

TTAB

17125/11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Enchantment International, Inc.

Application No. : 76,141,715

"Express Mail" mailing label No.: EL 647168447 US
Date of Deposit: July 10, 2002

Mark : PLATEAU & Design

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.
Name: Jane Williams

Filing Date : October 5, 2000

Signature: Jane Williams

Examining Attorney : Anthony J. Tambourino, Esq.

Law Office : 107



07-11-2002

U.S. Patent & TMOfo/TM Mail RcptDt. #11

RESPONSE TO FINAL OFFICE ACTION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Madam:

TRADemark AND
Tribunal Board
02 JUL 31 AM 8:33

Applicant submits this in response to the Final Office Action dated January

11, 2002. Registration has been finally refused based upon a likelihood of confusion between Applicant's mark, PLATEAU & Design, covering body lotion, body cleansing gel, body soap, shampoo, conditioner, body hydrating mist, mineral bath salts, body and massage oil, and body fragrance in International Class 3, and scented room deodorant in the form of a spray in International Class 5 on the one hand, and U.S. Trademark Registration No. 1,953,567 for the mark PLATEAU covering scented gift items, namely, sachet packets and potpourri (the "Cited Registration") on the other.

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Upon information and belief, the owner of the Cited Registration has ceased use of the mark which is the subject of said Registration, with the intent not to resume such use, and as such has abandoned said Registration. Upon information and belief, the owner of the Cited Registration will be unable to file a Section 8 Declaration, attesting to its continued use of the PLATEAU mark or its excused non-use of the mark. Since the Cited Registration issued on January 30, 1996, the Section 8 Declaration must be filed by no later than July 30, 2002.

Accordingly, concurrent with the filing of the instant Response, Applicant is filing a Petition To Cancel the Cited Registration on the grounds of abandonment (the "Petition To Cancel"). In order to preserve its rights, Applicant is also filing, concurrently, a Notice of Appeal. Copies of the Petition To Cancel and Notice of Appeal are enclosed for your ease of reference.

Based on the foregoing, it is respectfully requested that the instant Application be suspended pending the outcome of the Petition To Cancel.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
Attorneys for Applicant
90 Park Avenue
New York, New York 10016
(212) 697-5995

Dated: New York, New York
July 10, 2002

By: Holly Pekowsky
Morton Amster
Anthony F. Lo Cicero
Holly Pekowsky

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Enchantment International, Inc.

Application No. : 76,141,715

"Express Mail" mailing label No.: EL 857430640 usDate of Deposit: July 10, 2002

Mark : PLATEAU & Design

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Name: Jane Williams

Filing Date : October 5, 2000

Signature: Jane Williams

Examining Attorney : Anthony J. Tambourino, Esq.

Law Office : 107

NOTICE OF APPEALCommissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Madam:

Pursuant to 37 C.F.R. 2.142, Applicant hereby appeals to the Trademark Trial and Appeal Board from the Final Office Action of January 11, 2002 refusing registration of Applicant's PLATEAU & Design trademark covering goods in International Classes 3 and 5.

Enclosed is a check in the amount of \$200.00 as payment for the Appeal Fee.

Please charge any additional amount to the Deposit Account No. 01-1785 of Amster, Rothstein & Ebenstein.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
Attorneys for Applicant
90 Park Avenue
New York, New York 10016
(212) 697-5995

Dated: New York, New York
July 10, 2002

By: Holly Pekowsky
Morton Amster
Anthony F. Lo Cicero
Holly Pekowsky

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

In the matter of Trademark Registration No. 1,953,567

For the mark: PLATEAU Int'l Class: 3

Date registered: January 30, 1996

"Express Mail" mailing label No.: FI 857430640 US

Date of Deposit: July 10, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Name: Jane Williams

Signature: Jane Williams

-----X

ENCHANTMENT INTERNATIONAL, INC,

Petitioner,

v.

OLIO, INC.,

Registrant.

