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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79140651

MARK: SR

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: STEFANO RICCI S.P.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

T74817

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1187327

Applicant, Stefano Ricci S.P.A., has appealed the trademark examining attorney's final refusal to register the mark “SR” in stylized form for all of the goods in International Classes 3, 9, 18 under Trademark Act Section 2(d) because of a likelihood of confusion with the legally equivalent cited mark, “SR” in typed format[1], for all of the relevant goods in each of the U.S. Registration Nos. 3543709, 3930615, 2770611, and 2381337. *See* 15 USC §1052(d), the Trademark Act of 1946.

The registrant “Sonia Rykiel Creation et Diffusion de Modeles” owns both U.S. Registration Nos. 3543709 and 3930615; the registrant “The Sunrider Corporation” owns both U.S. Registration Nos. 2381337 and 2770611.

Each of the applicant’s goods in International Classes 3, 9, and 18 are the subject of the likelihood of confusion refusals under Section 2(d), and are as follows:

> "Soaps, shaving soaps, after-shave lotions, cosmetic preparations for baths, shampoos, perfumery, eau de toilette, essential oils, aromatic potpourris and oils, hair lotions, balms other than for medical purposes, namely, lip balms, body balms, face balms, after shave; dentifrices, cosmetics," in International Class 3;
>
> “Eyeglasses, spectacle frames, eyeglass cases,” in International Class 9; and
>
> “Key cases being leather goods, canes, umbrella sticks, travelling trunks, athletic bags, carry-all bags, travelling bags made of leather, reins, credit card cases, business card cases, briefcases being leather goods, coverings of skins being fur pelts, briefcases, hides being animal skins, pocket wallets, purses; suitcases, attaché cases, rucksacks; saddlery,

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[1] Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. Effective November 2,

2003, Trademark Rule 2.52, 37 CFR §2.52, was amended to replace the term “typed” with “standard character.” TMEP

§ 807.03. For the purposes of determining a likelihood of confusion, no difference exists; the analysis is still the same.

horse halters, horse collars, horse blankets, riding saddles, horseshoes," in International Class 18.

The relevant goods in the likelihood of confusion refusals under Section 2(d) in each of the cited U.S. Registration Nos. 3543709, 3930615, 2770611, and 2381337 are as follows:

U.S. Registration No. 2381337

"Cosmetics and cosmetic kits, comprising one or more of the following, namely; perfumes, skin oils, hand and cleansing lotions, cleansing, face and lightening creams, astringents for cosmetic purposes, sun protection creams, hair shampoos, hair conditioners and rinse, styling gels, hair sprays, styling glaze, cleansing foam, facial masques, powders, eye pencils, mascara, makeup, lipstick, lip gloss, non-medicated lip balm, eyeliner, eye shadows, nail base and topcoats, lip liner, concealer, liquid and bar face soaps, shaving soaps, after shave lotions, hair mousse, scalp-refreshing hair tonic, shaving cream, shaving gel, and applicators for use therewith; skin oils, hand and cleansing lotions; cleansing, face and lightening creams; astringents for cosmetic purposes; sun protection creams; hair shampoos; hair conditioners and rinse; toothpaste; styling gels; hair sprays; stylizing glaze; cleansing foam; facial masques; powders; eye pencils; mascara; makeup; deodorants; breath freshener; lipstick; lip gloss; non-medicated lip balm; eyeliner; eye shadows; nail lacquer; nail gloss; nail base and topcoats; lip liner; concealer; liquid and bar face soaps; shaving soaps; after shave lotions; hair mousse; scalp- refreshing hair tonic; shaving cream; shaving gel; and perfumes," in International Class 3.

U.S. Registration No. 3543709

"Eyeglasses, eyeglass cases, eyeglass frames," in International Class 9.

U.S. Registration Nos. 3930615 and 2770611

"Bags, namely, handbags, shoulder bags, purses, and cosmetic bags sold empty" and "leather and imitation leather as well as goods made thereof, namely, traveling bags, garment bags for travel, school bags, shopping bags, wheeled shopping bags, handbags, canvas, leather bags, briefcases, trunks, suitcases, cases, namely, document cases, attachè cases, traveling sets consisting of various sized travel bags and cases, traveling trunks, beach bags, purses, wallets, cardholders, keyholder cases, walking sticks and rods," in International Class 18.

