
To: Fuent, Daisy (laipmail@gtlaw.com)
Subject: TRADEMARK APPLICATION NO. 78341970 - DF DAISY FUENTES - 72793-010100
Sent: 11/2/2005 11:20:45 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/341970

APPLICANT: Fuent, Daisy

CORRESPONDENT ADDRESS:
STEVEN M. WEINBERG
GREENBERG TRAUIG, LLP
THE WATER GARDENS, 2450 COLORADO AVENUE
SANTA MONICA CA 90404

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: DF DAISY FUENTES

CORRESPONDENT'S REFERENCE/DOCKET NO: 72793-010100

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:
laipmail@gtlaw.com

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 78/341970

This Office action supersedes the previous Office action dated March 11, 2005 issued in connection with this application.

This letter responds to applicant's communication filed on January 14, 2005.

Likelihood of Confusion – Final Refusal Continued

For the reasons set forth below, the FINAL refusal under Trademark Act Section 2(d), 15 U.S.C. §1052 (d), is continued with respect to U.S. Registration No(s). 2454071. 37 C.F.R. §2.64(a).

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

The Goods

The applicant uses its mark on "jewelry, watches and clocks" and the registrant's mark is used on "watches, watch bands and jewelry." The applicant's "jewelry" and "watches" are identical to the registrant's goods, and the applicant's "watch bands" are related to the registrant's goods because they are complementary to the registrant's "watches." Further, the applicant's "clocks" are related to the registrant's goods because "clocks" and "watches" commonly emanate from a common source, as is seen in the attached third-party registrations.

If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698 (Fed. Cir. 1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

Applicant contends that the marketing of the goods by the parties differs because only applicant's goods are promoted for their association with Daisy Fuentes, who is a well known celebrity. However, the association of the applicant's goods with Daisy Fuentes will not distinguish the source of the parties' goods for consumers because consumers encountering the similar "DF" marks on the identical and related goods of the parties will be confused into believing that even registrant's goods are associated with Daisy Fuentes.

The Marks

It is the applicant's position that the marks are not similar because the applicant's mark includes the name of a well known celebrity, DAISY FUENTES, which identifies a line of merchandise bearing her name. The applicant submits that the inclusion of DAISY FUENTES in the mark changes its meaning, appearance and sound.

Where marks are otherwise virtually the same, the addition of a house mark is more likely to add to the likelihood of confusion than to distinguish the marks. *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982). It is likely not only that the two products sold under these marks would be attributed to the same source but also that purchasers would mistakenly assume that both were products of applicant by virtue of its use of DAISY FUENTES with the shared term DF. See *In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986), citing *Menendez v. Holt*, 128 US 514 (1888) ("It is a general rule that the addition of extra matter such as a house mark or trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them."); *A.T. Cross Co., v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 176 USPQ 15 (2nd Cir. 1972); *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 168 USPQ 1 (2nd Cir 1970); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200 (C.C.P.A. 1955); *Hammermill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662, 143 USPQ 237 (C.C.P.A. 1964). Each such case must be determined on its own facts and circumstances. *Rockwood Chocolate Co., Inc. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (C.C.P.A. 1967).

Moreover, the addition of the name "DAISY FUENTES" to the applicant's mark does not change the appearance of the mark in a manner that would make confusion unlikely since the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and "JOSE GASPAR GOLD"); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilly Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLY ANN"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202

USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"); TMEP §1207.01(b) (iii).

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).

Based on the similarity of the marks and relatedness of the goods, the FINAL refusal based on Section 2 (d) of the Trademark Act is maintained and continued.

Response to a Final Refusal

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). See 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

Remarks

The undersigned apologizes for the inclusion of an incorrect cite (Registration No. 2827030) and an incorrect designation of the goods in the previous Office action.

/Vivian Micznik First/
Vivian Micznik First
Trademark Attorney, Law Office 114
571-272-9159

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via

TEAS).

- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

Print: Nov 2, 2005

79000617

DESIGN MARK

Serial Number

79000617

Status

REGISTERED

Word Mark

RESONANCE

Standard Character Mark

Yes

Registration Number

3007543

Date Registered

2005/10/18

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

François-Paul Journe INDIVIDUAL FRANCE 17, rue de l'Arquebuse CH-1204
Genève SWITZERLAND

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Precious metals and their alloys sold in bulk; jewellery, precious
stones; timepieces and chronometric instruments, namely clocks,
watches, table clocks and chronometers.

