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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/855556

MARK: CH

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Chrome Hearts LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark, "CH," in stylized font for "clothing, namely, tee shirts, shirts, sweatshirts, sweat pants, sweaters and hats" in International Class 25. Registration was refused under Trademark Act §2(d), 15 U.S.C. §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 No. 3171270 for the mark, "CH," in standard characters for "pants, trousers, shirts, sweaters, pullovers, jackets, socks, dresses, skirts, jerseys, blouses, knit shirts, suits, raincoats, gloves, scarves, foulards, ties, T-shirts, cardigans, shorts, vests, jeans, swimsuits, belts, shoes, boots, hats, caps, headbands, and peaks" in International Class 25, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act §2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq*.

STATEMENT OF FACTS

On April 6, 2006, the applicant filed this use based application for the mark, "CH," in stylized font[1] for "clothing, namely, tee shirts, shirts, sweatshirts, sweat pants, sweaters and hats" in International Class 25.

On July 20, 2006, the examining attorney issued the first office action suspending the application pending the disposition of Application Serial No. 78774331 (Registration No. 3171270) as a potential bar under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). See 37 C.F.R. §2.83; TMEP §§1208 *et seq*.[2]

In its response filed January 12, 2007, applicant argued against the §2(d) refusal claiming that its stylized "CH" lettering distinguished its mark from the registrant's standard character "CH" mark.[3]

On February 28, 2007, the examining attorney removed the application from suspension and issued the second, non-final office action refusing registration of the proposed mark under Trademark Act §2(d), 15 U.S.C. §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 No. 3171270 for the mark, "CH," in standard characters for "pants, trousers, shirts, sweaters, pullovers, jackets, socks, dresses, skirts, jerseys, blouses, knit shirts, suits, raincoats, gloves, scarves, foulards, ties, T-shirts, cardigans, shorts, vests, jeans, swimsuits, belts, shoes, boots, hats, caps, headbands, and peaks,"[4] as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act §2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

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[1] The application describes the mark as consisting of the letters C and H in "old English font." This common font also known as Old English Text MT, is available on the USPTO's version of Microsoft® Word.

[2] The office action also advised applicant that its description of the mark would not be printed. TMEP §808.03.

[3] In its response, applicant noted that the referenced prior pending application Serial No. 78774331 had matured into Registration No. 3171270.

[4] The registration also covers the following goods: perfumery, cosmetics, essential oils for personal use, soaps, talcum powder, shampoos, hair lotions, bath and shower gels, bath salts, not for medical purposes, deodorants for personal use, dentifrices in International Class 3; and handbags, wallets, purses, suitcases, umbrellas, rucksacks in International Class 18.

In its second response filed August 28, 2007, applicant reiterated its arguments against the §2(d) refusal.

On October 25, 2007, the examining attorney issued the Final, third office action maintaining the §2(d) refusal. In support, the examining attorney attached websites of clothing designers and manufacturers that depict their trademarks in various fonts.

Applicant instituted an appeal on April 18, 2008, and filed its appeal brief on June 11, 2008. On June 12, 2008, the applicant's brief was forwarded to the examining attorney.

ISSUE

The sole remaining issue on appeal is whether the applicant's mark, CH, in stylized font for "clothing, namely, tee shirts, shirts, sweatshirts, sweat pants, sweaters and hats" is confusingly similar to the registered mark, CH, in standard characters for "pants, trousers, shirts, sweaters, pullovers, jackets, socks, dresses, skirts, jerseys, blouses, knit shirts, suits, raincoats, gloves, scarves, foulards, ties, T-shirts, cardigans, shorts, vests, jeans, swimsuits, belts, shoes, boots, hats, caps, headbands, and peaks" in US Registration No. 3171270 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act §2(d), 15 U.S.C. §1052(d).

