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Subject: U.S. TRADEMARK APPLICATION NO. 77128897 - HUMBLE SOLJAH
WEAR - JM-1-009sd - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION SERIAL NO. 77128897

MARK: HUMBLE SOLJAH WEAR



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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: Millan, Jolinda

CORRESPONDENT'S REFERENCE/DOCKET NO:

JM-1-009sd

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark HUMBLE SOLJAH WEAR (in standard character format) for "Cloth bibs; Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, namely, arm warmers; Clothing, namely, folk costumes; Clothing, namely, knee warmers; Clothing, namely, neck tubes; Clothing, namely, wrap-arounds; Corsets; Hoods; Infant and toddler one piece clothing; Infant cloth diapers; Jerseys; Mantles; Mufflers; Non-disposable cloth training pants; Paper hats for use as clothing items; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Perspiration absorbent underwear clothing; Shifts; Short sets; Shoulder wraps; Swaddling clothes; Ties; Tops; Wraps; Bed jackets; Denim jackets; Down jackets; Fishermen's jackets; Fur coats and jackets; Fur jackets; Heavy jackets; Jacket liners; Jackets; Light-reflecting jackets; Long

jackets; Men and women jackets, coats, trousers, vests; Rain jackets; Rainproof jackets; Ski jackets; Sleeved or sleeveless jackets; Smoking jackets; Sports jackets; Suede jackets; Waterproof jackets and pants; Wind resistant jackets; Wind-jackets; Balloon pants; Capri pants; Cargo pants; Denims; Jogging pants; Leather pants; Pants; Ski pants; Snow pants; Sweat pants; Dresses; Bathing suits; Bathing suits for men; Body suits; Flight suits; Gym suits; Jogging suits; Judo suits; Karate suits; Ladies' suits; Men's suits; Snow suits; Suits; Sweat suits; Track suits; Training suits; Warm up suits; Wet suits for water-skiing and sub-aqua; Blouses; Thermal underwear; Underwear; Woven or knitted underwear; Coats” in International Class 25. Registration was refused on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) on the grounds that the applicant’s mark, HUMBLE SOLJAH WEAR, is likely to be confused with the prior registered mark in U.S. Registration No. 1877687, namely SOLJAH (standard character format) for “t-shirts and hats.” It is respectfully requested that this refusal be affirmed.

FACTS

On March 12, 2007, Jolinda Millan filed U.S. Trademark Application Serial No. 77/128897, seeking registration of the proposed mark, HUMBLE SOLJAH WEAR, for a wide variety of clothing goods. On June 22, 2007, the examining attorney issued an Office Action citing prior filed application Serial No. 76634524 as a potential bar to registration and made the requirement for a disclaimer of the term WEAR.

On December 31, 2007, the applicant responded to the Office Action arguing against the citation to the prior filed application and provided a disclaimer of the term WEAR. On March 24, 2008, the examining attorney issued a Notice of Suspension pending the disposition of the prior filed application.

On May 5, 2008, the application was transferred to the undersigned attorney¹. On September 24, 2008 the application was removed from suspension and approved for publication, as prior filed application Serial No. 76634524 had gone abandoned.

The application was withdrawn from publication based on an Office Review on October 10, 2008.

On November 13, 2008, the examining attorney issued a Non Final Office Action refusing registration of the mark based on likelihood of confusion under Trademark Act Section 2(d) with respect to U.S. Registration No. 1877687 for the term SOLJAH.

On May 13, 2009, the applicant responded to the Office Action and amended the identification of goods in an attempt to overcome the refusal under Section 2(d). On June 8, 2009, the examining attorney made FINAL the refusal to register the mark.

On January 12, 2010, the application was abandoned for failure to respond to the Final Office Action. On March 10, 2010, the applicant filed a petition to revive the application and the petition was granted. The application was revived on March 10, 2010.

On March 18, 2010, the examining attorney issued an Office Action Continuing the Final Action and the refusal under Section 2(d).

On September 20, 2010, the applicant filed a Notice of Appeal and on November 19, 2010 the applicant filed an appeal brief with the Trademark Trial and Appeal Board. The application was forwarded to the examining attorney for a brief in accordance with Trademark Rule 2.142(b) on November 22, 2010.

ISSUE

¹ The examining attorney originally assigned to this application left the office.

The sole issue on appeal is whether applicant's mark HUMBLE SOLJAH WEAR for a wide variety of clothing goods is confusingly similar to the mark SOLJAH in U.S. Registration No. 1877687 for "t-shirts and hats," thus creating a likelihood of confusion within the meaning of Section 2(d) of the Trademark Act.

