

ESTTA Tracking number: **ESTTA752900**

Filing date: **06/16/2016**

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

Proceeding	86568560
Applicant	City Gear, LLC
Applied for Mark	GRINDHOUSE
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Submission	Appeal Brief
Attachments	City Gear Appellate Brief GRINDHOUSE SN 86568560.pdf(141902 bytes)
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Date	06/16/2016

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Serial No.: 86568560

Mark: GRINDHOUSE

Applicant/Appellant: City Gear, LLC

Application Date: March 18, 2015

Examining Attorney: Amy E. Hella
Law Office 110

APPEAL BRIEF

This brief is submitted following a Notice of Appeal filed on April 18, 2016
following a final action mailed on October 20, 2015.

INDEX OF CITATIONS

Cases:

1. *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, 2008 WL 927726 (TTAB 2008).
2. *Bobosky v. Adidas AG*, 843 F. Supp. 2d 1134, 105 U.S.P.Q.2d 1938 (D. Or. 2011).
3. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A. 1976).
4. *Glenwood Laboratories v. Am. Home Products Corp.*, 455 F.2d 1384, 173 U.S.P.Q. 19 (CCPA 1972).
5. *Hewlett Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2000).
6. *In re Astro-Gods Inc.*, 223 U.S.P.Q. 621 (TTAB 1984).
7. *In re David Crystal, Inc.*, 296 F.2d 771, 132 U.S.P.Q. 1 (C.C.P.A. 1961).
8. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).
9. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990).
10. *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498 (TTAB 2010).
11. *In re Max Capital Grp. Ltd.*, 93 U.S.P.Q.2d 1243 (TTAB 2010).
12. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985).
13. *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985).
14. *In re St. Helena Hospital*, 774 F.3d 747, 113 U.S.P.Q.2d 1082 (Fed. Cir. 2014).
15. *In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634 (TTAB 2009).
16. *In re Villeroy & Boch S.A.R.L.*, 5 U.S.P.Q.2d 1451 (TTAB 1987).
17. *In re Viterra Inc.*, 671 F.3d 1358, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012).
18. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000).

Statutes:

1. Trademark Act § 1 (15 U.S.C. §1051).
2. Trademark Act §2(d) (15 U.S.C. §1052(d)).
3. Trademark Act §45 (15 U.S.C. §1127).

ISSUE ON APPEAL

Whether Applicant City Gear, LLC’s “GRINDHOUSE” mark for “[c]lothing, namely, jeans, shirts and jackets” is likely to be confused with the mark that is the subject of Registration No. 3907542, LIVE FAST, EAT WELL! GRIND HOUSE KILLER BURGERS WOMEN CRY FOR IT! MEN DIE FOR IT! & Design (the “Registered Mark” or “Registrant’s Mark”), which is shown to the right and is registered for use in connection with “[w]earable garments and clothing, namely, shirts” in Class 25 and “[b]ar and restaurant services” in Class 43.



ARGUMENT

“Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2000). To determine whether a likelihood of confusion exists, the Board is required to consider the “relevant” *DuPont* factors considered by the Examining Attorney when rejecting Applicant’s application. *See In re Viterra, Inc.*, 671 F.3d 1358, 1361, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012); *In re St. Helena Hospital*, 774 F.3d 747, 750, 113 U.S.P.Q.2d 1082 (Fed. Cir. 2014). According to the *DuPont* court, the following are key considerations in any likelihood of confusion determination: the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; and the relatedness of the goods or services as described in the application and registrations. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 117 U.S.P.Q. 563 (C.C.P.A. 1973); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93

U.S.P.Q.2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1635 (TTAB 2009).

Here, in rejecting Applicant's application to register the Mark, the Examining Attorney focused primarily on those two *DuPont* factors (i.e., similarity of the marks and similarity of the goods) in concluding that there was a likelihood of confusion between Applicant's Mark and Registrant's Mark.¹ Applicant, however, respectfully submits that a proper analysis of these two factors weighs in favor of a finding that no likelihood of confusion exists between its Mark and the Registrant's Mark.

A. Similarity of the Marks

According to the Trademark Manual of Examining Procedure ("TMEP"), the likelihood of confusion analysis "requires careful consideration of the nature of the common elements of the marks at issue, as well as the overall commercial impression created by each mark." TMEP § 1207.01(b)(iii). "The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression" is a key consideration in any likelihood of confusion determination. *Id.* § 1207.01.

"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." *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985) (citing *Glenwood Laboratories v. American Home Products Corp.*, 455 F.2d 1384, 1385, 173 U.S.P.Q. 19, 20 (CCPA 1972)); 2 J. McCarthy, Trademarks and Unfair Competition § 23:15A (2nd ed. 1984)). "[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark." *Id.*

¹ Final Office Action, page 2.

