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Subject: TRADEMARK APPLICATION NO. 78217228 - REPORT SEATTLE -
910009.237

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/217228

APPLICANT: Topline Corporation, The

***7821722**
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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: REPORT SEATTLE

CORRESPONDENT'S REFERENCE/DOCKET NO: 910009.237

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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.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Topline Corporation, The	:	BEFORE THE
Trademark:	REPORT SEATTLE	:	TRADEMARK TRIAL
Serial No:	78/217228	:	AND
Attorney:	William O. Ferron Jr.	:	APPEAL BOARD
Address:	Seed Intellectual Property Law Group PLL 701 Fifth Avenue Ste 6300 Seattle, WA 98104-7092	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark REPORT SEATTLE for "men's, women's and children's apparel, namely, shirts, pants, jeans, sweaters, skirts, dresses, suits, lingerie, shorts, coats, jackets, and swimwear; fashion accessories, namely, hosiery, belts, hats, gloves and scarves." Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) because there is a likelihood of confusion between the mark for which registration is sought and a prior registration and a disclaimer of the geographically descriptive term SEATTLE was required.

FACTS

On February 20, 2003, the applicant applied to register the mark REPORT SEATTLE for "footwear, clothing, clothing accessories, outerwear and headwear."

On August 12, 2003, the examining attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), issued a requirement concerning the identification of goods and issued a requirement for the disclaimer of the geographically descriptive term SEATTLE.

On February 11, 2004, the applicant submitted a response to the Office Action arguing against the refusal under Section 2(d) of the Trademark Act, arguing against the disclaimer requirement and amending the identification of goods. The applicant simultaneously filed a Request to Divide and divided "footwear" out of this application.

On April 4, 2004, a final refusal under Section 2(d) of the Trademark Act and a final requirement concerning the disclaimer of the term SEATTLE were issued.

On September 28, 2004, the applicant filed a notice of appeal and request for reconsideration. On November 24, 2004, the request for reconsideration concerning the refusal under Section 2(d) of the Trademark Act and the disclaimer requirement was denied.

On February 7, 2005, the applicant filed its appeal brief. On February 10, 2005, the applicant's appeal brief was forwarded to the examining attorney.

ISSUES

There are two issues remaining in this application: (i) the applicant's mark is confusingly similar to the mark in U.S. Registration No. 1,957,041 such that when used with the identified goods it is likely to cause confusion, to cause mistake and to deceive and should therefore be refused registration under Section 2(d) of the Trademark Act; (ii) the term SEATTLE is geographically descriptive of the goods and must be disclaimed.

ARGUMENTS

I. The Applicant's Mark is Confusingly Similar to the Mark in Registration No. 1,957,041

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1,957,041 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207 *et seq.*

The law applicable to this refusal is well settled. There are two steps in an analysis to determine whether there is a likelihood of confusion. First, the marks themselves must be compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the goods must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The applicant's mark is REPORT SEATTLE for "men's, women's and children's apparel, namely, shirts, pants, jeans, sweaters, skirts, dresses, suits, lingerie, shorts, coats, jackets, and swimwear; fashion accessories, namely, hosiery, belts, hats, gloves and scarves." The registered

mark is REPORT COLLECTION for “men's clothing and accessories, namely shirts, polos, T-shirts, sweatshirts, sweaters, cardigans, wind resistant jackets, coats, underwear, belts, socks.”

A. Similarity of the Marks

Similarity in appearance is one consideration in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance notwithstanding the addition, deletion or substitution of letters or words. *See, e.g., Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS, both for computer software); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (McKENZIE'S (stylized) for processed frozen fruits and vegetables held likely to be confused with McKENZIE for canned fruits and vegetables); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for clothing held likely to be confused with THE “21” CLUB (stylized) for restaurant services and towels); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes held likely to be confused with NEWPORT for outer shirts); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON for microprocessor used in commercial laundry machines held likely to be confused with MILLTRONICS (stylized) for electronic control devices for machinery); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL for resinous chemicals used in dyeing textiles held likely to be confused with LUTEX for non-resinous chemicals used in the textile industry).

