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Subject: TRADEMARK APPLICATION NO. 76349852 - E-WEAR - 55210/424

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/349852

APPLICANT: MATSUSHITA ELECTRIC CORPORATION OF AMERI ETC.

***7634985**

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: E-WEAR

CORRESPONDENT'S REFERENCE/DOCKET NO: 55210/424

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

Applicant: Matsushita Electric Corporation : BEFORE THE
of America
Trademark: E-WEAR : TRADEMARK TRIAL
Serial No: 76349852 : AND
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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark E-WEAR for "wearable portable audio/video products, namely, digital camcorders, digital still cameras, digital audio players and digital voice recorder; liquid crystal display viewers for the viewing of videos, namely, video monitors and dot-matrix sd-enabled printers for printing digitally recorded video images, none of the above products to be featured in or as part of a cellular telephone or cellular telephone accessory,"¹ in Class 9 on the ground of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with the mark in Reg. No. 2293127, ELECTRONIC WEAR, for "electronic cordless telephone accessories, namely, antennas, backup batteries, phone batteries, battery eliminators, electrical cables, carrying cases and protectors, cellular phones, electrical cigarette lighter socket adapters, electrical cellular connectors, electrical coaxial connectors, digital display units, telephone headsets, telephone

microphones, power supplies, voice storage circuits, electrical cellular wire connectors and telephone mounts,” in Class 9.

FACTS

Applicant filed this application on December 17, 2001, applying to register on the Principal Register the mark E-WEAR for “wearable portable audio/video recorders including a digital camcorder, digital still camera, digital audio player and digital voice recorder; LCD viewers for the viewing of video; and printers for printing digitally recorded video images.” In the First Office Action dated April 12, 2002, registration was refused (1) under Section 2(e)(1) on the ground that the mark merely describes the goods identified in the application, (2) under Section 2(e)(1) on the ground that the mark deceptively misdescribes the goods identified in the application, (3) under Section 2(d) on the ground that the mark, when used in connection with the identified goods, so resembles the mark in Reg. No. 1845160 as to be likely to cause confusion, to cause mistake, or to deceive, (4) under Section 2(d) on the ground that the mark, when used in connection with the identified goods, so resembles the mark in Reg. No. 2532621 as to be likely to cause confusion, to cause mistake, or to deceive. The applicant was also required to clarify the identification of goods and to submit information concerning the goods. The applicant was also advised of the potential refusal under Section 2(d) with regard to prior-filed Application Serial Nos. 76024141, 75742114, 75755972, 75772783 and 76309290.

On October 10, 2003, the applicant (1) argued against the refusal to register the mark under Section 2(e)(1) as being merely descriptive, (2) argued against the refusal to register the mark under Section 2(e)(1) as being deceptively misdescriptive of the goods, (3) argued against the refusal to

¹ The identification reflects changes made by the applicant in correspondence dated August 4, 2004.

register the mark under Section 2(d) likelihood of confusion with regard to Reg. Nos. 1845160 and 2532621, (4) proposed an amended identification of goods, and (5) submitted information concerning the goods.

On November 6, 2002, the information concerning the goods was accepted, the potential refusals under Section 2(d) with regard to Application Serial Nos. 76024141 and 75755972 were withdrawn, the refusals to register the mark under Section 2(e)(1) as merely descriptive and alternatively as deceptively misdescriptive were maintained and continued, the refusals to register under Section 2(d) with regard to Reg. Nos. 1845160 and 2532621 were maintained and continued, the potential refusals under Section 2(d) with regard to prior-filed Application Serial Nos. 75742114, 75772783 and 76309290 were maintained and continued, and further action on the application was suspended pending disposition of prior-filed Application Serial Nos. 75742114, 75772783 and 76309290.

On March 31, 2003, applicant amended the identification of goods, argued against the refusal to register the mark under Section 2(e)(1) as merely descriptive of the goods, and argued against the refusal under Section 2(e)(1) as deceptively misdescriptive of the goods.

On June 10, 2003, the amended identification was accepted, the refusal to register the mark under Section 2(e)(1) as deceptively misdescriptive was withdrawn, the refusal to register the mark under Section 2(d) with regard to Reg. Nos. 1845160 and 2532621 were withdrawn, the potential refusal under Section 2(d) with regard to prior-filed Application Serial Nos. 75742114, 75772783 and 76309290 were withdrawn, the refusal to register the mark under Section 2(e)(1) as merely

descriptive was maintained and continued, and a new issue was raised with the mark being refused under Section 2(d) with regard to Reg. No. 2293127.

