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

Proceeding	86474261
Applicant	Banom, Inc.
Applied for Mark	COMFORT PLUS
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant : Banom, Inc.
Serial No. : 86/474,261
Filed : December 8, 2014
For : Trademark COMFORT PLUS
Tracking No. : ESTTA706785

APPELLANT'S BRIEF

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I. INTRODUCTION

This is an appeal from the final decision of the Examining Attorney refusing registration under Section 2(d).

II. STATEMENT OF FACTS

Applicant filed this intent-to-use application to register the trademark COMFORT PLUS, for use on protective cut-resistant gloves for industrial use.

In an Office Action dated February 9, 2015, registration was refused under Section 2(d), on the basis of Certificate of Registration No. 4,288,623. This registration covers the trademark COMFORT GUARD PLUS, for use on protective work gloves.

In the same Office Action, Applicant was required to disclaim the wording COMFORT.

On March 31, 2015, Applicant responded to the refusal to register under Section 2(d) by pointing out that the term COMFORT in the cited registration was a unitary term, and the word GUARD could not be separated from the word COMFORT. It was also pointed out that the word PLUS gives the connotation of something extra.

In support of Applicant's position, a portion of the PTO file on the application to register the mark COMFORT GUARD PLUS was attached. It was pointed out in the application, as filed, that the specimen submitted was for the mark COMFORT GUARD, even though the mark sought to be registered was COMFORT GUARD PLUS.

In an Office Action dated October 29, 2012, in the application to register the mark COMFORT GUARD PLUS, the Examining Attorney noted that the specimen displayed the mark as COMFORT GUARD, whereas the drawing showed the mark as COMFORT GUARD PLUS. New specimens were filed, depicting the mark as COMFORT GUARD PLUS.

In the same response, Applicant argued against the requirement for a disclaimer of the word COMFORT.

In an Office Action dated May 7, 2015, the refusal to register under Section 2(d) was maintained.

In the same Office Action, the requirement for a disclaimer of the word COMFORT was maintained. In support of the requirement, a number of prior Certificates of Registration for trademarks containing the word COMFORT, where the marks were used on gloves, contained a disclaimer of the word COMFORT.

The refusal to register in the Office Action dated May 7, 2015 was made FINAL.

In a Request for Reconsideration filed on November 5, 2015, Applicant inserted the required disclaimer of the word COMFORT.

It was stated in the Request for Reconsideration that insofar as the refusal to register under Section 2(d) was concerned, Applicant was filing a Notice of Appeal.

The Notice of Appeal was also filed on November 5, 2015.

In an Office Action dated December 2, 2015, the Request for Reconsideration was denied. However, in the denial, it was stated that the disclaimer requirement of the FINAL refusal to register was satisfied.

Even though Applicant did not argue against the Section 2(d) refusal in the Request for Reconsideration, the Office Action dated December 2, 2015 contained 28 attachments. It was stated in the Office Action that the 28 attachments show “additional evidence” of the relatedness of Applicant’s and the

registrant's goods. The statement is somewhat ironic, since there was no evidence allegedly showing the relatedness of the goods during the entire previous prosecution of the application. There was no explanation given for the furnishing of the attachments, especially in view of the fact that the Section 2(d) refusal was not being contested, nor was there any explanation given as to the nature and significance of the attachments.

The only issue on appeal is the correctness of the Section 2(d) refusal to register Applicant's mark.

III. ARGUMENT

A. Introduction

In determining a Section 2(d) issue, an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood-of-confusion issue should be considered. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). In any likelihood-of-confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24 (CCPA 1976).

Insofar as the similarity of the marks is concerned, when considering the marks in issue in their entireties, it is submitted that no likelihood of confusion could result.

Insofar as the similarity of the goods is concerned, Applicant's goods are specifically different from the goods of the cited registration.

Considering the differences in the marks and the differences in the goods, it is respectfully submitted that no likelihood of confusion results. Accordingly, the decision of the Examining Attorney refusing registration under Section 2(d) should be reversed.

B. The Marks in Issue are not Confusingly Similar

Applicant's mark is COMFORT PLUS, depicted in standard characters.

The registered mark is COMFORT GUARD PLUS, depicted in standard characters.

The mere fact that the marks have two words in common does not result in the conclusion that the marks themselves are likely to be confused. It is clear that "marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." *In re Hearst Corporation*, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992).

In *Hearst*, the court found that there was no likelihood of confusion resulting from the contemporaneous use of VARGAS and VARGA GIRL on identical, inexpensive consumer goods, despite the view that the word "GIRL" was merely descriptive of the goods.

The court acknowledged that although VARGA and VARGAS are similar, the marks must still be considered in the way they are used and perceived. When the suffix GIRL is given weight, along with the word VARGA, confusion with VARGAS becomes less likely. The court concluded there was no likelihood of confusion.

The facts in *Hearst* are virtually the same as those in the instant application. Although the word COMFORT and the word PLUS comprise Applicant's mark, and are present in the cited registration, the balance of registrant's mark cannot be ignored. When viewed in its entirety, Applicant's mark is not similar to the cited mark, and, pursuant to *Hearst*, no likelihood of confusion will result.

Similarly, in *In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir. 1986), the court found no likelihood of confusion between the marks BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL, for similar lodging reservations services. In doing so, the court pointed out that the issue of likelihood of confusion must be determined by considering the marks in their entireties, and the mere fact that there were common elements to the marks, did not result in a likelihood of confusion between the marks, in their entireties. *Id* at 819.

