

6-10-04

UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Trevira GmbH	:	BEFORE THE
Trademark:	BOIACTIVE and Design	:	TRADEMARK TRIAL
Serial No:	76/294340	:	AND
Attorney:	Marilyn Matthes Brogan	:	APPEAL BOARD
Address:	FROMMER LAWRENCE & HAUG LLP 745 5 th Avenue New York, New York 10151	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Scott M. Oslick, Examining Attorney, Law Office 108
(David Shallant, Managing Attorney) for the United States
Patent and Trademark Office

The applicant has appealed the trademark examining attorney's refusal to register the trademark BIOACTIVE and Design,¹ on the ground of a likelihood of confusion with a prior registered mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052 (1999).

PROCEDURAL HISTORY

Applicant seeks to register the mark BIOACTIVE and Design, in stylized-form, for goods ultimately identified in this application as "articles of clothing, namely, jackets, coats, raincoats, wind-resistant jackets, pants, skiwear, shorts, skirts, blouses, dresses,

¹ U.S. Application Serial No. 76-294340, filed on August 2, 2001, based on Section 1(b) of the Trademark Act, 15 U.S.C. Section 1051(b).

headwear, hats, gloves, shoes, foul-weather gear, jogging suits, mufflers, coveralls, snow suits, tennis wear and underwear, excluding hosiery," in International Class 25.

On October 3, 2001, in the first Office action in this case, the Examining Attorney refused of the Applicant's mark under Section 2(d) of the Trademark Act, based on a likelihood of confusion between the Applicant's mark and the mark in U.S. Registration No. 1,229,977, for the mark BIO ACTIVE, in stylized-form, for hosiery.

On April 5, 2002, Applicant responded to this first Office action, presenting arguments in support of registration. On July 1, 2002, after considering these arguments, the Examining Attorney issued a final refusal in this case. January 6, 2003, applicant filed an amendment after final, request for reconsideration and notice of appeal. On February 3, 2004, the examining attorney accepted the applicant's amendment after final, but refused applicant's request for reconsideration, and the present appeal ensued.

ISSUE

The sole issue in the instant appeal is whether the Applicant's mark, when used on or in connection with the stated goods is likely to cause confusion with the mark in U.S. Registration No. 1,229,977.

ARGUMENT

I. *General Rules for Analysis of Section 2(d) Cases*

Section 2(d) of the Trademark Act bars registration of a mark if it "... consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when applied to the goods [or services] of the applicant, to cause confusion...." 15 U.S.C. Section 1052(d). The duty of a court is to weigh "the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). The "... ultimate question ... is whether the marks as applied to the respective goods [or services] so resemble each other that there is a reasonable likelihood of confusion as to source." *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 177 USPQ 76, 77 (CCPA 1973). Any doubt that may arise on the question of likelihood of confusion must be resolved in favor of the prior registrant and against the applicant who has a legal duty to select a mark that is totally dissimilar to marks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). See *In re Whittaker Corporation*, 200 USPQ 54 (TTAB 1978).

II. *Comparison of the Marks at Issue*

A. General Rules for Comparison of Marks

Word marks are compared using a three-prong analysis of their sound, appearance and meaning. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See *Federated Food*, 192 USPQ at 28; *In re Lamson Oil Co.*, 6 USPQ2d

1041, 1042 (TTAB 1988). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). Importantly, when an 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). 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). 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).

B. The Wording "BIOACTIVE," or "BIO ACTIVE," is the Dominant Portion of the Applicant's Mark and the Mark in the Cited Registration

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976).

In the present case, the Applicant's mark consists of the wording "BIOACTIVE" displayed inside a semi-circular thin line outside of a design featuring a circle and two semi-circular curved lines. The wording "BIOACTIVE" is the dominant portion of the applicant's mark because this is the element that potential consumers will use when calling for the applicant's goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). The mark in the

cited registration consists solely of the wording "BIO ACTIVE" in a fanciful script. This stylization, however, does not constitute a separate, or separable, "design portion" of that mark. Thus, the term wording "BIO ACTIVE" is clearly the dominant portion of the mark in the cited registration.

