THE CONCERT TEE
85/684,551
Office Action Response

DISCLAIMER

In the present Office Action, the Examining Attorney requested that Applicant disclaim the wording "TEE" apart from the mark as shown. Applicant hereby submits the following standardized disclaimer:

> No claim is made to the exclusive right to use "TEE" apart from the mark as shown.

REQUEST FOR INFORMATION

In the present Office Action, the Examining Attorney requested that Applicant provide information about the nature of Applicant's goods. Applicant hereby submits the following product information and materials:

Product Information – Applicant does not sell its goods at concerts. Instead, Applicant sells its goods directly to its various customers (i.e., screen printers, embroiderers, promotional products distributors, etc.). Applicant sometimes advertises its goods using taglines such as "this tee has lived a little and knows how to rock," "looking like a star has never been so easy," "this tee rocks with comfortable softness," "be your own groupie in this soft essential," and "keep the beat going in this soft v-neck."

Product Materials – *See* pages from Applicant's catalog, which are attached as Exhibit A and made a part hereof by this reference.

LIKELIHOOD OF CONFUSION

In the present Office Action, the Examining Attorney refused registration of Applicant's mark, THE CONCERT TEE ("Applicant's Mark") for "clothing, namely, t-shirts, shirts, and tops," under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). The refusal is based on a likelihood of confusion between Applicant's Mark and the following registered mark (the "Registered Mark"):

Mark – CONCERT BRA
Reg. No. – 4,162,345
Owner – Retail Royalty Company ("Registrant")
Goods – Bras in Class 25

The Examining Attorney stated that Applicant's Mark may also be refused registration based on a likelihood of confusion between Applicant's Mark and the following pending marks (collectively, the "Pending Marks"):

Mark – CONCERT BY CLARE & Design
Serial No. – 85/548,489
Owner – Sung Su John Kang
Goods – Bottoms; dresses; footwear; headwear; jackets; tops.

Mark – CONCERT
Serial No. – 85/495,043
Owner – General Cigar Co., Inc.
Goods – Cigar bands in Class 16; Hats; shirts; jackets in Class 25; Cigars, cigar accessories, namely, cigar boxes, cigar cutters, cigar cases, not of precious metal, humidors, cigar lighters and ashtrays in Class 34.

Applicant respectfully disagrees with the Examining Attorney's position, and submits that there is no likelihood of confusion between Applicant's Mark on the one hand, and the Registered Mark and the Pending Marks (collectively, the "Cited Marks") on the other.

In assessing a likelihood of confusion, the courts have repeatedly said, "it is the duty of the examiner * * * to find, upon consideration of *all* the evidence, whether or not confusion appears likely." *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (CCPA 1973) (emphasis in original).

In the present case, consideration of *all* the evidence indicates that confusion between Applicant's Mark and the Cited Marks is unlikely, and favors allowing Applicant's Mark to proceed to publication. Applicant's Mark and the Cited Marks are different in sound, appearance, and connotation and do not project the same commercial impression. This is evident by the fact that Applicant's Mark, the Cited Marks, and other third party "CONCERT" marks have coexisted in the marketplace and/or on the Register, and to Applicant's knowledge, there have been no instances of actual confusion. Even if Applicant's Mark and the Cited Marks were found to be similar (which they are not), trademark law makes clear that even similar marks used for allegedly similar goods do not result in confusion where the respective marks convey different connotations and do not project the same commercial impression, as is the case here. In addition, Applicant's goods and Registrant's goods are sufficiently different to avoid consumer confusion.

A. Applicant's Mark and the Cited Marks Are Different in Sound, Appearance, and Connotation and Do Not Project the Same Commercial Impression.

When comparing Applicant's Mark and the Cited Marks in their *entireties*, it is clear that they are different in sound, appearance, and connotation and do not project the same commercial impression.

With respect to the Registered Mark, the Examining Attorney found that Applicant's Mark and the Registered Mark are similar in sound, appearance, connotation, and commercial impression. To support this finding, the Examining Attorney stated that the respective marks are both comprised either in whole or significant part of the term "CONCERT." The Examining Attorney claimed that the term "TEE" in Applicant's Mark and the term "BRA" in the

Registered Mark are descriptive of the parties' respective goods, and as a result, are of less trademark significance than the term "CONCERT." The Examining Attorney also claimed that the inclusion of the term "THE" in Applicant's Mark will generally not affect or otherwise diminish the overall similarity between the respective marks. Applicant disagrees with the Examining Attorney's position for the reasons discussed below.