In analyzing the cited registered mark, the word COMFORT is descriptive. Applicant was required to disclaim the exclusive right to use the word COMFORT, as part of a trademark for gloves, based on many recently-issued PTO registrations for marks containing the word COMFORT, when used on gloves. Although the registrant was not required to disclaim the exclusive right to use COMFORT, apart from the mark, the fact remains that the word COMFORT is descriptive.

The word PLUS in Applicant's mark and in the cited registered mark is highly suggestive.

In *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 116 (TTAB 1978), this Board stated:

“PLUS” is a dictionary word which denotes something better or an additional quality or quantity and, as such, possesses a highly suggestive significance as applied to most classes of goods. The suggestiveness of the term manifestly is the reason why opposer, applicant, and others in the same or related fields have adopted and used and/or registered as trademarks for their goods designations containing the word “PLUS.”

Subsequently, in *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1207 (TTAB 1981), this Board, relying on *Plus Products v. Redken, supra*, found no likelihood of confusion between the PLUS marks in issue, in view of the highly suggestive nature of the word PLUS as part of a trademark.

It is thus seen that the cited mark comprises the descriptive word COMFORT and the highly suggestive word PLUS, plus the word GUARD. It is clear that the dominant word in the registered mark is GUARD. This word, in a likelihood of confusion analysis, must be given prominence.

The refusal to register Applicant's mark concluded that Applicant formed its mark by merely deleting matter from an already registered mark. There is no factual basis for this statement. Applicant adopted its mark without any knowledge of the registered mark.

The two prior decisions cited in support of the conclusion that Applicant merely deleted matter from a previously registered mark are inapposite.

In *In re Mighty Leaf Tea*, 94 USPQ2d 1257 (Fed. Cir. 2010) the registered mark was composed of the letters ML and the name MARK LEES. The applicant's mark was ML. The goods in issue were both skin care products.

In affirming the decision of this Board in affirming the refusal of registration, the court stated:

Mighty Leaf Tea also contends that the additional words MARK LEES distinguish the registrant's mark from ML standing alone. However, as the PTO states, the presence of an additional term in the mark **does not necessarily** eliminate the likelihood of confusion if some terms are identical. (emphasis added).

Id. at 1260.

In *In re Optica International*, 196 USPQ 775 (TTAB 1977) this Board affirmed the refusal to register the trademark OPTIQUE in view of the prior registration for the trademark OPTIQUE BOUTIQUE, with both marks being used on optical wear. In doing so, this Board stated:

Turning to the marks here involved, “OPTIQUE BOUTIQUE” and “OPTIQUE,” in view of the meaning of the term “BOUTIQUE” as a small shop (The Random House College Dictionary, 1973), and in the case of the registered mark a shop that deals in optical devices, the deletion of this term by applicant is insufficient to distinguish “OPTIQUE,” per se, from “OPTIQUE BOUTIQUE,” when used in connection with competing optical wear, and hence to avoid confusion or mistake in the marketing of the products offered thereunder.

Id. at 778.

In view of the fact that the cited mark was registered on the Supplemental Register, BOUTIQUE was obviously considered to be a descriptive word.

It is thus seen that the two prior decisions relied on by the Examining Attorney concerning the elimination of a word from a registered mark are inapposite. In one case, the term eliminated was the name of the person whose initials formed the dominant part of the mark. In the other case, the eliminated word was obviously descriptive.

In the instant application, the word sought to be eliminated from the registered mark is the dominant word in the mark.

Attached to the response filed by Applicant in the PTO on March 31, 2015 was a copy of a portion of the PTO file on the application to register the cited mark COMFORT GUARD PLUS. The attached portion of the file shows that the Applicant considered its mark to be COMFORT GUARD, since the specimens originally filed with the application were for the mark COMFORT GUARD, and not COMFORT GUARD PLUS.

New specimens were required, and in response, newly-filed specimens depicted the mark COMFORT GUARD PLUS.

It is submitted to be clear from the record that the formative term of the registered mark is COMFORT GUARD. The formative term of Applicant's mark is COMFORT. The word PLUS is used for its ordinary meaning in both marks. It is submitted that the word GUARD cannot be separated from the word COMFORT, in the cited mark, since the two words are a unitary term.

In conclusion on this issue, when considering the marks in their entireties, no likelihood of confusion results.

C. The Goods in Issue are Specifically Different

The goods of the cited registration are protective work gloves. Applicant's goods are highly specialized, and are protective cut-resistant gloves for industrial use. While both the goods of the registration and Applicant's goods are

gloves, Applicant's gloves are for a specific use and will be sold to industrial customers for that specific use. They are not retail items sold in hardware stores.

In the denial of the Request for Reconsideration, mailed after Applicant filed its Notice of Appeal, "additional evidence" to show the relatedness of Applicant's and the registrant's goods was attached. Since no evidence was previously introduced by the Examining Attorney to show the relatedness of the goods, and since in the Request for Reconsideration, Applicant specifically stated that the Section 2(d) refusal would be handled on appeal, it is submitted that the attachments are inappropriate. Additionally, no explanation is given as to why the "additional evidence" shows the relatedness of the goods.

IV. CONCLUSION

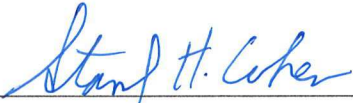
When considering the marks in issue, in their entireties, it is submitted that there is no likelihood of confusion between the marks. The attempt to eliminate the word GUARD from the unitary term COMFORT GUARD is inappropriate, and is not supported by the prior decisions cited by the Examining Attorney.

In view of the differences between the marks and the differences between the goods, it is respectfully requested that the refusal to register Applicant's mark be reversed, and that this application be passed to publication.

Respectfully submitted,

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