Priority Date

2003/09/26

Filing Date

2003/12/02

Examining Attorney

NEVILLE, BRIAN

RESONANCE

DESIGN MARK

Serial Number
79001122

Status
REGISTERED

Word Mark
POLICE

Standard Character Mark
No

Registration Number
3008976

Date Registered
2005/10/25

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner
DE RIGO S.P.A. CORPORATION ITALY Zona Industriale Villanova 12
LONGARONE (Belluno) ITALY

Goods/Services
Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Precious metals, namely, gold, silver, platinum and their alloys;
diamonds; cut diamonds; precious stones; jewelry; jewels; cuff links
and tie clips; wrist watches; clocks; watch straps; chronometers;
jewelry coated with precious metal; cases and other packaging
articles, namely, cases for watches, cases for clocks, cases made of
precious metal for jewelry and jewels, and boxes made of precious
metal for jewelry and jewels.

Goods/Services
Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050.
G & S: Books in the field of sports; dictionaries; newspapers in the
field of sports; comic strips; cartoon strips; periodicals in the
fields of sports; magazines in the field of sports; catalogs for use
in the field of sporting activities; post cards; note paper; paper
articles, namely, exercise books, blotting paper, photocopying paper,
photographs, stationery; adhesives for stationery use; glues for

stationery use; paint brushes; type-writers; punching machines for office purposes; instructional and teaching supplies, namely, football plans, document folders; playing cards; printing type; printing cliches; stamp inking pads; rubber stamps; stamp holders, namely, stamp albums; dating stamps; pencil sharpeners; stationery and household adhesive tapes; pen holders; ballpoint pens; pencils; fountain-pens; chalk; paper clips; drawing compasses; drawing squares and rulers; envelopes; letter paper; carbon paper; letter openers; self adhesive paper labels; posters; visiting-cards; and diaries.

Goods/Services

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S: Luggage, namely attache' cases, garment bags, suitcases, briefcases, athletic bags, duffel bags, hat boxes for travel, overnight cases, vanity cases, traveling bags, trunks, shoulder bags; key cases, purses, handbags, wallets and umbrellas.

Prior Registration(s)

2141822

Filing Date

2004/02/10

Examining Attorney

CORDOVA, RAUL

Attorney of Record

Frank P. Presta

POLICE

Print: Nov 2, 2005

79001251

DESIGN MARK

Serial Number

79001251

Status

REGISTERED

Word Mark

LD

Standard Character Mark

No

Registration Number

3008980

Date Registered

2005/10/25

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

LIGUORI DOROTEA INDIVIDUAL ITALY Via E. De Nicola, 26 I-80059 TORRE DEL GRECO (NA) ITALY

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: Bracelets, rings, necklaces, earrings, pins, pendants, cufflinks, decorative boxes and candle holders all made of precious metals; precious metal alloys; jewelry; precious stones; clocks, watches, chronometers.

Priority Date

2003/11/05

Description of Mark

The trademark is made by a couple of stylized and fancy letters "LD" which cross one another.

