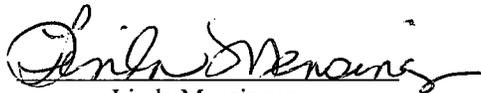


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Linda Mensinger

**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


09-22-2003
U.S. Patent & TMO/TM Mail Rpt. Dt. #40

APPLICANT'S APPEAL BRIEF

The Examining Attorney has refused to grant registration to Applicant's **SEAL** mark ("Applicant's Mark") in Classes 3, 18 and 21, citing the existence of several marks, namely, **HYDROSEAL, HEAT SEAL, SILKEN SEAL, SEAL 'N PROTECT, SEALSKIN, SEAL PAK, and SEALCO.**

Pursuant to Section 1203.02(a) of the TBMP, Applicant files this brief in support of its Notice of Appeal against the final refusal to register its mark **SEAL** in connection with goods identified in Class 3, 18 and 21.

FACTUAL BACKGROUND

On November 14, 2001, Applicant filed an application for its mark **SEAL** in connection with the following, now amended description of goods:

“Cosmetics, mascara, eye liners, eye brow pencils, eye shadow, artificial eyelashes, face powder, dusting powder, powder compacts containing make-up, rouge, liquid rouge, foundation, concealer, lipstick, lip liner, lip gloss and makeup remover; nail polish, nail polish remover, cuticle softener and cuticle cream; colognes, perfumes and toilet waters; toothpaste, mouthwash and tooth gel; sun screen, sun block and suntanning preparations; antiperspirants, deodorants; aftershave lotions, shaving lotions and cream, shaving foam, after-shave balm, astringents, skin toner and skin tonic; body, hand and face lotions and creams; skin cleansers, soaps, bubble bath, toilet soap, bath and shower gels, bath oils, bath salts, bath crystals, body powders and talc, body spray and essential oils for personal use, in Class 3;

Handbags, purses, backpacks, briefcases, cosmetic bags and toiletry cases sold empty, vanity cases sold empty, wallets and change purses in Class 18; and

Cosmetic accessories, namely, cosmetic brushes, facial sponges for applying make-up and applicators for applying make-up; hair brushes, in Class 21.”

On March 18, 2002, the Examining Attorney issued an office action refusing to register Applicant's SEAL mark because he believed it would be confused with the seven marks mentioned above. In its response filed August 22, 2002, Applicant pointed out that there is no likelihood of confusion because the marks themselves are significantly different and there is no overlap in the channels of trade as all of Applicant's goods are sold exclusively through its retail stores.

On September 27, 2002, the Examining Attorney issued a final office action maintaining his refusal of Applicant's mark based on likelihood of confusion. On March 21, 2003, Applicant filed a Request for Reconsideration of Final Refusal and a Notice of Appeal with the Trademark Office appealing the Examiner's decision. On July 18, 2003, the Examining Attorney denied the Request for Reconsideration.

ARGUMENT

The Examining Attorney has refused Wet Seal's application to register its mark SEAL ("Applicant's mark") for goods in Classes 3, 18 and 21. The stated ground for this final 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.

Applicant respectfully disagrees that its mark is confusingly similar to the above-identified Cited Registrations and therefore seeks reprieve from the Trademark Trial and Appeal Board.

The Trademark Office recognizes that registration of a mark should not be refused merely because other similar or identical marks exist. Rather, such a refusal should issue only where similar or identical marks create a likelihood of confusion or mistake on the part of the purchasing public. T.M.E.P. 1207.01. In determining whether a likelihood of confusion exists, a number of factors must be considered. In addition to the marks themselves, which must be examined for similarities in appearance, sound, connotation and commercial impression, other factors that must be considered include differences in the goods and services, differences in the

established trade channels, the sophistication of the consumer, and whether the mark is a house mark. In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

A close examination of each of these elements shows that Applicant's mark is distinct from the Cited Registrations. As explained more fully below, the following factors all weigh heavily in Applicant's favor: (1) the marks as a whole are distinguishable, (2) the goods and services are distinguishable, (3) the channels of trade are different, (4) the consumers are sophisticated and thus would not be confused, and (5) Applicant owns a family of "SEAL" marks and, thus, the subject mark is an abbreviation of its house mark.

(1) Applicant's mark and the Cited Registrations are distinct.

