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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85667426

MARK: AMERICA SECOND TO NONE

CORRESPONDENT ADDRESS:

LUKE BREAN

BREANLAW LLC

PO BOX 4120

PORTLAND, OR 97208-4120

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Monfredo, Vincent

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

luke@breanlaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant Vincent Monfredo appeals the examining attorney's refusal to register AMERICAN SECOND TO NONE and Design for baseball caps and hats, sweatshirts and t-shirts. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that the applied-for mark is likely to be confused with the registered mark SECOND II NONE in standard characters for baseball caps, shirts and sweat shirts in U.S. Registration No. 3,773,474.

FACTS

On July 2, 2012, applicant filed for registration on the Principal Register of AMERICAN SECOND TO NONE with a Design of an eagle head. The identification specifies the goods as "baseball caps and hats; sweatshirts; t-shirts."

On October 22, 2012, the examining attorney refused registration under Section 2(d) of the

Trademark Act, 15 U.S.C. §1052(d), on the ground that the applied-for mark is likely to be confused with the mark in U.S. Registration No. 3,773,474, for the mark SECOND II NONE in standard characters for the following goods "Baseball caps; caps; shirts; sweat shirts."

On May 9, 2013, the examining attorney made final the refusal to register, and subsequently denied applicant's request for reconsideration on November 22, 2013. Applicant appealed the refusal to register on November 9, 2013 at the same time as Applicant submitted its request for reconsideration.

ISSUE

The sole issue on appeal is whether, under Section 2(d) of the Trademark Act, there is a likelihood of confusion between the applicant's mark, AMERICAN SECOND TO NONE (and design) and the standard character mark, SECOND II NONE in U.S. Registration No. 3773474.[1]

[1] The Board recently affirmed a Section 2(d) refusal (February 26, 2014) with respect to Applicant's sister application, Ser. No. 85307627, for the mark AMERICA SECOND TO NONE. The examining attorney reviewing

ARGUMENT

Section 2(d) of the Trademark Act 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 and/or services of the applicant and registrant. 15 U.S.C. §1052(d).

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. *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. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Id*. at 1355

In this case, the following factors are the most relevant: identical and highly related nature of the goods, similarity of the marks, and similarity of the trade channels of the goods. *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Id.* at 1362 (quoting *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)). Additionally, the goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. *Herbko Int'l, Inc. v. Kappa Books, Inc*., 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002).

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the cited application refused registration in light of Reg. No. 3773474, the same registration cited herein. The Board reviewed the merits of the case and held that Applicant's AMERICA SECOND TO NONE mark was likely to cause confusion to consumers in light of Registrant's SECOND II NONE mark.

I. IDENTICAL GOODS

In short, the registration and application list numerous goods that are identical.

The application identified its goods as "baseball caps and hats; sweatshirts; t-shirts" while registrant's goods are set forth as "baseball caps; caps; shirts; sweat shirts." Neither the application nor the registration(s) 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); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

Applicant's responses did not address the issue of the relatedness of the goods, and, therefore, the examining attorney presumes that Applicant's silence evidences its concession on this point. In fact, the majority of the goods are identical, namely the baseball caps and sweatshirts. As for the other two goods identified in the application, hats and t-shirts, those are incorporated within the rest of registrant's goods, caps and shirts. The examining attorney respectfully requests that the Board take judicial notice of the two attached definitions for the terms cap and t-shirt.[2] The term cap is defined as: a soft hat with a stiffed part called a bill or visor that comes out over your eyes. See attached definition from MacMillan Dictionary. Since the cap is a type of hat, the wording in the registration is naturally within the sphere of goods in Applicant's "hats". Second, the term t-shirt is defined as: a soft shirt that usually has short sleeves and no collar. See attached definition from MacMillan Dictionary. As a result, Applicant's t-shirts are naturally incorporated within Registrant's shirts and could indeed be identical goods.

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[2] The Trademark Trial and Appeal Board may take judicial notice of definitions obtained from dictionaries that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; *see* Fed. R. Evid. 201; 37 C.F.R. §2.122(a); *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (taking judicial notice of definition from Merriam-Webster Online Dictionary at www.merriam-webster.com); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (taking judicial notice of definition from Dictionary.com because it was from The Random House Unabridged Dictionary); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition from *Encarta Dictionary* because it was readily available in specifically denoted editions via the Internet and CD-ROM); TMEP §710.01(c).

This factor, therefore, weighs heavily in registrant's favor.

Decisions regarding likelihood of confusion in the clothing field have found many different types of apparel to be related goods. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women's boots related to men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *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); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-99 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991). When analyzing an applicant's and registrant's goods for similarity and relatedness, that determination is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion.

It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)).

Finally, and prior to examining the similarities of the marks, it is also key to note that where the goods of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); TMEP §1207.01(b).

II. SIMILAR MARKS

It is black letter law that when it comes to a Section 2(d) analysis, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 at 1362, 101 USPQ2d at 1908 (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)). Similarity 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).

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 and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). 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).

The registered mark consists of the wording "SECOND II NONE", which, as explained below, is highly similar to the applied-for mark, AMERICAN SECOND TO NONE and Design.

As discussed in the Office Actions, the wording "SECOND II NONE," which wholly encompasses Registrant's mark, and "SECOND TO NONE" have the same sound, meanings and commercial impressions. The only difference between these phrases is that Applicant substitutes the Roman numeral II, which represents the number "two," in Registrant's mark with the phonetically equivalent term "TO." Both of these terms are likely to be viewed and pronounced by consumers in the same manner. 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).

