

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

Applicant: Isabella Fiore, LLC
Application Serial No.: 76/445173
Filed: August 29, 2002
Mark: FIORE
Law Office: 108
Examining Attorney: Sonya B. Stephens

APPLICANT'S REPLY BRIEF IN SUPPORT OF APPEAL

Commissioner for Trademarks
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202
BOX TTAB

This brief is filed in reply to the Examining Attorney's Appeal Brief submitted December 1, 2004 (the "Examiner's Brief"). Unless otherwise defined herein, all capitalized terms have the definitions supplied in Applicant's original Brief in Support of Appeal submitted on October 1, 2004 (the "Applicant's Brief").

I. INTRODUCTION AND PROCEDURAL HISTORY

For an introduction to the facts of this case and a summary of the procedural history, please refer to pages 1-2 of the Applicant's Brief and pages 2-3 of the Examiner's Brief.¹

¹ Applicant also wishes to clear up any confusion created by submission of Applicant's Brief by Melissa A. Weiland, General Counsel of Accessory Design Holdings, Inc. ("ADH"). Ms. Weiland is also the General Counsel of Isabella Fiore, LLC, a subsidiary of ADH, and files this Reply Brief and Applicant's Brief together with attorney Valerie du Laney of Miller Nash, LLP, who remains counsel of record.

II. ARGUMENTS IN REPLY TO EXAMINER'S BRIEF

A. OVERVIEW OF ARGUMENT

As previously stated in Applicant's Brief, both case law and the legislative history of the Trademark Act indicate that, in determining whether a mark should be refused registration because of its surname significance, the question to be addressed is whether the mark at issue has primary significance only as a surname. See Applicant's Brief at 3 (citing *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 206 (C.C.P.A. 1953); *Ex Parte Rivera Watch Corp.*, 106 U.S.P.Q. 145, 149 (Comm'r Pats. 1955); and *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33-34 (D.C. Cir. 1953)). Both Applicant and the Examining Attorney appear to agree with this general standard. See Examiner's Brief at 4. It is the factors to be considered and the weight to be given to each factor in making the determination of primary surname significance on which the parties disagree. In addressing this issue, the Examiner's Brief and the Final Action share the same flawed, central underpinnings – (i) that evidence of surname significance alone is grounds for refusal, even in the face of evidence of other readily ascertainable meanings for a mark; (ii) that a mark's alternative meaning must be in English to be relevant to the primary surname significance inquiry; and (iii) that evidence of each other suggestive meaning or connotation must be "major" or "famous" in order to be relevant or persuasive. Applicant believes each of these to be fallacies and addresses them in order in the arguments that follow.

B. ARGUMENTS

1. Evidence of Surname Significance.

It goes without saying that, under the "primary" significance standard, proof of a mark's co-existence as a surname does not, standing alone, support a surname refusal. While evaluation of this proof is the first step in the inquiry, many other factors also must be considered, including

whether the mark at issue has any other “readily ascertainable meanings” and whether anyone associated with the applicant bears the mark as a surname. *See* T.M.E.P. 1211.01(a)(1) (and citations therein); *In re Establissements Darty et Fils*, 759 F.2d 15, 225 U.S.P.Q. 652 (Fed. Cir. 1985).

Applicant does not dispute the fact that there exist people in the United States who have the term “Fiore” as a surname. Indeed, the Examining Attorney’s insistent focus on this admission and on the number of surname records produced for “Fiore” belie an assumption that the argument is won just by the number of telephone database records produced. But even assuming *arguendo* that this modicum of evidence makes for a *prima facie* case of primary surname significance,² Applicant respectfully reminds the reader that the inquiry only begins there. Significantly, each of the cases repeatedly cited by the Examining Attorney for the proposition that a minimal number of records showing surname significance may support a refusal to register involved a mark that had no other alternative meanings or connotations. *See* Final Action at 3; Examiner’s Brief at 7 (citing *In re Industrie Pirelli S.p.A.*, 9 U.S.P.Q. 1564 (T.T.A.B. 1988); *In re Petrin Corp.*, 231 U.S.P.Q. 902 (T.T.A.B. 1986); and *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (T.T.A.B. 1986)). These cases are inapposite from the present case, where Applicant has shown a readily ascertainable Italian meaning for the mark, as well as

² Although the Examining Attorney dismisses as untimely Applicant’s argument that the massive scope of the databases at issue must be taken into account by the Trademark Trial and Appeal Board (the “Board”) when reviewing the Examining Attorney’s evidence, the rules are clear that it is right and proper for the Board to take judicial notice of encyclopedic facts and the like. *See* T.B.M.P. 1208.4; *see also In re United Distillers PLC*, 56 U.S.P.Q. 1220, 1222 (T.T.A.B. 2000) (comparing the 1295 records of the surname HACKLER adduced by the Examining Attorney to the 80 million records available in the entire database and reversing the surname refusal accordingly).

myriad other geographic and historical connotations. In the face of this evidence, records tending to show only that the mark happens to be a surname – and a relatively uncommon one at that – do not prove that the mark’s primary significance to the purchasing public will be as a surname and nothing else.

