

TTAB

P-3716-20

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: Elegant Headwear Co., Inc.
MARK: ONE SIZE FITS ALL MAGIC STRETCH GLOVES in special form
SERIAL NO.: 76/605,639
FILED: August 4, 2004
EXAMINER Rebecca L. Gilbert, Trademark Attorney, Law Office 113

NOTICE OF APPEAL AND APPEAL BRIEF

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

NOTICE OF APPEAL

Appellant appeals the final rejection of July 25, 2005, and requests that the appeal fee of \$100 be charged to Deposit Account 01-1174.

A duplicate copy of this cover sheet is provided to facilitate making the charge to the Deposit Account.

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U.S. Patent & TMOtc/TM Mail Rcpt Dt. #64

BRIEF OF APPELLANT

FACTS

Appellant seeks registration of the mark in special form as reproduced below for "children's ambidextrous gloves."



Registration was refused initially based on Registration 2640780 of MAGICFIT used on men's, women's and children's clothing (not including gloves) and on Registration 2090700 of MAGIC GLOVE used on "fashion gloves for youths," but the rejection based on the '780 Registration was withdrawn, and that based on the '700 Registration was maintained and made final.

The rationale of the examining attorney is apparently that the common word MAGIC in the '780 Registration is not a source of consumer confusion, but is in the '700 Registration. This rationale is apparently also buttressed by the difference in goods, wherein the '780 Registration

does not include gloves, but the '700 registration does, although circumscribed to "fashion gloves for youths" (underlining added).

The examining attorney also insists that appellant make a restrictive disclaimer of the word 'STRETCH,' all to the obvious end of affording the examining attorney to argue, as she does, that "Magic Gloves" is the dominant portion of appellant's mark and is identical to the mark of the '700 Registration.

Issue

Dispositive of whether the Sect. 2(d) rejection is meritorious, the examining attorney must first get past the issue placed in contention between counsel, that the disclaimer of STRETCH is imperative.

Appellant argues otherwise.

Argument

Appellant's goods are "gloves," but with the curious restriction of being "ambidextrous." Moreover the "ambidextrous gloves" are covered by patent 6,895,599, made of record in the file wrapper which was prefaced by the statement "Applicant makes of record a full copy of Patent 6,895,599 referred to in the reply of 07-18-2005" and "As noted, the '599 patent is for a glove as follows," and what followed, for the Board's convenient reference is quoted below:

"A glove of stretch construction material so that one size fits all, in which the stretch is used to advantage for its utility to adjust for the discrepancy between the natural and glove construction position of the thumb and the glove is therefore ambidextrous, so the glove used as a pair has four displays, in which an inside color surface is one, an outside contrasting color surface is two, and contrasting colors on one hand and then on the other hand are three and four, the change of the color surfaces being achieved by turning the glove inside out."

Thus it is the stretch which renders the glove “ambidextrous” and neither the glove nor the manner in which the stretch is used to provide this unique, patented feature is common in the trade. Moreover, as to this unique, patented feature, applicant claims the exclusive right to use, and argues that disclaimer is not required by TMEP 1213 which in pertinent part provides:

“In a trademark application or registration, a disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark” (underlining added).

The examining attorney argues that “...stretch is a descriptive term and not the dominant feature of applicant’s mark. As to the disclaimer, whether or not the physical feature is patented, the words in the trademark are descriptive.”

Appellant argues otherwise that because the goods are patented ambidextrous gloves, they are outside the scope of the requirement of a disclaimer.

In RANDOMHOUSE WEBSTER’S College Dictionary, it is instructive to note the definitions of the words often applied to evidence, which in this case would be the appellant’s mark in special form, namely, the words “intrinsic” and “extrinsic.” The word “intrinsic” is defined as “belonging to a thing by its very nature,” and that of “extrinsic” being, operating or “coming from without.”

It appears that the Examining Attorney has improperly assessed appellant’s mark as intrinsic evidence, whereas as extrinsic evidence and factoring in its application to patented goods, it should have been deemed acceptable for meeting the proof burden of distinctiveness, and being registered without disclaimer.

Turning now to whether the marks in issue give rise to a likelihood of confusion, in any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. *Federated Foods, Inc. v. Fort Howard paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.

1. The goods are “children’s ambidextrous gloves” (appellant) and “fashion gloves for youths” (registrant).

Appellant relies on TMEP 1207.01(a)(i) which, in pertinent part, provides:

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.” (Citing *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990), *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986).

Appellant’s position is that on the record, it has not been established that the respective goods are marketed in a way that they would be encountered in a situation that would create the incorrect assumption that they originate from the same source (underlining added).

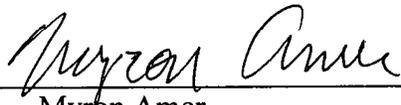
2. The marks in issue are the content of the special form drawing (appellant) and “Magic Glove” (Registrant).

The dominant portion of appellant's mark is the word STRETCH and not "Magic."

For the foregoing reasons the Section 2d) rejection should be overruled.

Respectfully,

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Dated: October 27, 2005