

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Holsted Marketing Inc.

Serial No. 75/503,362

Gerard F. Dunne for Holsted Marketing Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 16, 1998, the above-identified applicant applied to register the mark "FITTING PROMISE" for "hosiery," in Class 25, based on a claim of use of the mark in connection with these goods in interstate commerce since July 18, 1985. The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, as applied to hosiery, so resembles the mark shown below,

promise

which is registered¹ for "corsets, girdles, brassieres, and combinations of brassieres and girdles," that confusion is likely.

Applicant responded to the refusal to register with argument that confusion is not likely, contending that the term "promise" is weak in trademark significance as a result of its use by "many companies." Applicant submitted information from the U.S. Patent and Trademark Office database listing four third-party registrations for marks which consist of or include the word "promise" for a variety of goods and services. These marks are as follows: "PROMISE" for "underpants worn with incontinence pads"; "THE CHAMPION PERFORMANCE PROMISE" and design, for unspecified goods²; "PROMISE KEEPERS" for "printed matter, namely spiritual and educational brochures, pamphlets, books and training manuals for use in homes, churches and conferences," as well as "clothing, namely jackets,

¹ Reg. No. 577,085, issued to Poirette Corsets, Inc. on July 7, 1953. Combined affidavit under Sections 8 and 15 of the Act; Second renewal; Current owner is shown as Bestform Foundations, Inc., a Delaware corporation.

sweatshirts and sweatpants, sweaters, tee-shirts, golf shirts, polo shirts and caps"; and "I PROMISE TO DO MY BEST" and design for "specialty gift items of clothing, namely sweatshirts, T-shirts and caps, to serve as incentives, rewards and reminders to reinforce and encourage children."

The Examining Attorney was not persuaded by this evidence or applicant's arguments to withdraw the refusal to register. With his second Office Action, he repeated the refusal and made it final.

Applicant timely filed a Notice of Appeal, followed by applicant's appeal brief. The Examining Attorney identified above was then assigned this application. He requested suspension of action on the appeal and remand of the application to him in order to supplement the record with evidence that lingerie and foundation garments are commercially related to hosiery. His request for remand was granted by the Board, so he issued a new Office Action and submitted materials to show that the respective goods listed in this application and in the cited registration are often made by the same manufacturer and sold under the

² The second page of the entry for this registration, where the goods would be listed, was not included in applicant's submission.

identical or similar marks. Based on these materials, he concluded that a relationship exists between the goods specified in the application, hosiery, and the goods listed in the cited registration, corsets, girdles, brassieres and combinations of brassieres and girdles, such that in view of the similarity of these marks, confusion is likely.

The materials submitted with this Office Action included third-party registrations wherein the goods include hosiery, brassieres, coursets and/or girdles, and excerpts from three retail mail-order catalogues wherein these products are promoted together. Based on this additional evidence, the Examining Attorney maintained the refusal to register.

Applicant responded with argument that confusion is not likely in view of the third-party registration of "PROMISE" for underpants worn with incontinence pads. Applicant also alleged that applicant had owned a previous registration, No. 1,416,002, which coexisted with the cited registration without causing any confusion, although applicant made this argument without submitting any evidence in support of it.

The Examining Attorney pointed out that if applicant had once owned a registration that is no longer in effect,

such registration could not be the basis for claiming any rights in the mark now.

In view of the fact that applicant had already filed its brief on appeal, the application file was returned to the Board for resumption of action on the appeal. The Board resumed action on the appeal and allowed applicant the opportunity to file a supplemental brief in view of the additional evidence submitted by the Examining Attorney. Applicant did so, and the Examining Attorney then filed his appeal brief. Applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether confusion is likely between applicant's mark, "FITTING PROMISE," for hosiery, and the registered mark

promise

for corsets, girdles, brassieres, and combinations of brassieres and girdles. Based on careful consideration of the record before us, we conclude that confusion is likely because the marks are similar and the goods are commercially related.

We agree with the Examining Attorney that while applicant maintains that the goods are unrelated and

different, the materials made of record by the Examining Attorney clearly show that hosiery and foundation garments are often made by the same manufacturer and are sold under identical or similar marks. Retail sellers feature these items in the same places in their catalogs. Based on these materials, it is clear that hosiery and foundation garments are related in such a way that if similar marks are used thereon, confusion is likely.

We find the marks in the case at hand to be similar enough to each other that their use in connection with these related goods is likely to cause confusion. Applicant's mark is "FITTING PROMISE" and the registered mark is essentially "promise." As the Examining Attorney points out, merely adding a word to a registered mark is usually not sufficient to overcome the likelihood of confusion. In re Corning Glass Works, 229 USPQ 65 (TTAB 1985). The addition of the word "FITTING" does not change the meaning of the word "PROMISE" in applicant's mark, nor does it create a commercial impression, when used in connection with the goods specified in the application, which is very different from the one created by "promise" alone in the registered mark.

Applicant's argument that "PROMISE" is weak in source-identifying significance as a result of use by third

parties is not well taken. Third-party registrations, by themselves, are entitled to little weight on the issue of likelihood of confusion. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). They are not evidence of what happens in the marketplace or that the public is familiar with the use of the marks therein. National Aeronautics and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975). In the case at hand, most of the registrations argued by applicant are for goods other than clothing or for unrelated services. Additionally, most of these marks use the term "promise" as a portion of a mark which in its entirety creates a substantially distinct commercial impression from either applicant's mark or the cited registered mark. For example, "PROMISE KEEPERS" and "I PROMISE TO DO MY BEST" engender commercial impressions which are quite different from those of either "promise" or "FITTING PROMISE." As to the registration for "PROMISE" for underpants worn with incontinence pads, we agree with the Examining Attorney that these goods are specialized products which deal with a medical condition, rather than ordinary apparel items such as hosiery and foundation garments which are purchased by ordinary consumers without regard to bladder control problems. In any event, the previous decision by the Examining Attorney to register the

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mark in that application is not binding upon the agency or this Board. In re National Novice Hockey League, Inc., 222 USPQ 638, 641 (TTAB 1984).

In summary, confusion is likely in the instant case because the mark sought to be registered is similar to the mark in the cited registration, and the goods specified in the application are commercially related to those set forth in the registration.

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