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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85677459

MARK: NOMI MADE FOR A BETTER LIFE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Nomi Network, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

Nomi 7521

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the mark NOMI MADE FOR A BETTER LIFE for "On-line retail store services featuring clothing items, excluding footwear, that are specifically identified as made by survivors of sex slavery and human trafficking and sold to consumers

who wish to support victims of sex slavery and human trafficking.” Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052 (d) for the mark having a likelihood of confusion with a prior registration.

FACTS

Applicant filed the instant application, Serial No. 85/677459, on July 15, 2012 seeking to register the mark NOMI MADE FOR A BETTER LIFE for “On-line retail store services featuring items made by survivors of sex slavery and human trafficking” in class 35, as well as certain bags in class 18, clothing items in class 25, ornaments in class 22 and additional charitable types of services in class 35.

On October 23, 2012, the examining attorney issued an Office action refusing registration under Section 2(d) based upon a likelihood of confusion with two prior registrations, Registration Nos. 3918897 [NOMI for “footwear”] and 3560948 [NOMI with a line over the O for “Candle torches; Candles; Lamp fuel; Lamp oil; Lamp wicks; Wicks for candles; Wicks for oil lamps”]. This was a partial refusal, limited to the above referenced on-line retail store services as well as certain goods. The examining attorney further notified applicant of a prior pending application which could present a future issue, Application Serial No. 78614932. The examining attorney also made requirements regarding a number of informalities.

On April 23, 2013, applicant responded by making arguments against the Section 2(d) refusal and responding to the informality requirements.

The examining attorney suspended proceedings pending the outcome of the prior pending application on May 9, 2013. At this time, based upon the applicant's amendments to their identifications of goods and services, the examining attorney withdrew the Section 2d refusal as to Reg. no. 3560948 [NOMI with a line over the O for "Candle torches; Candles; Lamp fuel; Lamp oil; Lamp wicks; Wicks for candles; Wicks for oil lamps"].

On May 2, 2014, applicant filed a request to divide the application, leaving applicant's class 25 clothing and class 35 retail store services in the instant application, as amended to be "On-line retail store services featuring clothing items and clothing accessories made by survivors of sex slavery and human trafficking."

As the prior pending application had abandoned, the examining attorney issued a final Office action on November 20, 2014, making final the refusal to register under Section 2(d) as to Reg. no. 3918897 [NOMI for "footwear"]. No other issues remained at that time.

On May 20, 2015, applicant filed a notice of appeal and a request for reconsideration in which it again made arguments against the Section 2(d) refusal, and also deleted its class 25 goods and amended its class 35 recitation of services to read "On-line retail store services featuring clothing items, excluding

footwear, that are specifically identified as made by survivors of sex slavery and human trafficking and sold to consumers who wish to support victims of sex slavery and human trafficking.” Applicant argued that with the exclusion of footwear and with its narrow channels of trade, confusion was unlikely.

Although accepting applicant’s amendments to its identification of goods and recitation of services, the examining attorney denied applicant’s request for reconsideration as to the Section 2(d) refusal on May 27, 2015. The examining attorney provided applicant additional evidence showing that stores that sell clothing items also frequently sell footwear under the same mark, and also stressed to applicant that no matter how narrow the applicant lists its channels of trade, the issue is that the registrant’s identification of goods is not limited. It is broad, and encompasses all footwear, available to all potential users. Thus, registrant’s footwear encompasses footwear specifically identified as made by survivors of sex slavery and human trafficking and sold to consumers who wish to support victims of sex slavery and human trafficking.

Applicant filed an Amendment to Allege Use on July 23, 2015, which the examining attorney accepted. On that date, applicant also filed a second request for reconsideration in which it again made arguments against the Section 2(d) refusal based upon newly available evidence which it argued supports the limitations set forth in its recitation of services.

Applicant filed its appeal brief on July 27, 2015. Proceedings were then suspended pending the outcome of applicant’s second request for reconsideration.

On August 5, 2015, the examining attorney again denied applicant's request for reconsideration as to the Section 2(d) refusal, stressing as before that while applicant's recitation of services is narrow as to channels of trade, registrant's identification of goods contains no limitations as to its channels of trade.

Proceedings were resumed and on September 21, 2015 the case was forwarded to the examining attorney for a brief in accordance with Trademark Rule 2.142(b).

