

M.C.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE FEB 27 2003

Applicant:	CALZIFICIO FAR S.P.A.	:	BEFORE THE
Trademark:	BELLISSIMA BY CALZIFICIO FAP	:	TRADEMARK TRIAL
Serial No:	75/866321	:	AND
Attorney:	James V. Costigan	:	APPEAL BOARD
Address:	Hedman, Gibson & Costigan, P.C. 1185 Avenue of the Americas New York, NY 10036-2601	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Attorney's refusal to register the trademark BELLISSIMA BY CALZIFICIO FAP (stylized) for "stockings" on the Principal Register under Section 2(d) of the Trademark Act, on the grounds of likelihood of confusion with Reg. No. 1334447 for the trademark BELLISSIMO and design for "children's dresses."

FACTS

On December 7, 1999, applicant filed an application to register the mark BELLISSIMA BY CALZIFICIO FAP (stylized). Registration was refused under Section 2(d) of the Trademark Act because of a likelihood of confusion with Reg. No. 1334447 for the mark BELLISSIMO and design, which is used on the goods "children's dresses." The examining attorney also objected to the inclusion of "socks" and "garters" in the identification of goods because these goods were not in the identification of goods found in the foreign registration which serves as the basis for this application. The examining attorney also cited a pending application for BELLISSIMA which has since been abandoned.

In its response of November 7, 2000, applicant limited the identification of goods to "stockings," and offered translations of the terms BELLISSIMA and CALZIFICIO, which mean "very fine" and "hosiery factory", respectively. At the same time, applicant argued against the refusal to register the mark under Section 2(d). Applicant asserted that BELLISSIMO was essentially laudatory in nature and thus weak, and that BELLISSIMO signified the masculine gender whereas BELLISSIMA denotes the feminine gender. After suspending further examination of the application pending disposition of pending application serial No. 75/706827 on December 8, 2002, the examining attorney issued a final office action on February 19, 2002, refusing registration under Section 2(d) because of a likelihood of confusion with Reg. No. 1334447 for BELLISSIMO and design. After a request for reconsideration, which was denied, applicant filed this appeal.

#### ISSUES

Whether the applicant's mark BELLISSIMA BY CALZIFICIO FAP (stylized), used in connection with "stockings," is likely to be confused with the registered mark BELLISSIMO and design for "children's dresses."

## ARGUMENT

### A. THE COMMERCIAL IMPRESSION OF APPLICANT'S MARK AND THE REGISTERED MARK IS HIGHLY SIMILAR

The examining attorney submits that the commercial impression of applicant's mark BELLISSIMA BY CALZIFICIO FAP is highly similar to the registered marks BELLISSIMO and design.

Although the marks must be considered in their entireties, it is well settled that there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark...." *Id.* The dominant term in the marks under consideration are BELLISSIMA and BELLISSIMO, respectively. There is no other wording in the registered mark. The other wording in applicant's mark is much smaller than BELLISSIMA, and one of the terms CALZIFICIO, is descriptive because it means "hosiery factory".

Applicant has not carried the burden of proving that BELLISSIMA and BELLISSIMO are particularly weak for clothing. Applicant refers to one other registration in Class 25, Reg. No. 2412814 for the mark DOMINIC BELLISSIMO DB, but the connotation of BELLISSIMO is quite different in that mark because DOMINIC BELLISSIMO is the

name of an individual. The use of the term BELLISSIMO as a surname by one other party for clothing goods hardly allows one to draw the conclusion that the term is weak and deserving of a limited scope of protection.

As to the gender difference between the terms BELLISSIMO and BELLISSIMA, it cannot be assumed that those unfamiliar with the Italian language would know this. Even if they did, BELLISSIMO is used on children's dresses, which are presumably worn by girls. This fact, and the presence of a flower in the mark, would do much to minimize the "masculine" connotation which applicant ascribes to the mark.

It is true that the registered mark is written diagonally, and that there are two minor differences between the marks. However, these differences would not prevent a likelihood of confusion in this case, where the dominant terms BELLISSIMO and BELLISSIMA are so confusingly similar. The first difference, the presence of a flower in the registered mark, does not obviate the similarity between the marks because the literal portions of both marks are nearly identical in appearance, sound and meaning. *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975). TMEP §§1207.01(b)(viii) and 1207.01(c)(ii). When a mark consists of a literal portion and a design portion, the literal portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). TMEP §1207.01(c)(ii).

The other difference between the marks is the addition, in much smaller script, of the wording BY CALZIFICIO FAP. While FAP is indeed fanciful, the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under

Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (“THE LILLY” and “LILLI ANN”); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”). TMEP §1207.01(b)(iii).

#### **B. THE PARTIES’ GOODS ARE CLOSELY RELATED**

Like registrant’s goods, the stockings marketed by applicant would be worn by children. Although applicant refers to its goods as “women’s stockings,” it did not limit the identification of goods to stockings for women, so the identification of goods must be construed to include stockings for girls. The intended customers for applicant’s goods are the same as for registrant’s, since adult women, a substantial portion of which are mothers, are the primary purchasers both of dresses for children and stockings. It is common knowledge that the goods of both parties are frequently purchased in department stores. The examining attorney must resolve any doubts as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs*

*Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). Due to registrant's use of the BELLISSIMO mark on children's dresses for a period exceeding 20 years, its customers would be confused by another party offering stockings under the mark BELLISSIMA BY CALZIFICIO FAP, especially when one considers the relative sizes of the words in applicant's mark and the descriptiveness of the term CALZIFICIO.

#### OTHER

In addition to the similarity of the marks and the goods, applicant has presented arguments on four other *du Pont* factors. However, there is no evidence to support the assertions that there are differences in the channels of trade of the parties' goods, that the BELLISSIMO mark is or isn't famous, that there are "numerous" other registrations for BELLISSIMA or BELLISSIMO for clothing goods, or that the potential for confusion is *de minimis*. Since there is no evidence of record on the four other *du Pont* factors, the Board must decide this case on the basis of the most relevant factors, which are the similarity of the marks and the similarity of the goods.

CONCLUSION

Likelihood of confusion exists between applicant's mark BELLISSIMA BY CALZIFICIO FAP and the registered mark BELLISSIMO and design. The refusal to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) (1986), on the grounds of likelihood of confusion with Registration No. 1334447, should be affirmed.

Respectfully submitted,

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