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Subject: U.S. TRADEMARK APPLICATION NO. 85478497 - MARSHLAND - NTA-0808 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85478497

MARK: MARSHLAND



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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: NTA Enterprise, Inc

CORRESPONDENT'S REFERENCE/DOCKET NO:

NTA-0808

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark MARSHLAND and Design on the ground that the mark, under Trademark Act Section 2(d), 15

U.S.C. Section 1052(d), is likely to be confused with Registration Nos. 3162449 for MARSHLANDER and 1935600 for MARSHLANDER and Design.

I. FACTS

Applicant, NTA Enterprise, Inc., has applied for registration on the Principal Register of the standard character mark MARSHLAND and Design for “Fabrics for the commercial manufacture of Camouflage articles by commercial manufacturers; Textile fabrics for the commercial manufacture of clothing by commercial manufacturers; Textile fabrics for use in the commercial manufacture of garments, bags, jackets, gloves, and apparel by commercial manufacturers; Camouflage fabric for use as a textile in the commercial manufacture of hunter clothing and hunter accessories by commercial manufacturers” in Class 24. The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act based on standard character mark MARSHLANDER for “Rain coats; Rain jackets; Rain suits; Rain trousers; Rainwear; Waterproof jackets and pants” in Class 25, and the mark MARSHLANDER and Design for “weatherproof and waterproof rainwear” in Class 25, both owned by the same party. This appeal now follows the Trademark Examining Attorney’s final refusal under Section 2(d) of the Trademark Act.

II. THE MARKS OF APPLICANT AND REGISTRANT ARE SIMILAR IN SOUND, APPEARANCE AND MEANING AND THE GOODS ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT

The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark that is dissimilar to trademarks already being used. See *In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

A. The marks are similar in sound appearance and meaning.

The marks must be compared for similarities in sound, appearance, meaning, or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979). When an 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 (D.C. Cir.), *cert. denied*, 351 U.S. 973 (1956).

The applicant seeks to register the mark MARSHLAND in outlined block letters and a design of cattails. The registered marks are MARSHLANDER and MARSHLANDER and the design of a man in a canoe. Applicant's mark is similar in sound, appearance and connotation to the mark MARSHLANDER and also to the dominant literal portion of the mark MARSHLANDER and Design. As to the literal portion of its mark, applicant has merely deleted the final two letters "ER" of the word MARSHLANDER in the cited registrations. The mere deletion of wording or letters 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). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording else to distinguish it from registrant's mark.

The literal portions of the marks are extremely similar in sound and appearance because the entire word MARSHLAND appears in the first nine letters of MARSHLANDER. 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).

This Board has already ruled that applicant's standard character mark MARSHLAND and registrant's MARSHLANDER marks are confusingly similar, notwithstanding the presence or absence of a design element, stating:

"Applicant's mark MARSHLAND and registrant's marks MARSHLANDER and MARSHLANDER and design are similar in terms of sound and appearance in that registrant's marks incorporate the word "Marshland." *In re NTA Enterprises, Inc.*, 2010 TTAB LEXIS 351 (at page 4).

In this appeal, applicant does not dispute the examining attorney's finding that the marks are confusing similar. Since the marks are highly similar in sound, appearance and meaning, there is a likelihood of confusion between the respective marks.

B. The goods are closely related.

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

Applicant's goods are "Fabrics for the commercial manufacture of Camouflage articles by commercial manufacturers; Textile fabrics for the commercial manufacture of clothing by commercial manufacturers; Textile fabrics for use in the commercial manufacture of garments, bags, jackets, gloves, and apparel by commercial manufacturers; Camouflage fabric for use as a textile in the commercial manufacture of hunter clothing and hunter accessories by commercial manufacturers" in class 24.

The goods in the cited registrations are "Rain coats; Rain jackets; Rain suits; Rain trousers; Rainwear; Waterproof jackets and pants" in Class 25 (Reg. No. 3162449) and "Weatherproof and waterproof rainwear" (Reg. No. 1935600) also in Class 25.

In the Office action issued on December 6, 2011 the examiner made of record extensive Internet evidence demonstrating that camouflage fabrics are used to make rainwear, and that such fabrics are sold through the same channels of trade as various kinds of rain clothing. For example,

- Amazon.com offers jackets, pants and rainwear all made of camouflage fabrics. (p. 6, 7, 8)
- Lura's Fabric Shop offers various camouflage fabrics in a wide variety of patterns for use in making camouflage overalls and jackets and rainwear. (pp. 12, 13)

- Seattle Fabrics offers various camouflage fabrics in a wide variety of patterns for use in making camouflage overalls and jackets and rainwear. (pp. 14, 15, 16)

Further evidence that camouflage fabrics and jackets, pants and rainwear are closely related is found in the printouts of Registration Nos. 3850967, 3030393, 2636048 and 1892882 from the USPTO X-Search database which were attached to the Office action of December 6, 2011 (pp. 17 - 22 and 26 - 31).

