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Subject: U.S. TRADEMARK APPLICATION NO. 85314616 - THE TEAM, THE TEAM, THE TEAM - Schembechler - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85314616

MARK: THE TEAM, THE TEAM, THE TEAM



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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: Schembechler Enterprises, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant: Schembechler Enterprises, LLC : BEFORE THE
Trademark: THE TEAM, THE TEAM, THE : TRADEMARK TRIAL
TEAM
Serial No: 85314616 : AND
Attorney: Thomas L. Lockhart : APPEAL BOARD
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STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark THE TEAM, THE TEAM, THE TEAM on the ground of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with the mark in Registration No. 2809492, TEAM, and on the ground that the proposed mark is merely descriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

FACTS

Applicant filed this application on May 6, 2011 applying to register the mark THE TEAM, THE TEAM, THE TEAM for goods in International Classes 9 and 16 and "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.

In the first Office action dated August 27, 2011, registration was refused under Section 2(d) on the ground that the mark, THE TEAM, THE TEAM, THE TEAM, when used in connection with the identified goods in International Class 25, so resembles the mark in Registration No. 2809492, TEAM, as to be likely to cause confusion, to cause mistake, or to deceive and under Section 2(e)(1) on the ground that the mark is merely descriptive of applicant’s goods, “athletic uniforms.”

On February 27, 2012, applicant traversed the Section 2(d) and 2(e)(1) refusals.

On April 5, 2012, the refusal under Section 2(d) was made final as to the goods in International Class 25. The refusal under Section 2(e)(1) was made final as to “athletic uniforms.”

On October 5, 2012, this appeal was filed.

ISSUE

The issues on appeal are

- 1) Whether the mark, THE TEAM, THE TEAM, THE TEAM, when used in connection with the identified goods in International Class 25, so resembles the

mark in Registration No. 2809492, TEAM, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), and

- 2) Whether the mark, when used in connection with “athletic uniforms,” is merely descriptive under Trademark Act Section 2(e)(1).

ARGUMENT

I. BECAUSE THE MARKS CREATE A HIGHLY SIMILAR COMMERCIAL IMPRESSION AND WILL BE APPLIED TO IDENTICAL IN PART AND OTHERWISE CLOSELY RELATED GOODS, CONSUMER CONFUSION AS TO SOURCE IS LIKELY

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01.

(A) SIMILARITY OF THE GOODS: APPLICANT’S IDENTIFIED GOODS ARE IDENTICAL IN PART AND OTHERWISE CLOSELY RELATED TO, AND CAN BE EXPECTED TO EMANATE FROM THE SAME SOURCE AS, REGISTRANT’S GOODS

(1) THE GOODS ARE IDENTICAL IN PART

Analyzing the applicant’s and registrant’s goods for similarity and relatedness is based on the description of the goods set forth in the application and registration at issue. *See*

Octocom Sys. Inc. v. Hous. Computers Servs. Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Neither the application nor the registration contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. See *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); TMEP §1207.01(a)(iii).

Applicant's identified goods are "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."

Registrant's identified goods are "athletic shoes and sandals for men and boys; dress shoes, sandals, and slippers for women and girls."

In this case, applicant's goods "athletic footwear" encompass registrant's goods "athletic shoes and sandals for men and boys." The goods are identical in part.

(2) PURCHASERS WOULD BELIEVE THAT APPLICANT'S GOODS ARE WITHIN REGISTRANT'S ZONE OF EXPANSION

Any goods in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods are related to the applicant's identified goods for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the goods are within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

The types of footwear offered by registrant and the athletic, casual, and infant clothing offered by applicant commonly emanate from a single source. (See evidence from www.nike.com, www.adidas.com, www.shopadidas.com, and www.underarmour.com at pages 3-40 of Office action dated August 27, 2011 and evidence from www.sportsauthority.com at pages 2-42 of Office action dated April 5, 2012.) These third party websites establish that the same entity commonly manufactures the relevant goods and markets the goods under the same mark.

