Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA314976**

Filing date: **11/03/2009**

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

Proceeding	77336400
Applicant	U.S. Vision, Inc.
Applied for Mark	ATTITUDE EYEWEAR
Correspondence Address	SHERRY H. FLAX SAUL EWING LLP 500 E PRATT STREET BALTIMORE, MD 21202-3133 UNITED STATES sflax@saul.com
Submission	Reply Brief
Attachments	attitudeeye.pdf (6 pages)(262590 bytes)
Filer's Name	Sherry Flax
Filer's e-mail	sflax@saul.com
Signature	/sherry flax/
Date	11/03/2009

Applicant submits this Reply Brief in further support of its request that the final refusal of its application be reversed. In *ex parte* examinations, the issue of likelihood of consumer confusion revolves around the similarity or dissimilarity of the marks and the relatedness of the goods and services. Full consideration of each of the relevant *du Pont* factors leads to the conclusion that the marks are not more likely than not to be confused.

Applicant's Mark is distinguishable from the Registrant's Mark because: (1) the marks, in their entireties, are not confusingly similar; (2) the goods are sufficiently different to obviate any likelihood of confusion; (3) the term "attitude" is a relatively weak mark when used in connection with eye care products; (4) the goods are offered in distinctive channels of trade; (5) consumers of the products offered under the Registrant's Mark are discerning and sophisticated purchasers using a degree of care that would prevent confusion; and (6) any potential confusion would be insignificant.

(a) The dissimilarity of the marks.

The Examining Attorney relies entirely on the similarity in appearance of the marks. There are obvious differences in the sound and commercial impression of the marks. Applicant respectfully submits that its mark connotes a different commercial impression than that of Registrant's ATTITUDE Mark. The word "EYEWEAR" in ATTITUDE EYEWEAR connotes original designs, style, and fashion. Applicant consciously selected the term "attitude" to suggest unique frames, fresh designs, style and fashion. In fact, ophthalmic frames are uniquely identified with fashion in the mind of the consumer because of the fact that so many fashion designers sell collections of ophthalmic frames under their brand names. Although both marks contain the word "attitude," Applicant's mark contains a second word that renders its mark readily distinguishable both visually and phonetically and conveys a different commercial impression.

Many courts have found no likelihood of confusion between marks that shared the same word, even when the common word was the dominant term. In *In re the Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992), the Federal Circuit Court of Appeals reversed the TTAB, holding that VARGA GIRL was not confusingly similar to VARGAS. In reversing the TTAB, the Federal Circuit noted:

> The Board, analyzing the marks for confusing similarity, found that 'varga' was the dominant element of the VARGA GIRL mark, and that 'girl' was merely descriptive and thus could not be afforded substantial weight in comparing VARGA GIRL with

> VARGAS. The Board erred in its analytic approach. Although undoubtedly 'varga' and 'vargas' are similar, the marks must be considered in the way they are used and perceived. . . . Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight. . . . The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component 'girl'. By stressing the portion 'varga' and diminishing the portion 'girl', the Board inappropriately changed the mark. Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word 'girl'. When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.

Id. at 494 (internal citations omitted).

The Examining Attorney overlooked the significance of the word "eyewear" on the basis that it is a descriptive term. Descriptive terms, even ones that have been disclaimed, do not remove the descriptive word from the mark. TMEP § 1213.10. "The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks." *See, e.g., In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983). Thus, even though the term "eyewear" is not the dominant or most significant feature of a mark, it is nonetheless significant in a likelihood of confusion analysis. *See* TMEP § 1213.10. Here, the additional term in Applicant's Mark must be given due weight in this analysis.

When the marks are considered in their entireties, as they must be, they are not confusingly similar in appearance or sound. *See Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993) (finding PARENTS not confusingly similar to PARENT'S DIGEST, because, *inter alia*, "the only similarity concerned the use of the word "parents"); *The Conde Nast Publ'ns, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (C.C.P.A. 1975) (affirming the TTAB's holding that VOGUE and COUNTRY VOGUES were not confusingly similar, noting that the dissimilarities outweigh the shared use of the term "vogue"); *Lever Brothers Co. v. The Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (affirming the TTAB's holding that ALL CLEAR was not confusingly similar to ALL, noting that although there were similarities between the marks, "inspection of the two marks also shows some obvious differences."); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402 (2d Cir. 1970) (holding PEAK not confusingly similar with PEAK PERIOD).

