



TTAB

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U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

1011-TM-153

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

Calzificio Fap S.P.A.

Mark: BELLISSIMA BY CALZIFICIO FAP (and design)

Serial No.: 75/866321

Examiner: Michael Engel

Filed: April 3, 1998

Law Office: 108

Class(es): 25

New York, NY 10036
November 26, 2002

Commissioner for Trademarks
Box TTAB No Fee
2900 Crystal Drive
Arlington, VA 22202-3513

BRIEF ON APPEAL

SIR:

Applicant herein appeals the Examiner's refusal to register the trademark in the above-identified trademark application. Reversal of the refusal and allowance for publication is respectfully requested based on the following.

SUMMARY OF ARGUMENT

As set forth in the application, Applicant has filed for registration of the stylized mark



The image shows the stylized mark 'BELLISSIMA' in a large, serif font. Below the word, the text 'BY CALZIFICIO FAP' is written in a smaller, sans-serif font, enclosed within a black rectangular box.

on the designated goods, i.e. stockings, based on the Italian Registration No. 00760688.

The refusal to register the present mark is based solely on United States Registration No. 1,334,447 (the '447 registration) for the mark BELLISSIMO and design. The '447 registration is used on children's dresses. This mark is visually, aurally and connotatively different from the Applicant's stylized mark. The Examiner has dissected the Applicant's mark and refused to register BELLISSIMA BY CALZIFICIO FAP based only on the shared lettering b-e-l-l-i-s-s-i-m of the Applicant's mark and the '447 registration.

The Examiner has also stated that the lettering BELLISSIMA is confusing similar to BELLISSIMO when both are used on apparel. This is clearly not enough to substantiate a refusal under Section 2 (d) because United States Registration 2,412,814 (the '814 registration), which issued on December 12, 2000 for " DOMINIC BELLISSIMO DB " was *allowed over* the '447 registration for "BELLISSIMO" despite the fact that both marks were applied to women's apparel and were independently owned. Clearly, the differences between the marks was found to be sufficient to distinguish between the two marks. The Applicant respectfully suggests that

the significant differences between the cited '447 registration and the Applicant's mark, without any other factor, are sufficient to permit registration.

Notwithstanding, the present mark provides a clearly distinct commercial impression from the '447 mark and differences in the goods will further serve to prevent any confusion. Therefore, as no confusion is likely, allowance is proper.

ANALYSIS

The present application was refused registration by the Examining Attorney under Section 2 (d) as likely to cause confusion over the cited '447 registration for BELLISSIMO for use on children's dresses since 1985.

The issue of likelihood of confusion, for registration purposes, is determined by evaluating the factors established in In re E.I. du Pont DeNemours & Co., 476 F. 2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The significance of each factor is determined on the particular circumstances of each case. G.H. Mumm & Cie v. Desnoes & Geddes, Ltd., 917 F.2d 1292, 1295, 16 USPQ2d 1635, 1637 (Fed. Cir. 1990)

The most relevant du Pont factors in the instant matter are as follows:

1. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely to continue trade channels.
4. The fame of the prior mark (sales, advertising, length of use.)
5. The number and nature of similar marks in use on similar goods.
6. The extent of potential confusion, i.e. whether de minimis or substantial.

7. Any other established fact probative of the effect of use.

G.H. Mumm & Cie v. Desnoes & Geddes, Ltd., 917 F.2d 1292, 1295, 16 USPQ2d 1635, 1637-38 (Fed. Cir. 1990); In re E.I. du Pont DeNemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

When these factors are considered and applied to the present application, it is clear that there is no likelihood of confusion between the Applicant's stylized mark and the '447 registration.

1. The Marks are not Similar

When assessing the similarities of two marks the marks must be considered in their entireties, especially in the design area because the visual impression of a design mark is more important than the auditory impression. In re Electrolyte Laboratories, Inc., 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (wherein the court held that a "K+" design and the mark "K+EFF" for dietary potassium supplements were sufficiently different to avoid likelihood of confusion).