Filing Date

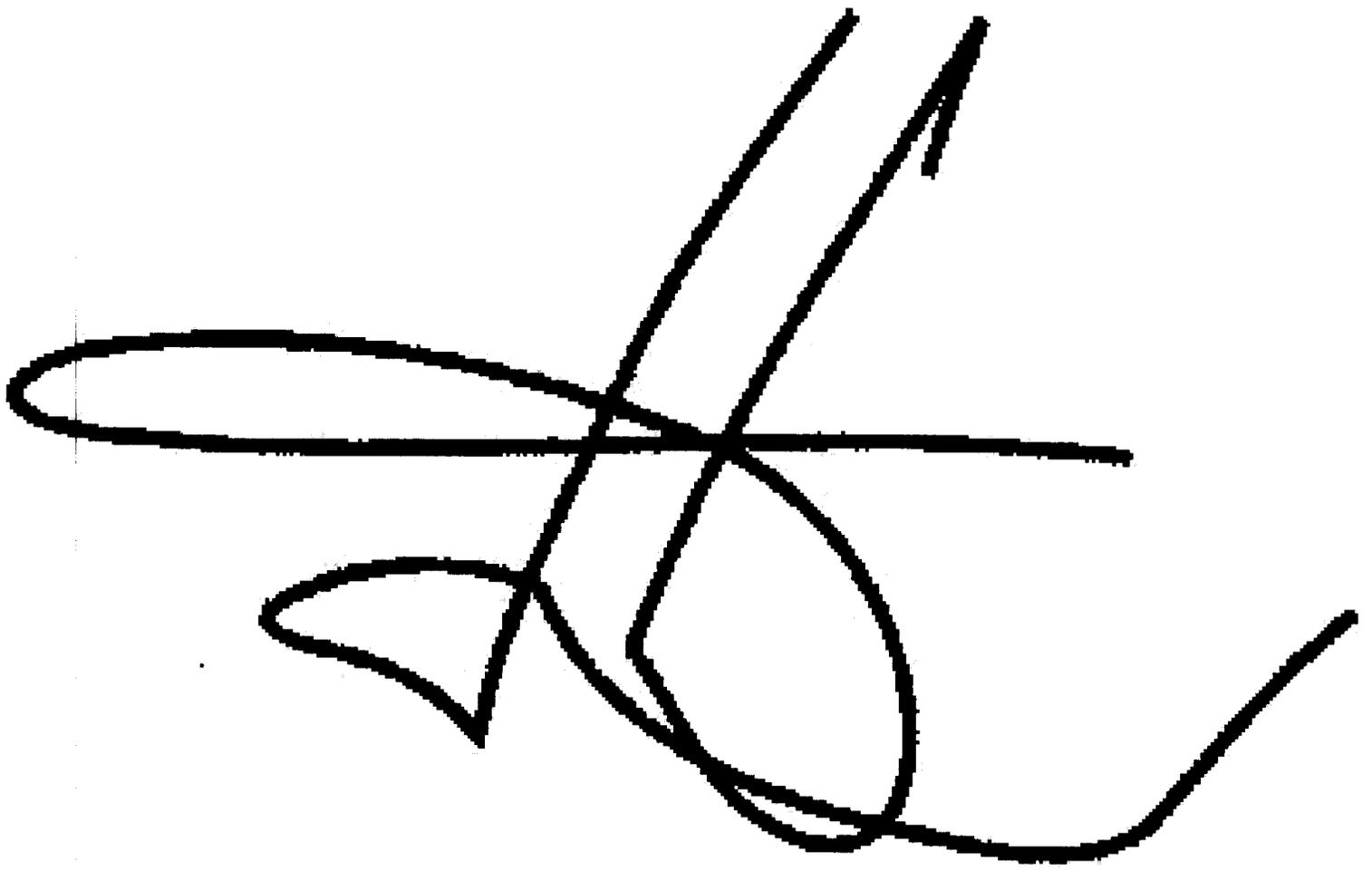
2004/01/12

Examining Attorney

Print: Nov 2, 2005

79001251

GARDNER, BERYL



Print: Nov 2, 2005

79001300

DESIGN MARK

Serial Number

79001300

Status

REGISTERED

Word Mark

TISSOT HIGH-T

Standard Character Mark

Yes

Registration Number

3008982

Date Registered

2005/10/25

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Tissot SA JOINT STOCK COMPANY SWITZERLAND Chemin des Tourelles 17
CH-2400 Le Locle SWITZERLAND

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Horological and chronometric instruments namely watches, watch
straps, watch bracelets and parts for the aforesaid goods, chronometers
for use as watches, chronographs, clocks, alarm-clocks, watches made
of precious me-metals, watches partly or entirely set with precious
stones.

Priority Date

2003/09/23

Filing Date

2004/03/01

Examining Attorney

SLOAN, CYNTHIA

TISSOT HIGH-T

DESIGN MARK

Serial Number
79001507

Status
REGISTERED

Word Mark
ESCADA

Standard Character Mark
Yes

Registration Number
3007556

Date Registered
2005/10/18

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
ESCADA AG CORPORATION FED REP GERMANY Margaretha-Ley-Ring 1 D-85609
Aschheim FED REP GERMANY

Goods/Services
Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S:
Perfumery, cosmetics.

Goods/Services
Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Spectacles and sunglasses.

Goods/Services
Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Jewellery, fashion jewellery, precious stones, clocks and watches.

Goods/Services
Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S:
goods made of leather and imitations of leather, namely, handbags,
cosmetic cases sold empty, business card cases, sports bags, overnight
cases, purses, wallets, key cases, traveling bags, trunks, umbrellas,
parasols.

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: articles of clothing, namely, trousers, pants, slacks, Bermuda shorts, jackets, blazers, dresses, gowns, ball gowns, cat suits, knit cardigans, knit pants, sweaters, knit shirts, pullovers, knit skirts, jeans, coats, half-coats, cloaks, track suits, pajamas, bikinis, swimsuits, skiing suits, cardigan sweaters, suits, skirts, shirts, blouses, t-shirts, body stockings, underwear, tights, socks, scarves, shawls, foulards, kerchiefs, mufflers, belts, shoes, footwear, hats, headwear.

