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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 79069986

MARK: CAVALLI

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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

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1005527

FACTS

On July 16, 2009, Applicant, Roberto Cavalli Club S.R.L., filed an application under Section 66 of the Trademark Act, 15 U.S.C. §1141f(a), for the service mark CAVALLI in standard characters for "[e]ducation; providing of training; entertainment; sporting and cultural activities" in International Class 41, and for "[p]rovision of food and drink; restaurant, bar, cocktail smoking and cigar lounge services, temporary accommodation services; hotels, motels, boarding houses, guest houses, tourist homes," in International Class 43. The Examining Attorney initially refused the Application under Section 2(d) of the Trademark Act for likelihood of confusion with Registration Nos. 3402059 and 3432649 for CAVALLI and ROBERTO CAVALLI, respectively, and cited pending application No. 78548106 for ROBERTO CAVALLI as a potential bar to registration. At the time of the Office Action, each of the cited marks was owned by IGA Finance B.V., a Netherlands Corporation. The Examining Attorney also refused the mark as primarily merely a surname under Section 2(e)(4) of the Trademark Act and required an amendment to the services.

On January 22, 2010, Applicant responded to the refusal under Section 2(d) by stating that the parties constitute a single source even though "they are separate legal entities". Response, Jan. 22, 2010. Applicant did not provide arguments traversing the refusal under Section 2(e)(4) but stated, "[a] mark that is primarily a surname may be registered on the Principal Register under Trademark Act Section 2(f)." Applicant raised a new and separate issue by claiming that the mark had acquired distinctiveness under

Section 2(f), 15 U.S.C. 1052(f), based on the cited registration No. 3402059 for CAVALLI and as "evidenced by IGA Finance B.V's ownership of U.S. Registration Nos. 3213885, 2937821 and 2305384 for similar marks for related goods or services." Response, Jan. 22, 2010. Applicant did not claim ownership of any of the registrations used to support the 2(f) claim but stated that IGA Finance B.V. was "part of the same business group" as Applicant. Applicant also noted the pending application serial No. 78548106 had been abandoned.

On February 9, 2010, the Examining Attorney issued a new non-final Office Action continuing the Section 2(d) refusal because Applicant's statement that the owner of the cited registrations was "part of the same business group" was insufficient to support unity of control. The Examining Attorney clearly explained that where there is merely a legal relationship and one party does not own all or substantially all of other party, Applicant must provide additional evidence in the nature of a detailed written explanation and any documentary evidence showing the parties' "unity of control" over the nature and quality of the goods and services. TMEP §1201.07(b)(ii)-(iii). The Examining Attorney also continued the surname refusal and rejected Applicant's claim of acquired distinctiveness based on use by related companies because the claim was not supported by evidence that one company exercises appropriate control over the nature and quality of the goods and services at issue. Additionally, the Examining Attorney explained that reliance on use of the mark by related companies can only be claimed based on a registration for the same services as in the Application, not merely "related services". *In re Admark, Inc.*, 214 USPQ 302 (TTAB 1982); TMEP §1201.03. And registration No. 3402059, the only registration for legally the same mark, does not contain the same services as in the application.

In its August 18, 2010 response, Applicant again disagreed with the refusal under Section 2(d) stating that the owner of the cited registrations, IGA Finance B.V. had been acquired by Erreci S.R.L. which had also changed its name to Roberto Cavalli S.p.A. Applicant also planned to merge into Roberto Cavalli S.p.A., which would nullify the likelihood of confusion refusal. Applicant again did not argue that the mark was not primarily a surname, but continued to argue that the proposed mark had acquired distinctiveness based on registration No. 3402059 for the same mark for related goods and registration Nos. 3213885, 2937821 and 2305384 for different marks for related goods and services because all the marks would soon be owned by the same entity. However, Applicant did not provide any evidence that the goods or services in any of the registrations were related to the services in the application.

