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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87440925

MARK: DIRTY LAUNDRY



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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: Telecom (CHINA) Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

The Applicant has appealed the Examining Attorney's final refusal to register the mark DIRTY LAUNDRY in standard characters on the Principal Register for "Hooded sweatshirts; Jackets; Jeans; Pants; Shirts; Shorts; T-shirts" in International Class 25 on the ground that the mark is likely to be confused with the marks in U.S. Registration Nos. 4117028 and 4275485 pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

II. STATEMENT OF FACTS

On May 8, 2017, the Applicant applied under Section 1(b) of the Trademark Act to register the mark DIRTY LAUNDRY in standard characters for “Hooded sweatshirts; Jackets; Jeans; Pants; Shirts; Shorts; T-shirts” in International Class 25.

On July 29, 2017, the Examining Attorney refused registration pursuant to Section 2(d) of the Trademark Act on the basis that the mark is likely to be confused with the marks in U.S. Registration Nos. 4117028—DIRTY LAUNDRY for “Footwear” in International Class 25—and 4275485—DIRTY LAUNDRY for “Luggage” in International Class 18.

The Applicant responded to the initial Office action on January 26, 2018, by arguing against the refusal.

The Examining Attorney maintained and made final the Section 2(d) likelihood of confusion as to U.S. Registration Nos. 4117028 and 4275485 on January 30, 2018.

On July 30, 2018, the Applicant filed a Notice of Appeal and Request of Reconsideration After Final Action, the latter of which the Examining Attorney denied that same day.

The Applicant filed an Appeal Brief and Request for Oral Hearing on October 8 and 12, 2018, respectively, the former of which was forwarded to the Examining Attorney on October 25, 2018.

III. ISSUE

The sole issue on appeal is whether the Applicant’s mark DIRTY LAUNDRY in standard characters, when used on or in connection with the goods identified in the application, so closely resembles the marks in U.S. Registration Nos. 4117028 and 4275485 for DIRTY LAUNDRY in standard characters for their respective goods as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

IV. ARGUMENT

A. Applicant's and Registrants' Marks Are Confusingly Similar and Their Goods Are Closely Related Such That Consumers Are Likely To Be Confused, Mistaken, or Deceived as to the Source of the Goods

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods of the parties. See 15 U.S.C. §1052(d). 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 goods [or services] and differences in the marks.”); TMEP §1207.01.

In this case, the following factors are the most relevant: identical marks and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 279 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.* As the following paragraphs will demonstrate, the Applicant's mark DIRTY LAUNDRY in standard characters is confusingly similar to the Registrants' marks DIRTY LAUNDRY (U.S. Registration Nos. 4117028 and 4275485) in standard characters because they are identical in appearance, sound, and commercial impression. Furthermore, the Applicant's "Hooded sweatshirts; Jackets; Jeans; Pants; Shirts; Shorts; T-shirts" are closely related to the Registrants' "Footwear" in U.S. Registration No. 4117028 and "Luggage" in U.S. Registration No. 4275485 because they routinely travel together in the same trade channels under the same mark. Therefore, consumers are likely to be confused, mistaken, or deceived as to the source of the goods under Section 2(d) of the Trademark Act.

B. The Applicant's and Registrants' Marks Are Confusingly Similar

The Applicant's mark DIRTY LAUNDRY in standard characters is confusingly similar to the Registrants' marks DIRTY LAUNDRY (U.S. Registration Nos. 4117028 and 4275485) in standard characters.

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *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)); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, the Applicant's and Registrants' marks are identical in appearance, sound, and meaning, namely, evoking "private matters whose public exposure brings distress and

embarrassment,”¹ “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with Applicant’s and Registrants’ respective goods. *Id.*

Therefore, the marks are confusingly similar, and the Applicant does not appear to contest this point.

C. The Applicant’s and Registrants’ Goods Are Closely Related

The Applicant’s “Hooded sweatshirts; Jackets; Jeans; Pants; Shirts; Shorts; T-shirts” in International Class 25 are closely related to the Registrants’ “Footwear” in International Class 25 (U.S. Registration No. 4117028) and “Luggage” in International Class 18 (U.S. Registration No. 4275485).

Where the marks of the respective parties are identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a).

The evidence attached in the initial and final Office actions show that at least ten third parties routinely provide the preceding goods under the same mark, such that the trade channels of the goods are identical:

- Kate Spade New York offers footwear, luggage, and t-shirts;²

¹ Office action dated July 29, 2017, at page 6.

² *Id.* at pages 7-9.

