

5-5-98

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.S.**

**05 MAY 1998**

293

Hearing: July 16, 1997

Paper No. 15  
RLS/RR

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wright's Knitwear Corporation

Simms

1/2  
only

Serial No 74/637,379

Simor L. Moskowitz of Jacobson, Price, Holman & Stern for  
Wright's Knitwear Corporation

Catherine K. Krebs, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney)

Before Simms, Cissel and Hairston, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge.

Wright's Knitwear Corporation (applicant), a New York  
corporation, has appealed from the final refusal of the  
Trademark Examining Attorney to register the mark ACME  
UNDERWEAR COMPANY ("UNDERWEAR COMPANY" disclaimed) for men's  
underwear and loungewear.<sup>1</sup> The Examining Attorney has  
refused registration under Section 2(d) of the Act, 15 USC  
§1052(d), on the basis of the mark shown below.

<sup>1</sup> Application Serial Number 74/637,379, filed February 23, 1995,  
based upon applicant's assertion of a bona fide intention to use  
the mark in commerce under Section 1(b) of the Act, 15 USC §1051  
(b)

# ACME

issued on the Supplemental Register (Registration Number 1,566,629, issued November 14, 1989, Section 8 affidavit accepted) for "clothing, namely t-shirts featuring the depictions of Looney Tunes cartoon characters.") The registration is owned by Time Warner Entertainment Company L.P. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

We affirm.

It is applicant's position that confusion is unlikely. Among other things, applicant points to the fact, as revealed in the identification of goods in the registration, that registrant's mark ACME is used in connection with well-known cartoon characters which, according to applicant, are dominant features in the display of registrant's mark. Accordingly, applicant argues that consumers will only associate the registered mark ACME with these cartoon characters and the Time Warner company. Also, applicant argues that the Examining Attorney has ignored the "weakly suggestive laudatory character of the common portions of the

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mark[s]." Applicant's Amendment, Response and Request for Reconsideration, filed November 2, 1995, 3. In this regard, applicant points to the definition of "acme" as meaning "the highest point; culmination; peak." Applicant also has made of record over one hundred third-party registrations of the mark ACME, either alone or with additional matter, in support of its argument that the registered mark is weak. Further, in support of applicant's argument that consumers are accustomed to encountering and distinguishing between multiple sources of goods bearing ACME marks, applicant points to various Yellow Pages directory listings of various businesses which include the name "ACME," such as "Acme T-Shirt Company" and "Acme Costumes."

The Examining Attorney, on the other hand, argues that consumers are likely to believe that the closely related goods of applicant and registrant with the marks ACME and ACME UNDERWEAR COMPANY originate from the same source or are otherwise affiliated. With respect to the marks, the Examining Attorney argues that one feature of a mark may be more significant in creating a commercial impression than the remainder of the mark. In the case of applicant's mark, the Examining Attorney argues that the generic words "UNDERWEAR COMPANY" are of little trademark significance and that the significant origin-indicating feature of applicant's mark is the word "ACME."

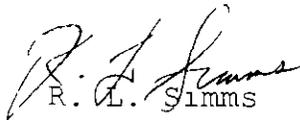
Webster's New World Dictionary (1988)

With respect to the goods, the Examining Attorney maintains that the definitions which she has made of record (of "T-shirt," "underwear," and "loungewear") show that T-shirts can be both undershirts (that is, underwear) or an outer shirt. The Examining Attorney argues that registrant's T-shirts could be used both as underwear (or loungewear) as well as outerwear. The Examining Attorney points to an L.L. Bean catalog of record as evidence that both unadorned and adorned T-shirts are sold by this same manufacturer and may travel in the same channels of trade. Finally, the Examining Attorney argues that the registered mark "ACME" is not diluted in Class 25. In this regard, the Examining Attorney notes that the only other registered ACME marks in Class 25 are registered marks of the Acme Boot Company (which registered marks were previously cited by the Examining Attorney as Section 2(d) bars to registration but later withdrawn). Moreover, the Examining Attorney maintains that the evidence of record does not show use of the third-party marks, or that consumers are aware of them, or that consumers have been accustomed to distinguishing these marks and goods in the marketplace. The Examining Attorney concludes that consumers will believe that both unadorned and adorned T-shirts bearing the marks ACME and ACME UNDERWEAR COMPANY come from the same source or are otherwise sponsored or endorsed by the same company.

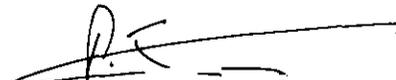
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Applicant's mark and the registered mark have obvious similarities in sound, appearance and meaning. Clearly, the word ACME in the primary origin-indicating feature of applicant's mark. Moreover, applicant's goods, including men's underwear, and registrant's T-shirts are, if not identical, closely related clothing items. We believe that consumers, accustomed to purchasing registrant's T-shirts bearing the registered mark ACME adorned with cartoon characters, would think that applicant's underwear including T-shirts (whether adorned or not) originate from the same source. If we had any doubt about this issue, it must be resolved in favor of the prior user and registrant because applicant had a legal duty to select a mark which is sufficiently different from registered marks. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir.)

Decision: The refusal of registration is affirmed.

  
R. L. Simms

  
R. F. Cissel

  
P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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