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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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MR2685-340

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	Amogreentech Co., Ltd.	:	
Serial No.:	86/618,200	:	Law Office #114
Filed:	4 May 2015	:	Trademark Examining Attorney:
Mark:	SNOWMASK	:	Jason Malashevich

BRIEF FOR APPELLANT

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I. INTRODUCTION

Applicant, Amogreentech Co. Ltd. (hereinafter, "Applicant") by the undersigned Attorneys, submits this brief in support of its Appeal to the Trademark Trial and Appeal Board in the United States Patent and Trademark Office, from the Trademark Examining Attorney's refusal to register the above-identified mark, "SNOWMASK," in International Class 3 for "cosmetics; mask pack for cosmetic purposes." The Trademark Examining Attorney's refusal is based on the grounds that there is a likelihood of confusion between Applicant's mark "SNOWMASK" and Registration No. 3,277,028 for the mark "'ICE MASK." Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Trademark Examining Attorney's decision.

It is respectfully requested that the prosecution history of the subject Trademark Application be made of record in this Appeal.

II. PROCEDURAL BACKGROUND

Applicant filed Application Serial No 86/618,200 to register the mark "SNOWMASK" on the Principal Register at the United States Patent and Trademark Office, for "cosmetics; mask pack for cosmetic purposes" in International Class 3 on May 4, 2015.

On August 14, 2015, the Examining Attorney issued a First Office Action in the Application refusing registration because the Trademark Examining Attorney believed there would be a likelihood of confusion with the mark in U.S. Registration No. 3,277,028. Applicant filed a Response to the First Office Action on January 12, 2016 traversing and requesting reconsideration of the Examining Attorney's conclusion that there is a likelihood of confusion between Applicant's "SNOWMASK" mark and the mark of U.S. Registration No. 3,277,028.

Despite Applicant's Response, the Examining Attorney issued a second Office Action on January 15, 2016 maintaining and making final the decision refusing registration of "SNOWMASK" because of a likelihood of confusion with the mark of U.S. Registration No. 3,277,028.

A Notice of Appeal was filed on July 14, 2016, concurrently with this Appeal Brief appealing the final refusal of registration as to the goods identified in Application Serial No. 86/618,200.

III. ARGUMENT

The Trademark Examining Attorney has refused registration of Applicant's mark, "SNOWMASK," because of a likelihood of confusion with the mark of U.S. Registration No. 3,277,028. Applicant respectfully disagrees with the Trademark Examining Attorney's conclusion, and submits that the rationale by which the Examining Attorney arrived at such a conclusion is misplaced. It is respectfully submitted that Applicant's "SNOWMASK" mark is distinguishable from the "ICE MASK" mark of cited Registration No. 3,277,028 in terms of sight, sound and meaning leading to an entirely different commercial impression.

Therefore, it is respectfully submitted that consumers would be readily able to differentiate between the marks and would recognize that the goods offered for sale in connection with the respective marks emanate from distinct sources. As such, Applicant's mark is entitled to registration on the Principal Register.

The January 15, 2016 Final Office Action, in large part, merely recycles the arguments presented in the August 14, 2015 Office Action and only briefly addresses the arguments raised by Applicant in its January 12, 2016 response. One new point raised by the Examining Attorney in the Final Office action is the notion that the goods associated with the respective marks are legally identical.

Applicant had not previously addressed the relatedness of the goods as Applicant admits that the goods *may*, in certain instances, travel in the same or similar channels of

respectfully disagrees that the goods are legally identical and therefore traverses this assertion. Indeed, the goods associated with the cited registration are silk masks which absorb a liquid solution applied thereto. Once the mask has been set on a user's face for a specified period of time, the mask is removed and discarded. In contrast, the mask associated with Applicant's mark is a fiber membrane mask which dissolves after being set on a user's face for a particular period of time. As the goods are distinguishable from one another, Applicant respectfully traverses the notion that they are "legally identical."

Nevertheless, even assuming *arguendo* that the goods are related or "legally identical", Applicant submits that the overall commercial impressions of the respective marks are unique such that consumers would be able to readily distinguish and differentiate between the products sold in connection with the marks. The basic rule is that marks must be compared in their entireties and not dissected, wherein articulating reasons for reaching a conclusion on the issue of confusion, there may be nothing improper in stating that more or less weight has been given to a particular feature of the mark, however, the ultimate conclusion must rest on the consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985).

Further, in making a comparison of the degrees of identity between the marks at issue, the marks are to be compared with respect to similarity of pronunciation, appearance and verbal translation; i.e., the "sight, sound and meaning trilogy". J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23: 21(4th Edition 1996). See also *MarCon, Ltd. v. Avon, Inc.*, 4 USPQ.2d 1474, 1476 (TTAB 1987) ("[I]t

is well settled that a mark should not be dissected, but must be considered as a whole in determining likelihood of confusion."). Further, see also *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 USPQ.2d 1351, 1354 (Fed. Cir. 2000) ("The ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety.") The Examining Attorney's rejection is heavily weighed upon consideration of the first prong of the test, namely, the meaning of the first term of the respective marks.