Because consumers are accustomed to seeing these types of goods emanate from a single source under a common mark, consumers are likely to believe that they emanate from a single source when the goods are marketed under highly similar marks.

(3) THE RESPECTIVE GOODS MOVE IN THE SAME CHANNELS OF TRADE

Decisions regarding likelihood of confusion in the clothing field have found many different types of apparel to be related goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985) (women's shoes related to outer shirts).

The types of athletic, casual, and infant clothing offered by applicant are sold in the same specialty stores to the same consumers through the same channels of trade as the type of footwear offered by registrant. (See evidence from www.nike.com, www.adidas.com, www.shopadidas.com, www.underarmour.com at pages 3-40 of Office action dated August 27, 2011 and evidence from www.sportsauthority.com at pages 2-42 of Office action dated April 5, 2012.) These excerpts from third party websites show that consumers will encounter the types of clothing offered by applicant and registrant on the same specialty retail sites.

(4) SIMILARITY OF THE MARKS: THE MARKS CREATE A HIGHLY SIMILAR COMMERCIAL IMPRESSION

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under applicant's and registrant's marks is likely to result. *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks.

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Applicant has applied to register the mark THE TEAM, THE TEAM, THE TEAM. The registered mark is TEAM.

When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term “the” at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984). “The” in applicant’s mark merely acts as the definite article for the term “TEAM.” It does not add any meaning to the mark. Because the wording “the” has no trademark significance, the only source indicating word in applicant’s mark, TEAM, is identical to registrant’s mark, TEAM.

The repetition of the wording “THE TEAM” in the applied-for mark does not change the commercial impression. There is nothing in the mark that that alters the meaning of “team.” The definition of record shows that the word “team” refers to “a group of people who play a sport or a game against another group.” www.macmillandictionary at page 42 of Office action dated August 27, 2011. Thus, the registered mark conveys the idea of footwear for use by “a group of people who play a sport or a game against another group.” The wording THE TEAM, THE TEAM, THE TEAM conveys the same idea.

The marks create a highly similar commercial impression.

Because the marks create a highly similar commercial impression and will be applied to identical in part and otherwise closely related goods, consumer confusion as to source is likely. Therefore it is respectfully submitted that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) as to International Class 25 be affirmed.

II. APPLICANT'S PROPOSED MARK MERELY DESCRIBES THE IDENTIFIED GOODS.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

A mark that describes an intended user or group of users of a product is merely descriptive. *E.g., In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984); *see* TMEP §1209.03(i).

Applicant has applied for the mark THE TEAM, THE TEAM, THE TEAM for "athletic uniforms."

(A) "TEAM" MERELY DESCRIBES THE INTENDED USERS OF APPLICANT'S GOODS

“Team” is defined as “a group of people who play a sport or a game against another group.” [www.macmillandictionary](http://www.macmillandictionary.com) at page 42 of Office action dated August 27, 2011.

“Uniform” is defined as “a set of clothes that you wear to show that you are part of a particular organization or school.” [www.macmillandictionary](http://www.macmillandictionary.com) at page 44 of Office action dated August 27, 2011. Athletic uniforms, by their nature of being used to identify members of a group, are commonly intended to be used by sports teams.

The following excerpts from the Internet evidence of record show that “teams” are intended users of “athletic uniforms”:

“We sell our products to thousands of colleges and high schools as well as youth and recreational teams...” www.ciscoathletic.com at page 46 of Office action dated August 27, 2011.

“Selling Team Uniforms Since 1997” ateamuniformsdirect.com at page 48 of Office action dated August 27, 2011

“We provide sportswear and uniforms to AAU teams, youth leagues, team sports, college, university, middle schools and high schools and across the country.” www.taylorcointl.com at page 51 of Office action dated August 27, 2011

“Team Uniforms, Equipment and Electronic Displays

Built on quality products, unmatched service and lasting relationships, Toth's Sports has been serving athletic teams of Western and Central NY for over 30 years."

www.tothsports.com at page 54 of Office action dated August 27, 2011.

