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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 77/211,233
For the Mark ANGEL FACE and Design
By Applicant Grapevine Intellectual Properties, LLC
Filed on June 20, 2007

EX PARTE APPEAL BRIEF

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INDEX OF CITED CASES

Cases

Champagne Louis Roederer v. Delicato Vineyards, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998).....6

Clark & Freeman Corp. v. Heartland Co., 811 F. Supp. 137 (S.D.N.Y. 1993).....7, 8

General Mills, Inc. v. Health Valley Foods, 24 U.S.P.Q.2d 1270 (T.T.A.B. 1992).....6

H. Lubovsky, Inc. v. Esprit de Corp, 627 F. Supp. 483 (S.D.N.Y. 1986).....7, 8

Inc. Pub. Corp. v. Manhattan Magazine, 227 U.S.P.Q. 257 (S.D.N.Y. 1985).....9

In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984).....7

In re E.I. duPont DeNemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973)..... 5

In re The Shoe Works, Inc., 6 USPQ2d 1890 (TTAB 1988).....7

Keebler Company v. Murray Bakery Products, Inc., 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989).....6

Kellogg Co. v. Pack 'Em Enterprises, Inc., 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991).....6

Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co., 228 U.S.P.Q. 364 (Fed.Cir.1986).....6

Opryland USA, Inc. v. Great American Music Show, Inc.,
23 U.S.P.Q.2d 1471 (Fed. Cir. 1992).....6

Sunenblick v. Harrell, 895 F. Supp. 616 (S.D.N.Y. 1995),
aff'd without op., 101 F.3d 684 (2d Cir. 1996).....8

STATEMENT OF THE ISSUES

The sole issue before the Board pursuant to Section 2(d) of the Lanham Act is whether a likelihood of confusion exists between Applicant's ANGEL FACE and Design mark and the registered ANGEL FACE mark.

RECITATION OF THE FACTS

A. PROCEDURAL HISTORY

Applicant, Grapevine Intellectual Properties, LLC, filed its application, serial number 77/211,233, for U.S. federal registration of the ANGEL FACE and Design trademark on the Principal Register in International Class 25 for "clothing, namely, athletic footwear, beachwear, blazers, blouses, boxer shorts, briefs, coats, dresses, footwear, gloves, hosiery, jackets, leather jackets, neckties, neckwear, pajamas, panties, pants, pantsuits, rainwear, robes, scarves, shirts, shoes, shorts, sleepwear, socks, sport coats, suits, swim wear, t-shirts" on or about June 20, 2007. The application was filed pursuant to Section 1(b) of the Lanham Act.

An Office Action, issued September 22, 2007, refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), citing a likelihood of confusion with the mark in U.S. Registration No. 2,370,580. In addition, the Examining Attorney rejected Applicant's digitized image of the mark and required clarification as to whether the portrait shown in the mark depicts a particular living individual.

On March 24, 2008, Grapevine Intellectual Properties, LLC filed a Response to the Office Action, amending the application to limit the identification of goods to "men's and women's athletic footwear, footwear and shoes" and asserting that there is no likelihood of confusion with the cited

mark. Applicant also submitted a new digitized image showing a clear rendering of the mark and a statement that "the portrait in the mark does not identify a living individual."

The Examining Attorney accepted the amendment, statement and substitute drawing, but issued a final refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) on April 16, 2008. The instant ex parte appeal was instituted on April 25, 2008. On June 20, 2008, the Board granted Applicant's request for an extension of time until July 24, 2008 in which to file its brief.

B. EVIDENCE OF RECORD

The file of the subject application, including the Office Action, dated September 22, 2007, Applicant's Response to the Office Action, dated March 24, 2008, the Office Action, dated April 16, 2008, and the Exhibits thereto are all of record pursuant to 37 C.F.R. §2.142.

ARGUMENT

The Examining Attorney has refused registration under Section 2(d) of the Lanham Act because of a likelihood of confusion with the registration for ANGEL FACE (Reg. No. 2370580) for "children's clothing, namely, tops, bottoms, jackets, sweat suits, pants and playsuits" in Class 25. Applicant submits that confusion between its mark and the registered mark is unlikely, for the following reasons:

Pursuant to Section 2 of the Lanham Act, 15 U.S.C.A. § 1052,

> No trademark by which the goods of an applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –
>
> (d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when applied to the good of the applicant to cause confusion, or to cause mistake or to deceive . . . .

15 U.S.C.A. § 1052. Likelihood of confusion is determined on a case-by-case basis by application of the factors identified in *In re E.I. duPont DeNemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973).[1] Here, the differences between the parties' respective marks and goods confirm a lack of potential confusion between the marks at issue.

A. The Parties' Marks are Sufficiently Different

This factor examines "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *In re duPont*, 177 U.S.P.Q. at 567.

[1] The thirteen factors are: (1) Similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) Similarity and nature of the goods and services; (3) Similarity of established, likely to continue channels of trade; (4) Conditions under which and to whom sales are made, i.e. "impulse" vs. careful, considered purchases; (5) Fame of the prior mark (sales, advertising, length of use); (6) Number and nature of similar marks in use on similar goods; (7) Nature and extent of any actual confusion; (8) Length of time and conditions under which there has been concurrent use without evidence of actual confusion; (9) Variety of goods on which a mark is used; (10) Market interface between applicant and the owner of a prior mark (consent; agreement re: confusion; assignment); (11) Extent to which applicant has a right to exclude others from use of its mark on the goods; (12) Extent of potential confusion, i.e. de minimis or substantial; and (13) Any other established fact probative of the effect of use.

