

03/30/01

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Paper No. 11
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Adriana Sanchez Manriquez

Serial No. 75/376,063

John S. Egbert of Harrison & Egbert for Adriana Sanchez Manriquez.

Mary J. Rossman, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before **Cissel**, Hanak and Holtzman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 20, 1997, applicant, who is a citizen of Mexico, applied to register the mark shown below

on the Principal Register for "athletic shoes and sneakers," in Class 25. The basis for filing the application was applicant's assertion that she possessed a bona fide intention to use the mark in commerce in connection with these products.

The Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if used on athletic shoes and sneakers, would so resemble the mark "CONCORD JEANS STORES," which is registered¹, with a disclaimer of the words "JEANS STORES," for "retail clothing store services featuring sportswear, footwear and men's and women's wearing apparel—namely, jackets, sneakers, shirts, pants, jeans and sweaters," that confusion would be likely.

Applicant responded with argument that confusion would not be likely "...[i]n view of the large number of registrations and the dilution of the 'CONCORD' mark..." In support of this argument, applicant submitted the results of a search of a private database of trademark information. Applicant argued that the search results demonstrate that there are 318 active registrations and applications and

¹ Reg. No. 1,283,713, issued on the Principal Register to Concord Jeans Corp. on June 26, 1984; subsequently assigned to A.I.J.J. Enterprises, Inc.; combined Section 8 and 15 affidavit received and accepted.

former registrations and applications of the mark "CONCORD" or its various permutations in many different classes, and that there are a total of 13 applications, registrations, former registrations and applications of such marks in Class 25 for clothing. A copy of the search report was attached to applicant's response.

The Examining Attorney was not persuaded to withdraw the refusal to register. She advised applicant that the search report applicant had submitted was not acceptable evidence of the registrations listed therein, and that because no copies of registrations or applications had been provided, applicant's arguments with respect to the alleged weakness of the cited registered mark were unsupported by any evidence.

The Examining Attorney argued that the cited registered mark should be considered to be a strong mark because not only has it achieved incontestable status by virtue of the post-registration affidavit under Sections 8 and 15, but also because the register reveals that no other "CONCORD" marks are registered in the field of footwear, clothing, or retail services related to such goods. Submitted in support of this position were copies of the Examining Attorney's search results from official Patent and Trademark Office records in Classes 25, 35 and 42.

In support of her position that the likelihood of confusion is not obviated by the inclusion of "JEANS" in the registered mark, the Examining Attorney attached excerpts from a search of Office records for registrations of marks which include "JEANS." This evidence establishes that the same entities that provide retail clothing store services under marks which includes "JEANS" also have separately registered the same marks for use in connection with individual items of clothing such as shoes and related goods. Examples are "JEANS WEST," "PEPE JEANS LONDON" and "CK CALVIN KLEIN JEANS." In addition, the Examining Attorney submitted copies of excerpts from catalogues and Office search records showing that several entities have used and registered, or applied to register, the same or similar marks in connection with both sports footwear and retail clothing store services. Examples include NIKE, REEBOK, OCEAN PACIFIC, FOOT LOCKER, and THE GAP.

The Examining Attorney reiterated her position that confusion would be likely with the registered mark for retail store services featuring clothing and sneakers if applicant were to use the mark she seeks to register, which is similar to the registered mark, in connection with athletic shoes and sneakers. The refusal to register was made final in the second Office Action.

Applicant concurrently filed a Notice of Appeal and an appeal brief. Attached to the appeal brief was a copy of another search report from an automated database of trademark information.

The Examining Attorney responded with her appeal brief, in which she objected to the consideration by the Board of the additional evidence attached to applicant's appeal brief. We sustain her objection, and have not considered this evidence. The submission of this evidence was untimely under Trademark Rule 2.142(d). That rule requires the record to be complete prior to the filing of a Notice of Appeal, and although it allows the record to be supplemented after that time under certain circumstances when the Board approves a request to allow this, applicant did not request or receive permission to submit this evidence.

In any event, as the Examining Attorney pointed out to applicant in her second Office Action, lists of third-party registrations, without appropriate copies of the listed registrations, do not make the registrations of record. In re Duofold Inc., 184 USPQ 638 (TTAB 1974); In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Moreover, even if the record included copies of the listed third-party registrations, such registrations would not establish

the use of those registered marks, so they could not be the basis upon which we could conclude that the consuming public is so familiar with the use of marks containing "CONCORD" on clothing items that they look to other components of such marks in order to distinguish among them. In re Hub Distributing, Inc., supra.