FACTS

On August 5, 2013, applicant, Stefano Ricci S.P.A., filed a Madrid application under Section 66(a) of the Trademark Act to register the mark "SR" in stylized form on the Principal Register for the above-identified goods in International Classes 3, 9, and 18, as well as for goods in International Classes 8, 14, 16, 20, 21, 25, and 34, and for services in International Class 35. *See* 37 C.F.R. § 2.34(a)(5). In the first Office Action mailed on January 13, 2014, the examining attorney refused registration under Trademark Act Section 2(d) for all of the goods in International Classes 3, 9, 18, and 25 because of a likelihood of confusion with the legally equivalent mark "SR" in typed format and for the relevant goods in U.S. Registration Nos. 3543709, 3930615, 2770611, 2381337, 3930615. *See* 15 USC §1052(d). The examining attorney also required that a description of the mark statement be entered into the application record and that the identification of goods and services be revised.

The applicant submitted a Response on July 14, 2014, to the first Office Action, arguing against the Section 2(d) likelihood of confusion refusals of the applicant's proposed mark "SR" in stylized form for the goods in International Classes 3, 9, 18, and 25 with the legally equivalent mark "SR" in typed format and for the relevant goods in U.S. Registration Nos. 3543709, 3930615, 2770611, 2381337, and 3930615. *See* 15 USC §1052(d). The applicant also submitted a description of the mark statement and revised the identification of goods and services.

The examining attorney issued a final Office Action on September 7, 2014, maintaining and making final the Section 2(d) likelihood of confusion refusals of the applicant's proposed mark "SR" in stylized form for the goods in International Classes 3, 9, 18, and 25, with the legally identical mark "SR" in typed format for the relevant goods in U.S. Registration Nos. 3543709, 3930615, 2770611, 2381337, and 3930615. *See* 15 USC §1052(d). The examining attorney also maintained and made final the requirement for a definite identification of goods and services.

On April 27, 2015 the applicant filed a Request for Reconsideration of the Section 2(d) likelihood of confusion refusals of the applicant's proposed mark "SR" in stylized form for the goods in International Classes 3, 9, 18, and 25, with the mark "SR" in typed format for the relevant goods in U.S. Registration Nos. 3543709, 3930615, 2770611, 2381337, and 3930615. *See* 15 USC §1052(d). The applicant also amended the identification of goods and services.

This appeal follows the examining attorney's Request for Reconsideration Denied of May 27, 2015, continuing the Section 2(d) likelihood of confusion refusals of the applicant's proposed mark "SR" in stylized form, only for the goods in International Classes 3, 9, and 18, with the mark "SR" in typed form for the relevant goods in U.S. Registration Nos. 3543709, 3930615, 2770611, and 2381337. *See* 15 USC §1052(d).

ISSUE ON APPEAL

The only issue on appeal is whether any likelihood of confusion under Section 2(d) exists between the applicant's proposed mark "SR" in stylized form for all of the above-identified goods in International Classes 3, 9, and 18, and the registrants' legally equivalent mark "SR" in typed format for the relevant goods in U.S. Registration Nos. 3543709, 3930615, 2770611, and 2381337. *See* 15 USC §1052(d).

ARGUMENT

The applicant and registrants' goods are legally identical, the applicant's and registrants' marketing and trade channels are identical, and the applicant's and registrants' marks are legally equivalent in appearance, sound, connotation, and commercial impression, such that a likelihood of confusion, mistake or deception under Section 2(d) of the Trademark Act exists. *See* 15 U.S.C. § 1052(d).

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. *See In re Shell Oil Co.*, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (The overriding concern is to prevent buyer confusion as to the source of the services); *see also In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973).

The applicant's arguments against the likelihood of confusion merely concern the parties' marks. The applicant does not even argue against the *du Pont* factor of the relatedness of the parties' goods, even though it is well-settled that one of the two most important considerations in any likelihood of confusion analysis is the relatedness of the goods. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010) ("In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services"). The applicant has failed to respond to the examining attorney's evidence and arguments that the applicant's and registrants' goods are legally identical and that therefore the trade channels are identical.

I. THE PARTIES' GOODS ARE LEGALLY IDENTICAL

The goods of the parties need not be identical or even directly competitive for a likelihood of confusion to be found. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 186 USPQ 476, 480 (CCPA 1975);

TMEP §1207.01(a)(i). Rather, the goods need only be related in some manner that such offering under similar marks would lead to the mistaken belief that the goods come from, or are in some way associated with, the same source. *See In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). In the instant case, the applicant's and registrants' goods are not merely related in some manner, but are in fact legally identical.

In a likelihood of confusion analysis, the comparison of the parties' goods is based on the goods as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); TMEP §1207.01(a)(iii). In the instant application and cited registrations the goods as listed are legally identical.

