

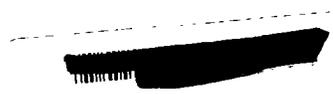


TAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	Margot Lynne Dorfman	)	
	Terry Lynn Williams	)	Examiner: Scott Baldwin
		)	
Serial No.:	78/078,585	)	Law Office: 112
		)	
Filed:	August 10, 2001	)	
		)	
Mark:	<b>U.S. WOMEN'S CHAMBER OF COMMERCE</b>	)	

**Attorney's Reference: 41615-188081**



05-07-2004  
U.S. Patent & TMO/TM Mail Rpt Dt. #22

**APPLICANT'S APPEAL BRIEF**

**INTRODUCTION**

This matter is before the Board on Appeal by the Applicant from a final refusal of registration based upon the section 2(d) of the Trademark Act.

**THE RECORD**

The record for this appeal consists of the application, a number of Office Actions and Responses, a Request for Reconsideration and the Examining Attorney's denial of the Request for Reconsideration.

**THE EXAMINER'S POSITION**

The Examining Attorney has maintained and made "Final" a refusal of registration based upon prior Registration Number 1,522,157 for the mark U.S. CHAMBER OF COMMERCE for "association services, namely promoting the interest of business men and women."

**THE APPLICANT'S POSITION**

It is the Applicant's position that there is no confusion between Applicant's mark and Registrant's mark because the marks are sufficiently distinct from each other.

## ARGUMENT

It is well-settled that in determining likelihood of confusion, the Examining Attorney must look at the marks in their entireties for similarities in appearance, sound, connotation and commercial impression. In re E.I. du Pont de Nemours & Co., F.2d 1357, 177 USPQ 563 (CCPA 1973). Here, that requires looking at the cited mark in its entirety. The cited mark is not identical to Applicant's mark and is readily distinguishable in appearance, sound, and commercial impression. See Kellogg Co. v. Pack'em Enterprises, Inc., 21 U.S.P.Q.2d 1142, 1144 (Fed. Cir. 1991) (finding that the mark FROOTEE ICE in script lettering and an elephant design and the mark FROOT LOOPS in plain capital letters sound differently and create different commercial impressions and the only similarity was that one began with the word FROOT and the other with the word FROOTEE).

One mark is U.S. CHAMBER OF COMMERCE, and the other mark is U.S. WOMEN'S CHAMBER OF COMMERCE. In both marks, the wording CHAMBER OF COMMERCE is a generic designation for the types of services offered, and that wording has been disclaimed. In the registered mark, the registrant has claimed distinctiveness with respect to the geographic designation "U.S." Presumably, if the term CHAMBER OF COMMERCE was capable of any trademark significance at all, the registrant would also have claimed distinctiveness for that term, considering that at the time the registrant filed its application in 1985, it had alleged use of that term for over 70 years (since 1915).

While the Examining Attorney might argue that the marks must be considered in their entireties, disclaimed matter included, clearly, in the present situation, no significance can be given to the fact that both marks contain the common *generic* wording CHAMBER OF COMMERCE, which is void of any trademark significance. That term appears in dictionaries as

defining "an association established to further the business interests of its community." The wording CHAMBER OF COMMERCE has no trademark significance whatsoever as applied to services of the type being offered by the registrant and applicant here.

It is well-settled that if a common portion of the two conflicting marks is a *generic* designation, the comparison must be between the non-generic portions of the marks. See: Beech-Nut, Inc. v. Warner-Lambert Co., 175 USPQ 583 (SDNY 1972) aff'd 178 USPQ 385 (2d Cir. 1973).

The remainder of the Applicant's mark consists of the wording U.S. WOMEN'S, whereas the remainder of the registered mark consists solely of the geographic term U.S.

The Examining Attorney has based the refusal of registration upon the proposition that "the applicant has fully appropriated the registered mark U.S. CHAMBER OF COMMERCE with the mere addition of the descriptive term WOMEN'S." That is not, in fact, the case.

Rather, applicant already owns U.S. Trademark Registration No. 2,644,856 for the mark THE WOMEN'S CHAMBER OF COMMERCE, Registration No. 2,807,531 for the mark INTERNATIONAL WOMEN'S CHAMBER OF COMMERCE and Registration No. 2,807,532 for the mark YOUNG WOMAN'S CHAMBER OF COMMERCE, all covering services substantially identical to those services listed in the present application. The applicant's mark U.S. WOMEN'S CHAMBER OF COMMERCE is, in fact, the applicant adding or substituting the geographic designation "U.S." to its existing marks.

Consumers are far more likely to associate the applicant's U.S. WOMEN'S CHAMBER OF COMMERCE mark with the applicant's THE WOMEN'S CHAMBER OF COMMERCE, INTERNATIONAL WOMEN'S CHAMBER OF COMMERCE and YOUNG WOMAN'S

CHAMBER OF COMMERCE marks than with the registered U.S. CHAMBER OF COMMERCE mark.

**CONCLUSION**

In order to maintain a rejection under Section 2(d), it is not sufficient if confusion is merely "possible." A higher standard is required. See Shatel Corp. v. Mao Ta Lumber & Yacht Corp., 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient."). This burden has not been met in this case.

In view of the foregoing, it is respectfully requested that the refusal of registration be withdrawn.

Respectfully submitted,

By:



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Date: May 7, 2004