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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85262439

MARK: "SOLEMATES"



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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: "SOLEMATES", LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

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INTRODUCTION

Applicant is appealing the examining attorney's FINAL refusal to register the standard character mark "SOLEMATES", for the goods, "Jewelry" in International Class 014. The examining attorney has concluded, pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), that applicant's mark, when used on or in connection with the identified goods, so resembles the mark "SOULMATE" in U.S. Registration No. 3306078, for the goods "Jewelry", and "SOULMATE. BECOME ONE. AGAIN." in U.S. Registration No. 3502298, for the goods "Jewelry", respectively, as to be likely to cause confusion, to cause mistake, or to deceive.

FACTS

The examining attorney issued a refusal of registration on 06/15/12 because of a likelihood of confusion with the mark in U.S. Registration Nos. 2935370, 3306078 and

3502298. U.S. Registration No. 2935370 was cancelled on 10/28/2011 and no longer presents a bar to registration. Applicant filed a response to the refusal on 12/24/2011 arguing for withdrawal of the refusal based on differences in the marks and the alleged generic nature of the term SOULMATES or SOULMATE for jewelry, and attached internet evidence of commercial use by third parties of the term SOULMATE or SOULMATES in the context of jewelry. The examining attorney was not persuaded by the arguments or evidence and issued a Final refusal on 01/09/2012. Applicant filed an appeal and request for reconsideration on 07/02/2012 that included additional commercial use of the terms SOULMATE or SOULMATES in the context of jewelry and reiterated the arguments regarding differences in the marks and the alleged generic nature of the term SOULMATES or SOULMATE for jewelry. The examining attorney was again not persuaded by the arguments or evidence and denied the Request for Reconsideration on 07/10/2012.

ISSUE

Whether applicant's use of the mark SOLEMATES for the goods "jewelry" so resembles the registered marks "SOULMATE" and "SOLEMATE. BECOME ONE. AGAIN." for the goods "jewelry," 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.

ARGUMENT

I. COMPARISON OF THE MARKS

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.*

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).

In this case, applicant has applied to register the standard character mark “SOLEMATES”. The registrant’s marks are the standard character marks “SOULMATE” and “SOLEMATE. BECOME ONE. AGAIN.”.

Applicant’s mark is similar in appearance, sound and connotation to registrant’s marks in that they use the phonetically similar terms “SOLEMATES” and “SOULMATE”. In addition, “SOULMATE” is the dominant term of “SOULMATE. BECOME ONE. AGAIN.”

First, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass’n*, 222 USPQ 350, 351 (TTAB 1983);

see In re Viterra Inc., 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

When applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted).

In this case, the mark "SOLEMATES" and the term "SOULMATE" are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are 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)(iv).

Moreover, there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are 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)(iv). For example, consumers calling out for a jewelry good in a retail environment using the term "SOLEMATE" would be unaware of the distinction in spelling between the spelling of "SOLEMATE" in applicant's mark and the spelling of "SOULMATE" in the registrant's marks.

Additionally, it is noted that the slight difference between the plural and singular forms of the phonetically equivalent terms is not enough to obviate the overall similarity between the marks.

Trademarks and/or service marks consisting of the singular and plural forms of the same term are essentially the same mark. See *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is “almost totally insignificant” in terms of likelihood of confusion among purchasers); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962) (finding no material difference between the singular and plural forms of RED DEVIL).

Second, the three marks have a similar overall commercial impression and connotation because of the phonetic similarities of “SOLEMATES” and “SOULMATE”. These terms both suggest that the use of the goods of applicant and registrant are intended for consumers who have a single mate, based on romantic notions.

Third, applicant contends that the use of “BECOME ONE. AGAIN.” with “SOULMATE.” in Registration No. 3502298 creates a sufficiently different commercial impression from the applicant’s mark that it obviates any likelihood of confusion. See Appeal Brief at 6. The examining attorney does not find this argument persuasive because the mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94

USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Despite the additional wording, applicant's mark does not create a distinct commercial impression because it contains, in its entirety, the phonetically similar wording as the dominant portion of the registrant's mark, and there is no other wording to distinguish it from registrant's mark.

Furthermore, consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); *see Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b). Here, the first word of "SOULMATE. BECOME ONE. AGAIN" is the dominant portion of U.S. Registration No. 3502298. The term is the phonetic equivalent of the applicant's entire mark. As discussed above, the commercial impression of the marks "SOLEMATES" and "SOULMATE BECOME ONE. AGAIN." is similar to the extent that both marks suggest the goods are intended for consumers who have a single mate. This connotation is not obviated by the use of the terms "BECOME ONE. AGAIN." in the registered mark.