2. Evidence of Ordinary Foreign Language Meaning.

In the Final Action, the Examining Attorney asserted, without citing any relevant authority, that a mark’s non-surname significance in a foreign language cannot overcome evidence that it is used as a surname in the United States. *See* Final Action at 3. In the Examiner’s Brief, this argument is taken one step further, to the point that a mark’s non-surname significance in a foreign language is wholly irrelevant to its significance in the United States:

Whatever meaning a term may have to the purchasing public of another country (e.g. Italy) *has no bearing* on the determination of the term’s significance to consumers in the United States. . . .

Given that English is the predominant language in the United States, in order for another meaning of a surname to have bearing upon whether the primary significance thereof is that of a surname, the other or alternative meaning generally must be that of an ordinary, readily recognizable (rather than obscure) *English term as opposed to a foreign word*. . . .

It is evident that, in this case, the additional meaning asserted by applicant for the surname “FIORE” is that of an Italian word (i.e., “FIORE”) which, while susceptible to translation into English as “flower,” is nonetheless *not an English term* itself.

See Examiner’s Brief at 8-9 (emphasis supplied).

For this proposition, the Examining Attorney first cites *In re Wickuler-Kupper-Brauerei KGaA*, 221 U.S.P.Q. 469 (T.T.A.B. 1983), a case dealing with (i) the surname significance of the word “Kupper” in the mark “Kupper Kolsch” and (ii) the disclaimer of the German word “Kolsch” in that mark. In *Wickuler-Kupper-Brauerei*, the Board required that the German word “Kolsch” in the mark be disclaimed, since it was descriptive of beer, the product the mark was

used to sell in the U.S. Thus, contrary to the Examining Attorney's position, this case actually highlights the relevance of a word's foreign meaning to its significance in the United States. The Examining Attorney also cites *In re Hamilton Pharmaceuticals Ltd.*, 27 U.S.P.Q.2d 1939 (T.T.A.B. 1993) and *In re Nelson Souto Major Piquet*, 5 U.S.P.Q.2d 1367 (T.T.A.B. 1987) in support of her position, but in neither of these cases can any distinction regarding foreign language meanings be found. In each of them, the applicant (whose last name also happened to be the mark at issue), asserted an extremely obscure and little-known alternative English meaning for the mark. It bears repeating that, to date, no case cited by the Examining Attorney actually supports her position that, in making a determination of primary surname significance, any foreign meanings of a mark should be ignored, or even discounted, simply because they are foreign.

There is good reason for this lack of support: The position is incorrect. Take, for example, *In re Industrie Pirelli S.p.A.*, 9 USPQ2d 1564 (T.T.A.B. 1988). In that case, the Board affirmed the trademark examiners' final refusal to register the mark PIRELLI on the basis of primary surname significance largely because the mark had *no ordinary meaning in the Italian language* (and also because the chairman of the applicant's parent group in that case had the surname Pirelli). *See id.* at 1566. Likewise, the fact that the mark DARTY did not appear in either the *French or English* dictionary was relevant to the issue of primary surname significance in *In re Establissements Darty et Fils*, 759 F.2d 15, 16, 225 U.S.P.Q. 652 (Fed. Cir. 1985).³ Similarly, in *In re United Distillers PLC*, 56 USPQ 2d 1220 (T.T.A.B. 2000), the Old English

³ Also relevant in that case was as was the fact that the mark was used in a manner which would reveal its surname significance to "those with a modicum of familiarity with the French language". *See id.*, 759 F.2d at 17.

meaning of the word HACKLER saved that mark from refusal based on primary surname significance, even in the face of phonebook evidence showing it to be a surname of roughly equivalent popularity to FIORE. *See id.* at 1222. *See also In re Monotype Corp. PLC*, 14 USPQ2d 1070 (T.T.A.B. 1989) (primary surname significance refusal reversed where the mark CALISTO had alternative meanings as either a moon of Jupiter or a Greek nymph). Case law thus seems clear that any readily ascertainable meaning for a word, whether in English or another language, is relevant to the determination of primary surname significance.

Applicant's mark FIORE has a readily ascertainable, non-archaic and non-obscure Italian meaning, which is the simplest and most straightforward of things – a flower. This the Examining Attorney instinctively recognized when, in the Non-Final Action, she found that the word “fiore” was an Italian word for “flower” and requested a formal translation for it.⁴ The Examining Attorney has offered no evidence tending to show that this ordinary meaning will be overcome by the surname significance of the word “Fiore” in the United States.

