

06082/300K629-US0

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

In re application of: Paul Stuart, Inc.
Serial No.: 78/246,819
Filed: May 7, 2003
Mark: **SILKY POWDER**

TTAB

Commissioner for Trademarks
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APPLICANT'S REPLY BRIEF



09-26-2006

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TABLE OF CONTENTS

I. INTRODUCTION 1

II. THE EXAMINING ATTORNEY’S ANALYSIS OF APPLICANT’S
MARK DOES NOT COMPORT WITH HER ANALYSIS OF THIRD
PARTY MARKS 1

III. CO-EXISTENCE OF THIRD PARTY REGISTRATIONS MILITATES
AGAINST A FINDING OF CONFUSION 4

IV. CONCLUSION 5

TABLE OF AUTHORITIES

Federal Cases

Assoc. of Co-Operative Members, Inc. v. Farmland Indus., Inc.,
216 U.S.P.Q. 361 (5th Cir. 1982).....4

Conde Nast Publ'ns, Inc. v. Miss Quality, Inc.,
507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975).....3

Crown Overall Mfg. Co. v. Chahin,
89 U.S.P.Q. 582 (W.D. Tex. 1951)3

Fortunoff Silver Sales, Inc. v. Norman Press Inc.,
225 U.S.P.Q. 863 (T.T.A.B. 1985).....4

In re Broadway Chicken,
38 U.S.P.Q.2d 1559 (T.T.A.B. 1996).....4

In re Chatam Int'l Inc.
380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004)3

In re Hearst Corp.,
982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992).....3

In re Melville Corp.,
18 U.S.P.Q.2d 1386 (T.T.A.B. 1991).....4

Secondary Sources

3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION
§ 23:47 at 23-148 (2006).....3

Applicant submits the following in reply to the points raised in the Examining Attorney's Appeal Brief.

I. Introduction

In support of her rejection, the Examining Attorney continues to use different yardsticks in measuring the subject mark and the references cited by Applicant. The Examining Attorney ignores the term SILKY in Applicant's SILKY POWDER and rejects the present mark over POWDER. However, when confronted with the already registered marks GOT POWDER, POWDER ROOM, POWDER BLU, POWDER RIVER and POWDER BANDIT, all for similar goods, the Examining Attorney takes the position that these marks ". . .create a different commercial impression" (Examining Attorney's Brief, at 7).¹

In essence, the Examining Attorney deems irrelevant the fact that Applicant's mark contains two words and no designs, and that the cited mark POWDER & Design (now Reg. No. 2,843,001, hereinafter the "'001 mark") contains one word and a very distinct design. The Examining Attorney continues to look at the word POWDER in the '001 mark in a vacuum and completely ignores the fact that the word is intertwined with and part of a unique design such that the design portion cannot be ignored.

II. The Examining Attorney's Analysis of Applicant's Mark Does Not Comport with Her Analysis of Third Party Marks

The Examining Attorney continues to place undue weight on the word "POWDER" in Applicant's two-word mark "SILKY POWDER" to conclude a likelihood of confusion with "POWDER". Yet, at the same time, she distinguishes the five other prior-registered POWDER - related marks, by looking at those marks in their entireties.

¹ Hereafter "Ex. Br."

In fact, the Examining Attorney takes great pains to discuss the different “commercial impressions” set forth by each of the composite marks in their entirety, without a finding that POWDER is the dominant word in any of these marks. For example, the Examining Attorney asserts that confusion is unlikely between the ‘001 mark and the prior-registered third party mark POWDER RIVER, since consumers will see “POWDER RIVER” in its entirety and think of a geographic location. The fact that POWDER RIVER did not receive a geographic descriptiveness refusal speaks words about the present Examining Attorney’s analysis. Therefore, one can only conclude that the Examining Attorney’s analysis is overreaching and goes far beyond the analysis of the Examining Attorney who allowed the registration. Additionally, the Examining Attorney’s analysis of POWDER BANDIT is equally inopposite. Thus, “When used with ‘skiwear and insulated scarves,’ the mark suggests that people who wear the clothing enjoy skiing in ‘light, dry snow.’” However, that is an argument why POWDER should be considered the dominant part of the mark. The Examining Attorney completely ignores the term BANDIT. The fact is that no one is going to make the mental gymnastics suggested by the Examining Attorney and will consider the composite marks in their entirety, just as they will SILKY POWDER.

More specifically, the Examining Attorney is quick to conclude that consumers will ignore “SILKY” in Applicant’s mark, and focus on “POWDER”. She ignores the fact that Applicant’s mark, in its entirety, suggests to consumers, and sets forth a commercial impression, that the clothing has a smooth texture. In fact, it is submitted that consumers’ first reaction upon seeing Applicant’s mark will be to feel the goods -- thus hardly ignoring the term SILKY. Therefore, “SILKY” is a defining word. At the

very least, “SILKY” is as important as “POWDER” and, contrary to the Examining Attorney’s conclusion, SILKY POWDER will create a commercial impression totally different than the ‘001 Registration.

