

SEP 12 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: XSCAPE PROPERTIES LTD. : BEFORE THE
Mark: XSCAPE with design : TRADEMARK TRIAL
Serial No.: 76114694 : AND
Attorney: Adam Cohen : APPEAL BOARD
Address: Kane Kessler P.C. : ON APPEAL
1350 Avenue of the Americas
New York, NY 10019

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the trademark examining attorney's final refusal to register the proposed mark "XSCAPE" with design for "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" in International Class 25. Registration was refused pursuant to Section 2(d) of the Trademark Act because applicant's mark is likely to cause confusion with the registered mark "ESCAPE" (Registration No. 1820663¹), used in connection with "t-shirts" in International Class 25.

FACTS AND HISTORY OF THE CASE

On August 22, 2000, applicant, XSCAPE PROPERTIES LIMITED, applied for registration of the mark, XSCAPE with an "X" design element, for "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 application was filed pursuant to an intent to use basis (Trademark Act Section 1(b), 15 U.S.C. 1051(b)).

In the first office action dated March 1, 2001, the examining attorney² refused registration under Section 2(d), as well as issued a prior pending advisory³ and requested the significance of the mark.

¹ A copy of the registration record is attached for convenient reference.

² The application was initially assigned to the Examining Attorney, Brian J. Pino, who issued the first office action. The application was then reassigned to Kelly A Choe, who issued the FINAL office action.

³ The advisory was later withdrawn since the prior pending application Serial No. 75803038 was abandoned on April 7, 2001.

The applicant's response, filed August 30, 2001, indicated that there was no significance to the mark, and traversed the Section 2(d) refusal.

By Final office action dated November 9, 2001, the examining attorney withdrew the prior pending application informality, but issued a Final refusal pursuant to Section 2(d) of the Trademark Act. Following the examining attorney's final refusal, applicant filed this appeal on May 8, 2002.

ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark, XSCAPE, with an "X" design, when used on or in connection with the applicant's identified 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," is likely to cause confusion with the registered mark, ESCAPE, used on or in connection with "t-shirts."

ARGUMENT

A likelihood of confusion determination under Trademark Act Section 2(d) requires a two-step analysis:

First, the marks themselves must be examined for similarities in appearance, sound, connotation, and overall commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) ;

Second, the examining attorney must compare the goods or services to determine if they are related, or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The examining attorney's determination must be based on the application, the specimens (if any), the drawings of the marks, and the descriptions of goods or services in the application and registration. The examining attorney may consider additional factors only if relevant evidence is contained in the record. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

I. APPLICANT'S MARK, XSCAPE, WITH DESIGN, AND THE REGISTERED MARK, ESCAPE, ARE CONFUSINGLY SIMILAR AND CAST THE SAME COMMERCIAL IMPRESSION.

The marks must be compared for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). Moreover, when the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351

U.S. 973, 109 USPQ 517 (1956). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison; the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Finally, the focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark is comprised of the word, "XSCAPE," in stylized form with a stylized X design. The registered mark is "ESCAPE" in stylized form. While marks must be considered in their entireties, greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). In this case, the "XSCAPE" portion of applicant's mark is more significant in creating a commercial impression because design elements are typically less significant or less dominant.

Though the two marks in the present case are not identical, enough similarity exists between XSCAPE and ESCAPE to cause confusion. The applicant's and registrant's marks are highly similar in that the marks contain the phonetic equivalent of the word, ESCAPE. Applicant's novel spelling of its proposed mark is still pronounced ESCAPE, and still retains the same meaning and commercial connotation. As noted in the previous office action, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re*

Energy Telecommunications & Electrical Association, 222 USPQ 350 (TTAB 1983). Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963).

In this case, the applicant's wording, XSCAPE, is merely the phonetic equivalent of registrant's ESCAPE. Since applicant's "XSCAPE" wording can, and is, pronounced as "ESCAPE," the marks in question clearly could be pronounced the same. *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985); *In re Mack*, 197 USPQ 755 (TTAB 1977). The fact that a term is not found in the dictionary is not controlling on the question of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977).

