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00012 - Message 1 of 4

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/276739

**APPLICANT:** ORVIS COMPANY, INC., THE



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

**CORRESPONDENT ADDRESS:**  
THOMAS E. YOUNG  
FAY, SHARPE, FAGAN, MINNICH & MCKEE  
1100 SUPERIOR AVENUE, SEVENTH FLOOR  
CLEVELAND OH 44114-2579

**MARK:** STREAMLINE

**CORRESPONDENT'S REFERENCE/DOCKET NO:** OCSE 5 00012

**CORRESPONDENT EMAIL ADDRESS:**  
TYoung@faysharpe.com

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's Final refusal based on Trademark Act Section 2(d), 15 U.S.C. §1052(d), to register the mark.

**Facts.**

On July 21, 2003, the applicant applied to register the mark STREAMLINE for “fishing vests” in International Class 25.

On February 9, 2004, the originally assigned attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), because the mark so

resembled the mark STREAMLINE for “women's and girl's swimwear, leotards and girdles” in U.S. Registration No. 2350414. See attachments.

On February 26, 2004, the applicant responded by arguing against the statutory refusal based on Section 2(d) and on April 19, 2004, the applicant filed notice of recordation of assignment.

On March 10, 2005, the examining attorney issued a final statutory refusal based on Section 2(d) of the Trademark Act.

On September 12, 2005, the applicant filed an appeal and requested for reconsideration.

On February 14, 2006, the then examining attorney denied reconsideration and maintained the final refusal.

On April 7, 2006, the application was again remanded to the examining attorney for reconsideration and on July 1, 2006; the application was assigned to the present examining attorney.

On July 12, 2006, the newly assigned attorney denied the applicant’s request for reconsideration because the marks are identical and the goods are related. On November 28, 2006, the applicant filed its brief.

### **ISSUES**

The issue for consideration in this appeal is whether the applicant’s mark, STREAMLINE, when used on or in connection with the applicant’s goods for “fishing vests” so resembles the mark STREAMLINE in U.S. Registration No. 2350414 for

“women's and girl's swimwear, leotards and girdles” as to be likely to cause confusion or mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act.

## ARGUMENTS

### The Marks

The applicant's proposed mark is STREAMLINE. The registered mark is STREAMLINE. The parties' marks are identical. 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 be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.* Here, there is no dispute as to the fact that the marks are identical as to appearance, sound, meaning and commercial impression. The applicant's proposed mark is STREAMLINE and the registered mark is STREAMLINE. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ

469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963); TMEP §1207.01(b)(iv). The Trademark Trial and Appeal Board (TTAB) should therefore, refuse registration.

### **The Examiner's Treatment of Mark is Consistent**

The applicant argues that it is the owner of a registered identical mark for different goods. The applicant subsequently contends that the application in issue should have been automatically allowed to register without the usual screening because of its prior registration. The applicant cited EXAMINATION GUIDE NO. 1-01 to support its assertion. The applicant's assertion is misdirected because every Trademark application is always treated with consistency in accordance with the EXAMINATION GUIDE guidelines thus the decision to refuse registration was proper. Also, the cited Examination Guide No. 1-01 is primarily for administrative purposes. It has no provision for automatic approval of conflicting marks as applicant asserts. Additionally, the examining attorney argues that 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); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978). Here, the marks are identical and the examining attorney properly refused registration because of likelihood of confusion.

The applicant also argues that its Trademark Registrations 1888631 and 2630583 are allowed to register for fishing tackle and clothing simultaneously. This assertion may be accurate. However, applicant's assertion is misleading because applicant left out an important fact. Unlike the applicant's proposed mark, there are no conflicting identical marks that may bar the aforementioned registrations. It is apparent that those registrations actually deserved to be registered and the Trademark Office properly did so. Also, applicant's argument is misdirected because prior decisions and actions of other examiners in registering different marks are without evidentiary value and are not binding upon the Patent and Trademark Office. Each case is decided on its own facts, and each mark stands on its own merits. TMEP. Section 1207.01. The application in issue therefore merits a refusal because of a conflicting identical mark.

### **Weak Marks are Also Protected**

The applicant further argues that the cited mark is relatively weak and deserves a narrow scope of protection. The applicant listed some registered marks to bolster its argument. The evidence includes registrations for irrelevant goods such as fruit juice and hair dryer. The assertion that the mark is weak is misplaced because the cited marks are neither relevant nor probative in terms of issues at hand. The goods are not in anyway related to clothing. Also, even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services as we have in the instant case. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and

cases cited therein. The Trademark Trial and Appeal Board should therefore refuse registration.

### **The Goods of the Parties**

As to the second prong of the analysis, the goods and/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); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Here, the applicant's goods are fishing vests. The registrant specializes in a variety of clothing goods such as women swimwear. These items may be easily marketed or sold together in retail establishments. See attachments. The rule is that the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, 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. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott*

*Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i). Here, the examining attorney asserts that the clothing goods in issue, namely, fishing vests and some of the registrant's goods such as swimwear are closely related. These clothing items are primarily for recreational purposes for both sexes and may be simultaneously purchased in retail or department stores. Also, fishing vests and swimwear are always marketed side-by-side online as indicated in the evidence of March 10, 2005 and the currently attached evidence. Because the marketing channels are the same and the goods are related, the TTAB should therefore, refuse registration of the proposed mark.