Consumers do not generally conclude that goods and services emanate from a single source based solely on common terms. "The use of identical, even dominant, words in common does not automatically mean that two marks are similar . . . Rather, in analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features." See, e.g., General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 627, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987).

Applicant acknowledges, of course, that the marks at issue all contain the term "SEAL," and thus have some sort of visual and aural similarities. Applicant believes, however, that the overall differences in the marks render them unique from each other. According to Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272 (CCPA 1974), marks must be considered in their entireties. When this is done, it is clear that each of the marks are distinct from one another.

Although Applicant's mark is wholly encompassed in each of the Cited Registrations, when the marks are considered separately and as a whole, the additional aspects of each of Registrants' marks renders them unique from Applicant's mark SEAL. The Cited Registrations appear to use "SEAL" to indicate a property of its product, thus each of the marks have a distinct commercial impression. For example, **HYDROSEAL** refers to sealing in hydrogen, **HEAT SEAL** seals in heat, **SILKEN SEAL** seals in a silky feel, **SEAL 'N PROTECT**

seals in the hair conditioner, **SEALSKIN** gives the impression of creating skin that looks smooth, and **SEAL PAK** alludes to leather products.

Thus, each of the additional terms in Registrants' Marks results in a unique commercial impression for each of these uses. The mark **SEAL** by the Applicant creates no such impressions. It refers to clothing, shoes, accessories, etc. that are produced by the well-known company The Wet Seal, Inc., and consumers of The Wet Seal, Inc. recognize that **SEAL** is used as an abbreviated version of its name.

Case law supports Applicant's position that confusion is not automatic simply because a mark is wholly encompassed in another's mark. In In re The Hearst Corporation, 982 F.2d 493, 25 U.S.P.Q. 2D 1238 (Fed Cir. 1992), the Patent and Trademark Office and the Trademark Trial and Appeal Board refused registration of Hearst's trademark **VARGA GIRL** citing the prior registration for **VARGA**, both used in connection with calendars and the like. The Federal Circuit, however, reversed the TTAB's decision and allowed Hearst to register **VARGA GIRL**. Although the TTAB stated that "varga" was the dominant element and that "girl" was merely descriptive, the Federal Circuit disagreed, citing In re National Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (...marks must be considered in the way they are used and perceived). Moreover, marks must be considered in their entireties, and all components thereof must be given appropriate weight. See Opryland USA Inc. v. Great American Music Show, Inc., 970 F. 2d 847, 23 U.S.P.Q. 2d 1471 (Fed. Cir. 1992). Thus, in In re The Hearst Corporation, the Federal Circuit found that the overall impression of **VARGA GIRL** derived significant contribution from the component "girl" and "when GIRL is given fair weight, along with VARGA, confusion with **VARGA** becomes less likely." Likewise, each of the Cited Registrations derive significant contribution from the additional terms, creating a unique overall impression. Thus, confusion with **SEAL** is less likely.

Another case that supports the position that an additional word can distinguish marks that are otherwise identical is Dakota Industries Inc. v. Dayton Hudson Corp., 60 U.S.P.Q. 2d 1590 (DC SD 2001). In this case, the marks at issue were **DAKOTA** and **DAKOTA BLUE**

versus **DAKOTA BLUES** used in connection with blue jeans. No likelihood of confusion was found and at page 1594, the court stated that “[t]he similarities between ‘Dakota’ and ‘Dakota Blue’ are not significant.” Thus, it should be concluded that the similarities between **SEAL** and the other “seal”-containing marks are not significant.

Similarly, in Jet, Inc. v. Sewage Aeration Systems, 165 F. 3d 419, 49 U.S.P.Q.2D 1355 (6th Cir. 1999), it was decided that **AEROB-A-JET** was not confusingly similar to **JET**, despite being used on nearly identical goods. The determination was based, in part, on the fact that when the marks are considered as a whole, they are visually and aurally distinct. The Court stated:

Although examination of the components of each mark may be helpful, the determination of similarity is made on the basis of the marks in their entirety. We have endorsed the ‘anti-dissection rule,’ which serves to remind courts not to focus only on the prominent features of the mark, or only on those features that are prominent for purposes of the litigation, but on the mark in its totality... Both **AEROB** and **JET** are somewhat descriptive of how the parties’ devices operate, but neither is generic or merely descriptive of the process. Considering the impression made by the marks as a whole, **JET** and **AEROB-A-JET** are not confusingly similar.

