

ESTTA Tracking number: **ESTTA298933**

Filing date: **08/04/2009**

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

Proceeding	79028161
Applicant	Müller, Durrer & Müller,; Schuhateliers
Applied for Mark	VABEENE
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Submission	Appeal Brief
Attachments	VABEENE - APPEAL BRIEF.pdf (6 pages)(426202 bytes)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: Müller, Durrer & Müller, Schuhateliers

Serial No.: 79/028,161

Filed: June 30, 2006

Mark: VABEENE

Trademark Law Office: 107

Examining Attorney:
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Commissioner for Trademarks

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APPELLANT'S APPEAL BRIEF

INTRODUCTION

This Brief is in support of Appellant's appeal from the Examining Attorney's FINAL Office Action dated December 7, 2008 and respectfully requests that the Trademark Trial and Appeal Board (hereinafter "the Board") reverse the Examining Attorney's FINAL refusal to register the proposed mark VABEENE pursuant to Section 2(d) of the Trademark Act.

Appellant filed its application to register the mark VABEENE on June 30, 2006. The Examining Attorney issued a first Office Action on December 5, 2006. Appellant filed a response thereto on June 1, 2007. Thereafter, action on the application was suspended pending the disposition of the noted prior pending application. On April 3, 2008, an Office Action issued, among other things, formally refusing registration of Appellant's mark. Appellant's response was filed on October 3, 2008, and a FINAL Office Action next issued on December 7, 2008. On June 5, 2009, Appellant filed its Notice of Appeal from that final rejection providing Appellant sixty (60) days for filing its Brief.

Appellant seeks registration, on the Principal Register of its mark, VABEENE. The current identification for Appellant's application is "leather and imitations of leather and goods

made of these materials, namely handbags and evening bags; trunks and traveling bags, umbrellas, parasols and walking sticks” in International Class 18 and “clothing, namely, footwear” in Class 25.

On December 5, 2006, the Examining Attorney issued a provisional refusal of Appellant’s mark noting the existence of a prior pending mark that could form the basis of a refusal of registration under Section 2(d) of the Trademark Act if that application should mature to registration. The Examining Attorney also indicated that Appellant must amend the identification of goods as originally filed, provide a translation for the mark and specify the Appellant’s legal nature and place of incorporation.

Appellant filed its response on June 1, 2007. As part of that response, Appellant amended the identification of goods, limiting both the Class 18 and 25 descriptions of goods to read as stated above. Additionally, Appellant apprised the Examining Attorney of the fact that its mark, VABEENE, is a coined term without any English translation or any other meaning or significance. Appellant also argued in opposition to the potential refusal to register noting that the marks are different in sight, sound and commercial impression, particularly given the fact that the mark associated with the prior pending application, VABENE, does have an English translation and arguably suggestive meaning and also noting the disparity in the goods underlying the two applications.

Thereafter, on July 29, 2007, action on the Appellant’s application was suspended pending the disposition of the noted prior pending application. The requirement to specify the Appellant’s legal nature and place of incorporation was continued. On April 3, 2008, the Examining Attorney issued a formally refusing registration of Appellant’s mark on the ground that it is confusingly similar to the mark shown in Registration No. 3,185,827. That registration is for the mark VABENE and covers a single item in Class 25, suits.

On October 3, 2008, Appellant filed an extensive response challenging the refusal based upon the disparity as between the marks and the associated goods, and Appellant clarified its legal nature and place of incorporation. On December 7, 2008, the Examining Attorney continued and made FINAL the refusal to register the mark under Section 2(d) of the Trademark Act.

ARGUMENTS

Disparity in the Marks

In making a comparison as to the resemblance as between any two marks, it is important to consider the marks in their entireties. This requires, among other things, an analysis of: the overall impression created by the designations, pronunciation of the marks, translation of foreign words, and connotations or meanings of the designations. *Restatement Third, Unfair Competition*, §21(a)(1995). While Appellant concedes its mark and the registered mark have certain letter patterns in common, the mere fact that the marks have common lettering within them is not determinative in likelihood of confusion analysis. It has long been recognized that

any comparison of conflicting marks cannot be considered complete if it does not also include an evaluation of differences in the meanings and/or connotations of those marks. *See, Revlon, Inc. v. Jerell, Inc.*, 713 F. Supp. 93, 11 U.S.P.Q.2d 1612, 1616 (S.D.N.Y. 1989) (“Such differences of connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used.”)

In the instant case, Appellant’s mark is the singular term VABEENE comprised, in large part, of repetitive vowels. The multiple Es in the center of the mark not only impact the way the mark is pronounced and/or sounds, but they also create the impression of an elongated term that has a distinctive visual impact. Registrant’s mark, on the other hand, VABENE, is a shorter compact term that alternates consonants and vowels. The differences as between the marks is further highlighted by the fact that Appellant’s mark is a coined term having no direct or indirect meaning or significance to consumers other than its significance as Applicant’s trademark, while the Registrant’s mark is an Italian term that translates into English as “good” and was arguably selected in order to reference, infer and/or connote that the products bearing the mark are of good quality. Taken together this series of differences as to the look, sound and meaning of the respective marks is significant.

