

Hearing:  
December 3, 2008

**THIS OPINION IS  
NOT A PRECEDENT  
OF THE TTAB**

Mailed:  
January 8, 2009

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Franco Ferrari, S.r.l.

Serial No. 76545104

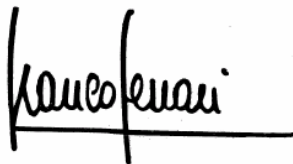
Kathleen A. Costigan of Hedman & Costigan, P.C.

John Hwang, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

Before Grendel, Rogers and Zervas, Administrative Trademark  
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Franco Ferrari, S.r.l. ("applicant") filed, on  
September 16, 2003, an application to register on the  
Principal Register the mark

A handwritten signature in black ink that reads "Franco Ferrari". The signature is written in a cursive style and is underlined with a single horizontal line.

for goods ultimately identified as "textile fabrics for use  
in the manufacture of clothing; fabric of imitation animal  
skin; glass cloth; woolen fabric; bed blankets; table

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cloths not of paper; tapestries of textile; handkerchiefs; and fabric flags" in International Class 24; and the following International Class 25 goods:

Foulards; scarves; shawls; clothing for ladies, gents and children, namely, suits made of leather; shirts; blouses; skirts; tailleurs; jackets; trousers; shorts; vests; jerseys; pajamas; bathrobes; stockings; singlets; clothing corsets; garters; pants; bras; petticoats; hats; neck-ties; raincoats; overcoats; greatcoats; bathing suits; tracksuits; wind resistant jackets; ski pants; belts; fur coats; gloves; dressing gowns; footwear in general, namely, slippers; shoes; sports shoes; boots and sandals.<sup>1</sup>

Registration of applicant's mark for the goods in each International Class has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of each of the following three previously registered standard character form marks:

Registration No. 2665194 ("194") issued December 24, 2002 for the mark FRANCO FERRARO for "clothing, namely, suits, dresses, skirts, blouses, jackets, jerkins, pants, t-shirts, coats, overcoats and raincoats" in International Class 25;

Registration No. 2895631 ("631") issued October 19, 2004 for the mark FERRARI for "Automobile racing suits, T-shirts, sweat shirts, polo-shirts, ties, caps, overalls, wind resistant jackets, waterproof jackets, blazers, pullovers, coats, robes, scarves, shoes, boots, sweaters, shirts, trousers, belts, raincoats, truck suits, shorts, gloves, pyjamas, slippers, swim-wear" in International Class 25; and

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<sup>1</sup> Application Serial No. 76545104, based on Sections 44(e) and 1(b) of the Trademark Act, 15 U.S.C. §§ 1126(e) and 1051(b).

Registration No. 2956960 ("960") issued May 31, 2005 for the mark FERRARI for "Flags made from fabrics, textile table cloths and napkins, beach towels, bed linen, bed covers" in International Class 24.<sup>2</sup>

When the refusal was made final, applicant filed this appeal and requested reconsideration. The examining attorney denied the request for reconsideration and the appeal was resumed. Both applicant and the examining attorney filed briefs and the Board conducted a hearing on December 3, 2008. We affirm the refusal to register.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See

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<sup>2</sup> The '631 and '960 registrations issued to the same registrant.

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also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the *du Pont* factor regarding the similarity or dissimilarity of the goods.

International Class 24 goods

Because applicant's application and Registration No. 2956960 for FERRARI recite "fabric flags" and "flags made from fabrics," respectively, applicant's International Class 24 goods are identical in part to those of the '960 registrant. Also, applicant's "bed blankets" are encompassed within the "bed covers" of the '960 registration.

Applicant's identification of goods also recites goods which are not identical to or encompassed within registrants' identifications. It is well settled, however, that goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an

association between the producers of the goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). In this regard, the examining attorney has made of record use-based third-party registrations that recite textile fabrics, tablecloths and/or bed blankets, and various articles of clothing of the kind recited in the FRANCO FERRARO registration. Third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).<sup>3</sup>

Thus, the examining attorney has established that applicant's textile fabrics, fabric of imitation animal skin, bed blankets, table cloths and fabric flags are identical, similar to or encompassed within registrants' goods.

