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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/404496

APPLICANT: José R. Negrón Cruz

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

MARK: MIA MODA INTIMA

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
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4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark "MIA MODA INTIMA" for "women's underwear and clothing, namely, brassieres, pantys, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, socks." Registration was refused on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) on the ground that the applicant's mark was likely to be confused with the prior registered mark "MIA" in U.S. Registration No. 2259181 for "shoes and footwear."

STATEMENT OF FACTS

On April 29, 2004, José R. Negrón Cruz (hereinafter "applicant") applied for registration on the Principal Register for the proposed mark "MIA MODA INTIMA" for

“women's underwear and clothing, namely, brassieres, pantys, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, socks.”

On November 26, 2004, the examining attorney refused registration based on a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) citing U.S. Registration No. 2259181 for the mark “MIA” for “shoes and footwear” and U.S. Registration No. 1338013 for the mark MIA SHOE COMPANY for “shoes.” Additionally, the applicant was required to disclaim the descriptive wording MODA INTIMA.

Applicant in its response filed on May 25, 2005, contested the grounds for refusal arguing that a likelihood of confusion did not exist because: (1) the applicant’s mark MIA MODA INTIMA and the registrant’s mark MIA SHOE STORE are absolutely different in sound, sight, and meaning not satisfying the three prong analysis for likelihood of confusion, (2) MIA MODA INTIMA is a completely Italian phrase, while MIA SHOE COMPANY is almost completely in English, (3) the marks MIA MODA INTIMA and MIA SHOE COMPANY are being used for different products and are composed of completely different words and are written in completely different languages, and (4) there has been no actual confusion. Also, the applicant provided a disclaimer of the wording MODA INTIMA.

The examining attorney, finding applicant’s arguments unpersuasive, made the refusal FINAL in an office action mailed on July 1, 2005 and attached 5 copies of third party registrations supporting said refusal. Thereafter, a Notice of Appeal was filed on December 8, 2005 with a supporting brief.

On March 4, 2006, the cited U.S. Registration No. 1338013 was cancelled
under Section 8. Therefore, the examining attorney **has withdrawn** the likelihood of
confusion refusal under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) for U.S.
Registration No. 1338013 for the mark MIA SHOE COMPANY for “shoes.”

For the reasons to follow, the examining attorney requests that the Board
AFFIRM the refusal under Section 2(d) of the Trademark Act.

ISSUE ON APPEAL

The outstanding issue in dispute is whether applicant’s proposed mark MIA
MODA INTIMA, *in words and design*, for “women's underwear and clothing, namely,
brassieres, pantys, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits,
belts, socks” is confusingly similar to MIA, *in typed form*, for “shoes and footwear” such
that registration should be refused.

ARGUMENT

I. THE PARTIES’ MARKS ARE CONFUSINGLY SIMILAR

Section 2(d) of the Trademark Act bars registration where a mark so resembles a
registered mark, that it is likely, when applied to the goods, to cause confusion, or to
cause mistake or to deceive. TMEP Section 1207.01. The Court in *In re E. I. DuPont de
Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors
to consider in determining whether there is a likelihood of confusion. Among these
factors are the similarities of the marks in terms of appearance, sound, connotation and
commercial impression, and similarities of the goods. *Id.* The overriding concern is to
prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen
U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of

a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

In determining whether a likelihood of confusion exists, the examining attorney must analyze each case in two (2) steps. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

4. **The dominant portion of the Applicant's Mark is Identical to the Registrant's Mark in Sound, Appearance, Meaning or Connotation, and Commercial Impression.**

Applicant requested registration of the mark MIA MODA INTIMA, *in words and design*, for “women's underwear and clothing, namely, brassieres, pantys, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, socks.” Registrant owns MIA, *in typed form*, for “shoes and footwear.”

The dominant portions (MIA) of the marks are identical. The Applicant's mark contains the exceptionally large and dominant word MIA in the middle of the mark, the smaller and less noticeable disclaimed matter MODA INTIMA which when translated means INTIMATE FASHION, and a design element that is merely used to “dot” the letter “I” in the word MIA. 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); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

As previously stated, the disclaimed matter in the Applicant's mark "MODA INTIMA" is highly descriptive or even generic of the goods identified and lack trademark significance. Disclaimed matter is typically less significant or less dominant when comparing marks. 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) (holding that DELTA is the dominant portion of the mark THE DELTA CAFÉ where the disclaimed word "café" is descriptive of applicant's services); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986).

The mere addition of a term, in this case the applicant added the wording MODA INTIMA, to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975)

("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"); TMEP §1207.01(b)(iii).

