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Sent: 7/25/2019 5:29:16 PM

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Subject: U.S. Trademark Application Serial No. 87147819 - SHAKY - PANAM-20323 - EXAMINER BRIEF

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Count: 1

Files: 87147819.doc

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 87147819

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Reference/Docket No. PANAM-20323

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the mark SHAKY, under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), on the grounds that applicant's mark, when used in connection with applicant's services, so resembles the mark in U.S. Registration No. 4511875 as to cause confusion, mistake, or deceive consumers as to the source of the services of the applicant and registrant. See 15 U.S.C. §1052(d).

I. FACTS

On August 23, 2016, applicant, Pan American Properties, Corp., a corporation incorporated under the laws of Puerto Rico, filed an application to register the mark SHAKY, for "*Clothing apparel, namely, t-shirts; Headgear, namely, caps*" in International Class 025, and "*Alcoholic beverages except beer*" in International Class 033.

On December 5, 2016, the previously assigned examining attorney refused registration of the proposed mark in International Class 025 under Section 2(d) of the Trademark Act, on the grounds that applicant's mark, when used on or in connection with the applied-for goods, so resembled the mark in U.S. Registration No. 4511875 as to be likely to cause confusion as to the source of the respective goods. The cited registration is for the mark SHAKY KNEES for use with "*Baseball caps and hats; Golf shirts; Hooded sweat shirts; Polo shirts; Short-sleeved or long-sleeved t-shirts*" (the "Cited Mark"). Additionally, prior-filed U.S. Application Serial Nos. 86515589, 87036101 and 87036125 were referenced as possible bars to registration of applicant's mark pursuant to Trademark Act Section 2(d) should they register.

On June 5, 2017, applicant responded to the Office action and provided arguments against the refusal and potential refusals pursuant to Trademark Act Section 2(d).

On July 10, 2017, the previously assigned examining attorney issued a final refusal under Trademark Act Section 2(d) in regards to U.S. Registration No. 4511875, and notified applicant that the prior-filed U.S. Application Serial Nos. 86515589, 87036101 and 87036125 had abandoned and no longer presented a possible bar to registration under Trademark Act Section 2(d).

On December 28, 2017, applicant emailed the United States Patent and Trademark Office indicating that it had been affected by Hurricane Maria and requested relief pursuant to the Widespread Disaster Guidance for Trademark Customers.

On January 8, 2018, the examining attorney issued an Office action informing applicant that it qualified for special relief due to the extraordinary situation and was granted six months from that date

to respond to the final Office action issued on July 10, 2017. Due to Office error, however, the Office action was issued as a non-final Office action.

On July 9, 2018, applicant submitted a Request to Divide Application, seeking to divide the application into a parent application consisting of the aforementioned International Class 025 goods and a child application consisting of the aforementioned International Class 033 goods.

On July 9, 2018, applicant also responded to the July 10, 2017 Office action reissued on January 8, 2018, providing arguments against the refusal pursuant to Trademark Act Section 2(d).

On July 30, 2018, applicant was provided with a Notice of Divisional Request Completed notifying applicant that the application had been divided into two applications.

On August 8, 2018, the examining attorney issued a final refusal under Trademark Act Section 2(d) in regards to U.S. Registration No. 4511875.

On February 8, 2019, applicant filed an appeal with the Trademark Trial and Appeal Board ("the Board") and filed a request for reconsideration, which was denied by the examining attorney on February 21, 2019.

On March 28, 2019, the Board notified applicant that the appeal was resumed and that applicant had sixty days from the mailing date thereof to file its appeal brief.

On May 13, 2019, the Board issued a decision notifying applicant that the appeal was dismissed because applicant did not file a brief within the time set therefore in the action dated March 28, 2019.

On May 15, 2019, applicant filed a Request for Reconsideration arguing against the dismissal as premature.

On May 21, 2019, the Board issued an order vacating the premature dismissal and informing applicant that its appeal brief was due sixty days from March 28, 2019.

On May 28, 2019, applicant filed its appeal brief. On June 3, 2019, applicant's appeal brief was forwarded to the examining attorney for a brief.

II. ISSUE

The sole issue on appeal is whether there is a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), between applicant's mark and the Cited Mark.

III. ARGUMENTS

Section 2(d) Refusal—Likelihood of Confusion

Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the services and differences in the marks.”); TMEP §1207.01.

1. The Marks are Confusingly Similar

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 Fondée 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 Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

Where the goods of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, ___ F.3d ___, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(b). In the present case, and as discussed further below, applicant's goods encompass the goods in the cited registration, and are therefore legally identical. As such, the degree of similarity in the marks required to show a likelihood of confusion is lessened.

