

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: Application of Xscape Properties, Limited)	Trademark Law Office 113
Mark: XSCAPE & design)	Examining Attorney:
Serial No.: 76/114,694)	Kelly A. Choe
Filed: August 22, 2000)	
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APPLICANT'S APPEAL BRIEF

TRADEMARK TRIAL AND
APPEAL BOARD
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KANE KESSLER, P.C.
Attorneys for Applicant
1350 Avenue of the Americas
New York, NY 10019
(212) 541-6222

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APPLICANT'S APPEAL BRIEF

INTRODUCTION

Pursuant to the Notice of Appeal filed May 7, 2002, Applicant has appealed from the Examining Attorney's refusal to register the above-identified trademark. The ground for the appeal is that Applicant's mark is not likely to be confused with the cited mark ESCAPE, Registration No. 1820663 (the "Cited Mark").

FACTS

A. Procedural History

Applicant filed its application to register the mark XSCAPE and Design on the Principal Register on August 22, 2000. The Application was pursuant to Section 1(b) of the Trademark Act based on Applicant's bona fide intent to use the mark in commerce. Applicant seeks registration for the following goods: "tee-shirts, sweatshirts, polo shirts, ties, fleece jackets, shorts, sweat pants, baseball caps, wool hats, rugby shirts, scarves, gloves, socks, footwear, underwear, jumpers and headgear."

The prior Examining Attorney issued the first office action on March 1, 2001 contending that Applicant's mark was likely to be confused with the Cited Mark and suggesting the possibility of a conflict with a pending application for MY ESCAPE, serial no. 75/803038. Applicant responded to that Office Action in a Response dated August 30, 2001. The Application was then apparently transferred to another Examining Attorney and that Examining Attorney issued another office action dated November 9, 2001 in which the informality regarding the pending application was withdrawn¹ but which continued and made final the 2(d) rejection based on the Cited Mark. The second office action continues to contend that there is a likelihood of confusion. This appeal ensued.

B. The Cited Mark

The Cited Mark, Reg. No. 1,820,663, is ESCAPE for "t-shirts" in International Class 25.

C. Applicant's Intended Use of the Mark

As evidenced by the documents contained in the Record on Appeal, namely Exhibit A to the Response to Office Action dated August 30, 2001, Applicant intends to use the mark on apparel in connection with indoor entertainment centers to be created by Applicant. Exhibit A describes such indoor entertainment centers established by Applicant in the United Kingdom. As Exhibit A shows, such indoor entertainment centers will be self-contained centers including movie theaters, family entertainment centers, fitness centers, restaurants, cafes, bars and shopping areas. Applicant expects that its apparel will be distributed within, and associated closely with, such entertainment centers.

¹ Between the time of the first Office Action and the response thereto, the application that was the subject of the informality citation was abandoned.

D. Applicant's Other XSCAPE and Design Marks

Applicant is the applicant in the following other applications for the mark XSCAPE and Design: Serial Nos. 76,114,695 (Class 9; published for opposition), 76,114,945 (Class 16, published), 76,114,937 (Class 21; published for opposition), 76,114,944 (Class 24; allowed), 76,113,839 (Class 32, published), 76,114,693 (Class 33, approved), 76,114,280 (Class 35, allowed), 76,114,284 (Class 36, allowed), 76,114,943 (Class 41, pending); 76/115,463 (Class 18, suspended); 76/114,285 (Class 42, suspended).

SUMMARY OF ARGUMENT

1. The Examining Attorney erred in finding that the visual differences between the two marks - - namely, the design component in Applicant's mark and the different spellings of the two marks - - did not render the marks sufficiently different so as to avoid a likelihood of confusion finding. As we demonstrate below, the significant design component in Applicant's mark and the different spellings of the two marks warrant a finding of no likelihood of confusion.

2. The Examining Attorney erred in finding that the two marks are phonetic equivalents. As we demonstrate below, the two marks are not phonetic equivalents. Rather, Applicant's mark is a play on - - but is pronounced differently from - - the word "escape" comprising the Cited Mark.

3. The Examining Attorney erred in finding that the two marks evince similar commercial impressions.

4. The Examining Attorney erred in finding a likelihood of confusion given the differences in channels of distribution, which differences the Examining Attorney apparently ignored.