ARGUMENTS

SINCE THE MARKS FEATURE THE IDENTICAL LETTERS, "C" AND "H,"AND THE CLOTHING GOODS ARE IDENTICAL, APPLICANT'S MARK, "CH," IS CONFUSINGLY SIMILAR TO REGISTRANT'S MARK, "CH"

Registration of the proposed mark, "CH," in stylized font, for "clothing, namely, tee shirts, shirts, sweatshirts, sweat pants, sweaters and hats" in International Class 25 has been refused because of a likelihood of confusion with US Registration No. 3171270 for the mark, "CH," in standard characters for "pants, trousers, shirts, sweaters, pullovers, jackets, socks, dresses,

skirts, jerseys, blouses, knit shirts, suits, raincoats, gloves, scarves, foulards, ties, T-shirts, cardigans, shorts, vests, jeans, swimsuits, belts, shoes, boots, hats, caps, headbands, and peaks" in International Class 25. Trademark Act §2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq*.

Trademark Act §2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). 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 when determining whether there is a likelihood of confusion under §2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods are also compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

<u>Goods are Identical</u>

The applicant's goods are "clothing, namely, tee shirts, shirts, sweatshirts, sweat pants, sweaters and hats." The registrant's goods are "pants, trousers, shirts, sweaters, pullovers, jackets, socks, dresses, skirts, jerseys, blouses, knit shirts, suits, raincoats, gloves, scarves, foulards, ties, T-shirts, cardigans, shorts, vests, jeans, swimsuits, belts, shoes, boots, hats, caps, headbands, and peaks." Thus, the goods are identical.

Applicant has not disputed the determination that the goods are identical.

Since the goods of the respective parties are identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Marks are Similar

The applicant's mark is "CH" in stylized font. The registrant's mark is "CH" in standard characters. Comprising of the letters, "C" and "H," and placement of the letters as "C," then "H," the marks are identical.

Applicant has not disputed the determination that the marks comprise identical letters.

Instead, applicant argues that its version of the registered mark features font stylization, described as Old English font, which is sufficiently distinct from registrant's standard character mark. *See*, applicant's Brief, pg. 3. Applicant further argues that registrant should not have "exclusive rights to the block letters CH…" *See*, applicant's Brief, pg. 3. Though applicant appears to be intimating that registrant's mark features a block letter "style," and should be restricted to this font/style, registrant's mark is in standard characters. A mark in standard characters may be displayed in any lettering style because the rights reside in the wording itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). That registrant does not currently depict its mark in Old English font is not the relevant issue since registrant is within its rights to adopt different stylizations of its mark, including applicant's Old English font.

As evidenced by industry practice, clothing manufacturers and designers commonly adopt various fonts and stylizations of their trademarks, including block and script form. For example:

- VICTORIA SECRET® features its trademarks, "VICTORIA SECRET" and "PINK" in simple block lettering, Times New Roman, script and careless scrawls;

- ARMANI EXCHANGE® features its trademarks, "AX," and "ARMANI EXCHANGE" in Times New Roman, and variations of block lettering;

- ABERCROMBIE & FITCH® features its trademarks, "ABERCROMBIE" and "A&F" in block lettering, script and Times New Roman;

- GAP® features its trademark, "GAP," in block and script lettering.

See, office action, October 25, 2007, pgs. 2-20. Thus, applicant's mark presented in stylized lettering will not generally avoid likelihood of confusion with registrant's standard character mark because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). As suggested by applicant, registrant is in fact, free to adopt any style of lettering, including the "old English font" lettering identical to that used by applicant. *See*, applicant's Brief, pg. 3.

