

ESTTA Tracking number: **ESTTA191719**

Filing date: **02/08/2008**

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

Proceeding	78940043
Applicant	Inca Textiles, LLC
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Proceeding	78940043
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 78/940,043

For the Mark INCA MAMA

By Appellant Inca Textiles, LLC

Filed on July 28, 2006

APPELLANTS'S EX PARTE REPLY BRIEF

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ARGUMENT

A. Examining Attorney does not address the incorrect assumption either the word or the design portion must be dominant.

Applicant contested on appeal that there *must* necessarily be a dominant portion in a combined word and design mark. However, Examining Attorney has not responded to this argument. “[I]f one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion.” TMEP 1207.01(c)(ii), citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Notably, the conditional “if” is used to preface this correct statement of the law. In no proceedings thusfar has the Examining Attorney suggested any reasoning why the word or design portion should be dominant.

B. The Examining Attorney provides only conclusory assertion that the word portion is actually dominant over the design portion.

Applicant has disputed the Examining Attorney's assertion that word portion was dominant over the design portion in the '016 registration. Applicant has called attention to the lack of facts or analysis in support of the Examining Attorney's proposition. The Examining Attorney has responded by merely stating that “the word portion is normally accorded greater weight.” Examining Attorney's Brief at 4. As noted above, there need not be a dominant portion. However, a general statement of probability is insufficient to support a finding that the word portion is dominant without any application to the facts of this case or analysis. Without specific application to this case, this general statement is of no evidentiary value and does not support the Examining Attorney's position.

The only factual evidence in the record applicable to the '016 registration (shown at right) supports finding the design portion dominant over the word portion. Consistent with what should be self-evident to any observer, Ms. Dori Rhoades notes in her declaration, “the most striking and dominant element of this trademark is the thin, tall girl in her scant attire.” Decl. of Dori Rhoades p4. Ms. Rhoades also notes that the mark “speaks to young, fashion-conscious girls, and it strongly conveys youthful sexiness.” *Id.* In addition, the tiny words are overwhelmed by the much larger design portion. Given the overall commercial impression of the mark and the relative sizes of the word and design portions, the design portion is dominant.



C. The Examining Attorney's suggestion that all clothing as a general class should be related goods is not supported by the authorities cited.

The Examining Attorney asserts that “decisions in the clothing field have held many different types of apparel to be related.” Examining Attorney's Brief at 3. Implicit in this statement is the suggestion that the “clothing field” should be dealt with as a per se class. However, this proposition has been repudiated by the precise authorities cited in support. “If there ever has been a per se class of goods rule as to wearing apparel, it has already been repudiated.” *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398 (TTAB 1982). In fact, “in the field of wearing apparel, as in any other field, each case must be decided on the basis of the relevant facts.” *Id.* To the degree that the Examining Attorney suggests a presumption that all clothing is to be treated the same, this argument is foreclosed by case law.

Particularly, the cited cases look to the individualized purchasing circumstances. Cited in support is *Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549

(C.C.P.A. 1961). However, this finding was predicated on a finding of “a reasonable likelihood that the same customers would purchase both the boots of registrant and the underwear of applicant.” *Id.* at 624. Similarly, *Jockey Int’l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992), noted that “both underwear and neckties are ordinary items of apparel worn by men.” *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991), noted that goods at issue “are frequently purchased in a single shopping expedition.” *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985), found “the respective goods of the parties are closely related goods particularly when it is considered that persons who are fashion conscious, especially women, are likely to purchase shoes at the same time as and as part of the same shopping transaction as a purchase of outer garments.”

These cases stand in contrast to the current situation. Rather than being purchased in the same shopping transaction or by the same person, Ms. Rhoades notes that the INCA GIRL line of clothing is “marketed to girls and younger women who generally are some time away from planned pregnancy.” Declaration of Dori Rhoades at 3. It is highly unlikely that an expectant mother would purchase non-maternity clothes for immediate wear during the “same shopping transaction” because she cannot wear the clothing for several months and cannot even try them on to see if they fit.

D. The Examining Attorney improperly dismisses Ms. Rhoades declaration.

While Ms. Rhoades contributes significant evidence on the record, the Examining Attorney dismisses Ms. Rhoades declaration because “[h]er opinion of registrant's mark is not indicative of how consumers will perceive the mark or whether consumers are likely to be

confused.” Examining Attorney's Brief at 5. This statement is factually erroneous.