The registrant's mark is also in typed form. If a mark (in either an application or a registration) is presented in typed form, the owner of the mark is not limited to any particular depiction. The rights associated with a mark in typed form reside in the wording (or other literal element, e.g., letters, numerals, punctuation) and not in any particular display. 1207.01(c)(ii). Therefore, the registrant may add a design feature to its mark in a manner similar to that of the applicant.

Comparing foreign marks

The argument that the marks are written in different languages is not valid. Since the cited U.S. Registration No. 1338013 for the mark MIA SHOE COMPANY was cancelled under Section 8, the only comparisons being made are with U.S. Registration No. 2259181 for the mark MIA for "shoes and footwear." The registered mark MIA conveys the same commercial impression as the dominant word MIA portion of the applicant's mark and both marks can convey to consumers an Italian or Spanish impression. The consuming public could perceive the registrant's goods as Italian or

Spanish shoes and footwear. Therefore, the commercial impressions for the two marks are very similar.

Additionally, consumers who are familiar with the registrant's MIA mark are likely to assume that the applicant's mark MIA MODA INTIMA simply represents a new line of intimate apparel and women's clothing from the same source. Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). As seen in the third party registrations in Exhibit 2, it is typical for manufacturers of shoes and footwear to also have a line of clothing and vice versa.

B. The Applicant's Goods are Closely Related to the Registrant's Goods, and the Goods are Sold in the Same Channels of Trade.

Applicant requested registration of the mark MIA MODA INTIMA, *in words and design*, for "women's underwear and clothing, namely, brassieres, pantys, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, socks." Registrant owns MIA, *in typed form*, for "shoes and footwear."

The second step in the likelihood of confusion test is a comparison of the goods. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). In the determination as to whether a likelihood of confusion exists the issue is not whether a likelihood of confusion exists between particular goods, but rather whether a likelihood of confusion exists as to the

source of those goods. See *In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP Section 1207.01. Further, 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 could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *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).

As earlier advised, the examining attorney finds that the parties' goods are closely related. Shoes and clothes are manufactured by the same companies as well as sold together in retail stores. In support of this position, the undersigned earlier submitted 5 copies of 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 women's underwear and clothing as well as shoes and footwear. [**Please see Exhibit 2. Originally submitted with FINAL office action dated July 1, 2005**]. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely brassieres, panties, pajamas, baby doll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, and socks versus the registrant's shoes and footwear, are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d

1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). The Banana Republic registration shows the typical goods manufactured by a single company, namely, shirts, swimwear, socks, shoes, and footwear.

Neither the application nor the registration(s) 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, i.e., clothing and department stores. 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).

In re British Bulldog and In re Sydel Lingerie Co. Distinguished

In *In re British Bulldog*, the comparison of the goods for commercial impression involved "men's underwear" versus "shoes" for identical marks. The board found that: "'PLAYERS" for shoes implies a fit, style, color and durability adapted to outdoors activities. "PLAYERS" for men's underwear implies something else, primarily indoors in nature." *In re British Bulldog, Ltd*, 224 USPQ 854 (TTAB 1984). However, a distinction can be made from the instant case because the applicant's goods involve more than just women's underwear. The fact that the applicant's goods are not merely women's underwear, but also ordinary clothing items such as shirts, jeans, tops, belts, and socks distinguishes the instant case from *In re British Bulldog*. Furthermore, the argument that the marks create an "indoor versus outdoor" commercial impression is flawed because we

are dealing with more than just women's underwear and thus, the entire identification as written must be analyzed. The applicant's goods are "women's underwear and clothing, namely, brassieres, pantys, pajamas, babydoll pajamas, shirts, jeans, blouses, tops, bathing suits, belts, socks." Clearly, the commercial impression for the registered mark MIA for "shoes and footwear" does not change for the applicant's mark MIA MODA INTIMA for goods such as women's "shirts, jeans, blouses, tops, bathing suits, belts, and tops." The same result occurs when considering *In re Sydel Lingerie Co.*. In *In re Sydel Lingerie Co.*, the goods involved were "women's and children's underwear" versus "men's suits, coats, and trousers." *In re Sydel Lingerie Co.*, 197 USPQ 629 (TTAB 1997). However, a distinction can be made from the instant case because both cases do not involve gender specific goods. The registrant's goods are "shoes and footwear" and could include women's shoes and footwear. Ultimately, the commercial impression for the registered mark MIA for "shoes and footwear" and the applicant's mark MIA MODA INTIMA for goods such as women's "shirts, jeans, blouses, tops, bathing suits, belts, and tops" are the same.

Furthermore, 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).

If the goods or services of the respective parties are closely related, 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*, 23 USPQ2d 1698 (Fed. Cir. 1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

Actual confusion

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant’s assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id.* at 1026-1027.

Accordingly, in view of the above circumstances, the examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register, pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be AFFIRMED.

Respectfully submitted,

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