

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/605639

APPLICANT: ELEGANT HEADWEAR CO., INC.

CORRESPONDENT ADDRESS: MYRON AMER MYRON AMER, P.C. 114 OLD COUNTRY RD STE 310 MINEOLA NY 11501-4410

12/21/06 [Redacted] BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

MARK: ONE SIZE FITS ALL MAGIC STRETCH GLOVES S ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

- 1. Filing date, serial number, mark and applicant's name. 2. Date of this Office Action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant filed the instant application Serial No. 76/605639 on August 4, 2004 to register a mark featuring the wording MAGIC STRETCH GLOVES surrounded by the additional wording ONE SIZE FITS ALL and STRETCHES TO ALL SIZES FOR A SUPER FIT for "children's gloves." Applicant has since amended the identification of goods to "children's ambidextrous gloves." The examining attorney has denied reconsideration of (1) her final requirement for a disclaimer of ONE SIZE FITS ALL and STRETCH GLOVES and STRETCHES TO ALL SIZES FOR A SUPER FIT; and (2) her final refusal to register applicant's mark under Trademark Act Section 2(d) on the grounds that the applied-for mark so resembles the mark in Registration No. 2,090,700 (MAGIC GLOVE for "fashion gloves for youths") as to result in a likelihood of confusion among consumers as to the source of the identified goods.

ARGUMENT

I. The term STRETCH is descriptive of a feature of applicant's children's ambidextrous gloves, and

applicant must provide a disclaimer of ONE SIZE FITS ALL and STRETCH GLOVES and STRETCHES TO ALL SIZES FOR A SUPER FIT.

The examining attorney required that applicant insert a disclaimer of ONE SIZE FITS ALL and STRETCH GLOVES and STRETCHES TO ALL SIZES FOR A SUPER FIT in the application. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.08. In its incoming response of July 18, 2005, applicant provided the following disclaimer: ONE SIZE FITS ALL and STRETCH GLOVES and STRETCH TO ALL SIZES FOR A SUPER FIT. The examining attorney did not accept this disclaimer because the phrase STRETCH TO ALL SIZES FOR A SUPER FIT does not match the phrase in the drawing STRETCHES TO ALL SIZES FOR A SUPER FIT.^[1] Applicant failed to amend the wording in its disclaimer to match the wording in the drawing.

Applicant has never clearly withdrawn any part of its proffered disclaimer. Nevertheless, in its appeal brief, applicant argues that it cannot disclaim the term STRETCH because STRETCH is a patented feature of its goods. Applicant does not contest the remainder of the disclaimer requirement. Applicant contends that it cannot disclaim the exclusive right to use STRETCH as a term because it has patented the stretch design feature of the gloves. Applicant's argument is without a legal basis. Applicant is confusing its patent with its trademark. The fact that applicant has a patent for the stretch feature of the gloves does not establish that applicant has the exclusive right to trademark and use the word "stretch" in relation to stretch gloves. In fact, the opposite is true. The patent establishes that a feature of applicant's goods is that they stretch. As noted by applicant, the patent states, "[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...". The patent actually refers to the goods as "stretch fashion gloves." See page 1 of the patent. It is clear that the term STRETCH is descriptive of a feature of the gloves and, therefore, it must be disclaimed. Applicant must insert the entire corrected disclaimer of ONE SIZE FITS ALL and STRETCH GLOVES and STRETCHES TO ALL SIZES FOR A SUPER FIT in the application. A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use ONE SIZE FITS ALL and STRETCH GLOVES and STRETCHES TO ALL SIZES FOR A SUPER FIT apart from the mark as shown.

II. Registration of applicant's mark, featuring the phrase MAGIC STRETCH GLOVES, for children's ambidextrous gloves, will result in a likelihood of confusion with the prior registered mark, MAGIC GLOVE, for fashion gloves for youths.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont 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).

With respect to a comparison of the marks, the marks are compared in their entireties under a Section 2 (d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The dominant feature of applicant's mark, MAGIC, is identical to the dominant feature of the cited registered mark. In addition, in each mark, MAGIC modifies GLOVE, in singular or plural form.

Applicant argues that STRETCH is the dominant feature of its mark. As discussed above, the term STRETCH is descriptive of a feature of applicant's goods and must be disclaimed. Disclaimed matter is typically less significant or less dominant when comparing marks. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). MAGIC is the only word in applicant's mark which is not descriptive of a feature of its goods. MAGIC, therefore, is the dominant feature of the mark, and not STRETCH.

