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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jose y Carlos Romano Hnos, SA.

Serial No. 75/787,161

John R. Crossan of Chapman and Cutler for Jose y Carlos Romano Hnos, SA.

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

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

Opinion by Cissel, Administrative Trademark Judge:

On June 27, 1999, applicant filed the above-referenced application to register the mark shown below



on the Principal Register for "clothing," in International Class 25. The basis for filing the application was applicant's assertion that it possessed a bona fide

intention to use mark in commerce in connection with the identified goods.

In addition to requiring a more definite identification-of-goods clause and a disclaimer of the descriptive term "JEANS," apart from mark as shown, the Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that if applicant's mark were to be used in connection with clothing, it so resembles the mark shown below,



which is registered¹ for "wearing apparel for men, women, children and infants-namely, infants' two piece coordinated sets consisting of tops with bloomers or tailored shorts, shorts, slacks, knit and woven tops, overalls, bib overalls with snap crotch, romper sets, sunsuits with ruffled seats, and sunsuits; children's tops, shorts, slacks, bib overalls with snap crotch, overalls, sun dresses, sunsuits, sunsuits with ruffled seats, romper sets, two piece coordinated sets consisting of tops with bloomers or tailored shorts,

¹ Reg. No. 1,140, 430, issued on the Principal Register to Stone manufacturing That Co., a South Carolina corporation, on Oct. 14, 1980, and subsequently renewed.

athletic tops and shorts; ladies' and girls' lingerie, including gowns, lingerie sets, half slips, slips, panties, sleep shirts, pajama sets, camisole tops and robes; men's underwear, including boxers and tailored shorts and men's athletic wear-namely, track, athletic and running shorts, sport tops and warm-up jackets," that confusion would be likely. He reasoned that the dominant portion of the mark applicant seeks to register is the same word that is the registered mark in its entirety, and that the goods with which applicant intends to use the mark are either the same as, or are closely related to, the goods specified in the cited registration.

Applicant responded to the first Office Action with a disclaimer of the word "JEANS" apart from the mark as shown and argument on the issue of likelihood of confusion, but applicant did not address the requirement for a more definite identification-of-goods clause. In support of applicant's contention that confusion with the cited registered mark would not be likely, applicant submitted a listing obtained from the United States Patent & Trademark Office's Trademark Text and Image Database of seventy-one registered trademarks and forty-one marks for which applications to register had been filed. Each of these marks includes the word "STONE," and, although the goods

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listed in the various applications and registrations are not specified, all are designated as being in Class 25. The clothing items specified in the application, as subsequently amended, and those listed in the cited registration are also classified in Class 25. Typical examples of these marks are as follows: CAPSTONE, STONEWEAR DESIGNS, STONE BAY, CORNER STONE, BLACKSTONE, GRIND STONE UNIVERSAL, ONE SMOOTH STONE, STONERICH, STONE HAVEN and STONEBRIDGE. These are just the first ten marks on the list. Each mark on applicant's list combines the word "stone" with at least one other term or letter. Applicant took the position that this evidence demonstrates that "stone" is weak and lacks source-identifying significance. Additionally, applicant argued that the mark applicant seeks to register, when considered in its entirety, is not similar to the cited registered mark.

The Examining Attorney advised applicant that its response was incomplete because it did not address the requirement for a more definite identification-of-goods clause, and allowed applicant additional time in which to do so. Applicant timely submitted an amendment to the application, specifying the goods with which it intends to use the mark as follows: "clothing, namely jeans, jackets, vests, shirts, shoes, tennis shoes, boots, belts,

underwear, and accessories for sports and professional wear."

The Examining Attorney found the wording "accessories for sports and professional wear" to be unacceptably indefinite, and additional amendment to specify the commercial names of these goods was required. Applicant's arguments on the issue of likelihood of confusion were considered, but the refusal to register under Section 2(d) the Lanham Act was maintained.

Applicant responded by amending the identification-of-goods clause to the following: "clothing, namely jeans, jackets, vests, shirts, shoes, tennis shoes, boots, belts, and underwear," in Class 25. Along with this amendment, applicant filed a Notice of Appeal from the final refusal to register under Section 2(d) of the Act.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the amendment. He accepted the amended identification of the goods, but maintained the final refusal to register based on likelihood of confusion under Section 2(d). Submitted with this Office Action were copies of third-party registrations obtained from Patent and Trademark Office official records showing that various

businesses have registered their marks for a wide variety of clothing items for men, women and infants.