Prior Registration(s)

1219137;1574202;2710538;AND OTHERS

Translation Statement

Staircase (ESCADA is a Portuguese word)

Filing Date

2003/12/16

Examining Attorney

NELSON, EDWARD H.

ESCADA

Print: Nov 2, 2005

79003477

DESIGN MARK

Serial Number

79003477

Status

REGISTERED

Word Mark

THE KISS COUPLE'S

Standard Character Mark

No

Registration Number

3006053

Date Registered

2005/10/11

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

TOKYO TRADING CO., LTD. Joint-stock Company JAPAN Shibuya-Markcity
West 23F 1-12-1 Dogenzaka,; Shibuya-ku; Tokyo 150-0043 JAPAN

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
precious metals; clocks and watches; personal ornaments, namely rings,
necklaces, bracelets, bangles, earrings, pierced earrings, and
brooches made from precious metals.

Filing Date

2004/06/11

Examining Attorney

CHOE, KELLY

THE KISS COUPLE'S

DESIGN MARK

Serial Number

79003643

Status

REGISTERED

Registration Number

3007562

Date Registered

2005/10/18

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(2) DESIGN ONLY

Owner

BNP PARIBAS Société anonyme FRANCE 16, Bld des Italiens F-75009 PARIS FRANCE

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: Watches, watch cases, watch bands, chronographs for use as watches, alarm clocks, fancy key rings of precious metal, tie pins, tie clips, cuff links, medals.

Goods/Services

Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050. G & S: Posters, almanacs, stickers, price tickets, memo pads, writing pads, desk calendars, wall calendars, documents files, pencils, writing paper and envelopes, paper labels, paper flags, pictures, pencil lead holders, checkbook holders, telephone indexes, plastic or paper bags in the nature of envelopes and pouches for merchandise packaging, fountain pens, photographs, wrapping paper.

Goods/Services

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S: Umbrellas, parasols, canes, school bags, business card cases, credit card cases, name card cases, key cases, briefcases, wallets, attaché cases, suitcases, change purses, beach bags, shopping bags with wheels attached, leather bags in the nature of envelopes and pouches for merchandise packaging, backpacks, travel bags, vanity cases sold empty, handbags, hunters' game bags, luggage in the nature of trunks.

Print: Nov 2, 2005

79003643

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Footwear, headgear namely hats, caps, cap peaks; bathrobes, bandanas, head bands, scarves, clothing belts, chemisettes, neckties, pullovers, T-shirts, sports coats, sports shirts, shorts, wind resistant jackets, wind shirts.