C. The Marks are Identical in Sound and Meaning and, thus, Highly Similar in Overall Commercial Impression

The applicant's mark and registrant's mark are identical in sound. Importantly, 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). However, the similarities between the marks are not limited to sound. Rather, the wording "BIOACTIVE" in the applicant's mark and the wording "BIO ACTIVE" in the cited registration are identical in meaning. Because the wording in a mark is dominant to the design elements, the marks are highly similar in overall commercial impression. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). These similarities render the marks as a whole confusingly similar.

III. *The Goods at Issue are Closely Related*

As previously stated, the Applicant's goods are articles of clothing, namely, jackets, coats, raincoats, wind-resistant jackets, pants, skiwear, shorts, skirts, blouses, dresses, headwear, hats, gloves, shoes, foul-weather gear, jogging suits, mufflers, coveralls, snow suits, tennis wear and underwear, excluding hosiery. Registrant's goods are hosiery. The goods at issue are closely related. Specifically, as the previously

submitted copies of third-party registrations from the Office database demonstrate, the same party routinely markets and sells various articles of clothing *and* hosiery together under the same mark.

Moreover, the cases in the clothing field have routinely found various articles of clothing to be related under Section 2(d) of the Trademark Act. Most notably, in *In re Mercedes Slacks, Ltd.*, the Board found hosiery and trousers to be related goods. 213 USPQ 397 (TTAB 1982). Applicant's goods include pants. Trousers are pants. Thus, the Board has previously recognized that applicant's goods and registrant's goods are, in fact, closely related for Section 2(d) purposes. *See also Cambridge Rubber Co. v. Chuet, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) ("WINTER CARNIVAL" for women's boots v. men's and boys' underwear); *Jockey International, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) ("ELANCE" for underwear v. "ELAAN" for neckties); *In re Melville Corp.* 18 USPQ2d 1386 (TTAB 1991) ("ESSENTIALS" for women's pants, blouses, shorts and jackets v. women's shoes); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) ("NEWPORTS" for women's shoes v. "NEWPORT" for outer shirts); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1985) ("GRANADA" for men's suits, coats, and trousers v. ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) ("SLEEX" for brassieres and girdles v. slacks for men and young men).

In support of registration, applicant argues that that the goods are not related because its goods specifically exclude hosiery and even "hosiery and clothing were both offered in the same department store, they would be sold in different and distinct departments; for example, the jackets and coats, ect. of applicant are not offered for sale

in the hosiery department of department stores.” First, the test for likelihood of confusion is not based solely on whether the articles of clothing would be sold in the same section of a department store. In fact, there are numerous specialty shops in which various articles of clothing are sold in close proximity to each other. Second, while jackets and coats may not be sold in the hosiery department of department stores, underwear and hosiery certainly *are* sold in the same department of department stores. Applicant’s identification of goods includes hosiery. Similarly, shoes and hosiery are frequently sold in close proximity to each other in a department store. Applicant’s goods include shoes. Third, and more importantly, as the aforementioned cases clearly demonstrate, various articles of clothing, including those marketed and sold by the applicant and registrant are related for Section 2(d) purposes. Thus, the goods at issue in the present case are closely related.

Moreover, the examining attorney notes that if the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698 (Fed. Cir. 1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECL Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b). In the present case, not only are the goods at issue closely related; the marks are identical in sound and meaning, and highly similar in overall commercial impression. Thus a likelihood of confusion exists in the present case.

III. *The Third Party Registrations Noted By Applicant are of No Probative Value*

In support of registration, applicant notes the existence of "various third-party marks which contain the formatives 'bio' and/or 'active,' or the like." However, in order to make these third party registrations of record during *ex parte* examination, soft copies of the registrations or even photocopies of the appropriate U.S. Patent and Trademark Office electronic printouts must be submitted. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Applicant has submitted no such copies. Thus, these third-party registrations are not properly of record. Moreover, the Board is respectfully requested to refrain from considering these third-party registrations because, to the extent the reference may be considered evidence at all, it is untimely. The examining attorney objects to their consideration. *See In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974)

CONCLUSION

The Applicant's mark is highly similar in sound, meaning and overall commercial impression to the marks in the cited registrations. The Applicant's goods and the Registrant's goods are, for all intents and purposes, at least virtually identical in nature. As a result of these similarities, a likelihood of confusion exists. Therefore, the Board is respectfully requested to affirm the refusal to register that issued under Section 2(d) of the Trademark Act.

Respectfully submitted,



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