

ESTTA Tracking number: **ESTTA509015**

Filing date: **12/04/2012**

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

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| Proceeding | 85314616 |
| Applicant | Schembechler Enterprises, LLC |
| Applied for Mark | THE TEAM, THE TEAM, THE TEAM |
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| Submission | Appeal Brief |
| Attachments | Schembechler Brief.pdf (11 pages)(120938 bytes) |
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| Date | 12/04/2012 |

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Applicant, Schembechler Enterprises, LLC, through the undersigned counsel, hereby respectfully appeals the Examining Attorney's refusal to register the mark THE TEAM, THE TEAM, THE TEAM.

DESCRIPTION OF THE RECORD

I. PROSECUTION HISTORY

Applicant filed an application to register the mark THE TEAM, THE TEAM ("Mark") with the United States Patent and Trademark Office ("USPTO" or "Office"). The application seeking registration of the Mark was filed May 6, 2011 ("Application"). The Examining Attorney initially refused to register the Mark in a non-final Office Action ("NFOA") on August 27, 2011. Applicant filed its response to the Examining Attorney's NFOA on February 27, 2012 ("Response"). Ultimately, the Examining Attorney refused to register the Mark in a final Office Action ("FAO") on April 5, 2012, basing her refusal under Trademark Act Section 2(b) with respect to U.S. Registration No. 2809492 as applied to clothing and under Trademark Act Section 2(e)(1) as being descriptive as applied to athletic uniforms. Applicant timely filed its Notice of Appeal to the Trademark Trial and Appeal Board ("TTAB") on October 5, 2012.

II. OVERVIEW OF EXAMINING ATTORNEY'S POSITION SUPPORTING NFOA REFUSAL TO REGISTER MARK

In her NFOA, the Examining Attorney refused registration of the applied-for mark as to Applicant's "clothing, namely athletic footwear, athletic uniforms, baseball caps, bathing trunks, Bermuda shorts, caps, cloth bibs, coats, jackets, fleece pullovers, footwear, golf shirts, gym shorts, headwear, hat bands, jerseys, jogging suits, polo shirts, rainwear, shorts, socks, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, tank tops, T-shirts, one piece baby undershirts with diaper cover, shirts, and pants" in International Class 25 because of a likelihood of confusion with U.S. Registration No. 2809492. The cited registration issued January 27, 2004

for the mark TEAM as applied to athletic shoes and sandals for men and boys; dress shoes, sandals, and slippers for women and girls. The Examining Attorney concluded that Applicant's mark THE TEAM, THE TEAM, THE TEAM was similar in sound and appearance and very similar in commercial impression to the mark that was the subject of the cited registration based on the shared use of the word TEAM. While acknowledging differences in sound and appearance, the Examining Attorney concluded that there was not a sufficient change in commercial impression of the proposed mark to overcome a likelihood of confusion with the cited mark. The Examining Attorney further concluded the articles of clothing for which Applicant sought registration of the Mark were closely related to the footwear covered by the cited registration.

The Examining Attorney in the NFOA further refused registration of the Mark on the basis of descriptiveness with respect to "athletic uniforms." The Examining Attorney took the position that the term "TEAM" immediately described the intended consumers of Applicant's goods and that the Mark did not create a unique, incongruous or non-descriptive meaning in relation to those goods.

III. OVERVIEW OF APPLICANT'S RESPONSE TO NFOA IN SUPPORT OF REGISTRATION OF THE MARK

In response to the NFOA, Applicant timely traversed both bases for refusing to register the Mark.

With respect to the refusal to register under Trademark Act Section 2(d), Applicant argued that the Examining Attorney had erred in dissecting the mark and considering it piecemeal to compare only the word TEAM with the mark of the cited registration rather than considering Applicant's Mark as a whole. Applicant argued that the respective marks conveyed significantly different commercial impressions, pointing out that a dramatically different

commercial impression was conveyed by the single-word mark TEAM when compared to the six-word Mark THE TEAM, THE TEAM, THE TEAM. Applicant further argued that the Examining Attorney had mistakenly concluded that Applicant had taken the word comprising the cited mark and simply repeated it three times. In addition, Applicant submitted and made of record third-party registrations as evidence that repetition can, when viewed as a whole, create a new and different mark having a different commercial impression.

In addition, Applicant argued that the refusal to register under Trademark Act Section 2(e) with respect to "athletic uniforms" was erroneous because Applicant's use of the Mark created a different mark with a unique, incongruous and otherwise non-descriptive meaning in relation to the goods such that consumers of athletic apparel would not conclude THE TEAM, THE TEAM, THE TEAM to merely describe the intended users of the athletic clothing.

IV. OVERVIEW OF EXAMINING ATTORNEY'S POSITION SUPPORTING FOA REFUSAL TO REGISTER MARK

In her FOA, the Examining Attorney once again concluded that there was a likelihood of confusion of the applied-for mark with respect to the applied-for clothing items in International Class 25 with respect to the cited mark. The Examining Attorney further again concluded that the applied-for mark was descriptive as applied to "athletic uniforms" under Trademark Act Section 2(e)(1).