ARGUMENT

THE EXAMINER ERRED IN FINDING A LIKELIHOOD OF CONFUSION

Under the Trademark Act, a refusal to register grounded on likelihood of confusion requires that such confusion as to the source of the goods or services not be merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). As this Board stated in In re Massey-Ferguson Inc., 222 U.S.P.Q. 367, 368 (T.T.A.B. 1983), quoting Witco Chemical Co. v. Whitfield Chemical Co., Inc., 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969):

“We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with practicalities of the commercial world, with which trademark deals.”

Mere similarity between two marks will not alone determine likelihood of confusion. See McGregor-Doniger, Inc. v. Drizzle, Inc., 202 U.S.P.Q. 81, 89 (2d Cir. 1979). As the Court of Appeals for the Second Circuit has stated:

“First, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. ‘Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.’” (Citation omitted)

In the present situation, the possibility of confusion between Applicant’s mark XSCAPE and Design and the Cited Mark is de minimis. Likelihood of confusion does not exist here because Applicant’s Mark is not sufficiently similar in appearance to the Cited Mark, the marks do not sound alike, the marks evince different commercial impressions and the channels of distribution are different. We submit that when the relevant factors articulated in In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) are applied to this case, a finding that there is no likelihood of confusion under Section 2(d) of the Trademark Act is appropriate. We respectfully suggest that a finding of likelihood of confusion here ignores the practicalities of the commercial environment within which the respective marks are used.

I. The Visual Differences Between Applicant's Mark and the Cited Mark Warrant a Finding of No Likelihood of Confusion

A. The Two Marks Are Not Visually Similar

The Examining Attorney found in Office Action No. 2 that "the applicant's and registrant's marks are highly similar in that both marks contain the dominant wording 'Escape' or 'Xscape'". This argument is both without merit and begs the essential question.

It is not true that Applicant's mark and the cited Mark are highly similar. In fact, there are several differences between the two marks. First, Applicant's mark contains a stylized, almost italicized font. Second, Applicant's mark contains a prominent design component emphasizing, in large letter-size, the "X". Moreover, the stylized second "X" itself is a highly individual and attention-grabbing feature. It is oversized and immediately attracts the viewer's eye. The impression of Applicant's mark therefore is that the mark is really X XSCAPE.

Of course, the Cited Mark is no more than the word ESCAPE in block letters and has none of the above-mentioned features.

It is well-settled that distinctively designed lettering differentiates the marks containing those letters. See, e.g., In re Warner Communication, Inc., 189 U.S.P.Q. 157 (T.T.A.B. 1975) (no confusion likely between stylized "C" and "Q" logos); Diamond Alkali Co. v. Dundee Cement Co., 343 F. 2d 781, 145 USPQ 211 (C.C.P.A. 1965) (two stylized versions of the letter "D" deemed not confusingly similar).

Although it is true, as the Examining Attorney states, that marks *may* be confusingly similar notwithstanding the addition, deletion or substitution of letters or words, such is not the case there. Here, as demonstrated above, there is much more to differentiate the marks than the simple addition of a letter or word.

B. The Two Marks Do Not Share the Same Dominant Wording

The Examining Attorney's statement that "both marks contain the dominant wording 'Escape' or 'Xscape'" is illogical; "ESCAPE" and "XSCAPE" cannot both be the same dominant words because they are different words. We believe that the Examining Attorney's statement that both marks contain the same "dominant wording" evidences the fact that she has glossed over the material and substantial differences between the two marks in an attempt to find a likelihood of confusion.

To the extent that the Examining Attorney was attempting to state that both marks share a dominant root, namely "scape", this is also untrue. First, the "scape" root does not dominate the two "Xs" in Applicant's mark. Second, it would be inappropriate to dissect Applicant's mark and ignore the "Xs". There is substantial precedent to support the rule that potentially conflicting marks should be compared in their entirety and not dissected into component parts to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer that is important. O. & W. Thum Co. v. Dickinson, 245 F. 609 (6th Cir. 1917), cert. denied, 246 U.S. 664, 62 L.Ed. 928, 38 S.Ct. 334 (1918); Massey Junior College Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974); Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc., 834 F.2d 568, 4 U.S.P.Q. 2d 1942 (6th Cir. 1987); Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538 (1920); In re Hearst Corp., 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992) (Fed. Cir. reversed T.T.A.B. decision finding that VARGA GIRL likely to be confused with VARGAS); cf. In re Nat'l. Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) ("basic principle in determining confusion between marks is that marks must be compared in their entirety. . .").