3. Other Suggestive Meanings.

Applicant has offered substantial evidence that, in addition to bearing a literal translation in Italian, the term “fiore” is highly suggestive of other meanings, all of which, by Applicant's design, point to Italy. These include the geographic and other place names of towns, streets, villas and cathedrals in Italy, as well as historical and cultural associations such as the Italian philosopher Joachim of Fiore and the classic Italian folk dance, “Ballo del Fiore, or “Dance of the Flower.” *See Applicant's Brief* at 9-10. The Examining Attorney attempts to push this

⁴ While the Examining Attorney argues that the Italian meaning of the word “fiore” is irrelevant, she simultaneously takes the position that its ability to be recognized as an *Italian surname* is highly significant. *See Examiner's Brief* at 11. This inconsistency is telling.

evidence aside by arguing that, taken individually, each alternative meaning is too minor to defeat evidence that the mark has surname significance. Thus the geographic connotations are unpersuasive because none have been shown to have “major significance as a geographic term,” and the historical connections are irrelevant because none is “so widely recognized that it is almost exclusively associated with a particular historical figure.” *See* Examiner’s Brief at 9-10. In this way, the Examining Attorney seems to be arguing that, in order to overcome evidence of surname significance, each alternative meaning proffered by the Applicant must itself be the primary meaning of the word “fiore”.

Again, this is where Applicant and the Examining Attorney differ. Assuming for the sake of argument that the Examining Attorney has shown that these other alternative meanings are not primary, the fact finder must still consider these suggestive associations and connotations as a whole and address their overall effect. As reflected in the case law, although a term may be a surname, when, upon coupling with the product it is used to sell, it is highly suggestive of another meaning, the suggested meaning may supplant any potential surname significance. Thus in *In re BDH Two Inc.*, 26 U.S.P.Q. 2d 1556 (T.T.A.B. 1993), the Board found the surname GRAINGERS in connection with the applicant’s cracker and snack products to be “suggestive of grain” and, even in the absence of any proffered alternative meaning for the term, reversed the examiner’s refusal on the basis of primary surname significance. Likewise, in *In re Pyro-Spectaculars Inc.*, 63 USPQ 2d 2022 (T.T.A.B. 2002), the mutual connotation of patriotism between the product, fireworks, and the suggested historical reference, John Phillip Sousa, tipped the scales in favor of registration of the mark SOUSA. *See id.* at 2024.

As the description of goods associated with the mark establishes, and as Applicant has shown, the mark FIORE will be used in conjunction with Applicant’s handbag and accessories

line, which by its nature includes leather and other fine goods. Like many other brands in Applicant's class and price point, Applicant's goods are intended to be associated with and evocative of Italian fashion and style, Italian leathers and other source materials, and Italian workmanship. These associations are made more likely by the choice of an Italian word – "fiore" – for the mark, which, in addition to its literal Italian translation, is associated with and highly suggestive of a plethora of other things Italian.

D. CONCLUSION

Notwithstanding the Trademark Examiner's assertion to the contrary, at the end of the day, substantial evidence is required to show that a mark will be understood primarily as merely a surname to the purchasing public. *See On-Line Careline, Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1085 (Fed Cir. 2000). And on review, any doubt with respect to this issue must be resolved in favor of the Applicant. *See In re Benthin Management GmbH*, 37 U.S.P.Q. 2d 1332 (T.T.A.B. 1995).

The Examining Attorney in this case has offered evidence that the term FIORE has some surname significance in the United States. The Applicant has rebutted this evidence by showing that the mark has an ascertainable and non-obscure alternative meaning, as well as multiple other connotations and suggestive associations. In light of this evidence, along with the relative rarity of the "Fiore" surname and the fact that no one associated with Applicant has the term as a surname, the Examining Attorney must provide something more to show that, despite Applicant's evidence, the mark's significance to purchasers of Applicant's handbags and other accessories will be solely that of a surname. The Applicant respectfully suggests that this burden has not been met.

The Applicant therefore again requests that the final refusal to register this mark be reversed, that the application file be remanded to the Examining Attorney for publication, and that the mark be permitted to register.

E. REQUEST FOR ORAL HEARING

In the event that the TTAB would find it helpful, Applicant also requests the opportunity to appear before the TTAB for an oral hearing of this matter.

Respectfully submitted, this 21st day of December, 2004.

By 

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ACCESSORY DESIGN HOLDINGS, INC.

December 21, 2004

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United States Patent and Trademark Office
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BOX TTAB

VIA UPS NET DAY AIR

Attention: Trademark Trial and Appeals Board

Subject: Ex Parte Appeal Reply Brief
Application Serial No. 76/445173
Isabella Fiore, LLC/FIORE
International Class 18

Dear Sir or Madam,

On behalf of Isabella Fiore, LLC (the "Applicant"), enclosed please find the Applicant's Reply Brief in Support of Appeal for the above-referenced Application Serial No. 76/445173.

Should you have any questions or need additional information, please contact me at (206) 381-9191, ext. 102, or at mweiland@adhinc.com. I look forward to hearing from you.

Respectfully submitted,



Melissa A. Weiland
General Counsel

On behalf of Isabella Fiore, LLC



12-23-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

Enclosures

I, Kelly Wright, hereby certify that these documents have been deposited on December 21, 2004 for hand-delivery by UPS, via Next Day Air Early A.M. delivery, to the United States Patent and Trademark Office, at Commissioner for Trademarks, 2900 Crystal Avenue, Arlington, Virginia 22202.



Kelly Wright