Further, the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975). The term STRETCH is highly descriptive and it is in a different

size font and stylization than MAGIC or GLOVES. It is also encompassed by an oval. The addition of this weak and separable term between MAGIC and GLOVES does not significantly alter the commercial impression of the mark. Similarly, the addition of the other descriptive wording and minimal design elements in applicant's mark does not obviate the likelihood of confusion.

With respect to a comparison of the goods, applicant appears to argue that the goods are marketed to different consumers in different channels of trade. Applicant's argument is without basis in fact. Applicant's goods are children's ambidextrous gloves. Registrant's goods are fashion gloves for youths. A determination of whether there is a likelihood of confusion is made solely on the basis of the goods identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the application and registration describe the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application and registration encompass all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); TMEP §1207.01(a)(iii). The intended users of registrant's goods are "youths." "Youths" are "young people considered as a group." "Young" is defined as "[b]eing in an early period of life, development, or growth." A "child" is "a boy or girl from the time of birth until he or she is an adult." See the attached definitions.^[2] Children are by definition youths. "Youths", therefore, include "children." Similarly, "fashion gloves" logically include "ambidextrous fashion gloves." Therefore, registrant's goods encompass ambidextrous fashion gloves for children. In fact, as shown in the patent, applicant's goods *are* fashion gloves for children. See pages 1 and 3 of patent registration no. 6895599, which was attached to the applicant's response of September 29, 2005, referring to the goods as "reversible interchangeable stretch fashion gloves" for children. Therefore, the goods must be considered legally identical.

CONCLUSION

The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). Due to the highly similar nature of the marks and the goods, confusion is likely among consumers as to the source of those goods. Accordingly, the refusal to register under Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

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[1] Note that the wording in the original drawing page was not readable and appeared to show the phrase **STRETCHED** TO ALL SIZES FOR A SUPER FIT, therefore, the original disclaimer requirement referenced the term STRETCHED rather than the term STRETCHES. The disclaimer requirement was corrected to STRETCHES TO ALL SIZES FOR A SUPER FIT following applicant's submission of a clear drawing page.

[2] These definitions are not of record. The Board is asked to take judicial notice of these definitions. *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 862 n. (TTAB 1981).

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Top Web Results for "youths"

1 entry found for youths.

youth **Pronunciation Key** (yooth)

n. pl. youths (yooths, yoothz)

1.
 - a. The condition or quality of being young.
 - b. An early period of development or existence: *a nation in its youth.*
2. The time of life between childhood and maturity.
3.
 - a. A young person, especially a young male in late adolescence.
 - b. *(used with a sing. or pl. verb)* Young people considered as a group.
4. Geology. The first stage in the erosion cycle.

[Middle English *youth*, from Old English *geoguth*. See *yeu-* in Indo-European Roots.]

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Definition

child Show phonetics noun [C] plural children

1 a boy or girl from the time of birth until he or she is an adult, or a son or daughter of any age:

an eight-year-old child

As a child I didn't eat vegetables.

A small group of children waited outside the door.

Both her children are now married with children of their own.

Jan is married with three young children.

They campaign for the rights of the unborn child.

See also brainchild.

2 DISAPPROVING an adult who behaves badly, like a badly behaved child:

He's such a child if he doesn't get his own way.

3 a child of sth someone who has been very influenced by a particular period or situation:

Me, I'm a child of the sixties.

childhood Show phonetics noun [C or U]

the time when someone is a child:

She had an unhappy childhood.

Childhood is not always a happy time.

Compare boyhood at boy; girlhood at girl.

childish Show phonetics adjective

1 typical of a child:

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Top Web Results for "young"

11 entries found for young.

young  **Pronunciation Key** (yŭng)
adj. **young-er, young-est**

1. Being in an early period of life, development, or growth.
2. Newly begun or formed; not advanced: *The evening is still young.*
3. Of, belonging to, or suggestive of youth or early life: *He is young for his age.*
4. Vigorous or fresh; youthful.
5. Lacking experience; immature: *a young hand at plowing.*
6. Being the junior of two people having the same name.
7. Geology. Being of an early stage in a geologic cycle. Used of bodies of water and land formations.

- n.*
1. Young persons considered as a group; youth: *entertainment for the young.*
 2. Offspring; brood: *a lioness with her young.*

Idiom:
with young

Pregnant.

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