Here, the Examining Attorney erred by improperly dissecting the Registrant's Mark and focusing too much on the "GRIND HOUSE" portion of the Registered Mark, as opposed to the mark as a whole, with all of its significant design and word features. Specifically, as stated in the registration, the Registered Mark is an illustration drawing which includes word(s)/letter(s)/number(s) that consists of

a voluptuous woman in a short dress with fishnet stockings and high heels, holding a gun and a hamburger, leaning on a brick wall engraved with the words "Grind[]house Killer Burgers", and a dark figure of a man with a tophat [sic] and tie, clutching a bloody gunshot wound to his chest, surrounded by the phrases "Live Fast, Eat Well!" and "Women Cry For It! Men Die For It!"²

Applicant's Mark, on the other hand, is simply the word mark GRINDHOUSE.

Even assuming *arguendo* that various elements of the Registered Mark may be dissected and analyzed in isolation for purposes of determining likelihood of confusion (which Applicant denies), Applicant respectfully submits that the Examining Attorney erred by separating the "GRIND HOUSE" portion of Registrant's Mark from the words "KILLER BURGERS." Those two phrases should be considered unitary for trademark registration purposes and should not be separated for likelihood of confusion determinations.

Registrant has two existing registrations for the mark GRINDHOUSE KILLER BURGERS (RN 4680775 and 3818027). In response to an office action during the prosecution of one of those marks, Registrant specifically argued that the "KILLER BURGERS" portion of its mark played a key role in conveying a specific overall commercial impression to consumers.³ Registrant's addition of the words "killer" and "burger" to the Registered Mark not only conveys a different commercial impression of Registrant's Mark, it highlights the very nature of

² Quoted from Registrant's cited Registration No. 3907542.

³ See Registrant's Response to Office Action on Registration No. 4680775, page 3.

Registrant's primary services (i.e., restaurants and bars where burgers are served). In view of the above, there can be no doubt that Applicant's use of the GRINDHOUSE mark on jeans, shirts, and jackets is distinguishable from Registrant's use of the LIVE FAST, EAT WELL! GRIND HOUSE KILLER BURGERS WOMEN CRY FOR IT! MEN DIE FOR IT! design mark on shirts. The Examining Attorney therefore erred when she failed to consider Registrant's Mark as a whole when comparing it to Applicant's Mark.

The Examining Attorney also argued that, because the GRIND HOUSE portion of the Registrant's Mark is the dominant portion of the Registered Mark, she properly compared the GRIND HOUSE portion of the Registered Mark to Applicant's Mark.⁴ Applicant respectfully disagrees. "[T]here is no general rule that the letter portion of the mark will form the dominant portion of the mark." *In re Viterra Inc.*, 671 F.3d 1358, 1362–63, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir. 2012). Moreover, "[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990). "Marks, therefore, must be considered on a case-by-case basis." *In re Viterra*, 671 F.3d at 1362–63, 101 U.S.P.Q.2d at 1908.

In view of the dominant design features present in the Registrant's Mark and the use of the KILLER BURGER phrase Registrant itself considers to be a unitary part of its mark, there can be no doubt that the commercial impression conveyed by the Registrant's Mark is readily distinguishable from that conveyed by the Applicant's Mark. Registrant's Mark features a large graphic of a scantily clad female character and the silhouetted man with a gunshot wound that is reminiscent of the kind of violence typically associated with grindhouse movies. *See Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, 2008 WL 927726

⁴ Final Office Action, pages 2-3.

(TTAB 2008) (finding that the Bass Pro Shop logo was the “dominant element” of the mark). Thus, arbitrarily dissecting the Registrant’s mark to deem only the GRIND HOUSE (two words) portion to be the dominant portion of the mark and then refuse registration to the Applicant’s Mark is nonsensical.

The combination of the unique design features of the Registrant’s Mark and the KILLER BURGER phrase confirms the absence of any likelihood of confusion on consumers’ part. In *Bass Pro Trademarks*, for instance, the TTAB found that the presence of a unique design on Bass Pro’s logo mark obviated the possibility that consumers would be confused by both parties’ use of the words “Sportsman’s Warehouse” in their respective marks. *Bass Pro Trademarks*, 2008 WL 927726, at *14. The same result is warranted here. The Registered Mark—with its unique design features and its clear intention to associate itself with bar and restaurant services through the use of the phrase KILLER BURGERS —conveys a completely different meaning and commercial impression than Applicant’s Mark. *See id.* (“The BASS PRO SHOPS logo specifically engenders the commercial impression of a professional fisherman's sports center store.”). Taking Registrant’s Mark into consideration in its entirety, Applicant respectfully submits that there is no likelihood of confusion between its Mark and the Registered Mark.

B. Ornamental Use

According to Section 1202.03 of the TMEP, “[s]ubject matter that is merely decorative feature does not identify and distinguish the applicant’s goods and, thus, does not function as a trademark . . . [t]his matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark, as required by §§1, 2, and 45 of the Trademark Act.” TMEP § 1202.03 (citing 15 U.S.C. §§1051, 1052, and 1127). In determining whether use of a

proposed mark is purely ornamental or decorative, an examining attorney must consider “the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function.” TMEP § 1202.03(a).