Further, the Examining Attorney misconstrues case law in an attempt to justify her disregard of the importance of “SILKY” in Applicant’s mark. *In re Chatam Int’l Inc.* does not stand for the Examining Attorney’s proposition that “the addition of a term to a registered mark does not obviate the similarity between the marks.” (Ex. Br. at 3); 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004). Rather, the court actually discussed two prior cases where it found no likelihood of confusion between marks containing nearly a single word difference (VARGA GIRL and VARGAS for calendars and COUNTRY VOGUES and VOGUE for women’s dresses and the fashion magazine, respectively). *Id.* at 1948 citing *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) and *Conde Nast Publ’ns, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975).

Furthermore, it is submitted the Examining Attorney cannot ignore the design of the reference where the ‘001 mark contains a *significant* design element in addition to a scripted font, whereas the Applicant’s mark has no design element. “[I]f one mark consists of a design and a word, and the other mark of merely a word, similarity is usually controlled by determining whether the word or the design dominates the first mark.” 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:47 at 23-148 (2006). Courts have concluded that a design element is dominant if it is more conspicuous than the accompanying words. *Id.*; see also *Crown Overall Mfg. Co. v. Chahin*, 89 U.S.P.Q. 582, 584 (W.D. Tex. 1951) (finding no

likelihood of confusion where the headlight beam image of the registered marks was the dominant feature since it made “a lasting impression on a person’s memory and distinguishes and characterizes these two trade marks”); *see also Assoc. of Co-Operative Members, Inc. v. Farmland Indus., Inc.*, 216 U.S.P.Q. 361, 367 (5th Cir. 1982) (stating, “[W]hen a composite includes both words and a design, the design element is likely to dominant [sic] if it is more conspicuous or well known to the purchasing public.”). Here, the ‘001 mark contains a bold and conspicuous pixelized diamond figure in varying tones with the script word POWDER superimposed on the diamond and forming a part of the design. (See the extension of the black background to accommodate the “o” and “d” in POWDER). Certainly, the diamond design would leave a lasting impression on consumers’ memories and create a commercial impression wholly removed from Applicant’s word mark SILKY POWDER.

III. Co-Existence of Third Party Registrations Militates Against a Finding of Confusion

Contrary to the Examining Attorney’s argument and her citation to *In re Melville Corp.*, third-party registrations for marks on related goods are entitled to consideration in a likelihood of confusion assessment. *See In re Broadway Chicken*, 38 U.S.P.Q.2d 1559, 1566 (T.T.A.B. 1996); *see also Fortunoff Silver Sales, Inc. v. Norman Press Inc.*, 225 U.S.P.Q. 863, 869 (T.T.A.B. 1985). In point of fact, *In re Melville Corp.*, 18 U.S.P.Q.2d 1386 (T.T.A.B. 1991) cited by the Examining Attorney (Ex. Br. at 7) for support that third-party registrations are entitled to little weight actually stands for the proposition that little weight is given to registrations of third party marks for *unrelated* goods). The third-party registrations of POWDER-related marks for similar goods (i.e. clothing) serve as probative evidence that the marks are not particularly distinctive in the field of clothing.

Also, these registrations suggest that the Trademark Office has determined that confusion is unlikely among POWDER-related marks for clothing products.

The Examining Attorney notes (Ex. Br., at 8) that prior decisions and action of other trademark examining attorneys in registering different marks are without evidentiary weight and not binding. However, it is submitted that where five other examining attorneys have allowed the registration of "POWDER" marks, it is the present rejection that should be questioned, not the numerous registrations.

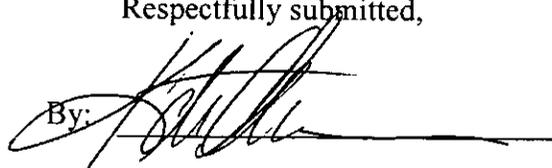
IV. Conclusion

Based on the foregoing and the contents of the Applicant's Brief on Appeal, the Applicant respectfully submits that it has conclusively demonstrated that registration of Applicant's mark SILKY POWDER for the specified goods is unlikely to cause confusion with the registered mark POWDER & Design. The Applicant respectfully requests that the refusal to register be withdrawn, and Applicant's mark be passed to publication.

Date: September 26, 2006

The Commissioner is authorized to charge any deficiency or credit any excess in this fee to Deposit Account No. 04-0100.

Respectfully submitted,

By: 

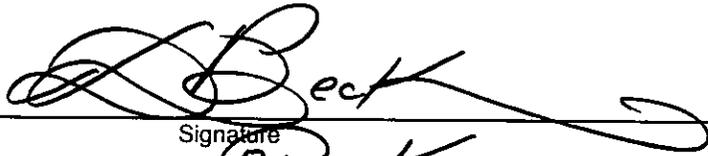
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Applicant's Reply Brief (5 pages)
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