On August 27, 2010, the Examining Attorney issued a Final Office Action continuing the refusal under Section 2(d) with regard to the services in class 43 until Applicant could provide evidence of its relationship to the owner of the cited registrations or evidence of a merger. The Examining Attorney also continued the rejection of the claim of acquired distinctiveness and further argued that the goods and services in the claimed registrations were not sufficiently related to Applicant's services.

On February 28, 2011, Applicant filed this appeal and requested reconsideration of the refusals under Section 2(d) and 2(e)(4). In the request for reconsideration, Applicant provided evidence that its mark was assigned to Roberto Cavalli S.P.A, the owner of cited registration Nos. 3402059 and 3432649. With regard to the surname refusal, Applicant argued for the first time that the mark was not primarily merely a surname because it has a meaning in a foreign language and it does not have the look and feel of a surname. Applicant provided no arguments or evidence in support of the previous claim of acquired distinctiveness.

On May 21, 2011, the Examining Attorney denied reconsideration of the refusal of the mark as a surname, and provided evidence in support of the refusal. Because the application was assigned to the owner of the cited registrations, the likelihood of confusion under Section 2(d) was withdrawn.

ISSUES

I. Whether Applicant's proposed mark CAVALLI is primarily merely a surname under Section 2(e)(4) of the Trademark Act.

II. If CAVALLI is primarily merely a surname, whether it is registrable on the Principal Register for the services in classes 41 and 43 under Section 2(f) based on ownership of registration Nos. 3402059, 3213885, 2937821 and 2305384.

ARGUMENT

I. CAVALLI is Primarily Merely a Surname

The proposed mark CAVALLI is primarily merely a surname under Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4) because the primary significance to the purchasing public is that of a surname and not an Italian word. The primary, not the secondary, significance to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *see* TMEP §§1211, 1211.01. The Trademark Trial and Appeal Board has identified the following factors in determining the primary significance: 1) whether the surname is a rare surname; 2) whether term is the surname of anyone connected with Applicant; 3) whether the term has any recognized meaning other than as a surname; and 4) whether it has the "look and feel" of a surname. *In re Benthim Management GmbH*, 37 USPQ2D 1332, 1333-1334 (TTAB 1995).

A. The Primary Significance of CAVALLI to the Purchasing Public is that of a Surname.

In the Office Action dated February 9, the Examining Attorney attached evidence from a Lexis® public records database where CAVALLI appeared 332 times in a list of surnames. Although Applicant argues that this evidence is insufficient to show that the surname is not rare, Brief at 7, there is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. *See* TMEP §1211.02(b)(i); *see, e.g.*, *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

An additional issue to be considered in determining how rarely a surname is used is the media attention or publicity accorded to public personalities who have the surname. A surname rarely appearing in birth records may nonetheless appear more routinely in news reports, so as to be broadly exposed to the general public. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). In the Office Action dated March 21, 2011, the Examining Attorney provided several pages of evidence from an Internet search for the surname CAVALLI. The evidence includes: a website featuring posters from the artist Angelo Cavalli (pp. 2-7); a page of abstract paintings and sculptures by Mirko Cavalli (pp. 10-13); a reference to Valeria Cavalli, an Assistant Professor of anatomy and neurobiology at Washington University in St.Louis who has co-authored several publications (p. 14); and three law firms identified as Gwilliam Ivary Chiosso Cavalli & Brewer in Oakland, California (pp. 8-9), Cavalli & McCann in New Jersey (pp. 18-19), and attorney Fred L. Cavalli in Georgia (p. 15). Additionally, a search of a Lexis® news publications database shows 724 uses of CAVALLI as a surname in the media in the last two years including a reference to Italian composer Francesco Cavalli. (See 14th of 33 articles attached to end of March 21, 2011 Office Action).