Thus, the wording "team" merely describes the intended users of applicant's uniforms.

(B) THE PRESENTATION OF APPLICANT'S MARK CREATES THE SAME COMMERCIAL IMPRESSION AS "TEAM"

Adding the term "the" to a descriptive term generally does not add any source-indicating significance or otherwise affect the term's descriptiveness. *See In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005). "The" in applicant's mark merely acts as the definite article for the term "TEAM." It does not add any meaning to the mark and has no source indicating significance.

A mark comprised of a repeated descriptive term may be merely descriptive where no new or different commercial impression results from the repetition. *See In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009); *In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474-75 (TTAB 2007); *In re Disc Jockeys, Inc.*, 23 USPQ2d 1715, 1716 (TTAB 1992); TMEP §1209.03(t).

In *In re Tires, Tires, Tires, Inc.*, the Board found that the repetition of the word "tires" in the mark, TIRES TIRES TIRES, did not create a meaning different from "tires" alone.

The Board distinguished marks comprised of repetitive wording from phrases comprised

of different words because the terms that comprise phrases modify each other, while words that are merely repeated in marks have the same meaning as the individual term. *See In re Tires, Tires, Tires, Inc.*, 94 USPQ2d at 1155. Likewise in *In re Litehouse, Inc.* and *In re Disc Jockeys, Inc.*, the Board found nothing in the composite marks CAESAR!CAESAR! or DJDJ that changed the meaning of the letters in any manner to give them a different meaning. *See In re Litehouse, Inc.*, 82 USPQ2d at 1474; *In re Disc Jockeys, Inc.*, 23 USPQ2d at 1716.

As in the cited cases, the repetition of the wording “THE TEAM” does not create any new meaning. Applicant argues that the mark creates “a unique, incongruous and otherwise non-descriptive meaning in relation to the goods” (applicant’s brief at page 7), but does not indicate what it believes this unique meaning to be. The mark simply creates the impression of being composed of the wording “THE TEAM” appearing three times.

(C) PRIOR REGISTRATIONS FOR DIFFERENT MARKS ARE NOT CONCLUSIVE ON THE ISSUE OF DESCRIPTIVENESS

Applicant argues that because the mark PIZZA!PIZZA! was registered with a disclaimer of “pizza,” the mark THE TEAM, THE TEAM, THE TEAM is not descriptive. (Applicant’s brief at 7; Registration Nos. 1399730 and 1439558 at pages 2-4 of applicant’s response filed February 27, 2012.) The fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue of descriptiveness. An applied-for mark that is merely descriptive does not become

registrable simply because other seemingly similar marks appear on the register. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); TMEP §1209.03(a).

These registrations were submitted as part of the record in *In re Litehouse, Inc.* and the Board found that the existence of these registrations registered in 1986 and 1987 were not persuasive because the evidence of record left no doubt that the mark was merely descriptive, as is the case in the present application. *See In re Litehouse, Inc.*, 82 USPQ2d at 1474-75.

Because the mark merely describes the intended users of “athletic uniforms,” it is respectfully submitted that the refusal of registration under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) be affirmed as to these goods.

CONCLUSION

For the foregoing reasons, the applicant’s mark, THE TEAM, THE TEAM, THE TEAM, is likely to be confused with registrant’s mark, TEAM, where applicant’s mark creates a highly similar commercial impression and the marks are used on goods in International

Class 25 that are identical in part and otherwise closely related and is merely descriptive as applied to “athletic uniforms.” Therefore it is respectfully submitted that the refusal of registration under Trademark Act Sections 2(d), 15 U.S.C. Section 1052(d) and 2(e)(1), 15 U.S.C. Section 1052(e)(1) be affirmed.

Respectfully submitted,

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