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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78217228
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
ON APPEAL

Applicant : The Topline Corporation
Serial No. : 78/217,228
Filed : February 20, 2003
Mark : REPORT SEATTLE in Class 25

TM Attorney : Stacy B. Wahlberg
Law Office : 113
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Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPLICANT'S REPLY
TO EXAMINING ATTORNEY'S APPEAL BRIEF

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With this Reply, Applicant responds to specific issues raised by the Examining Attorney's Appeal Brief of April 8, 2005.

I. The Examining Attorney Improperly Dissected Applicant's Mark in Finding a Likelihood of Confusion and Requiring a Disclaimer of SEATTLE

The Examining Attorney's Appeal Brief highlights the improper dissection of Applicant's mark in the examination process. The mark as a whole, REPORT SEATTLE, creates a distinctive commercial impression that (1) sets Applicant's mark apart from the cited registration, and (2) obviates the need for a disclaimer of SEATTLE.

A. The Examining Attorney Places Undue Significance on the Word REPORT in Finding a Likelihood of Confusion With the Cited Registration

The Federal Circuit has articulated the essential flaw in the Examining Attorney's analysis:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted).

In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985)

(emphasis added). The Examining Attorney's finding that U.S. Registration No. 1,957,041 for REPORT COLLECTION is confusingly similar to REPORT SEATTLE is predicated entirely on the marks' shared word REPORT, without any analysis of the impressions created by each mark as a whole. The Examining Attorney completely discounts COLLECTION from the registrant's mark simply because it is disclaimed, and seeks to completely discount SEATTLE from Applicant's mark as geographically descriptive.

While a disclaimer may in some circumstances influence the relative weight particular words receive in a likelihood of confusion analysis, there is no support for the Examining Attorney's complete dismissal of this additional matter. *See, e.g., In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS, with "CATFISH" disclaimed, still created substantially different commercial impression from BOBBER for restaurant services, and confusion found unlikely). The Examining Attorney's analysis is especially problematic because of the distinctiveness created by the inclusion of SEATTLE in Applicant's mark. REPORT SEATTLE, giving proper weight to SEATTLE, calls to mind the beauty of the Pacific Northwest, the technology climate created by several Seattle-area companies such as Microsoft and Amazon.com, and even musical icons, such as Jimi Hendrix, Kurt Cobain of Nirvana and Dave Matthews of the Dave Matthews Band.

These cultural and visual images are especially important in association with a mark used for clothing, because clothing by its very nature conveys cultural and style information about the consumer wearing the goods, *i.e.*, the words "Hawaii," "Rodeo Drive" and "Miami" all convey information about styles of clothing, apart from the actual location of clothing manufacturer. *See Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 U.S.P.Q. 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 U.S.P.Q. 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 U.S.P.Q. 491 (1953) (HYDE PARK conveyed cultural and style connotations apart from geographical source of clothing); *In re Yardley of London, Inc.*, 165 U.S.P.Q. 272 (T.T.A.B. 1970) (LONDON LASHES conveyed style, not just geographic information). None of the Seattle imagery in Applicant's mark is suggested by the registrant's REPORT COLLECTION mark, and the Examining Attorney's failure to consider each mark as a whole has greatly skewed the analysis of the distinct commercial impressions created by each mark.

Moreover, the Examining Attorney provides no support for designating REPORT as the dominant portion of Applicant's and the registrant's marks. The word "report" is not a coined word and appears in nearly 600 registered marks on the Trademark Register. While Applicant believes that REPORT does add to the distinctiveness of its mark as a whole, there is no basis for the Examining Attorney to find that the non-fanciful, non-arbitrary word "report," by itself, is the only portion of the mark relevant or "dominant" enough for consideration in the likelihood of confusion analysis. When viewing the marks as a whole, there are marked differences between Applicant's and the registrant's mark, avoiding a likelihood of confusion. Applicant respectfully requests that the 2(d) likelihood of confusion refusal be withdrawn.

B. The Examining Attorney's Disclaimer Analysis Is Flawed

Applicant's mark as a whole does not have primarily geographic significance, and thus is registrable without a disclaimer of SEATTLE. *See* Section III. C. of Applicant's Opening Brief; *In re Gale Hayman Inc.*, 15 U.S.P.Q.2d 1478 (T.T.A.B. 1990). Seattle is not known as a geographic source for clothing. The word "Seattle" may suggest a quality of life, but it is not associated with the manufacture of clothing. *See* Applicant's Opening Brief, page 7. Accordingly, a disclaimer of SEATTLE is unnecessary.

The Examining Attorney's Brief further errs in its analysis of this disclaimer issue by dissecting Applicant's mark into registrable and unregistrable components. REPORT SEATTLE creates a single commercial impression. Thus, even if "SEATTLE" were unregistrable for these goods (which it is not for the reasons noted in pages 6-8 of Applicant's Opening Brief), it is a unitary mark that does not require disclaimer of SEATTLE. *B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (C.C.P.A. 1964); TMEP 1213.05. Applicant's mark is similar to that in *In re Hampshire-Designers, Inc.*, 199 USPQ 383 (TTAB 1978) where the Board found the mark DESIGNERS PLUS+ for sweaters to be registrable

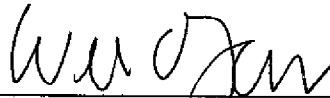
without a disclaimer, even though the word DESIGNERS alone was descriptive in association with sweaters. "DESIGNERS PLUS+" created a unique commercial impression separate and apart from the descriptive meaning. The Board accordingly held that DESIGNERS PLUS+ was a unitary mark, and that a disclaimer of DESIGNERS was unnecessary. *See also In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509 (TTAB 1974) (E GEM for bath oil containing vitamin E held unitary; thus, no disclaimer of "E"). Here, REPORT SEATTLE, combined, suggests up-to-the-minute, cutting-edge clothing that reflects Seattle culture and style, *i.e.*, the beauty of the Pacific Northwest, the technological and entrepreneurial spirit of Seattleites, and the creativity of Seattle's musical icons. Neither "report" nor "Seattle" conveys this impression independently--it springs from the combination of these two words. Accordingly, Applicant's unitary mark should not be segmented into disclaimed and non-disclaimed segments.

Further, even when a compound mark is not considered unitary, the Examining Attorney is still required to determine the primary significance of the **composite**, rather than individual geographic elements of a mark. *See* TMEP 1210.07. If, when viewed as a whole, a composite mark would not be likely to be perceived as identifying the geographic origin of the goods or services (*i.e.*, the mark as a whole is not primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive), then the mark is regarded as arbitrary, fanciful or suggestive. *See National Lead Co. v. Wolfe*, 223 F.2d 195, 105 USPQ 462 (9th Cir. 1955), *cert. denied*, 350 U.S. 883, 107 USPQ 362 (1955) (DUTCH BOY for paint); *In re International Minerals & Chemical Corp.*, 147 USPQ 262 (TTAB 1965) (KENTUCKY TURF for fertilizer). Applicant's mark, when considered as a whole, does not primarily communicate to consumers that its clothes are manufactured in Seattle--it is an arbitrary combination of words that consumers will perceive as a distinctive trademark, suggesting a current, cutting-edge clothing that evokes the Seattle lifestyle and culture. Applicant therefore

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respectfully requests that the Board reverse the Examining Attorney's findings and approve Applicant's mark for publication.

Respectfully submitted,
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