The Applicant respectfully submits that the distinctive visual appearance of the Applicant's mark will clearly serve to distinguish it from the mark of the '447 registration, thereby obviating any potential confusion. In re Electrolyte Laboratories, Inc., 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990). Additionally, a multi-word mark has been held to be distinct from a single word mark. See Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co., 781 F.2d 884 USPQ 364 (Fed. Cir. 1986) (wherein the court held that there is no likelihood of confusion between the mark ROMANBURGER and design for prepared carryout foods and various "ROMAN" and "ROMAN MEAL" trademarks for cereal, breakfast foods, breads, flour and biscuits because ROMANBURGER is a single word with a single sound).

Applicant's mark is:

BELLISSIMA
BY CALZIFICIO FAP

and the '447 registration is:

Bellissima


In both sound and appearance the terms "BELLISSMA BY CALZIFICIO FAP" create a multi-word mark in stark contrast to the cited BELLISSIMO and design. The commercial impression of the Applicant's stylized mark and the cited registration are completely different. The Applicant's mark when read or spoken is an eleven syllable phrase while the '447 registration is a four syllable word.

Curiously, the Examiner attempts to dismiss the fanciful term FAP, which is part of the applicant's mark, because, "it would be reasonable for consumer's to think that the registrant's products ... come from [what the Examiner termed] the FAP hosiery factory". The Applicant submits that there is no basis for such an assertion.

It is clear from the comparison of Applicant's mark and the '447 registration that the marks are dissimilar in sight, sound, connotation and commercial impression.

As the court held in Kellogg Co. v. Pack'em Enterprises, Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), a great difference between an Applicant's mark and the cited registration is enough to obtain registration. In Kellogg, the Federal Circuit affirmed the Board's decision granting the Applicant's summary judgement motion because the Board properly considered all the relevant du Pont factors before making its determination that the Applicant's mark FROOTEE ICE and design for frozen flavored liquid bars was so different in appearance from Opposer's mark FROOT LOOPS for breakfast cereals, dessert sundaes, shakes and frozen confections that no likelihood of confusion would occur from the simultaneous use of the marks.

The unique and distinctive design of Applicant's mark creates a completely different visual appearance from the '447 registration that will obviate any likelihood of confusion. The Applicant's mark contains a stylized printed BELLISSIMA in a "bridge" like design over the wording BY CALZIFICIO FAP while the cited mark is the word BELLISSIMO, set on an angle, in script, with a flower design.

2. The Goods are not Similar

The Applicant's stylized mark will be applied to women's stockings. The '447 registration is applied to children's dresses.

The differences in the actual goods, without any other factor, is enough to distinguish the marks and obviate any possible confusion. The Applicant has reviewed the cases cite by the Examiner, during the prosecution, as support for the position that the actual goods identified with the two marks are similar for purposes of this analysis. In fact, the cited cases contain dramatically different fact patterns from the instant matter and in no way suggest that children's

dresses are similar to women's stockings. Specifically, In Re Mr. Wiggs Department Store 175 USPQ 719 (TTAB 1972) the marks in questions were single word marks which differed by only one letter, whereas, in the instant matter we have a stylized, compound word mark vs. a single word mark with a single flower design element. Furthermore, the goods for the marks in Wiggs were women's apparel for one mark and women's stockings for the other. Clearly, when the goods are as different as they are in the instant matter there is no likelihood of confusion. It should also be noted that the other cases cited by the Examiner on this point all involve marks which were used on various types of ladies apparel and not one involved a controversy between marks for children's dresses and women's stockings or a controversy with such dissimilar goods.

In addition, the goods which these marks are to be applied to (clothing and intimate apparel)) are commodities which are usually purchased in a self-service environment, and not purchased by verbal order. The Applicant's stylized, multi-syllable mark is clearly not likely to cause the average purchaser confusion with the single syllable '447 registration.

3. The Channels of Trade are not Similar

While it is technically correct to state that all the items for both marks are sold in the garment trade, the fact remains that children's dresses are not sold in the same venue as women's stockings.

The Applicant submits that courts have found, that even within the same channels of trade, similar names having a clear "difference in meaning makes them dissimilar in commercial impression." Ross Bicycles, Inc. v. East Coast Cycles, Inc., 224 USPQ 725 (N.D. Fla. 1984), *aff'd*, 765 F.2d 1502, 226 USPQ 879 (11th Cir. 1985) cert. denied, 473 U.S. 1013 (1986)(in

which the court found the mark "BOSS CRUISER" did not infringe the mark "ROSS" even though both were used on bicycles.)

The basic distinctions in the goods and the substantial differences in the marks obviate any potential confusion.