Based on the foregoing, Applicant submits that when considered in their entireties, Registrant's Mark is not confusingly similar to Applicant's Mark.

(b) The dissimilarity of the goods.

The Examining Attorney states that the goods are identical or closely related. Both parties use their marks in connection with sunglasses optical products. Significantly, Registrant's Mark is registered only for eyeglass lenses. Applicant's goods, on the other hand, are for the finished product -- eyeglasses, sunglasses, and accessories. Applicant does not seek to register its mark for lenses.

Consumers are well aware that providers of "eyewear," such as Applicant, do not make the lenses for eyeglasses. The retail consumer purchasing decision of eyeglasses involves choosing a frame that fits correctly and looks appealing on his or her face. The manufacturer or "brand" of the lenses is not something that the consumer even comes into contact with, even if a prescription for those lenses is involved. Accordingly, there is a manifest distinction in the goods provided by Applicant and Registrant, particularly when the purchasing of these products is considered in accordance with *duPont*. Despite that Applicant and Registrant operate in the broad field of optical goods, it is well accepted that use of even an identical mark in the same general field "is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992) (*quoting Astra Pharmaceutical Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786, 790 (1st Cir. 1983) (finding no likelihood of confusion for use of identical mark ASTRA on blood analyzer machine and on pharmaceutical products, both sold to hospitals, even if sold within the same hospitals). Just as the healthcare field is not a homogeneous whole, the optical goods field is similarly vast and diverse. If the marketplace can accommodate an ASTRA blood analyzer unit and ASTRA drug products marketed to and sold within the same hospitals, surely the market can accommodate Applicant and Registrant marketing their different goods to different consumers. Accordingly, it would be error to deny registration simply because Applicant and Registrant sell different eye wear products. *See Electronic Design & Sales, Inc.*, 954 F.2d at 716-17.

(c) The weakness of the term "ATTITUDE"

"Whether a mark is classified as 'strong' or 'weak' is a very important element in deciding likelihood of confusion. If the common element of conflicting marks is a word that is 'weak' then this reduces the likelihood of confusion." J. Thomas McCarthy, McCarthy on

Trademarks and Unfair Competition, § 23:48, at 23-150 citing Independent Grocers' Alliance Distributing Co. v. Potter-McCune Co., 404 F.2d 622 (C.C.P.A. 1968).

Use by many sellers render a mark weak and obviate a likelihood of confusion. In *Comerica Inc. v. Fifth Third Bancorp*, 282 F. Supp. 2d 557 (E.D. Mich. 2003), no likelihood of confusion was found between FLEXLINE and FIFTH THIRD EQUITY FLEXLINE based, in large part, to the widespread use of the term "flexline" in the banking industry and the fact that there were ***two*** federal registrations employing the term "flexline." The court stated:

> Fifth Third has shown that FLEXLINE is being used in connection with banking services offered nationwide by at least twenty-two other banks, primarily with a home equity loan product. Fifth Third has also shown that FLEXLINE is being used in connection with products other than financial products. These uses in addition to the federal registrations of FLEXLINE and FLEX LINE PLATINUM PLUS for financial services in the form of credit cards indicates that the mark is weak as it is commonly used. . . . '[E]xtensive third-party use of the disputed term indicates that the term itself deserves only weak protection.'

Id. at 569 (*quoting First Savings Bank F.S.B. v. First Bank Sys., Inc.,* 101 F.3d 645, 654 (10th Cir. 1996).

