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Subject: U.S. TRADEMARK APPLICATION NO. 76680512 - X FIGHT - P-3847-3

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 76/680512

**MARK:** X FIGHT



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** X-FIGHT LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

P-3847-3

**CORRESPONDENT E-MAIL ADDRESS:**

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's final refusal to register the trademark X FIGHT for athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports on the grounds that it is likely to cause confusion with the registered mark, X-FIGHTERS,<sup>1</sup> pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Furthermore, applicant has appealed the trademark examining attorney's refusal to register the trademark under 37 C.F.R. §2.71(a) because the proposed amendment to the identification of goods is outside the scope of the identification that was set forth in the application, as amended on February 15, 2008.

## **FACTS**

On August 9, 2007, the applicant filed an application to register X-FIGHT for "athletic apparel." In the first Office Action, dated January 15, 2009, the trademark

examining attorney required that the applicant amend the identification of goods to indicate the specific items of athletic apparel and informed the applicant that the upon entry of an acceptable identification of goods, the application would be suspended pending the disposition of Serial No. 79-038602 for the mark X-FIGHTERS, filed February 27, 2007.

On February 15, 2008, the applicant submitted a response to the trademark examining attorney's first Office action arguing that confusion was unlikely because of the differences in sound, meaning, and appearance between the marks and also amended the original identification of goods to reads as "athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports."

On March 17, 2008, the trademark examining attorney accepted the amendment to the identification of goods and suspended the application waiting the disposition of the prior pending application. On April 13, 2009, the trademark examining attorney refused registration on the Principal Register because the proposed mark so resembled the mark in Registration No. 3,543,747, as to be likely to cause confusion, to cause mistake or to deceive. On May 20, 2009, the applicant responded to the refusal to register the mark under Section 2(d) of the Trademark Act by amended the drawing to delete the hyphen between the letter "X" and the word "FIGHT." Applicant also sought to amend the identification of goods to "footwear for sports, not including golf shoes with spikes."

On May 28, 2009, the trademark examining attorney accepted the amended drawing, but issued a final refusal to the proposed amendment to the identification of goods because it referred to goods that were not within the scope of the identification as

amended on February 15, 2008. The trademark examining attorney also made final the refusal to register the mark based on a likelihood of confusion with Registration No. 3,543,747.

On June 17, 2009, applicant submitted a request for reconsideration which was denied by the trademark examining attorney on July 15, 2009. In response to the trademark examining attorney's denial of the request for reconsideration, the applicant timely filed its Appeal Brief on August 10, 2009.

### **ISSUES ON APPEAL**

**I. Whether the proposed mark so resembles U.S. Registration No. 3543747 as to be likely to cause confusion, to cause mistake, or to deceive.**

**II. Whether the proposed amendment to the identification of goods exceeds the scope of the identification as amended on February 15, 2008.**

### **ARGUMENTS**

**I. The proposed mark so resembles U.S. Registration No. 3543747 as to be likely to cause confusion, to cause mistake, or to deceive**

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, 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. du Pont 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. *Id.* The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

### **SIMILARITY OF THE MARKS**

The applicant is seeking registration of the mark X FIGHT, as compared to the registrant's mark, which is X-FIGHTERS. The applicant argues that confusion is not likely because of the *differences* in sound, meaning and appearance between the marks.<sup>ii</sup> However, the marks need not be identical for confusion to result. Rather marks are compared for *similarities* in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b). When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). In this case, both marks contain the letter X followed by a slight variation of the same word, that being "fight" and "fighter." As demonstrated by the dictionary definitions, the term "fight" is defined as "to contend in battle or physical combat." The term "fighter" is

defined as “one who engages in battle or physical combat.”<sup>iii</sup> Both marks bring to mind a battle or physical combat and therefore, conjure up the same idea, stimulate the same mental reaction and therefore, create the same overall meaning. In spite of the fact that one mark contains the verb fight, while the other contains the noun fighter, both marks create the same overall commercial impression. Consumer confusion has been held likely for marks that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MR. STAIN likely to be confused with MR. CLEAN on competing cleaning products); see *Ralston Purina Co. v. Old Ranchers Canning*, 199 USPQ 125

(TTAB 1978) (holding TUNA O’ THE FARM for canned chicken likely to be confused with CHICKEN O’ THE SEA for canned tuna).