Applicant's claim that its wording, XSCAPE, creates a different commercial impression is simply without merit. Rather than "calling to mind" registrant's mark, applicant's wording, XSCAPE, is pronounced ESCAPE, and intended to be pronounced as ESCAPE. Unlike the cases cited by applicant, for example, wherein the wording, DUVET, which refers to a type of linen/blanket,⁴ appears, means and creates a different commercial impression from the wording, DUET, which refers to a type of music⁵; here, the proposed mark *sounds*, and *means* the same, as well as creates the same commercial impression as registrant's mark. See also,

⁴ See enclosed definition printout.

⁵ See enclosed definition printout.

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).

Therefore, the marks are essentially phonetic equivalents.

The only real difference between the marks is the addition of the stylized “X” design element in applicant’s mark. However, the addition of a stylized letter design to a word mark does little to alter the appearance, sound, connotation and overall commercial impression, and fails to obviate the similarities of the marks.

The applicant has argued that its mark has been improperly dissected for purposes of analysis under Section 2(d). However, applicant is reminded that it is proper to find a portion of the mark “weak” and to ascribe less significance thereto when making a determination under Section 2(d). *In re National Data Corp.*, 224 USPQ 749 (CAFC 1985) and *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987). Here, the stylized “X” letter is merely a design element to the dominant word mark, as demonstrated by applicant’s own reference to itself as “XSCAPE,” rather than as X XSCAPE (or other variations incorporating the “X” design).⁶ Accordingly, potential purchasers will focus more on the wording, XSCAPE, and its phonetic equivalent, ESCAPE, when attempting to distinguish the source of the goods.

⁶ See applicant’s Exhibit A attached to its correspondence filed August 30, 2000, wherein applicant’s website refers to itself: “Q: What is Xscape?...Q: Who owns Xscape?...Based in Milton Keynes, Xscape is Europe’s coolest entertainment center...”

In fact, marks may be confusingly similar in appearance notwithstanding the addition, deletion, or substitution of letters or words. *Weiss Assoc. Inc. v. HRL Assoc.*, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992) (ORAL-ANGLE held likely to be confused with ORAL-B); *Jockey Int'l. Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (ELAAN stylized held likely to be confused with ELANCE); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986) (COMMCASH likely to be confused with COMMUNICASH); *in re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON likely to be confused with MILLTRONICS (stylized)). Therefore, applicant's claim that the substitution of the registrant's letter "E" with its "X" distinguishes its mark from registrant's mark is simply without merit, particularly since applicant's wording, XSCAPE, is the phonetic equivalent to registrant's ESCAPE

In any event, the test under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. Since applicant's proposed mark, XSCAPE, is the phonetic equivalent of the registrant's mark, ESCAPE, words that sound and mean the same, the mere addition of a design element does little to alter connotation and overall commercial impression, and fails to obviate the similarities of the marks.

Because potential consumers will not perceive the "X" design element as a source identifier, they will focus more on the wording, XSCAPE, when attempting to distinguish the source of

the goods. Furthermore, since XSCAPE is essentially the phonetic equivalent of ESCAPE, the marks, XSCAPE and ESCAPE will create the same commercial impression in the eyes of consumers, who are likely to confuse the marks as originating from the same source.

II. APPLICANT'S CLOTHING GOODS ARE IDENTICAL TO REGISTRANT'S T-SHIRTS

It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

Applicant's "tee shirts" are identical to registrant's "t-shirts."

In fact, applicant's other clothing goods, including, sweatshirts, polo shirts, ties, fleece jackets, shorts, sweat pants, baseball caps, wool hats, rugby shirts, scarves, gloves, socks, footwear, underwear, jumpers and headgear, are also highly related to registrant's, "t-shirts" in that the goods are normally marketed and sold in the same channels of trade.

Furthermore, prospective purchasers of the goods at issue are accustomed to seeing the respective goods of the applicant and registrant sold under the same mark. As a result, purchasers would mistakenly assume, upon encountering applicant's goods sold under a highly similar mark to that of the registrant, that they originated from a common source. *See In re*

Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (third party registrations may have some probative value to the extent that they may serve to suggest that such goods or services are of a type which emanate from a single source), and cases cited therein; TMEP § 1207.01(d)(iii).