Priority Date

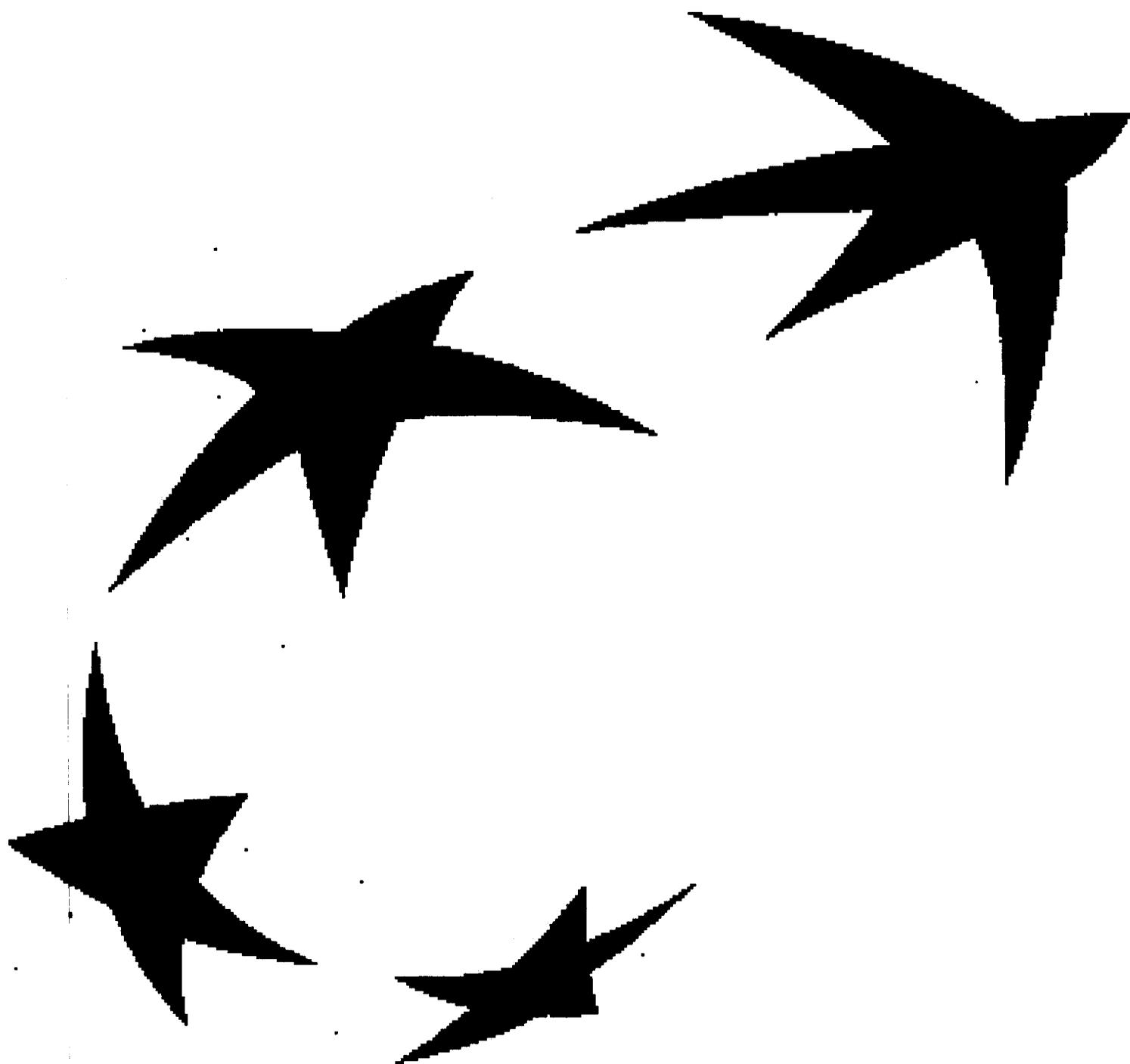
2003/10/08

Filing Date

2004/02/16

Examining Attorney

MCCRAY, RENEE



Print: Nov 2, 2005

79005227

DESIGN MARK

Serial Number

79005227

Status

REGISTERED

Word Mark

CRADLEBACK

Standard Character Mark

Yes

Registration Number

3004604

Date Registered

2005/10/04

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

ALFRED DUNHILL LIMITED LIMITED COMPANY UNITED KINGDOM 30 Duke Street
St. James's; LONDON, SW1Y 6DL UNITED KINGDOM

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Horological and chronometric instruments; clocks, watches; watch
straps, watch bracelets; jewellery, cufflinks; tie bars, tie pins;
shirt and collar studs.

Priority Date

2004/02/27

Filing Date

2004/08/18

Examining Attorney

MADDEN, ANNE

CRADLEBACK

Print: Nov 2, 2005

79005228

DESIGN MARK

Serial Number
79005228

Status
REGISTERED

Word Mark
CITYFIGHTER

Standard Character Mark
Yes

Registration Number
3006068

Date Registered
2005/10/11

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
ALFRED DUNHILL LIMITED LIMITED COMPANY UNITED KINGDOM 30 Duke Street
St. James's; LONDON, SW1Y 6DL UNITED KINGDOM

Goods/Services
Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Horological and chronometric instruments; clocks, watches; watch
straps, watch bracelets; jewellery, cufflinks; tie bars, tie pins;
shirt and collar studs.

Priority Date
2004/02/27

Filing Date
2004/08/18

Examining Attorney
REGAN, BRENDAN

CITYFIGHTER

Print: Nov 2, 2005

79006934

DESIGN MARK

Serial Number
79006934

Status
REGISTERED

Word Mark
CITYTAMER

Standard Character Mark
Yes

Registration Number
3006072

Date Registered
2005/10/11

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
ALFRED DUNHILL LIMITED LIMITED COMPANY UNITED KINGDOM 30 Duke Street
St. James's; LONDON, SW1Y 6DL UNITED KINGDOM

Goods/Services
Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Horological and chronometric instruments; clocks, watches; watch
straps, watch bracelets; jewellery, cufflinks; tie bars, tie pins;
shirt and collar studs.

Priority Date
2004/04/16

Filing Date
2004/10/07

Examining Attorney
REGAN, BRENDAN

CITYTAMER