ARGUMENTS

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

I. THE MARKS ARE HIGHLY SIMILAR

Turning first to consideration of the marks at issue, the examining attorney submits that the marks are highly similar. The applicant's mark is comprised of the

wording HUMBLE SOLJAH WEAR in standard character format. The mark in U.S. Registration No. 1877687 is the word SOLJAH in standard character format. The applicant has merely added the term HUMBLE and the descriptive term WEAR, to the registered mark.

As noted above, the applicant has disclaimed the term WEAR. 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); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Therefore, the more significant feature of the applicant's mark is the term HUMBLE SOLJAH.

When marks are otherwise virtually the same, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ

707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

The applicant acknowledges that both marks contain the identical term SOLJAH. *See* applicant's brief, pgs. 4-5. It is well settled that 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).

The applicant argues that because the term SOLJAH has a particular meaning or definition, that the term is weak with respect to the goods and therefore the registrant should only be afforded narrow protection.

In support of its argument the applicant indicates that this case is similar to *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 45 CCPA 856, 254 F.2d 158, 117 USPQ 295, 297 (1958), *Nestle's Milk Products, Inc. v. Baker Importing Co.*, 37 CCPA 1006, 182 F.2d 193, 86 USPQ 80 (1950), and *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d

1910, 1912 (T.T.A.B. 1988). In each of the cited cases, the Court found that the marks or portions thereof were weak because the terms were descriptive of a feature of the goods being offered, or found that the marks were weak because the parties showed that there were multiple U.S. Registrations for the same mark used on the same or similar goods. The cases cited by applicant are not applicable in this case.

In the instant case, the applicant has not provided any third party U.S. Registrations evidencing widespread use of the term to refer to clothing, nor has the applicant provided evidence to show that the term is commonly used in the clothing or fashion industry.

Further, the word SOLJAH is not descriptive of the goods being offered. The term has no apparent meaning as applied to registrant's goods, namely T-shirts and hats. The applicant has supplied a dictionary definition of the term SOLJAH as a "thug soldier" of the streets. *See* dictionary definition attached to applicant's brief. As such, the word "SOLJAH" is arbitrary with respect to registrant's goods, and hence must be considered a "strong" trademark. "Strong" marks are given 'strong' protection – protection over a wide range of related products and services and variations on visual and aural format." 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:73 (4th ed. 2004). Accordingly, the fact that both applicant's mark and registrant's mark contain the word SOLJAH is highly significant in the likelihood-of-confusion analysis.

Finally, it is well settled that the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already

being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

II. THE GOODS ARE HIGHLY RELATED

The second consideration is the goods at issue and the channels of trade for said goods. The examining attorney submits that the goods are highly related, and that they travel in the same channels of trade. The applicant's goods consist of a wide variety of clothing. The goods in the cited registration are "t-shirts and hats." The applicant argues that because it has specifically deleted the terms "tops" and "caps" from its original identification, there is no overlap with the goods listed in the cited U.S. Registration, and therefore, no likelihood of confusion exists.

The amendment to the identification of goods was made by the applicant in its response to the Office Action dated May 13, 2009. In that amendment, the applicant deleted the terms "caps," "dress shirts," "dress suits," and "shirts for suits." *See* applicant's response dated May 13, 2009. However, the examining attorney notes that the identification of goods still includes the terms "jerseys" and "tops."

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see* TMEP §1207.01(a)(iii).

In this case, applicant's goods namely "tops" are identified broadly. Therefore, it is presumed that the application encompasses all goods of the type described, including

those in the registrant's more specific identification, namely t-shirts. It is also presumed that the goods move in all normal channels of trade, and that they are available to all potential customers. See *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); TMEP §1207.01(a)(iii).

Even if the applicant had deleted "jerseys" and "tops" from the identification, 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).

Further, neither the application nor the registration(s) contains 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 trademark examining attorney refers to the excerpted articles from her search on the GOOGLE® computerized database attached to the Final Office Action and incorporated by reference herein. The web pages show that clothing manufacturers provide all types of clothing including the clothing goods provided by both the applicant and the registrant.

Based on the similarity of the marks and the close relationship of the goods, the examining attorney submits that purchasers who encounter the marks of the applicant and the registrant would mistakenly believe that the goods originate from or are in some way associated with the same producer. See *Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244, 1247 (TTAB 1984).

SUMMARY

In summary, the marks are highly similar in appearance, sound and commercial impression and the goods at issue are highly related to each other. Because consumers would mistakenly believe that the goods of the applicant and the registrant emanate from a common source, there is a likelihood of confusion as to the source of the goods. The refusal to register the mark pursuant to Section 2(d) of the Trademark Act should therefore be affirmed.

Respectfully submitted,

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