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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/106782

MARK: SPORT BEANS



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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: Jelly Belly Candy Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

JBCC-1212

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The examining attorney refused registration on the Principal Register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that the mark, SPORT BEANS when used in connection with “protective helmets for sports” and “clothing for sports for men, women and children, namely, shorts, pants, t-shirts, sleeveless shirts, shirts with collars, tank tops, tankinis; training and warm-up suits, rain proof and wind-resistant jackets, skirts and skirt/short combinations, sweaters, underwear, socks, sweatbands, bathing suits, hats, caps, and visors; cycling apparel, namely, booties, caps, gloves, headbands, jackets, jerseys, muffs, shirts, pants, socks, shorts, tights, leg and arm warmers and trousers,” is likely to be confused with U.S. Registration Number 2697973, for the mark “BEANSPORT,” for “women's swimsuits and fitness wear, namely, shorts, pants, tops, skirts, tankinis, tank tops and capris.”

STATEMENT OF FACTS

On February 13, 2007, the applicant filed an application to register the mark SPORT BEANS on the Principal Register for goods identified as “protective helmets for sports” and “clothing for sports for men, women and children, namely, shorts, pants, t-shirts, sleeveless shirts, shirts with collars, tank tops, tankinis; training and warm-up suits, rain proof and wind-resistant jackets, skirts and skirt/short combinations, sweaters, underwear, socks, sweatbands, bathing suits, hats, caps, and visors; cycling apparel, namely, booties, caps, gloves, headbands, jackets, jerseys, muffs, shirts, pants, socks, shorts, tights, leg and arm warmers and trousers.”

In the Office Action dated March 26, 2007, the examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), because the applicant’s mark, SPORT BEANS, when used in connection with the identified goods, is likely to cause confusion, to cause mistake, or to deceive with the Registrant’s mark, BEANSPORT. The examining attorney also required the applicant to submit a disclaimer of SPORT.

On September 25, 2007, the applicant filed its Response, submitting a disclaimer of SPORT and provided arguments against the refusal to register under Section 2(d).

On October 14, 2007, following a review of the applicant’s Response to the original Office Action, the examining attorney issued a Final Refusal under Section 2(d).

On April 4, 2008, the applicant filed a Request for Reconsideration of the Final Refusal issued on October 14, 2007. The applicant also filed a Notice of Appeal at which time, the case was remanded back to the examining attorney for review.

On May 7, 2008, the examining attorney denied the applicant's Request for Reconsideration and the case was returned to the Trademark Trial and Appeal Board.

On July 21, 2008, the applicant filed an Appeal Brief which was then forwarded to the examining attorney on July 23, 2008.

ARGUMENT

THE PROPOSED MARK CREATES A LIKELIHOOD OF CONFUSION WITH THE CITED REGISTERED MARK BECAUSE THE MARKS ARE SO SIMILAR AS TO CAUSE CONFUSION AS TO THE SOURCE OF THE GOODS, THE GOODS ARE HIGHLY RELATED AND THE GOODS TRAVEL IN THE SAME STREAM OF COMMERCE.

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.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). 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).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, 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. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

It is initially noted that the applicant has not raised any contentions concerning the similarity of the goods of the parties. The goods of the parties are identical: clothing. As indicated in the prior Office Actions, 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, 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 Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii). The decisions in the clothing field have held many different types of apparel to be related under Trademark Act Section 2(d). *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) (women's boots related to men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (women's shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213

USPQ 397 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) (brassieres and girdles related to slacks for men and young men). If the goods and/or services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

With respect to the similarity of the marks, the applicant contends that the marks of the parties are so different such that there would be no likelihood of confusion under Section 2(d) of the Trademark Act. Specifically, the applicant contends that "beans" in SPORT BEANS are "beans related in some way to one or more sports," Brief at 6, while the "Bean" in BEANSPORT is the surname Bean in the name L. L. Bean. Finally, the applicant contends that the registrant's mark, the L. L. Bean's "bean" is invariably singular, while SPORT BEANS is plural.

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In*

re Lamson Oil Co., 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (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. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (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 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

In the instant case, the marks are highly similar in appearance, sound, commercial impression and connotation. The applicant's contention that the marks are different inasmuch as although the marks share the same sounds, the order of the sounds is reversed is insufficient to overcome the likelihood of confusion under Section 2(d) of the Trademark Act. As indicated in the prior Office Actions, the applicant's mark is

essentially a transposition of the registrant's mark and creates a similar commercial impression and meaning. Confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g., In re Wine Soc'y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design, for "wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant," likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER, with "RUST" disclaimed, for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil).

Additionally, as the applicant correctly indicated in its prior Response, the marks of the parties share the same sounds. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963); TMEP §1207.01(b)(iv). 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 Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*,

228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii). Moreover, the fact that one mark is plural and one mark is singular does not change the overall commercial impression. Similarly, the fact that the applicant's mark is made up of two words while the registered mark is made up of one word does not change the overall commercial impression between the marks.

Finally, the applicant's contention that there is no likelihood of confusion inasmuch as there has been no evidence of actual confusion, is unsupported by well-settled case law. 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. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal 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 the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

CONCLUSION

Based on the record evidence and case law, applicant's mark, when used on or in connection with the identified services, so resembles the marks in U.S. Registration No. 3697973 as to be likely to cause confusion, to cause mistakes, or to deceive. The examining attorney, therefore, respectfully requests that the Board affirm the refusal to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

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