With respect to all of the Cited Marks, as acknowledged by the Examining Attorney in the Office Action, the determination of whether a likelihood of confusion exists must be based on a comparison of the marks in their entireties. *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (CCPA 1974); Trademark Manual of Examining Procedure ("TMEP") 1207.01(c)(ii).

Applicant's Mark is THE CONCERT TEE, while the Registered Mark is CONCERT BRA, and the Pending Marks are CONCERT BY CLARE & Design and CONCERT. While the respective marks all contain the term "CONCERT," they also all contain different and/or additional wording and/or design elements, which distinguishes each of the marks from each other. When saying each mark out loud, the different wording contained in the respective marks causes them to have noticeably different sounds. When the marks are written out and compared in their entireties, the different wording and/or design elements contained in the respective marks creates clear visible differences, as depicted below.

Applicant's Mark: THE CONCERT TEE

Registered Mark: CONCERT BRA

Pending Marks:

CONCERT

Applicant's use of different and additional wording, namely, the terms "THE" and "TEE," differentiates Applicant's Mark from the Cited Marks in both sound and appearance. This is true regardless of the Examining Attorney's attempt to downplay the trademark significance of the term "THE" at the beginning of Applicant's Mark, or if Applicant has disclaimed the term "TEE." A disclaimer does not remove disclaimed matter from a mark, and the Examining Attorney must still regard Applicant's Mark in its entirety. *See, e.g., In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (CCPA 1965); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991). Applicant's disclaimer of the term "TEE" may not properly have any effect on the Examining Attorney's determination of whether a likelihood of confusion exists between the respective marks in their entireties. *See*

In re RSI Sys., LLC, 88 USPQ2d 1445, 1448 (TTAB 2008) (finding voluntary disclaimer of "RSI" has no legal effect on the issue of likelihood of confusion because it is not a weak term). TMEP 1213.01(c).

In re Diane R. Gunter (TTAB 2010) is instructive and demonstrates how the Trademark Trial and Appeal Board ("TTAB") compares marks in their entireties when determining whether a likelihood of confusion exists. In *Gunter*, the Examining Attorney refused registration of the mark WISH YOU WERE HERE for underwear in Class 25 based on a likelihood of confusion with the registered mark WISH YOU WERE HERE! LOVE, JETSY & Design for women's dresses, shirts, skirts, and apparel in Class 25. The Examining Attorney argued that confusion was likely because both marks contained the dominant wording "WISH YOU WERE HERE." The Examining Attorney also argued that the substantial similarities in sound, appearance, connotation, and commercial impression between the marks outweighed any differences created by the use of additional wording and design elements in the registered mark. The TTAB disagreed with the Examining Attorney's position and found that such additional wording and design elements created significant differences between the respective marks when compared in their entireties. Accordingly, the TTAB reversed the refusal to register applicant's mark.

Similarly in the present case, while the respective marks all contain the term "CONCERT," they also all contain different and/or additional wording and/or design elements, which create significant differences between the marks when compared in their entireties. The additional terms "THE" and "TEE" contained in Applicant's Mark create a mark that is totally dissimilar in both sound and appearance from each of the Cited Marks. Therefore, Applicant's Mark and the Cited Marks are not confusingly similar, but rather they are distinguishable from each other and do not project the same commercial impression.

In addition to being different in sound, appearance, and commercial impression, Applicant's Mark and the Cited Marks convey different connotations to consumers. "In determining the meaning and connotation which the trademark projects, it is proper to look to the context of use such as material on labels, packaging, advertising and the like." 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:26.

Applicant's Mark is THE CONCERT TEE, which conveys to customers that they are buying casual outerwear clothing that has a classic and signature look, can be easily cared for, and is made from vintage-style material for added comfort and softness. Applicant sometimes advertises its t-shirts, shirts, and tops using taglines such as "this tee has lived a little and knows how to rock," "looking like a star has never been so easy," "this tee rocks with comfortable softness," "be your own groupie in this soft essential," and "keep the beat going in this soft v-neck." *See* Exhibit A.