Applicant timely filed its appeal brief, the Examining Attorney filed his brief on appeal,² and applicant filed a reply brief. Applicant did not request an oral hearing before the Board, so we have resolved this appeal based on the written record and the arguments presented by applicant and the Examining Attorney in their respective briefs.

Based on careful consideration of this record and these arguments, we hold that if applicant were to use the mark it seeks to register on the goods identified in the application, as amended, confusion with the cited registered mark would be likely.

The test for determining whether confusion is, or will be, likely is well settled. In its opinion in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court enunciated a number of factors to be considered in resolving this issue. Chief among them are the similarities between the marks and the similarities between

² Copies of ten third-party registrations of marks which include the word "stone" were attached to applicant's brief. Ordinarily, the Board would not consider such evidence under Trademark Rule 2.142(d), but because the Examining Attorney did not object to its consideration, and in fact addressed its probative value in his brief, we have considered it as if he had stipulated to its admission.

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the goods or services with which they are, or are intended to be, used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Under certain circumstances, a portion of a mark consisting of separate elements can be more significant in creating the commercial impression that the mark engenders than other, less dominant elements. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1988).

The marks are not necessarily going to be compared on a side-by-side basis, but rather are more likely to be encountered at different times and under different circumstances by ordinary consumers, who will not necessarily have perfect memories, but instead will be likely to recall the mark they first encountered in terms of its overall commercial impression. In *re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999).

In the instant appeal, confusion is likely because the mark applicant seeks to register is similar to the cited registered mark and the goods with which applicant intends to use it are closely related to the goods set forth in the cited registration. These marks create similar commercial impressions because the dominant portion of applicant's mark is the same word, "STONE," which is the registered mark in its entirety.

The evidence submitted by the Examining Attorney establishes that consumers have reason to expect that the goods listed in the registration and the goods specified in the application, if sold under the same or similar marks, would emanate from the same source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1983). Applicant makes no persuasive arguments to the contrary.

The case boils down to whether the marks are so similar that confusion would be likely. Where the goods are the same or closely related, in order for confusion to be likely, the marks in question do not need to be as similar as would be the case if the goods were not as close. ECI Division of E Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443 (TTAB `1980). The word "STONE" is the registered mark in its entirety. Although applicant's mark includes a design element and the term "JEANSPHILOSOPHY" in much smaller letters, it is the same term, "STONE," which is the dominant portion of applicant's mark. It is this word, rather than the complex design of an oval with a sideways chevron design or the coined term "JEANSPHILOSOPHY" presented beneath "STONE" and in smaller letters than those in which "STONE" is shown, that is the most discernible part of the mark, the part that will be most easily remembered and used to call for or to recommend

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the goods. Prospective purchasers who are familiar with clothing sold under the registered "STONE" mark would, upon encountering applicant's clothing products under the mark here sought to be registered, be likely to assume, erroneously as it would turn out to be, that the same source is responsible for all such goods.

Applicant's arguments to the contrary are not persuasive. The pending and registered marks listed as being in Class 25 in the response to the first Office Action do not show "weakness" of the word "STONE" as an indicator of source for clothing. Even if we knew what the Class 25 goods were that are listed in these registrations, the marks themselves all create commercial impressions which are substantially different from that created by the registered mark cited as a bar to registration of applicant's mark. The same is true for the marks in the registrations which applicant attached to its brief.

"STONE TARLOW SIGNATURES," "STONE HARBOR," "STONE WOLF VINYARDS" and "STONE MOUNTAIN," for example, are no more similar to each other than they are to the cited registered mark. The existence of these registrations hardly justifies registering applicant's mark over the cited registered mark.

There is no evidence in support of applicant's argument that confusion is not likely because its mark connotes "softness," or, for that matter, that the connotation of the word "STONE" is different in applicant's mark from the connotation it has in the cited registered mark.

Because the mark applicant seeks to register is similar to the cited registered mark and because the goods with which applicant intends to use it are closely related to the goods set forth in the cited registration, confusion would be likely.

We have no doubt that confusion would be likely if applicant were to use the mark it seeks to register in connection with the goods specified in the amended application, but even if we did have some doubt, it would have to be resolved in favor of the registrant and prior user, and against applicant, who, as the second comer, had a duty to select a mark which is not likely to cause confusion with a mark already in use in its field of commerce. In re Hyper Shoppes (Ohio) Inc., 837 F2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

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