Specifically,

- Registration No. 3850967 - SANKO and S Design is registered for “Woven and non-woven textile fabrics for use in the manufacture of clothing, table linen, bed linen, household linen; waterproof fabrics, namely, waterproof fabric for manufacturing clothing; fabric of imitation animal skins; oilcloth for use as table cloths; bed covers, namely, bed blankets, bed sheets, bedspreads, bed linen, diapered linen, pillowcases; furniture coverings of textile, namely, unfitted fabric furniture covers; upholstery fabrics; table napkins of textile; bed covers of paper, bundles of textile, namely, quilts of textile, tapestries of textile; washing mitts; bath linen; flannel; hand towels; face towels of textile; bathing towels, namely, bath towels” in Class 24, and for “Clothing, namely, trousers, jackets, overcoats, coats, skirts, suits, jerseys, waistcoats, shirts, T-shirts, sweatshirts, dresses, bermuda shorts, shorts, pajamas, pullovers, jeans, tracksuits, rainwear, beachwear, bathing suits, swimming suits; articles of clothing made from cotton denim, namely, t-shirts; articles of clothing made from knitted fabrics, namely, t-shirts; clothing for sportswear, namely, sports shirts; clothing for babies, namely, baby tops; underclothing, namely, boxer shorts, brassieres, briefs, pants, socks; footwear, namely, shoes excluding orthopedic shoes, sandals, waterproof boots, walking boots, bootees, sporting shoes, slippers; shoe parts, namely, heelpieces, insoles for footwear, footwear uppers” in Class 25.

- Registration No. 3030393 - FABRIC TO THE NEXT is registered for “Textile fabrics for use in the manufacture of clothing; textile fabrics for use in the manufacture of furnishings for home, industrial and commercial use; and upholstery fabrics for home, industrial and commercial use” in Class 24, and “Clothing, namely suits, dresses, blouses, shirts, skirts, pants, jeans, shorts, coats, jackets, blazers, uniforms, athletic uniforms, military uniforms, loungewear, rainwear, aprons, gloves, and activewear, namely tops and bottoms and combinations of tops and bottoms; footwear; and headwear” in Class 25.
- Registration No. 2636048 - TIMBERGHOST is registered for “Textile photo-realistic camouflage fabrics for use in clothing” in Class 24, and “Clothing, namely, shirts, pants, jumpsuits, coveralls, jackets, coats, sweatshirts, tee shirts, gloves, mittens, hats, hoods, raincoats, rainpants, foul weather gear, vests, and veils” in Class 25.
- Registration No. 1892882 for TREBARK is registered for “Yard goods, namely camouflage fabrics” in Class 24, and “Clothing, namely vests, pants, jackets, shirts, hats, ski masks, net masks, coveralls, overalls, coats, boots, ponchos, gloves, mittens, bandanas, garter belts, suspenders, boot toe-warmers, belts, clothing mufflers, sweaters and sweatshirts” in Class 25.

These third-party registrations show trademarks used in connection with textile fabrics for use in the commercial manufacture of clothing, as well for use in connection with the clothing itself. These registrations serve to suggest that textile goods and clothing may be sold under the same marks and may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii).

That applicant’s textile fabrics are closely related to camouflage clothing is also evidenced by the simple fact that applicant’s fabrics are used in the manufacture of such clothing, as specifically set forth in applicant’s identification of goods. Since such products are so commonly made by the same

companies and offered for sale side by side in the same stores and on-line, and since camouflage fabrics are complementary products used to produce camouflage clothing, customers seeing the similar marks MARSHLAND and MARSHLANDER used in connection with fabrics and clothing are likely to believe the goods at issue may come from or, are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4

In this appeal, applicant does not dispute the finding that the goods are closely related. Applicant's fabrics are used for the manufacture of clothing of all kinds, which may include registrant's rainwear, jackets and pants. In fact, the marks might be used on the same garments, i.e. MARSHLANDER jackets made using MARSHLAND fabrics. Accordingly, consumers seeing both marks on a garment could be confused as to the relationship between the source of the fabric and the garments.