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In this case, the examining attorney believes that the inclusion of what is seemingly Registrant's entire mark within Applicant's mark, to say nothing of the identical nature of the goods, is sufficient to demonstrate that the marks create a highly similar commercial impression and are likely to confuse consumers.

Applicant's responses have centered on the notion that the examining attorney has improperly dissected the marks, not giving sufficient weight in the Section 2(d) analysis to the inclusion of the term AMERICA, as well as the Eagle head design. On the contrary, the examining attorney has considered these elements at length. The examining attorney, however, simply does not believe that these differences are sufficient to create a significant difference in the commercial impression the marks' create, and certainly not adequate to alleviate the likelihood of confusion.

First, the term AMERICA is a relatively weak term, and even disclaimed in the application because it is geographically descriptive of the origin of Applicant's goods. This body, as well as federal court, has consistently held that the mere addition of a term [AMERICA] to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); TMEP §1207.01(b)(iii).

This is particularly true when the additional element is descriptive, and moreover, when Applicant does not claim exclusive rights to such wording. To be sure, disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii)

Applicant further believes that the Section 2(d) refusal is erroneous because the examining attorney did not accord proper weight to the inclusion of the eagle head design in its mark. Again, the examining attorney did consider this element and analyzed the marks in such regard. The design, however, in the examining attorney's opinion, was simply not sufficient to create a sufficiently different overall commercial impression from Registrant's mark. The examining attorney conclusion is based on the long-held premise that when analyzing a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

When consumers encounter the marks, place them into memory and recall them, they are likely to place more emphasis on the literal elements, and less on the design. The examining attorney did not dissect the marks, as Applicant alleges, but rather simply recognized the evident similarities between the phrases AMERICA SECOND TO NONE and SECOND II NONE, and how such wording will resound with consumers. While marks are considered and analyzed in their entireties, one portion of a mark may be more dominant than other terms or designs. The examining attorney did not dissect the mark but rather determined that the phrase SECOND TO NONE, when the mark was considered as a whole, was the dominant portion and wording that consumers would most likely recall. Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark . . . ."); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). In this case, it is impossible to ignore the portion of Applicant's mark that virtually wholly encompasses Registrant's mark, and which amounts to the most dominant portion of the applied-for mark.

Applicant further argues that marks can share common terms and still avoid the likelihood of confusion to consumers. There is a difference, however, between the notion of marks sharing certain terms on the one hand, and appropriating one's mark wholesale and merely adding a geographically descriptive element, along with a design, on the other. Simply put, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); TMEP §1207.01(b)(iii).

In the end, the marks create highly similar sounds and have similar appearances, particularly when considering the most dominant portion of the marks and, thus, create highly similar overall commercial impressions. Even if, *assuming arguendo*, the marks sounded different, 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.)

There simply 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)

As a result, this factor in the Section 2(d) analysis weighs heavily in the examining attorney's favor.

CONCLUSION

For the foregoing reasons, the examining attorney requests that the refusal to register the applied-for mark because of a likelihood of confusion with the mark in U.S. Registration No. 3,773,474 be affirmed.

Respectfully submitted,

/Alain J. Lapter/

Trademark Examining Attorney

Law Office 105

500 Dulany Ave.

Alexandria, VA 22316

(571) 272-3162

alain.lapter@uspto.gov

/Susan C. Hayash/

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2. lid/covering
3. top part
4. limit on money
5. artificial tooth cover
6. explosive in toy gun

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1 a soft hat with a stiff part called a bill or visor that comes out over your eyes
a baseball cap
Thesaurus entry for this meaning of cap

a. a soft hat that people wear as part of a uniform
a nurse's/chauffeur's/sailor's cap
Thesaurus entry for this meaning of cap

b. a soft hat that you wear to protect or cover your hair
a swimming/bathing/shower cap
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2 a lid or part that fits over the top of something
Meg screwed the cap back on the bottle

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Meg screwed the cap back on the bottle.
Thesaurus entry for this meaning of cap

3 LITERARY the top part of a mountain
the hills with their snowy caps
Thesaurus entry for this meaning of cap

a. the top part of a wave
Thesaurus entry for this meaning of cap

b. the round top part of a mushroom
Thesaurus entry for this meaning of cap

4 a limit on the amount of money that you can spend or charge
Airlines began to impose a $50 cap on commissions for domestic flights.
Thesaurus entry for this meaning of cap

5 a hard cover attached to a tooth to protect it or replace part of it
Thesaurus entry for this meaning of cap

6 a small amount of explosive that is used to make a loud noise in a toy gun called a cap pistol
Thesaurus entry for this meaning of cap

PHRASES

- **go cap in hand to someone**
  to ask someone to give you something, especially money, in a way that makes you feel ashamed
  Thesaurus entry for this meaning of cap

- **set your cap for/at someone** OLD-FASHIONED
  to try to make someone fall in love with you
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a person … who has progressive political views and an unconventional approach to fashion, lifestyle, etc

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Word of the Day

duffer

someone who is stupid or who does something very badly

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xun

a flute-like Chinese musical instrument

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a soft shirt that usually has short sleeves and no collar

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a person ... who has progressive political views and an unconventional approach to fashion, lifestyle, etc
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someone who is stupid or who does something very badly

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a flute-like Chinese musical instrument
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