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U.S. Application Serial No. 88559109

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appeals the trademark examining attorney's final refusal to register the mark **B.A. WOMEN**, in standard characters, for clothing on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). The trademark examining attorney refused registration based on a likelihood of confusion with the mark in U.S. Registration No. 5662286, **B. A. MAN** in standard characters, also for clothing. *See* 15 U.S.C. §1052(d).

ISSUE

Whether Applicant's proposed mark is likely to be confused with that of Registrant so as to preclude registration under Section 2(d) of the Trademark Act.

STATEMENT OF RELEVANT FACTS

On August 1, 2019, Applicant filed an application seeking registration on the Principal Register for the standard character mark **B.A. WOMEN** for "Clothing, namely, t-shirts, long sleeved shirts, hoodies, short sets, sport tops, leggings, tank tops, athletic tops and bottoms for women," in International Class 25. On November 7, 2019, the trademark examining attorney refused registration of the applied for mark pursuant to Section 2(d) of the Trademark Act on the grounds that applicant's mark would likely cause confusion with the standard character mark in U.S. Registration No. 5662286, **B. A. MAN** for clothing, particularly "Hats; Jogging suits; Pants; Shorts; Yoga pants" in International Class 25.

On May 4, 2020, applicant responded to the Office action by providing arguments against the refusal. The trademark examining attorney issued a Final Office action refusing registration on May 26, 2020. On November 12, 2020, applicant filed the instant appeal before the Trademark Trial and Appeal Board. Applicant filed its Appeal Brief on January 12, 2021.

DISCUSSION

THE MARK B.A. WOMEN IS SO SIMILAR IN APPEARANCE AND COMMERCIAL IMPRESSION SO AS TO CREATE A LIKELIHOOD OF CONFUSION WITH THE REGISTERED MARK B. A. MAN FOR RELATED CLOTHING, AND, ACCORDINGLY, REGISTRATION IS REFUSED UNDER SECTION 2(d) OF THE TRADEMARK ACT.

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). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

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.

Similarity 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 Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant's mark is **B.A. WOMEN** in standard characters and registrant's mark is **B. A. MAN** in standard characters. The wording **B.A.** and **B. A.** is identical in sound, virtually identical in appearance, and similar in commercial impression such that the different descriptive ending terms, **WOMEN** and **MAN**, do not obviate the similarity between the marks.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Detroit Athletic Co.*, 903 F.3d at 1305, 128 USPQ2d at 1050 (citing *In re Dixie Rests.*, 105 F.3d at 1407, 41 USPQ2d at 1533-34).

In this case, the marks are confusingly similar, because the dominant feature of each mark are the letters **B** and **A**. Consumers are likely to focus on this wording in the marks, because consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark. See *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"). A space in between the elements in the marks is generally insignificant, because it does not diminish that the marks are identical in sound, virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion. See, e.g., *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) ("[T]he marks 'SEAGUARD' and 'SEA GUARD' are, in contemplation of law, identical [internal citation omitted]."); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"); *Stock Pot, Inc., v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff'd* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.").

In this case, the terms **B.A.** and **B. A.** appear and sound to prospective purchasers as initials or as an abbreviation regardless of how the term is spaced.

Although applicant's mark ends with the term **WOMEN** and registrant's mark ends with the term **MAN**, this difference does not obviate the similarity between the marks. Applicant disclaimed the wording **WOMEN** and registrant disclaimed the wording **MAN**. Disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). For these reasons, the wording **WOMEN** and **MAN** is less dominant than the terms **B.A.** or **B. A.** Additionally, **WOMEN** describes applicant's identified "Clothing... for women" and **MAN** describes registrant's clothing, which presumably includes all clothing of the type described, including clothing for men. These terms are frequently used as descriptive words in the context of clothing to categorize goods online and in retail establishments. (*See e.g.* Final Office action dated May 26, 2020, TSDR pp. 2-3, 9-10, 13-14 (showing a variety of clothing tops and bottoms that are categorized by goods for women and for men)).

Applicant argues that the wording **B. A. MAN** is a grammatically correct phrase intended to be read as "be a man", but that the applicant's mark, **B.A. WOMEN** would not appear to consumers as a phrase ("be a women"), because it is not a grammatically correct phrase. However, when comparing marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific

impression of trademarks. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b). Here, an average purchaser retaining a general impression of the marks is likely to merely retain the general impression of clothing from **B.A.**, and also merely perceive the second term as further identifying clothing that can be worn by a **MAN** or worn by **WOMEN**.

Furthermore, consumers could reasonably assume that applicant's goods sold under the **B.A. WOMEN** mark constitute a new or additional product line from the same source as the goods sold under the **B. A. MAN** mark with which they are acquainted or familiar, and that applicant's mark is merely a variation of the registrant's mark that is more specifically geared towards women. *See, e.g., SMS, Inc. v. Byn-Mar Inc.*, 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were "likely to evoke an association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing."); *In re Collegian Sportswear, Inc.*, 224 USPQ 174, 176 (TTAB 1984) ("...customers familiar with registrant's 'COLLEGIENNE' clothing might believe that 'COLLEGIAN OF CALIFORNIA' clothing was a new line of clothing from registrant featuring a 'California' or west coast style."); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977).

Lastly, where the goods of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). Here, as noted below, the goods are highly related, overlapping, and legally identical at least in part.

In sum, because the marks begin with the virtually identical terms, **B.A.** and **B. A.**, and because the remaining descriptive wording in the marks does not obviate the similarity between the marks, the marks are confusingly similar.

Relatedness of Goods

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).

The compared goods 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); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods 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).

