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06082/300K62

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/246819

**APPLICANT:** Paul Stuart, Inc.

**CORRESPONDENT ADDRESS:**

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**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

**MARK:** SILKY POWDER

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 06082/300K62

**CORRESPONDENT EMAIL ADDRESS:**

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the Examining Attorney's final refusal to register its mark SILKY POWDER. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on the identified goods, so resembles the mark in U.S. Registration No. 2,843,001 as to be likely to cause confusion, to cause mistake, or to deceive.

**FACTS**

The applicant has applied to register SILKY POWDER, in standard character form, for “Clothing, namely, suits, pants, skirts, and jackets.”<sup>1</sup> In the October 18, 2003 initial Office action, Application Serial No. 78/200085 was cited as a potential bar to registration of the applicant’s mark. Other issues raised in the first Office action were the identification and classification of goods, and a disclaimer of the word “SILKY” apart from the mark as shown. In its April 16, 2004 response, the applicant satisfactorily addressed the identification and disclaimer requirements. Consequently, further prosecution of the application was suspended pending the final disposition of Application Serial No. 78/200085. Application Serial No. 78/200085 matured into U.S. Registration No. 2,843,001 on May 18, 2004. Prosecution of the present application was resumed, and registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant’s mark is confusingly similar to U.S. Registration No. 2,843,001. U.S. Registration No. 2,843,001 is POWDER (and Design) for “clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts and hats.” By Office action dated June 2, 2005, the Section 2(d) refusal was made final. By Office action dated December 5, 2005, the applicant’s request for reconsideration was denied. The sole issue to be decided on appeal is whether the applicant’s mark is likely to cause confusion with the cited registered mark.

## **ARGUMENTS**

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<sup>1</sup> Application Serial No. 78/246819, filed on May 7, 2003, based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b). On September 25, 2003, the applicant filed an acceptable amendment to allege use, and the application was converted to a use-based application under Trademark Act Section 1(a), 15 U.S.C. §1051(a), with a first use in commerce date of July 15, 2003.

**THE APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH U.S. REGISTRATION NO. 2,843,001 UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

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. The Court in *In re E. I. du Pont 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. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). 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).

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co., supra*. Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

**A. The Applicant's Mark and the Registrant's Mark are Similar**

The applicant's mark is SILKY POWDER, in standard character form. The registrant's mark is POWDER (and Design). The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, the marks contain the same dominant wording, "POWDER." The literal portion of the registrant's mark consists solely of the word "POWDER." The applicant's mark consists of the word "POWDER" preceded by the adjective "SILKY."

The applicant essentially has added the descriptive word "SILKY" to the registrant's mark. The mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004).

The applicant argues that the Examining Attorney has violated the anti-dissection rule by giving undue weight to the word "POWDER" in its mark. It is the applicant's position that "since SILKY does modify POWDER, it is that precise reason why the public will not focus on the term POWDER alone. The mark will be interpreted as what it is – a composite mark with each term being given the same weight."

The fact that one feature of a mark may be more dominant than other features of the mark is just one factor to consider when determining similarity of marks. That

determination does not circumvent the first step of the analysis – the Examining Attorney’s determination that the marks are highly similar when compared in their entireties:

[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.

*In re National Data Corp.*, *supra*, at 751.

In this case, the word “POWDER” has been given greater weight in the likelihood of confusion analysis because it is the word that both marks share. The literal portion of the registrant’s mark consists solely of the word “POWDER.” The word “SILKY” in the applicant’s mark modifies the word “POWDER.” It describes a type of “powder,” i.e., “silky” powder. The more dominant word in the applicant’s mark is the noun “POWDER.”

Further, when used in conjunction with clothing, the word “SILKY” is descriptive of clothing that “resembles silk” or is “lustrous.”<sup>2</sup> The applicant has disclaimed the word “SILKY” apart from the mark as shown. Disclaimed matter is typically less significant or less dominant when comparing marks. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). 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. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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<sup>2</sup> See the dictionary definition from *The American Heritage Dictionary of the English Language* (3<sup>rd</sup> ed. 1992), quoted in the October 18, 2003 Office action.

The word “SILKY” has been taken into consideration in the likelihood of confusion analysis. However, it has not been given the same weight as the word “POWDER” because it describes a type of “powder” and because it is descriptive in the context of the applicant’s goods. The commercial impression created by the registrant’s mark is the word “powder.” The commercial impression created by the applicant’s mark is a specific type of “powder,” i.e., “silky” powder. The two marks create a similar commercial impression. The applicant’s “SILKY POWDER” is a subset of the registrant’s more general “POWDER.”

The applicant argues that “the Examining Attorney’s own analysis is inconsistent. In attempting to distinguish over third party registrations cited by Applicant to show the weakness of POWDER, the Examining Attorney considered the registrations in their entirety, contrary to the position taken above.”<sup>3</sup> The Examining Attorney’s analysis is not inconsistent. The applicant’s mark was considered in its entirety. However, for the aforementioned reasons, the word “POWDER” was given more weight in the likelihood of confusion analysis.

