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

<b>Proceeding</b>	78404496
<b>Applicant</b>	Jose R. Negron Cruz
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

	:	<b>BEFORE</b>
Applicant: <b>José R. Negrón Cruz</b>	:	<b>TRADEMARK TRIAL</b>
Trademark: <b>MIA MODA INTIMA</b>	:	<b>AND</b>
Serial No.: <b>78/404,496</b>	:	<b>APPEAL BOARD</b>
	:	<b>APPEAL</b>
	:	

**APPEAL TO OFFICE ACTION**

Now comes the applicant, José R. Negrón Cruz, represented by the undersigned attorney who, respectfully and by means of this Appeal hereby requests this Trademark Trial and Appeal Board to revoke the examining attorneys decision in the office action rendered on July 1, 2005, by the United States Patent and Trademark Office, denying applicant registration of the trademark "MIA MODA INTIMA", S.N. 78/404,496, on reconsideration.

The bases for our appeal are as follows:

**FACTS**

1. On April 19, 2004, an application was filed for the trademark "Mia Moda Intima"
2. On November 26, 2004, an Office Action was received denying registration.

3. The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because:

"the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration Nos. 1338013 and 2259181, as to be likely to cause confusion, to cause mistake, or to deceive."

4. The alleged likelihood of confusion was with the mark "Mia Shoe Co."
5. On May 24, 2005, a Request for Reconsideration to Office Action was filed by applicant. Applicant argued that the mark "Mia Moda Intima" translated in English to "My Intimate Fashion", and that the trademark must be analyzed as a whole when been compared to the mark "Mia Shoe Co." which translates to English as "My Shoe Co."
6. On July 1<sup>st</sup>, 2005, a Final Office Action was received. In it the examining attorney maintained his previous decision, based on the same reasons and made it Final.
7. It is from that Final Office Action that applicant, respectfully, appeals.

### ARGUMENT

#### I. NO LIKELIHOOD OF CONFUSION

##### A. TRADEMARKS MUST BE ANALYZED AS A WHOLE

It has been a long-standing doctrine of law that when evaluating a mark the Trademark Attorney must analyze a trademark as a whole. Courts should look at the marks "as a whole". Henri's Food Products Co., Inc. v. Tasty Snacks, Inc., 817 F.2d 1303, 2 U.S.P.Q.2d 1856 (7<sup>th</sup> Cir. 1987) In this case the analysis of both trademarks

as a whole can very quickly show immediate differences between the two trademarks and therefore, the probability of confusion by consumers is non-existent.

The judgment criteria in trademark law to check if a conflict exist between trademarks is that create confusion in the minds of consumers. The statute recognizes that there are situations where the concurrent use of similar trademarks is entirely lawful, and there may be "concurrent registrations" where confusion or mistake or deceit of purchasers as to the origin of defendant's goods is not likely to result from the continued use of the marks. 15 U.S.C.A. § 1052 (d).

When evaluating the mark the Trademark Attorney must examine commercial impression of the mark in its totality; they cannot dissect and evaluate each word separately. The test is "overall impression," not a "dissection of individual features". Sun-Fun Products, Inc., v. Suntan Research & Development Inc., 656 F.2d 186, 213 U.S.P.Q. 91 (5<sup>th</sup> Cir. 1981) It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion. Massey Junior College, Inc., v. Fashion Institute of Technology, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974); "Likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark." In re National Data Corp., 153 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)

#### **B. COMPARING FOREIGN MARKS**

"MIA MODA INTIMA" is a completely Italian phrase, while "Mia Shoe Company" is almost completely in English. Furthermore, once translated to the English language "My Intimate Fashion" for "Mia Moda Intima" and "My Shoe

Company" for "Mia Shoe Company", are absolutely different in sound, sight and meaning, not satisfying the three prong analysis for likelihood of confusion. Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 U.S.P.Q. 529 (1970); Clairol Inc. v. Roux Laboratories, Inc., 442 F.2d 980, 169 U.S.P.Q. 589 (1971)

The words in each phrase are not difficult to pronounce, so confusion can not be based upon pure visual similarity. Otoard, Inc. v. Italian Swiss Colony, 141 F.2d 706, 61 U.S.P.Q. 131 (C.C.P.A. 1944) (CALOGNAC—COGNAC); E. Daltroff & Cie v. Vivaudou, Inc., 53 F.2d 536 (C.C.P.A. 1931) (CHEZ MOI—CHEZ LUI)

Even if under the doctrine of equivalents, the English and non- English words have a similar meaning and connotation, that is only one prong of the sound, sight and meaning trilogy of analysis. (McCarthy on Trademarks and Unfair Competition, Fourth Edition, § 23:37.) "[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to source." In re Sarlki, Ltd., 721 F.2d 353 (Fed. Cir. 1983).

A simple look at both phrases and it is undeniable that they do not satisfy the three prong analysis needed to find likelihood of confusion. The first is composed of three Italian words "mia", "moda" and "intima". These words are completely different in sound, sight, and meaning with the English words "shoe" and "company", with the only exception of the word "mia", which in both cases translates to the word "my", a common possessive of both the Italian and the English language.

