

This Opinion is not a  
Precedent of the TTAB

Mailed: December 30, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re ITOCHU Corporation*

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Serial No. 86374514

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Michael R. Friscia and Carissa L. Rodrigue of McCarter & English LLP,  
for ITOCHU Corporation.

Paul Moreno, Trademark Examining Attorney, Law Office 103,  
Michael Hamilton, Managing Attorney.

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Before Wellington, Wolfson and Heasley,  
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

ITOCHU Corporation (“Applicant”) seeks registration on the Principal Register of the mark **MERINO OPTIMO** (in standard characters, with “MERINO” disclaimed) for “Aprons; babies’ pants; bathrobes; bodices; boxer shorts; suspenders; brassieres; breeches for wear; camisoles; collar protectors; dress shields; dresses; dressing gowns; hosiery; inner soles; jerseys; jumpers; layettes; liveries; masquerade costumes; neckties; overalls; pajamas; pants; shirts; short-sleeve shirts; skirts; skorts; sleep masks; slippers; socks; sports jerseys; stockings; suits; sweat-absorbent stockings; sweat-absorbent underwear; sweaters; teddies; tee-shirts; trousers; underpants;

underwear; uniforms; veils; and vests all made in whole or in significant part of Merino wool” (emphasis added) in International Class 25.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act on the ground that the applied-for mark so resembles the mark **OPTIMO** (in standard characters) for “hats” in International Class 25, as to be likely to cause confusion or mistake, or to deceive prospective purchasers of the goods. 15 U.S.C. § 1052(d).<sup>2</sup>

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

## I. Analysis

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

We have considered each *DuPont* factor that is relevant, and have treated any other factors as neutral. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378,

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<sup>1</sup> Application Serial No. 86374514 was filed on August 22, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The Application originally identified additional goods in International Classes 18, 23, and 24—goods that were divided out into a separate child application, Serial No. 86974547, for which a Notice of Allowance subsequently issued. This appeal concerns only the parent Application, Serial No. 86374514, which identifies goods in International Class 25.

<sup>2</sup> Registration No. 3204051, issued on the Principal Register on January 30, 2007, Section 8 & 15 declarations accepted and acknowledged.

78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687-88 (Fed. Cir. 1993) (factors “may play more or less weighty roles in any particular determination”).

#### **A. Comparison of the Marks**

Under the first *DuPont* factor, we compare Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that its addition of the term MERINO distinguishes its mark from Registrant’s mark. It argues that MERINO is the first and most dominant component of its mark, and that “[f]urther, the inclusion of the term MERINO in Applicant’s Mark renders the marks different in meaning because this term calls to mind wool from the Merino breed of sheep, a meaning that the Cited Mark does not connote.”<sup>3</sup> Hence, it concludes, “[b]ecause Applicant’s Mark and the Cited Mark

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<sup>3</sup> Applicant’s brief, p. 4, 4 TTABVUE 9.

appear differently, sound differently and express different meanings, they convey different overall commercial impressions. Therefore, under *DuPont*, confusion is not likely.”<sup>4</sup>

Upon our review of the record evidence, however, we agree with the Examining Attorney that the term MERINO is not the dominant element of Applicant’s mark and has very little to no source-indicating value, despite its position as the first word in the mark. Rather, it merely describes the kind of wool from which Applicant’s apparel items are made. It is well settled that descriptive matter may have less significance in likelihood of confusion determinations. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). “Merino” is defined as “a sheep of a breed with long, fine wool,” or “a soft woolen or wool-and-cotton material resembling cashmere, originally of merino wool.”<sup>5</sup>

Other registrations have been issued disclaiming the element “MERINO” in marks used on woolen goods, e.g., Registration No. 2063740, for use on wool knitwear:<sup>6</sup>

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<sup>4</sup> Applicant’s brief, p. 5, 4 TTABVUE 10.

<sup>5</sup> At [www.OxfordDictionaries.com](http://www.OxfordDictionaries.com) (American English version), Aug. 17, 2015 Office Action, p. 6.

<sup>6</sup> Aug. 17, 2015 Office Action, pp. 8-9.



And Registration No. 4339456 for “Australian merino wool fabrics for the manufacture of clothing” (“Australian Merino wool” disclaimed):<sup>7</sup>



Applicant’s identification of goods admits that they are “all made in whole or in significant part of Merino wool.” Applicant has accordingly disclaimed the term MERINO, conceding its descriptiveness. *See In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014n.4 (TTAB 1988) (“By its disclaimer of the word LITE, applicant has conceded that the term is merely descriptive as used in connection with applicant’s goods.”). So the term MERINO merely informs consumers that Applicant’s clothing goods are made of Merino wool; it does not serve to indicate or distinguish the source of the goods from others’. *See National Data*, 224 USPQ at 751 (“That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly

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<sup>7</sup> Aug. 17, 2015 Office Action, pp. 29-31.

accepted rationale for giving less weight to a portion of a mark....”) *quoted in In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014).

