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

APPLICANT : ATICO INTERNATIONAL USA INC.
MARK : ALCO
SERIAL NO. : 76/251,522
FILING DATE : May 4, 2001

Commissioner for Trademarks
BOX TTAB NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

APPLICANT'S APPEAL BRIEF

TRADEMARK TRIAL AND APPEAL BOARD
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Applicant Atico International USA Inc. ("Atico), respectfully submits this memorandum in support of its appeal of the Examining Attorney's Final Refusal¹ to register the proposed mark ALCO, pursuant to 15 U.S.C. § 1052(d), "because the mark for which registration is sought so resembles the marks shown in U.S. Registration Nos. 0865520 and 1644718 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive." (Final Office Action, Ex. 1, at 1).² As the Examining Attorney's refusal to register the proposed mark is based on third-party registrations absent relevant persuasive authority, in combination with a misrepresentation of Atico's response to a prior Office Action, the refusal to register lacks factual or legal support, and should be reversed.

I. AMENDMENT TO IDENTIFICATION OF GOODS

Atico notes initially that the Final Office Action, in addition to refusing to register the proposed mark under § 1052(d), also included the requirement that Atico amend the identification of goods in Classes 16 and 21, to delete "memo boards" from Class 21 and insert – memo boards – in Class 16.

Accordingly, pursuant to 37 C.F.R. § 2.71(b), and in accordance with the instructions of the Examining Attorney in the Final Office Action, Atico amends the identification of goods as follows:

Class 16: After "appointment pads," insert – memo boards, -- .

1 By Final Office Action dated April 22, 2002. See Exhibit 1, attached.

2 Reg. No. 0865520 is for the mark ALCO, for retail services in connection with variety and discount stores (International Class 35). Reg. No. 1644718 is for ALCO YES (word and design), for discount department store services (International Class 42). Both registrations are owned by Duckwall-ALCO Stores, Inc., of Abilene KS.

Class 21: After “organizers, locks, picture frames, mirrors,” delete “memo boards.” .

As amended, the identification of goods in Class 16 reads:

photograph albums, appointment pads, memo boards, stationery boxes, crayons, desk caddies, desk organizers, drawing compasses, erasers, memo pads, pens, rubber stamps, score pads, paper staplers, telephone number and address books, art sets comprised of color pens, color pencils, crayons, oil pastels, watercolors pencils, palette, erasers, sharpeners, rulers, cutter, stapler, tacks, sponge, carrying case with handle, white water color, markers, brushes, scissors, glue and paper notepad, binders, book covers, chalk, clip boards, colored pencils, composition books, copy paper, correcting fluid for type, correcting tape for type, day planners, dry erase markers, envelopes, paper expandable files, filler paper, glue and glue sticks for stationery or household use, highlighter markers, hole punches, index cards, laser paper, markers, math sets consisting primarily of pencil sharpeners, eraser, six-inch ruler, protractor, triangles, pencil, compass, divider, and mechanical pencil, mechanical pencils, multipurpose paper, notebooks, paint brushes, painting sets, vinyl and metal paper clips, paper shredders, pencil cases, pencil grips, pencil pouches, pencil sharpeners, pencils, permanent markers, portfolio folders, push pins, rubber bands, drawing rulers, social stationery, staple removers, stencils, stick-on notes, stickers, adhesive tape for stationery or household use, writing pads, finger paints.

As amended, the identification of goods in Class 21 reads:

locker accessories namely, organizers, locks, picture frames, mirrors, and lunch boxes.

Atico notes that no amendment to the identification of goods was required for Classes 8, 9, 18, 25 and 27.

II. BACKGROUND RELEVANT TO THE INSTANT APPEAL

On May 4, 2001 Atico filed an Intent-to-Use application for the proposed mark ALCO, to be used in connection with the following goods:

finger paints in International Class 2; scissors and utility knives in

International Class 8; pocket calculators and protractors in International Class 9; albums, appointment pads, stationery boxes, crayons, desk caddies, desk organizers, drawing compasses, erasers, memo pads, pens, rubber stamps, score pads, staplers, telephone & address books, art sets, binders, book covers, chalk, clip boards, colored pencils, composition books, copy paper, correction fluid, correction tape, day planners, dry erase markers, envelopes, expandable files, filler paper, glue, glue sticks, highlighter markers, hole punches, index cards, laser paper, markers, math sets, mechanical pencils, multipurpose paper, notebooks, paint brushes, paint sets, paper clips (vinyl and metal), paper shredders, pencil cases, pencil grips, pencil pouches, pencil sharpeners, pencils, permanent markers, portfolio folders, push pins, rubber bands, rulers, social stationery, staple removers, stencils, stick-on notes, stickers, tape and writing pads in International Class 16; tote bags and backpacks in International Class 18; locker accessories and lunch boxes in International Class 21; artist aprons in International Class 25; and children's play mats in International Class 27.

