; the similarity of established, likely-to-continue trade channels; the conditions under which and buyers to whom sales are made, i.e., impulse purchases versus careful, sophisticated purchasing; and the number and nature of similar marks on similar goods.

That the marks are identical is beyond dispute. In situations where the marks are the same, in order for confusion to be likely, the relationship between the goods

does not need to be as close as would be the case where the marks are distinguishable. In re Concordia International Forwarding Corp., 222 USPQ 355 (TTAB 1983).

The products set forth in the application are closely related to those identified in the registration. Applicant's goods are specified as "clothing, namely, women's shirts, jackets, pants, blazers, shorts, T-shirts and underwear." Contrary to the arguments of applicant's counsel, these products are not limited to "high-end," silk items sold to a particularly sophisticated class of clothing purchasers in places where footwear is not sold. We must consider the goods as they are identified in the application and registration, respectively, without limitations or restrictions not reflected therein. In re Elbaum, 211 USPQ 639 (TTAB 1981). In the absence of such restrictions, we must assume that the goods move through the normal and usual trade channels for such goods, and that they are purchased by the usual buyers of such products and used for the normal purposes for which such goods are used. Fort Howard Paper Co. v. Marcal Paper Mills, Inc., 189 USPQ 305 (TTAB 1975).

When we adopt this approach, we must conclude that the women's clothing items identified in the application are closely related to footwear. The evidence made of record

by the Examining Attorney shows that these goods are sold by the same businesses in the same trade channels to the same kinds of people, ordinary consumers. Common sense and experience tell us that some of the clothing items listed by applicant, such as jackets, pants and blazers, are used together with footwear as complementary components of the same outfits. Further, the third-party registration information introduced by the Examining Attorney shows that some businesses have registered their marks for both kinds of products. This is further evidence establishing that these goods are related. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Applicant's argument concerning the two other businesses which applicant claims also used "RIVA" for clothing items at the same time the registrant used "RIVA" for footwear fails for several reasons. To begin with, the information presented concerns expired registrations, not use. Even if we were presented with evidence of valid, subsisting registrations, such evidence would not establish that there is any significant use of the registered marks in the marketplace, such that consumers are familiar with the registered marks on the goods for which they are registered. Second, as the Examining Attorney points out, contrary to applicant's contention, the records of the

Patent and Trademark Office do not even show that the two registrations applicant refers to coexisted on the register with the cited registration. In fact, both were canceled prior to the issuance of the registration cited as a bar to the instant application. The third fatal point with regard to applicant's argument concerning the two canceled registrations is that even if we could consider them to be evidence of use, and even if the registrations had coexisted on the register for a significant period of time with the registration cited as a bar to the instant application, we would still have no reasonable basis upon which to conclude that no confusion took place during that time. For all these reasons, applicant's argument with regard to the canceled registrations is without merit.

Confusion is likely in the instant case because applicant's mark is identical to the cited registered mark and the clothing items listed in the application are

closely related to the goods specified in the registration.
Accordingly, the refusal to register under Section 2(d) of
the Act is affirmed.

R. F. Cissel

G. D. Hohein

C. E. Walters
Administrative Trademark Judges
Trademark Trial & Appeal Board

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