The examining attorney notes that 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) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly

significant because consumers typically notice those words first"). In the present case, the beginning of the Cited Mark is "SHAKY." Thus, although the Cited Mark includes the additional wording "KNEES," the first portion of the mark, "SHAKY," which comprises the entirety of applicant's mark, is the feature that would likely appear most prominent to consumers.

Applicant argues that the marks, when viewed as whole, present distinct commercial impressions because "SHAKY KNEES" refers to "*someone or something that is shaking at the knees, that is, that a part of the human, animal or insect leg is 'lacking in stability',*" whereas the applicant's mark is arbitrary and describes something that is "*'characterized by shakes'; 'lacking stability'; 'lacking firmness (as to beliefs or principles)'*" or "*lacking in authority or reliability.*" The examining attorney notes that although the marks as a whole may present slightly different commercial impressions, the commercial impressions are nonetheless highly similar and heavily influenced by the wording "SHAKY," denoting lacking stability.

Applicant further argues that the marks differ in appearance due to the wording "KNEES" appearing in the Cited Mark. While the additional wording "KNEES" in the Cited Mark results in a slightly different visual impression, the shared common element in the marks appearing first in the cited registration and comprising the entirety of the applicant's mark is more likely to be viewed or read first by consumers. *See Palm Bay Imps.*, 396 F.3d at 1372, 73 USPQ2d at 1692; *Century 21 Real Estate*, 970 F.2d at 876, 23 USPQ2d at 1700. Further, because there is no additional wording in applicant's mark to distinguish it visually from the Cited Mark, the visual similarity of the marks outweighs their difference.

Applicant also argues that the additional syllable in the Cited Mark results in a different pronunciation. The examining attorney notes that the non-identical wording in the marks comprises a single syllable which is pronounced last. Slight differences in the sound of similar marks will not avoid a

likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Although applicant's mark does not contain the entirety of the Cited Mark, applicant's mark is likely to appear to prospective purchasers as a shortened form of registrant's mark. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Moreover, the examining attorney has included evidence that indicates that in the clothing industry, companies often use and register shortened formatives of their marks and use such shortened formatives to indicate the same source of goods.

Please refer to the following evidence:

- Third-party registration evidence establishing that Abercrombie & Fitch Trading Co. has registered the word mark ABERCROMBIE & FITCH, and its shortened formative ABERCROMBIE, and Internet evidence from www.abercrombie.com establishing that both ABERCROMBIE & FITCH and ABERCROMBIE are used on clothing items and indicate the same source. *Please refer to pages 2-9 of the Office action dated August 8, 2018.*
- Third-party registration evidence establishing that Boardriders IP Holding LLC has registrations for the word mark QUIKSILVER, and the shortened formative QUIK, and Internet evidence from www.quiksilver.com establishing that both QUIKSILVER and QUIK are used on clothing items and indicate the same source. *Please refer to pages 10-14 of the Office action dated August 8, 2018.*
- Third-party registration evidence establishing that Levi Strauss & Co. has registrations for the word mark LEVI STRAUSS & CO. (& design), and the shortened formative LEVI'S, and Internet evidence from www.levi.com establishing that both LEVI STRAUSS & CO. (& design) and LEVI'S are used on clothing items and indicate the same source. *Please refer to pages 15-22 of the Office action dated August 8, 2018.*
- Third-party registration evidence establishing that PRL USA Holdings, Inc., has registrations for the word mark POLO RALPH LAUREN, and the shortened formative POLO, and Internet

evidence from www.ralphlauren.com establishing that both POLO RALPH LAUREN and POLO are used on clothing items and indicate the same source. *Please refer to pages 23-29 of the Office action dated August 8, 2018.*

- Third-party registration evidence establishing that Hugo Boss Trade Marks Management GMBH & CO. KG has registrations for the word mark BOSS HUGO BOSS, and the shortened formative BOSS, and Internet evidence from www.hugoboss.com establishing that both BOSS HUGO BOSS and BOSS are used on clothing items and indicate the same source. *Please refer to pages 30-35 of the Office action dated August 8, 2018.*
- Third-party registration evidence establishing that Tommy Hilfiger Licensing LLC has registrations for the word mark TOMMY HILFIGER, and the shortened formative TOMMY, and Internet evidence from <https://usa.tommy.com> establishing that both TOMMY HILFIGER and TOMMY are used on clothing items and indicate the same source. *Please refer to pages 36-42 of the Office action dated August 8, 2018.*

Thus, this evidence suggests that relevant consumers of applicant's and registrant's clothing items are accustomed to encountering marks and shortened formatives thereof used as source identifiers to denote the same source of clothing goods.