On December 4, 2003, the applicant argued against the refusal to register the mark under Section 2(e)(1) as merely descriptive, and argued against the refusal to register the mark under Section 2(d) with regard to Reg. No. 2293127.

On February 5, 2004, the refusal to register the mark under Section 2(e)(1) as merely descriptive was withdrawn, and the refusal to register the mark under Section 2(d) with regard to Reg. No. 2293127 was maintained and made final.

On August 4, 2004, the applicant submitted a request for reconsideration of the refusal to register the mark under Section 2(d), proposed an amended identification of goods, and filed a Notice of Appeal.

On August 6, 2004, the applicant submitted an amendment to allege use. On September 1, 2004, the amendment to allege use was accepted.

On September 20, 2004, the amended identification of goods was accepted, and the request for reconsideration was refused and the final refusal maintained with regard to the Refusal to register the mark under Section 2(d).

On November 26, 2004, the applicant filed its appeal brief, and the file was forwarded to the examining attorney for statement on December 6, 2004.

ISSUE

The issue on appeal is whether the mark, when used in connection with the identified goods, so resembles the mark in Registration No. 2293127 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

BECAUSE THE MARKS WILL BE APPLIED TO CLOSELY RELATED GOODS, REGISTRATION OF E-WEAR, WHICH CREATES THE SAME COMMERCIAL IMPRESSION AS ELECTRONIC WEAR, IS LIKELY TO CREATE CONSUMER CONFUSION AS TO SOURCE

(A) SIMILARITY OF THE MARKS

THE MARKS CREATE THE SAME COMMERCIAL IMPRESSION

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *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 of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

When determining whether there is a likelihood of confusion under Section 2(d), the question is not whether people will confuse the marks, but rather whether the marks will confuse the people into believing that the goods they identify emanate from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); TMEP §1207.01(b).

The applicant applied to register the mark E-WEAR. The registered mark is ELECTRONIC WEAR.

The commercial impression created by the applicant's mark, E-WEAR, is the same as the registrant's mark, ELECTRONIC WEAR.

The prefix E- is a well-known abbreviation for “electronic,” and is commonly used as a prefix to indicate “electronic.”² Moreover, numerous cases have recognized the “e” prefix as a descriptive designation for electronic when the mark is used for electronic goods and/or services. *See generally, In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002) (E-AUTODIAGNOSTICS merely descriptive of an “electronic engine analysis system comprised of a hand-held computer and related computer software”); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000) (E FASHION held merely descriptive of software for use in shopping via global computer network and electronic retailing services); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (E-TICKET held generic for computerized reservation and ticketing of transportation services). In this case, where the applicant’s goods are electronic, the prefix “e” would be understood by potential purchasers as meaning “electronic.”³

The examining attorney makes reference to and incorporates herein a sample of excerpted articles from the LEXIS/NEXIS® computerized database included with the June 10, 2003 Office Action. The excerpts demonstrate that the letter “E” in the applicant’s mark would be understood as meaning “electronic.” The relevant parts of the articles read as follows:

USA Today, July 8, 1998.

“When you see a technological term that starts with the letter ‘e’ and a hyphen, it most likely is an e-commerce-driven term. And nine times out of 10, the ‘e’ means electronic.”

² *Cambridge English Dictionary*. Copyright 2003 by Cambridge University Press. Attached as evidence to the Office Action dated June 10, 2003; *Encarta World English Dictionary [North American Edition]*. Copyright 2004 by Microsoft Corporation. Attached as evidence to the Final Refusal dated February 5, 2004.

³ The term ELECTRONIC means “of, relating to, produced by means of electronics.” *The American Heritage Dictionary of the English Language, Fourth Edition*. Copyright 2000 by Houghton Mifflin Company. Attached as evidence to the Final Refusal dated February 4, 2004.

St. Petersburg Times, June 11, 2001.

“It’s being called wearable electronics, or “e-wear.”

The examining attorney also makes reference to an incorporates herein an excerpt of a sample representative article obtained from a search of the Internet using the Google® computerized database and included with the June 10, 2003 Office Action. The excerpt further demonstrates that the letter “e” in the applicant’s mark would be understood to mean “electronic.” The relevant part of the article reads as follows:

<http://www.telemed.no/cparticle69113-4361.html>.

“Developments in textile technology and fibre industry are other components of the design concept of ewear (wearable electronics) for health care workers.”

The word WEAR is defined as, “To carry or have habitually on the person... .”⁴

The meaning of the two marks is the same, namely, electronic items which people habitually carry on them.

The confusing similarity of the marks is compounded by the fact that the immediate image evoked by the marks, goods people habitually carry on them, are the types of goods at issue here, e.g., cellular phones, cellular video phones, digital cameras, audio players, video players, and camcorders.