ISSUE

The sole issue on appeal in this case is whether there is a likelihood of confusion between applicant's mark, NOMI MADE FOR A BETTER LIFE for "On-line retail store services featuring clothing items, excluding footwear, that are specifically identified as made by survivors of sex slavery and human trafficking and sold to consumers who wish to support victims of sex slavery and human trafficking" and the prior registered mark, NOMI for "footwear." Trademark Act Section 2(d), 15 U.S.C. §1052(d).

ARGUMENT

CONFUSION IS LIKELY BETWEEN APPLICANT'S MARK "NOMI MADE FOR A BETTER LIFE" AND THE PRIOR REGISTERED MARK, "NOMI".

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the du Pont factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 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 and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 et seq.

A. COMPARISON OF THE MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

In the present case, applicant’s mark is NOMI MADE FOR A BETTER LIFE and registrant’s mark is NOMI. The dominant and first term in applicant’s mark, NOMI, is registrant’s mark. Applicant has merely added the slogan MADE FOR A BETTER LIFE to registrant’s mark.

Applicant argues that the marks must be considered in their entireties and that this added wording avoids confusion. While applicant is correct that marks must be viewed in their entireties, adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar);

TMEP §1207.01(b)(iii). In other words, incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2D 1651, 1660-61 (TTAB 2014) (finding PRECISION and PRECISION DISTRIBUTION CONTROL confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part. Thus, the added phrase is insufficient to obviate the likelihood of confusion. Moreover, the added phrase sounds like a slogan added to the main term NOMI.

Further, 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); *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). The first word in applicant’s mark, NOMI, is registrant’s mark and consumers are more likely to focus on this word than the added slogan.

Applicant’s contention that the added wording creates a different commercial impression being that the services feature goods made by victims of human trafficking and sex slavery is unfortunately not persuasive. While the slogan has meaning, the common term NOMI would have the same sound, connotation and impression in both marks. Adding a slogan to the registered mark does not avoid the likelihood of confusion in this case. Because nearly all slogans have meaning, to find otherwise would

be tantamount to finding that any applicant could avoid confusion simply by adding a meaningful slogan to a registered mark.

B. COMPARISON OF THE GOODS AND SERVICES

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant’s services are:

“On-line retail store services featuring clothing items, excluding footwear, that are specifically identified as made by survivors of sex slavery and human trafficking and sold to consumers who wish to support victims of sex slavery and human trafficking.”

Registrant’s goods are “footwear.”

“Footwear” is:

“clothing worn on a person's feet”

See the dictionary definition attached to the November 20, 2014 final office action.

Footwear, being a type of clothing, is sold in clothing stores.

Although applicant has excluded footwear from its retail clothing store identification, that fact would not be known by the general consumer who would believe that a store selling many types of clothing (applicant’s clothing encompasses all other types of clothing) would also sell clothing in the nature of footwear. Registrant’s goods are a type of clothing (footwear) and they are known by consumers to be sold in clothing stores. Many clothing stores sell a variety of types of clothing: shirts, pants, footwear etc. A consumer encountering NOMI footwear and a store selling clothing called NOMI with slogan MADE FOR A BETTER LIFE would be likely to believe that they come from a common source. They would

not first search through the store website to see if the store does in fact sell all types of clothing (including footwear).

The use of similar marks on or in connection with both products and retail-store services has been held likely to cause confusion where the evidence showed that the retail-store services featured the same type of products. See *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (holding the use of similar marks both for jewelry and for retail-jewelry and mineral-store services was likely to cause confusion); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (holding the use of nearly identical marks both for coats and for retail outlets featuring camping and mountain climbing equipment, including coats, was likely to cause confusion, noting that “there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion”); *In re U.S. Shoe Corp.*, 8 USPQ2d 1938, 1939 (TTAB 1988) (holding the use of nearly identical marks both for leather cowboy boots and for retail western-, outdoor-, and leisure-clothing-store services featuring boots was likely to cause confusion); TMEP §1207.01(a)(ii).

Here, while, as noted above, applicant has excluded footwear, its stores and registrant’s goods still feature the same general type of products, being clothing items. Applicant’s argument that footwear is not found in clothing stores and that the goods it sells are very different from footwear is not persuasive. The goods applicant sells encompass all types of clothing other than footwear, such as socks, which are highly related to footwear. Further, on-line clothing store websites typically feature footwear and other clothing items for sale via adjacent links. See for example the evidence of record showing such webpages:

