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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79145119

MARK: DIAMOND X COLLECTION



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Powerful Vision Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

8280-0001

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1198350

Powerful Vision Limited ("Applicant") has appealed the examining attorney's refusal to register the mark DIAMOND X COLLECTION for "Mirrors; Mirrored bathroom furniture made of plastic, mild

steel, stainless steel and aluminum; mirrored bathroom cabinets made of plastic, mild steel, stainless steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel and aluminum; mirrors enhanced by electric lights” in International Class 20. Registration was refused on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1152(d). In addition, the applicant has appealed the requirement to disclaim the wording “DIAMOND” and “COLLECTION” as merely descriptive for the applicant’s aforementioned goods under Trademark Act Section 6, 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

FACTS

On January 23, 2014, the applicant filed a trademark application for the mark DIAMOND X COLLECTION (standard character) in connection with “Furniture; mirrors; furniture made of wood, plastic, mild steel, stainless steel and aluminium which are not included in other classes; cabinets; bathroom cabinets; mirrored cabinets; mirrors enhanced by electric lights” in International Class 20.

On April 29, 2014, the initial Office action refused registration citing the mark DIAMOND (typed drawing) in U.S. Registration Number 1231958 (“Registration”) as a bar to the registration of applicant’s mark under Trademark Act Section 2(d). In addition, the examining attorney set forth identification and disclaimer requirements.

On September 18, 2014, the applicant’s response argued that the marks DIAMOND and DIAMOND X COLLECTION are dissimilar and that the goods travel in different channels of trade. The applicant deleted unacceptably vague language from the identification, corrected a misspelling, and also deleted “furniture” from the identification of goods (wording that encompassed registrant’s “wooden

cabinets”). Last, the applicant argued the mark is unitary which would overcome the disclaimer requirements issued for “DIAMOND” and “COLLECTION”.

On October 9, 2014, the examining attorney issued a final Office action maintaining the Section 2(d) refusal and disclaimer requirements. On April 9, 2015, the applicant filed a Request for Reconsideration after Final Action that the examining attorney denied on April 30, 2015.

The appeal resumed on May 6, 2015. On July 14, 2015, the applicant filed an Appeal Brief to which this brief pertains. Please note that the examining attorney hereby withdraws the disclaimer requirement for the wording “DIAMOND”.

ISSUES ON APPEAL

The two issues on appeal are the Section 2(d) refusal and disclaimer requirement for the wording “COLLECTION”.

ARGUMENT

A. Section 2(d) Refusal

a. Marks are Confusingly Similar

Registration was refused under Section 2(d) because the applied-for mark DIAMOND X COLLECTION is confusingly similar to registrant’s mark DIAMOND.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Consumers are generally 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); *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).

The applicant argues that the addition of “X COLLECTION” differentiates and distinguishes its mark from the registrant’s mark. The applicant also argues that “the mere fact that both marks incorporate a form of the common term does not render the marks sufficiently similar to establish likelihood of confusion.” *See Applicant’s Appeal Brief at p. 6*. However, three of the four cases cited therein are distinguishable because they involve marks that each contain additional matter in conjunction with the identical shared term. The fourth case cited involved the marks “FINAL” and “FINAL FLIP”¹ and is distinguishable not only because the court made a preliminary finding that the shared term “FINAL” is weak, but also because the applicant’s mark in that case incorporated the distinctive wording “FLIP”, among other factors distinguishing the overall commercial impressions of the marks in that case. *See Bell Laboratories, Inc. v. Colonial Prods. Inc.*, 644 F.Supp. 542, 546-7 (S.D.Fla. 1986).

Without further explanation from the applicant showing how *Bell Laboratories* demonstrates the marks at issue are different, the arguments presented and case law cited are unpersuasive because the wording “DIAMOND” is not weak. In addition, the term “COLLECTION” is descriptive and does not distinguish the applied-for mark DIAMOND X COLLECTION from registrant’s mark DIAMOND in a sufficiently meaningful way to avoid likelihood of confusion where the goods are related. *See Non-final Office action dated April 29, 2014 at pp. 1, 5*.

¹ Applicant incorrectly cites the marks as “FINAL FLIP” and “FLIP.” *See Applicant’s Brief at p. 6*. The marks at issue in the cited case were actually “FINAL” and “FINAL FLIP.” Please note that the court makes a preliminary finding that the mark “FINAL” is weak. *See Bell Laboratories, Inc. v. Colonial Prods. Inc.*, 644 F.Supp. 542, 549 (S.D.Fla. 1986).

