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Subject: U.S. TRADEMARK APPLICATION NO. 79114008 - ESSENZA - 23883 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79114008 MARK: ESSENZA	
CORRESPONDENT ADDRESS: MARY CATHERINE MERZ MERZ & ASSOCIATES PC 1010 LAKE STREET SUITE 400 OAK PARK, IL 60301-1135	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Van Es Home B.V.	
CORRESPONDENT'S REFERENCE/DOCKET NO: 23883 CORRESPONDENT E-MAIL ADDRESS: docket@merz-law.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1069947

The Applicant, Van Es Home B.V., seeks to register the mark "ESSENZA" in standard characters for the following goods in International class 24:

textiles and textile goods, not included in other classes, namely, household linen, bed linen, bath linen, bed sheets, pillow shams, pillow cases, bed blankets, comforters, quilts, bedspreads, bed covers, coasters of textile, duvet covers, duvets, dust ruffles, mattress covers, towels, bath towels, beach towels, traveling rugs, face cloths, shower curtains, table linen, table covers of textile, table cloths of textile, fabric table runners, table napkins of textile, place mats of textile material, curtains, draperies, unfitted fabric furniture covers, fabric flags, handkerchiefs, cloth labels, floor towels, curtain tie-backs in the nature of textile curtains holders, net curtains, upholstery fabrics, wall hangings of textiles

The examining attorney refused registration of the Applicant's marks under Trademark Act Section 2(d) based on a likelihood of confusion with a mark featuring the wording "PAGLIERI ESSENZA AUTENTICA" and a flower design with the wording "DAL 1876" in U.S. Registration 3728500, owned by PAGLIERI S.P.A. for (in relevant part):

textile fabrics; textile goods, namely, napkins, cotton fabrics, damask, linen for diapers, linen cloth, flannel, jersey, jute cloth, rayon fabric, silk, fustian, crepe, taffeta, tulle, velvet, woolen fabrics, zephyr, friction cloths in the nature of hemp cloth, crepe chiffon, chenille fabrics, hemp fabric; goods of elastic textiles, namely, bands of elastic fabric to be stretched around luggage for the purpose of luggage identification; fabric of imitation animal skins; fiberglass fabrics for textile use; goods made of textile materials, namely, textile napkins; curtains of textile for windows; textiles for wall hangings and for furniture; flags not made of paper; bed covers; bedding, namely, bed sheets; counterpanes, namely, bedspreads that extend to cover the legs of the bed; paper bedspreads, pillow cases, tablecloths, table throws and covers; household linen, textile hand towels, washing mitts, bath linen; handkerchiefs of textile; tissues, of textile, for removing make-up; fabric for boots and shoes; bed covers, plastic table covers

This appeal follows the Examining Attorney's final refusal of April 28, 2014.

OBJECTION TO EVIDENCE

Applicant has submitted new evidence with its appeal brief. Specifically, the applicant has attached TESS search results and associated third party registrations, none of which have been previously submitted.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

THE MARKS OF APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR AND THE GOODS AND SERVICES OF THE PARTIES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d).

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup*

Inc. v. Capital City Bank Grp., Inc., 637 F.3d at 1355, 98 USPQ2d at 1260. In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

A. THE MARKS ARE SIMILAR

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). 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). In the present case, applicant's mark is ESSENZA and the registrant's mark is "PAGLIERI ESSENZA AUTENTICA" with an abstract flower design that includes that wording "DAL 1876."

As discussed further below, in this instance, the goods of the parties are highly related, if not identical. Where the goods of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

1. Comparison of the marks.

Applicant argues that because the dominant features of the applicant's and registrant's marks are not the same, consumers will not be confused as to the source of the goods. However, a likelihood of confusion determination is not made comparing only the "dominant" features of the marks in question. Marks must be considered in their entireties. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle*

S.A., 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). In this instance, the term ESSENZA in the registered mark is not disclaimed, nor is it descriptive of the registrant's goods. Further, registrant's mark is the only registered mark containing the word ESSENZA for these goods, thus making it very strong. (See screen shots of a TESS search, attached as page 47 of the October 18, 2013, Office action). Finally, as is discussed below, the applicant's supposition as to what the "dominant" feature of the registered mark is not dispositive as to the overall commercial impression of the marks.

A. *Applicant argues the marks differ in sight, sound and connotation.*

Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977). Here, the applicant's mark contains the same common wording as the registered mark, and there is no other wording in the applicant's mark to distinguish it from the registered mark. The applicant has merely deleted the name PAGLIERI and the word AUTENTICA from the registered mark. Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting a house mark, other distinctive matter, or a term that is descriptive or suggestive of the named goods or services; if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See. e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP* at 1161 (affirming TTAB's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks).¹ Here, PAGLIERI S.P.A is the owner of the registrant's mark and PAGLIERI appears to be the house mark with the secondary product mark of "ESSENZA

¹ A house mark is used by an entity on a wide range of goods and is different from a product mark in that it is used on a specific item or closely related items. A product may bear both a product mark and a house mark, See TMEP § 1402.03(b).

AUTENTICA.”² The addition of the term “AUTENTICA” does not change the commercial impression of the term ESSENZA in Registrant’s mark. Thus, the shared term ESSENZA makes the marks sufficiently similar as to cause confusion.

Further, with regard to the visual appearance of the mark, as the applicant’s mark is in standard characters, it can appear in any stylization, including one similar to the registrant’s. *See In re Viterra Inc.*, 671 F.3d at 1363.