In this case, the applicant's mark is similar to the registrant's mark in appearance and sound, and is identical to the registrant's mark in meaning and commercial impression.

(B) SIMILARITY OF THE GOODS

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); TMEP §1207.01(a)(iii).

Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

Since the marks of the respective parties are highly similar and identical in meaning or commercial impression, the relationship between the goods or services of the respective parties need not be as

⁴ *The American heritage Dictionary of the English Language, Fourth Edition.* Copyright 2000 by Houghton Mifflin

close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

1. APPLICANT'S IDENTIFIED GOODS ARE CLOSELY RELATED TO AND WITHIN THE LOGICAL ZONE OF EXPANSION OF TRADE AS THE REGISTRANT'S GOODS

The applicant's identified goods, as amended are, "wearable portable audio/video products, namely, digital camcorders, digital still cameras, digital audio players and digital voice recorder; liquid crystal display viewers for the viewing of videos, namely, video monitors and dot-matrix sd-enabled printers for printing digitally recorded video images, none of the above products to be featured in or as part of a cellular telephone or cellular telephone accessory."

The registrant's identified goods include "cellular phones," "digital display units," "power supplies" and "voice storage circuits."

The applicant's identified goods are substantially related to the registrant's goods. That is, the applicant's digital voice recorders can be used in conjunction with the registrant's cellular phones and voice storage circuits. The registrant's "digital display units" could be used in conjunction with the applicant's digital camcorders and digital still cameras.

Within the last several years, cellular telephones which incorporate cameras, camcorders, audio players, voice recorders and/or video monitors have become readily available to the consumer

public. The registrant's goods identified as "cellular phones" contain no limitations as to the features or functions of the phones. Therefore, the examining attorney must presume that they encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. That is, the examining attorney must presume that the registrant's cellular phones encompass cellular phones which incorporate cameras, camcorders, audio players, voice recorders and video monitors. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); TMEP §1207.01(a)(iii).

The examining attorney makes reference to and incorporates herein a sample of excerpted articles from the LEXIS/NEXIS® computerized database included with the February 4, 2004 Final Refusal. The excerpts demonstrate that the applicant's goods are features and/or functions of many cellular phones. The relevant parts of the articles which demonstrate the related nature of the goods read as follows:

Akron Beacon Journal (Ohio), January 29, 2004.

"Students with cell phone cameras... ."

Argus Leader (Sioux Falls, SD), January 24, 2004.

"As cell phone camera usage becomes more popular... ."

Newsday (New York), July 13, 2001.

"...wireless mobile devices that combine cell phones with audio players are the future"

CBS News Transcripts, January 27, 2004.

“Sales hit a three-year high as people bought cell phones with features such as cameras and audio players.”

Electronic Business, August 1, 2001.

“Samsung was one of the first companies to introduce ‘converged’ consumer devices, such as Uproar, its cell phone with a built-in MP3 audio player.”

Buffalo News (New York), January 26, 2003.

“... cell phones that have digital voice recorders, cameras and computer access devices.”

The examining attorney also makes reference to and incorporates herein a sample of representative articles obtained from a search of the Internet using the Google® computerized search engine and included with the February 4, 2004 Final Refusal. These articles also demonstrate that the applicant’s identified goods are features and/or functions of many cellular phones. The relevant parts of the articles which demonstrate the related nature of the goods read as follows:

[Http://www.ysatoday.com/tech/news/2004-01-16-cam-phone-quality_x.htm](http://www.ysatoday.com/tech/news/2004-01-16-cam-phone-quality_x.htm).

“Tens of millions of these ... pictures were snapped from cell phones in the United States during 2000, the first full year such services were available.”

[Http://www.wired.com/news/business/0,1367,57692,00.htm](http://www.wired.com/news/business/0,1367,57692,00.htm)

“Global sales of mobile phones that can take, send, and receive pictures rose 65 percent in the last quarter from 5.2 million units to 8.6 million phones sold, according to market research firm Strategy Analysts.”

[Http://www.videosystems.primediabusiness.com/ar/video_sound_bells/](http://www.videosystems.primediabusiness.com/ar/video_sound_bells/)

“Camera equipped cell phones, according to marketing research firm IDC, are likely to outsell digital still cameras this year and may even surpass all cameras, film and digital, by the end of next year.”

[Http://www.telestial.com/products/n_8910_gsm_cell_phone.htm](http://www.telestial.com/products/n_8910_gsm_cell_phone.htm)

“Nokia 8910 ... a phone packed with such standard functions as ... voice recorder... .”