-----X

CANCELLATION NO. _____

PETITION TO CANCEL

BOX TTAB - FEE
Commissioner for Trademarks
Washington, D.C. 20231

Madam:

In the matter of U.S. Trademark Registration No. 1,953,567 registered January 30, 1996 to Olio, Inc., a Texas Corporation, 706 Knickerbocker Road, San Angelo, Texas 76903 ("Respondent"), which was assigned the corresponding application by Reminence, Inc., a Texas Corporation located at P.O. Box 854, Fredericksburg, Texas 78624 on February 6, 1995, for the mark PLATEAU in International Class 3

covering scented gift items, namely, sachet packets and potpourri, Enchantment International, Inc., a corporation organized and existing under the laws of the State of New York, having a place of business at 5 West 16th Street, New York, New York 10011 ("Petitioner") believes that it is or will be damaged by the above-identified registration and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. Petitioner is a corporation organized and existing under the laws of the State of New York, having a place of business at 5 West 16th Street, New York, New York 10011.
2. Since at least as early as October 28, 1999, Petitioner has been using the mark PLATEAU (Stylized) as a trademark for candles in International Class 4, body lotion, body cleansing gel, body soap, shampoo, conditioner, body hydrating mist, mineral bath salts, body and massage oil, and body fragrance in International Class 3, and scented room deodorant in the form of a spray in International Class 5. Such products have been offered for sale and sold nationally by petitioner under the PLATEAU (Stylized) mark continuously since that date.
3. By an application filed in the United States Patent and Trademark Office November 10, 2000, Application Serial No. 76/162,640, petitioner applied to federally register its trademark PLATEAU (Stylized) covering candles in International Class 4 (the "640 Application"). A copy of a print out of the '640 Application from the Thomson & Thomson trademark database is annexed hereto and identified as Exhibit 1.

4. By an application filed in the United States Patent and Trademark Office October 5, 2000, Application Serial No. 76/141,715, petitioner applied to federally register its trademark PLATEAU (Stylized) covering body lotion, body cleansing gel, body soap, shampoo, conditioner, body hydrating mist, mineral bath salts, body and massage oil, and body fragrance in International Class 3, and scented room deodorant in the form of a spray in International Class 5 (the "715 Application"). A copy of a print out of the '715 Application from the Thomson & Thomson trademark database is annexed hereto and identified as Exhibit 2.

5. At present, the '640 and '715 Applications has each been rejected, *inter alia*, on the basis of alleged likelihood of confusion with U.S. Trademark Registration No. 1,953,567. Copies of such rejections are annexed hereto and identified as Exhibits 3 and 4, respectively.

6. Upon information and belief, the owner of U.S. Trademark Registration No. 1,953,567, which is the subject of the instant Cancellation Petition, has ceased use of the mark which is the subject of Registration No. 1,953,567, with the intent not to resume such use. As a result, Respondent has abandoned Registration No. 1,953,567. Upon information and belief, the owner of U.S. Trademark Registration No. 1,953,567 will be unable to file a Section 8 Declaration, attesting to its continued use of the PLATEAU mark or its excused non-use of the mark. Since Registration No. 1,953,567 issued on January 30, 1996, the Declaration must be filed by no later than July 30, 2002.

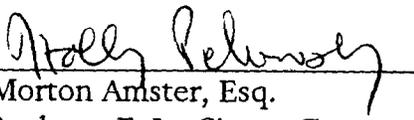
7. If there is a likelihood of confusion between Petitioner's PLATEAU (Stylized) mark which is the subject of the '640 and "715 Applications, and Respondent's PLATEAU mark which is the subject of Registration No. 1,953,567, then the continued existence of Registration No. 1,953,567 on the Principal Register will damage Petitioner, since Registration No. 1,953,567 will prevent Petitioner from obtaining a registration for its PLATEAU (Stylized) mark in connection with its goods.

8. For at least the reasons stated herein, the continued registration of U.S. Trademark Registration No. 1,953,567 for the goods for which it is registered would in all likelihood be damaging to petitioner.

WHEREFORE, Petitioner prays that the within Cancellation Petition be granted and U.S. Trademark Registration No. 1,953,567 be cancelled.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
Attorneys for Petitioner,
Enchantment International, Inc.
90 Park Avenue
New York, NY 10016
212-697-5995

By: 
Morton Amster, Esq.
Anthony F. Lo Cicero, Esq.
Holly Pekowsky, Esq.

Dated: New York, New York
July 10, 2002

PLATEAU

Image

TRADEMARKSCAN®--U.S. Federal

Serial Number: 76162640

Status: PENDING

USPTO Status: (645) FINAL REFUSAL - MAILED

USPTO Status Date: January 11, 2002

Filed: November 10, 2000

Goods/Services: CANDLES

International Class(es)

4 (Lubricants and Fuels)

International Class: 4

First Used: October 28, 1999

In Commerce: October 28, 1999

Applicant:

ENCHANTMENT INTERNATIONAL, INC.

