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MARK: INCA MAMA



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

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APPLICANT: Inca Textiles, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

INC-3.001

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant Inca Textiles, LLC has appealed the examining attorney's refusal to register the trademark "INCA MAMA" (standard character mark) under Section 2(d) of the Trademark Act on the basis that it is likely to cause confusion with the registered mark "INCA GIRL" and design (Registration No. 2735016).

FACTS

On July 28, 2006, applicant applied to register the mark "INCA MAMA" (standard character mark) for "maternity wear and clothing for pregnant and nursing women, namely sweaters, wraps, coats, dresses, skirts, shirts, tops, pants, nightgowns and comfort wear." On December 23, 2006, the examining attorney issued a refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based upon a likelihood of confusion with the mark "INCA GIRL" and design in Registration No. 2735016. The examining attorney also 1) cited a prior-filed, pending application as a potential bar to registration under Section 2(d) (Application No. 78851873), and 2) refused registration based on a

requirement for an acceptable identification of goods. On March 27, 2007, applicant filed a response that provided arguments against the refusal under Section 2(d). On May 21, 2007, the examining attorney made final the refusal under Section 2(d) and the requirement for an acceptable identification goods. The citation of the prior-filed, pending application was withdrawn. On October 29, 2007, applicant filed a Request for Reconsideration in which applicant argued against the refusal under Section 2(d) and amended the identification of goods to the following: maternity wear and clothing for pregnant and nursing women, namely sweaters, wraps, coats, dresses, skirts, shirts, tops, pants, and nightgowns. The examining attorney accepted the amended identification of goods, but denied the Request for Reconsideration as to the refusal under Section 2(d). Applicant filed a Notice of Appeal on October 30, 2007 and filed its appeal brief on December 6, 2007. The application file was subsequently forwarded to the examining attorney for her brief.

ISSUE

The sole issue on appeal is whether applicant's mark "INCA MAMA" (standard character mark) is likely to cause confusion with the mark "INCA GIRL" and design in Registration No. 2735016 as set forth under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

ARGUMENTS

I. Section 2(d) – Likelihood of Confusion

A. Overview of Likelihood of Confusion Analysis

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.*

Taking into account the relevant *DuPont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods 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.*

Regarding the issue of likelihood of confusion, all circumstances surrounding the sale of the goods and/or services are considered. *Industrial Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973). These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. In comparing the

marks, similarity in any one of the elements of sound, appearance or meaning is sufficient to find a likelihood of confusion. In comparing the goods and/or services, it is necessary to show that they are related in some manner. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755, 757 (TTAB 1977); TMEP §§1207.01 *et seq.*

B. Applicant's Goods are Related to Registrant's Goods

Applicant's goods are "maternity wear and clothing for pregnant and nursing women, namely sweaters, wraps, coats, dresses, skirts, shirts, tops, pants, and nightgowns." Registrant's goods are "clothing, namely, tee shirts, sweatshirts, shorts, pants, jeans, jackets, skirts, dresses, caps and socks and footwear; namely, shoes, sandals and boots." Therefore, both applicant and registrant have a variety of clothing goods, which specifically include dresses, shirts, pants, and jackets or coats.

Significantly, the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). TMEP §1207.01(a)(iii). In this case, registrant's goods are broadly defined and it is

presumed that they include *maternity* tee shirts, sweatshirts, shorts, pants, jeans, jackets, skirts, dresses, caps and socks and footwear, namely, shoes, sandals and boots.

Even assuming *arguendo* that registrant's goods do not cover maternity clothing, the goods are highly related as many entities provide a variety of clothing items. Additionally, many entities provide both maternity clothing as well as other types of clothing. In this regard, the examining attorney refers to copies of printouts from the USPTO X-Search database, which show third-party trademark registrations demonstrating this and which were attached to the May 21, 2007 final Office action and the November 20, 2007 denial of the Request for Reconsideration. In particular, please see Registration Nos. 2884934, 3211701, 2881016, 3165659, 3137660, 3203280, 3210216, 3181886, 3111784, 3241445 and 3158551. The printouts have probative value to the extent that they serve to suggest that the goods listed therein 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). Similarly, the excerpts from the examining attorney's searches of the Google® internet search engine that were attached to the May 21, 2007 final Office action and the November 20, 2007 denial of the Request for Reconsideration demonstrate that many entities provide both maternity clothing and other types of clothing.

Finally, it is noted 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).

1. The Trade Channels are Similar

Applicant argued that the trade channels for its goods differ from those for registrant’s goods as maternity clothing is often sold in different stores than other types of clothing. Applicant further argued that even online stores provide separate links for maternity clothing and other types of clothing. Applicant’s brief, p. 14-15.

The examining attorney respectfully disagrees with applicant’s analysis. If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all purchasers. *See, e.g., In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). TMEP §1207.01(a)(iii). In this case, it must be presumed that, like applicant, registrant’s goods include those used for maternity purposes. Moreover, neither the application nor the registration contains any limitations regarding trade channels for the goods. Therefore, it is assumed that

registrant's goods and applicant's goods are sold everywhere that is normal for such items, i.e., clothing and department stores. *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).

Additionally, the evidence attached to the November 20, 2007 denial of the Request for Reconsideration demonstrates that many entities and online stores provide maternity clothing as well as other types of clothing. Significantly, the evidence, which includes excerpts from the Ann Taylor Loft®, Gap®, and Old Navy® websites, demonstrates that these entities use the same or similar marks in connection with maternity clothing as well as other types of clothing.

