

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: X-FIGHT LLC

Please place on Upper Right Corner
of Response to Office Action ONLY.

MARK: X FIGHT

Examining Attorney: BUTLER, MIDGE

SERIAL NO.: 76/680,512

Serial Number: 76/680512

FILED: August 9, 2007

EXAMINER: Midge F. Butler, Trademark Attorney, Law Office 107

**NOTICE OF APPEAL
AND
APPLICANT'S APPEAL BRIEF**Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

08/07/2009 SWLSON1 00000005 011174 76680512

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NOTICE OF APPEAL

Applicant appeals the final refusal based on Reg. No. 3543747 of X-FIGHTERS and requests that the appeal fee of \$100 be charged to Deposit Account No. 01-1174, a duplicate copy of this request being submitted herewith to implement this request.

APPLICANT'S APPEAL BRIEF**1. Prefatory Statement**

In applicant's reply of February 13, 2008, applicant amended the recited goods to "Athletic apparel, namely sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports" wherein the caveat "except t-shirts, sportswear and footwear for sports" was intended to avoid conflict with Registrant's recited goods of "clothing, footwear . . . headgear, including t-shirts,

blouses, sweaters, anoraks, windbreakers, aprons, caps, hats, headbands, braces, belts (clothing), . . . sportswear, footwear for sports.”

The avoidance sought was not possible for business reasons so applicant sought avoidance with Registrant’s “footwear for sports” and in a Reply to Office Action of May 15, 2009 amended the recitation of goods to “Footwear for sports not including golf shoes with spikes.”

In addition to (A) the likelihood of confusion issue, there is the (B) issue on appeal of whether the recitation “Footwear for sports not including golf shoes with spikes” is not within the exception “to clarify or limit the goods.”

2. Argument to Issue (B)

REGISTRATION NO. 3,543,747

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Clothing, namely, T-shirts, blouses, sweaters, anoraks, wind resistant jackets, aprons, caps, hats, headbands, suspenders, belts, money belts, sun visors; sportswear, namely, shirts, pants, polo shirts, sweat shirts and sweat pants, hooded shirts and sweat shirts, shorts, blouses, skirts, jumpers, jackets and coats; footwear for sports; footwear excluding orthopedic footwear; headgear, namely, hats, caps, headbands; cap peaks, namely, cap visors, baseball caps, golf caps, and caps with visors.

In reciting “footwear (except for orthopedic purposes),” applicant argues it was intended to refer to popular footwear and, similar to the exclusion of “footwear for orthopedic purposes” would be the exclusion of footwear for sports, such as sneakers, running shoes, and the like.

In reciting the goods in Reg. No. 3,543,747, the sequence of the goods highlighted, a sequence absent in the application and occurring in the recitation of goods of the registration, applicant argues that it is within the exception “to clarify or limit the goods” and has

done so in excluding “golf shoes with spikes,” an exclusion known from common experience to be necessary under the circumstances “to clarify or limit the goods.”

Also in the recitation of the goods in the registration reads “footwear (except for orthopedic purposes)” and in the application reads “footwear excluding [no word ‘for’] footwear” (underlining added). Thus, excluding is substituted for “except,” the word “for” is omitted, and the word “footwear” is substituted for “purposes.”

In summary, applicant argues that it has established by its amended goods a product diversity which obviates the likelihood of confusion and relies on TMEP 1207.01(a)(i) which, in pertinent part, provides:

“If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. (Citing *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990), *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986).”

Applicant’s position is that on the record, it has not been established that the respective goods are marketed in a way that they would be encountered in a situation that would create the incorrect assumption that they originate from the same source (underlining added).

3. Argument to Issue (A)

Assuming the Board rules in favor of applicant on Issue (B), applicant addresses Issue (A).

On the issue of Likelihood of Confusion

Section 2(d) of the Trademark Act precludes registration of an applicant’s mark “which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion... .” 15 U.S.C. 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563,

567 (CCPA 1977), sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods in the application and the cited registration. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

In this case the respective goods are “footwear for sports, not including shoes with spikes”) (applicant) and “. . . sportswear, footwear for sports”(underlining added to focus on pertinent goods of Registrant).

As known from common experience, Registrant’s footwear for sports would be focused on popular sports such as tennis, skiing, football, soccer and baseball and will be sold in specialty sports stores and, in applicant’s case, sold in a golf store in which it is important to note, again as known from common experience, is not likely to sell footwear for tennis, skiing, football, soccer and baseball. Thus, there is no likelihood of confusion based on the respective goods.

Nor are the goods related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ 2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Furthermore, in comparing the goods the Board must consider the goods as identified in the application and registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ 2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to

the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed." See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Applicant's goods are identified as "footwear for sports, not including golf shoes with spikes." The goods in the cited registration is identified as "sportswear, footwear for sports" *i.e.* sports such as tennis, skiing, football, soccer and baseball.

Based on the aforesaid it must be concluded that the respective goods, as identified, are, not the least in part, overlapping and identical, and that the goods identified in the cited registration do not encompass the goods identified in the application.

In view of the fact that the goods as identified are not in the least in part, overlapping and identical, and in the use by applicant of a trade-channel limitation in the caveat "golf shoes with spikes," it must be concluded that the respective goods are not marketed to the same potential purchasers through the same trade channels. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ 2d 1910 (TTAB 2000); and *In re Smith & Mehaffey*, 31 USPQ 2d 1531 (TTAB 1994).

Before proceeding to consider the marks, it is to be noted that, "the lack of similarity [between the marks] necessary to support the conclusion of likely confusion does not redound to applicant's detriment as when the goods or services are identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992).

In comparing the marks it must consider the differences in appearance, sound, connotation and commercial impression of the marks at issue. (see *Palm Bay Imports Inc. v.*

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ 2d 1689, 1692

(Fed. Cir. 2005) which in this case are:

X Fight (no hyphen and no “ers” suffix by applicant) and

X-FIGHTERS (hyphen and plural “ers” suffix by registrant).

Finally, after considering all evidence and arguments bearing on the *du Pont* factors, it is respectfully requested that the Board conclude that there is no likelihood of confusion between Applicant’s X FIGHT mark when used in connection with “footwear, not including golf shoes with spikes,” and the registered X-FIGHTERS mark used in connection with “sportswear, footwear for sports” *i.e.* sold in specialty sports stores.

It is respectfully requested that the Board overrule the refusal under Trademark Act Section 2(d).

Respectfully Submitted,

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Dated: July 30 2009