The remaining term in Applicant’s applied-for mark, OPTIMO, is identical to the cited OPTIMO mark. Applicant adopts Registrant’s mark in its entirety, adding a prefatory, subordinate term; its complete incorporation of Registrant’s one-word OPTIMO mark increases the likelihood of confusion between the two. *See, e.g., Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (CALIFORNIA CONCEPT with surfer logo for men’s hair and cosmetic products confusingly similar to CONCEPT for cold permanent wave lotion and neutralizer); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant’s mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus confusingly similar to TITAN for medical ultrasound diagnostic apparatus). Thus Applicant’s mark would tend to be seen as a variation of Registrant’s mark, suggesting another line of apparel goods, one made of Merino wool, emanating from the same source. *Id. See also In re Collegian Sportswear, Inc.*, 224 USPQ 174, 176 (TTAB 1984) (“...customers familiar with registrant's “COLLEGIENNE” clothing might believe that “COLLEGIAN OF CALIFORNIA” clothing was a new line of clothing from registrant featuring a “California” or west coast style.”); *Wella v. California Concept*, 194 USPQ at 422. The average consumer, who normally retains a general rather than a specific impression of trademarks, *see Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016), would tend to gloss over the one-word distinction between the marks.

In short, the marks, taken in their entireties, are very similar in appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. Consequently, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

### **B. The Goods and Channels of Trade**

We next consider the second and third *DuPont* factors, concerning the relatedness of Applicant's and Registrant's respective goods and channels of trade. *DuPont*, 177 USPQ 567.

Applicant maintains that “[b]ecause Registrant’s goods only include hats, and Applicant’s Goods do not include hats, the goods are not related and confusion is not likely.”<sup>8</sup> Elaborating upon this theme, Applicant contends that its identified goods do not contain headwear of any sort, do not compete with hats, do not serve the same purpose as hats, and do not substitute for hats. Thus, Applicant concludes, although they are “both part of the broad category of apparel, they are sufficiently unrelated that consumers are not likely to think they originate from the same source.”<sup>9</sup>

The issue is not whether consumers would confuse the goods themselves, but whether they would be confused as to the source of the goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *Mini Melts*, 118 USPQ2d at 1471. It is not necessary that the apparel goods of the Applicant and Registrant be similar or even competitive to support a finding of likelihood of confusion. Instead, likelihood of confusion can be found “if the respective products are related in some manner and/or

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<sup>8</sup> Applicant’s brief, p. 6, 4 TTABVUE 11.

<sup>9</sup> Applicant’s brief, p. 8, 4 TTABVUE 13.

if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). Applicant appears to acknowledge, toward the end of its analysis, that this is the standard.

The Board has found many different articles of clothing related for likelihood of confusion purposes. *See Jockey Int’l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-399 (TTAB 1982) (hosiery related to trousers). “[A] likelihood of confusion may be found with respect to a particular class based on any item within the identification of goods for that class.” *Bond v. Taylor*, 119 USPQ2d 1049, 1052-53 (TTAB 2016). Hats and shirts, for example, have been found to be related. *See In re C. F. Hathaway Co.*, 190 USPQ 343, 345 (TTAB 1976) (“Moreover, we are firmly of the opinion that purchasers confronted by “GOLF CLASSIC” men’s hats and “HATHAWAY GOLF CLASSIC” men's knitted sport shirts are likely to assume that both products emanate from or are in some way associated with applicant ....”).

Hats and other apparel items like those identified in the Application often emanate from a single source under a single mark, as evidenced by eleven use-based third-party registrations the Examining Attorney has introduced, e.g.:

- CAVEAT, Reg. No. 4536376 for “dress suits, dresses, **hats**, jackets, jeans, pants, shirts, skirts.

- LOVE, HANNA, Reg. No. 4822730 for “T-shirts, shirts, dresses, robes, **hats**, rompers, pants, jumpsuits, sweaters, cardigans, overalls, jackets, socks, shorts, long johns, camisoles, scarves, sleepwear, belts.”
- ART HAS NO BOUNDARIES, Reg. no. 4898380 for “clothing, namely, shirts, t-shirts, blouses, tanktops, pants, shorts, skirts, dresses, jackets, coats, scarves, vests, suits, belts, sweaters, and **hats**.” (Emphases added).<sup>10</sup>

These third-party registrations serve to suggest that hats and other apparel like that identified in the application may be provided by the same source under the same mark. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1091-92 (TTAB 2016); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) *aff'd per curiam* 864 F.2d 149 (Fed. Cir. 1988); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The Examining Attorney has also introduced market evidence that hats and other articles of clothing often emanate from a single source under a single mark, e.g.:

- [www.GAP.com](http://www.GAP.com) -- caps, men’s pants, shirts<sup>11</sup>
- [www.UrbanOutfitters.com](http://www.UrbanOutfitters.com) -- caps, hats, women’s and men’s pants, shirts, boxer shorts, socks<sup>12</sup>
- [www.Converse.com](http://www.Converse.com) -- pants, shorts, T-shirts,<sup>13</sup>

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<sup>10</sup> Feb. 16, 2016 Office Action pp. 10-14, 25-26.

