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Sent: 4/25/2016 4:27:28 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 86347651 - ALII - AAZ14001US - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86347651

MARK: ALII



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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: Active Angelz, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

AAZ14001US

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's FINAL refusal to register the trademark "ALII" for "athletic apparel, namely, shirts, pants, jackets, headwear, hats and caps, undergarments, athletic uniforms and specifically excluding footwear" (SIC) on the ground that it so resembles U.S. Registration No. 4163947 "ALI'I COLLECTION" for "footwear" as to be likely to cause confusion, or to cause mistake, or to deceive pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d).

FACTS

On July 24, 2014, applicant filed the instant application and was notified by an Office action dated November 6, 2014, that registration was denied pursuant to Section 2(d) of the Trademark Act based upon U.S. Registration No. 4163947. A FINAL refusal to register as to this issue was made on May 28, 2015. On November 30, 2015, applicant filed "A Notice of Appeal" and "Request for Reconsideration" and on December 21, 2015, an Office action was issued maintaining the refusal to register.

ARGUMENT

THE TRADEMARK AT ISSUE WHEN USED IN CONNECTION WITH THE IDENTIFIED GOODS IS LIKELY TO CAUSE CONFUSION AS TO THE SOURCE OR ORIGIN OF THE GOODS AS TO U.S. REGISTRATION NO. 4163947 PURSUANT TO SECTION 2(d) OF THE TRADEMARK ACT

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. The court in *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973) listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor the registrant. *Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc.*, 498 E. 2d 906, 182 USPQ 368 (CCPA 1974).

The Trademark Examining Attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the Trademark Examining Attorney must look at the marks themselves for similarities in appearance, sound and connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1375, 177 USPQ 563 (CCPA 1973). Second, the Trademark Examining Attorney

must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scot Paper Co.*, 200 USPQ 738 (TAB 1978).

Here, the marks at issue are all but identical, applicant's mark is "ALLI" and the registrant's mark is "ALL'I COLLECTION" with "collection" disclaimed as being merely descriptive of the goods. Disclaimed matter that is descriptive of or generic for a party's goods or services is typically less significant or less dominant when comparing marks. *See, In re Dixie Rests., Inc.*, 105 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). Thus, the marks at issue rest between a comparison of "ALLI" and "ALL'I" and the marks at issue look, appear and sound alike as they contain the identical letters. The inclusion of an apostrophe symbol in the registered mark does not serve to change the almost identical appearance of the marks or how the marks at issue would be pronounced. Furthermore, both applicant and registrant have provided a translation of their marks and both have said that "ALLI" contained in each mark is Hawaiian for "royal." In light of this analysis and evidence of the meaning of the word "ALLI" applicant's argument that the applicant's mark is "one word and one syllable" and the registered mark is "two words and four syllables" is simply not persuasive for it is "ALLI/ALL'I" that the public will recall and remember each of the marks at issue and not reflect upon the number of syllables or consider a highly descriptive if not generic word in recalling the marks at issue herein.

Applicant is seeking registration of its mark for "athletic apparel, namely, shirts, pants, jackets, headwear, hats and caps, undergarments, athletic uniforms and specifically excluding footwear" (SIC) and the registered mark is for "footwear." The Office action of November 6, 2014, contained copies of U.S. trademark registrations from the USPTO X-search database that showed third-party registrations of marks used in connection with the same or similar goods of applicant and registrant. These printouts have probative value to the extent that they suggest that goods of applicant and registrant are of a kind that from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP section 1207 (d)(iii).

As demonstrated by the stories from the Internet attached to the May 28, 2015, Office action, “athletic apparel” and “footwear” are considered part of the same industry and are at the very least inter-related articles of clothing that are sold in the same marketplace. Material from the Internet is generally accepted as competent evidence. See, *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination).

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 (CCPA 1961) (women’s boots related to men’s and boy’s underwear); *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 (TTAB 1985) (women’s shoes related to outer shirts).

Applicant’s collateral attack on the goods identified in the registration, that is, that the goods of registrant are of premium quality and would further distance the relationship between the goods at issue is simply not permissible nor persuasive. The presumption under Trademark Act Section 7(b), is that the registrant is the owner of the mark and that use of marks extends to all goods and/or services 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 and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald’s Corp. McKinley*, 13USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980). Furthermore the *ex parte* “evidence” of the quality of registrant’s goods does not establish that it is the only “footwear” as to quality or type sold by the registrant for registrant may very well use the registered mark to sell a wide variety of goods all of which are subject to interpretation as to their quality by others besides applicant.

The ownership of U.S. Registration No. 4906097 by applicant is unpersuasive as to the registrability of this application since 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. TMEP section 1207.01(d)(vi); See *In re Midwest Gaming & Entm’t LLC*, 106 USPQ

1163, 1165 n.3 (TAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57USPQ2d 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.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973); *In re Bunion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Where the marks of the respective parties are identical or virtually identical, there need be only a viable relationship between the relevant goods and/or services to support a finding of likelihood of confusion. See, e.g. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB 2001); See also *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). Here, it has been established that there is more than a “viable” relationship between the goods of registrant and the goods of applicant and relatedness of the goods at issue has been satisfied.

Accordingly, where the marks at issue are all but identical and the goods are closely related, and there is no evidence to suggest that the goods are available in different trade channels, confusion is likely between the marks at issue pursuant to Section 2(d) of the Trademark Act.

CONCLUSION

Each case must be decided on the basis of the particular marks at issue, in light of the particular facts or evidence relating thereto. *In re Cosmetically Yours, Inc.*, 171 USPQ 963 (TTAB 1971). The marks in the present case are all but identical and goods are closely related. When the public views the marks at issue used for the identified goods, confusion is likely to take place and registration is required to be refused pursuant to Section 2(d) of the Trademark Act. Accordingly, for the foregoing reasons, the refusal to register made pursuant to Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

/Edward Nelson/

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