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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 79/028161

**MARK:** VABEENE



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Müller, Durrer & Müller,;  
Schuhateliers

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## EXAMINING ATTORNEY'S APPEAL BRIEF

### **INTERNATIONAL REGISTRATION NO. 0896681**

Applicant, Müller, Durrer & Müller, Schuhateliers, has appealed the trademark examining attorney's final refusal to register its mark under Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 2(d). Registration was refused because applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 3185827, as to be likely to cause confusion, to cause mistake, or to deceive. TMEP Section 1207. It is respectfully requested that the refusal to register be affirmed.

### FACTS

On June 30, 2006, the present application was filed to register the mark VABEENE for 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, footwear, headgear” in International Class 25. On December 1, 2006, an office action was issued requesting an amendment of the goods and cited application no: 78641634 as a prior pending application. The applicant responded on June 1, 2007. Thereafter, action on the application was suspended pending the disposition of the noted prior pending application. April 04, 2008, registration was refused under Trademark Act Section 2(d) based on a likelihood of confusion between applicant’s mark and the mark in U.S. Registration No. 3185827 for VABENE for “suits” in International Class 25.

After considering the arguments advanced by applicant in support of registration, the examining attorney issued a final refusal on December 7, 2008.

On June 5, 2009, applicant filed a Notice of Appeal from the final.

### **ISSUES ON APPEAL**

The sole issue on appeal is whether applicant’s mark, VABEENE is likely to cause confusion with U.S. Registration No. 3185827 for VABENE.

### **ARGUMENT**

- I. The Asserted Mark VABEENE is Confusingly Similar in Appearance and Sound to the Registered Mark VABENE.**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. See *In re Opus One*,

*Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 et seq.

Here, the marks are nearly identical as to their wording. The only difference between the marks is the applicant's additional letter "E" to the cited registered mark VABENE. The applicant's mark differs by one letter, but they are essentially phonetic equivalents and thus sound similar. This is a significant similarity because similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); TMEP §1207.01(b)(iv). Moreover, applicant concedes that the marks "have certain letter patterns in common." (applicant's brief, p. 2.).

Here, the degree of similarity between the respective marks at issue is indeed great. Both the asserted mark and the mark in the cited registration are presented in typed, standard character form. Consequently, both marks may be presented in similar or even the exact same stylization, if either party so chooses. That is, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); see 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form will not generally avoid likelihood of confusion with a mark in typed or standard

characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

The applicant argued that the marks are pronounced differently and have different connotations. First, there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv); *see In re Energy Telecomm. & Elec. Assoc.*, 222 USPQ 350, 351 (TTAB 1983). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); TMEP §1207.01(b)(iv). Nevertheless, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983).

Additionally, there is no anecdotal or legal basis from which to contend that consumers will necessarily pronounce the respective marks as the Applicant believes they should, despite the applicant's argument that the multiple Es in the applicant's mark impact the pronunciation and/or sound and create a different commercial impression. (Applicant's brief, p.3). The record fails to reflect that either the asserted mark or the

mark in the cited registration actually are or are intended to be pronounced differently. Consequently, consumers are likely to pronounce and view the respective marks similarly.

Ultimately, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The applicant also argues that there is no likelihood of confusion because the registrant's mark is an Italian term for "good" while the applicants mark is an arbitrary term. There is no evidence of record that indicates VABENE is Italian for "good." Assuming, arguably, that the mark is an Italian word, the connotation of the marks to

both non-Italian and Italian speaking consumers must be considered. To an Italian speaking consumer who encounters the mark VABEENE, the perception is that the word VABENE is merely misspelled. Although non-speaking Italian consumers would not understand the meaning of the words, because of the similarity in appearance and pronunciation the marks likely would be perceived as having similar meaning.

Here, the marks clearly are similar in appearance and sound. As the goods of the respective parties are similar in kind and/or closely related, the visual similarities of the respective marks are such that the average purchaser who normally retains a general rather than specific impression of trademarks is likely to be confused as to the source of the respective goods.

## **II. THE GOODS ARE RELATED**

The applicant's goods are identified in the application as "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." The registrant's goods are identified as "suits."