(See, Exhibit 2, attached).

The application was assigned to Examining Attorney Won T. Oh, who issued a first Office Action dated September 20, 2001 (the "First Office Action").³ There, the Examining Attorney refused registration under 15 U.S.C. § 1052(d) "because the applicant's mark, when used on or in connection with the identified goods, so closely resembles the marks in U.S. Registration Nos. 0865520 and 1644718 as to be likely to cause confusion, or to cause mistake, or to deceive." (First Office Action, Ex. 3, at 1).

(Renewed) Reg. No. 0865520, for ALCO, for retail services in connection with variety and discount stores (International Class 35), is owned by Duckwall-ALCO Stores, Inc., of Abilene KS. Reg. No. 1644718, for ALCO YES (words and design), for discount department store services (International Class 42), also is owned by Duckwall-ALCO Stores, Inc., of

Abilene KS.

According to the Examining Attorney:

The applicant has applied to register the mark 'ALCO' for various goods in multiple international classes 2, 8, 9, 16, 18, 21, 25 and 27. The registered marks are 'ALCO' for "retail services in connection with variety and discount stores" and 'ALCO YES' for "discount department store services." ... Applicant's mark is highly similar to the registered marks. Applicant's mark is identical to one of the registered marks and highly similar to the other registered mark. Thus applicant's mark is confusingly similar to the registered marks.

...[I]n this instance, the applicant's goods are highly related to the registrant's services. Applicant's goods are items that may likely be sold in registrant's retail and discount stores. Consumers may assume that the goods and services originate from the same source.

(Id. at 2).

Atico filed a response to the First Office Action on or about January 18, 2002. (*See* Exhibit 4, attached). In connection therewith, Atico attempted to traverse the refusal to register on the basis of likelihood of confusion, noting that there was no evidence proffered by the Examining Attorney that the cited registrant sells goods through its ALCO retail stores or catalogs under the brand name ALCO. (Ex. 4 at 5). According to Atico, in its response to the First Office Action:

That an ALCO store may sell variety and discount goods does not establish that it sells those goods under an ALCO brand, or that a likely purchaser, seeing variety and discount goods under the ALCO mark sold at a different retail outlet would likely believe it to derive from a common source with the ALCO store.

(Id.).

3 *See* Exhibit 3, attached.

Atico further noted the following expressly abandoned registrations for the mark ALCO, all owned by Al Nyman & Sons, Inc., of Miami FL:

- (Renewed) Reg. No. 0868295, for tote bags sold for use by students and school children (International Class 18).
- (Renewed) Reg. No. 0861944, for staplers and rubber stamps (International Class 8).
- (Renewed) Reg. No. 0862705, for drawing compasses and pocket calculators (International Class 9).
- (Renewed) Reg. No. 0861696, for pens, crayons, albums, score pads, telephone and address books, memo pads, appointment pads, boxed stationery erasers, desk organizers, and desk caddies (International Class 16).

Atico contended that the identified goods of the above expressly abandoned marks were highly similar or identical to the identified goods of Atico's mark. Yet, the Trademark Office registered the cited registered ALCO marks over the then-current above ALCO marks. Clearly, per Atico, the Trademark Office had determined that the identified services of the cited registered marks *did not* give rise to a likelihood of confusion with the identified goods of Atico's proposed mark, notwithstanding the high similarity or identity of the proposed marks. (*Id.*)

Atico further noted that the Examining Attorney's proposed standard, "consumers may assume that the goods and services originate from the same source," was in contradistinction to the recognized standard for § 1052(d) rejections, viz., *likelihood* of confusion. (*Id.* at 5-6). "The Examining Attorney's standard is wholly speculative. Indeed, were the applicable standard whether consumers 'may assume', no marks having shared formatives ever would register. The

Principal Register, filled with such marks, clearly shows that the mere possibility of confusion is insufficient.” (*Id.* at 6).

By Office Action dated April 22, 2002 and designated FINAL (Final Office Action), the Examining Attorney maintained his refusal to register the proposed mark in connection with the intended goods, “because the mark for which registration is sought so resembles the marks shown in U.S. Registration Nos. 0865520 and 1644718 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive.” (Ex. 1 at 1). The Examining Attorney claimed to have considered the arguments presented in Atico’s response to the First Office Action, “but has found them unpersuasive.” (*Id.*).

According to the Examining Attorney:

The applicant’s mark is ‘ALCO’ used to identify various goods in multiple international classes... Because applicant’s mark is highly similar to the registered mark and the goods are also highly similar, the examining attorney has refused registration ... under Section 2(d)... Applicant argues that its goods re not sold in the registrant’s stores nor would any consumers ever believe its goods would be associated with the registrant’s stores. The examining attorney encloses multiple third party registrations showing one mark used to identify retail store services and goods similar to the applicant’s. These third party registrations show consumers are accustomed to seeing retail stores sell various goods with their own housemark.