More importantly, the media evidence is filled with references to Roberto Cavalli, a world famous clothing designer. A page from the on-line magazine *AskMen* contains an article about Roberto Cavalli titled "Why is He Famous". (pp 20-23 of March 21, 2011 Office Action). The attached pages 26 to 54 from the March 21 Office Action, all contain references to Roberto Cavalli and identify him as "famous" for being one of the top fashion designers in the world. The attachments also contain references to the world renown designer's products such as sunglasses (pp. 28-29), his "famous shoes" (pp. 36-37), wedding gowns (pp. 38-42), watches (p. 47), and his retail clothing line. (pp. 52-54). Evidence of print media exposure was also submitted within the March 21, 2011 Office Action. The sample of articles from a Lexis® search reference Roberto Cavalli with other famous designers such as Calvin Klein, Jimmy Choo and Ralph Lauren. (See attachments at end of March 21, Office Action). The abundant evidence indicates that, when viewed in the media and in terms of public perception, CAVALLI, is not a rare surname.

The second factor in the surname analysis, whether CAVALLI is the surname of anyone connected to Applicant, weighs heavily in support of the refusal. The Applicant is Roberto Cavalli, S.P.A. and has claimed ownership of registration Nos. 2305384 and 2937821 for ROBERTO CAVALLI for goods and services in the field of fashion. Clearly, the proposed mark is the surname of someone connected to Applicant and would be recognized as such. Moreover, Applicant concedes that this factor weighs in favor of the refusal. Brief at 6.

Regarding the third factor in the analysis, whether the term has any recognized meaning other than as a surname, the term CAVALLI has no other meaning in the English language other than as a surname. The Examining Attorney requests that the Board take judicial notice of the attached pages from *Merriam-Webster*, *Macmillan*, and *Cambridge* on-line dictionaries and a page from *dictionary.com* as evidence that CAVALLI has no meaning in the English language. The Trademark Trial and Appeal Board can take judicial notice of online dictionaries available in printed format or online

dictionaries that are readily available and capable of being verified, e.g., dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); TMEP §710.01(c).

Regarding the last factor in the analysis, the proposed mark CAVALLI clearly has the look and feel of a surname. The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. *In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986); *see* TMEP §1211.01(a)(vi). In *In re Industrie Pirelli*, the Board determined that, although PIRELLI was a very rare surname, it was a surname of someone connected with Applicant and resembled some common Italian-American surnames such as Antonelli, Mancinelli, and Pacelli. *Id.* at 1566. Here, the proposed mark CAVALLI is very similar to PIRELLI in that it also ends with the "lli" sound. In the March 21, 2011 Office Action, the Examining Attorney provided several examples of surnames from whitepages.com that are similar in structure and pronunciation to CAVALLI. The names include Carvelli, Caparelli, Fanelli, Garelli, Mirabelli, Pacelli, Pasquarelli, Tomaselli, Cavall, Covalli, Morelli and Cavallo. (See attached pages 56-91). The Examining Attorney also attached registration No. 3624924 for PASCALLI on the Supplemental Register and Applicant's own registration No. 3402059 for CAVALLI Registered under Section 2(f)[1]. (pp. 92-96). Based on this evidence, CAVALLI has the look and sound of a surname.

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[1] Applicant notes in its brief that it owns a later filed application for CAVALLI (Serial No. 79079375) that has been approved for publication "after Applicant submitted similar arguments". Brief 11-12. However,

B. Consumers of Applicant's Services Would Not Stop and Translate CAVALLI into the English Equivalent.

Applicant's primary argument, raised in the Request for Reconsideration, is that CAVALLI has an alternative, recognized meaning in another language because it is the word for "horses", and therefore, is not primarily a surname. Brief at 8. However, "[t]he doctrine of foreign equivalents is not an absolute rule, but merely a guideline which should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent." TMEP §1211.01(a)(ii) *citing Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In this case, due to the fame and media exposure of Roberto Cavalli, a principle of Applicant, consumers seeing the term CAVALLI are not likely to stop and translate the term into the English equivalent of the plural form of "horse".