In the present case, when the “anti-dissection rule” is followed, it is realized that the marks are not confusingly similar. Each of the Cited Registrations has at least two or more syllables, to Applicant’s one syllable. Moreover, when the marks are pronounced, terms such as “hydro,” “silken” and “n’ protect” are prominent and clearly differentiate these marks from simply **SEAL**.

Two other supporting cases include General Time Corp. v. General Dynamics Corp., 141 U.S.P.Q. 746 (T.T.A.B. 1964) and Wagner Electric Corp. v. Raygo Wagner, Inc., 192 U.S.P.Q. 33 (T.T.A.B. 1976). In General Time, the Board decided that there was no likelihood of confusion between the marks **STROMBERG** and **STROMBERG-CARLSON**. In that case, the Board performed the following analysis at page 749:

Here, the compound mark sought to be registered includes more than just the name “**STROMBERG**” and even a casual glance at the mark as reproduced above indicates that the name is but an integral part of the whole mark. In no way does

the name “**STROMBERG**” dominate the composite mark. It is axiomatic that a trademark is to be considered in its entirety in determining the question of likelihood of confusion.

Likewise, in Wagner Electric, the Board rejected an opposition brought by the owner of the trademark **WAGNER** against an application for the mark **RAYGO WAGNER**. The Board considered the fact that “WAGNER” is a common surname: “First use as a trademark of a specific name does not, by and of itself, give first user the right to prevent subsequent fair use of same name by others.” *Id.* at 43.

Moreover, it is not uncommon for two marks on the Principal Register to have a term in common where the remaining portion of the mark renders that mark distinctive from the other mark. For instance, the mark **SUBURBANS** (Reg. 1,703,429) was on the Principal Register for “*women’s clothing, including shirts,*” peacefully co-existing with the mark **SUBURBAN CLASSICS** (Reg. No. 1,088,214) for “*men’s, boys’, girls’, and women’s shirts,*” and the mark **SUBURBAN MISS** (Reg. No. 640,377) for “*suits with blouses.*” Although all three marks are now expired or cancelled under Section 8, all were considered distinguishable and co-existed on the Trademark Register despite the nearly identical goods and dominant “SUBURBAN” term.

Each of the cases mentioned represent marks in a format similar to those in the subject case, and no likelihood of confusion was found to exist. Thus, Applicant’s mark for **SEAL** should be deemed distinguishable from Registrants’ Marks incorporating the term “SEAL,” based on the differences visually and aurally, as well as the different commercial impressions created by the marks.

(2) The goods and services are distinct.

Applicant is seeking registration for a variety of products, including cosmetics, lotions, bath products, purses and the like, and cosmetic accessories. While some of the identified goods of the cited marks overlap with the Applicant’s use, others do not. For example, the marks **HEAT SEAL**, **SILKEN SEAL**, and **SEAL ‘N PROTECT** are all registered for a variety of hair care products. Applicant is not seeking protection for hair care products. This disparity

in the covered goods, combined with the overall differences in the marks, results in no confusion among the consumer.

Moreover, Applicant intends to use the mark SEAL on purses, handbags, etc., but it not interested in using it on luggage. The mark SEALCO is registered for *mail order service in the field of luggage*. This mark is owned by a well-known and established company, Skyway Luggage. Applicant is also a well-known and established company. Since these are both well-known companies in distinct fields, it is highly unlikely that a consumer will believe Applicant's use of the mark SEAL on purses is related to Skyway Luggage's use of SEALCO on *mail order services* for luggage.

Case authority supports the proposition that even though goods and services may be in the same *general* category, it does not automatically follow that they are related. In Electronic Data Systems Corp. v. EDSA Micro Corp., 23 U.S.P.Q. 2d 1460, 1463 (T.T.A.B. 1992), the court held that the issue of whether two products are related does not revolve around the question of whether a term can be used that describes them both, or whether they can be classified in the same general category. Likewise, we respectfully suggest that while Applicant's and the Registrants' goods and services are both connected to the toiletries or luggage industries, they are nevertheless sufficiently distinct to co-exist without confusion.

(3) The respective channels of trade are different.