As stated by McCarthy: "If the two marks alleged to be confusingly similar are *both* foreign words, it may be that the doctrine of foreign equivalents is not applicable,

and the prime comparison should be based on phonetic similarity to the English-speaking customer. Myrurgia, S.A. v. Comptoir de La Parfumerie S.A. Ancienne Maison Tschanz, 441 F.2d 673, 169 U.S.P.Q. 587 (C.C.P.A. 1971) (McCarthy on Trademarks and Unfair Competition, Fourth Edition, § 23:40)

In this case the marks in question are not both foreign and there is no confusing similarity or phonetic similarity between both phrases. The only similarity found is for only one word, the word "mia". Which, as we stated translates to the word "my" in English and is merely a common possessive of the language as well as a common possessive of the Italian language.

The only way to find confusion would be by extracting the word "mia", taking it out of context and forgetting about the rest of the phrase, something that goes against what has been deemed to be axiomatic in determining likelihood of confusion. Such action would be a dissection of a mark when it must be considered as a whole in determining likelihood of confusion. Massey Junior College, Inc., v. Fashion Institute of Technology, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974); In re National Data Corp., 153 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)

### C. MARKS DO NOT IDENTIFY THE SAME KIND OF PRODUCTS

In the case of In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) the Trademark Trial and Appeal Board (TTAB) held that **PLAYERS** for men's underwear was not likely to be confused with **PLAYERS** for shoes. The Board found that the term **PLAYERS** implies a fit, style, color and durability adapted to outdoor activities

when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear.

In a more recent case this Trademark Trial and Appeal Board found no likelihood of confusion between the marks "**Bottoms Up**" for women's and children's underwear and the mark "**Bottoms Up**" for men's suits, coats and trousers. In re Sydel Lingerie Co. Inc., 197 U.S.P.Q. 629, 630 (TTAB 1997)

In that case the trademarks were exactly the same and the goods identified by them were, by analogy and use, almost exactly as the trademarks now before the consideration of this agency. Nevertheless, the TTAB determined that the trademark was also registrable.

Similarly, the mark "Mia Moda Intima", is used to identify "women's underwear and clothing, namely brassieres, panties, pajamas, baby doll pajamas, shirts, jeans, blouses, tops, bathing suits and belts, socks" while the trademark "MIA SHOE COMPANY" is being used to identify shoes.

Furthermore, not only are the marks "Mia Moda Intima" and "Mia Shoe Company" being used for different products but they are composed of completely different words and are written in completely different languages. Words that when translated to the English language have completely different meanings for the exception of the word "mia" which when translated means "my", a common possessive of the language as well as a common possessive of the Italian language, as stated before.

#### D. THERE HAS BEEN NO ACTUAL CONFUSION

As our federal courts have stated "If a defendant's product has been sold for an appreciable period of time without evidence of actual confusion, one can infer that continued marketing will not lead to consumer confusion in the future. The longer the challenged product has been in use, the stronger this inference will be." Versa prods. Co. v. Bifold Co., 50 F.3d 189, 33 U.S.P.Q.2d 1801 (3d Cir. 1995), cert. denied, 516 U.S. 808, 116 S.Ct. 54 (1995) (no likelihood of confusion found) (McCarthy on Trademarks and Unfair Competition, Fourth Edition § 23:18)

This interpretation has continued to be supported by the courts in later proceedings. The second circuit stated that: "If consumers have been exposed to two allegedly similar trademarks in the marketplace for an adequate period of time and no actual confusion is detected either by survey or in actual reported instances of confusion, that can be powerful indication that the junior trademark does not cause a meaningful likelihood of confusion.... In contrast, if numerous instances of consumer confusion have occurred, that suggests a high likelihood of continuing confusion." Nabisco, Inc. v. PF brands, Inc., 191 F.3d 208, 228, 51 U.S.P.Q.2d 1882, 1897 (2d Cir. 1999).

The mark "Mia Moda Intima" has been in use since May 27, 2003, and there is absolutely no evidence of actual confusion with the mark "Mia Shoe Company". Since the mark has been used for more than two and a half years and there has been no evidence of actual confusion it is permissible to infer that there is no

likelihood of future confusion between the marks "Mia Intima Moda" and "Mia Shoe Company"

#### E. CONSIDERING PURCHASERS OF PRODUCTS

Another important factor to consider is to determine, who are the customers to which the product is being marketed? "Rather than consider the similarities between the component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products." Duluth News-Tribune v. Mesabi Pub. Co., 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8<sup>th</sup> Cir. 1996)

The mark "Mia Moda Intima" is applied to women's underwear and clothing, a demographic deemed to have a certain degree of expertise in determining the difference between marks at time of purchase. In fact the courts are supposed to take judicial notice of "a certain degree of sophistication" of women purchasers. Warner Brother Company v. Jantzen, Inc., 2 Cir., 1957, 249 F.2d 353, 354; Avon Shoe Co. v. David Crystal, Inc., 171 F.Supp. 293, 121 U.S.P.Q. 397 (D.N.Y. 1959)

#### CONCLUSION

Wherefore, for the reasons stated above, the applicant, respectfully requests that the United States Patent and Trademark Office's Trademark Trial and Appeal Board revoke the examining attorneys decision and order the registration of the trademark "MIA MODA INTIMA" due to the fact that this trademark is not substantially similar to "MIA SHOE CO.", there is no likelihood of confusion, and

when analyzed as a whole, one can immediately see substantial differences between both trademarks.

Respectfully submitted,

December 9, 2005

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