International Class 25 goods

Because both applicant's application and the '631 registration recite shirts, scarves, shorts, raincoats,

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<sup>3</sup> We have not given any consideration to those third-party registrations which are not based on use in commerce.

wind resistant jackets, slippers, boots and shoes, applicant's and the '631 registrant's goods are in part identical. Further, both the application and the '194 registration recite blouses, raincoats and overcoats, applicant's "suits made of leather" are included within the '194 registrant's "suits," and applicant's "shirts" include the '194 registrant's "t-shirts." Applicant's basic clothing items are thus identical to, encompassed within or otherwise similar to registrants' goods.

In view of the foregoing, and because applicant has not contended otherwise, we resolve the *du Pont* factor regarding the similarity or dissimilarity of the goods in favor of finding a likelihood of confusion.

We also resolve the *du Pont* factors regarding the trade channels and classes of purchasers for each International Class in favor of finding a likelihood of confusion. Because the goods are identical in part, their trade channels and classes of purchasers are legally identical. See *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages").

Next, we turn to the *du Pont* factor regarding the similarity or dissimilarity of applicant's and registrants' marks when compared in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In cases such as the one before us, where the applicant's goods are identical in part to registrants' goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Before comparing the marks, however, we consider applicant's contention that it seeks registration of "a distinctive design mark." The examining attorney challenges applicant's contention and contends that applicant is seeking to register FRANCO FERRARI in a stylized font.

We agree with the examining attorney - applicant's mark is not so extreme or highly stylized that the wording in the mark is unrecognizable or that it is essentially a design mark which conveys a distinct impression separate from its words. First, the mark is displayed as a

signature is displayed, on one line, and looks like a signature. Second, an elevated dot appears on the right side of the mark in the position where the dot on a lower case letter "i" would appear. Third, several letters are recognizable in the mark, such as the letters "a", "o," "f" and "i," which signal consumers that the letters spell something, and that the mark is not a design. Once the purchaser perceives the letters in the mark, the purchaser will try and determine what the wording is. Fourth, the mark does not resemble anything except a signature and contains no geometric shapes or patterns.

Additionally, while applicant argues in its brief that its mark is a design mark, applicant also argues that its mark is different in sound from the registered FERRARI mark, stating that the marks have the sound "FER-RAR-O as opposed to FER-RAR-I..." Brief at p. 9. If applicant's mark were truly a design, it would not have the sounds that applicant attributes to its mark. We also note that in its original application papers, applicant identified the mark as "FRANCO FERRARI"; and at p. 2 of its response to the examining attorney's first Office action it stated "Applicant is using the trademark as a signature in stylized type." At least early in the prosecution of its



application, applicant did not take the position that its mark was a design.

For the foregoing reasons, we disagree with applicant and agree with the examining attorney - the mark is a stylized depiction of the wording FRANCO FERRARI and not a design.

As for registrants' marks, each of their marks is a standard character mark. As such, registrants' rights in their marks are not limited to the depiction of such marks in any special form. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). When a word mark is registered in typed or standard character form, the Board must consider all reasonable modes of display that could be represented, including a signature form similar to that in which applicant's mark appears. *Id.* at 36. As mentioned above, we do not consider the stylized lettering in applicant's mark to be so extreme or unrecognizable to not be a reasonable mode of display of registrants' marks. The stylized lettering of applicant's mark consequently does not serve to distinguish applicant's mark from the cited marks.

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Registration No. 2665194 for FRANCO FERRARO

In view of the broad possible modes of display we must accord to registrant's mark, including a display similar to that of applicant's mark, the only difference between the marks is the final letter in the second word of each mark. This subtle difference in the last syllable of the multi-syllable marks does not sufficiently distinguish the marks from one another; they are highly similar in sound, appearance, meaning and commercial impression.<sup>4</sup>

Registration Nos. 2895631 and 2956960 for FERRARI

Of course, the only difference between applicant's mark and the cited marks is the term FRANCO in applicant's mark. FERRARI has surname significance; the FERRARI mark in Registration No. 2956960 was registered under Section 2(f) of the Trademark Act, 1052(f), indicating that registrant established that its mark has acquired distinctiveness, which is necessary for a mark which is primarily merely a surname.<sup>5</sup> Even with the addition of FRANCO to FERRARI, the meaning and commercial impression of

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<sup>4</sup> Applicant has argued at p. 7 of its brief that "FRANCO FERRARI[] identifies a specific individual, its founder" without explaining how this fact lessens the likelihood of confusion. This argument is not persuasive; consumers will still confuse the source of the goods even if applicant's mark has some connection to an individual, who the record reveals is not living.