Moreover, consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Since the first part of the registrant’s mark and the applicant’s mark are

identical, consumers will be more inclined to focus on that element when making purchasing decisions.

Lastly, marks may be confusingly similar in appearance where there are similar terms or phrases or *similar parts of terms* or phrases appearing in both applicant's and registrant's mark. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and

MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii). Because applicant's X FIGHT mark is incorporated in its entirety by registrant's mark "X-FIGHTERS," the marks are substantially similar in overall sound and appearance.

### **SIMILARITY OF THE GOODS**

As the current record stands, the applicant uses the proposed mark on “athletic apparel, namely, *sweatshirts and sweatpants*, except t-shirts, sportswear and footwear for sports,” as compared to the registrant’s goods which are “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.” First, it should be noted that the applicant’s entire argument regarding the differences between the goods is based on an amendment to the applicant’s identification of goods which, for the reasons explained below, is not the current identification of goods in the application.

Therefore, when considering the current identification of goods, specifically the above highlighted items, both the applicant and the registrant sell the identical goods, that being, sweatshirts and sweatpants. The registrant’s remaining goods are additional clothing items. The decisions in the clothing field have held many different types of apparel to be related under

Trademark Act Section 2(d). *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) (women’s boots related to men’s and boys’



underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386 (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); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

Moreover, neither the application nor the registration contain any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

Before addressing the remaining identification of goods issue, the applicant should note that any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

**II. The proposed amendment to the identification of goods exceeds the scope of the identification as amended on February 15, 2008.**

The proposed amendment to the identification of goods exceeds the scope of the identification that was set forth in the application, as amended on February 15, 2008. *See* 37 C.F.R. §2.71(a). Under 37 C.F.R. §2.71(a), an applicant may amend “to clarify” the identification of goods and services. The applicant may clarify an identification of goods and services that is indefinite or overly broad, to identify goods or services that are within the scope of the goods and services in the identification. Trademark Act §7(c), 15 U.S.C. §1057(c), provides that filing an application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration. Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for the Principal Register. For that reason, the applicant may not expand those rights through amendment of the identification of goods and services.

In response to the trademark examining attorney’s Office Action dated November 28, 2007, requiring the applicant to clarify the original identification of goods to specify the type of athletic apparel, the applicant amended the identification of goods to “athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports.” The trademark examining attorney informed the applicant that the

amendment to the identification of goods was accepted and thereby, made of record.<sup>iv</sup>

The applicant then attempted to substitute the previously accepted identification with “footwear for sports, not including golf shoes with spikes.”<sup>v</sup> This wording is beyond the scope of the amended application because the applicant had previously entered an acceptable amendment to the identification listing the goods as “athletic apparel, namely, sweatshirts and sweatpants, *except t-shirts, sportswear and footwear for sports.*”

Once an applicant amends the identification of goods in a manner that is acceptable to the trademark examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm’r Pats. 1991). TMEP §1402.07(e). The applicant may not amend the identification to reinsert goods that were omitted or deleted from the identification of goods. Note that in the February 15, 2009 response, the applicant specifically deleted “footwear for sports” and further argued that confusion is unlikely “because of the non-use of X FIGHT on “t-shirts, sportswear and footwear for sports.” Because this amendment includes goods that were explicitly deleted from the applicant’s February 15, 2008 response, the amendment exceeds the scope of the identification of goods and therefore, is unacceptable.

### **CONCLUSION**

For the foregoing reasons, the trademark examining attorney respectfully requests that the refusal to register the applicant’s mark X-FIGHT under Trademark Act

Section 2(d), U.S.C. §1052(d) be affirmed. It is also requested that the refusal to register the mark on the ground that the May 20, 2009 proposed amendment to the identification of goods exceeds the scope of the previously accepted amendment to the identification of goods be affirmed.

Respectfully submitted,

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<sup>i</sup> Issued December 9, 2008

<sup>ii</sup> See applicant's incoming response dated February 15, 2008

<sup>iii</sup> See April 13, 2009 Office Action pages 5 and 7

<sup>iv</sup> See March 17, 2008 Office Action page 1

<sup>v</sup> See Applicant's response dated May 20, 2009 page 1