

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of: )  
)  
**STEVEN REEVES** )  
)  
Serial No. **88/439,635** ) **Trademark Law Office 121**  
)  
Filing Date: **05/21/2019** )  
)  
)  
For: **BROWNIES** )  
)

Examiner: Hannah Gilbert  
(571) 272-5029

**RESPONSE**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

This communication is responsive to the Office Action dated 08/12/2019.

**AMENDMENT**

In the above referenced Application, please delete the present description of the services and insert the following:

--Wearable garments and clothing, namely, novelty sports jersey shirts having a formal front appearance and a sports jersey back appearance so that the wearer of the shirt when viewed from the front appears dressed in a formal shirt and when viewed from the back appears dressed in a sports jersey, in International Class 25.—

## REMARKS

The Office Action of 08/12/2019 has been carefully considered and reconsideration of this Application is respectfully requested.

### Amendment to Applicant's Description of Goods

Applicant has clarified the description of goods of the Application to read as follows:

--Wearable garments and clothing, namely, , novelty sports jersey shirts having a formal front appearance and a sports jersey back appearance so that the wearer of the shirt when viewed from the front appears dressed in a formal shirt and when viewed from the back appears dressed in a sports jersey in International Class 25.—

### Attorney Bar Information and Attestation

In the Office Action, the Examiner requests that Applicant's Attorney provide his bar membership number, state of bar membership and year of admission to the bar. Applicant's Attorney has been a member of the Minnesota State Bar since 1979 having bar membership number 26025. Further, Applicant's attorney attests that he is an attorney who is an active member in good standing of the bar of the highest court of a US State. Applicant's Attorney will provide this via TEAS.

### SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

In the Office Action, the Examiner found a likelihood of confusion with US Registration Nos. 4547511 for BROWNIE with Design (Owner: Grupo Textil Brownie) and 1435516 for BROWNIE (Owner: Girl Scouts of the United States of America).

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant to the determination of

likelihood of confusion. The relevant factors to be considered in the present case are the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, the relatedness of the goods or services as described in the application and registration(s), the similarity or dissimilarity of established, likely-to-continue trade channels, the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing, the number and nature of similar marks in use on similar goods, similarity and the number and nature of similar marks in use on similar goods.

Applicant believes that confusion is unlikely amongst purchasers of the goods represented by his trademark with the purchasers of Registrant's goods.

**Relatedness of the goods as described in the application and registrations**

**BROWNIE**



U.S. Reg No. 4547511 for **BROWNIE and Design**

**(Owner: Grupo Textil**

**Brownie)** represents the goods "bathing costumes for women; belts; blazers; coats; coats for men and women; crop pants; custom made to measure suits for men and women; denims; dress pants; dresses; footwear; footwear for women; head scarves; headgear, namely, hats and caps; headwear; hooded sweatshirts for women and girls; leotards and tights for women, men and children of nylon, cotton or other textile fibers; men's and women's jackets, coats, trousers, vests; men's suits, women's suits; pants; scarves; shirts, shoes, skirt suits; sleep pants; socks; suits; suspender belts for women; sweatshirts for women and girls; t-shirts for women and girls; vests; women's ceremonial dresses; women's clothing, namely, shirts, dresses, skirts, blouses; women's hats and hoods; women's shoes; women's tops, namely, camis; women's underwear". U.S. Reg No 14355516 for **BROWNIE (Owner: Girl Scouts of America)** represents the goods "sweaters,

shirts, blouses, tee-shirts, ties, jumpers, shorts, slacks, nightshirts, tights, socks, sock flashes, sweatshirts, sweatpants, scarves, hats, headbands, sweatbands and visors”.

The description of Applicant’s goods have been amended to clarify the nature of the goods. Applicant’s goods are novelty jersey shirts wherein each shirt has formal front appearance, for example a button down shirt, and a sports jersey back appearance so that the wearer of the shirt when viewed from the front appears dressed in a formal shirt and when viewed from the back appears dressed in a sports jersey. Applicant’s jersey shirts are not likely to be confused with

**BROWNIE**



clothing bearing the BROWNIE and design mark( ) nor with clothing sold by Girl Scouts of America to their youngest members, namely a troop of Brownie Girl Scouts.

**Dissimilarity of established, likely-to-continue trade channels, the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing**


The purchasing conditions surrounding the purchase of merchandise for a young Girl Scout in a Brownie Troop differ from a sports fan seeking a novelty shirt. The origin of these goods are not likely to be confused because of the established Girl Scouts trade channels and the careful purchasing of the respective buyers. For example, a sports fan wishes to ensure the proper team colors and player number are on their jersey shirt. Whereas a Girl Scout parent or Brownie troop leader is buying merchandise directly from the Girl Scouts for their young troop members. Thus, confusion is unlikely between the buyers of the respective goods.

**Dissimilarity of the Marks: Appearance and Sound**

Applicant’s mark **BROWNIES** is different as to appearance and sound than Registrants’

**BROWNIE**




marks **BROWNIE** and **BROWNIE and design**(  ). As stated in *duPont*, the marks must be compared in their entireties to determine any similarities. Applicant's mark looks and sounds different than Registrants' marks because Applicant's mark has an S at the end of the word BROWNIE.