The applicant also argues that the applied-for mark “creates a distinct effect on the eye, on the ear, and on the mind from the Registrant’s single word mark, DIAMOND” without listing or explaining these visual, aural or cognitive effects. *See Applicant’s Appeal Brief at p. 6.* As a result, this argument is also unconvincing. Both marks are in standard characters (or the equivalent) and the applied-for mark begins with the shared arbitrary term “DIAMOND” which comprises the entirety of registrant’s mark and the dominant feature of the applied-for mark. The term “X” is weak in Class 20 for furniture, mirrors, and/or cabinets. Further, “X” is the Roman numeral for the number 10. Because the registrant’s mark is DIAMOND, a consumer may interpret the applied-for mark DIAMOND X COLLECTION to be registrant’s tenth annual or seasonal collection of goods. Finally, the term “COLLECTION” is weak, descriptive, and is subject to the disclaimer requirement discussed below.

For the foregoing reasons, the examining attorney found the applicant’s arguments unpersuasive and the overall similarities of the respective marks to outweigh any minor differences.

Therefore, the applicant’s and registrant’s marks share the same overall commercial impression.

b. Trade Channels are the Same

The registrant’s goods are “wooden cabinets.” The applicant’s goods are “Mirrors; Mirrored bathroom furniture made of plastic, mild steel, stainless steel and aluminum; mirrored bathroom cabinets made of plastic, mild steel, stainless steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel and aluminum; mirrors enhanced by electric lights.”

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

The applicant argues that the trade channels of the respective goods are different because the “Registration describes goods narrowly, and incorporates limitation as to their nature, type, channels of trade, or class of purchasers.” However, the applicant’s argument is unconvincing because the registration does not limit trade channels or class of purchasers. Furthermore, the applicant sells registrant’s goods. *See Final Office action dated October 29, 2014 at pp. 3-7.*

The evidence from applicant’s website shows that it sells solid oak bathroom cabinets. The registrant’s goods are “wooden cabinets” which encompass oak bathroom cabinets, demonstrating the relatedness of applicant’s and registrant’s goods since they travel in the same trade channels and emanate from the same source. There is additional evidence of record showing applicant’s mirrors and mirrored bathroom cabinets and registrant’s wooden cabinets travel in the same trade channels, including evidence from third-party furniture retailers Pottery Barn, IKEA, and Wayfair. *See id at pp. 8-42.*

Based on relevant case law and the evidence of record, the applicant’s and registrant’s goods travel in the same trade channels and emanate from the same source.

Therefore, the applicant’s and registrant’s goods are related.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, 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, 1026 (Fed. Cir. 1988).

For the foregoing reasons, the Section 2(d) refusal should be affirmed.

B. Disclaimer Requirement

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods in the marketplace. See *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

The record demonstrates that the applicant uses the term “COLLECTION” descriptively in relation to its own goods. The wording “COLLECTION” refers to “a group of objects or works to be seen, studied, or kept together” and “a line of products produced for one season.” See *Response to Request for Reconsideration dated April 30, 2015 at p. 33*. In this case, the term refers to applicant’s assembly of goods for viewing and purchase as demonstrated by the evidence from applicant’s website which states that “large bathroom mirrors in the collection provide a beautiful focal point.” See *Final Office action dated October 9, 2014 at pp. 44*.

However, the applicant argues that the applied-for mark DIAMOND X COLLECTION is unitary and, therefore, not subject to a disclaimer requirement for the wording “COLLECTION”. The applicant also argues that the mark as a whole is suggestive.

The applicant's arguments are not persuasive because the cases cited in support of these positions are distinguishable because they involve unitary marks, *e.g.* double entendres with suggestive significance or compound words formed with a hyphen. *See TMEP §§1213.05(a)(ii),(c)*. Under current law, applicant's mark does not qualify as unitary nor does applicant explain exactly how or why it should be treated as unitary. The mark DIAMOND X COLLECTION is neither physically unified, nor does it create a cohesive unitary expression such that a disclaimer of "COLLECTION" would be unnecessary.

For the foregoing reasons, the disclaimer requirement under Section 6 for the wording "COLLECTION" should be affirmed.

CONCLUSION

The examining attorney respectfully requests that the Board affirm the Section 2(d) refusal and Section 6 disclaimer requirement.

Respectfully submitted,

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