Here, Registrant’s use of the Registered Mark with goods in Class 25, as evidenced in the specimen, is strictly ornamental and thus not used as a trademark. *See* TMEP § 1202.03. The design logo on the shirt is very large, located in the center of the goods, and dominates the whole t-shirt specimen, all of which weigh against trademark use. *See* TMEP § 1203.03(a) (“A small, neat, and discrete word or design feature . . . may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of a garment . . . may be perceived merely as a decorative or ornamental feature of the goods.”); *see also Bobosky v. Adidas AG*, 843 F. Supp. 2d 1134, 105 U.S.P.Q.2d 1938 (D. Or. 2011); *In re Astro-Gods Inc.*, 223 U.S.P.Q. 621 (TTAB 1984).

“Ornamental matter that is neither inherently distinctive nor a secondary source indicator may be registered on the Principal Register under §2(f), *if* the applicant establishes that the subject matter has acquired distinctiveness as a mark in relation to the goods.” TMEP § 1203.03(d). Registrant’s application, however, contains no claim of acquired distinctiveness for use of the Registered Mark on wearable garments in Class 25. Thus, the logo as used on the specimen-of-record is merely a decorative feature of the goods; it does not function as a trademark to identify and distinguish Registrant’s goods (shirts) from those of others and to indicate their source. *Id.*; *see In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985); *In re David Crystal, Inc.*, 296 F.2d 771, 132 U.S.P.Q. 1 (C.C.P.A. 1961); *In re Villeroy & Boch S.A.R.L.*, 5 U.S.P.Q.2d 1451 (TTAB 1987). To the extent Registrant was granted a registration for use of the Registered Mark on t-shirts and other

wearable garments in Class 25, that decision must have been based on an unstated conclusion by the examining attorney that the ornamental use was acceptable for goods in Class 25 as a secondary source indicator for the restaurant and bar services in Class 43 that were also part of the application that matured into Reg. No. 3907542.

Registrant, however, does not have broad rights in the GRIND HOUSE portion of the Registered Mark for use in connection with goods in Class 25 because Registrant is not using the term GRIND HOUSE, by itself, as a source identifier for its wearable garments and clothing. For the reasons stated herein, Applicant submits that Registrant's use of the GRIND HOUSE phrase on shirts should be accorded limited protection taking into account all elements of the Registered Mark and should not be used as a basis for refusing Applicant's Application to register the GRINDHOUSE mark for use in connection with goods in Class 25.

C. Applicant's Prior Application

Applicant previously filed a trademark application for a similar mark, GRINDHOUSE DENIM CO. (Ser. No. 85974632), on July 1, 2013 (the "Prior Application"). At no point during the prosecution process of the Prior Application did the examining attorney identify Registrant's Mark as a source of confusion or a bar to registration. Instead, the Prior Application received a notice of allowance on January 28, 2014. But Applicant, for unrelated reasons, abandoned the Prior Application and reapplied for both GRINDHOUSE DENIM (Ser. No. 86568545) and the instant Mark on March 18, 2015.

The Examining Attorney here is now concluding that Applicant's Mark is likely to be confused with the Registrant's Mark, despite a previous conclusion that no likelihood of

confusion existed between the Registrant's Mark and Applicant's prior mark.⁵ The lack of consistency between these two conclusions is inexplicable, to say the least. The examining attorney who reviewed the Prior Application presumably found Registrant's Mark and did not raise it as a source of confusion or a bar to registration of the Prior Application. Yet, the Examining Attorney here is raising the Registered Mark as a bar to registration, despite the significant similarities between the mark featured in the Prior Application and the instant Mark.⁶ There can be no question that the Examining Attorney's conflicting decision on Applicant's Mark is erroneous. While Applicant recognizes prior decisions are not binding, the instant Mark contains the same dominant wording as the previous application, namely the word GRINDHOUSE. In other words, the same question now facing the Examining Attorney was considered previously and no bar to registration was found. The Prior Application containing GRINDHOUSE was not found to create a likelihood of confusion with the Registered Mark, therefore the same result should obtain in this Application.

D. Similarity of the Goods

The Examining Attorney noted that the goods are "identical," in that both Applicant and Registrant offer "shirts" in the respective identification of goods.⁷ Confusion, however, can only be found where the "two marks for related goods or services share identical or similar dominant features and the marks, when viewed in their entirety, create similar overall commercial impression." TMEP 1207.01(b)(viii) (emphasis added). As noted above, the Registered Mark and Applicant's Mark do not have similar dominant features, and, when viewed in their

⁵ Final Office Action, page 3.

⁶ *Id.*

⁷ *Id.*

entireties, do not have a similar appearance or convey a similar overall commercial impression. Accordingly, this factor weighs in favor of Applicant, despite the similarity of the goods.

CONCLUSION

For the foregoing reasons, Applicant submits that Examining Attorney's refusal to register Applicant's Mark was in error and should be reversed. There is no likelihood of confusion between Applicant's Mark and the Registered Mark because consumers are not likely to perceive Applicant's goods as related to Registrant's goods.

Respectfully submitted,

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June 16, 2016
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