In contrast, the Registered Mark is CONCERT BRA, which conveys to consumers that they are buying undergarments that are showy, revealing, and meant to stand out in a crowd (such as in a crowd at a concert). *See* pages from Registrant's website and Registrant's specimen of use as submitted with the U.S. Patent and Trademark Office ("USPTO"), which are attached as Exhibit B and made a part hereof by this reference. The Pending Marks are CONCERT BY CLARE & Design and CONCERT, each of which conveys different connotations to consumers

as well. CONCERT BY CLARE & Design conveys a particular person's name, together with a treble clef, as on sheet music, and thus suggests that this person is the "concertmaster" or "conductor" of the various clothing sold under the mark. *See* drawing as submitted with the USPTO, which is attached as Exhibit C and made a part hereof by this reference. CONCERT conveys the perfect harmony of flavor and body found in the cigars associated with the various clothing sold under the mark (just like when the singer is in harmony with the band at a concert). *See* web pages, which are attached as Exhibit D and made a part hereof by this reference. Moreover, to the extent such clothing is marketing for like-branded cigar products, that clothing is likely only directed toward purchasers who are already familiar with the cigar brand

GA Peach Buns, Inc. v. Voucia Corporation (TTAB 2010) is instructive and shows how the TTAB determines whether a likelihood of confusion exists in cases where the meaning and connotation of a term is clearly different as applied to the respective goods. In *GA Peach Buns*, the owner of the registered mark PEACH BUNS for clothing, namely swimwear, wraps, tops, coverups, skirts, shorts, dresses in Class 25 opposed applicant's application for the mark PEACH CLAIRE for lingerie in Class 25. The TTAB found the respective marks to be distinguishable from each other in meaning, and as a result, dismissed the opposition.

> The marks are similar in sound and appearance to the extent that they share the word PEACH, but the words BUNS and CLAIRE have nothing in common. The addition of those words significantly changes the meanings the marks as a whole convey and as a result, the marks create different, unitary commercial impressions. PEACH BUNS is a slang expression suggesting revealing clothing or an attractive body part, while PEACH CLAIRE suggests a particular individual or an individual's name. To the extent that the marks have some aural and visual similarities, we find that the differences between the marks as a whole in terms of their meaning and commercial impression are sufficient to outweigh those similarities.

Id. at 13. The TTAB's finding in *GA Peach Buns* is precisely on point and should be applied in the present case as well. Applicant's Mark and the Cited Marks may share the term "CONCERT," but the parties' different and/or additional wording and/or design elements have nothing in common (i.e., Applicant's use of THE and TEE v. the other parties' use of BRA, BY CLAIRE, and/or music-related design elements, etc.). Applicant's use of the different and additional terms "THE" and "TEE" is such that Applicant's Mark in its entirety conveys a completely different meaning from those conveyed by the Cited Marks and as a result, the respective marks do not project the same commercial impression.

In re Park Lane Shoes Limited (TTAB 2011) is also instructive and on point. In *Park Lane*, the Examining Attorney refused registration of the mark PARK LANE for, in part, articles of clothing for men, women, and children, namely, tops, bottoms and jackets; footwear; belts in Class 25. The refusal was based on a likelihood of confusion with the registered mark PARK AVENUE (Stylized) for women's hosiery and footwear in Class 25. Despite the fact that the respective marks shared the term "PARK" and the parties' respective goods were identical as to

footwear in Class 25, the TTAB still reversed the refusal to register applicant's mark. The TTAB found that when the marks PARK LANE and PARK AVENUE were compared in their entireties, they took on different meanings and commercial impressions. This decision demonstrates that these findings apply even when PARK was combined with common (and arguably descriptive) words such as LANE and AVENUE.

Likewise in the present case, despite the fact that Applicant's Mark and the Cited Marks share the term "CONCERT" and some of the parties' respective goods may overlap, the marks still take on different meanings and commercial impressions when compared in their entireties. Therefore, consumer confusion is unlikely.

Applicant's Mark and the Cited Marks are different in sound and appearance. In addition, the parties' respective marks convey very different connotations to consumers. Compared in their entireties and placing appropriate emphasis on their differences, it is clear that the respective marks do not project the same commercial impression, which favors a finding of *no* likelihood of confusion.

B. Applicant's Mark, the Cited Marks, and Other Third Party "CONCERT" Marks Have Coexisted in the Marketplace and/or on the Register.