II. Applicant's Mark and the Cited Mark are Not Phonetic Equivalents

The Examining Attorney erred in finding that the two marks are “essentially phonetic equivalents” and that the “[t]he marks in question clearly *could* be pronounced the same.” (Emphasis added) The fact of the matter is that the two marks are *not* pronounced the same and are not phonetic equivalents.

The prominence of the “Xs” in Applicant’s mark and the lack of an “E” leads to the ineluctable conclusion that Applicant’s mark is pronounced with the emphasis on the “X”. Conversely, the Cited Mark emphasizes the “S”. Contrary to the statements of the Examining Attorney, the word “escape” is not pronounced “ex-cape”. It is widely understood that the word “escape” is pronounced “ĩ-skāp” in English.² It would be unprecedented to allow an examiner’s tortured pronunciation of an established word to sustain a likelihood of confusion finding.

Courts have routinely held that marks sounding as similar or more similar to each other than the marks at issue here are not phonetic equivalents. See, e.g., National Distillers and Chemical Corp. v. William Grant & Sons, Inc., 505 F. 2d 719, 184 U.S.P.Q. 34 (C.C.P.A. 1974) (“DUVET” and “DUET” not phonetic equivalents); Coca Cola Co. v. Essential Products Co., 421 F. 2d 1374, 164 U.S.P.Q. 628 (C.C.P.A. 1970) (“COCA COLA” and “COCO LOCO” not phonetic equivalents); Lebow Bros, Inc. v. Lebole Euroconf S.p.a., 503 F. Supp. 209, 212 U.S.P.Q. 693 (E.D. Pa. 1980) (“LEBOW” and “LEBOLE” not phonetic equivalents).

² **es·cape** (ĩ-skāp); *v.* **es·caped, es·cap·ing, es·capes**; *v. intr.* To break loose from confinement; get free: *escape from jail.* *The American Heritage® Dictionary of the English Language, Fourth Edition.*

Applicant concedes that its mark is a play on the word “escape” and may in fact call to mind the word “escape”.³ However, it is well-settled that the “calling to mind” of one mark by another does not lead to likelihood of confusion. In fact, the opposite is the case. See, e.g., In re Ferrero, 479 F. 2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (“the very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, the two marks...”); American Express Co. v. Payless Cashways, Inc., 222 U.S.P.Q. 907 (T.T.A.B. 1984) (junior marks which call to mind similar marks are not likely to be confused with the senior mark).

III. The Two Marks Evince Different Commercial Impressions

The Examining Attorney erred in finding that the two marks evince the same overall commercial impression. We respectfully submit that the emphasis on the “Xs” in Applicant’s mark makes Applicant’s mark evince a very different commercial impression than the commercial impression evinced by the Cited Mark. The “X” connotes something wild, dramatic, dangerous and on the fringe. To this end, we draw the Board’s attention to the teen equivalent of the Olympics - - the “X” games - - where out of the ordinary, dangerous sports like rock climbing, bungee jumping and daredevil skateboarding are performed, or to the words “excitement” or “extraordinary”. This impression of a wild, dramatic ride is consistent with Applicant’s amusement/entertainment park theme.

On the contrary, the Cited Mark “ESCAPE” evinces a more soothing and halcyon commercial impression, like escaping to a desert island.

We submit that the commercial impressions evinced by the two marks are very different.

³ Applicant does not concede that its mark calls to mind the Cited Mark, only that its mark calls to mind the word “escape”.

IV. The Goods Covered by the Two Marks Will Travel in Different Channels of Distribution

As we state above, the goods of Applicant will be distributed in and be associated with Applicant's entertainment centers. The goods identified in the Cited Mark will not be distributed in or associated with Applicant's entertainment centers. Rather, these goods will be sold through traditional retail outlets.