(*Id.* at 2).

Atico filed its Notice of Appeal on May 22, 2002. (Ex. 5, attached).

III. THERE IS NO LIKELIHOOD OF CONFUSION

The Examining Attorney proffered nothing to support his continued refusal to register the proposed mark under § 1052(d). With respect to the Examining Attorney’s citation to third-party registrations, to the extent that such have any probative value at all (*cf. infra*), they may be

evidence of goods and services under a single mark for the identified registrants. They are not, however, evidence that the cited registrant, Duckwall-ALCO Stores, sells goods under an ALCO brand or trade name. There is no such evidence, anywhere.

Moreover, as a matter of law, third party registrations are **NOT** evidence of how a particular mark is used in the marketplace. See, e.g., *Old Tyme Foods, Inc. v Roundy's, Inc.*, 961 F.2d 200, 204, 22 USPQ2d 1542 (Fed. Cir. 1992) (“The existence of [third party] registrations is not evidence of what happens in the market place...”), quoting *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973); *Bill Rivers Trailers, Inc. v. Thermo King Corp.*, 478 F.2d 1243, 1245, 177 USPQ 764 (CCPA 1973), citing *AMF*. The TTAB’s position is the same. See, e.g., *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“[W]e have on numerous occasions stated the position that [third party] registrations are of little probative value in determining likelihood of confusion in the absence of evidence to establish their use in the market-place.”); *Plus Products v. Medical Modalities Assoc’s, Inc.*, 217 USPQ 464, 465 (TTAB 1983) (“The third-party registrations are not, of course, evidence of marks actually appearing in the marketplace.”); *In re Delbar Products, Inc.*, 217 USPQ 859, 861 (TTAB 1981) (“Further, even if copies of third-party registrations were made of record, the probative value of such third-party registrations is very limited since there is no evidence of the use of the mark or the impact made on the marketplace by the mark.”).

It is the same here. The Examining Attorney has proffered third party registrations that (per the Examining Attorney) “show consumers are accustomed to seeing retail stores sell

various goods with their own housemark.” (Ex. 1 at 2). However, based on the foregoing clear statement of controlling law, the registrations themselves are valueless absent evidence of use of the cited marks in the marketplace. No such evidence was proffered by the Examining Attorney. Atico’s search for evidence of such use establishes that, in fact, the cited registrant ***does not*** sell goods at its ALCO or ALCO YES! Retail outlets under the ALCO brand name. Indeed, printouts of product pricing information taken from the Internet web site of the cited registrant, www.duckwall.com, clearly demonstrate that products offered for sale by the cited registrant are so offered under the ***manufacturer’s brand name***, and not the ALCO name. (See Ex. 6, attached).

The Examining Attorney proffered no evidence of any company including the name ALCO selling any product under an identical or highly similar brand name. The Examining Attorney’s proffered “evidence” thus fails to establish a prima facie case of likelihood of confusion as to source.

Additionally, there is no support for the Examining Attorney’s assertion that Atico claimed that “consumers ever believe its goods would be associated with the registrant’s stores.” (Ex. 1 at 2). Such language, or synonymous, is entirely absent from Atico’s response to the First Office Action.⁴ The attempt by the Examining Attorney to translate Atico’s reasoned response into an extreme, legally untenable position, was improper, and cannot serve as a sufficient basis for an otherwise baseless refusal to register.

The Examining Attorney proffered nothing sufficient to sustain the refusal to register the

4 See Ex. 4.

proposed mark under § 1052(d). Absent sufficient evidentiary and legal support, the refusal is merely capricious and arbitrary, and cannot be sustained.

IV. CONCLUSION

The Examining Attorney's refusal to register Atico's proposed mark ALCO is unsupported by the "evidence" proffered, and is countered by the prior registered (and now expressly abandoned) ALCO marks for goods highly similar to those of Atico. Accordingly, based on the foregoing, the refusal to register the proposed mark ALCO for the identified goods, should be reversed.

Respectfully submitted,
Atico International USA, Inc.

Date: June 4, 2002



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June 4, 2002

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02 JUN 10 AM 8:23
TRADEMARK TRIAL AND
APPEAL BOARD

Re: Applicant: Atico International USA, Inc.
Mark: ALCO
Serial No.: 76/251522
Filed: May 4, 2001

Dear Sir:

In connection with the referenced Mark, enclosed please find:

1. An original (signed) and two (2) copies of APPLICANT'S APPEAL BRIEF; and
2. Acknowledgment postcard.

Very truly yours,

Clyde A. Shuman

Enclosures