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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/676410

MARK: SUN SPOT



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: U.S. VISION, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: U.S. Vision, Inc.	:	BEFORE THE
Trademark: SUN SPOT	:	TRADEMARK TRIAL
Serial No.: 76676410	:	AND
Attorney: Sherry H. Flax	:	APPEAL BOARD
Address: Sherry H. Flax Saul Ewing LLP Suite 900 500 E. Pratt St. Baltimore, MD 21202	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

The applicant, U.S. Vision, Inc., has appealed the trademark examining attorney's refusal to register the proposed mark, SUN SPOT, on the ground that the mark for which

registration is sought so resembles the marks shown in U.S. Registration Nos. 1864634 and 2425822 as to be likely, when used on or in connection with the identified goods, to cause confusion, or to cause mistake, or to deceive, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d).

II. FACTS

On May 10, 2007, applicant, U.S. Vision, Inc. (hereinafter “applicant”) applied for registration on the Principal Register for the proposed standard character mark, SUN SPOT, for “sunglasses” in International Class 009.

In an Office action dated August 21, 2007, the trademark examining attorney refused registration on the Principal Register under Trademark Act Section 2(d), 15 U.S.C. §1052(d) based on a likelihood of confusion, citing U.S. Registration Nos.: (1) 1864634 for the mark SUNSPOT and design for “jewelry and jewelry pins” in International Class 014, “water bottles sold empty and mugs” in International Class 021 and “t-shirts, sweatshirts, sweaters, t-necks, hats, headbands and wind-resistant jackets” in International Class 025; and (2) 2425822 for the typed mark SUN SPOTS for “wearing apparel; namely, womens bathing suits, cover-ups, dresses, shirts, pants, shorts, skirts, jackets, rompers, jumpsuits” in International Class 025. Evidence in the form of third-party registrations was attached to demonstrate the relatedness of applicant’s and registrants’ goods. In addition, the trademark examining attorney required applicant to submit a standard character claim and to specify its state of incorporation.

On March 31, 2008, an abandonment notice was mailed to applicant for failure to respond to an outstanding Office action within the six (6) month response period.

On April 23, 2008, applicant filed a petition to revive, which the Office granted, along with a response in which applicant contested the grounds for refusal and asserted therein that applicant's mark was not confusingly similar to the registered marks cited by the trademark examining attorney. In addition, applicant satisfied the above informalities by submitting a standard character claim and specifying its state of incorporation.

After careful consideration of applicant's response, in an Office action dated May 20, 2008, the trademark examining attorney, not persuaded by applicant's arguments, made final the refusal to register the proposed mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Additional evidence in the form of third-party registrations was attached to further demonstrate the relatedness of applicant's and registrants' goods.

On October 17, 2008, applicant filed a Request for Reconsideration.

In an Office action dated November 6, 2008, the trademark examining attorney denied the Request for Reconsideration and adhered to the final Office action as written, explaining that no new significant and compelling facts or reasons were presented to overcome the refusal to register the proposed mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

On November 7, 2008, applicant filed a Notice of Appeal and filed an appeal brief on December 17, 2008.

For the reasons set forth below, the trademark examining attorney respectfully requests that the Trademark Trial and Appeal Board AFFIRM the refusal to register the proposed mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

III. ISSUE

The sole issue on appeal is whether applicant's proposed mark, SUN SPOT, when used in connection with "sunglasses" in International Class 009 so resembles registrants' marks: SUNSPOT and design, for "jewelry and jewelry pins" in International Class 014, "water bottles sold empty and mugs" in International Class 021 and "t-shirts, sweatshirts, sweaters, t-necks, hats, headbands and wind-resistant jackets" in International Class 025; and SUN SPOTS for "wearing apparel; namely, womens bathing suits, cover-ups, dresses, shirts, pants, shorts, skirts, jackets, rompers, jumpsuits" in International Class 025, that it is likely to cause confusion, or to cause mistake, or to deceive and thus should be refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

IV. ARGUMENT

THE LITERAL PORTIONS OF APPLICANT'S AND REGISTRANTS' MARKS ARE VIRTUALLY IDENTICAL IN SOUND, APPEARANCE, CONNOTATION AND COMMERCIAL IMPRESSION AND THE GOODS ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION EXISTS UNDER TRADEMARK ACT SECTION 2(d), 15 U.S.C. §1052(d).

