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Sent: 9/17/2014 1:02:09 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 85892299 - SOUTH BEACH SWIMWEAR - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85892299 MARK: SOUTH BEACH SWIMWEAR	
CORRESPONDENT ADDRESS: STEVEN E EISENBERG LIPSCOMB EISENBERG & BAKER PL 2 S BISCAYNE BLVD STE 3800 MIAMI, FL 33131-1809	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Michael D. Mathes	
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the proposed mark **SOUTH BEACH SWIMWEAR** in stylized form featuring a contoured border for "Swimsuits; Swimwear excluding T-shirts, polo shirts, tank tops, hats, visors, aprons." Registration was refused pursuant to Trademark

Act Section 2(d), 15 U.S.C. §1052(d), because applicant's mark, when used on or in connection with the identified goods is confusingly similar to the mark in U.S. Registration No. **3864216**. The registered mark is **SOUTH BEACH WINE & FOOD FESTIVAL** in standard characters for "T-shirts, polo shirts, tank tops, hats, visors, aprons".

I. **FACTS**

Applicant, Michael D. Mathes, applied for registration on the Principal Register of the trademark **SOUTH BEACH SWIMWEAR** in stylized form featuring a contoured border for "swimsuits" and "swimwear". Registration was refused under Section 2(d) of the Trademark Act and subsequently made final on November 19, 2013. Applicant's request for reconsideration amended the identification of goods to "Swimsuits; Swimwear excluding T-shirts, polo shirts, tank tops, hats, visors, aprons." The amended identification was accepted and made of record. The request for reconsideration was denied and Applicant filed its appeal brief on August 6, 2014.

II. **ARGUMENTS**

The law applicable to this Section 2(d) refusal is well settled. A likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E .I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Second, the goods are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

A. APPLICANT’S MARK “SOUTH BEACH SWIMWEAR” IS LIKELY TO CAUSE CONFUSION WITH THE CITED MARK “SOUTH BEACH WINE & FOOD FESTIVAL”.

Marks are compared in their entireties under a Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat’l Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985).

Applicant’s mark is **SOUTH BEACH SWIMWEAR** in stylized form featuring a contoured border for “Swimsuits; Swimwear excluding T-shirts, polo shirts, tank tops, hats, visors, aprons.” The registered mark is **SOUTH BEACH WINE & FOOD FESTIVAL** in standard characters for “T-shirts, polo shirts, tank tops, hats, visors, aprons”.

The shared word **SOUTH BEACH** is the dominant and most significant feature of applicant’s and registrant’s marks, not only because it appears first in the marks (*See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 73 USPQ2d 1689, 1692 (Fed. Cir. 2005), but also it has stronger source-identifying potential than the other elements of the marks. Specifically, applicant has disclaimed “**SWIMWEAR**”. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997). The presence of “**WINE & FOOD FESTIVAL**” in registrant’s mark does not diminish the overall similarities of both marks because such wording immediately conveys to consumers that registrant’s products are sold at a social event, namely, festivals about wine and food. *See* attachments from <<http://sobefest.com/about.php>> in November 19, 2013 final Office action at pages 72-73. Matter that is descriptive of registrant’s goods is typically

less significant or less dominant in relation to other wording in a mark. *See In re Chatam Int'l Inc.*, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004).

Applicant's contoured border does not alter the above analysis because it is not sufficiently unique or eye catching as to alter the overall commercial impression of the word portion of the mark which is **SOUTH BEACH SWIMWEAR**. Put in another way, the oblong border is not inherently distinctive because it is a common geometric shape that functions merely as a background carrier for the word portion of the proposed mark. Further, for 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. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)). 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. *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.*, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Applicant argues that there are "stark differences" between the marks. Not so. 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 Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). The above discussion concluded that the most prominent and significant parts of both marks are the words **SOUTH BEACH** in light of all the similarities and differences of the marks at issue.

The second step in determining whether there is a likelihood of confusion is made solely on the basis of the goods 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).

