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

Proceeding	78706972
Applicant	Smoke Merchandise, LLC
Applied for Mark	SMOKE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: )  
)  
Smoke Merchandise, LLC ) Examining Attorney  
Serial No. 78/706,972 ) Angela Micheli  
Filed: September 6, 2005 ) Law Office 101  
Mark: SMOKE )  
International Class: 25 )

REPLY BRIEF

SONNENSCHN NATH & ROSENTHAL LLP

Dated: June 2, 2008

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## I. INTRODUCTION

Pursuant to TBMP § 1203.02 and 15 U.S.C. § 1070, Applicant submits this Reply Brief in response to the Examining Attorney's Appeal Brief of May 11, 2008. This Reply Brief supports Applicant's Appeal filed with the Trademark Trial and Appeal Board ("the Board") on June 5, 2007, Applicant's Appeal Brief filed on August 6, 2007, and Applicant's Supplemental Appeal Brief filed on March 10, 2007.

Applicant appeals the Examining Attorney's final refusal to register the trademark SMOKE ("Applicant's Mark"). As set forth below, Applicant respectfully submits that the Examining Attorney has failed to rebut Applicant's strong showing that there is no likelihood of confusion with Applicant's Mark and the cited mark SMOKE, Registration No. 2,753,582 (the "Cited Mark"). Accordingly, Applicant requests that the Board reverse the Examining Attorney's refusal to register Applicant's Mark.

## II. ARGUMENT

The Examining Attorney's Appeal Brief largely ignores Applicant's arguments in its Appeal Brief and Supplemental Appeal Brief, and thus fails to rebut a number of key points. First, the Examining Attorney's Appeal Brief fails to address that since the Cited Mark is directed to a single, narrow good in a field where specific items are commonly distinguished, there is no likelihood of confusion. Second, the Examining Attorney's Appeal Brief attempts to rebut Applicant's Appeal Brief with mere conclusory statements concerning the channels of trade. Third, the Examining Attorney's Appeal Brief fails to rebut, and arguably concedes, that Applicant's consumers are sophisticated and thus capable of sufficiently differentiating the goods, minimizing any likelihood of confusion. Based on the record to date, Applicant has sufficiently shown that no likelihood of confusion exists.

A. The Cited Mark is Directed to a Single, Narrow Good in a Field Where Specific Items are Commonly Distinguished.

Noticeably absent from the Examining Attorney's Appeal Brief is any response to Applicant's argument that since the Cited Mark is directed to a single, narrow good in a field where specific items are commonly distinguished, the marks are sufficiently distinguishable to prevent a likelihood of confusion. A key factor in determining whether there is a likelihood of confusion is a comparison of the goods. The Cited Mark is registered in connection with simply "footwear." Nothing more. Applicant's Mark is applied for in connection with a number of different, specific types of apparel, namely, "denim jackets; head scarves; headwear; jackets; jerseys (clothing); leather jackets; pants; polo shirts; shirts; shorts; skirts; sweat shirts; t-shirts; tank tops and underwear." Applicant's goods do not include footwear, and in fact, Applicant's goods and footwear are quite distinct. The narrow recitation of the goods ensures that the goods are and remain separate, without overlap.

Moreover, the Examining Attorney's Appeal Brief fails to rebut Applicant's strong showing that courts have long distinguished between discrete types of apparel. *See, e.g., In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (finding men's underwear and shoes are distinctly different in nature, would be displayed in different sections of a store, and are not complementary or companion items); *In re Shoe Works, Inc.*, 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (finding no likelihood of confusion between the use of PALM BAY for women's shoes and PALM BAY for shorts and pants); *H. Lubovsky, Inc. v. Esprit de Corp.*, 228 U.S.P.Q. 8 14 (S.D.N.Y. 1986) (finding that the use of ESPRIT on shoes would not cause confusion with use of the same mark on wearing apparel, noting "shoes are generally sold in shoe stores or shoe departments of department stores....they are either in a different store, or a different department, from sportswear."). Instead of addressing these decisions, the Examining Attorney resorted to again referencing third-party registrations, which alone have little probative weight with respect

to the question of likelihood of confusion. *In re Hub Distributing, Inc.*, 218 U.S.P.Q. 284 (T.T.A.B. 1983).

