

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

12/20/01

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Matsui International Co., Inc.

Serial Number 75/481,117

Request for Reconsideration

Cecelia M. Perry for Matsui International Co., Inc.

Julie Clinton Quinn, Trademark Examining Attorney, Law
Office 107 (Thomas Lamone, Managing Attorney).

Before Hanak, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Matsui International Co., Inc. (applicant) seeks
reconsideration of this Board's decision of July 27, 2001
wherein the Board affirmed the Examining Attorney's
refusal to register applicant's mark UNIMARK for "heat
transfer labels" based on the fact that use of this mark
would be likely to cause confusion with the identical
mark UNIMARK previously registered for, among other
goods, "self-adhesive unprinted labels." Registration No.
1,732,953.

Virtually all of applicant's Request for

Reconsideration is devoted to arguing that there is no proof that heat transfer labels and self-adhesive unprinted labels

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are related. However, what applicant's Request for Reconsideration fails to address is the fact that its mark is identical to the previously registered mark. As this Board noted at page 2 of its decision of July 27, 2001, when the marks in question are identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)(emphasis added).

However, as applicant itself concedes at page 5 of its brief and again at page 3 of its Request for Reconsideration, the same consumers, such as manufacturers of t-shirts, could purchase and use both applicant's UNIMARK heat transfer labels and registrant's UNIMARK self-adhesive unprinted labels. Said manufacturers of t-shirts would place registrant's UNIMARK self-adhesive labels on the t-shirts while they are in the process of being manufactured for, to use

applicant's own words, "the purpose of organization or routing." (Applicant's brief page 5). Of course, the same manufacturers of t-shirts could order from applicant UNIMARK heat transfer labels to place graphics on the t-shirts. Moreover, as noted at page 4 of our decision,

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it would not be at all implausible for a manufacturer of t-shirts to use registrant's self-adhesive unprinted labels, with the manufacturer's wording added, on the packaging for the t-shirts. Indeed, a manufacturer of t-shirts could well affix registrant's UNIMARK self-adhesive labels on the t-shirts themselves to convey the size, material (e.g. 100% cotton) or price of the t-shirts. The ultimate consumer would then remove the label before wearing the t-shirt.

In short, we find that even if we assume for the pure sake of argument that heat transfer labels and self-adhesive unprinted labels are not closely related goods, they are at least somewhat related goods. Given the fact that applicant seeks to register the identical mark previously used by registrant, this is sufficient for a finding of likelihood of confusion. Shell Oil Co., 26

USPQ2d at 1689. See also In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Contrary to applicant's assertion at page 2 of its Request for Reconsideration, this Board did not base its finding of likelihood of confusion simply on the fact that applicant's identification of goods and registrant's identification of goods both contained the word "labels." This Board is not pleased with applicant's

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statement at page 2 of its Request for Reconsideration that the Board's "reasoning would result in outrageous conclusions such as garden hose and panty hose being related."

Decision: The Request for Reconsideration is denied.

