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Subject: U.S. TRADEMARK APPLICATION NO. 79074557 - ALEXANDRE DE  
PARIS - N/A - Request for Reconsideration Denied - Return to TTAB - Message 1 of 7

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Attachment Information:

Count: 7

Files: BvlgariA.jpg, Bvlgari-1.jpg, Bvlgari-2.jpg, BvlgariC.jpg, Movado-1.jpg, Movado-2.jpg, 79074557.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 79074557

MARK: ALEXANDRE DE PARIS



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

APPLICANT: ALEXANDRE DE PARIS  
INTERNATIONAL SPRL

CORRESPONDENT'S REFERENCE/DOCKET NO:  
N/A

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE: 6/22/2011**

**INTERNATIONAL REGISTRATION NO. 1017850**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The refusal(s) made final in the Office action dated December 1, 2010 is maintained and continues to be final. *See* TMEP §§715.03(a), 715.04(a). However, *the Section 2(d) refusal is based on Registrations 2124713 and 2145559 only.* The amendments to the identification of goods/services have been entered into the record.

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

***Relatedness of the Parties' Goods is a Factor Supporting a Section 2(d) Likelihood of Confusion Refusal***

In an effort to overcome the Section 2(d) refusal, applicant amended the identification of goods/services to delete some items in Classes 21, 26 and 44, and to include a specific exclusion to the Class 14 goods. These deletions and exclusionary language have been accepted and entered into the record.

Despite the exclusion of identical goods from the application's Class 14, the goods remain closely related to registrant's goods appearing in *Registration No. 2124713* for ALEXANDRE DE PARIS, to the extent that they include goods that are similar in nature and in particular items that would typically be marketed together through the same channels of trade to the same consumers. Here, this includes watches, for example, because both fashion jewelry and jewelry can include watches, which are typically sold together to the same consumers through the same channels of trade. Attached are copies of 18 third-party registrations from the USPTO X-Search database, which show marks used in connection with the same or similar goods as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods listed therein, namely jewelry, fashion jewelry, cuff links, tie pins, earrings, gems AND watches, are of a kind that may emanate from a single source and be identified by the same trademark. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), *citing In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). (*See also the attached third party evidence from jewelry houses Bvlgari, Movado, David Yurman and Cartier showing how watches and clocks, as well as jewelry in general and fashion jewelry such as cuff links in general travel through the same channels of trade, are marketed together, and can be identified by the same mark*).

The goods also remain similar to the extent that the applicant's goods include items such as "jewelry cases, gems, precious stones, medals" all of which are often sold together with watches and clocks, and may be identified by the same mark. (*See attached registrations referenced above, in particular Reg Nos. 2965650, 3373713 and 3942523*). All of these third-party registrations indicate that these goods typically emanate from the same source.

Neither the application nor the registration(s) contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., jewelry stores, 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).

Thus, applicant's exclusionary language in Class 14 does not overcome the likelihood of confusion between applicant's mark and registrant's 2124713. Accordingly, the second part of the likelihood of confusion test is met with respect to *Reg. No.* 2124713.

With respect to *Reg. No.* 2145559, the examining attorney remains of the opinion that the parties' goods are closely related so as to support a likelihood of confusion refusal. Applicant relies on the argument that the parties' goods differ so that the second prong of the likelihood of confusion test fails. Applicant makes mere conclusory statements about how the products are ultimately very different and aimed at different consumers. However, applicant submits no evidence supporting this argument. Simply relying on the fact that the NICE classification system classifies the parties' products in different classes has no bearing on the Section 2(d) likelihood of confusion analysis. Proper classification of goods and services is a purely administrative matter within the sole discretion of the United States Patent and Trademark Office. *In re Tee-Pak, Inc.*, 164 USPQ 88, 89 (TTAB 1969).

The likelihood of confusion analysis takes into consideration that the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

There is third-party evidence of the relatedness of applicant's goods and the goods in *Reg. No.* 2145559. The registration identifies hair care products in Class 3 and videotapes featuring hair styling techniques in Class 9. The best example that the parties' goods are related and travel in similar channels of trade is the venue of a beauty supply

store. The attached evidence from beauty supply stores shows they carry applicant's products such as hair brushes, nail brushes, hair combs, eyebrow brushes, hair curlers, hair pins, hair nets, hair clips, false hair, wigs, headbands AND registrant's products such as hair care products and DVDs/videos about hair styling. (*See attachments labeled Supply*). This evidence establishes that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use and that the goods are similar or complementary in terms of purpose or function. Therefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Furthermore, the trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of 15 third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely hairdressing salons, manicuring services, hair barrettes, lace and ribbons, false hair, nail brushes, hair brushes, ornamental hair pins, electric hair brushes, wigs AND hair care products and videos about hair styling, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). (*See attached third party registrations.*)