Applicant argues that because the term has non-surname meaning that is not obscure in a common, modern language "[t]his alone should be sufficient to show that the CAVALLI mark is not primarily merely a surname." Brief at 9. This argument ignores important factors in the analysis, namely, the "marketplace circumstances or the commercial setting in which the mark is used." *In re La Peregrina Ltd.*, 86 USPQ2d 1645 (TTAB 2008). In *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975) the Board found that consumers at TIA MARIA restaurant surrounded by Mexican décor and serving Mexican food were not likely to translate TIA MARIA to AUNT MARY. Here, the surname CAVALLI will be used with the services provided by Applicant, Roberto Cavalli, S.P.A., and associated with Roberto Cavalli, the world famous fashion designer. (See pp. 26-54 of March 21, 2011 Office Action identifying Cavalli as famous). In *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985), the Court of Appeals found the fact that "the subject mark is not only the surname of the

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the application was withdrawn from publication on May 13, 2011 and a Section 2(e)(4) refusal was re-issued on June 17, 2011.

principal of the business, but also is used in the company name in a manner which reveals its surname significance" was "highly persuasive that the public would perceive DARTY as a surname." *See also, In re Braun Camerawerk*, 124 USPQ 184 (TTAB 1960) ("While "BRAUN" may have a meaning other than that of a surname, it is clear that it is applicant's surname, it is used as such, and it would be thought of and recognized as such by the average purchaser."). In addition to the evidence that Roberto Cavalli is famous, the Examining Attorney provided a web page for CAVALLI CLUB which states that it is "[i]nspired by and launched in collaboration with celebrated designer Roberto Cavalli." (See p. 55 of March 21, 2011 Office Action). The Examining Attorney notes that the original Applicant of the CAVALLI application is Roberto Cavalli *Club* S.R.L. (Emphasis added). This is highly persuasive evidence that the consuming public would immediately associate CAVALLI with Roberto Cavalli when used with the services in classes 41 and 43. Consequently, due to the marketplace circumstances surrounding the use of CAVALLI with the education, entertainment, food and lodging services provided in connection with Roberto Cavalli, consumers are not likely to stop and translate the surname to the plural form of "horse" such that consumers would view the services as HORSES CLUB or HORSES RESTAURANT.

Applicant compares its proposed mark to the mark FIORE in *In re Isabella Fiore*, 75 USPQ2d 1564 (TTAB 2005). However, in *Fiore*, unlike here, the term was not the surname of anyone associated with the applicant and the Board found that consumers would stop and translate the term partially because "the term does not have such an obvious 'look and feel' of a surname that potential consumers would overlook its Italian language meaning." *Id*. at 1570. Here, the proposed mark is clearly the surname of

someone associated with the Applicant and consumers will know it as such due to the fame of the person associated with Applicant and the marketplace circumstances and use of the mark. Further, the Examining Attorney has provided significant evidence that CAVALLI, unlike FIORE, has the look and feel of a surname.

II. Claim of Acquired Distinctiveness Under Section 2(f) Based on Ownership of Prior Registrations.

If the Board finds that Applicant's proposed mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, the Board must address Applicant's claim that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act based on ownership of Registration Nos. 3402059, 3213885, 2937821 and 2305384.[2] In its brief, Applicant restated its claim of acquired distinctiveness under Section 2(f) that was originally raised in its response dated August 13, 2009. The claim is insufficient because the goods and services in the registrations are not sufficiently related to the services in the application and Applicant has made no effort to provide evidence that the secondary meaning established with those marks would transfer to the applied-for services. Moreover, Applicant may not base its claim of acquired distinctiveness on Registration Nos. 3213885, 2937821 and 2305384 because the marks are not legally the same mark.