The examining attorney further asserts that if the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *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); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a). Here the goods are related. The examining attorney has provided attached evidence showing that the goods in issue are closely related and it is not uncommon to see swimwear and fishing vests being marketed or displayed side-by-side online or in the department stores. Thus the proposed mark should be refused registration.

**The Goods are Closely Related**

The applicant argues that the goods are not related because its goods are vests and the registrant only specialized in swimwear and other related women's goods. The applicant, additionally claims that unlike the registrant's, its goods are neither snugly nor directed to women. The applicant then concludes that these features will eliminate likelihood of confusion. The examining attorney disagrees and asserts that all clothing goods such as swimwear and fishing vests are related as to marketing. The examining attorney further asserts that both sexes purchase the goods in issue. The office action of March 10, 2005 provided evidence to support examiner's assertion of relatedness of the goods. Also, several rulings pertaining to the goods in issue have considered these goods to be related. It is apparent that 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) ("WINTER CARNIVAL" for women's boots v. men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) ("ELANCE" for underwear v. "ELAAN" for neckties); *In re Melville Corp.* 18 USPQ2d 1386 (TTAB 1991) ("ESSENTIALS" for women's pants, blouses, shorts and jackets v. women's shoes); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) ("NEWPORTS" for women's shoes v. "NEWPORT" for outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) ("OMEGA" for hosiery v. trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) ("GRANADA" for men's suits, coats, and trousers v. ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) ("SLEEX" for brassieres and girdles v. slacks for men and young men).

Despite the applicant's attempts to differentiate the goods in issue, it is apparent that the goods are related and the marketing channels are the same.

### **Purchaser are the Same**

The applicant asserted, "women and girls who purchase swimwear, leotards and girdles are not likely to be fisherman who purchase fishing vests." The examining attorney disagrees because the applicant did not limit its identification of goods to any particular sex. It is reasonable to assume that both sexes do purchase all kinds of vests and swimwear for themselves, children, and spouses. This probably explains why the goods in issue are marketed side-by-side online. Also, the examining attorney asserts that the applicant's identification of goods is particularly broad enough to cover both sexes. As provided in the record, neither the application nor the registration contain any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items. 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 and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Evidence provided by the examining attorney has shown that the goods in issue are related and marketed side-by-side for both sexes. The TTAB should therefore rule for the registrant because applicant's identification of goods is relatively broad.

### **Trade Channels are the Same**

The applicant further argues that its goods are sold in catalogs, fishing stores and online fishing sites. This assertion is misdirected because swimwears are also sold through the same channels such as online and department stores as supported by the office action of March 10, 2005. Although, the applicant contested the relevancy of the examiner's evidence, the examining attorney asserts that the goods of the parties do not have to be available in the same stores for the marks to be considered confusingly similar. *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) ("SLEEX" for brassieres and girdles v. slacks for men and young men). Although, these goods are different and not sold side-by-side, the Trademark Trial and Appeal Board found the marks confusingly similar for these goods. The TTAB should therefore, reach the same conclusion in the instant case. Also, the mere fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the **source** of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Thus the applicant's registration should therefore, be refused.

Moreover, office action of July 12, 2006 provided copies of printouts from the USPTO X-Search database, which showed third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely vests and registrant's, are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214,

1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). The applicant's assertion that some of these registrations are intent to use or foreign-based applications is inaccurate. Most of the registrations in the evidence were registered marks with no foreign filing basis. This evidence supports the examiner's assertion that the goods in issue are related and confusion is likely. The TTAB should therefore refuse registration of the proposed mark.

Finally, it is reasonable to assume that the registrant may expand in the future. Clothing manufacturers and distributors usually expand their consumer base. Thus the examining attorney must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). TMEP §1207.01(a)(v). The examining attorney therefore asserts that the registrant may be offering the goods in issue online or through a catalog in the future if it is not already doing so. Furthermore, it is reasonable to assume that registrant is marketing its products in every reasonable channel of trade. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991);

*McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980).

Finally, the TTAB should decide for the registrant because 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); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i). Accordingly, the final refusal to register should be affirmed.

### **Improperly Submitted Evidence**

The applicant improperly submits evidence that was not previously provided to the trademark examining attorney. The examining attorney objects to this submission as improper as “it has long been standing policy of Patent and Trademark Office not to permit introduction of any evidence into application file record after appeal has been filed.” *In re Gagliardi Bros. Inc.*, 218 U.S.P.Q. 181 (TTAB 1983). *See also In re August Storck, K.G.*, 218 (TTAB 1983); TMEP §2.142(d).

### **CONCLUSION**

For the foregoing reasons, the examining attorney submits that the refusal to register applicant's mark STREAMLINE as used in connection with “fishing vests” on the basis that it is confusingly similar to STREAMLINE in U.S. Registration No. 2,350414 for “women's and girls' swimwear, leotards and girdles” was proper and should be affirmed.

Respectfully submitted,

*/Zachary R. Bello/*  
Trademark Attorney Advisor  
Law Office 111  
USPTO  
571-272-9376

Craig D. Taylor  
Managing Attorney  
Law Office - 111