Applicant argues that these examples should be viewed as highly speculative because there is no legal basis to support the conclusion that it is common in applicant's industry for companies to use shortened formatives of their marks as source indicators. The examining attorney notes, however, that there is ample legal precedent for holding that a likelihood of confusion exists where an applied-for mark that comprises the first portion or portion of a registered mark (or vice versa). *See e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1322 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (affirming TTAB's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (affirming TTAB's finding that applicant's mark, ML, is likely to be perceived as a shortened version of registrant's mark, ML MARK LEES (stylized), when used on the same or closely related skin-care products); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion, noting

that the marks are more similar than they are different and that the addition of applicant's "product mark," VANTAGE, to the registered mark would not avoid confusion); *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1219 (TTAB 2008) (holding SAM EDELMAN and EDELMAN, both for wallets and various types of bags, likely to cause confusion, noting that there are strong similarities between the marks because they share the same surname, and that consumers viewing the mark EDELMAN may perceive it as an abbreviated form of SAM EDELMAN because it is the practice in the fashion industry to refer to surnames alone); *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (holding CORAZON BY CHICA with design, and CORAZON with design, both for jewelry, likely to cause confusion, noting that, "to many consumers, applicant's mark for the identical word 'Corazon' followed by the phrase 'BY CHICA' will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (holding MACHO COMBOS (with "COMBOS" disclaimed), and MACHO (stylized), both for food items as a part of restaurant services, likely to cause confusion). In the present case, the marketplace and third-party registration evidence provided by the examining attorney supports this principle as to the clothing items specified in the application and registration.

In summary, the degree of similarity in the marks required to show a likelihood of confusion is lessened, because, as discussed further below, applicant's goods encompass the goods specified in the cited registration. Both marks share an identical literal element, which appears first in the Cited Mark and comprises the entirety applicant's mark; further, there is no additional wording in applicant's mark to distinguish it from the Cited Mark. The marks are highly similar in appearance, sound, and commercial impression by virtue of the identical wording in the mark, and consumers would likely view applicant's mark as a shortened formative of the Cited Mark. As such, the marks are confusingly similar. Therefore, this factor favors a refusal.

2. The Goods are Encompassing

The goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In the present case, the application uses broad wording to describe "*Clothing apparel, namely, t-shirts; Headgear, namely, caps,*" which presumably encompasses all goods of the type described, including registrant's more narrowly described "*Baseball caps*" and "*Short-sleeved or long-sleeved t-shirts.*" See, e.g., *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods are legally identical. See, e.g., *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and 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)).

Applicant argues that the goods can be distinguished from one another because the channels of trade of the applicant and registrant differ. Specifically, applicant argues that the goods identified in the

cited registration are sold exclusively through the registrant's website and during an annual music festival in Atlanta, Georgia, whereas the applicant intends to sell its goods in direct connection with its alcoholic beverages.

The examining attorney notes, however, that the presumption under Trademark Act Section 7(b) is that the registrant is the owner of the mark and that its use of the mark extends to all goods identified in the registration. 15 U.S.C. §1057(b). In the absence of limitations as to channels of trade or classes of purchasers in the goods in the registration, the presumption is that the goods move in all trade channels normal for such goods and are available to all potential classes of ordinary consumers of such goods. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(iii). In the present case, neither the application nor the registration have any limitations as to the nature, type, channels of trade or classes of purchasers. As such, applicant's argument that the goods of the applicant and the registrant are distinguishable is unpersuasive.

In summary, applicant's goods encompass the goods specified in the registration and neither the registration nor the application are have any limitations as to the nature, type, channels of trade or classes of purchasers. As such, the goods are legally identical. Therefore, this factor favors a refusal.

3. Other Considerations

Applicant argues that the coexistence of U.S. Registration No. 4535177 for SHAKY in International Class 041 and a registration for SHAKY KNEES in International Class 041 suggests that the applicant's mark and the Cited Mark may also coexist. The examining attorney notes, however, that applicant did not make the registration for SHAKY KNEES in Class 041 a part of the record. To make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Star Belly Stitcher*,

Inc., 107 USPQ2d 2059, 2064 (TTAB 2013); TBMP §1208.02; TMEP §710.03. Accordingly, the examining attorney requests that the registration for SHAKY KNEES in Class 041 referenced by the applicant not be considered.

In the event the Board considers this evidence, the examining attorney notes that the registration cited by the applicant and the registration referenced by the applicant are for goods and/or services that are predominantly different or unrelated to the goods in the application and the cited registration. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection” in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

Evidence comprising third-party registrations for similar marks with different or unrelated goods and/or services, as in the present case, has “no bearing on the strength of the term in the context relevant to this case.” *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). Thus, the third party registration submitted by the applicant and registrant's registration referenced by the applicant are insufficient to establish that the wording SHAKY is weak or diluted.

CONCLUSION

Because the applicant's mark is incorporated in its entirety into the Cited Mark, and because the goods are encompassing, the examining attorney requests affirmance of the refusal to register pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d).

Respectfully submitted,

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