A. Goods and Services in Claimed Registrations are not Sufficiently Related to the Services in the Application.

The Applicant claims that the proposed mark has acquired distinctiveness for the education and entertainment services in class 41 and the food and temporary accommodation services in class 43 based on ownership of Registration No. 3402059 for the same mark. The goods identified in the registration include "[A]lcoholic beverages

[2] Applicant did not enter copies of the prior registrations into the record. Therefore, the Examining Attorney has attached the registrations herein.

made with brewed malt and natural flavors; alcoholic fruit beverages; alcoholic coffee-based beverages; alcoholic tea based beverages; rum, vodka, wine, whisky, cognac, brandy, grappa, alcoholic bitters, alcoholic bitters aperitifs, champagne, sparkling wines, liqueurs, eaux-de-vie, namely, fruit brandy" in International Class 33, and "[t]obacco; smokers' articles, namely, ashtrays, cigar and cigarette boxes, cigar cases, cigar cutters, cigar holders, cigar tubes, cigarette ash receptacles, cigarette cases, cigarette holders, lighter flints, lighters for smokers of cigarettes, smoking pipes, and snuff boxes" in International Class 34. Applicant has applied for the proposed mark based on §66 of the Trademark Act. "The same standards for establishing acquired distinctiveness apply whether the application is based on §1(a), §44, or §66(a)." TMEP §1212.08. Here, it cannot merely be assumed that consumers would automatically transfer the acquired distinctiveness of the alcoholic beverages, tobacco and smokers products to educational and entertainment services in a variety of fields and to restaurant, bar, cigar lounge and housing and accommodation services.

In determining the relatedness of the goods or services, the Trademark Manual of Examining Procedure provides:

> The examining attorney should determine whether the goods or services named in the application are sufficiently similar to the goods or services named in the prior registration(s). If the relatedness is self-evident, the examining attorney can generally accept the §2(f) claim without additional evidence. This is most likely to occur with ordinary consumer goods or services where the nature of the goods or services is commonly known and readily apparent (e.g., a prior registration for hair shampoo and new application for hair conditioner). However if the relatedness is not self-evident, the examining attorney must not accept the §2(f) claim without evidence **and** an explanation demonstrating the purported relatedness between the goods or services.

TMEP §1212.04(c) (emphasis added).

Applicant argues that its services in Class 43, namely, "provision of food and drinks, restaurants, bars, cocktails, smoking and cigar lounge services, temporary accommodation services, hotels, motels, boarding houses, providing guest housing and accommodations, tourist homes" are "obviously related to the goods identified in U.S. Registration Nos. 3402059 and 3432649."[3] Brief at 14-15. However, "[n]othing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration. Nor do the PTO rules afford any greater rights. Under Rule 2.41(b), in appropriate cases, a prior registration on the Principal Register for the same mark "may" be accepted as "evidence" of distinctiveness, but the same rule reserves to the PTO discretion to require additional proof." *In re Loew's Theaters, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985). In finding that a geographic term had not become distinctive as applied to chewing tobacco despite a preexisting registration for cigars the Court of Appeals stated, "[t]he issue of acquired distinctiveness is a question of fact. . . . We can not say that a requirement for some additional evidence was unduly burdensome or unreasonable or that the finding that distinctiveness was not established was clearly erroneous." *Id*.

Applicant further argues that the services in class 43 are sufficiently related to the goods in the claimed registrations because the Examining Attorney noted the relationship between the goods and services in the Section 2(d) refusal in the first Office Action. However, regarding registration of Levi Strauss' nondistinctive trademark, the Court of Appeals stated, "one seeking to register it as a trademark therefore bears the burden of showing secondary meaning under Section 2(f)." *Levi Strauss & Co. v. Genesco, Inc.*,

[3] The Examining Attorney does not address the 2(f) claim based on ownership of registration No. 3432649 because the claim based on ownership of this registration was not raised during prosecution of the application.