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and

registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves the following two-part analysis. First, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). Second, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

Regarding the issue of likelihood of confusion, all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP

§1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b). In comparing the goods and/or services, it is necessary to show that they are related in some manner. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

(A) THE LITERAL PORTIONS OF APPLICANT'S AND REGISTRANTS' MARKS ARE VIRTUALLY IDENTICAL IN SOUND, APPEARANCE, CONNOTATION AND COMMERCIAL IMPRESSION.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b). Moreover, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54

USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

In the present case, the trademark examining attorney maintains that the literal portions of the marks are virtually identical in appearance, sound, connotation and commercial impression. The marks all contain the element SUN SPOT. Minor spelling and spacing deviations of the registered marks do not obviate the likelihood of confusion in this instance. Trademarks and/or service marks consisting of the singular and plural forms of the same term are essentially the same mark. *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is “almost totally insignificant” in terms of likelihood of confusion among purchasers); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962) (finding no material difference between the singular and plural forms of RED DEVIL).

Furthermore, when a mark consists of a literal portion and a design portion, the literal portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services. Therefore, the literal portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553

(TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). In this case, because the literal portions of the marks are virtually identical in appearance, sound and meaning, the addition of the design element does not obviate the similarity of the marks. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

Applicant has argued that based on third-party usage, the mark SUN SPOT is weak. In support of this argument, applicant has attached four (4) third-party registrations. This argument is unpersuasive. The third-party registrations are for goods different than those of applicant and registrants in this case. Specifically, the goods listed in the third-party registrations are “grass seed,” “medical electrodes,” “photovoltaic (PV) solar energy monitoring system[s]” and “newsletters in the field of weathering testing.” Third-party registrations for seemingly similar marks featuring goods and/or services dissimilar or unrelated to those in the application and the cited registration are of little probative value in determining the weakness of a mark or portions of a mark. Weakness or dilution is generally determined in the context of the number and nature of similar marks in use in the marketplace on similar goods and/or services. *See Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Therefore, these third-party registrations are insufficient evidence to show that the wording SUN SPOT is weak for sunglasses, jewelry and clothing. Moreover, even if applicant has shown that SUN SPOT is weak, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to

protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Finally, applicant has argued that there are identical marks that are “registered and owned by different registrants for sunglasses and apparel” and that the two cited marks are owned by different registrants. These arguments are unpersuasive. Prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int’l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

(B) APPLICANT’S AND REGISTRANTS’ GOODS ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION EXISTS UNDER TRADEMARK ACT SECTION 2(d), 15 U.S.C. §1052(d).

In determining whether a likelihood of confusion exists, all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree

of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. If the marks of the respective parties are identical, the relationship between the goods and/or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcors, Inc. v. Amcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a). The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In this case, the trademark examining attorney maintains that applicant's and registrants' goods are very closely related, because the goods will travel through the same channels of trade to the same consumers under circumstances that could give rise to the mistaken belief that the goods emanate from a common source. Furthermore, the trademark examining attorney asserts that the goods are complementary, making it highly likely that the goods will be used together.

Here, because the literal portions of applicant's and registrants' marks are virtually identical in appearance, sound, connotation and commercial impression, the extent to which the relevant goods must be related to support a finding of likelihood of confusion is lessened. In the previous Office actions, the trademark examining attorney attached copies of printouts from the USPTO X-Search database, which showed at least forty-five (45) third-party registrations, based on use in commerce, of marks used in connection with the same or similar goods as those of applicant and registrants' in this case. The third-party registrations include the following:

- (1) U.S. Registration No. 3255832 for “cases for spectacles and sunglasses; frames for spectacles and sunglasses; sunglass lenses; sunglasses” and “caps ; caps with visors; coats; fishing vests; hunting vests; jackets; men and women jackets, coats, trousers, vests; pants; perspiration absorbent underwear clothing; rain coats; rain jackets; rainproof jackets; shirts; t-shirts; vests; waterproof jackets and pants; wind shirts; wind vests”
- (2) U.S. Registration No. 3203568 for “eyeglass lenses; eyeglasses; frames for eyeglasses and pince-nez; frames for spectacles and sunglasses; lenses for sunglasses; ophthalmic lenses; optical lenses; protective eyewear; sunglass lenses; sunglasses” and “jewelry”
- (3) U.S. Registration No. 3191692 for “sunglasses” and “watches; jewelry, namely, bands that are worn on the wrist, bracelets, earrings and necklaces that light up and provide entertainment”
- (4) U.S. Registration No. 3184488 for “eye glasses, sun glasses” and “t-shirts, shorts, sweat shirts, pants, shoes, hats, g-strings, head bands, underwear, socks, jeans”
- (5) U.S. Registration No. 3168241 for “sunglasses” and “shirts, pants, shorts, bathing suits, sweatshirts, hats, belts, shoes”
- (6) U.S. Registration No. 3116548 for “sunglasses” and “clothing apparel, namely, bomber jackets, leather coats, hats, belts, boots, shoes, shirts, pants, leather jackets; aviation and military apparel, namely, coats, jackets, shirts, t-shirts, hats, gloves”

- (7) U.S. Registration No. 2854161 for “eyeglasses, sunglasses, reading glasses, and eyeglass cases” and “jewelry”
- (8) U.S. Registration No. 2827080 for “sunglasses” and “jewelry, namely, earrings, rings, necklaces, bracelets, and watches” and “clothing, namely, tops, shirts, blouses, pullovers, sweaters, bottoms, dresses, skirts, pants, jeans, suits, coats, jackets, pantyhose, undergarments, socks, shoes, lingerie, hats, and belts”
- (9) U.S. Registration No. 2823202 for “sunglasses” and “clothing, namely, hats, sweatshirts, shirts, shorts, pants, beanies, tank tops, swimwear, rash guard shirts, and wet suits”
- (10) U.S. Registration No. 1477515 for “sunglasses” and “jewelry”

These printouts have probative value to the extent that they serve to suggest that the goods listed therein, namely, sunglasses, clothing and jewelry, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). In addition, these third-party registrations evidence that sunglasses and clothing are complementary goods in that sunglasses are often purchased as a fashion accessory. Clearly, consumers are accustomed to seeing these types of goods sold under the same mark. Therefore, the evidence establishes that it is highly likely that the goods will be encountered by the same consumers under circumstances that could give rise to the mistaken belief that the goods emanate from or are sponsored or licensed by a common source.

Moreover, any goods in the registrant’s normal fields of expansion should be considered when determining whether the registrant’s goods are related to the applicant’s goods. TMEP §1207.01(a)(v); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581

1584 (TTAB 2007). Evidence that third parties offer the goods of both the registrant and applicant suggest that it is likely that the registrant would expand their business to include applicant's goods. In that event, consumers are likely to believe the goods at issue come from or, are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4; *see* TMEP §1207.01(a)(v). As the third-party registrations and the complementary nature of the goods indicate, applicant's goods are clearly within registrants' logical zone of expansion.

Finally, a determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services 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); TMEP §1207.01(a)(iii). In this case, there are no limitations as to channels of trade or classes of purchasers in either the application or the registrations. It is presumed that the goods move in all normal channels of trade and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). It is highly likely that these closely related and complementary goods, which bear virtually identical marks, will be purchased by the same consumer, as part of a coordinated outfit, in a single shopping trip, from the same retailer, thereby, giving rise to the mistaken belief that the goods emanate from or are sponsored or licensed by a common source.

V. CONCLUSION

The literal portions of applicant's and registrants' marks are virtually identical in sound, appearance, connotation and commercial impression and the goods are closely related such that a likelihood of confusion, mistake, or deception exists under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Therefore, for the foregoing reasons, the trademark examining attorney respectfully requests that the Trademark Trial and Appeal Board AFFIRM the refusal to register the proposed mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

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