In her brief, the Examining Attorney asked the Board to take judicial notice of copies of several excerpts from standard reference materials submitted with the brief. We have done so. These references demonstrate that the Concorde is recognized as a supersonic passenger airplane, and that it resembles the airplane depicted in the mark applicant seeks to register.

Applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether confusion would be likely if applicant were to use the mark she seeks to register on the goods specified in the application in view of the cited registration.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the

marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. Any doubt as to whether confusion exists must be resolved in favor of the registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

In the case now before us, confusion is likely because the marks are similar and the goods set forth in the application are closely related to the services recited in the cited registration.

Turning our attention first to the marks, we note that when they are considered in their entirety, applicant's mark and the cited registered mark create similar commercial impressions. The Examining Attorney has pointed out many of the legal principles that lead to this conclusion. The test for similarity between marks is not whether the marks can be distinguished when they are subjected to side-by-side comparison, but rather whether they create commercial impressions which are similar. Visual Information Institute, Inc. v. Vicon industries Inc., 209 USPQ 179 (TTAB 1980). We must focus on the likely recognition of the average purchaser, who normally retains a general, rather than specific, impression of a trademark. Chemtron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537 (TTAB 1979). Generally, the likelihood of

confusion is not avoided by adding or deleting descriptive wording from otherwise similar marks. In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB 1988). We must consider the marks in their entireties. Any disclaimed portions cannot be ignored, but one feature of a mark may nonetheless be recognized as having more significance in creating the commercial impression for that particular mark. El Torito Restaurants Inc., supra. The points of similarity between the marks have greater significance than the points of difference. Esso Standard Oil Co. v. Sun Oil Co., 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), cert. denied, 351 U.S. 973, 109 USPQ 517 (1956). When a mark consists of a word portion and a design portion, the word portion is usually more likely to be retained by a prospective purchaser so that it can be used later in calling for or recommending the product. In re Appetito Provisions Co., Inc., 3 USPQ2d 729 (TTAB 1987).

When we consider the marks at issue in the instant case in light of these principles, we conclude that these two marks are similar enough that their use in connection with goods and services as closely related as the goods set forth in the application and the services recited in the cited registration would be likely to cause confusion.

Applicant's mark consists of the word "Concord" and a stylized presentation of the distinctive image of the Concorde aircraft. The registered mark is "CONCORD JEANS STORE." While we have considered applicant's mark in its entirety, we nonetheless recognize that the word "Concord" is the dominant portion of it. The graphic representation of the Concorde jet simply amplifies the word "Concord." The differences in spelling are inconsequential.

In a similar sense, the word "CONCORD" is the dominant portion of the registered mark. The generic, and hence disclaimed term "JEANS STORE" has no source-identifying significance, and as such, plays a much smaller role in creating the mark's commercial impression.

The registered mark and applicant's mark create similar commercial impressions because each is dominated by the same word, "CONCORD." This is the word that prospective purchasers would be likely to remember after encountering either of these two marks. As noted above, there is no evidentiary support for applicant's argument that the word "CONCORD" is weak and trademark significance in connection with footwear, clothing or retail store services.

When two marks are used in connection with very closely related goods and services, the degree of

similarity necessary to support the conclusion that confusion is likely declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). The goods and services do not need to be identical or even competitive in order to find that confusion would be likely. They need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services come from a common source. In *re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). It has been consistently held that confusion is likely to result from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. In *re Hyper Shoppes (Ohio), Inc.*, supra.

The record before us in this appeal establishes that the goods set forth in the application are closely related to the services recited in the cited registration. Applicant's "athletic footwear and sneakers" are encompassed within the products registrant's stores sell, which are identified in the registration as "footwear," "sportswear," and "sneakers." Additionally, the evidence made of record by the Examining Attorney demonstrates that

third-party retailers of footwear have adopted, used and registered their trademarks for both retail store services and the footwear sold in their retail stores.

Applicant admits (brief, p. 3) that the goods specified in the application "overlap with the services of the prior registered mark," but argues that confusion is not likely because the registrant has not registered its mark in connection with goods in Class 25. To the extent that we understand his argument, we are not persuaded by it. While we agree with applicant that her goods are of the same type sold in registrant's retail stores, we find that this is an entirely appropriate basis for concluding that the use of similar marks both on the goods and in connection with services which include selling these goods at retail would be likely to cause confusion.

In summary, the respective goods and services of applicant and registrant are very closely related and applicant's mark creates a commercial impression which is quite similar to the one created by the registered mark. Under these circumstances, confusion would be likely if applicant were to use her mark in connection with the goods specified in the application.

Decision: The refusal to register under Section 2(d) the Lanham Act is affirmed.

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