

TTAB

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I hereby certify that, on the date indicated above I deposited this paper or fee with the U.S. Postal Service and that it was addressed for delivery to the Assistant Commissioner of Trademarks, Box TTAB NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 by "Express Mail Post Office to Addressee's service."

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08-19-2002

ATTY. DOCKET NO. 103185/41987

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

TRADEMARK TRIAL AND APPEAL BOARD 02 AUG 30 AM 12:14

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

Commissioner for Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3513

APPLICANT'S REPLY BRIEF

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As provided by 37 C.F.R. § 2.142(b)(1), Applicant Atico International USA Inc. (“Atico”), respectfully submits this reply brief in response to the Examining Attorney’s Appeal Brief, mailed August 6, 2002, and in further support of Atico’s memorandum in support of its appeal of the Final Refusal 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.”¹ The Examining Attorney’s continued reliance on third-party registrations which do not, as a matter of law, constitute evidence of use in the marketplace, fails to overcome the clear arguments presented by Atico in its Appellant’s Appeal Brief. The refusal to register remains unsupported, and should be reversed.

I. IDENTIFICATION OF GOODS

With respect to the proposed acceptable identification of goods proffered by the Examining Attorney in his Examining Attorney’s Appeal Brief (“Attorney’s Brief,”), Atico hereby amends the identification of good for the referenced application to correspond precisely to the acceptable identification of goods proffered by the Examining Attorney. Atico submits herewith a check in the amount of \$325.00, to cover the filing fee for the International Class (20) not already paid.

¹ See Ex. 1 to Applicant’s Appeal Brief (“Applicant’s Brief”), at p. 1. 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.

II. THE EXAMINING ATTORNEY'S ARGUMENTS LACK SUPPORT

Atico notes that the previously cited registration for the mark ALCO YES has been canceled. (Attorney's Brief at 1).

With respect to the Examining Attorney's arguments, his continued reliance on third-party registrations is unavailing. (*Id.* at 5). As noted in Atico's Appellant's Brief, such registration are not evidence that the cited registrant, Duckwall-ALCO Stores, sells goods through its ALCO retail services under an ALCO brand or trade name.

The Examining Attorney's principal (of not sole) argument appears to be this:

The third party registrations that applicant so quickly dismisses clearly shows [*sic*] that the purchasing public is accustomed to seeing stores sell not only other manufacturers' goods but also its [*sic*] 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 types of goods.

(*Id.*). That this position is contrary to both reason and controlling law has been established by Atico.

As a matter of law, third party registrations are not evidence of how a 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 agrees. 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.”).

The Examining Attorney’s proffered third party registrations are irrelevant without some evidence of use of the cited marks in the marketplace. As noted by Atico, there is no such evidence. Indeed, the only evidence of marketplace use of the cited registered mark is proffered by Atico, viz., that the cited registrant does not sell goods at its ALCO or retail outlets under the ALCO brand name, but rather sells goods under the manufacturer’s brand name.²

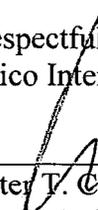
There is no evidence of marketplace sale of goods under a mark that is the same as the mark of the retail services through which such goods are sold. The Examining Attorney’s

2 See Ex. 6 to Applicant’s Brief.

argument is thus entirely conclusory, and is contrary to law and the evidence of record. The refusal to register the proposed mark ALCO in connection with the intended goods (as amended, *supra*) should be reversed.

Respectfully submitted,
Atico International USA, Inc.

Date: August 19, 2002



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August 19, 2002

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Re: Applicant: Atico International USA, Inc.
Mark: ALCO
Serial No.: 76/251,522
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 REPLY BRIEF with Express Mail Certificate;
2. Check for \$325.00 to cover the filing fee for the International Class 20 not already paid; and
3. Acknowledgment postcard.

Very truly yours,


Peter T. Cobrin

Enclosures

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