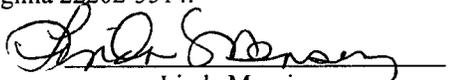


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Linda Mensinger

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

In re Application of:

Applicant: The Wet Seal, Inc.

Serial No.: 76/338,469

Filed: November 14, 2001

Mark: **SEAL**

Classes: 3, 18, 21

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**APPLICANT'S REPLY BRIEF**

This is Applicant's reply to the Examining Attorney's Appeal Brief, mailed December 19, 2003, in connection with the above-referenced application.

The Examining Attorney has refused Applicant's application to register its mark **SEAL** ("Applicant's mark") for goods in Classes 3, 18 and 21. The stated ground for this refusal is that Applicant's mark so resembles seven other registrations for variations of the mark "SEAL" ("Cited Registrations"), that confusion or mistake will result. In particular, the Cited Registrations are as follows:

1. **HYDROSEAL**, U.S. Registration No. 2,528,395, for “*non-medicated moisturizing component as used in ingredient complex in fragrance and toiletry products, namely, foam bath, shower gel, body lotion, fragrance, spray, hand cream, moisturizing gel, exfoliating body scrub*” in Class 3.
2. **SEALSKIN**, U.S. Registration No. 782,185, for “*preparation for filling the skin pores with an innocuous material to keep out certain irritants*” in Class 3.
3. **HEAT SEAL**, U.S. Registration No. 2,424,116, for “*hair care products, namely, conditioners, gels, and sprays*” in Class 3.
4. **SILKEN SEAL**, U.S. Registration No. 1,680,023, for “*hair care preparations, namely, shampoos, conditioners, styling gels, hair sprays and hair glossers*” in Class 3.
5. **SEAL ‘N PROTECT**, U.S. Registration No. 1,216,213, for “*hair conditioners*” in Class 3.
6. **SEAL PAK**, U.S. Registration No. 1,749,402, for “*fanny packs, hip packs and waist packs*” in Class 18.
7. **SEALCO**, U.S. Registration No. 1,884,104, for “*mail order services in the field of luggage*” in Class 42.

The Trademark Examiner argues that two of the Dupont factors should control this case: (a) the similarities of the marks and (b) the similarities of the goods. See In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

There are, of course, certain similarities between the marks and the goods offered under the Cited Registrations and those offered under Applicant’s mark, but the *dissimilarities* far outweigh those similarities. Moreover, other important factors—the differences in the established trade channels, the sophistication of the consumer, and the

fact that **SEAL** is a house mark—are equally, if not more, important in determining whether there is a of likelihood of confusion in this case.

### **Differences in the Marks**

The Trademark Examiner argues that “SEAL” is the dominating element in each of the Cited Registrations because each of the additional terms—“HYDRO,” “SKIN,” “HEAT,” “SILKEN,” “N PROTECT,” “PAK” and “CO”—have either been disclaimed or are descriptive. But this does not automatically make “SEAL” the dominant portion of the Cited Registrations. For example, in the marks **HYDROSEAL**, **SEALSKIN** and **SILKEN SEAL**, the terms “HYDRO,” “SEAL,” and “SILKEN” are more prominent than the term “SEAL.” In the remaining marks, the other element is at least as prominent as the term “SEAL.”

Moreover, the fact that the other elements in these marks are descriptive is of little significance when the term “SEAL” is *also* used in a descriptive manner—as appears to be the case in each of the Cited Registrations. When all of the elements of a mark are descriptive, no single element should be automatically be considered dominant.

The descriptive use of “SEAL” in the cited registrations should be contrasted with the *non-descriptive* use proposed by applicant. Consumers know they are not purchasing cosmetics or handbags made from seal parts when they purchase applicant’s goods. They know that Applicant’s goods are not intended to be used to seal leaks, or seal skin pores, or seal additives into strands of hair, or seal luggage from outside elements. Applicant’s mark is a common word that is used in an uncommon way to describe a product that has no apparent tie to the mark. Like “**APPLE**” for computers or “**AMAZON**” for bookselling, Applicant’s **SEAL** mark is a strong mark—indeed, stronger than the cited marks as a source identifier—and is unlikely to be confused with any of them.

### **Commercial Impression**

The Examining Attorney also argues that the marks would create the same overall impression for the average consumer who might encounter Applicant's mark and Registrants' mark in different locations. The term "SEAL" is a common word, however, not an obscure one. As noted above, it *can* be used in a descriptive sense. If the mark was fanciful, this argument might be better received, but because "SEAL" is a word that is encountered in everyday life, the average consumer would not likely believe that every use of the term emanates from the same source, even if used on the similar goods. One simply cannot conclude that every use of "SEAL" would necessarily create the same impression for the average consumer.

### **House Mark**

The Examining Attorney argues that this is not a "traditional" likelihood of confusion determination with respect to a house mark. The argument is that because Applicant is removing "WET," as opposed to adding a term, reverse confusion becomes a factor. Applicant respectfully disagrees.

Reverse confusion is not a factor here because Applicant is a prominent—indeed famous—retailer who has been using the term "SEAL" for *forty* years in connection with its stores. Consumers will not suddenly assume that every mark containing the term "SEAL" is a Wet Seal mark merely because Applicant begins using the mark with cosmetics or handbags that will be sold in its stores.

