

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: )  
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Redan Management Corp., Inc. ) Law Office: 115  
 )  
Serial No.: 76/101,636 ) Examiner: Andrea P. Hammond  
 )  
Filed: August 2, 2000 ) Docket No. 251803-3010  
 )  
Mark: THE WINNER'S CIRCLE )  
(AND DESIGN) )

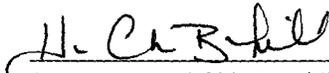


11-29-2002

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Trademarks, Arlington, VA 22202-3515, on Nov 25, 2002.

  
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Signature – Hui Chin Barnhill

**SUBSTITUTE APPEAL BRIEF**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Sir:

This is an Appeal from the Examiner's Final rejection in the above-identified trademark application. In this application, registration has been refused under Trademark Act §2(d), 15 U.S.C. §1052(d), stating that Applicant's pending mark, "THE WINNER'S CIRCLE" (and design), when used in connection with the identified services, is likely to cause confusion, or to cause mistake, or to deceive with respect to the mark shown in U.S. Registration No. 2,193,353.

**I. TEST FOR LIKELIHOOD OF CONFUSION**

The appropriate test for determining likelihood of confusion is set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). In *In re E.I. du Pont de Nemours & Co.*, the court set forth thirteen factors, called the *du Pont* factors, to be applied, when of record, in testing for likelihood of confusion. Not every factor is applicable to every case and no one factor is necessarily determinative. Instead, the weight and applicability of each factor varies from case to case. *du Pont*, 177 USPQ at 167. The *du Pont* factors which are most relative to this Appeal are: (1) the number and nature of similar marks in use, (2) dissimilarity of the marks,(3) dissimilarity of the goods and services, and (4) dissimilarity of trade channels. However, other of the *du Pont* factors may also be deemed relevant for concluding that there is no likelihood of confusion in this present application.

**II. RESPONSE TO LIKELIHOOD OF CONFUSION REJECTION**

There is no likelihood of confusion between Applicant's mark and that of the '353 registration. Specifically, a number of marks similar to the registered mark exist, the marks are dissimilar, the goods/services used in connection with the marks are dissimilar, and the channels of trade in which the marks are used are dissimilar.

**A. The Number and Nature of Similar Marks in Use**

When a mark, or a portion of a mark, has been widely used on similar goods, any similarity between two marks based on that portion has little evidentiary value in determining likelihood of confusion. See §5.02 (2), *Gilson, Trademark Protection and*

*Practice*, 1994. If a portion of a mark had been widely used in an industry, it is generally expected that consumers will not rely on that portion of a mark to distinguish the source of the goods offered under that mark. Hawes, *Trademark Registration Practice*, §6.02[8] (1994). In the case at hand, Applicant has identified several federally registered trademarks that use the terms THE WINNER'S CIRCLE, including (WINNERS CIRCLE). In particular, Applicant respectfully refers the Examiner's attention U.S. Registration No. 2,114,796. Specifically, the Registration is for WINNERS CIRCLE in connection with toy vehicles. As is known, toy vehicles representative of actual vehicles have become quite collectible and that these toy vehicles oftentimes are sponsored by, endorsed by and/or otherwise affiliated with the companies that produce the actual vehicles. Thus, although initially appearing unrelated to the goods associated with the Registrant, Applicant respectfully asserts that, in actuality, the similarity is quite great and that the Office has still recognized that there is no likelihood of confusion between those marks and has registered both of those marks.

Similarly, Applicant respectfully asserts that there is no likelihood of confusion between Applicant's proposed mark and the Registrant's mark. Thus, registration of Applicant's "THE WINNER'S CIRCLE" mark for automobile cleaning and washing services should not be prevented, since the cited registration is directed to different goods.<sup>1</sup>

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<sup>1</sup> Indeed, the present mark THE WINNER'S CIRCLE is not unusual in this respect. Applicant notes that even famous marks are often granted multiple registrations to different owners/applicants. For example, the famous mark DELTA has been registered to numerous applicants. Notwithstanding, this mark enjoys fame and notoriety in different classes. In this regard, DELTA is a famous mark in the areas of transportation/air travel, plumbing, and tools/shop equipment. Notwithstanding the fame that this mark has attained in different areas, confusion among the different sources is not likely – i.e., a person is not likely to confuse DELTA Air Lines with DELTA faucets.

**B. Dissimilarity of the Marks**

The "*similarity or dissimilarity of the marks*" must be viewed "*in their entirety as to appearance, sound, connotation, and commercial impression.*" *du Pont*, 177 U.S.P.Q. 563 (*emphasis added*). Hence, it is improper to dissect the marks when comparing the appearance, sound, connotation, and commercial impression. The Office Actions, however, improperly dissect the marks by unduly comparing only the word portions of the marks.

The Final Office Action continues to ignore the design element of the Applicant's mark. The Office Action maintains that Applicant's word mark THE WINNER'S CIRCLE (and design) is identical to the registrant's mark, and that consumers would be unable to differentiate the Applicant's mark from the registrant's mark. Applicant respectfully asserts that so doing is improper.

