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Subject: U.S. TRADEMARK APPLICATION NO. 77735348 - PURE AIR - 20505/015 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/735348

MARK: PURE AIR

CORRESPONDENT ADDRESS:
KATHLEEN S. RYAN
THE OLLILA LAW GROUP, LLC
2569 PARK LANE SUITE 202
LAFAYETTE, CO 80026

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Fragrant Passage Candle Co., L.P.

CORRESPONDENT'S REFERENCE/DOCKET NO:
20505/015
CORRESPONDENT E-MAIL ADDRESS:
KRyan@olgip.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the trademark

PURE AIR (standard characters) for "candles" on the grounds that the mark, under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), is likely to be confused with the mark PUREAYRE for "air freshening preparations" that is the subject of U.S. Registration No.2303846.

FACTS

On May 12, 2009, applicant, Fragrant Passage Candle Co., L.P., applied for registration, on the Principal Register, for the trademark PURE AIR (standard characters), for

"candles." In the Office Action dated August 10, 2009, the trademark examining attorney refused registration under Section 2(d) of the Trademark Act based on likelihood of confusion with U.S. Registration No. 2303846 for the mark PUREAYRE (typed drawing) for "air freshening preparations." On October 23, 2009, the trademark examining attorney issued a final refusal regarding the likelihood of confusion as to U.S. Registration No. 2303846. Applicant's subsequent Request for Reconsideration was denied on May 28, 2010. This appeal now follows.

ARGUMENT

APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARK, AND THE GOODS ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). 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 be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. Not all of the factors, however, are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks; similarity of the goods; and similarity of trade channels of the goods. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); TMEP §§1207.01 et seq.

A. The Marks are Confusingly Similar

Applicant seeks to register the mark PURE AIR in standard characters. The registrant's mark is PUREAYRE in typed form. The marks are phonetic equivalents. Similarity in sound is particularly relevant here because the spoken mark is what consumers use when asking for a product and what consumers hear in radio advertisements and word-of-mouth endorsements. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); see TMEP §1207.01(b)(iv).

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *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). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd*., 8 USPQ2d 1534, 1535 (TTAB 1988); *see* TMEP §1207.01(b). Applicant's "PURE AIR," is similar to registrant's "PUREAYRE," in sound, meaning, and commercial impression.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that they identify come from the same source. *In re West Point-Pepperell, Inc.,* 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). 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. *See Recot, Inc. v. M.C. Becton,* 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). 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, 540-41 (TTAB 1979); TMEP §1207.01(b).

Applicant submits that the examining attorney refused registration based only on the "side-by-side" comparison of the marks. See applicant's brief, page 4. The examining attorney relies on precisely the opposite premise, that the comparison is not a side-by-side comparison, but based on the identical sounding marks that create an identical commercial impression, in light of both party's goods.

Applicant also argues that the word "PURE" is weak, and has submitted third-party registrations for marks containing the term "PURE." All third-party registrations submitted, however, are for "PURE," in combination with other matter. See applicant's brief, page 6. One part of a mark being supposedly weak does not render the entire mark weak. The second portion of the applicant's and registrant's marks are phonetically identical, with applicant's mark being "PURE AIR and registrant's mark being

"PUREAYRE." The addition of the phonetic equivalent of "air" in applicant and registrant's marks, in relation to the goods, creates a highly similar connotation and commercial impression.

Moreover, 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 goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978). 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 Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. American Leisure Prods., Inc.*, 47 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009). Furthermore, the goods listed in the third-party

registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods at issue, namely, candles and air freshening preparations.

In regard to the prior registrations submitted by the applicant, it is known that prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973).

In support of applicant's arguments, applicant also submits Registration No. 1146729, cancelled in February 9, 2002. See applicant's brief, page 7. A cancelled or expired registration, however, is not evidence that the mark listed therein is currently in use in the marketplace; it is evidence only that the registration issued. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); TBMP §704.03(b)(1)(A). Thus, Registration No. 1146729 has little, if any, probative value with respect to the registrability of applicant's mark.

Applicant argues that "sound" is of lesser importance in relation to "sight," and "meaning." See applicant's brief, page 9. The Board, however, has noted in the past that even slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983). In

the case at hand, applicant's proposed mark is identical sounding to registrant's mark.. "Sound" is actually of great importance, as similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); TMEP §1207.01(b)(iv).

Applicant argues that applicant's mark and registrant's mark are dissimilar in appearance and overall commercial impression. See applicant's brief, page 9. The fact the marks begin with the same word, and end in phonetic equivalents, makes the difference in spelling a very small factor to be considered. The small difference in spelling does not serve as a distinguishing feature, in light of the overriding similarities.

Applicant also submits that its proposed mark "PURE AIR," and registrant's "PUREAYRE" have different commercial impressions. When a consumer encounters "PUREAYRE," for "air freshening preparations," it is very likely they will come away with the identical commercial impression as "PURE AIR," since the goods are for "air" freshening purposes.

B. The Goods are Closely Related, Within The Same Channel of Trade

The applicant is providing "candles," while registrant is providing "air freshening preparations." Likelihood of confusion is determined on the basis of the as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); TMEP

§1207.01(a)(iii). In this case, the registrant's goods are identified broadly. It is presumed, therefore, that the registration encompasses all goods of the type described, including those in applicant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

The examining attorney makes reference to and incorporates herein the Internet evidence attached to the final Office Action of October 23, 2009, showing "candles" to be a type of "air freshening" preparation. The Febreze website shows a collection of air freshening preparations, that includes candles, that provide a "refreshing atmosphere." They specify that their "Home Collection is more than décor. It's a breath of fresh air." See also, evidence attached in the initial Office Action of August 10, 2009, and final Office Action of October 23, 2009, showing providers of families of air freshening preparations that include candles. For example, the WiseGeek and LovetoKnow web pages references "air freshening candles," and the FirstChoiceOKC web page shows "candle air freshener." The CooksWarehouse page shows candles listed alongside air fresheners. Registrant's broadly identified "air freshening preparations" may include "candles," and thus the goods are highly similar. Neither applicant's nor registrant's identification of goods contain restrictions as to classes of purchasers, therefore it is presumed that the goods overlap, and will be offered in the same trade channels, to the same classes of purchasers. *See In re Elbaum*, 211 ESPQ 639, 640 (TTAB 1981).

Applicant further argues that purchasers of applicant's and registrant's goods are knowledgeable and discriminating. See applicant's brief, page 12. The fact, however, that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Finally, 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. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). 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); TMEP §§1207.01(d)(i).

CONCLUSION

For the reasons set forth above, the refusal to register under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

/Gretta Yao/
Gretta Yao
Attorney
United States Patent & Trademark Office
Law Office 105
T. 571.272.9313
F. 571.273.9313

Thomas G. Howell
Managing Attorney
Law Office 105