4. The '477 Registration is not a Famous Mark

There is no evidence of wide spread use of the '447 registration.

5. The Words Bellissimo and Bellissima are Employed by Numerous Other Registrations

Applicant conducted a preliminary search of the USPTO online databases and found 16 current registrations and 8 current applications which employ the term BELLISSIMO or BELLISSIMA in various international classes. Although these 24 marks employing the terms are not dispositive that the marks are currently in use, "they do show the adoption of them and at least the minimum amount of use necessary to support the respective applications." Keebler Company v. Associated Biscuits, Ltd., 207 USPQ 1034, 1038 (TTAB 1980). Furthermore, these third-party registrations "exemplify long standing and extensive practice within the Patent and Trademark Office." Keebler, at 1038.

Because the words "Bellissimo" and/or "Bellissima", are used in a number of registrations on a variety of goods, to exclude all other use is not proper and the significant dissimilarities in the marks become very important.

This aspect becomes controlling where the '814 registration for DOMINIC BELLISSIMO DB was actually allowed over the '447 registration for BELLISSIMO. The

registration of DOMINIC BELLISSIMO DB over BELLISSIMO clearly shows the propriety of registration of the present mark where it strongly evidences "practice within the Patent and Trademark Office." Keebler Company v. Associated Biscuits, Ltd., 207 USPQ 1034, 1038 (TTAB 1980).

Here the co-existing cited registrations which employ DOMINIC BELLISSIMO DB and BELLISSIMO, show that the marks which incorporate BELLISSIMO are subject to a limited scope of protection. When a mark is used by a number of individuals on a variety of goods the scope of protection narrows and the dissimilarities between the other components of the mark become more relevant. Washington National Ins. Co. v. Blue Cross and Blue Shield United of Wisconsin, 727 F.Supp. 472, 476, 14 USPQ2d 1307, 1311 (N.D. Ill. 1990). See also In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (wherein the Court ruled that there was no likelihood of confusion between BED & BREAKFAST REGISTRY and BED AND BREAKFAST INTERNATIONAL because the similar portion of both marks was weak and descriptive); Wright Line, Inc. v. Data Safe Services Corp., 229 USPQ 769 (TTAB 1985) (wherein the Board allowed registration of the mark "DATA SAFE" for storage and retrieval of business records in view of opposer's mark "DATABANK" for storage of information because the similar portion of both marks was weak).

6. The Potential for Confusion is Virtually Non-Existent

The significant differences in sight, sound, connotation and commercial impression between Applicant's stylized mark and the mark of the '447 registration, taken with the

consuming public's knowledge of numerous third party uses of the derivatives of the term BELLISSIMO as a trademark, makes the potential for confusion virtually non-existent.

7. The Marks Must be Evaluated in Their Entireties

While one portion of the mark may be recognized as more significant in creating a commercial impression, and therefore, given more weight, it has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of the mark and decide likelihood of confusion solely upon that feature, ignoring all other elements of the mark.¹ Sun-Fun Products, Inc. v. Sontan Research & Development, Inc., 656 F.2d 186, 213 (5th Cir. 1981)

CONCLUSION

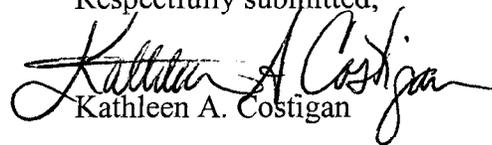
The only substantive issue is likelihood of confusion between the Applicant's mark BELLISSIMA BY CALZIFICIO FAP and the '447 registration for BELLISSIMO.

Most importantly, the sight, sound, connotation and commercial impression of Applicant's mark is completely different from the '447 registration, thereby eliminating any likelihood of confusion. Moreover, it is clear that the registration of the '814 registration over

¹ McCarthy on Trademarks and Unfair Competition, 4th ed. citing Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399 (CCPA 1974).

the '447 registration, owned by a different entity, fully illustrates Trademark Office practice in this area, supporting registration of the present mark.

Respectfully submitted,

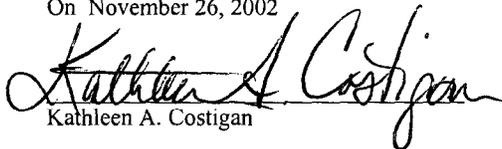

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

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On November 26, 2002


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