LEGAL ARGUMENT

The application stands refused as to goods in International Class 25 on the basis of alleged likelihood of confusion with the mark in U.S. Registration No. 2,809,492 under Trademark Act § 1052(d) and TMEP §§ 1207.01 *et seq.* The application also stands refused as to certain specific goods, namely "athletic uniforms" in International Class 25 as allegedly being merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and TMEP

§§ 1209.01(b), 1209.03, *et seq.* Applicant appeals from the refusal on both of those bases for the reasons set forth below

Trademark Act Section 2(d) Refusal

Turning first to the refusal to register as to goods in International Class 25 based on an alleged likelihood of confusion with the mark of U.S. Registration No. 2,809,492, the mark of the cited registration is "TEAM" (as applied to athletic shoes and sandals for men and boys; dress shoes, sandals, and slippers for women and girls). The Court of Customs and Patent Appeals in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) enumerated factors to be weighed in a Section 2(d) likelihood of confusion analysis. When conducting its likelihood of confusion analysis, the TTAB must consider all *du Pont* factors for which there is evidence in the record. *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). The *du Pont* factors to be considered include the similarity or dissimilarity of the marks in their entireties. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567; *See also In re Majestic Distilling Co. Inc.*, 316 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Each case must be decided on its own facts and any one *du Pont* factor may be dispositive. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998).

The cited mark consists of a single word which appears three separate times in Applicant's THE TEAM, THE TEAM, THE TEAM mark. The Examining Attorney, however, wrongly concluded that Applicant essentially has taken the word comprising the cited mark and repeated it three times. In essence, the position taken in the FOA violates the anti-dissection rule by breaking up Applicant's Mark into component parts and comparing only certain of the component parts to the cited mark. Applicant's mark should be considered in its entirety. *In re the Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920). It is axiomatic

that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion. It is improper to dissect conflicting marks to determine if the commercial impressions were confusing. *Recot, Inc. v. Becton*, 214 F3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000).

Although it is sometimes noted that if the dominant portion of two marks is the same, then confusion may be likely notwithstanding peripheral differences, that proposition does not apply where the marks in their entireties convey significantly different commercial impressions. TMEP § 1207.01(b)(iii). In this case, there is a dramatically different commercial impression conveyed by TEAM when compared to THE TEAM, THE TEAM, THE TEAM. One is a single-word mark. The other is a six-word mark. Moreover, the Examining Attorney erred in supposing that Applicant's mark merely consists of repetition of the word TEAM or that applicant has taken simply word comprising the cited mark and repeated it three times. That is not the case. Applicant's mark is not TEAM TEAM TEAM or even TEAM, TEAM, TEAM. Instead, Applicant's mark is THE TEAM, THE TEAM, THE TEAM. Repetition can create, when viewed as a whole, a new and different mark. See, for example, the registrations for PIZZA!PIZZA! owned by Little Caesar's (one for "restaurant services" and one for "pizza for consumption on or off the premises). (See Registration No. 1,399,730 and Registration No. 1,439,558 made of record during prosecution) Although third-party registrations are, of course, not binding precedent, the foregoing illustrates that consumers would interpret THE TEAM, THE TEAM, THE TEAM to be something other than simply some variant of "team" just as pizza consumers would interpret PIZZA!PIZZA! as something other than just a repetition of the generic word for an Italian dish. In this case, of course, Applicant's mark is not simply a repetition of TEAM and, instead, is the six-word mark (not counting the

punctuation) THE TEAM, THE TEAM, THE TEAM. Considering the overall commercial impression of applicant's mark, it is respectfully submitted that there is no likelihood of confusion with respect to the goods in International Class 25 and it is respectfully requested that the refusal be reversed.

Trademark Act Section 2(e) Refusal

A mark is descriptive when it conveys an immediate idea of the ingredients, qualities or characteristics of the goods. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976). As the TTAB has stated, the conveyance of an idea of the ingredients, qualities or characteristics must be with a degree of particularity. *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981). "[I]f a mark requires imagination, though, and perception to arrive at the qualities or characteristics of the good, then the mark is suggestive." *In-re Nett Designs*, 236 F.3d 1339, 1341, 57 USPQ2d 1564 (Fed. Cir. 2001). Applicant's mark is not descriptive.

Courts and the TTAB have long recognized that a thin line exists between a suggestive mark and one that is merely descriptive. Courts and the TTAB have also long recognized that doubts are to be resolved in Applicant's favor. *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981).

The application stands refused registration with respect to specific goods in International Class 25, namely "athletic uniforms" on alleged mere descriptiveness grounds. In particular, the Examining Attorney in the FOA has concluded that the term "TEAM" immediately describes the intended consumers of applicant's goods. The Examining Attorney in the FOA goes on, however, to recognize that applicant's mark is not TEAM and, instead, is THE TEAM, THE TEAM, THE TEAM, THE TEAM, but assumes that this difference does not overcome the merely descriptive

nature of the applied-form mark in connection with applicant's 'athletic uniforms'. To the contrary, Applicant's use of THE TEAM, THE TEAM, THE TEAM creates a mark with a unique, incongruous and otherwise non-descriptive meaning in relation to the goods. *In re Colonial Stores, Inc.*, 394 F2d 549, 551, 157 U.S.P.Q. 382, 384 (C.C.P.A. 1968). As noted above, just as consumers would, given the overall commercial impression, interpret PIZZA! PIZZA! to be a source identifier for a brand of pizza pie rather than a mere descriptive identifier for the Italian dish, consumers of athletic apparel would not (given the overall commercial impression created by the overall six-word mark) conceive THE TEAM, THE TEAM, THE TEAM to merely describe the intended users of the athletic clothing.

V. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the TTAB reverse the FOA and order registration of the Mark.

Respectfully submitted,

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Dated: December 4, 2012

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CERTIFICATE OF SERVICE

I hereby certify that on December 4, 2012, a copy of the foregoing was filed electronically.

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