In support of the likelihood of confusion refusal, the Examining Attorney stated that Applicant's Mark and the Registered Mark are both comprised either in whole or significant part of the term "CONCERT." However, in this case, it is irrelevant that Applicant's Mark or any of the Cited Marks share the term "CONCERT." As discussed above, the respective marks when compared in their entireties do not convey the same connotations or meanings and do not project the same commercial impression, regardless of whether they share similar wording. Trademark law makes clear that even when applied to identical or related goods, marks containing identical or similar wording may convey sufficiently different connotations and meanings and/or create sufficiently different commercial impressions so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear, with the term being suggestive of sportswear that "crosses over" the line between informal and more formal wear when applied to lades' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color, and durability adapted to outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature," when applied to men's underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase "Drink Up" when applied to men's suits, coats, and trousers, but does not have this connotation when applied to ladies' and children's underwear). In the present case, as discussed above, because Applicant's Mark and the Cited Marks convey different connotations and meanings and do not project the same commercial impression, there is no likelihood of confusion. This is also evident by the fact that the respective marks have coexisted in the marketplace, and to Applicant's knowledge, no instances of actual confusion have taken place.

As indicated by the various cases referenced above, the USPTO and the courts have allowed marks containing identical or similar wording to coexist on the Register in connection with identical or related goods. Likewise, here the USPTO has allowed the Registered Mark and other third party "CONCERT" marks to coexist on the Register in connection with various goods covered in Class 25. Some examples of the third party "CONCERT" marks are listed below.

- CONCERT CHICK for denims; halter tops; hats; hooded sweat shirts; knit shirts; lingerie; lounge pants; pajamas; short-sleeved or long-sleeved t-shirts; sleep shirts; sweat jackets; sweat pants; t-shirts; tank tops; under garments; yoga pants; yoga shirts (Reg. No. 3,706,155)
- CONCERT CHICK PRODUCTS for short-sleeved or long sleeved t-shirts, baseball caps, crop tops, t-shirts, tank tops (Reg. No. 3,640,861)
- CONCERT SEASON: for wearable garments and clothing, namely, shirts (Reg. No. 3,792,481)
- CONCERTO for women's jackets of woven fabrics (Reg. No. 3,517,369)
- VINTAGE CONCERT for shirts; t-shirts (Reg. No. 3,971,247)
- THE CONCERT CHANNEL PRESENTS for apparel, namely, caps, t-shirts and shirts (Reg. No. 3,636,756)
- LEGENDS IN CONCERT for clothing, namely, t-shirts, sweat shirts, polo shirts, hats and jackets (Reg. No. 3,205,284)
- SMOKIN' COUNTRY CONCERT for men's, women's and children's clothing, namely, shirts, pants, shorts, jackets, sweaters, hooded sweaters, zippered sweaters, sweatpants, swimwear, visors (Reg. No. 4,274,181)
- TCC CONCERTCENTRAL ON DEMAND for clothing, namely, caps and shirts (Reg. No. 3,573,913)
- STARS IN CONCERT & Design for clothing, namely, t-shirts, sweatshirts, jackets, and caps (Reg. No. 2,541,241)
- WALT DISNEY CONCERT HALL for shirts (Reg. No. 3,042,408)

The number of third party "CONCERT" marks coexisting on the Register in connection with various goods covered in Class 25 suggests that it is a crowded field of marks. *See* U.S. Certificates of Registration for the above-listed "CONCERT" marks, which are attached as Exhibit E and made a part hereof by this reference.

In re ASICS Corporation (TTAB 2010) is instructive and illustrates how the TTAB may treat evidence consisting of numerous third party filings in a crowded field of marks. In *ASICS*, the Examining Attorney refused registration of the mark LEG BALANCE for athletic apparel, namely, shirts, singlets, jackets, shorts, tights, running suits, bras, briefs and socks in Class 25 (including a disclaimer of LEG apart from the mark as a whole) based on a likelihood of confusion with the registered mark FOOT BALANCE for leather boots and shoes in Class 25. Applicant argued that "BALANCE" is a highly suggestive term in connection with both its athletic apparel and registrant's leather shoes and boots. In support of its position, applicant submitted copies of eight third party registrations for various "BALANCE" marks, including NEW BALANCE, BODY BALANCE, AIR BALANCE, ORTHO BALANCE, THIRD BALANCE, DRI-BALANCE, POWER BALANCE, and BIRKO BALANCE, all covering athletic apparel and/or footwear in Class 25. The TTAB reversed the refusal to register

applicant's mark because it found, in part, that due to the number of third party registrations for marks containing the term "BALANCE," the scope of protection for the registered mark was narrowed in the fields of athletic apparel and/or footwear in Class 25.