Even if the two marks are closely similar in sound and sight -- - which we submit they are not - - the Federal Circuit has held that marks resembling each other in sight and sound are not confusingly similar when the goods associated with the marks travel in different channels of trade. See PC Club v. Primex Technologies, Inc., 2002 U.S. App. LEXIS 4982 (Fed. Cir. 2002) ("EMPOWER" and "ENPOWER" not confusingly similar).

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board reverse the Examining Attorney's finding of likelihood of confusion and allow this application to proceed to publication.

Respectfully submitted,

KANE KESSLER P.C.

By: 

Adam M. Cohen
Brendan P. McFeely
Attorneys for Applicant
1350 Avenue of the Americas
New York, New York 10019
(212) 541-6222

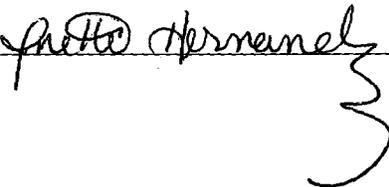
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Name: Ivette Hernandez

Signature: 

TTAB



KANE KESSLER, P.C.

1350 AVENUE OF THE AMERICAS
NEW YORK, NEW YORK 10019-4896

(212) 541-6222

FAX: (212) 245-3009

NEW JERSEY OFFICE
CONTINENTAL PLAZA
433 HACKENSACK AVENUE
HACKENSACK, N. J. 07601-6319
(201) 487-2828
FAX: (201) 487-3776

WRITER'S DIRECT NUMBER
(212) 519-5146
E-mail: acohen@KaneKessler.com

July 3, 2002

THOMAS A. KANE (1928-1977)
SIDNEY S. KESSLER (1938-1986)

DARREN S. BERGER†
ADAM M. COHEN
STEVEN E. COHEN
JEFFREY H. DAICHMAN
ERIC P. GONCHAR
ARIS HAIGIAN
MITCHELL D. HOLLANDER†
S. REID KAHN**
ROBERT L. LAWRENCE
JOSEPH NURNBERG
RONALD L. NURNBERG*
ARTHUR M. ROSENBERG†
DAVID R. ROTHFELD
JUDITH A. STOLL
JEFFREY S. TULLMAN

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ROBERT KOLODNEY
ROBERT L. SACKS
COUNSEL

ALBERT N. PROUJANSKY*
MICHAEL A. ZIMMERMAN
OF COUNSEL

JOSEPH BERGMAN
EDWARD J. BULLARD JR.
STEPHEN L. CAMPBELL
MARCUS COLAGIACOMO
GARY E. CONSTABLE†
WENDY D. FORREST
MATTHEW J. HENDERSON
NAHUM A. KIANOVSKY†
BRENDAN P. McFEELY
MICHAEL MESSI
NIKI J. SPYROPOULOS
DANA SUSMAN
LOIS M. TRAUB

ALSO ADMITTED
FLA. BAR
N.J. BAR
N.J. AND D.C. BAR
PA. BAR

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VIA EXPRESS MAIL: NO. EL673544265US

BOX TTAB - NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Appeal Brief

Dear Sir or Madam:

Enclosed please find Applicant's Appeal Brief submitted in triplicate.¹

Please telephone the undersigned if you have any questions regarding the foregoing.

Sincerely,

Adam M. Cohen

AMC/ih
Enclosures

¹If at any time a fee is required but inadvertently is not submitted (or is submitted, but is inadequate) in connection with this application, or any registration or other application resulting therefrom, and such omission or insufficiency necessarily would result in the immediate abandonment/cancellation of all or a portion of any such application/registration, without at least a 30-day period to cure said omission/deficiency, then, and in such case only, please telephone us to confirm that the PTO should debit our deposit account, number 50-0908, in order to cover the minimum fee that would be required in order to avoid any such total or partial abandonment/cancellation. Otherwise, please notify us as to any omitted or deficient fee in the normal course. The foregoing procedure is in accordance with our discussions with Cheryl Black, Esq. of the Assistant Commissioner's Office, and Ms. Polly Kemp in the PTO Deposit Accounts office.