<sup>5</sup> The Office record for this registration does not indicate that the term FERRARI has any meaning in a foreign language.

applicant's mark remains the same as the meaning and commercial impression of registrant's marks, i.e., as a name. The addition of FRANCO merely emphasizes that FERRARI is an individual's name, rather than a place or some other thing. See *In re Chatam Int'l Inc.* 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) regarding the mark JOSE GASPAR GOLD, stating:

With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark. See *E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291-92 [21 USPQ2d 1824] (9th Cir. 1992) (affirming that GALLO and JOSEPH GALLO are similar); *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1073-74 [12 USPQ2d 1901] (Fed. Cir. 1989) (holding that VITTORIO RICCI and NINA RICCI are similar); *John B. Stetson Co. v. Stephen L. Stetson Co.*, 85 F.2d 586, 587 (2d Cir. 1936) (holding that STEPHEN L. STETSON and STETSON are similar).... In sum, the first name JOSE modifies the surname GASPAR and serves to emphasize that GASPAR is a name.

Additionally, because of the shared term FERRARI, FRANCO FERRARI and FERRARI bear a strong similarity in appearance and sound. As the examining attorney has pointed out citing *Chatam Int'l, supra*, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of

confusion under Section 2(d).<sup>6</sup> Thus, despite the addition of FRANCO, we find the marks to be similar.

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity of the marks in favor of finding a likelihood of confusion.

Applicant argues that it is entitled to registration because the FERRARI marks registered despite the existence of the FRANCO FERRARO registration.<sup>7</sup> "All the cited registrations granted despite the fact that the goods were the same or, as stated by the Examiner, those that may emanate from a single source." Brief at p. 8. We are not persuaded by applicant's argument. First, the Board is not bound by prior decisions of examining attorneys, but must decide each case on its own merits. *In re Nett Designs*

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<sup>6</sup> Applicant, in contrast, cites to *Holiday Inns, Inc. v. Trump*, 617 F. Supp. 1443 (D.N.J. 1985) (TRUMP PLAZA/TRUMP CASTLE CASINO HOTEL); *Worsham Sprinkler Co., Inc v. Wes Worsham Fire Protection, LLC*, 419 F. Supp. 2d 861 (E.D. Va. 2006) (WES WORSHAM FIRE PROTECTION/WORSHAM SPRINKLER); and *Abraham Zion Corp. v. Lebow*, 593 F. Supp. 551 (S.D.N.Y. 1984), *aff'd*, 761 F.2d 93 (2d Cir. 1985) (HARRY LEBOW/LEBOW), as decisions which support registration. *Holiday Inns* is not persuasive because it does not involve the addition of a first name to a surname, and *Worsham Sprinkler* is not persuasive because the involved marks contain wording beyond the involved names that distances one mark from another. *Abraham Zion* is not persuasive because the court in concluding that confusion was not likely relied on facts such as the identification of the manufacturer of the goods and the sophistication of purchasers, and not necessarily on any differences in the marks.

<sup>7</sup> Applicant also maintains that the FRANCO FERRARO mark registered over a registration for a FERRARI and design mark. Because the FERRARI and design registration is not of record, we do not give this registration any consideration.

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*Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Second, applicant's mark is closer to FRANCO FERRARO and to FERRARI than FERRARI is to FRANCO FERRARO.

Applicant also argues that it "has been marketing its high fashion goods under the FRANCO FERRARI mark at the finest high fashion retailers in the United States since at least 1979." Brief at p. 7. If, in so arguing, applicant suggests that care is taken by purchasers in making purchasing decisions, applicant's argument is not persuasive. We are constrained in this proceeding to consider the goods as set forth in the application, which are not limited to "high fashion goods" but encompass inexpensive clothing items. Also, in considering the registrability of applicant's mark, we do not consider the manner of actual use of applicant's mark.

In weighing the relevant *du Pont* factors discussed above, we conclude (i) that applicant's mark for its International Class 24 goods is likely to be confused with the marks of the three cited registrations; and (ii) that applicant's mark for its International Class 25 goods is likely to be confused with the marks of Registration Nos. 2665194 and 2895631.

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Decision: The refusal to register under Section 2(d) in International Classes 24 and 25 under Section 2(d) is affirmed.