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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Atico International USA Inc. : BEFORE THE
 Trademark: ALCO : TRADEMARK TRIAL
 Serial No: 76/251522 : AUG 6 2002 AND
 Attorney: Peter T. Cobrin : APPEAL BOARD
 Address: 750 Lexington Avenue : ON APPEAL
 New York, New York 10022

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's refusal to register the mark ALCO for various consumer goods in classes 8, 9, 16, 18, 21, 25 and 28. The Trademark Examining Attorney refused the mark because applicant's mark is confusingly similar to the registered marks "ALCO" for "retail services in connection with variety and discount stores" and "ALCO YES" for "discount department store services." The registered mark "ALCO YES" has since been cancelled and no longer presents a bar to registration of applicant's mark. Two issues are presented upon appeal.

ISSUE

WHETHER THE TRADEMARK EXAMINING ATTORNEY PROPERLY REFUSED REGISTRATION OF APPLICANT'S MARK, ALCO, ON THE GROUNDS THAT APPLICANT'S MARK AS APPLIED TO THE GOODS IS SO SIMILAR TO THE REGISTERED MARK, ALCO, AS TO BE LIKELY TO CAUSE PURCHASER CONFUSION OR MISTAKE, OR TO DECEIVE PURCHASERS. WHETHER APPLICANT HAS PROPERLY IDENTIFIED ITS GOODS AS REQUIRED BY THE EXAMINING ATTORNEY.

FACTS

1. Applicant filed the U.S. Trademark Application 76/251522 seeking registration of the mark ALCO for use on a variety of consumer goods classified in classes 2, 8, 9, 16, 18, 21, 25 and 27 on May 4, 2001.
2. On September 20, 2001, the examining attorney refused registration of applicant's mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), on the grounds that applicant's mark, ALCO, is so similar as applied to the goods to the registered marks ALCO (U.S. Registration No. 0865520) and ALCO YES (U.S. Registration No. 1644718), as to cause confusion, or to cause mistake or deceive.
3. Applicant responded to the initial Office Action contesting the examining attorney's statutory refusal on January 22, 2002. In its response, applicant argued

that the examining attorney has not shown that applicant's goods are sold in the registrant's stores. Applicant also argued that the existence of identical marks for similar goods that have since been abandoned shows that there is no likelihood of confusion.

4. On April 22, 2002, the examining attorney issued a final statutory refusal.
5. On May 28, 2002, the applicant filed a notice of appeal.
6. On June 4, 2002, applicant filed its appeal brief where it amended its identification of goods to the following:

International Class 8: scissors and utility knives

International Class 9: pocket calculators and protractors, graduated rulers

International Class 16: photograph albums, appointment pads, 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

International Class 18: tote bags and backpacks

International Class 21: locker accessories namely, organizers, locks, picture frames, mirrors, and lunch boxes

International Class 25: artist aprons

International Class 27: children's play mats for use in connection with playing, exercise, and sleeping

7. U.S. Registration No. 1644718 has since been cancelled and no longer present a bar to registration of applicant's mark.

IDENTIFICATION OF GOODS

The identification of goods is unacceptable as indefinite because applicant has misclassified certain items and has not properly identified the nature of two other goods. TMEP §1402.01. The applicant may adopt the following, if accurate:

International Class 8: scissors and utility knives

International Class 9: pocket calculators and protractors, graduated rulers

International Class 16: photograph albums, appointment pads, 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

International Class 18: tote bags and backpacks

International Class 20: locker accessories namely, personal organizers, non-metal locks, picture frames, mirrors,

International Class 21: locker accessories, namely lunch boxes

International Class 25: artist aprons

International Class 28: children's play mats for use in connection with playing, exercise, and sleeping

This suggested identification of goods includes the addition of class 20. Applicant has not submitted the fees the support the addition of this class.

ARGUMENT

A mark shall be refused registration where it is so similar to a registered mark as to be likely, when applied to the applicant's goods, to cause confusion, or mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. Section 2(d). Such likelihood of confusion may be deemed to exist where (1) the applicant's mark is confusingly similar to the registered mark and (2) the applicant's goods are related to the goods distinguished by the registered marks. See *In re August Storck KG*, 218 USPQ 823 (TTAB 1983).

I. APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTERED MARKS

Applicant does not contest the fact that its mark is identical to the registered mark. The purchasing public will not be able to distinguish applicant's mark from the registered marks.

II. APPLICANT'S GOODS ARE SUFFICIENTLY RELATED TO THE REGISTRANT'S SERVICES SUCH THAT A PRUDENT PURCHASER MAY BE CONFUSED AS TO THE SOURCE OF THE GOODS

Applicant argues that the likelihood of confusion refusal is improper because the examining attorney has not submitted any evidence that applicant's goods are actually sold in the registrant's stores. Applicant has discounted the examining attorney's third party registration evidence arguing that it is not evidence of how a particular mark is used in the marketplace. Applicant offers printouts from the registrant's web site arguing that it only sells goods offered under the manufacturer's brand name. Absent clear evidence that applicant's goods are sold in registrant's stores, the examining attorney's refusal should be withdrawn.

The examining attorney is not persuaded by the applicant's arguments. The examining attorney is not required to show that applicant's goods are actually sold in the registrant's stores. The examining attorney is only required to show whether there is a sufficient nexus between applicant's goods and the registrant's services such that the purchasing public may be led to believe that both the goods and services originate from the same source. The goods/services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i). 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). TMEP §§1207.01(a) and 1207.01(b).

It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (SEILER for catering services held likely to be confused with SEILER'S for smoked and cured meats); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services held likely to be confused with AZTECA for Mexican food products); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services held likely to be confused with GOLDEN GRIDDLE for table syrup); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988) (MUCKY DUCK and duck design for mustard held likely to be confused with THE MUCKY DUCK and duck design for restaurant services); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms).

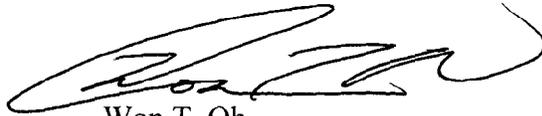
The examining attorney has clearly supported the position that retail stores sell items that also bear its house mark. The third party registrations that applicant so quickly dismisses clearly shows that the purchasing public is accustomed to seeing stores sell not only other manufacturers' goods but also its own goods. Thus even if applicant's goods may not be sold in the registrant's stores, the expansion of trade doctrine supports some level of protection for these type of goods. The examining attorney must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). TMEP §1207.01(a)(v). The examining attorney must resolve any doubt 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).

SUMMARY

Applicant's identification of goods is unacceptable because certain items are improperly classified and requires further clarification. The examining attorney has suggested proper wording and appropriate classification for applicant's identification of goods. Applicant's mark is identical to the registered mark. Applicant's goods are also highly related to the registrant's services. In light of these facts, the examining attorney properly

refused registration of Applicant's mark for the identified goods under Trademark Act Section 2(d). Therefore the examining attorney respectfully requests that the Board affirm the refusal to register applicant's mark.

Respectfully Submitted

A handwritten signature in black ink, appearing to read 'Won T. Oh', with a large, sweeping flourish extending to the right.

Won T. Oh
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