The applicant's goods in International Classes 3, 9, and 18 are identical to, overlap, encompass, and/or are encompassed by the registrants' relevant goods, making the parties' goods legally identical. The applicant has not disputed during prosecution or on appeal that the applicant's and registrants' goods are legally identical. The high relatedness of the parties' goods, such that they are legally identical, is shown and discussed below.

Cited Reg(s).	Classes of Goods	Applicant's Goods Subject to 2(d) Refusal	Registrant's Goods
Reg. No. 2381337	Class 3	Soaps, shaving soaps, after-shave lotions, cosmetic preparations for baths, shampoos, perfumery, eau de toilette, essential oils, aromatic potpourris and oils, hair lotions, balms other than for medical purposes, namely, lip balms, body balms, face balms, after shave; dentifrices, cosmetics	Cosmetics and cosmetic kits, comprising one or more of the following, namely; perfumes, skin oils, hand and cleansing lotions, cleansing, face and lightening creams, astringents for cosmetic purposes, sun protection creams, hair shampoos, hair conditioners and

			rinse, styling gels, hair sprays, styling glaze, cleansing foam, facial masques, powders, eye pencils, mascara, makeup, lipstick, lip gloss, non-medicated lip balm, eyeliner, eye shadows, nail base and topcoats, lip liner, concealer, liquid and bar face soaps, shaving soaps, after shave lotions, hair mousse, scalp-refreshing hair tonic, shaving cream, shaving gel, and applicators for use therewith; skin oils, hand and cleansing lotions; cleansing, face and lightening creams; astringents for cosmetic purposes; sun protection creams; hair shampoos; hair conditioners and rinse; toothpaste; styling gels; hair sprays; stylizing glaze; cleansing foam; facial masques; powders; eye pencils; mascara; makeup; deodorants; breath freshener; lipstick; lip gloss; non-medicated lip balm; eyeliner; eye shadows; nail lacquer; nail gloss; nail base and topcoats; lip liner; concealer; liquid and bar face soaps; shaving soaps; after shave lotions; hair mousse; scalp- refreshing hair tonic; shaving cream; shaving gel; and perfumes
Reg. No. 3543709	Class 9	Eyeglasses, spectacle frames, eyeglass cases	Eyeglasses, eyeglass cases, eyeglass frames
Reg. Nos. 2770611 and 3930615	Class 18	Key cases being leather goods, canes, umbrella sticks, travelling trunks, athletic bags, carry-all bags, travelling bags made of leather, reins, credit card cases, business card cases, briefcases being leather goods, coverings of skins being fur pelts, briefcases, hides being animal skins, pocket wallets, purses;	Bags, namely, handbags, shoulder bags, purses, and cosmetic bags sold empty" and "leather and imitation leather as well as goods made thereof, namely, traveling bags, garment bags for travel, school bags, shopping bags, wheeled shopping bags, handbags, canvas, leather bags,

		suitcases, attaché cases, rucksacks; saddlery, horse halters, horse collars, horse blankets, riding saddles, horseshoes	briefcases, trunks, suitcases, cases, namely, document cases, attachè cases, traveling sets consisting of various sized travel bags and cases, traveling trunks, beach bags, purses, wallets, cardholders, keyholder cases, walking sticks and rods

The applicant's goods which are identical to, overlap, encompass or are encompassed by the registrant's goods in International Class 3 are:

> "Soaps, shaving soaps, after-shave lotions, cosmetic preparations for baths, shampoos, perfumery, eau de toilette, essential oils, hair lotions, balms other than for medical purposes, namely, lip balms, body balms, face balms, after shave; dentifrices, cosmetics."

The applicant's and registrant's goods in International Class 9 are identical.

The applicant's goods which are identical to, overlap, encompass or are encompassed by the registrant's goods in International Class 18 are:

> "Key cases being leather goods, canes, travelling trunks, athletic bags, carry-all bags, travelling bags made of leather, credit card cases, business card cases, briefcases being leather goods, briefcases, hides being animal skins, pocket wallets, purses; suitcases, attaché cases, rucksacks."