Finally, maternity and other types of clothing cannot be considered unrelated merely because online stores provide multiple links to their clothing goods. For practical reasons an online store must provide many links for consumers to view product information. In this regard, the space on each web page is limited, and the links help consumers to navigate through a website.

2. Confusion is Likely Even if the Purchasers are Knowledgeable

Applicant also argued that confusion is not likely, because purchasers of maternity wear exercise a high level of discretion. Applicant's brief, p. 13. However, even if that is the case, 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. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii).

C. The Marks are Confusingly Similar

Applicant's mark is the standard character mark "INCA MAMA." Registrant's mark is "INCA GIRL" and design.

Applicant argued that confusion is unlikely, because the unique design in registrant's mark is the dominant or most significant portion of the mark. Applicant's brief, p. 6. In support thereof, applicant referred to a declaration by Dori Rhodes, which was attached to the October 29, 2007 Request for Reconsideration.

The examining attorney respectfully disagrees. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). Additionally, as a general rule, consumers are more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

In this case, "INCA" is the first word in each mark. "INCA" is combined with "MAMA" in applicant's mark and with "GIRL" in registrant's mark. "MAMA" may be used to refer to a mother and, informally, to a woman. "GIRL" refers to a woman or young woman (see the definitions attached to the May 21, 2007 final Office action).

While “GIRL” and “MAMA” are not identical, they can be interpreted to have similar meanings. Therefore, the composite terms “INCA MAMA” and “INCA GIRL” create very similar commercial impressions. Moreover, even if “MAMA” in applicant’s mark is interpreted to refer to “mother,” it is likely that consumers would mistakenly believe that “INCA MAMA” and “INCA GIRL” are simply two “INCA” clothing lines provided by one company focusing on women’s clothing.

Additionally, applicant’s mark is a standard character mark. Registration of a mark in standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). Therefore, it is presumed that applicant’s mark may be displayed in exactly the same manner as the term “INCA GIRL” in registrant’s mark.

Finally, with respect to the declaration provided by Ms. Rhodes, it is noted that Ms. Rhodes is the co-owner of a business that represents applicant and markets its goods. Her opinion of registrant’s mark is not indicative of how *consumers* will perceive the mark or whether *consumers* are likely to be confused as to the origin of applicant’s goods. Based on the foregoing, it is clear that confusion as to source is likely.

1. Registrant’s Mark is Not Weak

Applicant also argued that confusion is not likely as the term “INCA” in the registered mark is weak as “INCA” is commonly used in connection with clothing that is highly suggestive of the Incan culture or people. Applicant’s brief, p. 9-10. In support of its argument, applicant referred to several excerpts that were submitted with its March 27, 2007 response and its October 29, 2007 Request for Reconsideration. Applicant’s March 27, 2007 response also included an excerpt allegedly from registrant’s website indicating

that the creator of registrant's goods uses inspiration from her trip to Peru and the Incan trail when creating her goods.

The examining attorney respectfully disagrees. Although a few of the referenced excerpts show the term "INCA" used in connection with clothing items available today, the majority of the evidence submitted by applicant shows the term "Inca" or "Incan" used in connection with either a) goods other than clothing, including alpaca wool and cola, or b) clothing that was actually worn by members of the Incan civilization hundreds of years ago. They do not demonstrate that the term "INCA" is generally weak or highly suggestive of *clothing* offered in *today's* marketplace.

Additionally, even if applicant has demonstrated that the term "INCA" is somewhat suggestive of the style of applicant's goods or those of some other clothing providers, applicant has not provided evidence that it is highly suggestive of registrant's goods. In this regard, "INCA" in registrant's mark cannot be considered highly suggestive simply because the creator of registrant's goods uses "inspiration" from her trip when creating her goods.

Moreover, attached as Exhibit E to applicant's March 27, 2007 response are the only excerpts that applicant provided that appear to be from registrant's website (see attachment pages 38 and 39). Significantly, the mark in the cited registration is not on these two pages. A similar mark, "INCAGIRL," is shown, but only as a web link. Even more significant is that a) the only goods on the webpages are swim suits that do not appear particularly suggestive of the Incan culture and b) the cited registration does ***not*** cover swimwear.

Similarly, applicant's other evidence includes several web pages allegedly depicting registrant's goods and demonstrating how they are marketed (see attachment pages 59-64 from applicant's March 27, 2007 response). However, registrant's "INCA GIRL" and design mark also is not shown on these webpages, and the only goods shown are swimsuits and swimsuit cover-ups or tunics made of sheer materials, which do not appear to be particularly suggestive of "Incan" culture. Based on the foregoing, it simply cannot be presumed from the evidence that the term "INCA" in registrant's mark is weak or highly suggestive of the goods actually identified in the registration.

2. Even Weak Marks Are Entitled to Protection

However, even assuming *arguedo* that 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. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

3. Any Doubt is Resolved in Favor of Registrant

Finally, 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).

CONCLUSION

The foregoing demonstrates that the applicant's mark is likely to cause confusion with the mark in Registration No. 2735016. Therefore, the examining attorney

respectfully requests that the refusal to register under Trademark Act Section 2(d), 15
U.S.C. §1052(d) be affirmed.

Respectfully submitted,

/Maureen L. Dall/

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