Furthermore, when comparing marks that consist of a series of two or more letters, confusion may be more likely because it is more difficult to remember a series of arbitrarily arranged letters than to remember words or figures; that is, confusion is more likely between arbitrarily arranged letters than between other types of marks. *See, e.g., Weiss Assoc. v. HRL Assoc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding confusion between TMS and TMM); *Dere v. Inst. for Scientific Info., Inc.*, 420 F.2d 1068, 164 USPQ 347 (C.C.P.A. 1970) (finding confusion between ISI and I.A.I.); *cf. In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001) (finding confusion between registrant's KING FM and KING-TV and applicant's KYNG). This principle was set forth in *Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 506, 25 USPQ 5, 6 (C.C.P.A. 1935) wherein the Court of Customs and Patent Appeals applied the following reasoning in holding Z.B.T. likely to be confused with T.Z.L.B. for talcum powder: "We think it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures,

syllables, words or phrases. The difficulty of remembering such lettered marks make confusion between such marks, when similar, more likely."

Here, the marks comprise two identical letters, "C" and "H," and feature the identical placement of those letters. Though applicant's mark features stylized lettering, the letters merely appear in a font-type which still clearly portrays the letters as "C" and "H," and still clearly depicts the placement of the letters as "C" and "H." The mark incorporates no design element separate and apart from the font, and features no "highly stylized, highly contrasting letter design logos." *See,* Applicant's Brief, pg. 3 (citing *Textron, Inc. v. Maquinas Agricolas "Jacto" S.A.*, 215 U.S.P.Q. 162 (TTAB 1982); *In re Buty-Wave Products, Co.*, 198 U.S.P.Q. 104 (TTAB 1978)). Thus, applicant's claim that its mark is so highly stylized as to "serve as a source identifier and further fall on the no likelihood of confusion side of the line" is not persuasive. *See,* Applicant's Brief, pg. 3.

Moreover, when determining likelihood of confusion under §2(d), the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). Since the only difference between the marks is applicant's stylization of the letters, the mere addition of the font element does not obviate the similarity of the marks in this case. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

Applicant also argues that its mark warrants registration because "the letters CH in different stylized variations" have been allowed to register. *See*, applicant's Brief, pg. 3. In support, applicant references 1 registration owned by third party, KC New York, LLC. *See*, applicant's Brief attachment, pg. 6. However, this referenced registration features design elements separate from the literal portion of the mark, and appears in such a highly stylized manner that the letters comprising the mark are unclear ("CCH" or "COH" or "H" with 2 semi-circle designs), whereas applicant's mark merely comprises the letters "C" and "H" in Old English font with no additional design component. Furthermore, one registration for an arguably different mark does not constitute "weakness." But even if applicant had shown "weakness" of the wording, "CH," the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that even marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

In any event, third-party registrations are entitled to little weight on the question of likelihood of confusion because they are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *see In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(d)(iii). Prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994). Thus, that "CH" marks, including applicant's (for different goods), or that other famous designer initials for dissimilar marks have registered, does not provide a basis for registrability for this applied-for mark (*see*, applicant's Brief, pgs. 2-3). *AMF*, 474 F.2d at 1406, 177 USPQ at 269; *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

Lastly, applicant alludes to its use of "CH" as predating registrant's use, and questions whether registrant's use of the mark "has raised consumer consciousness to such level that consumers readily identify the letters CH with [registrant] only." *See*, applicant's Brief pgs. 2-3. However, applicant's claim of priority of use is not relevant to this *ex parte* proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Furthermore, an applicant will not be heard on matters that constitute a collateral attack on the cited registration during *ex parte* prosecution. *See In re Dixie Restaurants,* 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Calgon Corp*., 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (C.C.P.A. 1970); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992); *In re White Swan Ltd.*, 8 USPQ2d 1534 (TTAB 1988); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988). Trademark Act §7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During *ex parte* prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Here, the marks comprise the identical lettering, “CH,” and are identical in sound and commercial impression. Thus, applicant’s addition of a font-type to the registered mark with nothing more, does not present a separate commercial impression nor obviate the similarity of the marks. Since the clothing goods are also identical, the applicant’s mark is confusingly similar to the registered mark under Trademark Act §2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq*.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register applicant’s proposed mark under Trademark Act §2(d), 15 U.S.C. §1052(d) be affirmed.

Respectfully submitted,

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