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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 76/682440

**MARK:** OUCH! MOUNTAIN



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**GENERAL TRADEMARK INFORMATION:**

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

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

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**CORRESPONDENT'S REFERENCE/DOCKET NO:**

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## EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appeals the examining attorney's final refusal to register the trademark OUCH! MOUNTAIN (and design) for clothing and apparel for outdoorsmen on the grounds that the mark is likely to be confused with U.S. Registration No. 2,119,347 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). It is respectfully requested that the Board affirm the final refusal.

The examining attorney also respectfully requests that the Board take judicial notice of the dictionary definition attached to and referenced in this brief.<sup>1</sup>

### **I. FACTS**

On October 1, 2007, applicant applied for registration on the Principal Register of the proposed trademark OUCH! MOUNTAIN (and design) for "clothing and apparel for outdoorsmen, namely, shirts, sweatshirts, hats, socks, and jackets" based on an intent to

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<sup>1</sup> Although the record in an application should be complete prior to the filing of an appeal, the Board may take judicial notice of printed dictionary definitions. TBMP §1208.04 (judicial notice); *See In re Azteca Restaurant Enters. Inc.*, 50 USPQ2d 1209, 1210 n. 6 (TTAB 1999).

use the mark in commerce under Section 1(b). The examining attorney initially refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with Registration Nos. 2,119,347 and 3,082,697. Reg. No. 2,119,347 is OUCH WEAR SO GOOD IT HURTS (stylized) for “t-shirts, jackets, hats.” Reg. No. 3,082,697 is OUCH for “swimwear.”

On July 16, 2008, applicant submitted arguments against the likelihood of confusion refusals and amended the identification of goods to specify that the intended user is “outdoorsmen.” On August 11, 2008, having found applicant’s arguments unpersuasive as to the refusal pertaining to Reg. No. 2,119,347, the examining attorney issued a final refusal under Section 2(d) based on a likelihood of confusion with Reg. No. 2,119,347. The refusal as to Reg. No. 3,082,697 was withdrawn and the examining attorney accepted applicant’s amendments to the identification of goods.

This appeal directly follows the examining attorney’s final refusal under Section 2(d) of the Trademark Act. On February 10, 2009, applicant filed its Notice of Appeal and submitted its appeal brief. Jurisdiction was restored to the examining attorney for this appeal brief.

## **II. ISSUE**

Whether applicant’s mark and the registrant’s mark are confusingly similar and the goods are so closely related as to cause a likelihood of confusion under Section 2(d) of the Trademark Act.

## **III. ARGUMENT**

**THE APPLICANT’S MARK AND THE REGISTRANT’S MARK ARE CONFUSINGLY SIMILAR AND THE GOODS OF THE PARTIES ARE SO CLOSELY RELATED TO THE EXTENT THAT A LIKELIHOOD OF CONFUSION EXISTS UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

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 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.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and similarity of trade channels of the goods. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); TMEP §§1207.01 *et seq.*

All circumstances surrounding the sale of the goods 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. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973). When 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). When comparing the goods, 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).

Fundamentally, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

#### **A. Similarity of the Marks**

Taking into account the relevant *du Pont* factors, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. *In re E.I. du Pont*, 476 F.2d at 1357. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE).

Applicant's proposed mark is OUCH! MOUNTAIN (with design). The mark consists of the designs of an outline of a mountain, a backpacker figure on the mountain, and a tree design in the letter T in MOUNTAIN. The registered mark is OUCH WEAR SO GOOD IT HURTS (stylized). The term OUCH is the dominant portion of the registered mark as it is larger than all other words in the mark and is positioned above "WEAR" and "SO GOOD IT HURTS." The term WEAR is disclaimed.

Applicant's mark is similar to registrant's mark because both contain the identical leading term OUCH. The different wording following OUCH and applicant's design elements do not obviate the similarities of the marks. The term WEAR in registrant's

mark is disclaimed and is less dominant when comparing the marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

Applicant argues that the exclamation mark, the term “MOUNTAIN,” the different additional words and stylizations, and the mountain/backpacker design sufficiently distinguish applicant’s mark from the registrant’s mark. *See Applicant’s Brief at 2, 5-7.* However, consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Moreover, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii).