Furthermore, marks must be considered in their entirety under Section 2(d). However, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of

confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988).

Here, the applicant's mark and the registered mark contain the identical dominant term REPORT. The only difference in the applicant's mark and the registrant's mark is the addition of the highly descriptive and disclaimed term COLLECTION in the registered mark and the addition of the geographically descriptive term SEATTLE in the applicant's mark..

The applicant's argument that marks must be analyzed in their entireties is noted. However, it is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting matter that is descriptive or suggestive of the named goods or services. Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences. TMEP §1207.01(b)(iii). *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (even though applicant's mark PACKARD TECHNOLOGIES (with "TECHNOLOGIES" disclaimed) does not incorporate every feature of opposer's HEWLETT PACKARD marks, similar overall commercial impression is created); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBOS (with "COMBOS" disclaimed) held likely to be confused with MACHO (stylized), both for food items as a part of restaurant services); *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987) (CSC ADVANCED BUSINESS SYSTEMS for retail computer stores held likely to be confused with CSC for computer time sharing and computer programming services); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE held likely to be confused with RESPONSE CARD (with "CARD" disclaimed), both for banking services); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for

footwear); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Energy Images, Inc.*, 227 USPQ 572 (TTAB 1985) (SMART-SCAN (stylized) for optical line recognition and digitizing processors held likely to be confused with SMART for remote data gathering and control systems); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment); *In re Denisi*, 225 USPQ 624 (TTAB 1985) (PERRY'S PIZZA held likely to be confused with PERRY'S, both for restaurant services); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and design (with "CALIFORNIA" disclaimed) held likely to be confused with COLLEGIENNE, both for items of clothing); *In re Pierre Fabre S.A.*, 188 USPQ 691 (TTAB 1975) (PEDI-RELAX for foot cream held likely to be confused with RELAX for antiperspirant).

Essentially, the applicant is using the dominant, literal portion of an already registered mark as the dominant literal portion of its own mark. The addition of descriptive and geographically descriptive matter to each of the marks does not obviate a finding that the applicant's mark is confusingly similar in appearance, sound, connotation and overall commercial impression to the registered mark.

B. Comparison of Goods

The second step in determining whether there is a likelihood of confusion is to compare the goods to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 38 (TTAB 1978). The applicant is seeking registration for

“men's, women's and children's apparel, namely, shirts, pants, jeans, sweaters, skirts, dresses, suits, lingerie, shorts, coats, jackets, and swimwear; fashion accessories, namely, hosiery, belts, hats, gloves and scarves.” The registrant has “men's clothing and accessories, namely shirts, polos, T-shirts, sweatshirts, sweaters, cardigans, wind resistant jackets, coats, underwear, belts, socks.”

Here, the goods of the applicant and registrant contain identical and related clothing items. The applicant's and registrant's shirts, sweaters, jackets, coats and belts are identical. The remainder of the parties' clothing is related and likely to be encountered by the same purchasers. Neither the application nor the registration contain any limitations regarding trade channels for the clothing and therefore it is assumed that registrant's and applicant's clothing items are sold everywhere that is normal for such items, including 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 and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Furthermore, the decisions in the clothing field have held many different types of apparel to be related under Section 2(d), including the clothing items of the applicant and the registrant. *Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) (“WINTER CARNIVAL” for women's boots v. men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (“ELANCE” for underwear v. “ELAAN” for neckties); *In re Melville Corp.* 18 USPQ2d 1386 (TTAB 1991) (“ESSENTIALS” for women's pants, blouses, shorts and jackets v. women's shoes); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (“NEWPORTS” for women's shoes v. “NEWPORT” for outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) (“OMEGA” for hosiery v. trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) (“GRANADA” for men's suits, coats, and

trousers v. ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) ("SLEEX" for brassieres and girdles v. slacks for men and young men).

