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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IMT Accessories Inc.

Serial No. 76/015,534

Ezra Sutton, P.A. for IMT Accessories Inc.

Amos Matthews, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney).

Before Hanak, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

IMT Accessories Inc. has filed an application to  
register the mark SIMPLY IRRESISTIBLE for "clothing,  
namely, sleepwear, lingerie, pajamas, robes and footwear."<sup>1</sup>

Registration has been refused under Section 2(d) of  
the Trademark Act, 15 U.S.C. §1052(d), on the ground that

<sup>1</sup> Application Serial No. 76/015,534, filed March 24, 2000, based  
on an asserted bona fide intent to use the mark in commerce.

if applicant's mark were used in connection with the identified goods, it would so resemble the mark IRRESISIBLES which is registered for "retail clothing store services;"<sup>2</sup> and "women's apparel, namely, dresses, pants, shorts, skirts, blouses, shirts, sweaters, coats, jackets and outerwear, namely, scarves, mittens, gloves and hats,"<sup>3</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

Preliminarily, we must discuss an evidentiary matter. With its appeal brief applicant has submitted printouts taken from the United States Patent and Trademark Office website of two third-party registrations for the marks IRRESISTIBLE LACE and IRRESISTIBLY SHEER, IRRESISTIBLY YOU. In addition, applicant submitted a printout from a private company's database of common law marks which include the word "IRRESISTIBLE." The Trademark Examining Attorney has objected to these materials, stating that their submission is untimely.

While, under Trademark Rule 2.142(d), evidence submitted for the first time with a brief on appeal is

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<sup>2</sup> Registration No. 1,448,987 issued July 21, 1987; Section 8 affidavit accepted; Section 15 affidavit received.

<sup>3</sup> Registration No. 2,101,696 issued September 30, 1997. The registrations are owned by the same entity.

normally considered by the Board to be untimely and therefore would usually be given no consideration, we note that in its response to the first office action applicant submitted a printout of the registration for the mark IRRESISTIBLE LACE from a private party's database and the Examining Attorney made no objection at the time. Instead, in the second Office action, the Examining Attorney merely stated that while uniform treatment under Trademark Act Section 2(d) is the Office's goal, each case must be decided on its own set of facts. By treating the registration for the mark IRRESISTIBLE LACE to be of record, the Examining Attorney has waived any objections to its consideration. As to the remaining third-party registration and the printouts of common law marks, in accordance with Rule 2.142(d), we have given them no consideration.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d), two of the most important considerations are the similarities between the marks and the similarities between the

goods/services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering first the goods of applicant and registrant, applicant does not dispute that its items of apparel and those of registrant are closely related. Indeed, this Board has held that the marketing of different items of wearing apparel under the same or substantially similar marks is likely to cause confusion. See e.g., *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) [ESSENTIALS for women's shoes is likely to cause confusion with ESSENTIALS for women's pants, blouses, shorts and jackets]. See also *in re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) and cases cited therein.

Considering next applicant's items of apparel and registrant's retail clothing store services, applicant states that "consumers would not associate applicant's mark on clothing as emanating from or being associated [with] a retail store." (Brief, p. 3). The Examining Attorney, however, argues that applicant's items of apparel and registrant's retail clothing stores are related. In support of his position, the Examining Attorney submitted twenty use-based third-party registrations of marks which cover clothing items, on the one hand, and retail clothing store services, on the other hand. Although such

registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that clothing items and retail clothing store services are the kinds of goods and services which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993) and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6. Moreover, the Board has recognized that items of clothing and retail clothing store services are related goods and services. See e.g. *Andre Oliver Inc. v. Products Exchange Company Inc.*, 1 USPQ2d 1817 (TTAB 1986) and *In re Peebles Inc.*, 23 USPQ2d 1795 (1992). Under the circumstances, we find that applicant's items of apparel and registrant's retail clothing stores are sufficiently related that if offered under the same or substantially similar marks, confusion would be likely.

Turning then to a consideration of the marks, we agree with the Examining Attorney that SIMPLY IRRESISTIBLE and IRRESISTIBLES are substantially similar in sound, appearance, meaning, and thus, overall commercial impression. In terms of sound and appearance, the similarities are obvious because both marks include the word IRRESISTIBLE(S).

In terms of connotation, we find the word IRRESISTIBLE(S) in both marks would be understood to mean "impossible to resist" or "having an overpowering appeal." Further, we find the word SIMPLY in applicant's mark would be understood to mean "absolutely" or "altogether." We reach these findings based on the dictionary definitions submitted by the Examining Attorney<sup>4</sup> and the goods and services involved in this case, namely items of apparel and retail clothing store services. Thus, the marks have virtually identical connotations in that consumers would understand them to mean items of apparel/retail clothing store services that are impossible or absolutely impossible to resist.

In finding that the marks are substantially similar, we have kept in mind the normal fallibility of human memory over time and the fact that the average consumer retains a general rather than a specific impression of trademarks in the marketplace. In this regard, we note that applicant's

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<sup>4</sup> The Examining Attorney submitted the following definitions of the words "simply" and "irresistible" taken from The American Heritage Dictionary of the English Language (Third Edition 1992):

**simply:** 4. Absolutely; altogether: *simply delicious.*

**irresistible:** 1. Impossible to resist: *an irresistible impulse to sneeze.* 2. Having an overpowering appeal. *irresistible beauty.*

items of apparel and registrant's items of apparel and retail clothing services would be offered to the same classes of consumers, namely the general public, who cannot be presumed to be particularly knowledgeable or sophisticated purchasers.

Finally, with respect to applicant's contention that marks containing the word IRRESISTIBLE are weak marks which are therefore entitled to only a limited scope of protection, as noted previously, applicant made of record a third-party registration for the mark IRRESISTIBLE LACE for "intimate apparel, namely, undergarments." Also, applicant submitted a printout from a private company's database of domain names, which include the word "IRRESISTIBLE." The existence of this third-party registration does not justify registration of a confusingly similar mark. Third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Such registrations are not evidence of what happens in the marketplace or even 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). Furthermore, the printout of domain names furnished by applicant is of limited probative value for the reason

that there is no indication as to what, if any, goods or services the domain names are used in connection with. Nevertheless, and aside from the absence of any demonstrated instances of third-party use in the clothing field, we note that even if marks which consist of or contain the word IRRESISTIBLE are considered to be weak, due to an assertedly high degree of suggestiveness conveyed by such term, even weak marks are entitled to protection where confusion is likely. Here, notwithstanding any alleged weakness in the term IRRESISTIBLE, the registered mark is still substantially similar in sound, appearance, connotation and commercial impression to applicant's mark.

In sum, we find that consumers familiar with registrant's women's apparel and retail clothing store services offered under its mark IRRESISTIBLES would be likely to believe, upon encountering applicant's mark SIMPLY IRRESISTIBLE for sleepwear, lingerie, pajamas, robes and footwear, that the goods originated with or were somehow associated with or sponsored by the same entity.

**Decision:** The refusals to register based on Registration Nos. 1,448,987 and 2,101,696 are affirmed.