The use of the common term ATTITUDE in other registrations for optical goods supports reversal of the refusal to register. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626-27 (8th Cir. 1987) (finding no likelihood of confusion between OATMEAL RAISIN CRISP and APPLE RAISIN CRISP because the "mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related" and "the greater number of identical or more or less similar trademarks already in use, the less is the likelihood of confusion."); *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.,* 616 F.2d 440, 445 (9th Cir. 1980) (affirming that there was no likelihood of confusion between ALPHA and ALPHA STEEL TUBE, noting that "ALPHA occurs in widespread use as a tradename or trademark; and that ALPHA as part of a trademark or tradename is weak."); *Triumph Hosiery Mills, Inc. v. Triumph Int'l Corp.,* 308 F.2d 196 (2d Cir. 1962) (no likelihood of confusion between TRIUMPH and TRIUMPH INTERNATIONAL CORPORATION); *Comerica Inc.*, 282 F. Supp. 2d 557; *24 Hour Fitness USA, Inc. v. Tribeca Fitness, LLC,* 277 F. Supp. 2d 356 (S.D.N.Y. 2003) (finding no likelihood of confusion between 24 HOUR FITNESS and 24/7 FITNESS); *Castle Oil Corp. v. Castle Energy Corp.*, 26 U.S.P.Q.2d 1481 (E.D. Pa. 1992) (finding no likelihood of confusion between CASTLE OIL and CASTLE ENERGY). The term

"attitude," commonly used in the optical goods industry and other markets, it is a weak term entitled to little protection. Accordingly, Applicant requests that the refusal to register be reversed.

(d) The dissimilarity of trade channels.

The nature of the trade channels through which the products are marketed and sold is a significant factor in the likelihood of confusion analysis. Here, the differences in the goods result in the products being sold through different trade channels, to different consumers, and used for different purposes. Applicant respectfully submits that these cumulative dissimilarities are sufficient to outweigh any similarity between the respective marks. Indeed, even where marks are identical in appearance and sound, confusion is deemed unlikely if the goods and services bearing the marks are not advertised or sold in such a way that purchasers would be inclined to erroneously believe the services come from the same source. *See, e.g., Dynamics Research Corp. v. Lengenau Mfg. Co.*, 704 F.2d 1575, 217 U.S.P.Q. 649 (Fed. Cir. 1983) (DRC for gauges for press brakes sold to sheet metal fabrication shops held not confusingly similar to DRC for sheet metal fabric); *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156, 1158 (T.T.A.B. 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER for design and preparation of plumbing advertising copy and literature); *Quartz Radiation Corp. v. Comm/Scope Co.,* 1 U.S.P.Q. 2d 1668, 1669 (T.T.A.B. 1986) (QR for coaxial cable held not confusingly similar to QR for photocopiers and blueprint machines).

The Examining Attorney erroneously assumes that "the goods of the registrant and applicant may be used together by a consumer wanting to replace the lenses in their existing eyewear. Additionally, the goods may be found together in the same channels of trade, such as in eyewear stores, and purchased by the same consumer, namely, ones who want to purchase new prescription eyeglasses or sunglasses." Registrant's goods – eyeglass lenses -- are marketed to opticians and ophthalmologists, not to retail consumers. These are sophisticated, discerning consumers who are aware of the sources of the goods they purchase and are not likely to be confused by these marks. Applicant's goods – eyewear and accessories – are marketed to retail consumers. Accordingly, the channels of trade are entirely distinctive and not likely to create consumer confusion.

(e) The goods are purchase after careful consideration.

The Board has reversed refusals of marks for even related goods or services where the targeted purchasers are sophisticated consumers buying expensive goods or services. In *In re Software Design*, the Board held that despite the similarity of the marks DOC'S and DOX for related computer services, they were used in connection with "highly sophisticated, technical, and relatively expensive services, which are likely to be purchased only with care and deliberation after investigation to determine their suitability for specific needs; and under these circumstances, the phonetic similarity between the marks is not as significant as it would be if the marks were used . . . to identify inexpensive, over-the-counter items likely to be orally requested in retail stores." 222 U.S.P.Q. at 663.

Consumers who purchase goods under Registrant's Mark are careful and sophisticated. Similarly, the retail consumers who purchase goods under Applicant's Mark are necessarily careful because they are making significant purchases of expensive products that involves direct communication. These products relate to consumers' vision, requiring the consumers to be more discriminating than individuals purchasing nonessential goods and services. Because Applicant's goods are purchased in an ophthalmologist's or optician's office or optical store, and not in a retail environment, the consumers are likely to be discerning. The relatively high cost of the goods requires care and deliberation on the part of the consumer.

(f) Any doubt should be resolved in favor of Applicant.

Finally, any doubt as to likelihood of confusion should be resolved in Applicant's favor. Publication of the mark will give Registrant the opportunity to oppose registration if it so chooses.

In consideration of the foregoing, Applicant respectfully urges that the refusal to register be reversed and remanded for publication.