At the outset, it is noted that while both marks do contain the word "mask", the terms is descriptive. Indeed, the term "mask" is disclaimed in Registration No. 3,277,028.

Considering the "meaning" portion of the trilogy, in an attempt to draw a correlation between the terms "ice" and "snow", the Examining Attorney argued that "both marks connote that such goods will leave the consumer's skin as clear as ice." (First Office Action, Page 3). In Applicant's response, it was submitted that snow is not thought of as being clear but rather, to the contrary, is readily appreciated for blanketing surfaces in white. Indeed Miriam Webster's online dictionary provides a simple definition of "snow" as "soft, white pieces of frozen water that fall to the ground from the sky in cold weather." Thus, it is not believed that that any consumer would view the mark "SNOWMASK" and be led to the mental conclusion that a product sold under that name would leave the consumer's skin "clear" based upon their understanding or appreciation of the word snow.

Still, in the final Office Action, the Examining Attorney maintained that there was a correlation between the marks but morphed the previously asserted basis for such a conclusion stating that since both of the terms refer to frozen water, "the marks in their entireties have similar connotations and stimulate the same mental reactions in the consumer in that they connote masks of frozen water." (Final Office Action, Page 3). First, this one factor alone could not stand as the basis for a conclusion that there would be a likelihood of confusion as the sight and sound of marks contribute to their overall commercial impression.

Nevertheless, the same reasoning presented above (as offered by Applicant in its January 12, 2016 response) applies to refute this conclusion. The terms "snow" and "ice" do not have similar connotations. The Examining Attorney was quick to dismiss Applicant's introduction of the fact that "ice" and "snow" are not synonymous by saying that "there is no requirement that terms appear in each other's definitions, or even that the terms be synonymous, in order to convey the same idea, stimulate the same mental reaction, or have the same overall meaning." (Final Office Action, Page 4). While this may or may not be true, it has no bearing on the validity of Applicant's argument in this regard. Indeed, Applicant is not asserting that words must be synonymous for them to convey the same overall meaning. Applicant is merely submitting this fact to show that the terms are not used interchangeably which supports the notion that the words do not necessarily stimulate the same mental impression. As previously noted, it is difficult to imagine a situation when someone would use the terms "ice" and "snow" interchangeably

and therefore it is not believed that such terms, would stimulate the same mental reaction as they have different meanings. Snow and ice are different forms of precipitation which stimulate distinct mental imagery based upon general interpretations and impressions of the terms. For instance, a forecasted "snow" storm may solicit much excitement for children with the potential for a day off of school or for providing the canvas by which to go sledding, but a forecasted "ice" storm would hardly stimulate the same excitement.

The commonalities between ice and snow exist only inasmuch as they are both forms of water. If, as the Examining Attorney contends, such terms would lead to consumer confusion, it should follow that any form of water used in connection with the word "mask" for goods sold in the same or similar channels of trade would cause confusion and therefore preclude concurrent registration. However, the USPTO has determined that, on at least two other occasions, marks comprised of a variation of the word "water" or a term related thereto and the word "mask" for related goods in International Class 3 were entitled to concurrent registration, namely, Registration No. 2,280,000 for the mark "WATER MASK" and Registration No. 4,375,066 for the mark "AQUATIC MASK." These marks were brought to the attention of the Examining Attorney in Applicant's January 12, 2016 response. While detailed information including the literal elements of the marks, the registration numbers, the associated goods and the registration dates was provided in the response, copies of the Registration Certificates themselves were not submitted and therefore, the Examining Attorney failed to consider any of the registrations cited. Accordingly, copies of these registrations have been

submitted by voluntary amendment making them part of the record and copies are also being resubmitted herewith as Exhibit A (Registration No. 2,280,000 for the mark "WATER MASK") and Exhibit B (Registration No. 4,375,066 for the mark "AQUATIC MASK"). It is respectfully requested that these exhibits be made of record in this Appeal.

As seen in Exhibit A, the mark "WATER MASK" was granted registration on September 21, 1999 for "hydrating mask" in International Class 3. This mark was cancelled on June 24, 2006, however, it was in effect during the time that the cited Registration (Registration No. 3,277,028) was undergoing prosecution at the USPTO. The ultimate grant of Registration No. 3,277,028 evidences that the USPTO deemed that consumers would be able to differentiate between marks using the words "water" and "ice" both as a prefix to the word "mask" and that there was no likelihood of confusion notwithstanding that both marks were to be used in connection with a type of beauty or facial "mask." Ice is a form of water and if consumers would be able to distinguish the marks "ICE MASK" and "WATER MASK", we see no reason to conclude that they would not similarly be able to distinguish between the marks "ICE MASK" and "SNOWMASK."