742 F.2d 1401, 222 USPQ 939, 942 (Fed. Cir. 1984). In finding that acquired distinctiveness from long use of its mark on pants did not automatically transfer to shoes, the Court stated, "[t]he strength of the tab as a trademark for pants might be relevant if there were evidence establishing public awareness and transference of its trademark function to related goods." *Id*. Consequently, the Examining Attorney's evidence that some alcohol products and food and beverage services may originate from the same source for likelihood of confusion purposes does not relieve Applicant of its burden of showing that the acquired distinctiveness and public awareness has transferred to the applied-for services. Applicant has made no claim nor provided any evidence that it has even used the proposed mark in United States commerce on the applied-for services in order for public awareness to have transferred to those services. "Although dates of first use are not required in applications based solely on §44 or §66(a), reference to length of use in commerce or information as to specific dates of use in commerce, presented in support of the claim of acquired distinctiveness, is clearly relevant to a determination of the acceptability of the claim." TMEP §1212.08. Unlike a Section 1(b) application, Applicant must show that the acquired distinctiveness has transferred, not "will transfer". TMEP §1212.09(a). Clearly, some evidence regarding secondary meaning and use of the mark for the applied for services is not unduly burdensome or unreasonable.

With respect to the services in Class 41, Applicant argues that the "retail store services relating to apparel, footwear, jewelry, fragrances, cosmetics, sunglasses, spectacle frames, luggage, belts, paper goods, stationery, playing cards, furniture, mirrors, picture frames, household and toilet utensils, glassware, carpets, games, playthings, sporting articles, mobile phones and accessories relating to the aforesaid

goods" in Registration Nos. 3213885 and 2937821 and the Class 25 clothing articles in Registration No. 2305384 are sufficiently related to Applicant's services in Class 41, namely, "education, namely, providing classes, seminars, workshops in the field of culture, art, fashion; training in the use and operation of computer, data processors; entertainment, namely, organizing live performances by musicians, singers and dancers, parties, fashion shows, presentation of live show performances in the field of art, culture and fashion; sporting and cultural activities, namely, entertainment in the nature of live dance and musical performances." Brief at 15. Despite several opportunities Applicant has not provided any evidence or explanation "demonstrating the proposed relationship between the goods or services." TMEP §1212.04(c).

Applicant further argues that the evidence of fame associated with Roberto Cavalli provided by the Examining Attorney somehow "bridges the gap" between the goods and services in the application and the claimed registrations. Brief at 16. However, evidence of the fame of a person as a fashion designer does not establish evidence of the fame of the mark CAVALLI for goods such as food, alcoholic beverages, and smokers' products. Additionally, the Board in *In re Rogers*, 53 USPQ2d 1741, 1745-6 (TTAB 1999), stated that "[t]he owner of a famous mark must still establish a strong likelihood of transference of the trademark function to the goods or services identified in the intent-to-use application." Moreover, reliance on prior registrations as evidence of acquired distinctiveness under Section 2(f) presumes a certain level of consumer awareness of the marks in the registrations. The amount of consumer awareness or fame acquired by those registrations, no matter how extensive, can only transfer to the application if the goods or services are shown to be related. *See Bausch & Lomb*, 6

USPQ2d at 1478 (TTAB 1988). Applicant has provided no evidence of fame for any of its marks or any evidence that any of the goods or services in the registrations are related to the services in the application and that the fame has transferred to those services. Again, the burden is on the Applicant to show how the goods and services are related. *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1478 (TTAB 1988).

B. Registration Nos. 3213885, 2937821 and 2305384 are not the "Same Mark".

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), provides that the Examining Attorney may accept, as evidence of acquired distinctiveness, ownership by applicant of one or more prior registrations of the *same mark* on the Principal Register or under the Act of 1905. TMEP §1212.04. (Emphasis added). In order to be the "same mark" for the purpose of 37 C.F.R. §2.41(b) a previously registered mark must be the "legal equivalent" of such a mark. "A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark." TMEP §1212.04(b) *citing In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