Moreover, the two reverse confusion cases cited by the Examiner are not directly pertinent in this case because they refer to marks that are identical, not marks that merely share one common term. (Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947 (23 USPQ2d 1001)(7<sup>th</sup> Cir. 1992) and Banff Ltd. v. Federated Dep't Stores, Inc., 841 F.2d 486 (6USPQ2d 1187) (2d Cir. 1988)).

### **Sophisticated Consumers**

The Examiner also believes that the situation in Faberge, Inc. V. Dr. Babor GmbH & Co., 219 USPQ 848 (TTAB 1983) is distinguishable from the present case because the marks are so distinct. The Examiner, however, misses the point Applicant attempted to make in citing these cases. Most purchasers of cosmetics take care to purchase from specific companies that they prefer. The consumers of Applicant's goods and services are adolescent girls, who are focused on their appearance and what their peers are buying. The clothing store, Wet Seal, is well known among this age group, and the teenagers well understand when they are buying something from Wet Seal. Therefore, they are "sophisticated" with respect to their fashion and cosmetic purchases. Of course, being sophisticated does not mean that a person is immune from source confusion, but it is a factor to be considered when determining likelihood of confusion. When all of the relevant Dupont factors are considered, it is doubtful a consumer would ever confuse a Wet Seal product with one found in a grocery store, for example, just because they share the term "SEAL."

### **Relatedness of Goods**

The Examining Attorney argues that all of the goods are related and that because there are no limitations in some instance as to nature, type and class of purchasers, we must assume they encompass all of the goods and potential purchasers. Nevertheless, even though goods may be related, they are not necessarily likely to be confused.

For example, the Examiner states that "handbags" is defined as a "traveling bag" in the dictionary. In this definition, "traveling" clearly does not refer to going on vacation or a business trip. Traveling refers to traveling from home to school to the grocery store to the mall, etc. As everybody knows, women carry purses, or "handbags" everyday and they are not akin to luggage used for actual travel. In reality, these products are used in connection with two entirely distinct realms of life.

The Examiner uses the case In re AMBA Marketing Systems, Inc., 218 USPQ 958 (TTAB 1983) to support his position that handbags and luggage are related. In this case however, the luggage was a small piece of hand luggage. Moreover, the mark at issue, **LIFESTYLE**, was a wholly arbitrary term with respect to both parties goods. This is much different from the present case, where the Registrants' are using their marks in descriptive ways, and therefore are entitled to a more limited scope of protection.

In support of his contention that services and goods are related, the Examiner notes the case In re Hyper Shoppes (Ohio), Inc., 6 USPQ2d at 1025. The Applicant understands that services and goods can be related, but other factors dominated in the Hyper Shoppes case. Unlike the present case, the marks at issue in Hyper Shoppes were identical (both for a variation of BIGGS), and were completely arbitrary.

Even though goods may be related, it should not automatically be concluded that confusion will result. "Related goods are those products which would be reasonably thought by the buying public to come from the same source if sold under the same mark" AMF, Inc. v. Sleekcraft Boats, 599 F2d 341 (9<sup>th</sup> Cir. 1979). So even if goods are related on some level, the question to be asked is whether consumers believe they come from the same source. When the totality of the facts discussed above are considered, we believe the answer is an emphatic "No!"

A consumer in a Wet Seal store is not likely to believe that a product bearing the **SEAL** mark is from the same company as a product bearing any of the marks of the Cited Registrations. Nor will grocery store shoppers, beauty store shoppers, or on-line luggage shoppers be likely to conclude that the products offered under the cited registrations emanate from Wet Seal.

**CONCLUSION**

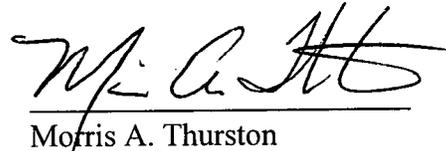
Applicant respectfully submits that the Cited Registrations discussed above are not confusingly similar to Applicant's SEAL mark and that they should be removed as a bar to registration of Applicant's Mark. Many factors play a role in the distinction between Applicant's mark and Registrants' marks, and Applicant asks the Board to recognize the importance of all of these differences. Consideration of the Dupont factors in their entirety, as discussed in Applicant's Opening and Reply Briefs, weighs heavily in Applicant's favor.

In view of the foregoing, Applicant submits that the refusal to register its proposed mark should be reversed and that its application should be passed to publication.

Respectfully submitted,  
LATHAM & WATKINS LLP

Dated: February 9, 2004

By:



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February 9, 2004

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Re: Ex Parte Appeal In re Wet Seal, Inc., The  
Serial No.: 76/338,469

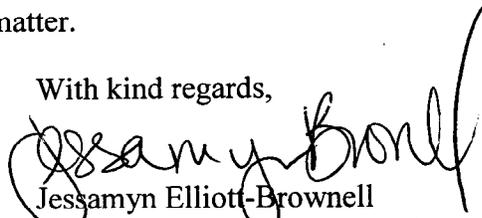
Dear Sir or Madam:

Enclosed for filing are the following documents to be filed in connection with the above-referenced appeal:

1. A Reply Brief; and
2. A stamped, self-addressed postcard to acknowledge receipt.

Thank you for your assistance in this matter.

With kind regards,

  
Jessamyn Elliott-Brownell  
Intellectual Property Paralegal

Enclosures

cc: Karen Miyakawa, Docketing