- Calvin Klein offers footwear, pants, and luggage;³
- Nautica offers footwear, jackets, and luggage;⁴
- Victorinox Swiss Army offers luggage and shirts;⁵
- Tommy Bahama offers luggage, footwear, and hooded sweatshirts;⁶
- Timberland offers luggage, footwear, and jackets;⁷
- The North Face offers luggage, footwear, and pants;⁸
- Ted Baker London offers luggage, footwear, and t-shirts;⁹
- Patagonia offers luggage, footwear, and shorts;¹⁰ and
- Michael Kors offers luggage, footwear, and jeans.¹¹

The Examining Attorney also submitted evidence from the Office’s X-Search database consisting of seventeen third-party marks registered for use in connection with the same or similar goods in International Classes 18 and 25 as those of both Applicant and Registrants in this case. This evidence shows that the goods listed therein 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).

<u>U.S. Registration No.</u>	<u>Mark</u>	<u>Relevant Goods</u>	<u>Location in Actions</u>
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³ *Id.* at pages 10-12.

⁴ *Id.* at pages 13-15.

⁵ Office action dated January 30, 2018, at pages 2-3.

⁶ *Id.* at pages 4-6.

⁷ *Id.* at pages 7-9.

⁸ *Id.* at pages 10-12.

⁹ *Id.* at pages 13-15.

¹⁰ *Id.* at pages 16-18.

¹¹ *Id.* at pages 19-21.

5177252	DANCING DAYS	“Luggage” in International Class 18; “Footwear; ... Hooded sweatshirts; ... Men's and women's jackets ...; Pants; [] Shirts; [] Shorts; ... T-shirts” in International Class 25	Office action dated July 29, 2017, at pages 16-18
5225881	TRIPP NYC	“Luggage” in International Class 18; “Athletic footwear; ... Capri pants; ... Hooded sweatshirts; [] Jeans; ... Jogging pants; ... Shirts; [] Shorts; ... Sweat pants; ... Sports jackets; Sweat pants; ... T-shirts” in International Class 25	Office action dated July 29, 2017, at pages 19-21
5210789	BEACH BODY	“luggage” in International Class 18; “tee-shirts; shirts; sweatshirts; sweatpants; [] jackets; ... pants; shorts; ... footwear” in International Class 25	Office action dated July 29, 2017, at pages 22-24
5235012	MIYAHOUSE	“Luggage” in International Class 18; “Footwear; ... Jackets; ... Pants; [] Shirts” in International Class 25	Office action dated July 29, 2017, at pages 25-27
5189625	HARCOUR	“Luggage” in International Class 18; “Athletic apparel, namely, shirts, pants, jackets, footwear ...; ... Footwear; [] Jackets; Jeans; ... Waterproof jackets and pants; Women's clothing,	Office action dated July 29, 2017, at pages 28-30

		namely, shirts” in International Class 25	
4376639	B.D. BAGGIES	“luggage” in International Class 18; “Shirts, T-shirts, sweatshirts, ... pants, jeans, shorts, ... athletic footwear, beach footwear, casual footwear, outdoor winter footwear, sports footwear, ... outdoor clothing, namely, jackets” in International Class 25	Office action dated January 30, 2018, at pages 22-24
3663170	NICKY HILTON	“luggage” in International Class 18; “Women's apparel, namely, women's shirts, [] pants, ... shorts, sweatshirts[], sweatpants, jeans, ... jackets ... ; and footwear, namely shoes, boots, loafers, pumps, high heels, flats, wedges, stillettoes [sic], walking shoes, running shoes, athletic shoes, sandals, beach sandals, beach shoes, clogs sneakers and slippers” in International Class 25	Office action dated January 30, 2018, at pages 25-27
3703617	tree design	“bags, namely, ... luggage” in International Class 18; “clothing, footwear, and headwear, namely, t-[]shirts, woven shirts, ... sweatshirts, ... jackets, ... jeans, pants,	Office action dated January 30, 2018, at pages 28-30

		... shorts, ... athletic shoes, slippers, sandals, boots, dress shoes” in International Class 25	
4376842	J	“Small leather goods, namely, ... luggage” in International Class 18; “Clothing, namely, ... shirts ...; outerwear, namely, jackets ... ; footwear; ... sportswear, namely, shirts, pants, ... T-shirts, shorts, ... jeans, outerwear, namely, jackets, sweatshirts” in International Class 25	Office action dated January 30, 2018, at pages 31-33
4514178	ECO-ESSENTIALS	“Luggage” in International Class 18; “Capri pants; ... Cargo pants; ... Footwear; [] Golf shirts; ... Jackets; Jeans; [] Night shirts; ... Pants; Polo shirts; ... Shorts; ... Sweatpants; Sweatshirts; T-shirts; ... Turtle neck shirts” in International Class 25	Office action dated January 30, 2018, at pages 34-36
4682756	ELEPHANT GARDEN	“luggage” in International Class 18; “Clothing, namely, T-shirts, shirts, tops, ... hooded sweatshirts; ... jackets; [] pants, [] jeans, shorts ...; footwear” in International Class 25	Office action dated January 30, 2018, at pages 37-39
4619888	GODWIN	“soft luggage; ... luggage bags” in International Class 18;	Office action dated January 30, 2018, at pages 40-42