The products sold by the Applicant and the goods offered by the owners of the Cited Registrations are not likely ever to be sold in the same channels of trade. While some of the goods may be similar, Applicant markets and sells its product solely in its self-named stores. Applicant owns almost 500 stores under the name of "WET SEAL." These stores are marketed towards teenage girls only, and sell products like clothing, makeup, purses and hair accessories. The Registrants' goods and services, on the other hand, will never be sold in Applicant's stores or its web site.

Because the channels of trade are distinct, buyer confusion as to the source of the goods is prevented. See Jeanne-Marc Inc. v. Cluett, Peabody & Co., 221 U.S.P.Q. 58, 61

(T.T.A.B. 1984). There is far less likelihood of confusion where the trade channels do not lead to the same target purchasers. Leathersmith of London v. Alleyn, 695 F.2d 27, 30, 220 U.S.P.Q. 204, 206 (1st Cir. 1982) (This absence of convergent marketing channels or of competition serves to decrease the likelihood of confusion.)

Further supporting Applicant's position is the case Local Trademarks, Inc. v. Handy Boys, Inc., 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990). In Local Trademarks, the courts held that the Applicant's mark **LITTLE PLUMBER** for liquid drain opener sold to consumers would not likely cause confusion with opposer's mark, **LITTLE PLUMBER & DESIGN**, for advertising services for professional plumbing services. The court reasoned that because the goods and services were sold through different channels of trade, there was no likelihood of confusion. *Id.* at 1156.

Again, Applicant's goods are restricted to a narrow channel of trade in that the goods are sold exclusively through Applicant's retail clothing and accessories stores. Applicant's goods are not sold independently or through any other channels of trade, including via third party retail outlets. Therefore, there is no chance that its goods could overlap the channels of trade for the Registrants' goods.

(4) The consumers of the goods and services are discriminating and sophisticated.

The consumers of Applicant's goods and services are young 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 recognize when they are buying something from Wet Seal. Thus, they are sophisticated in their purchases and would not be confused that the **HYDROSEAL** product or other Registrants' products are the same as Applicant's products sold under the **SEAL** mark.

The TTAB has even decided that purchases of cosmetics are sophisticated and discriminating. In Faberge, Inc. v. Dr. Babor GmbH & Co., 219 U.S.P.Q. 848 (T.T.A.B. 1983) the court stated "we believe that most purchasers of cosmetics, which are to be used for

cleanliness and the enhancement of one's appearance, are aware of the products in this line which they prefer and the companies from which those products emanate. We are therefore of the opinion that purchasers of cosmetic products would have no difficulty in distinguishing between the well-known, easily recognized word 'BABE' and applicant's unfamiliar 'BABOR.'"

Likewise, the purchasers of products under Applicant's SEAL mark, easily recognized because of the store name, will have no difficulty in distinguishing it from Registrants' "SEAL"-type marks. Thus, it is unlikely that the purchasers of Applicant's and Registrants' products would be confused as to the source of the products.

(5) Applicant's mark is an abbreviation of its house mark and Applicant is the owner of a family of "SEAL" marks.

Applicant's mark SEAL is a portion of its company name. The company and the mark WET SEAL have been around since 1962 and, as mentioned, Applicant owns over 500 stores under this name. Thus, the term SEAL is naturally an important mark to Applicant as it represents its entire company. Wet Seal owns a family of "SEAL" marks, as follows:

- WET SEAL (Registration No. 1,508,250);
- WET SEAL (Registration No. 2,241,292);
- SEAL PUPS (Allowed Application No. 76/272,525);
- SEAL MAGAZINE (Allowed Application No. 78/108,060); and
- SEAL (Allowed Application No. 78/107,987).

Applicant asks the Appeal Board to take into account that SEAL is part of its company name. The Applicant has at least an equal, if not greater, presence on the Trademark Register than the Registrants. Obviously, Wet Seal has no desire for its mark to be confused with the Cited Registrations and will naturally go to lengths to make certain its name is understood to be distinct. This is certainly not a case where the Applicant is seeking to capitalize on the fame or reputation of Registrant's mark.

Consumers of Applicant's store recognize Applicant's family of marks and thus, will not be confused into believing that its SEAL products are associated with the Registrant's products. Consumer's recognize that the Applicant is using its mark as an abbreviation of its company name.

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. Applicant has demonstrated that the marks are significantly different, that the goods are marketed to different consumers and that Applicant has created a family of similar marks. Consideration of all of these factors 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: September 19, 2003

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