Applicant has failed to refute, much less address the determination that its clothing goods are *identical* to the registrant's t-shirts.

The applicant attempts to distinguish its goods by arguing that its clothing are sold in limited trade channels. This argument is not supported by any evidence of record. The examining attorney notes that the registrant has not limited its channels of trade to any particular industry, much less to any particular niche within the clothing or retail industry. Therefore, registrant is free to offers its goods to any customer in any industry. Similarly, the applicant has not limited its channels of trade. Therefore, the applicant is also free to offers its goods to any customer in any industry, including "traditional retail outlets."⁷ The examining attorney reminds the applicant that during *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration, such as brochures or web pages from the registrant's company that seek to show that the registrant only sells its goods in certain trade channels. See, *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515 (C.C.P.A. 1970); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988).

⁷ See applicant's Appeal Brief pg. 9.

In any event, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

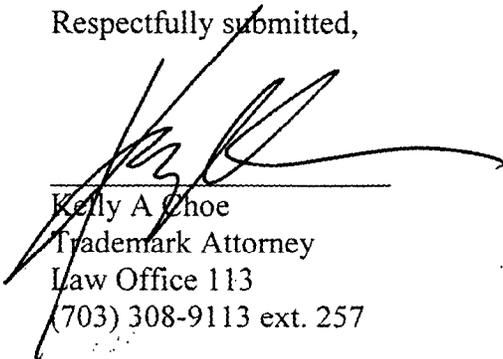
Here, the applicant's "tee shirts" and clothing goods are *identical* to registrant's "t-shirts." Accordingly, purchasers encountering both the applicant's and the registrant's shirts are likely to mistakenly believe that they emanate from a common source.

CONCLUSION

The applicant's identified goods and those of the cited registrant are clearly identical. Under Trademark Act § 2(d), any doubt must be resolved in the favor of the cited registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). Given the similarity of the marks at issue, the demonstrated relationship between the goods is more than enough to create a likelihood of confusion in the mind of the potential purchaser.

For the foregoing reasons, it is respectfully submitted that the refusal to register the proposed mark, XSCAPE with design, should be affirmed.

Respectfully submitted,



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ESCAPE

Mark

ESCAPE

Goods and Services

IC 025. US 039. G & S: T-shirts. FIRST USE: 19920500. FIRST USE IN
COMMERCE: 19920500

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number

74191089

Filing Date

August 2, 1991

Filed ITU

FILED AS ITU

Publication for Opposition Date

November 10, 1992

Registration Number

1820663

Registration Date

February 8, 1994

Owner Name and Address

(REGISTRANT) CONOPCO, INC. DBA CALVIN KLEIN COSMETICS COMPANY CORPORATION
NEW YORK Trump Tower, 725 Fifth Avenue New York NEW YORK 10022

(LAST LISTED OWNER) CALVIN KLEIN COSMETIC CORPORATION (NOTE:"COSMETIC")
CORPORATION BY ASSIGNMENT DELAWARE 501 SILVERSIDE ROAD WILMINGTON
DELAWARE 19809

Assignment Recorded

ASSIGNMENT RECORDED

Type of Mark

TRADEMARK

Register

PRINCIPAL

Affidavit Text

SECT 8 (6-YR).

Live Dead Indicator

*** User: kchoe *** Serial Number: 74191089 ***

LIVE

Attorney of Record
ROWENA S DELEON

*** Search: 1 *** Document Number: 2 ***

du·vet

du·vet (doo-vā', dyoo-) *noun*

A quilt, usually with a washable cover, that may be used in place of a bedspread and top sheet.

[French, down, from Old French, alteration of *dumet*, diminutive of *dum*, *dun*, from Old Norse *dūnn*.]

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du·et

du·et (doo-ët', dyoo-) *noun*

1. *Music.* **a.** A composition for two voices or instruments. **b.** The two performers of such a composition.
2. A pair.

[Italian *duetto*, diminutive of *duo*, from Latin, two.]

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