The mark in Registration No. 3213885 is JUST CAVALLI. The mark in Registration No. 2937821 is for the typed mark ROBERTO CAVALLI. And the mark in Registration No. 2305384 is for the wording ROBERTO CAVALLI in stylized form. In *In re Binion*, 93 USPQ2d 1531 (TTAB 2009) the Board held that BINION and BINION'S are not the legal equivalents of the registered marks JACK BINION and JACK BINION'S. Much like the marks in *Binion*, the proposed mark creates the continuing commercial impression of a surname, while the marks for ROBERTO CAVALLI create the commercial impression of the full name of an individual. In

Registration No. 3213885, the mark adds the arbitrary term "JUST" which changes the continuing commercial impression from a surname to an arbitrary phrase.

Applicant argues that because the Examining Attorney originally cited Registration No. 3432649 for ROBERTO CAVALLI for likelihood of confusion under Section 2(d), this is evidence that consumers would consider CAVALLI and ROBERTO CAVALLI the "same mark". This argument is highly misplaced. Under Section 2(d), marks are compared as a whole for *similarities* in appearance, sound, 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)-(b)(v). *Similarity* in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Comparing marks for "similarity" is clearly not the same test as determining the "legal equivalent" such that consumers would consider the marks the "same mark". Therefore, Applicant's claim of acquired distinctiveness based the prior registrations must be rejected.

CONCLUSION

The record shows that the surname CAVALLI is not a rare surname, it is the surname of someone connected with Applicant, it has the "look and sound" of a surname and, based on the fame of a principle of Applicant and the marketplace circumstances, consumers are not likely to stop and translate the surname into its English equivalent. For the foregoing reasons, the refusal of the proposed mark as primarily merely a surname under Section 2(e)(4) should be affirmed. Additionally, for the reasons stated

above the claim of acquired distinctiveness based on ownership of prior registrations should be rejected.

Respectfully submitted,

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- cavalla
- cavil
- cavalier
- Cavallini
- calli
- cavatelli
- cavallas
- cavel
- kaválla
- calli-
- cavalla's

Encyclopedia:

- Cavalla
- Caval
- Cavell
- Kavali
- Kavalla
- C. Vallie
- Kaválla
- Kávalla

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2. Cavell
3. cavil
4. Kavala
5. coeval
6. cheval
7. Colville
8. Cavan
9. cavalier
10. Calvin
11. caviar
12. cavalry
13. caveat
14. clavate
15. Cavite
16. clavier

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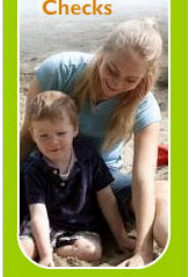

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16. clavier

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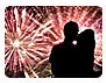

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Top 10 Particular Kinds of Lovers

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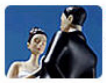

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- **cavilled**
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- **cavalry**
- **rivalling**
- **cavaliers**
- **cavalcade**
- **cavalrymen**
- **metallic**

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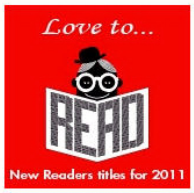

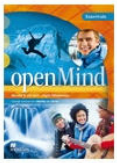

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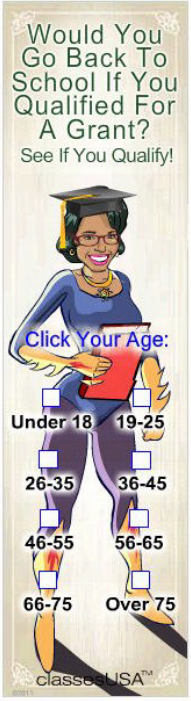

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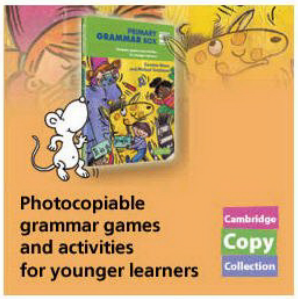
- cavaliers
- cavalcade
- rivalling
- cavalcades
- cavalryman
- metallic



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