C. Coexistence of the Marks Does Not Obviate a Finding of Confusion

The applicant's argument that the coexistence of the registered mark and the applicant's prior registrations obviates a finding of confusion, is not persuasive. The applicant argues that because the marks have existed without incidence of actual confusion there is a presumption that there is no likelihood of confusion. However, it is unnecessary to show actual confusion in establishing likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id.* at 1026-1027.

While the prior decisions of the Trademark Trial and Appeal Board discussed above state that it is not necessary to show actual confusion in an ex parte proceeding, it is notable that the prior registrations of the applicant are not for the goods in this application. These prior registrations are all for shoes and footwear. There is nothing in the record to support the applicant's proposition that its mark and the registered mark, when used on identical clothing items, have coexisted since 1993.

Furthermore, the examining attorney objects to any reference to and arguments based on the applicant's prior registrations as the applicant never properly made copies of the registrations of record in this application file.

Accordingly, the similarity in the appearance, sound, connotation and overall commercial impression of the applicant's mark and the registrant's mark and the identical and highly related nature of the applicant's and registrant's goods is sufficient to sustain a finding that the marks are confusingly similar under Section 2(d) of the Trademark Act. Therefore it is respectfully requested that the refusal to register the intended mark on the Principal Register under Trademark Act Section 2(d), 15 U.S.C Section 1052(d), be affirmed.

II. The Term SEATTLE is Geographically Descriptive of the Goods and Must be Disclaimed

Trademark Act Section 6(a), 15 U.S.C. §1056(a), permits the Office to require a disclaimer of an unregistrable component of a mark. Trademark Act Section 2(e), 15 U.S.C. §1052(e), bars the registration of a mark which is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive of the goods. Therefore, the examining attorney may require the disclaimer of a portion of a mark which, when used in connection with the goods, is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive. If an applicant does not comply with a disclaimer requirement, the examining attorney may refuse registration of the entire mark. TMEP §1213.01(b).

A two-part test is applied to determine whether a mark or term is geographically descriptive. First the term must be the name of a place known generally to the public. Second, the public must be likely to make a goods-place association, i.e., believe that the goods originate from that location. *In re California Pizza Kitchen*, 10 USPQ2d 1704, 1705 (TTAB 1989) (goods); *In re MCO Properties, Inc.*, 38 USPQ2d 1154, 1155 (TTAB 1995) (services).

In this case, the applicant is seeking to register the mark REPORT SEATTLE. The geographical place in the mark is SEATTLE. The applicant is located in the Seattle area, specifically, in Bellevue, Washington. The dictionary definition of Bellevue attached to the office

action dated April 7, 2004 indicates that Bellevue is in the Seattle metropolitan area. Furthermore, the applicant concedes that Bellevue is a suburb of Seattle (Applicant Brief at 7). Where the primary significance of the term is the name of a geographic location the public generally knows, and the applicant's goods come from that geographical place named in the mark, a public association of the goods with the place is presumed. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982); TMEP §1210.04(b). Accordingly, because the goods are sold by the applicant in Seattle, the public is likely to believe the goods originate there. Therefore, a goods-place association is presumed.

The applicant's argument that a finding that the term SEATTLE is geographically descriptive of its goods is not mandated by the mere fact that the applicant's offices are in the Seattle metropolitan area, is noted. However, the applicant does not dispute that it is located in the Seattle area and that its goods are sold there. Goods may be said to "originate" from a geographic location if they are sold there or if a business's headquarters are located there. *See Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sell "prestige" fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive); *see also In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993) (NANTUCKET NECTARS held primarily geographically descriptive of soft drinks, even though the goods were manufactured elsewhere, where the record showed that applicant's headquarters and research and development division were on Nantucket, the distributor of the goods was located on Nantucket, the specimens

indicated that the goods were “born” or “created” on Nantucket, and the goods were sold in the applicant’s store on Nantucket).