Here, applicant’s goods are “Clothing, namely, t-shirts, long sleeved shirts, hoodies, short sets, sport tops, leggings, tank tops, athletic tops and bottoms for women”. Registrant’s goods are “Hats; Jogging suits; Pants; Shorts; Yoga pants.” Applicant’s and registrant’s goods are related, because applicant and registrant both provide clothing.

Applicant’s short sets and registrant’s shorts are directly overlapping because short sets are presumed to encompass shorts. Therefore, it is presumed that the channels of trade and classes of purchasers are the same for these goods. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127

USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)).

Some of applicant's and registrant's other clothing are overlapping because the goods are encompassing. For example, the application uses broad wording to describe "athletic tops and bottoms for women," which presumably includes all goods of the type described including registrant's narrower jogging suits, yoga pants, and shorts and pants for athletic use. 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, at least in part. 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)).

Additionally, any of applicant's and registrant's types of remaining clothing are all broadly related. Decisions regarding likelihood of confusion in the clothing field have found many different types of apparel worn by women and men to be related goods. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women's boots related to men's and boys' underwear); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

The trademark examining attorney has presented evidence of seven third-party websites to establish that the same entity commonly provides and markets the identified clothing under the same mark. These referenced third party websites include:

- Adidas, offering men's and women's clothing, including women's jackets, yoga pants, and tank tops; and men's jackets and track pants (See Office action dated May 4, 2020, TSDR pp. 4-9);
- Nike, offering men's jackets, women's sports bras, tops, and yoga pants (See Office action dated May 4, 2020, TSDR pp. 10-14);
- Under Armour, offering women's jackets, bottoms, sports bras, tank tops, boots, hats and headwear; and men's track suits, pants, sweatpants, (See Office action dated May 4, 2020, TSDR pp. 15-21);
- Alo Yoga, offering women's tops, bottoms, jackets, jackets, and hats; and men's tops, bottoms, jackets, and hats (See Office action dated May 26, 2020, TSDR p. 2-3);
- Altheta, offering tops including short- and long-sleeve shirts, tank tops, sweatshirts; bottoms including joggers, sweatpants, pants, and shorts; and accessories including hats and yoga gear (See Office action dated May 26, 2020, TSDR p. 4-7);
- Kira Grace, offering athletic tops and bottoms including yoga shirts, tanks, yoga pants, and leggings (See Office action dated May 26, 2020, TSDR p. 8);
- Lululemon, offering separate sections for men and women, which include men's and women's jackets, coats, dresses, pants, shirts, shorts, sweaters, underwear, and hats (See Office action dated May 26, 2020, TSDR p. 9-11);
- Prana, offering men's and women's tops, bottoms, swimwear; and accessories including hats and headbands (See Office action dated May 26, 2020, TSDR p. 13-15);

Thus, applicant's and registrant's goods are 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).

In applicant's Appeal Brief, applicant merely reasserts the lack of confusion between its mark and the cited registration and argues that the cited registration has been constructively abandoned. In support of its claim, applicant avers that the goods are marketed to different customers, because applicant's clothing line is intimately tied with the field of female empowerment. However, as previously set forth, when analyzing an applicant's and registrant's goods for relatedness, determining a 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)). Neither the application nor the registration contains any limitations regarding trade channels for the clothing. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. See *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

Applicant asserts that the applied-for mark **B.A. WOMEN** should be registered because it is widely recognized, and conversely, the registered mark **B. A. MAN** is not as widely recognized by consumers. However, the purported lack of fame of a cited mark is not significant to the issue of likelihood of confusion in ex parte examination. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (citing *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006)). Additionally, the Trademark Act not only guards against the misimpression that the senior user is the source of a junior user's goods, but it also protects against "reverse confusion," where a significantly larger or prominent junior user is perceived as the source of a smaller, senior user's goods such that the "senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user" for related goods. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1329, 123 USPQ2d 1744, 1752 (Fed. Cir. 2017) (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994). As noted above, the likelihood that **B.A. WOMEN** could appear as a significantly larger junior user such that it would affect the identity and good will of the senior user **B. A. MAN**.

Accordingly, applicant's argument is not persuasive.

With respect to applicant's argument that the registration has been abandoned, U.S. Registration No. 5662286 is live on the Principal Register. For the purposes of this proceeding, a

trademark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified clothing. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Thus, the additional evidence submitted by the applicant and the arguments in applicant's brief constitute an impermissible collateral attack on a cited registration, as it is well established that information or statements regarding a registrant's nonuse of its mark are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Applicant's additional evidence includes a google image search for the wording "**B. A. MAN**", a screenshot from the California Secretary of State's Office, several screen shots from applicant's website, Instagram, and Facebook profile pages, and several photographs of applicant's clothing (Exhibits A-K). However, the record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Applicant's Appeal Brief indicates that the date visited on these sites are November 13, 2020-December 17, 2020. Therefore, this cited evidence, including the new screenshots from applicant's webpages, was submitted after the filing date of the Notice of Appeal on November 12, 2020, at which point the record should have been complete. Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. See *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

Because the marks are confusingly similar and because the goods are highly related, consumers would be likely to mistakenly believe that the goods emanate from a single source. Thus, registration is properly refused pursuant to Section 2(d) of the Trademark Act.

CONCLUSION

For the reasons set forth above, the trademark examining attorney respectfully submits that the applied-for standard character mark **B.A. WOMEN** is so similar to the registered standard character mark **B. A. MAN** such that consumers are likely to be confused as to the source of applicant's and registrant's clothing in the marketplace. Accordingly, the refusal to register applicant's mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), should be affirmed.

Respectfully submitted,

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