Finally, if the goods and/or services of the respective parties are “similar in kind and/or closely related,” 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 and/or services. 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). In this case, the goods are identical since all are jewelry. Therefore, the similarities in the spellings and connotations of the phonetically similar terms “SOLEMATES” and “SOULMATE” as used in the registered marks “SOULMATE” and “SOULMATE. BECOME ONE. AGAIN.” is sufficient to support a determination of likelihood of confusion in this case.

Accordingly, the marks are similar for the purposes of a likelihood of confusion analysis.

II. SOULMATE IS NOT A DESCRIPTIVE OR GENERIC TERM FOR JEWELRY

Applicant’s principal argument on appeal is that the term “SOULMATE” is generic in the context of jewelry. See Appeal Brief at 9. Applicant concludes that the registered marks are entitled to little or no scope of protection from subsequent registration of similar marks because “SOULMATE” is generic for jewelry. See Appeal Brief at 15.

Applicant’s supporting evidence includes Internet search results showing third-party use of the terms “SOULMATE”, or “SOUL MATE” or “SOULMATES” as a search term in the context of various jewelry goods. The examining attorney again disagrees with

applicant's conclusions and interpretation of the standards for determining the generic nature of a term for trademark registration purposes, and finds the corresponding third-party use evidence not persuasive on the issue of genericness.

First, the term "SOULMATE" is not a descriptive or generic term for jewelry, but rather is suggestive of the type of intended consumer for the jewelry goods, based on romantic notions. A mark is suggestive if some imagination, thought or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a); *see In re Shutts*, 217 USPQ 363, 364 (TTAB 1983).

In this case, imagination, thought or perception is needed to understand the nature of the goods in the context of the term "SOULMATE" because "SOULMATE" is defined as "one of two persons esp. of opposite sex temperamentally suited to each other." See Appeal Brief at 8. This meaning does not describe jewelry. Further, the examining attorney simply disagrees with applicant's argument that this wording is the apt or common name for the genus of the goods. Accordingly, the relevant public would not understand this designation to refer primarily to that genus of goods because SOLEMATE merely suggests a type of consumer for the jewelry goods, based on romantic notions. Thus, a mental leap, or imagination, is required to associate the term with the goods.

Second, applicant's internet evidence of search results for use of the term SOULMATE in the context of jewelry does not show that the genus of the goods is the term SOULMATE. Rather the evidence merely shows that the term SOULMATE may be used as part of a marketing strategy by various retailers in the context of jewelry goods. The popularity of a suggestive term or phrase used for marketing purpose does make a term generic for the goods. Thus, the website evidence does not show that SOULMATE is a genus of jewelry goods, but rather that it is used in marketing jewelry intended for romantic occasions.

Since the designation SOULMATE is not the genus of the goods, and the public does not understand SOULMATE as to primarily refer to the genus of jewelry, the term SOULMATE is not generic.

Finally, to the extent that applicant's genericness arguments are taken into consideration, it is noted that Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be 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 in connection with the goods or services specified in the certificate. During ex parte prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); *In re*

Pollio Dairy Prods. Corp., 8 USPQ2d 2012, 2014-15 (TTAB 1988). Thus, the evidence and arguments presented by applicant constitute a collateral attack on the cited registrations, and the examining attorney requests that such a collateral attack on the basis of the alleged genericness of applicant's mark be disregarded as not relevant to this ex parte proceeding. See TMEP 1207.01 (d)(IV).

III. APPLICANT'S GOODS ARE IDENTICAL TO THE REGISTRANT'S GOODS

Applicant has not argued against or in any way contested the examining attorney's previous conclusions that the goods are identical. Thus, the examining attorney concludes that applicant concedes this point. In a likelihood of confusion analysis, the comparison of the parties' goods is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In the present case, the applicant's and registrant's goods are each identified as "jewelry." Thus, the goods at issue are identical, and it is presumed that they move in all normal channels of trade and are available to all potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir.

2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); TMEP §1207.01(a)(iii).

Accordingly, the goods are considered related for purposes of the likelihood of confusion analysis.

As a result, the similarities among the marks and the relatedness of the goods and channels of trade of the goods of the parties are so great as to create a likelihood of confusion.

CONCLUSION

Based on the foregoing, the examining attorney respectfully requests that the refusal to register “SOLEMATES” under Section 2(d) of the Trademark Act for the goods identified herein is proper and should be affirmed.

Respectfully submitted,

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