First, Ms. Rhoades' declaration is more valuable because it represents distilled experience over a number of years. The Examining Attorney does not indicate what would be satisfactory evidence, but presumably evidence from an actual consumer would be preferable. For example, Ms. Rhoades states that the '016 registration “speaks to young fashion conscious girls.” Declaration of Dori Rhoades at 3. Ms. Rhoades is not speaking as a fashion conscious girl. The Examining Attorney cannot be suggesting that only a fashion conscious girl has any inkling what this person is thinking, particularly with someone with over ten years of experience as a buyer, manager, and owner of clothing stores. Ms. Rhoades necessarily has strong insight as to what customers are thinking to be able to sustain a career as a clothing buyer.

Second, the customers are likely not as articulate as Ms. Rhoades. With extensive experience in clothing sales, Ms. Rhoades distills impressions from numerous contacts with actual consumers. The Examining Attorney does not indicate what evidence would be satisfactory, but it is unlikely that a single “young fashion conscious girl” would be representative of all customers. In addition, a “young fashion conscious girl” is unlikely to be as articulate as Ms. Rhoades.

Third, the Examining Attorney's reasoning here undercuts the Examining Attorney's own evidence. Ms. Rhoades' declaration merits no consideration apparently because it does not come from actual consumers. However, compilers of the dictionary the Examining Attorney relies on are not actual consumers. Similarly, the Examining Attorney relies on cited court decisions that include findings based on consumer common sense. Judges are clearly not actual consumers, yet the Examining Attorney relies on their authority.

Fourth, the Examining Attorney's complete disregard for Ms. Rhoades declaration is an error of law. There is "no warrant, in the statute or elsewhere, for discarding any evidence bearing on the question of likelihood of confusion." *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1362 (CCPA 1973). However, the Examining Attorney has disregarded this evidence. "Reasonable men may differ as to the weight to give specific evidentiary elements in a particular case." *Id.* Yet, the Examining Attorney did not give this declaration less weight or find that a general purpose dictionary was more persuasive than someone with ten years of experience in the clothing industry. The Examining Attorney erroneously gave this declaration no weight at all, finding the declaration to be "not indicative."

E. Customers need not be knowledgeable in trademarks.

The Examining Attorney asserts that "the fact that purchasers are knowledgeable in a particular field does not necessarily mean that they are knowledgeable in the field of trademarks or immune from source confusion." Examining Attorney's brief at 4. The first portion of sentence is an incorrect statement of the law, while the second is correct. "The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion." TMEP 1207.01. However, "'impulse' vs. careful, sophisticated purchasing" is one of the "factors are usually the most relevant." TMEP 1207.01. In this case, the evidence shows that buyers are not impulse buyers and will take the time to discern differences between Applicant's and the cited marks. Purchaser's sophistication is further bolstered by the dominance of the design portion of the cited mark as argued *supra*. This weighs against likelihood of confusion.

In addition, the Examining Attorney attempts to turn explanatory dicta into a separate requirement that purchasers be knowledgeable. One case does not support the Examining Attorneys contention that customers must be knowledge of trademarks. While the cases cited do say that customers “are not necessarily expert in trademark evaluation or immune from source confusion,” the court did not adopt expertise in trademark evaluation as an additional factor as the Examining Attorney suggests. *In re Pellerin Milnor Corp.*, 221 U.S.P.Q. 558, 560 (TTAB 1983). Notably both cited cases are twenty years old. The Federal Circuit has not only not endorsed an additional factor but has backed away from this phrasing of the rule. *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005) (“Purchaser sophistication may tend to minimize likelihood of confusion.”). Read in light of Federal Circuit precedent, the proper reading of *Decombe* and *Pellerin* is as explaining the underlying reasoning for why sophistication is not dispositive. To the extent that the Examining Attorney claims that knowledge of trademarks is a separate factor or serves to diminish purchaser sophisitication, this argument is unsupported by law and undercut the well-established analysis of purchasers buying on impulse versus higher care and sophistication.

To the extent that the provision above is given force of law, customers’ lack of knowledge of trademarks would likely defeat the Examining Attorney’s arguments that the word portion of a mark is more likely be dominant than the design. If customers are unaware of these cases, customers, rather than scrutinizing the design for an tiny word portion, would find the design portion to be dominant.

CONCLUSION

In light of the arguments herein and of prior record, Appellant respectfully requests that the Examining Attorney's refusal be reversed.

Respectfully submitted,



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