C. The goods travel in the same channels of trade.

Textile fabrics used for commercial manufacture travel in the same channels of trade as the clothing in which they are used. In the Office action issued on June 21, 2012 the examiner made of record evidence demonstrating that camouflage fabrics for use in the commercial manufacture of rainwear are also sold under the same marks and move through the same channels of trade as the rainwear itself. For example,

- Gortex offers fabrics for the manufacture of Gortex brand outerwear, and also sells the outerwear itself, including jackets, pants and rainwear all made of camouflage fabrics. (pp. 4 and 5)
- Fashion Fabrics Club offers various camouflage fabrics in a wide variety of patterns for use in making camouflage overalls and jackets and rainwear. (pp. 6, 7, 8, 9, 10 and 11)

- Alibaba offers jackets, pants and rainwear all made of camouflage fabrics (pp. 12 – 21) as well as camouflage fabrics for use in the making of jackets, pants and rainwear. (pp. 22-25)

The fact that textile fabrics and clothing move in the same channels of trade is amply supported by the above evidence. The Board recently ruled that applicant's fabrics and registrant's clothing products are indeed closely related and also travel in the same channels of trade, stating:

"Applicant's mark is proposed for use in connection with fabrics sold as an integral part of clothing products. Accordingly, that means that the goods would move through the retail clothing channel and would be encountered by the ultimate consumers. Presumably, the sales process would be similar to clothing products made from GORE-TEX fabrics as displayed in many of the website excerpts submitted by the Examining Attorney. Moreover, as indicated above, the evidence submitted by the Examining Attorney shows that there is an association between fabrics and clothing. In fact, several exhibits display camouflage raingear (*e.g.*, L.L. Bean, RedHead clothing sold at BASS PRO SHOPS, CABELA'S, CARHARTT WorkCamo line). In view of the foregoing, we find that applicant's fabrics sold as an integral part of camouflage clothing and the registrant's raingear move in the same channels of trade and are sold to the same classes of consumers."

In re NTA Enterprises, Inc., 2010 TTAB LEXIS 351 (at pages 11 and 12)

It is applicant's contention that by amending its identification of goods to specify that its fabrics are used for commercial manufacture of clothing, that this somehow removes the goods from the same channels of trade as registrant's goods. (Applicant's Brief, p. 2). However, although applicant has specified that its fabrics are used for commercial manufacture, the identification of goods still does not preclude use of the mark on applicant's fabrics as they move through subsequent channels of trade to the ultimate consumer. Therefore, although the mark is claimed for use on fabrics for commercial manufacturing, it is presumed that the fabrics will still move in all normal channels of trade as part of the finished garments, and that they will be available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977).

Applicant insists that its mark is only be presented to commercial manufacturers, and claims that there is no evidence in the record to show that the mark will ever be seen by the ultimate consumer of the garments identifying the fabric used in making the garments. However, applicant's specimens of use in the present application clearly demonstrate that the mark is presented to the purchasers of the finished clothing articles to identify the fabric used in making the clothing. Applicant's specimen of record is a clothing hangtag showing the mark MARSHLAND used under license from applicant to identify the fabric in camouflage clothing. (Specimen 11/22/2011). This specimen does not show use of the mark on textile fabric sold to a commercial manufacturer, because applicant sells directly to such purchasers and use of the mark would not require a license. In its brief, applicant's claims *".... the applicant's mark, not being directed to a fabric with special properties, would not make it downstream beyond the applicant's channels of trade to the consumers of the cited registrants."* (Applicant's Appeal Brief, Page 3). However, based on the evidence submitted into the record by applicant, this is exactly how the mark is used by applicant's licensees in connection with the finished clothing products. Of course, such use is customary in the trade, as noted by the Board above, since marks for fabrics are often used on clothing to identify the brand of fabric used to make the clothing. Since the applicant's identification contains no restriction as to the trade channels in which applicant's mark may be used, and since applicant's mark is in fact used under license on finished clothing products, it is presumed that applicant's mark may be encountered by purchasers of clothing, including registrant's clothing, and that applicant's and registrant's marks will travel in the same channels of trade.

Applicant also argues that only sophisticated commercial manufacturers will ever see its MARSHLAND trademark, and that they will never be confused because they are highly sophisticated. (Applicant's Brief, page 4). However, whether or not the commercial manufacturers are likely to be confused, as demonstrated by applicant's own evidence, applicant's mark will also be seen by

purchasers of the finished clothing items bearing applicant's mark, and it is these relatively unsophisticated consumers who are likely to be confused.

The evidence of record clearly shows that the goods are closely related, and applicant does not dispute this finding. The evidence of record also clearly establishes that the respective goods travel in the same channels of trade, and that applicant's mark may be presented not only to commercial clothing manufacturers, but may also be presented to consumers of clothing made from applicant's fabrics sold under the mark.

D. Evidence of actual confusion.

Finally, applicant contends that there is no evidence of actual confusion and that the owner of the cited registrations has taken no action against applicant's use of its mark. However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board has stated as follows:

"[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case)." *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

III. CONCLUSION

Because the marks are similar in sound, appearance and meaning, and the goods are closely related and travel in the same channels of trade, consumers encountering the applicant's mark and the registered mark in the marketplace are likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

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