Furthermore, the applicant’s argument that the term SEATTLE “evokes the feeling and aesthetic of the Pacific Northwest” rather than the geographic origin of the goods, is not persuasive. The fact that a term may have other meanings in other contexts does not negate the basis for refusal as long as the most prominent meaning or significance is geographic. *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986); *In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986); TMEP §1210.02(b). Here, the applicant states that the term SEATTLE may suggest “a quality of life” and repeatedly refers to a Seattle aesthetic, but the applicant does not consistently state what that quality or aesthetic is. Furthermore, the applicant submitted absolutely no evidence indicating that the term SEATTLE has any generally and commonly understood meaning, connotation or significance other than geographic significance.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) and the final requirement for a disclaimer of the term SEATTLE, be affirmed.

Respectfully Submitted,

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me·chan·i·cal

me·chan·i·cal (mî-kàn'î-kel) *adjective*

Abbr. **mech.**

1. Of or relating to machines or tools: *mechanical skill*.
2. Operated or produced by a mechanism or machine: *a mechanical toy dog*.
3. Of, relating to, or governed by mechanics.
4. Performed or performing in an impersonal or machinelike manner; automatic: *a droning, mechanical delivery of the speech*.
5. Relating to, produced by, or dominated by physical forces: *the mechanical aspect of trumpet playing*.
6. *Philosophy.* Interpreting and explaining the phenomena of the universe by referring to causally determined material forces; mechanistic.
7. Of or relating to manual labor, its tools, and its skills.

noun

Printing.

A layout consisting of type proofs, artwork, or both, exactly positioned and prepared for making an offset or other printing plate.

— **me·chan·i·cal·ly** *adverb*

— **me·chan·i·cal·ness** *noun*¹

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advertising material which reflect how the term is used, the commercial impression created by such use, and the significance the term has on prospective purchasers. Put another way, printouts from collectors' websites do not address the issue of whether the applicant's proposed mark is being used in a manner that would permit customers to perceive the wording SUPERIOR QUALITY as a source indicator.

If arguendo, the applicant's collectors' websites were deemed to be admissible as evidence, the examining attorney believes that the use of the proposed mark SUPERIOR QUALITY as a "back mark" or "quality mark" stamped on the back of the antique buttons does not show use of the proposed mark as a trademark. "Back mark" or "quality mark" are stampings found on the back of buttons "to promote sales, as the differences in quality [in buttons] can seldom be noted." *See* selected pages from *The Collector's Encyclopedia of Buttons* which were previously attached to the examining attorney's continuation of final refusal dated June 28, 2004. The relevant pages from the reference text include definitions for the terms "back mark" and "quality mark" and depictions of 12 buttons. When the descriptions and depictions of applicant's printouts from the collectors' websites are taken into context, what they show is that like other descriptive and laudatory phrases, such as "Extra Rich" or "Superfine," the wording "Superior Quality" is a back mark "denoting quality," e.g. providing information about the quality and characteristic of the buttons, or is a Quality Mark, such as "Rich Gold", Treble Gilt," "Gilt," and "Rich Orange," as such highly descriptive, laudatory wording does not indicate the source of the button.

CONCLUSION

The Applicant's evidence submitted in support of its Section 2(f) claim fails to show that its proposed mark, SUPERIOR QUALITY is promoted as a trademark or that the purchasing

public recognizes the proposed mark as a trademark and as such, is insufficient to support a claim of acquired distinctiveness.¹⁷ Therefore, the Board is requested to affirm the refusal to register the proposed mark on the Principal Register under Section 2(e)(1) of the Trademark Act.

Respectfully submitted,

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¹⁷ Given the highly descriptive nature of the applicant's proposed mark, the applicant has a formidable burden in proving acquired distinctiveness under Trademark Act Section 2(f). The applicant has submitted no evidence showing whether consumers actually perceive the proposed mark as a source indicator. Accordingly, the applicant has not met the burden of proving that its proposed mark has acquired distinctiveness.