The applicant also argues that its “two-word mark SILKY POWDER is visually different from the ‘001 mark POWDER & Design.” The applicant’s mark is in standard character form. A party who presents a standard character drawing cannot assert differences in typestyle. *Squirtco v. Tomy Corp.*, 216 USPQ 937 (Fed. Cir. 1983). Should the applicant’s standard character drawing of the mark be allowed to register, the applicant would be entitled to adopt any style of lettering in the display of its mark, including lettering identical to that used by the registrant.

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<sup>3</sup> The applicant’s third-party registrations will be discussed in detail in subsection C above.

In the applicant's opinion, "It is an oversimplification to state that greater weight should be given to the literal portion and to ignore the design/script elements." The applicant's mark has only a literal portion. It is not claiming any "design/script elements" as part of its mark. Further, the literal portions are generally the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). With respect to the registrant's goods, consumers are going to call stores looking for "POWDER" clothing. When they search the Internet for the registrant's clothing, they are going to search for the word "POWDER" in relation to clothing. In neither instance will consumers look for "a design of small dots coming together to form a black diamond."

The applicant's mark and the registrant's mark contain the same wording, in part, and are similar in sound and commercial impression. The marks are sufficiently similar under Section 2(d) of the Trademark Act such that a likelihood of confusion exists between the marks.

**B. The Applicant's Goods and the Registrant's Goods are Identical, in Part, and are Highly Related**

The applicant's goods are "Clothing, namely, suits, pants, skirts, and jackets." The registrant's goods are "clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts and hats." The goods are

identical, in part. Both the applicant and the registrant manufacture and/or sell pants, skirts, and jackets.

To the extent the clothing items are not identical, they are very highly related. The decisions in the clothing field have held many different types of apparel to be related under Section 2(d). *Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992); *In re Melville Corp.* 18 USPQ2d 1386 (TTAB 1991); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964).

The applicant does not address this issue in its brief, nor does it address how this fact weighs into the overall likelihood of confusion analysis. It is well-settled that if the goods or services of the respective parties are closely related, as is the case here, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992). Thus, the effect of all of the applicant's arguments concerning the differences between its mark and the cited registered mark is lessened by the fact that the goods are identical, in part, and are highly related.

The applicant's clothing items and the registrant's clothing items are identical, in part, and are highly related. Accordingly, the applicant's goods and the registrant's goods are sufficiently related under Section 2(d) of the Trademark Act such that they

could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source.

**C. Third-Party Registrations**

During the prosecution of this application, the applicant submitted copies of five third-party registrations as “evidence of the weak origin-designating function of ‘powder’ for clothing products and entitle[s] marks containing POWDER, including the cited mark POWDER & Design, to only a narrow scope of protection.”

Third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001). Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Notwithstanding the foregoing, five third-party registrations are not compelling evidence that the word “POWDER” is weak when used in conjunction with clothing, especially in light of the fact that the third-party registrations submitted by the applicant create different commercial impressions than the word “POWDER” standing alone. The mark in U.S. Registration No. 2,759,084, is GOT POWDER? and is an obvious play on the famous GOT MILK? advertising campaign. The mark in U.S. Registration No.

2,497,557 is “POWDER ROOM,” which is another name for a women’s restroom. See the attached excerpt from *The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000).<sup>4</sup> The mark in U.S. Registration No. 2,390,622 is POWDER BLU, which is the phonetic equivalent of “powder blue.” “Powder blue” is a “moderate to pale blue or purplish blue” color. *Id.* The mark in U.S. Registration No. 2,267,688, POWDER RIVER, is a geographic location. *Id.* The mark in U.S. Registration No. 1,512,825 is POWDER BANDIT. When used in conjunction with “skiwear and insulated scarves,” the mark suggests that people who wear the clothing enjoy skiing in “light, dry snow.” *Id.*

The applicant also argues that “where the ‘001 mark was allowed over these five prior marks, all of which were filed earlier than the ‘001 mark, there is no basis for the Examining Attorney to conclude that the registration for the ‘001 mark can block Applicant’s distinguishable mark from registration.” Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973).

The applicant’s final argument is that “the evidence of record suggests that the registrant of the ‘001 mark is not concerned about likelihood of confusion among POWDER marks” because it “did not oppose the GOT POWDER? application.” The applicant is in no position to speculate about the registrant’s concerns. In *ex parte* cases, there is no opportunity to hear from the registrant on this or any other issue.

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<sup>4</sup> The Trademark Trial and Appeal Board may take judicial notice of a dictionary definition furnished after an appeal. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ594 (TTAB 1982), *aff’d*, 217 USPQ 505 (Fed. Cir. 1983).

## CONCLUSION

The applicant's mark and the registrant's mark contain the same dominant wording and are similar in sound and commercial impression. The goods are identical, in part, and are highly related. The similarities among the marks and the goods are so great as to create a likelihood of confusion among consumers. Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Accordingly, the Examining Attorney respectfully requests that the Section 2(d) refusal be affirmed.

Respectfully submitted,

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