Further, Applicant's mark looks different than Registrant's mark BROWNIE AND

**BROWNIE**



DESIGN (  ) because of Registrant's design element, namely a light brown dog with black eyes and nose and the word BROWNIE set forth in the color brown.

Thus, Applicant's BROWNIES mark does not appear or sound like Registrants marks and is not deemed confusingly similar.

**Dissimilarity of the Marks: Connotation and Commercial Impression**

In *In re Covalinski*, the TTAB found confusion unlikely between REDNECK RACEGIRL and RACEGIRL because of "crucial differences" in the marks. *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014). The TTAB stated:

"[T]he proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). While we must consider the marks in their entireties, **it is entirely appropriate to accord greater importance to the more distinctive elements in the marks.** See *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). (emphasis added)

Regarding the dominance of the design portion of the REDNECK RACEGIRL mark, the TTAB further stated:

While it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case. In *Viterra*, the Federal Circuit acknowledged this general rule while affirming a Board decision that found the



dominant portion of the registered mark was the literal portion (XSEED) rather than the stylized letter “X” alone, see 101 USPQ2d at 1911; but it also found no inconsistency between the Board’s *Viterra* decision and its earlier decision *in In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009), wherein the Board found no likelihood of confusion between applicant’s standard character mark VOLTA for caffeine-infused vodka and the cited mark (shown below) for wines, **due to the**



TERZA  
VOLTA

**prominent design in the registered mark:** . Serial No. 85685983 7 See also *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966) (confusion was



unlikely between applicant’s mark and several marks owned by opposer consisting of or containing FERRO, due to the **dominance of the design elements of applicant’s mark** and the relatively small typeface in which FERRO appeared);<sup>5</sup> *accord Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (**prominently displayed design considered to be dominant**



BODYMAN

**element of the mark** because it catches the eye and engages the viewer before the viewer looks at the word “Bodyman”); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987) (no likelihood of confusion



between for restaurant services and STEVE’S for ice cream; “Even with the word ‘STEVE’S’ appearing above the hot dog figures, applicant’s mark is distinguishable from the registered

mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”). (**emphasis added**)

The TTAB ultimately found that “the **overall commercial impression of Applicant’s mark is dominated by its design features...and that this weighs heavily against a conclusion that confusion is likely.**” Further, the TTAB stated that “Applicant’s mark is so different from the registered mark that even when used on in-part identical goods, confusion is unlikely.”

Similarly, in this case, Applicant’s BROWNIES mark, is not likely to be confused with

**BROWNIE**



because of the dominance of the design features of the BROWNIE and DESIGN mark, namely a light brown dog with black and brown eyes and nose and the wording BROWNIE appears in brown. The overall commercial impressions of Registrant’s mark is dominated by its design features.

Thus, no confusion is likely due to the significantly different commercial impressions that are created for each of the marks particularly in view of the dominant design portions of the BROWNIE and DESIGN mark.

#### **Number and Nature of Similar Marks on Similar Goods**

Regarding the number and nature of similar marks, the trademark database of the U.S.P.T.O. shows that there are numerous uses of the word BROWNIE. *See Exhibit A – Search print outs from www.uspto.gov.* For example, in all classes there are 568 instances of BROWNIE. Regarding similar marks in use on similar goods, there are 22 marks using the term BROWNIE in International Class 25.

Thus, marks containing the term ‘BROWNIE’ can coexist without confusion with each other, as indicated in the USPTO trademark database.

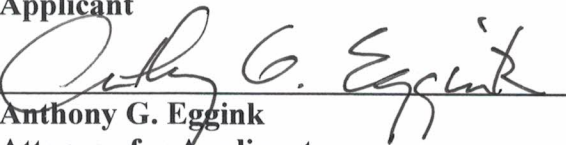
**Conclusion**

In conclusion, the goods represented by Applicant's mark and Registrants' marks are unrelated, are purchased by careful purchasers and travel in different trade channels. Further, Applicant's mark differs from Registrants marks as to appearance, sound, connotation and commercial impression, and other marks coexist using the terms BROWNIE/BROWNIES. Thus, no likelihood of confusion exists between Applicant's mark and Registrants' marks, particularly in view of the description of goods as now amended.

In view of this Response and the Amendment and Remarks herein, Applicant believes that this Application is now ready for publication. Such action is respectfully requested. Should the examining attorney feel that telephone contact with Applicant's Attorney would advance this case to publication, she is invited to call at the number below.

**Respectfully submitted,**

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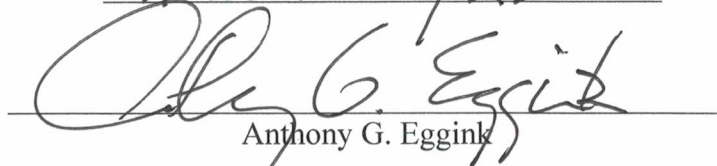
**Dated:** 02/11/2020



**Certificate of TEAS Transmission under 37 CFR 1.8**

**I hereby certify that this correspondence is being transmitted via the U.S. Patent and Trademark Office electronic filing system (TEAS) to the USPTO.**

on 11 February 2020

  
Anthony G. Eggink

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Exhibit A**