Applicant states that the design features and the term MOUNTAIN in its mark create an impression of an “outdoorsy” feel and that the goods bearing the mark are meant for outdoor activities. *See Applicant’s Brief at 5.* Applicant asserts that the commercial impression of the registered mark indicates that the clothing sold under the

mark is of high quality or will make the wearer grab attention and look good. *Id.* at 6. However, 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). 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). 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).

In the present case, the average purchaser of the registrant's mark will recollect the term OUCH due to its dominant size and arbitrary meaning in connection to clothing. Similarly, when viewing applicant's mark, the average purchaser will remember the term OUCH! due to its size and position in relation to the rest of the mark and due to the uniqueness of the term in the field of clothing. Moreover, given that applicant's goods are for "outdoorsmen," as specified in the identification of goods, the term MOUNTAIN in the applicant's mark is suggestive; the applicant notes that the features in the mark "are intended to provide a wilderness or backpacking impression and that the goods sold under the mark are hearty and meant to be used in outdoors activities." Accordingly, OUCH is the dominant element, and the term that consumers are likely to recall. In addition, the word "OUCH" is defined in *Merriam-Webster's Collegiate Dictionary* as an interjection used to "express sudden pain." See the attached dictionary definition. Used

in relation to the applicant's and registrant's goods, the term "OUCH" has no descriptive meaning nor does it suggest an idea of the ingredients, qualities, or characteristics of the goods.

Applicant cites *In re Electrolyte Labs., Inc.* as an example of a case where the Court found no likelihood of confusion between marks containing similar literal elements, different design elements, and identifications of nearly identical goods. 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990). In that case, the applicant sought to register "K+" (with a double rectangular border design) for "dietary supplements." The registered mark was "K+EFF" (stylized with a small plus symbol) for "potassium and chloride supplement for human use." *Id.* at 646-47. The Court stated that the letter "K" was the symbol for potassium, "EFF" was an abbreviation for "effervescent," and noted that both sides treated "K+" as the symbol for a potassium ion. *Id.* at 647. Applicant argued that since "K+" was descriptive, the term was entitled to little weight when comparing the marks. *Id.* In finding no likelihood of confusion, the Court stated that "[a]lthough the symbols and abbreviations can be pronounced, they are not identical, and the design of the marks is substantially different." *Id.* at 648.

Applicant argues that its design elements create an even greater distinguishing factor than did the design elements in the *Electrolyte* applicant's "K+" mark. See Applicant's Brief at 7. However, unlike in *Electrolyte*, where the common element of the marks was the descriptive term "K+", the term OUCH in the instant case is completely arbitrary as used in connection with the registrant's and applicant's goods. Accordingly, the term OUCH should be accorded much more weight in comparing the marks than "K+" was accorded when comparing the *Electrolyte* marks. In addition, because the

marks in *Electrolyte* consisted of letters and symbols as opposed to words, the Court distinguished letter marks from pure design marks and word marks, noting that stylized letters are “in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.” *In re Electrolyte*, 929 F.2d at 647 (quoting *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 760, 204 USPQ 697, 699 (C.C.P.A. 1980)). Unlike in the marks in *Electrolyte*, the marks at issue comprise words and, in the applicant’s mark, words and designs. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a consumer’s memory and to be used in calling for the goods. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin’s Miniatures*, 59 USPQ2d at 1596.