The goods of the respective parties are closely related. In support of this conclusion, prior office actions featured attached internet evidence consisting of webpages showing third parties selling the same goods as those of both applicant and registrant, namely, swimsuits and shirts, tank tops, or hats. Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods are related. *See In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009). These third parties are:

1. <http://store.nike.com/us/> - Nike sells "tank swimsuit" and "running shirt". *See* attachments from July 15, 2013 first office action at pages 7-14.
2. <http://underarmour.com/shop/us/> - Under Armour sells "board shorts" and "t-shirt". *Id.* at 15-18.
3. <http://www.adidas.com/us/product/> - Adidas sells "swimsuit" and "tee". *Id.* at 19-22.
4. <http://www.victoriasecret.com/> - Victoria's Secret sells "swimwear" and "shirt". *See* attachments from November 19, 2013 final office action at pages 2-8.
5. <http://www.forever21.com/> - Forever 21 sells "swimwear" and "shirt". *Id.* at 9-16.
6. <http://www.express.com/> - Express sells "swimsuit" and "shirt". *Id.* at 17-21.
7. <http://www.gap.com/> - GAP sells "swim trunks" and "shirt". *Id.* at 22-31.
8. <http://www.hollisterco.com/> - Hollister sells "swim shorts" and "shirt". *Id.* at 53-58.
9. <https://www.jcrew.com/> - J. Crew sells "swim trunks" and "shirt". *Id.* at 59-64.
10. <http://www.oakley.com/> - Oakley sells "swimsuit" and "shirts". *Id.* at 65-71.
11. <http://shop.nordstrom.com/> - Nordstrom sells swimsuits and tank tops. *See* attachments from June 5, 2014 Request for Reconsideration Denial at pages 3-20.
12. <http://www.kohls.com/> - Kohl's sells swimsuits and tank tops. *Id.* at 21-32.
13. <http://www.target.com/> - Target sells swimsuits and tank tops. *Id.* at 33-41

14. <http://www.jcpenney.com/> - JCPenny sells swimsuits and tank tops. *Id.* at 42-48.
15. <http://www1.macys.com/> - Macy's sells swimsuits and tank tops. *Id.* at 49-60.
16. <http://www.landsend.com/> - Land's End sells swimsuits and hats. *Id.* at 61-69.
17. <http://www.modcloth.com/> - ModCloth sells swimsuits and hats. *Id.* at 70-105.
18. <http://www.dillards.com/> - Dillard's sells swimsuits and hats. *Id.* at 106-110.
19. <http://www.speedousa.com/> - Speedo sells swimsuits and hats. *Id.* at 111-114.
20. <http://www.reyswimwear.com/> - Rey Swimwear sells swimsuits and hats. *Id.* at 115-119.

Applicant argues that the trade channels are different. This argument is unpersuasive.

Since applicant's and registrant's identification of goods contains no limitations or restrictions as to trade channels, the identified goods of both parties are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Next, applicant argues that the "targeted customers are sophisticated, careful and different." This argument is undermined because applicant's and registrant's identification of goods are not limited to a specific class of purchasers. Further, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Applicant has referenced a number of third-party registrations for marks containing the wording **SOUTH BEACH** to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar

marks *in use in the marketplace* in connection with *similar* goods. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973).

All the third-party **SOUTH BEACH** registrations applicant relies upon have disclaimed **SOUTH BEACH** and feature an inherently distinctive element. These facts and not weakness or dilution reasons explains exactly why those registrations coexist on the register. In any event, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. See *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973).

In a futile attempt to overcome this refusal, applicant has amended the identification of goods to exclude registrant's goods. This amendment fails. First, the exclusionary language does not apply to "swimsuits" because a semicolon is present and thus creates two separate distinct categories of goods. See *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013) (finding that, because a semicolon separated the two relevant clauses in registrant's identification, its "restaurant and bar services" is a discrete category of services that stands alone and independently as a basis for likelihood-of-confusion analysis, and is not connected to nor

dependent on the services set out on the other side of the semicolon). Accordingly, the exclusionary language only applies to “swimwear”. Second, it is highly unlikely that consumers are aware of the exclusion in applicant’s identification of goods. “. . . [T]he decision respecting likelihood of confusion is made in the PTO by comparing an applicant's mark and the description of his goods with the registered marks on file in the PTO, and the goods described in the registration of those marks, should not lead to the notion that the locus of potential confusion is in the files of the PTO. The confusion sought to be prevented by the statute is not that of examiners, lawyers, board members, or judges. Confusion is likely, if at all, only in the marketplace, where marks are used.” *See In re The Clorox Co.*, 198 USPQ 337, 340 (CCPA 1978). In the marketplace, it is improbable that applicant’s use of the mark in connection with swimwear would inform consumers of it’s self-imposed restrictions.

III. **CONCLUSION**

For the foregoing reasons, it is respectfully requested that the refusal to register applicant’s proposed mark under Sections 2(d) of the Trademark Act be affirmed.

Respectfully submitted,

/Simon Teng/

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