[Http://www.cellularabroad.com/nokia7860gsm.html](http://www.cellularabroad.com/nokia7860gsm.html)

The Nokia 7650 features include an integrated digital camera and voice recorder.

[Http://www.telestial.com/products/m_p7389_gsm_cell_Phone.htm](http://www.telestial.com/products/m_p7389_gsm_cell_Phone.htm)

“The Motorola Timesport series ... features on this cellular phone include ... a voice recorder... .”

[Http://www.forbes.com/infoimaging/2003/07/16/ex_ik_0716tentech.htm](http://www.forbes.com/infoimaging/2003/07/16/ex_ik_0716tentech.htm).

“Samsungs Anycall SCH-V330, a mobile phone with a camcorder function. ... Camcorder phones allow users to shoot video clips with audio in addition to shooting still pictures.”

The applicant’s goods are within the registrant’s logical zone of expansion. That is, the registrant could reasonably expand into the trade of digital camcorders, digital still cameras, digital audio players and digital voice recorder; liquid crystal display viewers for the viewing of videos, namely, video monitors and dot-matrix sd-enabled printers for printing digitally recorded video images.

The examining attorney makes reference to and incorporates herein a sample of representative third party registrations included with the February 4, 2004 Final Refusal and the September 20, 2004 denial of the request for reconsideration. The third party registrations have probative value to the extent that they serve to suggest that the goods listed therein, namely, cellular telephone and cellular telephone accessories, and camcorders, cameras, audio players, voice recorders, liquid crystal displays, video monitors and printers, are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The relevant parts of some of the third party registrations which demonstrate the related nature of the goods read as follows:

Registration No. 2541823 – “... cellular telephones, digital cameras and camcorders... .”

Registration No. 2565083 – “... cellular telephones, digital cameras and camcorders... .”

Registration No. 2578879 – “... cameras, ... digital cameras, ... cellular telephones... .”

Registration No. 2598648 – “... cellular telephones, ... liquid crystal displays, ... digital voice recorders.”

Registration No. 2684369 – “... digital audio recorders, ... digital cameras and/or camcorders, ... cellular telephones, ... audio tape and/or digital players”

Registration No. 2701005 – “... digital audio recorders, ... digital cameras and/or camcorders, ... cellular telephones, ... audio tape and/or digital players”

Registration No. 2709682 – “... cellular and digital phones, ... video camcorders, digital still cameras, digital voice recorders... .”

Registration No. 2778270 – “... digital cameras, printers for digital cameras, ... cellular telephones, ... digital audio players... .”

Registration No. 2778230 – “... digital cameras, printers for digital cameras, ... cellular telephones, ... digital audio players... .”

Registration No. 2798239 – “... consumer electronics equipment, namely, cameras, camcorders, audio and video recorders and players, ... cellular phones... .”

Registration No. 2753781 – “... digital still cameras, ... digital video and audio recorders, ... cellular telephones... .”

Registration No. 2735350 – “... cellular telephones, ... video monitors... .”

Registration No. 2480744 – “... electronic displays for use as a component in camcorders, cameras, digital cameras, ... cellular telephones, ... crystal display screens.”

2. THE RESPECTIVE GOODS MOVE IN THE SAME CHANNELS OF TRADE

The applicant’s and registrant’s consumer electronics goods would be found in the same channels of trade. As evidenced by the excerpted Lexis® articles, the online articles, and the representative third party registrations attached to the Final Refusal dated February 4, 2004, and the refusal of the request for reconsideration dated September 20, 2004, companies manufacture and market the goods under the same mark, and the goods are sold through the same stores or websites. This is evidence that consumers are accustomed to viewing the same mark used in connection with the respective goods. Upon viewing marks which create the same commercial impression on such closely related goods, purchasers would mistakenly believe that the goods emanate from a common source.

The applicant argues that confusion is unlikely because the purchasers at issue are sophisticated. In the electronics field, case decisions have held that the sale of related merchandise under the same or similar marks would be likely to cause confusion in spite of the sophistication and technical background of the purchasers. The fact that purchasers of products of the parties are well

informed, technically trained, and a discriminating group of people does not mean that they are immune from confusing products as to source when the marks applied thereto are similar. *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973).

CONCLUSION

The applicant's mark E-WEAR is likely to be confused with the registrant's mark ELECTRONIC WEAR where the applicant's mark has the same meaning and creates the same commercial impression as the registrant's mark, are used on substantially related goods with overlapping functions, where the applicant's goods are within the registrant's logical field of expansion of trade, the goods can be made by the same companies, marketed under the same trademark, and sold through the same channels of trade to the same end consumers. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

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