- the Nike ® website showing links to shoes and other types of clothing in close proximity
- the Ann Taylor ® website showing links to shoes and other types of clothing in close proximity
- the J.Crew ® website showing links to shoes and other clothing items in close proximity
- the Old Navy ® website showing links to shoes and other clothing items in close proximity
- the Brooks ® website showing links and photos of shoes and other clothing items in close proximity
- the North Face ® website showing footwear and other clothing links in close proximity
- the Benetton ® website showing links to footwear and other clothing items in close proximity
- the Banana Republic ® website showing links to shoes and other clothing in close proximity
- the Tommy Bahama ® website showing links and photos of footwear and other clothing items in close proximity
- the Ferragamo ® website showing shoes and clothing items on the same website
- the Coach ® website showing links to shoes and other clothing items in close proximity
- the Gap ® website showing links to shoes and other clothing items in close proximity

Note that in many of these websites a consumer can see the store trademark placed directly on the footwear (eg on the foot bed or side of the shoe). This evidence establishes that clothing stores put their store trademarks directly on footwear.

Note also the New Balance ® website showing its footwear sold also for charitable purposes with “5% of the suggested retail price of sales from the Lace Up for the Cure Collection with a minimum donation of \$500,000 each year to Susan G. Komen® through 2012.”

The trademark examining attorney attached evidence from the USPTO’s X-Search database to the November 20, 2014 final office action consisting of a number of representative third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely stores featuring clothing items and footwear, are of a kind that may emanate from a single

source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Also attached to the first office action, the final office action and the May 27, 2015 denial of the request for reconsideration is Internet evidence consisting of representative websites showing online retail clothing stores and footwear sold in these stores under the same marks. This evidence establishes that the same entity commonly provides the relevant goods and/or services and markets the goods and/or services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and/or services are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The

Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at

[http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation -
_americas_emerging_online_experience.pdf](http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf)). Thus, the widespread use of the Internet in the United

States suggests that Internet evidence may be probative of public perception in trademark examination.

Applicant contends that its services and registrant's goods are not closely related because registrant's goods are sold for profit to consumers simply seeking to buy shoes for themselves based upon utility, aesthetics and price whereas the goods applicant sells in its stores are made by victims of sex slavery and human trafficking and sold for charitable purposes to consumers wishing to support those victims. Thus applicant contends that the consumers and channels of trade differ.

Unfortunately, the applicant's argument is not persuasive. Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it must be assumed that these footwear items are made by the same survivors and sold to the same charitable consumers. Thus, they must be presumed to travel in the same channels of trade. Applicant cannot during ex parte prosecution limit registrant's footwear to those sold for profit to consumers making decisions based upon utility, aesthetics and price. Applicant argues that its channels of trade are so specific as to be not normal or usual and so the channels of trade cannot be considered to overlap. However, applicant's services are essentially an on-line clothing store and footwear is often sold in on-line clothing stores. Moreover, as above, it cannot be concluded based upon the identification as written that registrant's goods are sold only for profit. The footwear as listed encompasses footwear sold for charitable purposes via all means, including charitable stores.

Applicant's reliance on the Board's 1988 decision in *In re The Shoe Works Inc.* 6 USPQ2d 1890 (TTAB 1988) is misplaced. First, in that case, the store type was more limited with the registration being for "men's, women's and children's shorts and pants" and the application being for "women's shoes sold solely through applicant's retail shoe store outlets." Second, and more importantly, there was a consent agreement which weighed heavily in the Board's decision (finding that "We agree with the Examining Attorney that a consent agreement is but one factor to be considered. But, in this case, it is our opinion that the agreement, which is quite explicit in its terms, is entitled to considerable weight). Registrant had agreed to the use and registration by applicant of its mark on women's shoes. It is also certainly of note that this case was decided in 1988, before online stores selling a myriad of clothing items, including footwear, became so commonplace.

In the instant case there is no consent. Applicant's stores are not limited in which specific items of clothing they sell, other than excluding footwear. Thus they must be assumed to sell socks and all other clothing items. Online clothing stores often sell footwear and other items of clothing in close proximity. Currently, in modern times, these goods and services are found in the same channels of trade. As for the narrow aspect of applicant's services, as previously discussed, it must be assumed that registrant's footwear encompasses those sold for charitable purposes via charitable website stores.

Applicant also argues that purchasers would exercise care in the purchase of goods from its store. However, the fact 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, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

CONCLUSION

The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. In *re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). In the instant case, the goods and services are highly related and the marks have a highly similar commercial impression, therefore, confusion is likely among consumers as to the source of those goods and services. Accordingly, the examining attorney requests that the refusal to register under Trademark Act Section 2(d) be affirmed.

Respectfully submitted,

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