Exhibit B is directed to Registration No. 4,375,066 for the mark "AQUATIC MASK." While the term "aquatic" is undoubtedly related to "water" and while "ice" is a form of water, the USPTO granted registration for the mark "AQUATIC MASK" on July 30, 2013 notwithstanding the cited registration for the mark "ICE MASK" being in full

force and effect. The USPTO was also not deterred from granting registration despite the fact that both marks are associated with products in the field of facial cosmetics, in International Class 3.

The concurrent registration of such marks is evidence that the terms "ice", "water" and "aquatic" are differentiatable and it is respectfully submitted that the term "snow" is similarly distinguishable from such terms as they all relate to water but have different meanings.

Though the terms "ice" and "snow" do not have the same meaning as the Examining Attorney contends, even if they did, the other two factors of the three-pronged analysis- sight and sound- weigh heavily *against* any likelihood of confusion.

With respect to the "sight" portion of the sight, sound and meaning trilogy, Applicant's mark is visually displaced from the mark of Registration No. 3,277,028. Indeed, in contrast to Registration No. 3,277,028 which is comprised of two distinct words, Applicant uses the words "snow" and "mask" and combines them into a single, unitary term. The fact that there is a space between the words "ice" and "mask" in Registration No. 3,277,028 creates a mental impression that is distinct from Applicant's single word mark. The space breaks the cited registration into a three-letter word followed by a four-letter word while Applicant's mark is simply visualized as an 8 letter fanciful word.

In considering the "sound" portion of the trilogy, it is again noted that the spacing of the terms "ice" and "snow" as compared to the word "mask" is not insignificant. The

"ICE MASK" mark, as it is made up of two distinct terms, would be read with a break or breath in between whereas Applicant's "SNOWMASK" mark –a unitary, fanciful word- would be read in a single breath.

Referring to any phonetic similarity between the marks at issue, it is clear that the words "snow" and "ice" are not phonetically similar to each other in any audio interpretation imaginable.

Thus, it is believed that the Examining Attorney's analysis fails in all three of the "meaning", "sight" and "sound" tests when applied to the marks which are the subject of this appeal.packard

IV. CONCLUSION

In consideration of all of the above-factors, Applicant submits that there is no reasonable likelihood of confusion between the "ICE MASK" mark of Registration No. 3,277,028 and Applicant's "SNOWMASK" mark.

The Trademark law seeks to prevent likelihood of confusion, not remote possibilities of confusion based upon speculation and supposition. See *In re Chalet Chocolate, Inc.,* 212 USPQ 968, 969 (TTAB 1982). A conclusion that a likelihood of confusion exists between Applicant's mark and the cited Registration would be speculative and not supported by the record.

Accordingly, Applicant's mark is entitled to registration. The Board is therefore respectfully requested to reverse the Trademark Examining Attorney's decision refusing registration of Applicant's mark.

Respectfully submitted,
FOR: ROSENBERG, KLEIN & LEE

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this paper is being transmitted electronically to the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board on the date shown below.

Nicole B. Rackiewicz

July 14, 2016
Date

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 2,280,000

United States Patent and Trademark Office

Registered Sep. 21, 1999

TRADEMARK
PRINCIPAL REGISTER

WATER MASK

HELENA RUBINSTEIN S.A. (FRANCE SOCIETE ANONYME)
129, RUE DU FAUBOURG
SAINT-HONORE
75008 PARIS, FRANCE 75381

FOR: HYDRATING MASK, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).
FIRST USE 4-6-1999; IN COMMERCE 4-6-1999.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MASK", APART FROM THE MARK AS SHOWN.

SN 75-404,332, FILED 12-12-1997.

PRISCILLA MILTON, EXAMINING ATTORNEY

Exhibit A

United States of America

United States Patent and Trademark Office

AQUATIC MASK

Reg. No. 4,375,066

Registered July 30, 2013

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

TAIKI CORP., LTD. (JAPAN LIMITED PARTNERSHIP)
2-16, MIYAKOJIMAKITADORI, 1-CHROME,
MIYAKOJIMA-KU, OSAKA-SHI
OSAKA, JAPAN 534-0014

FOR: PLASTERING TYPE FACE-PACK COSMETICS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY CLAIMED UNDER SEC. 44(D) ON JAPAN APPLICATION NO. 2012-059436, FILED 7-24-2012, REG. NO. 5551932, DATED 1-25-2013, EXPIRES 1-25-2023.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MASK", APART FROM THE MARK AS SHOWN.

SER. NO. 85-743,734, FILED 10-2-2012.

WILLIAM VERHOSEK, EXAMINING ATTORNEY

Acting Director of the United States Patent and Trademark Office

Exhibit B