

From: Khan, Ahsen

Sent: 8/27/2008 9:39:59 AM

To: TTAB EFiling

CC:

Subject: TRADEMARK APPLICATION NO. 77211233 - ANGEL FACE - GIP023UST

Attachment Information:

Count: 1

Files: 77211233.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/211233

MARK: ANGEL FACE

CORRESPONDENT ADDRESS:
EDMUND J. FERDINAND, III
GRIMES & BATTERSBY, LLP
488 MAIN AVE STE 3
NORWALK, CT 06851-1008



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

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

APPLICANT: Grapevine Intellectual Properties,
LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
GIP023UST

CORRESPONDENT E-MAIL ADDRESS:
Ferdinand@gandb.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the examining attorney's final refusal to register the proposed mark "Angel Face" plus a design consisting of the face of a woman for good identified as "men's and women's athletic footwear, footwear and shoes" in International Class 25.

Registration has been refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in US Registration No. 2370580, "Angel Face" for goods identified as "Children's clothing, namely, tops, bottoms, jackets, sweat suits, pants, and playsuits" as to be likely to cause confusion, to cause mistake, or to deceive.

FACTS

On June 20, 2007, an application was filed seeking to register the proposed trademark, Angel Face plus a design on the Principal Register for goods subsequently amended to consist of “men's and women's athletic footwear, footwear and shoes” in International Class 25.

In an office action mailed on September 22, 2007, the examining attorney refused registration of the applicant’s proposed mark pursuant to Section 2(d) of the Trademark Act on the grounds that the proposed mark is confusingly similar to the marks shown in U.S. Registration No. 2370580. The registered mark is “Angel Face” for “Children's clothing, namely, tops, bottoms, jackets, sweat suits, pants, and playsuits.” In addition, the examining attorney required the applicant to submit a statement indicating whether the design in the mark represented a living individual and a new drawing.

On March 24, 2008 the applicant responded by providing the required statement and drawing as well as submitting arguments against the refusal issued under Section 2(d).

The examining attorney made the refusal final under Section 2(d) on April 16, 2008.

A Notice of Appeal was subsequently filed on April 25, 2008. Thereafter, the applicant filed its brief on July 22, 2008.

ISSUE

Whether the proposed mark, “Angel Face” combined with the pictorial representation of a woman is likely to cause confusion with the registered mark “Angel Face” pursuant to Trademark Act Section 2(d) 15 U.S.C. Section 1052(d).

ARGUMENT

THE APPLICANT’S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANT’S MARK BECAUSE THE WORD PORTION OF THE APPLICANT’S MARK IS IDENTICAL TO THE ENTIRETY OF REGISTRANT’S MARK AND BECAUSE THE GOODS OF BOTH PARTIES ARE RELATED.

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1073), 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 similarity of the goods. Similarity in any one of these elements is sufficient to find a likelihood of confusion. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. 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).

A. THE MARKS ARE HIGHLY SIMILAR

A comparison of the applicant's proposed mark "Angel Face" plus a design consisting of the face of a woman with the registrant's mark "Angel Face" shows that the marks are quite similar in appearance, meaning, and overall commercial impression.

The literal portion of applicant's mark is identical to the entirety of registrant's mark and the addition of a design element to applicant's mark does not obviate the similar nature of the marks because 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 and/or services. 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); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii).

The literal portion of applicant's mark is the dominant element in the mark and applicant's argument that the addition of a design element to its mark causes it to create a different commercial impression than the registrant's mark is therefore unpersuasive.

Applicant's additional argument that its mark is "displayed in distinctively stylized lettering" is also unpersuasive because the registrant's mark is in standard character format. Applicant's Brief at 7. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and

not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form will not generally avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

The literal elements in the marks are identical and as discussed above, the design element in applicant's mark does not obviate the similarities of the marks. As such, the marks create similar commercial impressions.

B. APPLICANT'S GOODS ARE HIGHLY RELATED TO REGISTRANT'S GOODS

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).

Applicant's goods are identified as "men's and women's athletic footwear, footwear and shoes" while registrant's goods are identified as "Children's clothing, namely, tops, bottoms, jackets, sweat suits, pants, and playsuits."

As the third party registrations from the USPTO X-Search database attached in the previous office action show, the goods of the parties, namely "children's clothing" and "men's and women's footwear" are the sort of goods that are likely to emanate from the same source bearing the same mark.

For example, the goods in US Registration 3339204 are identified as "Men's, women's, and children's clothing, namely shirts, T-shirts, muscle t-shirts, tank tops, singlets, tops, blouses, pants, jeans, shorts, sweatshorts, sweatpants, bottoms, trousers, jackets, coats, suits, ties, halters, pullovers, sweaters, vests, leggings, dresses, skorts, rompers, jumpsuits, overalls, leotards, tights, underwear, sleepwear, sleepshirts, pajamas, robes, nightgowns, swimwear, legwarmers, footwear, shoes, boots, sandals, slippers, slipper socks, socks, hosiery, bandannas, caps and hats, headwear, gloves, wristbands, belts" in International Class 25. Of particular relevance is the fact that the goods in US Registration no. 3339204 include both "children's clothing" and "footwear, shoes, and boots" for men and women.