In the case of *The Morrison Milling Company v. General Mills, Inc.*, 436 F.2d 1050, 168 U.S.P.Q. 591 (C.C.P.A. 1971), the court specifically stated:

Turning, then, to a comparison of marks, we cannot agree with the board that the marks so resemble each other that confusion or mistake as to the origin of the goods is likely. While it is true that “Kits” and “Kix,” or “Corn-Kits” and “Corn Kix” are somewhat similar in sound and appearance, they nevertheless possess entirely different connotations. “Kix” or “Corn Kix” itself is arbitrary, having no well defined meaning. “Kits” or “Corn-Kits,” on the other hand, is suggestive of the packaging form of appellant’s product—a handy “kit” from which one can easily prepare corn muffins or corn bread.

Id. at 592. Such is the case here. Although the marks have similar elements and/or lettering, they are different in key ways. The marks look different. They sound different. Perhaps, most significantly, one is an arbitrary term while the other is a term whose meaning is meant to reference or suggest some feature or characteristic of the associated goods.

Disparity in the Goods

While these facts and legal precedent demonstrate that the marks at issue are sufficiently disparate such that the Appellant’s mark should be entitled to registration, Appellant further contends that the goods at issue are sufficiently distinguishable. With respect to the related nature of Registrant’s suits to Appellant’s footwear, it must be remembered that there is no *per se* rule that the use of the same or similar marks on different items of wearing apparel will result in consumer confusion, *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984). Similarly, with respect to the related nature of Registrant’s suits to the other goods covered by

the instant application, such as handbags, traveling bags and/or umbrellas, it must be remembered that there is no *per se* rule that goods are to be considered sufficiently related just because they are sold in the same kind of establishment. See, e.g., *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1984 (Fed Cir. 2000) on remand 56 U.S.P.Q.2d 1859 (T.T.A.B. 2000).

Time and time again the Board and the courts have stated that clothing cases must be determined on a case by case basis focusing not only on the similarity of the marks but also taking into consideration the disparity as between the specific items involved. See, e.g., *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 202 U.S.P.Q. 81 (2d Cir. 1979) (no likelihood of confusion between DRIZZLER for men's golf jackets and DRIZZLE for women's overcoats and raincoats); *H. Lubovsky, Inc. v. Esprit de Corp.*, 627 F. Supp. 483, 228 U.S.P.Q. 814 (S.D.N.Y. 1986) (ESPRIT on shoes was found to be strong enough to create confusion from use on shoes, but not from use on wearing apparel); *In re Shoe Works, Inc.*, 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (no likelihood of confusion between PALM BAY for use on women's shoes and PALM BAY for use on shorts and pants); *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 166 F.3d 191, 49 U.S.P.Q.2d 1493 (3d Cir. 1999) (no likelihood of confusion between MIRACLESUIT for swimwear and MIRACLE BRA on lingerie); *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 57 F. Supp. 2d 155, 52 U.S.P.Q.2d 1143 (E.D. Pa. 1999), judgment aff'd as to no direct confusion, rev'd as to reverse confusion, 237 F.3d 198, 57 U.S.P.Q.2d 1097 (3d Cir. 2000) (no likelihood of confusion between senior MIRACLESUIT for swimwear versus junior MIRACLE BRA on swimwear). The analysis can not stop at the fact that the goods could be viewed as falling in the same industry and/or purchased by the same class of purchasers. Rather, it is necessary to evaluate, among other things, how modern consumers shop and whether or not they are likely believe that goods are related because they are sold within a single establishment.

While Appellant does not dispute the fact that there are some large retailers that sell both suits and one or more of the items covered in Applicant's application, it also contends that suits are different from footwear and perhaps even more distinguishable from items such as handbags, traveling bags and parasols. Specifically, even in those instances where suits and footwear and/or suits and traveling bags, handbags, umbrellas and/or walking sticks are sold by the same retailer or marketed by a single manufacturer, they will be available for purchase within different departments as parts of distinct purchasing decisions and/or available at entirely different stores. This difference in the location and timing of the purchasing decisions is significant in that it highlights the unrelated nature of the goods.

In *In re Weyerhaeuer Company*, 180 U.S.P.Q. 274 (T.T.A.B. 1973), the applicant, Weyerhaeuser Company sought registration of its TENDER TOUCH mark for use in association with disposable diapers of cellulose material with plastic backing. Registration was refused under Section 2(d) in light of an existing registration for the identical mark for use in association with ladies undergarments, namely, slips, petticoats and panties. On appeal of the FINAL refusal, the TTAB reversed the Examining Attorney stating:

After careful consideration of the arguments presented by the examiner and applicant, we are inclined to agree with applicant that the distinctively different character of disposable

cellulose diapers and ladies' undergarments; that these products are purchased under different circumstance and conditions in different stores or in different location or departments in stores that may carry both; and that the term "TENDER TOUCH" possesses an obviously suggestive significance as applied to goods concerned are all factors tending to obviate the likelihood that purchasers of such goods, although the same, would attribute these products to the same producer.