<sup>11</sup> At [www.GAP.com](http://www.GAP.com). downloaded 2/16/2016, Feb. 16, 2016 Office Action pp. 37-61.

<sup>12</sup> At [www.UrbanOutfitters.com](http://www.UrbanOutfitters.com), downloaded 2/16/2016, Feb. 16, 2016 Office Action pp. 65-99.

<sup>13</sup> At [www.Converse.com](http://www.Converse.com), downloaded 2/16/2016, Feb. 16, 2016 Office Action pp. 100-103.

- www.LLBean.com -- Merino wool ski hat,<sup>14</sup> pants, shirts, T-shirts, sweaters<sup>15</sup>

This evidence supports a finding that hats and the other items of apparel identified in the subject application are indeed related products. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba*, 91 USPQ2d at 1268-69, 1271-72. If these related goods bear very similar trademarks, “a purchaser who sees one mark and later encounters the other is likely to think, ... that the second mark is the same mark he had seen earlier, or, if he realizes that there are some differences in the marks, that the second is simply a slightly varied version of the first, with both serving to indicate origin in the same source.” *Mucky Duck*, 6 USPQ2d at 1468.

Even so, Applicant maintains that confusion is unlikely because Registrant’s hats and Applicant’s goods will not travel in the same channels of trade. Applicant, having reviewed Registrant’s website, asserts that its hats appear to be sold only in its Chicago retail store, where customers will never encounter Applicant’s clothing goods. Consequently, Applicant asserts, “Given the differences between the channels of trade, confusion is very unlikely.”<sup>16</sup>

However, we base our determination regarding the similarities between the parties’ goods, channels of trade and classes of purchasers on the goods as they are identified in the applications and registration, respectively. *Octocom Sys. Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813

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<sup>14</sup> At www.LLBean.com, downloaded 2/16/2016, Feb. 16, 2016 Office Action p. 104.

<sup>15</sup> At www.LLBean.com, downloaded 2/16/2016, Feb. 16, 2016 Office Action pp. 104-118.

<sup>16</sup> Applicant’s brief, pp. 9-10, 4 TTABVUE 14-15.

(Fed. Cir. 1987); *Mini Melts*, 118 USPQ2d at 1471. The Application and Registration contain no limitation as to channels of trade or classes of customers, and we decline to read any such limitation into them. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) *quoted in In re Mr. Recipe*, 118 USPQ2d at 1091. Rather, the evidence shows that hats and the variety of apparel goods identified in the Application may be sold via the same retail channels of trade to all relevant classes of purchasers.

Based on the record evidence, we find that Registrant's and Applicant's clothing goods are related, and travel through the same channels of trade to the same classes of customers. Thus, the second and third *DuPont* factors favor finding a likelihood of confusion.

### **C. Cost of the Goods and Conditions of Sale**

The fourth *DuPont* factor is the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. Applicant argues, based once again on its review of Registrant's website, that Registrant's hats are expensive, ranging in price from several hundred to several thousand dollars apiece, and these high prices impel careful, sophisticated purchasing.<sup>17</sup>

But again, absent express limitation, it must be assumed that the identified goods encompass all goods of the type identified. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139

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<sup>17</sup> Applicant's brief, pp. 10-11, 4 TTABVUE 15-16.

(CCPA 1958)). Because the respective identifications of goods include hats and apparel without any limit as to price points, we must treat the goods as including inexpensive as well as more costly clothing goods, and therefore presume that purchasers for the products include ordinary consumers who may buy inexpensive clothing. *See Stone Lion*, 110 USPQ2d at 1163-64. And even if the purchasers were sophisticated, “careful purchasers who do notice the difference in the marks will not necessarily conclude that there are different sources for the goods, but will see the marks as variations of each other, pointing to a single source.” *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014).

For these reasons, the fourth *DuPont* factor is considered neutral.

## II. Conclusion

After considering all of the evidence of record and arguments pertaining to the *DuPont* likelihood of confusion factors, we find that Applicant and Registrant’s marks are very similar, that Registrant’s hats and Applicant’s identified clothing goods are related, and that their respective goods would travel through the same channels of trade to the same classes of customers, which would include unsophisticated as well as sophisticated consumers. Thus the first, second and third *DuPont* factors favor a finding of likelihood of confusion, and the fourth factor is neutral. Accordingly, we find that there is a likelihood of confusion between Applicant’s and Registrant’s marks for the identified goods under Section 2(d).

**Decision:** The refusal to register Applicant’s mark **MERINO OPTIMO** is affirmed.