The description of goods in US Registration no. 2814011 also supports the argument that the goods of the parties are related. Here, the goods are identified as “clothing; namely men's, women's and children's clothing, namely, fleece tops and bottoms, caps, head wear, T-shirts, sweatshirts, shorts, tank tops, sweaters, pants, jackets, turtlenecks, jump suits, golf shirts, jerseys, wristbands, warm up suits, swim wear, wind resistant jackets, raincoats, parkas, ponchos, gloves, ties, suspenders, cloth bibs, sleep wear; namely, robes, night shirts and pajamas, gloves, mittens, knit hats and caps, scarves, aprons, headbands, ear muffs and underwear; footwear, namely, boots, sneakers and athletic shoes” in International Class 25. Again, the goods here include both “children’s clothing” and “footwear, shoes, and boots” for men and women.

The third party registrations discussed above are probative because they show that the goods of the parties are the sort of goods that are likely to emanate from the same source. The fact that the public is likely to believe that these are the sort of goods that are likely to emanate from the same source shows their relatedness. It also refutes applicant’s argument that the goods are not related since the registrant’s goods are for children and its goods are for adults because it shows that clothing for children and footwear for adults will often emanate from the same source.

Also, please note the goods in US Registrations 2781833 and 2885212 identified in part as “Clothing for men, women, children, infants namely-- socks, ankle garters, aprons, ascots, athletic footwear, athletic shoes, athletic uniforms” and “Clothing and shoes for men, women and children, namely, anklets, anoraks, athletic footwear, athletic shoes” respectively. These registrations are particularly relevant because they show that “clothing for children” and “athletic footwear for men and women” are the sort of goods that often emanate from the same source and further refute applicant’s contention that its “athletic footwear for men and women” is not related to registrant goods.

Applicant also argues that its goods will be sold in stores specializing in shoes and that the goods therefore travel through different channels of trade. According to applicant, “shoes are generally sold in shoe stores or shoe departments of department stores.”

Applicant further contends that the goods of the parties are intended for a “very different class of purchasers.” These arguments are unpersuasive for the following reasons.

(1) Applicant’s identification of goods contains no limitations regarding channels of trade. Since neither the application nor the registration contain any limitations regarding trade channels for the goods 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).

Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii).

When the application describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant’s argument that its goods are sold only in its own retail stores is not persuasive There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold.”); TMEP §1207.01(a)(iii).

(2) Even if the applicant’s identification of goods did contain such a limitation it would not be sufficient to show the goods are not related because the attached evidence shows that stores specializing in shoes will still sell various clothing items. For example, the attached website from www.footlocker.com shows shoes being sold in conjunction with clothing items. Also, the attached website from www.ninewest.com shows that company’s shoes being marketed with “apparel” and “dresses.”

(3) Applicant has provided no evidence that its goods and the goods of the registrant travel through different channels of trade or that shows typically travel through differing channels of trade than clothing items. No evidence has been provided to support applicant's contention that applicant's goods "will be sold in stores or department of stores specializing in shoes, whereas the goods in the registered mark are likely to be sold in entirely different stores or departments of stores." Applicant's brief at 8.

(4) Applicant's contention that its goods are intended for a different class of purchasers is also without merit. Although registrant's goods may be intended for *use* by children, the class of *purchasers* of registrant's goods is presumably the parents of those children and these individuals are likely to be adult men and women. Since applicant's purchasers will also be adult men and women, the argument that the goods of the parties appeal to different classes of purchasers is not persuasive.

Based on the evidence discussed above and the case law cited in the previous office actions, it seems clear that the goods of the parties are highly related.

CONCLUSION

The literal element of applicant's mark is identical to the entirety of registrant's mark, "Angel Face." The addition of a design element to applicant's mark does not obviate the

similar nature of the marks since the wording “Angel Face” is the dominant element of applicant’s mark. The goods of the parties are highly related because they are the sort of goods that are likely to emanate from the same source bearing the same mark and travel through similar channels of trade.

For the foregoing reasons, the examining attorney submits that the applicant’s mark “Angel Face” plus a design element is confusingly similar to the mark in US Registration no. 2370580 and that the goods of the parties are highly related. Accordingly, the examining attorney respectfully requests that the refusal to register under Section 2(d) of the Trademark Act be affirmed.

Respectfully submitted,

/Ahsen Khan/
Law Office 113
(571) 272 1479
ahsen.khan@uspto.gov
Odette Bonnet
Managing Attorney
Law Office - 113