In discounting the impact of the Applicant's design element on the consumer, the Office Action maintains that the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and services. Applicant contends that it is improper to only look to the word portions of the marks, thereby not considering the marks *in their entireties*. As well, the Court of Appeals for the Federal Circuit has stated "[t]here is no general rule as to whether letters or design will dominate in composite marks. . . . No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." *In re Electrolyte Laboratories, Inc.*, 913 F.2d 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990), *corrected*, 929 F.2d 645 (Fed. Cir. 1990). In the instant case, not only has the design element been determined to be less dominant, but it has been ignored.

Applicant agrees with the trademark attorney's contention that the test of likelihood of confusion is not whether the marks can be distinguished when subject to a side-by-side comparison, and that the issue is whether the marks create the same overall impression. In this regard, Applicant contends that the highly stylized design element of its mark should receive at least equal consideration to the word portion. The design element of the Applicant's mark is not merely a different font applied to the word portion, which is, however, one of the differences from the '353 registration. Also included are an animated vehicle having eyes and smiling, two crossed checkered flags above the vehicle, all set against a circular backdrop having the word portion of the mark written around its border in stylized font. Clearly, the Applicant's dynamic mark, viewed in its entirety, leaves an impression with the consumer beyond what the word portion alone is capable of.

Considering the marks in their entireties, there are significant differences between Applicant's mark and the Registrant's marks. Thus, based upon the well-established legal precedent that exists, Applicant respectfully submits that no confusion between Applicant's mark and the mark of the '353 registration is not likely.

**C. Dissimilarity of the Goods and Services**

Next, the Office Action maintains that the marks of the respective parties are identical. As discussed previously, numerous differences do exist between the Applicant's mark and the '353 mark. However, assuming *arguendo* that the assertion that the marks are identical is correct, the associated goods and services are dissimilar. The similarity or dissimilarity of the goods should be considered with respect to how the Applicant's goods are described in the application for registration and how the goods are described in the '353 registration. TMEP 1207.01(a)(iii); *See Paula Payne Products Co. v. Johnson Publishing Co.*, 177 U.S.P.Q. 76 (C.C.P.A. 1973). The Registrant's mark is used on "cleaning preparations for automotive use," while the Applicant's mark applies to "automobile cleaning and washing."

In this regard, the Office Action indicates that "the fact that the goods and services of the parties differ is not controlling in determining likelihood of confusion." As stated before, Applicant agrees that relatedness of goods and services is but one factor to consider when determining likelihood of confusion. Since, in the instant application, the marks are dissimilar and the goods/services also are dissimilar, the weighting of the aforementioned factors certainly leans toward a finding of no likelihood of confusion.

**D. Dissimilarity of Trade Channels**

As previously discussed, Applicant's mark is associated with automobile cleaning and washing services, whereas the Registrant's mark is used on cleaning preparations for automobile use. In support of the Examining attorney's contention, a scenario is posited whereby other car cleaning service providers could use the Registrant's goods and its

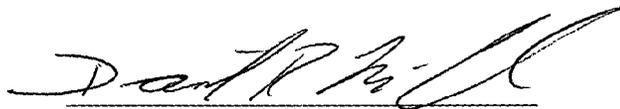
dispensers, and display its mark in the same manner and potentially cause confusion as to the source of goods and services. Applicant appreciates the stated scenario, but points out that in such a case, Registrant's mark and Applicant's mark would appear side-by-side. Therefore, there would be no likelihood of confusion as the marks clearly are dissimilar in appearance and are not amenable to being confused.

**CONCLUSION**

Because there are a vast number of similar marks and Applicant's services are dissimilar to the goods of the cited reference, it is submitted that publication of the Applicant's mark is warranted.

No fees are believed to be due in connection with this Substitute Appeal Brief. If, however, any fee is due, you are hereby authorized to charge any such fees to Deposit Account No. 20-0778.

Respectfully submitted,



Daniel R. McClure  
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H. Ch. Barnhill  
Signature - Hui Chin Barnhill

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 TRADEMARK AND  
 APPELLATE DIVISION

**TRANSMITTAL OF SUBSTITUTE APPEAL BRIEF**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Sir:

This Substitute Appeal Brief is being filed in response to a Notice by Angela Campbell that Applicant's previous Appeal Brief exceed the maximum allowed page limitation. In fact, the previous brief was well under the page limit, but included an attached Exhibit, which apparently was mistaken as comprising part of the brief itself.

The undersigned attorney attempted to contact Ms. Campbell by phone to discuss this issue, and left a voice message for Ms. Campbell. Unfortunately, Ms. Campbell has not returned this message, so the undersigned is proceeding by filing the accompanying

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Substitute Appeal Brief. The Substitute Appeal Brief merely removes reference to the attachment to the original Appeal Brief. In substance, however, no changes have been made.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Daniel R. McClure", written over a horizontal line.

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Registration No. 38,962

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