> They demonstrate that there exist on the register several two-word marks with BALANCE as the second word for goods which are either identical to applicant's and registrant's respective goods or closely related thereto. The coexistence on the register of so many similar marks for related and similar goods suggests that BALANCE is either highly suggestive or ubiquitous in connection with these goods; and that the differing first word in each mark is sufficient to distinguish the marks from each other.
>
> In view thereof, we find that, when compared in their entireties, the examining attorney has not established that the marks are sufficiently similar to support a conclusion of likelihood of confusion even if the goods had been found to be related. This du Pont factor weighs against a finding of likelihood of confusion.

Id. at 10. This finding is precisely on point and should be applied to the present case as well. Due to the number of third party registrations for marks containing the term "CONCERT," the Registered Mark (and the Pending Marks, if and when they achieve registration) should be restricted to a narrow scope of protection in connection with various goods covered in Class 25. The coexistence on the Register of so many "CONCERT" marks for various goods covered in Class 25 suggests that it is a crowded field of marks. As a result, the different and/or additional wording and/or design elements contained in Applicant's Mark and the Cited Marks is sufficient to distinguish the marks from each other, which favors a finding of *no* likelihood of confusion.

C. <u>Applicant's Goods and Registrant's Goods Are Sufficiently Different To Avoid Consumer Confusion.</u>

The Examining Attorney found that the identifications of clothing items in Applicant's goods and Registrant's goods evidence the relationship between them. To support this finding, the Examining Attorney stated that any goods in Registrant's normal fields of expansion must be considered to determine whether Registrant's goods are related to Applicant's goods under Section 2(d). The Examining Attorney's theory is excessively broad and creates a slippery slope in which a registration covering a specific type of clothing item in Class 25 could effectively block an application covering any of a vast array of unrelated goods in Class 25. Furthermore, the evidence provided by the Examining Attorney, namely, third party registrations covering the same or similar goods as those of both Applicant and Registrant, does not support such an overly broad conclusion, nor does it show that the parties' respective goods are likely to cause consumer confusion when used with their respective marks. However, the Examining Attorney relied on such evidence to come to the erroneous conclusion that Applicant's goods and Registrant's goods are of a kind that may cause consumers to think they emanate from a single source under a single mark.

When determining whether a likelihood of confusion exists, the Federal Circuit Court has stated, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). Therefore, the Examining Attorney's overly broad theoretical possibility of confusion described above, including the statement that any goods in Registrant's normal fields of expansion must be considered to determine whether Registrant's goods are related to Applicant's goods under Section 2(d), should not be a factor when determining whether a likelihood of confusion exists in the present case. In the practicalities of the commercial world, the question of likelihood of confusion must be determined based on an analysis of the goods recited in Applicant's application versus the goods recited in Registrant's registration. *See, e.g., Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

The goods recited in Applicant's application are as follows:

> "Clothing, namely, t-shirts, shirts, and tops."

The goods recited in Registrant's registration are as follows:

> "Bras."

Except for both being included in the very broad field of goods covered in Class 25, the goods recited in the parties' respective trademark filings have nothing in common. As discussed below, they serve very different purposes, which is sufficient to ensure that consumers will not be confused as to the source of the respective goods.

Trademark law makes clear that there is no *per se* rule governing likelihood of confusion in cases involving clothing items. *See, e.g., In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (shoes and men's underwear); *In re Shoe Works*, 6 USPQ2d 1890, 1891 (TTAB 1988) (women's shoes and men's, women's and children's shorts and pants). Along these lines, *The H.D. Lee Company, Inc. v. Maidenform, Inc.* (TTAB 2008) is instructive. In *H.D. Lee Company*, the owner of the registered mark ONE TRUE FIT for clothing, namely non-leather coats, shorts, shirts, blazers, non-leather jackets, skirts, jeans, and pants in Class 25 opposed applicant's application for the mark ONE FAB FIT for foundation garments, panties, brassieres, underwear, briefs, body briefers, body suits, shapewear, girdles, camisoles, women's undergarments, and women's intimate apparel namely, sleepwear, lingerie, and slippers in Class 25. Despite the similarities between the respective marks, the TTAB dismissed the opposition because although applicant's outerwear and registrant's undergarments are both clothing, the TTAB found the parties' respective goods to be different types of clothing, having different purposes.