Consumers who view ALEXANDRE DE PARIS hair care preparations and videos in commerce will likely be confused as to source when they see ALEXANDRE DE PARIS hairdressing services, hair brushes, hair ornaments, etc. The parties' goods and services are closely related. As such, based on the evidence discussed above, we can conclude that the parties' goods and services travel and are sold through the same channels of trade. Accordingly, a likelihood of confusion exists between the parties' marks because, when encountered in commerce, consumers are likely to mistakenly believe that the parties' goods and services come from a common source, or that applicant is somehow affiliated to, associated with or sponsored by registrant.

In the eyes of the purchasing public, the trademarks will be confusingly similar since it can appear that the proposed mark, merely distinguished by the addition of a design element, identifies a new line of products in registrant's already existing line of related products, already identified by the term ALEXANDRE DE PARIS. Neither the

application nor the registration contain any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items. 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 and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

***The Similarity of the Parties' Marks in that they Consist of Identical Wording is a Factor Supporting a Section 2(d) Likelihood of Confusion Refusal***

There is no argument that the proposed mark 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).

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).

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. *See* TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *see* TMEP §1207.01(b)(viii), (c)(ii).

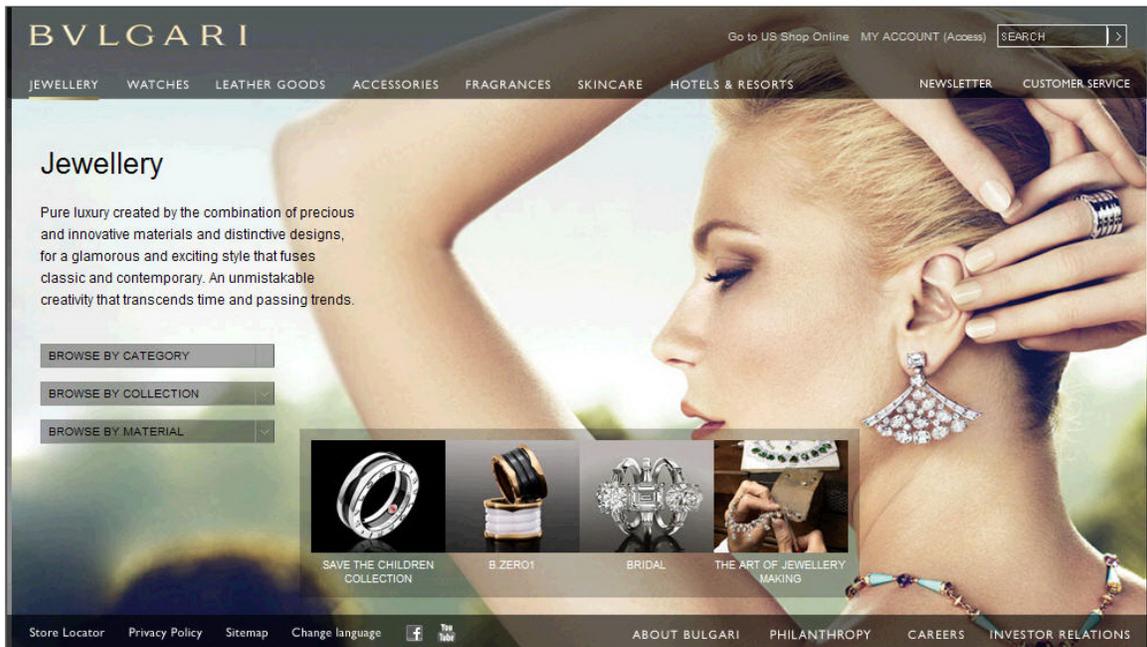
The most significant feature of the proposed mark is the word portion of the mark. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011).

As such, taking the above into account, it is clear that the marks are highly similar and convey the same overall commercial impression. Also, as discussed above, the facts in this case support a finding in favor of meeting the second factor in a likelihood of confusion analysis.

Given the high similarity of the marks and the close relationship of the goods and services, there is a likelihood of confusion as to the source of the goods and services. Having conformed to both steps in the Section 2(d) analysis, the examining attorney herein maintains and continues the refusal to register because Applicant's mark so resembles the mark in U.S. Registration Nos. *2124713 and 2145559* as to be likely to cause confusion when used on or in connection with the goods and services identified in the application.

The request for reconsideration is denied.

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