NEW YORK CORPORATION

5 WEST 16TH STREET

NEW YORK , NEW YORK 10011

Filing Attorney: MORTON AMSTER, ESQ

Filing Correspondent:

MORTON AMSTER, ESQ

AMSTER, ROTHSTEIN & EBENSTEIN

90 PARK AVE

NEW YORK NY 10016

Design Codes:

999999 NO CODES

plateau

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO.

76/162640 Enchantment International, Inc.

APPLICANT

PAPER NO.

MARK

PLATEAU (STYLIZED)

ADDRESS

JOHN FLOCK
KENYON & KENYON
ONE BROADWAY
NEW YORK NY 10004

ACTION NO.

02

MAILING DATE

01/11/02

REF. NO.

ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

TRADEMARK LAW OFFICE 107
Serial Number: 76/162640
Mark: PLATEAU (STYLIZED)

Please Place on Upper Right Corner
**of Response to Office Action ONLY **

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
Mailing date of this Office action.
Examining Attorney's name and Law Office number.
Your telephone number and ZIP code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/162640
Mark: PLATEAU (stylized)

This Office Action responds to the applicant's written communication dated October 3, 2001.

The examining attorney accepts the applicant's substitute specimens and declaration in support thereof.

Final - Likelihood of Confusion under 15 U.S.C. §1052(d) of the Trademark Act

Registration was refused under Trademark Act §2(d), 15 U.S.C. §1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 1953567 as to be likely, when used on or in connection with the identified goods, to cause confusion, or to cause mistake, or to deceive.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons described below, the refusal under §2(d) is maintained and made **FINAL**.

The examining attorney found that the marks are identical. The applicant does not dispute that the marks are identical. If the marks of the respective parties are identical, the relationship between the

goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Amcors, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

However, the applicant has attempted to distinguish its goods by arguing that the registrant is merely a wholesaler of the goods it provides and that the applicant's goods are consumed by celebrities and featured in popular magazines.

Despite the applicant's argument, the registrant has not limited the scope of its registration to wholesale sales. If the cited registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The fact that "celebrity" purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

So even though the registrant may have chosen to sell the PLATEAU line of goods in wholesale only, the registrant is entitled to the full scope of its broad identification, which may include retail sales that it intends to, or apparently recently has, offered to the public.

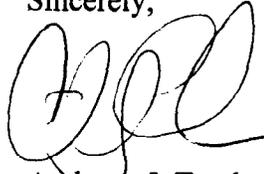
The examining attorney has attached copies of third party registrations to show that a single owner can offer both the registrant's goods and the applicant's goods. See enclosed Register evidence. Nevertheless, if the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). Candles, potpourri and sachets are goods that are sold in the same marketplace. Confusion therefore is likely as to the source of the goods because the goods are related.

For the reasons described above, the refusal under §2(d) is maintained and made FINAL.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Commissioner if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a). Regarding petitions to the Commissioner, see 37 C.F.R. §2.146; TMEP §1702 and §1704. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

Sincerely,

A handwritten signature in black ink, appearing to read 'AJT', written in a cursive style.

Anthony J. Tambourino, Esq.
Trademark Examiner
United States Patent & Trademark Office
Law Office 107
Phone: (703) 308-9107, x282
Fax: (703) 308-7191

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 76/141715 Enchantment International		APPLICANT		PAPER NO.	
MARK PLATEAU (STYLIZED)				ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov	
ADDRESS JOHN FLOCK KENYON & KENYON ONE BROADWAY NEW YORK, NEW YORK 10004		ACTION NO. 02		If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
		MAILING DATE 01/11/02			
		REF. NO.			
FORM PTO-1525 (5-90)		U.S. DEPT. OF COMM. PAT. & TM OFFICE		Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. Mailing date of this Office action. Examining Attorney's name and Law Office number. Your telephone number and ZIP code.	

TRADEMARK LAW OFFICE 107
Serial Number: 76/141715
Mark: PLATEAU (STYLIZED)

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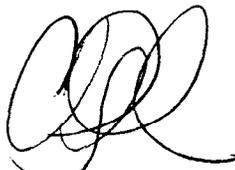
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A handwritten signature in black ink, appearing to be 'AJT', written in a cursive style.

Anthony J. Tambourino, Esq.
Trademark Examiner
United States Patent & Trademark Office
Law Office 107
Phone: (703) 308-9107, x282
Fax: (703) 308-7191