Applicant respectfully submits that the reasoning applied in the cases above is equally applicable to the case at hand. The footwear in connection with the Cited Mark is commonly distinguished and kept distinct from Applicant's goods, including underwear, denim jackets, head scarves, headwear, jackets, jerseys, leather jackets, pants, polo shirts, shirts, shorts, skirts, sweat shirts, t-shirts, and tank tops. Rather than address this issue, the Examining Attorney attempted to simply cast a wide net over the goods, broadly stating that the "goods are related in that they are articles worn on the body." Such a statement oversimplifies the issues; the Examining Attorney failed to address Applicant's specific arguments and evidence, presumably because she could not. The public will easily distinguish between Applicant's Mark for its goods and the Cited Mark for footwear.

B. The Channels of Trade are Sufficiently Different to Avoid Confusion.

In addition to failing to rebut Applicant's contention that the narrowly defined goods are distinguishable and commonly differentiated, the Examining Attorney resorted to using broad, sweeping statements to rebut Applicant's contention that the differences in the channel of trade prevents confusion. For instance, the Examining Attorney's Appeal Brief simply states that both "footwear and clothing would be sold in stores, departments, catalogues and websites"; "the goods would be advertised in the same trade channels"; and "the goods would be marketed to consumers who are interested in purchasing footwear and apparel."

These conclusory statements do not address the specific goods identified in connection with the marks, or reflect the actual markets that the goods are sold in. As explained by Applicant, Applicant's goods relate to Tony Stewart, one of the most recognizable race car drivers on the NASCAR Cup circuit. The purchasers of Applicant's goods and the channels of

trade in which they are sold are very specific purchasers and markets, relating to loyal fans with unique knowledge of the products that are offered in connection with drivers' names, nicknames, race car numbers, etc. The Examining Attorney has made no showing of any specific nature evidencing that the channels of trade have anything more than superficial commonalities. In actuality, Applicant's specific goods are not complementary to footwear and are not sold or marketed through the same channels of trade. As such, Applicant maintains and respectfully submits that differences in the channels of trade between the goods prevent a likelihood of confusion.

C. Consumers of Footwear and Clothing are Brand Conscious and Sophisticated.

The Examining Attorney's Appeal Brief does not seem to dispute Applicant's showing that its purchasers are brand conscious and sophisticated. Rather, the Examining Attorney argues that Applicant has not shown that its purchasers would use care in distinguishing the products. However, Applicant properly referenced facts and Exhibits relied on during examination to support its contention that customers sophisticated with respect to a product, such as Tony Stewart (a/k/a "Smoke") fans with respect to specific articles of clothing bearing the SMOKE mark, would use diligence and care in distinguishing between products associated with their favorite driver, and unrelated footwear likely for sale in an unrelated channel of trade. *See, e.g.,* Exhibit D, Response to First Office Action (showing that the footwear sold under the Cited Mark generally ranges from \$50-\$60 a pair); *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 225 (3d Cir. 2000) (affirming that customers will be discriminating in purchasing apparel priced at over \$50). Moreover, the facts relied on by Applicant, evidence submitted along with responses, and the analyses from the cases cited by Applicant speak for themselves. *See, e.g., Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 831 (8th Cir. 1999) (noting

that the TTAB may find that purchasers “discriminate” between goods of interest to them, even when the goods are not expensive).

Furthermore, to the extent there can be any question that Applicant’s consumers exercise sufficient care, Applicant’s respectfully request that the Board take Judicial Notice of the commonly known fact that customers who are sophisticated with respect to a type of product, and who exhibit staunch brand loyalty with respect to the product, generally exercise a high degree of care when purchasing the product. *See, e.g., Avon Shoe Co. v. David Crystal, Inc.*, 171 F. Supp. 293 (S.D.N.Y. 1959) (allowing the court to take judicial notice of “a certain degree of sophistication” with respect to certain purchasers). Contrary to the Examining Attorney’s suggestion, it is the Examining Attorney’s Office Actions and Appeal Brief that failed to provide any evidence that Applicant’s sophisticated and loyal customers are placed in predicaments where they are likely to suffer from source confusion between Applicant’s goods and the goods of the Cited Mark. Accordingly, Applicant submits that consumers of Applicant’s products and those of the Cited Mark are sophisticated and will be able to sufficiently discern among the respective products.

### III. CONCLUSION

The Examining Attorney’s Appeal Brief failed to rebut Applicant’s strong showing that Applicant’s Mark in connection with denim jackets, head scarves, headwear, jackets, jerseys, leather jackets, pants, polo shirts, shirts, shorts, skirts, sweat shirts, t-shirts, tank tops and underwear is not likely to be confused with the Cited Mark in connection with footwear. For the foregoing reasons, Applicant respectfully requests that the Examining Attorney’s refusal be reversed, and that the present application be passed to publication.