In addition, applicant argues that the term OUCH is weak in relation to clothing and apparel goods. *See* Applicant’s Brief at 3-4. Applicant notes that the two registrations initially cited against applicant, OUCH WEAR SO GOOD IT HURTS and OUCH, Reg. No. 3,082,697 for “swimwear,” is evidence of the weakness of the term OUCH. *Id.* at 3. Also, applicant attached the printouts of registrations, pending applications, and an abandoned application containing the term OUCH. *See* Applicant’s Response. Applicant argues that these “multiple third party registrations of marks containing the phrase ‘ouch’ for related goods are highly probative in this case to show that otherwise distinguishable marks containing this terminology can co-exist in the marketplace without a likelihood of confusion.” *See* Applicant’s Brief at 4.

However, the registrations relied upon by applicant to demonstrate dilution of the term OUCH have different commercial impressions and are used with goods that are not

closely related to applicant's goods. Of the registrations applicant cited, OUCH POUCH and OUCH POUCH JR. are both for "footwear, namely, elastic fabric and polymer gel products designed to protect areas of a dancer's foot." The rhyming nature of the marks and the fact that the goods are specialized protective dancing footwear sufficiently distinguish it from the registrant's and applicant's marks. Similarly, OUCHLESS for "hair accessories, namely, elastic hair bands and ponytail holders" is sufficiently different in commercial impression and in the relatedness of the goods. The pending applications for OUCHOHOL, OUCH for "headgear for soccer" are not dispositive to show that a mark is weak since they have yet to register. Similarly, the application for OUCH SWEAT AND TEAR has little evidentiary weight as it abandoned in 2006. Despite applicant's contention that "at least eight marks containing the word 'ouch' owned by different owners have been registered or allowed for various types of clothing or apparel items," the only currently registered mark containing the prominent term OUCH for articles of clothing such as applicant's is the cited registrant, OUCH WEAR SO GOOD IT HURTS.

Moreover, even if the term OUCH were established to be weak for articles of clothing, 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); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Applicant further states that as evidenced by the registrations and Notices of Allowance issued for marks containing OUCH, “the Trademark Office has recognized that consumers can differentiate between different sources of clothing and apparel goods offered under otherwise distinguishable marks that share in common the phrase ‘ouch.’” See Applicant’s Brief at 4. Applicant also argues that if the initially cited mark OUCH for swimwear, Reg. No. 3,082,697, can co-exist with the mark OUCH WEAR SO GOOD IT HURTS, then applicant’s mark with design elements and additional wording should also be able to co-exist without a likelihood of confusion. *Id.* at 7. However, 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 *In re Int’l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000).

**B. Similarity of the Goods**

The goods 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).

In this case, applicant seeks to use its mark to identify “clothing and apparel for outdoorsmen, namely, shirts, sweatshirts, hats, socks, and jackets.” The registered mark is used to identify “T-shirts, jackets, hats.” Applicant’s goods and the registrant’s goods

are closely related because both are for articles of clothing. The decisions in the clothing field have held many different types of apparel to be related under Trademark Act Section 2(d). *See e.g. Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (underwear related to neckties).

Also, both marks are for jackets and hats, and the applicant's identification of "shirts" encompasses the registrant's identification of "t-shirts."

Moreover, the registrant's goods are identified broadly. Therefore, it is presumed that the registration encompasses all goods of the type described, including those in applicant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In the present case, applicant's goods are restricted to outdoorsmen, whereas the registrant's goods contain no such restriction. Accordingly, the registrant's goods are presumed to encompass "T-shirts, jackets, hats" for outdoorsmen.

Also, neither the application nor the registration contain any limits regarding the trade channels for the goods and therefore it is assumed that applicant's goods and the registrant's goods are sold everywhere that is normal for such items, *i.e.*, clothing and department stores. 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 In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

As shown by the evidence attached with the Final Action dated August 11, 2008, it is common for the same clothing companies to sell sweatshirts, t-shirts, hats, etc. that

have an outdoorsy theme but which clearly can be worn anytime. *See* Final Action pages 7-10 from Cabela's.

#### **IV. CONCLUSION**

The same consumers will be exposed to the goods identified with the marks. The similarities between the marks and relatedness of the goods of the parties are so great as to create a likelihood of confusion. For the foregoing reasons, the final refusal to register the mark under Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

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