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Subject: U.S. TRADEMARK APPLICATION NO. 86406889 - SMARTSOCKS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86406889

MARK: SMARTSOCKS



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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: America Directo Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant has applied for registration on the Principal Register for the mark, SMARTSOCKS in standard characters for goods described as "Hosiery; Socks." Registration was refused pursuant to

Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on a likelihood of confusion with Registration No. 4649441 for the mark, "HEEL 2 HEAL SMARTSOCKS" and design for "socks" and Registration No. 2734333 for the mark, "SMART SOCKS SOCKS THAT THINK ON YOUR FEET and design for "Hosiery, namely socks" as to be likely, when used in connection with the identified goods, to cause confusion or to cause mistake or to deceive. This appeal follows the Examining Attorney's final refusal under Section 2(d).

ARGUMENT

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

It should be noted that in the instant case, the Applicant has failed to raise any contention concerning the similarity of the goods of the parties on appeal. As indicated above, the applicant's goods are "Hosiery; Socks" while the goods of the registrations are "socks" and "Hosiery, namely socks," respectively. It is well-settled case law that where the goods of an applicant and registrant are "similar in kind and/or closely related," 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. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). Accordingly, the sole issue in this case is whether the marks of the parties are similar enough such that there would be a likelihood of confusion under Section 2(d) of the Trademark Act.

THE APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANTS' MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective 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); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

The applicant's mark and the registrants' marks are very similar in sound and connotation. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). In the instant case, the marks of the parties feature the identical wording SMARTSOCKS or its phonetic equivalent, SMART SOCKS.

In its appeal brief, the applicant contends that inasmuch as the two cited registrations, which are owned by different parties and includes the wording SMARTSOCKS and SMART SOCKS respectively, indicates dilution of the cited terms and therefore, there should be no finding of a likelihood of

confusion. Additionally, the applicant contends that inasmuch as the registered marks have disclaimed the term SMARTSOCKS and SMART SOCKS, these terms should be considered weak and descriptive with respect to the goods and therefore, should not bar the applicant from registering its mark. See Brief at 9, 11. The trademark examining attorney respectfully disagrees. 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 Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Although evidence of widespread third-party use of similar marks with similar goods "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that industry or field, evidence comprising of only two third-party registrations for similar marks with identical goods, as in the present case, is entitled to little weight in determining the weakness of a mark. See generally *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). These few registrations are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; see *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ at 992. Thus, applicant's contention is insufficient to establish that the wording SUPERSOCKS or SUPER SOCKS is weak or diluted.

Similarly, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related or as in the instant case, identical goods. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is "to be avoided, as much between

'weak' marks as between 'strong' marks, or as between a 'weak' and 'strong mark')); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) ("even weak marks are entitled to protection against registration of similar marks").

Finally, the applicant maintains that the marks of the parties differ inasmuch as it is attempting to register its mark in standard characters while the cited registrations feature highly stylized trademarks containing additional wording. Brief at 12-13. The examining attorney finds the applicant's contention to be unpersuasive based on well-settled case law. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

Therefore, the marks are confusingly similar.

CONCLUSION

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *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. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Based on the record evidence and case law, the applicant's mark, when used on the identified goods, so resembles the mark in U.S. Registration Nos. 4649441 and 2734333 as to be likely to cause confusion, to cause mistakes, or to deceive. The trademark examining attorney, therefore, respectfully requests that the Board affirm the refusal to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

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