According to the Federal Circuit,

> [M]arks must be considered in the way they are perceived by the relevant public, in determining likelihood of confusion. Although it is often helpful to the decisionmaker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared.

See Opryland USA, Inc. v. Great American Music Show, Inc., 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992) (emphasis added). Here, the differences in appearance and commercial impression between the cited mark and Applicant's mark alleviate any possibility of confusion.

It is well settled that marks are not similar for purposes of assessing likelihood of confusion simply because they contain an identical or nearly identical word. *See Champagne Louis Roederer v. Delicato Vineyards*, 47 U.S.P.Q.2d 1459, 1460 (Fed. Cir. 1998) (contemporaneous use of the marks CRISTAL and CRYSTAL CREEK for wine would not result in a likelihood of confusion, despite the fact that plaintiff's mark was strong and the goods were identical); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 228 U.S.P.Q. 364 (Fed.Cir.1986) (no likelihood of confusion between ROMANBURGER for prepared sandwiches and ROMAN MEAL and related marks for bread and hamburger buns due to differences between the marks); *Keebler Company v. Murray Bakery Products, Inc.*, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) (PECAN SHORTEES for cookies not likely to cause confusion with PECAN SANDIES for the same goods); *Kellogg Co. v. Pack 'Em Enterprises, Inc.*, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (FROOTEE ICE and design for flavored ice bars not likely to cause confusion with FROOT LOOPS for breakfast cereal and related products); *General Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270, 1278 (T.T.A.B. 1992) (notwithstanding the identity of the goods, the marks FIBER ONE and FIBER 7 FLAKES are sufficiently dissimilar such that

consumers are not likely to be confused). Notably, each of these cases involved identical or closely related products.

Here, while the parties' marks share some of the same elements, namely, the terms "ANGEL" and "FACE," they are differentiated by the fact that Applicant's mark also contains a highly distinctive design element consisting of a female portrait. Moreover, Applicant's mark is displayed in distinctively stylized lettering. Given these differences, the marks are sufficiently differentiated such that confusion is unlikely.

B. <u>The Parties' Goods are Sufficiently Different</u>

In addition, the parties' goods are different such that confusion is not likely. Applicant's goods, which are in the nature of men's and women's athletic footwear, footwear and shoes, are different from the children's clothing cited in the ANGEL FACE registration.

There is no *per se* rule that all clothing items are related for purposes of determining whether a likelihood of confusion exists. *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984). In fact, even similar marks have been held to be not confusingly similar when used on different items of apparel. *See In re The Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988) (no likelihood of confusion between PALM BAY for women's shoes and PALM BAY for men's, women's and children's shorts and pants); *Clark & Freeman Corp. v. Heartland Co.*, 811 F. Supp. 137 (S.D.N.Y. 1993) (no likelihood of confusion between HEARTLAND for shirts, sweaters, trousers and jackets and HEARTLAND for men's shoes and boots); *H. Lubovsky, Inc. v. Esprit de Corp*, 627 F. Supp. 483 (S.D.N.Y. 1986) (no likelihood of confusion between ESPRIT for clothing and ESPRIT for women's shoes). Notably, each of these cases involved a determination of whether shoes were related to certain other items of wearing apparel.

The court in *Clark & Freeman Corp. v. Heartland Co.* considered defendants' shirts, sweaters, trousers and jackets and plaintiffs' men's shoes and boots to be "separate lines of merchandise." 811 F. Supp. 137 at 138. In *H. Lubovsky, Inc. v. Esprit de Corp*, the court found "an appreciable distance between plaintiff's shoes and defendant's clothing, which diminishes the likelihood of confusion. Shoes are generally sold in shoe stores or shoe departments of department stores. Most frequently, therefore, they are either in a different store, or a different department, from sportswear." 627 F. Supp. 483 at 488. Likewise, in the present case, the goods in Applicant's mark will be sold in stores or departments of stores that specialize in shoes, whereas the goods in the registered mark are likely sold in entirely different stores or departments of stores. In addition, registrant's clothing is specifically designed for children, whereas Applicant's goods will be marketed to and appeal to adult men and women, very different classes of purchasers.

As such, there is little proximity between the parties' respective goods, and the parties can safely co-exist without a hint of possible consumer confusion. In *Sunenblick v. Harrell*, 895 F. Supp. 616, 628 (S.D.N.Y. 1995), *aff'd without op.*, 101 F.3d 684 (2d Cir. 1996), the court found no likelihood of confusion between the senior user's mark UPTOWN RECORDS, used as a label for jazz recordings, and the junior user's mark MCA/UPTOWN RECORDS, used as a label for rap recordings, primarily based upon the differences in proximity between the two products:

> ***Although the products are sold in the same channels of trade, they are not sold side-by-side; rather, they are featured in different sections of the stores in which they are sold, according to genre and not by label name.*** Hence, absent any evidence that consumers of one will be potential consumers of the other, it is most likely that the consumer entering a record store with the intention of purchasing one of [plaintiff's] products would not

> even see defendants' products, much less the trademarks appearing thereon.

Id. at 629-30 (emphasis added). *See also Inc. Pub. Corp. v. Manhattan Magazine*, 227 U.S.P.Q. 257 (S.D.N.Y. 1985) (lack of product proximity and audience appeal reduced likelihood of confusion between two competing business publications). Such is the case here.

SUMMARY

For the reasons stated herein, Applicant respectfully urges the Board to sustain this Appeal and grant registration of Applicant's Application Serial No. 77/211,233.

Dated: Norwalk, Connecticut
July 22, 2008

Respectfully submitted,

THE APPLICANT,

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