As such, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). The goods or services of the parties however, need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods or services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Footwear and handbags, on the one hand, and clothing items such as suits, on the other, are closely related, complementary articles of everyday wearing apparel. Given the absence of any limitations in either the application or the registration, we assume that these closely related goods move through all the normal channels of trade to all the usual purchasers, and that the trade channels and purchasers for the goods overlap.

The crucial issue is not likelihood of confusion between particular goods or services, but likelihood of confusion as to the source of those goods or services. *See In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP § 1207.01. As such, enclosed in the final Office action were copies of current USPTO registrations showing entities offering and using the same mark on or in connection with suits and

footwear or suits and handbags. Such third-party registrations have probative value to the extent that they serve to suggest that certain goods or services are of a type, which can emanate from a single source. *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

For example, the goods in US Registration 3289741 are identified as “Men's and women's clothing and accessories, namely suits, pants, dress shirts, casual shirts, jackets, blazers, coats, overcoats, skirts, Capri pants, dresses, evening gowns, sleepwear, lingerie, undergarments, underwear, boxer shorts, shorts, t-shirts, shoes, sandals, boots, athletic footwear, rainwear, neckties, socks, belts, leather jackets, leather pants, jeans, caps, hats, headwear, athletic wear, namely, sweat suits, sweat pants, sweat shirts, and jogging outfits, gloves, bathing suits, swim wear, beachwear, bathrobes, tanktops, sweat suits, suspenders, and sun visors” in International Class 25 and “Shoulder bags, purses, suitcases, wallets, brief cases, leather key chains, knapsacks, handbags, gym bags, garment bags, and duffle bags” in International Class 18. Of particular relevance is the fact that the goods in US Registration no. 3374988 include both “handbags” and “footwear” and “suits.”

The description of goods in US Registration no. 2936441 also supports the argument that the goods of the parties are related. Here, the goods are identified as “Leather and imitation of leather, namely wallets, traveling bags, clutch-bags, tote-bags,

handbags, purses, suitcases” in International Class 18 and “Clothing, namely leather jackets, coats, sweaters, shirts, suits, pants, dresses, vests, t-shirts, blazers, raincoats, pants, lingerie, hosiery, blouses, jeans, skirts; swimwear, namely swimsuits, scarves, hats, belts, gloves; footwear, namely shoes, boots, sandals, slippers” in International Class 25. Again, the goods here include both “footwear,” “suits” and “handbags.”

The third party registrations discussed above are probative because they show that the goods of the parties are the sort of goods that are likely to emanate from the same source. The fact that the public is likely to believe that these are the sort of goods that are likely to emanate from the same source shows their relatedness.

Applicant also argues that in instances where its goods and the registrant’s suits are sold in the same retail establishment, that the goods would be available in different departments as part of different purchasing decisions. While it is true all of the goods may be purchased in different departments, all of these items may be part of an ensemble that may be purchased in a single shopping trip. *See in re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (shoes may be featured in a larger ensemble of clothing items frequently purchased in a single shopping expedition, and shoes and clothing may be found in the same stores; thus, shoes found to be complementary with clothing. *See also In re United States Shoe Corp.*, 8 USPQ2d 1938 (TTAB 1988) (cowboy boots and clothing items, including hats, are related and may be sold in the same stores).

Applicant's identification of goods contains no limitations regarding channels of trade. Since neither the application nor the registration contain any limitations regarding trade channels for the goods it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii). Moreover, it is presumed that the goods are marketed to the same classes of purchasers, including ordinary consumers who would use nothing more than ordinary care in making their purchasing decisions about suits, footwear and handbags.

Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii). When the application describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) ("With reference to the channels of trade, applicant's argument that its

goods are sold only in its own retail stores is not persuasive . . . . There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold.”); TMEP §1207.01(a)(iii).

Based on the evidence discussed above and the case law cited here and in the previous office actions, it seems clear that the goods of the parties are highly related.

## **CONCLUSION**

The marks are highly similar and the goods are related. Consumers encountering applicant's mark and the cited mark in the marketplace are likely to mistakenly believe that the goods derive from a common source. The refusal to register the applicant's mark pursuant to Section 2(d) of the Lanham Act should therefore be affirmed.

Respectfully submitted,

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