Additionally, with respect to registrant’s design element, although marks must be compared in their entireties, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods using the wording. *Id.* at 1362. As such, the wording of the registrant’s mark is dominant over the abstract floral design. As such, applicant’s mark is identical to part of the registrant’s mark in sight, sound and connotation

Any doubt as to the issue of likelihood of confusion must be resolved 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. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). (Emphasis added.)

B. Applicant argues PAGLIERI is the dominant feature of the registered mark.

Applicant bases its supposition that consumers perceive the name PAGLIERI as the dominant feature of the registered mark because the name appears first, in larger stylized font while ESSENZA AUTENTICA appears in smaller, less ornate font. However, in this instance, the name PAGLIERI is presented in such stylized font that is difficult to read. Conversely, as displayed in the registered mark, the wording ESSENZA AUTHENTICA is presented in clear, easy to read stylization. The public is likely to

² The mark also includes the wording “DAL 1876,” which means “since 1876,” and is disclaimed because it is not registrable because it is an informational phrase indicating the year of the company’s origination. *See In re AOP LLC*, 107 USPQ2d 1644, 1655 (TTAB 2013).

note the easier read product marks and not pay as much attention to the registrant's stylized house mark.

When comparing marks, the proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014). Here, as the ESSENZA AUTHENTICA portion of the registered mark is more legible, applicant's arguments regarding the dominant feature of the registered mark are not sufficient to establish that the overall impression of the applied-for mark and the registered mark are dissimilar.

2. Prior approval of a similar mark is not binding on the current likelihood of confusion determination.

The applicant cites to the approval of application 77572170 for the mark ESSENZA for "bath linens" as evidence that there is no likelihood of confusion between applicant's mark and the registrant's mark. Applicant contends that application 77572170 and the registered mark "co-existed" on the register, and therefore applicant's mark should be allowed to "co-exist" with the registered mark. However, application 77572170 and the registered mark never "co-existed" on the register as application 77572170 **never registered**. The application was abandoned for failure to provide a statement of use.

Further, as acknowledged by the applicant, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d

1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). As such, the prior approval of an abandoned ESSENZA mark is not binding in the current likelihood of confusion determination.

As such, the marks are more than sufficiently similar to find a likelihood of confusion under Section 2(d) of the Trademark Act.

B. THE GOODS ARE CLOSELY RELATED

In its brief, the applicant has made no argument that the goods of the parties are unrelated. In this instance, the registrant's goods are related to, if not identical to, the applicant's goods. Specifically, applicant and registrant both offer household linen, bath linen, bed sheets, pillow cases, towels, flags, handkerchiefs and wall hanging textiles. Further, the evidence of record clearly indicates that the identified goods originate from the same sources and travel in the same channels of trade. For the convenience of the Board, the examining attorney outlines a sample of the evidence of record. Please see:

- a. Evidence from www1.macys.com of the Martha Stewart line provided at pages 2-16 of the October 18, 2013, Office action and at pages 20-23 of the April 28, 2014 final refusal Office action, shows that household linens, including bedding, blankets, rugs and towels are provided by the same source and sold through the same trade channels.
- b. Evidence from www.jcpenny.com of the Royal Velvet line provided at pages 17-24 of the October 18, 2013, Office action shows household linens, including curtains, table covers, napkins, rugs and towels are provided by the same source and sold through the same trade channels.

- c. Evidence from bedbathandbeyond.com of the Wamsutta line provided at pages 25-27 of the October 18, 2013, Office action shows household linens, including bedding, curtains, rugs, and towels, are provided by the same source and sold through the same trade channels.
- d. Evidence from www1.macys.com of the Hotel Collection line provided at pages 28-32 of the October 18, 2013, Office action shows household linens, including bedding, towels and rugs are provided by the same source and sold through the same trade channels.
- e. Evidence from bedbathandbeyond.com of the Kenneth Cole line provided at pages 33-43 of the October 18, 2013, Office action shows household linens, including curtains, bedding and rugs are provided by the same source and sold through the same trade channels.
- f. Evidence from bedbathandbeyond.com of the Tommy Bahama line provided at pages 43-46 of the October 18, 2013, Office action shows household linens, including bedding, curtains, rugs, placemats and napkins are provided by the same source and sold through the same trade channels.
- g. Evidence from www.target.com, of the Fieldcrest line provided at pages 5-10 of the April 28, 2014, final refusal Office action shows household linens, including towels and bedding are provided by the same source and sold through the same trade channels.
- h. Evidence from www.sears.com of the Now Designs line provided at pages 10-19 of the April 28, 2014, final refusal Office action shows household linens, including towels, placemats, napkins and table covers are provided by the same source and sold through the same trade channels.

Additionally, the TTAB should note the evidence from the April 28, 2014, final refusal at pages 24-58 consisting of third party registrations indicating that applicant's and registrant's goods commonly originate from the same source. The examining attorney respectfully submits that copies of third party use-based registrations may serve to suggest that the goods and services are of a type that may emanate from a single source. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012).

When the third party registrations are taken together with real world evidence outlined above, the record clearly shows a variety of evidence supporting the fact that the goods of the Registrant are commonly sold by the same parties as the goods of the Applicant.

CONCLUSION

The evidence of record shows that Applicant's and Registrant's goods, as identified in the registration and application, are sufficiently related under Section 2(d) of the Trademark Act, such that purchasers would confuse the source of the goods. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

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