Id. at 274. The Weyerhauser case is far from the only instance where the TTAB has determined that the mere fact that respective goods could be sold within the same type of retail store is not a sufficient basis for finding the goods to be sufficiently related relative to a finding of likelihood of confusion. In *In re Sears Roebuck and Company*, 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987), the Board allowed the applicant to register the mark CROSS-OVER for brassieres despite the fact that the virtually identical mark CROSSOVER was previously registered for ladies sportswear. The Board based its determination, in large part on the fact that the products were sold at a competitive distance from one another. See also *Minnesota Mining and Manufacturing Company v. Sterling Products Co., Inc.*, 127 U.S.P.Q. 83 (T.T.A.B. 1960); *Anderson, Clayton & Co. v. Krier*, 178 U.S.P.Q. 46 (C.C.P.A 1973); *Borden, Inc. v. Placo Products Co.*, 197 U.S.P.Q. 580 (T.T.A.B. 1977). See also *Jockey International, Inc. v. Frantti*, 196 U.S.P.Q. 705, 707 (T.T.A.B. 1977) (hockey equipment bags are manifestly different from various articles of and there is no possibility that applicant's product would be bought when opposer's product is desired).

It should also be noted that the fact that the Examining Attorney can identify various third party registrations that cover suits as well as footwear or certain other of Appellant's goods is not determinative in a likelihood of confusion analysis. The courts and the Trademark Trial and Appeal Board have consistently held that "little weight is to be given such [third-party registrations] in evaluating whether there is a likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them...." See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 U.S.P.Q. 268 (C.C.P.A. 1973). In the case of *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783, 1993 WL 596274 (T.T.A.B. 1993), the Board found that no likelihood of confusion existed between an application for the mark PHOENIX for leather sold in bulk and the cited registration of an identical PHOENIX mark for luggage despite the Trademark Examiner's citation of five third-party registrations of marks for both types of goods. The Board stressed that such third-party evidence had "very limited" probative value. *Id.* at 1786. The Board came to a similar conclusion in *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917 (T.T.A.B. 2006), appeal dismissed, 2006 WL 1876826 (Fed. Cir. 2006) where third-party registrations for both clothing and automobiles failed to convince the Board that identical TUNDRA marks on clothing and automobiles would cause a likelihood of consumer confusion.

The addition of a few webpage printouts relating to just three retailers can not be said to prove such goods are always deemed related, especially, where as here, the marks associated with the goods are NOT identical. In today's society, consumers know that some retailers sell different and unrelated types goods marketed under the same mark. This marketplace reality does not lead modern consumers to always infer a connection between such goods. In *In re Sydel Lingerie Co.*, 197 U.S.P.Q. 629 (T.T.A.B. 1977), the court found no likelihood of confusion to exist between

identical BOTTOMS UP marks used on ladies and children's underwear and men's suit coats and trousers, respectively, due to the fact that the goods would be ordinarily be found in distinctly different areas or sections of a store and the fact that the marks project different commercial impressions in association with the goods. Similarly, in *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984), the Board determined that the identical PLAYER'S mark could be used by different parties in association with men's underwear and in association with shoes without resulting in a likelihood of purchaser confusion since the goods would be found in different departments in the same store and because the mark, PLAYER'S, had different connotations when applied to the different goods.

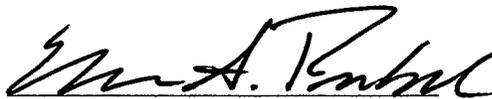
In the final assessment, it is the combination of these facts, the differing commercial impressions of the marks and the differing nature of the goods that support a finding that the Appellant's VABEENE mark is not sufficiently similar to the registered VABENE mark that the contemporaneous use of the two marks would result in consumer confusion. That is, these facts present far more than just the use of similar marks on similar types of goods. The marks at issue and the goods associated with each mark are distinguishable in key ways.

Given the differences in the appearance, sound commercial impression and connotation of the respective marks and given the disparity as between the associated services, Appellant asserts that its VABEENE mark is entitled to registration and requests that the refusal to registration be withdrawn and that the application be immediately approved for publication. In the event that the Board finds confusion likely as to the Class 25 goods, Appellant urges the Board to make a separate analysis as to the Class 18 goods and come to a different result.

CONCLUSIONS

Based on these Arguments and Remarks, Appellant avers that there is no likelihood of confusion between Applicant's mark and Registrant's VABENE mark sufficient to support a refusal for registration under Section 2(d) of the Trademark Act relative to the goods identified in Class 18 and/or Class 25. Therefore, Appellant respectfully asks that the Board reverse the Examining Attorney's FINAL refusal and allow the instant application to proceed to publication.

Respectfully submitted,



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Dated: August 4, 2009