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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 76/656180

**APPLICANT:** RP CREATIONS LTD.



**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

**CORRESPONDENT ADDRESS:**

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**MARK:** NATALIE

**CORRESPONDENT'S REFERENCE/DOCKET NO:** P-4103-1

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**

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

The applicant has appealed the trademark examining attorney's refusal to register the trademark

NATALIE on the ground that it is confusingly similar to the NATALIE & ME mark in Reg. No. 3,020,769, within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

## FACTS

The applicant's mark is NATALIE, in standard character format, for what was originally described as "women's clothing, garments and accessories." This identification was amended to the description of "accessories for women, namely, barrettes, buttons, embroidery, hair clips, hat pins and ornamental novelty pins." The mark in Reg. No. 3,020,769 is the stylized wording NATALIE & ME, for women's pants, skirts, tops, t-shirts, blouses, shorts, knit tops, dresses and jackets. Included with the applicant's October 23, 2006 response is a declaration by the applicant's president in which the president avers that the applicant's goods are sold directly to retail store customers and that a reference to "& Me" would not be understood and would likely cause confusion because there is no "ME" other than the declarant. Attached to the final refusal mailed November 14, 2006 are ten third-party registrations of marks used in connection with the same or similar goods as those of the applicant and registrant in this case.

## ARGUMENT

### THE MARKS ARE HIGHLY SIMILAR

NATALIE is a strong mark for the goods at issue because it is arbitrary and distinctive. There is no evidence that the word has any meaning other than trademark significance. Also, there are no other NATALIE marks for clothing or accessories. As a general rule, consumers are more inclined to focus on the first word, prefix or syllable in any trademark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Marks may be confusingly similar in appearance where there are similar terms appearing in both the applicant's and registrant's marks. *See e.g., In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS). The "& ME" wording in the registrant's mark fails to create a different commercial impression from NATALIE, the dominant or only term in the marks. Consumers would likely see NATALIE & ME as just a slight variation from the NATALIE mark.

The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinctly different commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

### THE GOODS ARE CLOSELY RELATED

The original identification read: "women's clothing, garments and accessories." While this was amended to delete the indefinite reference to women's clothing and garments, it demonstrates the relatedness of women's clothing and accessories. It is common knowledge that women's clothing and hair accessories are worn together. Such complementary use has long been recognized as a pertinent consideration in determining that a likelihood of confusion exists. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). The identification of goods in the subject application and the cited registration may in itself constitute evidence of the relatedness

of the goods. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

The Board found the use of similar marks for hair ornaments, sundry items and clothing confusingly similar in *Faberge, Incorporated v. Faber S.p.A.*, 1982 TTAB LEXIS 15 (TTAB Dec. 1, 1982)(holding the applicant's use of the mark FABER on "articles of clothing, in particular, corsets, brassieres, girdles, swim-suits" likely to cause confusion with opposer's mark FABERGE used on "perfume, pearls, various items of jewelry, cigarette cases, key rings, powder boxes, buckles, women's hosiery, soap, various cosmetic, toiletry and fragrance products, hair brushes, scarves, hair nets, hair bonnets, shower caps, beauty gloves, beauty caps, hair ornaments and various hair care products"). This case is probative of the relatedness of the goods here at issue, even though the marks were arguably less similar than "NATALIE" and "NATALIE & ME."

The ten third-party registrations of record show use of the same marks for clothing and accessories like the barrettes, buttons, embroidery, hair clips, hat pins and ornamental novelty pins here at issue. These registrations show that such goods commonly emanate from a single source. Since consumers are accustomed to seeing such goods come from the same source, they would likely believe that NATALIE barrettes, buttons, embroidery, hair clips, hat pins and ornamental novelty pins are from the same source as NATALIE & ME women's pants, skirts, tops, t-shirts, blouses, shorts, knit tops, dresses and jackets.

In its brief, the applicant contends that because the goods tend to be displayed differently – clothing on hangers, barrettes, buttons, etc. on counter trays – this obviates likelihood of confusion. There is no evidence that addresses how the goods are displayed or encountered. Since there is no restriction in either identification, it must be presumed that the goods reach the same class of purchasers in all ways normal for such goods. Clothing is often displayed in trays, and goods like the applicant's accessories are often displayed on shelf-top hangers. Clothing and accessories are complementary items where one is often bought to accessorize with the other.

Neither the application nor the registration contain any limitations regarding trade channels for the goods and therefore it is assumed that the goods of the parties are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same class of purchasers shops for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods, but it also protects against "reverse confusion," that is, that the junior user is the source of the senior user's goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

#### APPLICANT'S DECLARATION FAILS TO OBVIATE LIKELIHOOD OF CONFUSION

The declaration of the applicant's president asserts a restriction on the identification of goods that is not in the goods description. The declaration states that the applicant's goods are sold directly to retail store customers. However, the identification lists the goods without any limitation on how they are sold. Thus, if the application describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the application encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Neither the application nor the registration contain any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. V. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

The applicant's declaration also states that "reference to '& Me' would not be understood and would likely cause confusion because there is no 'ME' other than declarant using her name, NATALIE." The conclusion of the declarant is without any evidence to support it. The only confusion that would seem to arise is that of consumers who think the goods of the parties come from the same source, since such goods commonly are identified by the same mark.

The applicant argues in its brief that "there is factual support" that the applicant's customers would not confuse the registrant's clothing with the applicant's accessories. This "factual support" seems to be the "EVIDENTIARY DECLARATION" of the applicant's president. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case).

## CONCLUSION

NATALIE & ME is very similar to NATALIE. The only objective evidence of record – ten third-party registrations – shows that goods such as those of the applicant and registrant herein are commonly sold under the same mark. Clothing and women’s accessories are complementary items often sold in close proximity to each other.

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

For the foregoing reasons, the refusal to register on the basis of §2(d) of the Trademark Act, 15 U.S.C. §1052(d), for the reason that there is a likelihood of confusion as a result of the use of similar marks for related goods, should be affirmed.

Respectfully submitted,

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