> [T]here is nothing in this record that allows us to conclude that women consider undergarments as part of an ensemble including coats, shorts, shirts, blazers, jackets, skirts, jeans, or pants, and that

> undergarments and outerwear are considered complementary products. Moreover, we find that the fact that the products of the parties are sold in different sections of department stores underscores their differences (*e.g.*, there is no evidence or testimony that, in the same shopping trip, women buy underwear to go with their jeans).

Id. at 23. The TTAB's finding in *H.D. Lee Company* is on point and should be applied in the present case as well. Although Applicant's outerwear consisting of t-shirts, shirts, and tops and Registrant's undergarments consisting of bras are both clothing, they are *different types* of clothing, having different purposes. Furthermore, the Examining Attorney's evidence in the form of third party registrations covering the same or similar goods as those of both Applicant and Registrant does not show that the parties' respective goods are related in such a way that consumers would believe they emanate from the same source, even if sold under a similar mark.

In re Forsyth of Canada, Inc. (TTAB 2004) is also instructive. In *Forsyth*, the Examining Attorney refused registration of the mark EXPAND-A-COLLAR (Stylized) for men's shirts in Class 25 based on a likelihood of confusion with the registered marks EXPAND-A-WAIST for women's apparel, namely, pants in Class 25 and EXPAND-A-BAND for hats in Class 25. The TTAB reversed the refusal and found that there was no likelihood of confusion. While the parties' respective marks were similar, the TTAB found that "although men's shirts, women's pants and hats are clothing items that travel in the same trade channels to the same classes of consumers, each item is specifically different." Moreover, the Examining Attorney's evidence in the form of third party registrations showing that entities have adopted a single mark for all of the types of clothing involved did not convince the TTAB that the parties' respective goods were related in a way that would cause consumer confusion. Similarly, in the present case, Applicant's goods and Registrant's goods are specifically different and the Examining Attorney's evidence is not convincing in showing that the parties' respective goods are related in a way that will cause consumer confusion.

This concept was again demonstrated and confirmed in *In re Gelati International, Inc.* (TTAB 2000). In *Gelati*, the Examining Attorney refused registration of the mark U.S. SPORTS GEAR for men's, ladies', and children's clothing; namely, underwear, sleepwear, and lingerie in Class 25 based on a likelihood of confusion with the registered marks US SPORTS for footwear and clothing, namely sweatshirts in Class 25 and US SPORTS for footwear having an upper portion made of canvas or other man made material, such as sneakers and the like in Class 25. The TTAB reversed the refusal because, in part, the Examining Attorney failed to show that applicant's goods and registrant's goods were in anyway related other than being included in the extremely broad field of apparel.

> Given the fact that the only relationship between applicant's goods and registrant's goods is that they all are items within that broad category of goods known as apparel, we hold that the marks would have to be identical or extremely similar in order for there to exist a likelihood of confusion. Put quite simply, we find that the

> presence of the word GEAR in applicant's mark is sufficient to distinguish it from registrant's mark.

Id. at 4. The same is true in the present case as well. Applicant's goods and Registrant's goods are not related simply because they are both included in the very broad category of clothing covered in Class 25. Modern consumers of clothing products will not confuse the parties' respective goods just because they fall into the same broad field. Moreover, even if Applicant's goods and Registrant's goods were purchased by the same consumers, the Examining Attorney's evidence fails to show that those consumers would believe the parties' respective goods come from or are associated with the same source.

Because the goods sold under Applicant's Mark and the goods sold under the Registered Mark serve very different purposes and are not related in such a way that consumers would believe they emanate from the same source, Applicant submits that no likelihood of confusion exists between Applicant's Mark and the Registered Mark.

Applicant also submits that no likelihood of confusion exists between Applicant's Mark and the Pending Marks, regardless of whether some of the parties' goods overlap. As discussed above, the differences between Applicant's Mark and the Pending Marks in sound, appearance, connotation, and commercial impression are sufficient to distinguish the marks from each other, which favors a finding of *no* likelihood of confusion.

D. <u>Conclusion.</u>

As discussed above, Applicant's Mark and the Cited Marks are different in sound, appearance, and connotation and do not project the same commercial impression. The field of "CONCERT" marks appears to be crowded, which narrows the scope of protection for the Registered Mark (and the Pending Marks, if and when they achieve registration). In addition, Applicant's goods and Registrant's goods are sufficiently different to avoid consumer confusion. For the foregoing reasons, Applicant requests that the Examining Attorney remove the likelihood of confusion refusal from Applicant's application and approve Applicant's Mark for publication.