		<p>“Clothing and apparel for men, women, young adults, children and infants, namely, shirts, ... tee shirts, shorts, ... sweatshirts, ... footwear, ... jackets, ... pants, jeans” in International Class 25</p>	
4905612	900	<p>“luggage” in International Class 18; “Clothing, namely, pants, [] jeans, shorts, shirts, t-shirts, ... sweatshirts, [] jackets ...; infants and children's clothing, namely, [] t-shirts, [] long sleeved shirts, shorts, pants ...; footwear” in International Class 25</p>	Office action dated January 30, 2018, at pages 43-45
5018890	ELLEEN	<p>“Luggage” in International Class 18; “Athletic apparel, namely, shirts, pants, jackets, footwear ...; Jackets; Jeans; ... Pants; ... Shirts; Shorts; ... Sweat shirts; ... Women's clothing, namely, shirts” in International Class 25</p>	Office action dated January 30, 2018, at pages 46-48
5106111	R!D!CULOUS L!FE	<p>“luggage” in International Class 18; “Apparel, namely, [] footwear, ... t-shirts, shirts, [] sweatshirts, pants, jackets, shorts, ... jeans” in International Class 25</p>	Office action dated January 30, 2018, at 52-54

5292313	JE JIA ESPINAR U.S.A.	“Luggage” in International Class 18; “Pants for men and women; Women's clothing, namely, shirt ...; Footwear for men; Men's and women's jackets” in International Class 25	Office action dated January 30, 2018, at pages 58-60
5368788	heart design	“soft luggage” in International Class 18; “Clothing for men, women and children, namely, shirts, T-shirts, ... pants, ... jeans, ... shorts, ... sweat shirts, ... ponchos, jackets, reversible jackets, ... footwear” in International Class 25	Office action dated January 30, 2018, at pages 61-63

As the preceding registrations demonstrate, consumers are accustomed to encountering the goods set forth in the Applicant’s and Registrants’ identifications under a single mark, and the Applicant does not appear to contest this point

Collectively, this evidence demonstrates that the parties’ goods are closely related because they frequently travel in the same trade channels, including under the same mark. Accordingly, consumers may confuse the source thereof when viewing or hearing DIRTY LAUNDRY in the marketplace.

D. Even Though the Registrants’ Marks Co-Exist, Applicant’s Argument That the Applied-For Mark Should Also Be Able To Co-Exist Is Not Persuasive

The Applicant’s sole argument on appeal is that because the two cited registrations co-exist with each other allegedly without confusion, its mark should be able to as well.

To the extent the Applicant is asserting that this wording in the marks is weak, diluted, or so widely used that it should not be afforded a broad scope of protection, 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. *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 “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).

However, evidence comprising only two cited registrations for similar marks with similar goods, as in the present case, is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These two cited registrations are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; *In re I-Coat Co.*, 126 USPQ2d 1730, 1735 (TTAB 2018). Thus, the two cited registrations are insufficient to establish that the wording DIRTY LAUNDRY is weak or diluted.

Additionally, Applicant’s claim that “the fact that the two registrants’ marks coexist in the marketplace without consumer confusion means that Applicant’s Mark can coexist with each of them in the marketplace without consumer confusion”¹² is not persuasive because ““a showing of actual confusion is not necessary to establish a likelihood of confusion.”” *In re i.am.symbolic, llc*, 866 F.3d

¹² Applicant’s Appeal Brief at page 5.

1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). “[T]he relevant test is *likelihood* of confusion, not *actual* confusion.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original).

The Applicant has not provided evidence to substantiate its allegation that no actual confusion exists or has existed between the cited registrations in the marketplace apart from their mere co-existence on the Principal Register. Assuming, *arguendo*, the Applicant was able to provide such evidence and establish no likelihood of confusion as to the Registrant’s mark DIRTY LAUNDRY (U.S. Registration No. 4275485) for “Luggage” in International Class 18, the Applicant does not explain why its mark DIRTY LAUNDRY for goods in International Class 25 should be able to co-exist with the Registrant’s (U.S. Registration No. 4117028) identical mark in the same class.

V. CONCLUSION

The evidence and argument submitted herein demonstrate that the Applicant’s and Registrants’ marks are identical and, therefore, confusingly similar and their goods are closely related. In light of this, consumers are likely to confuse the source of the parties’ goods when viewing or hearing DIRTY LAUNDRY in commerce. Therefore, it is respectfully requested that the final refusal to register the mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), be affirmed.

Respectfully submitted,

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