Beyond the fact that the parties' goods are legally identical in the identifications of goods, the examining attorney has substantial submitted evidence of more than 20 different third parties who manufacture the same goods as both the applicant and the registrant, and travel through the same trade channels to the same end consumers in the form of printouts of web sites of applicant's and registrants' competitors on which the applicant's and registrants' goods are both sold. *See* Office Action

of January 13, 2014, pp. 2, 13 – 34 (all evidence of the relatedness of the parties' International Class 9 goods); Office Action of September 7, 2014, pp. 2 – 51 (all evidence of the relatedness of the parties' International Class 3 goods); Office Action of September 7, 2014, pp. 52 – 89, 97 – 99, 105 – 108, 113 – 116, 122 – 127, 131 – 133, 149 – 151, 164 – 167, 171 – 184 (all evidence of the relatedness of the parties' International Class 18 goods). All of this evidence demonstrates that applicant's and registrants' goods are of a kind that do emanate from a single source.

The fact that applicant's goods are identical to, overlap, encompass or are encompassed by the registrants' goods in the parties' identifications, along with the copious amounts of evidence demonstrate that the parties' goods are of a kind that do emanate from a single source, which weighs very heavily in favor of a finding of a likelihood of confusion and against registration of applicant's mark.

II. <u>Applicant's and Registrant's Marketing and Trade Channels Are Identical</u>

The fact that applicant's and registrant's goods are legally identical means that the parties' marketing and trade channels are also considered identical. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); TMEP §1207.01(a)(iii). The applicant has not disputed during prosecution or on appeal that the applicant's and registrants' marketing and trade channels are identical, thereby conceding this issue.

Inasmuch as the applicant's and the registrants' goods are legally identical, and as in this case, all of the parties' identifications of goods have no restrictions, the goods must be assumed to move in the same channels of trade to the same customers. *See Schieffelin & Co. v. The Molson Cos. Ltd.*, 9 USPQ2d 2069 (TTAB 1989) ("[S]ince there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in

all normal channels of trade for those alcoholic beverages"). Therefore, the *du Pont* factor of the parties' marketing and trade channels is deemed to be identical as well.

The fact that the parties' marketing and trade channels are identical weighs very heavily in favor of a likelihood of confusion and against registration of applicant's mark.

The applicant has not disputed during prosecution or on appeal that the applicant's and registrants' marketing and trade channels are identical, thereby conceding this issue.

III. THE PARTIES' MARKS ARE IDENTICAL

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, connotation, and commercial impression. See In re E. I. du Pont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *See In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b). However, in this case the applicant's and registrants' marks are not merely similar, but are in fact legally equivalent.

Applicant's mark is "SR" in stylized form. Both of the cited registrants' marks are the identical term "SR" in typed format, which as discussed earlier is equivalent to standard character format. *See* Footnote 1, *supra*. The parties' marks are legally equivalent in appearance, sound, connotation and commercial impression.

Applicant's and registrants' marks both consist solely of the term "SR"; no other wording or design elements exist in any of the parties' marks.

While the applicant's mark is in stylized form, the registrants' "SR" mark is in typed format. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters will not avoid a likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). Therefore, the registrants' marks encompasses all possible variations of a stylized letter mark, including the applicant's mark in this case, making the parties' marks legally equivalent.

The fact that the applicant's and registrants' marks are legally equivalent weighs heavily in favor of a likelihood of confusion and against registration of applicant's mark.

IV. APPLICANT'S EVIDENCE AND ARGUMENTS ARE INSUFFICIENT TO OVERCOME THE LIKELIHOOD OF CONFUSION REFUSALS

The applicant's arguments focus solely on the parties' marks, and do not include any discussion concerning the identical nature of the applicant's and registrants' goods and the fact that the applicant's and registrants' marketing and trade channels are identical. The applicant does, however, make the following arguments.

A. EVIDENCE AND ARGUMENTS OF THIRD-PARTY USE ARE INSUFFICIENT TO SHOW REGISTRANTS' MARKS ARE WEAK

The applicant argues that the registrants' marks are weak and therefore entitled to a narrow scope of protection. The applicant argues that, in fact, the scope of protection for the registrants' mark is so narrow that a likelihood of confusion does not exist between the applicant's and registrants' marks. The applicant states, "The strength and distinctiveness of a mark is a vital consideration in determining the scope of protection it should be accorded….Third-party use of similar marks indicates that a mark is weak and should be afforded only a very narrow scope protection." *See* Applicant's Appeal Brief, pp. 7 – 8.

As evidence of the alleged weakness of the cited registrations, the applicant points to one third-party application. *See* Applicant's Request for Reconsideration, pp. 18 – 20 (Third-party App. No. 86126129). Third-party App. No. 86126129 is irrelevant to the instant case. Third-party applications generally have no probative value because they are not entitled to the Section 7 presumptions of the Lanham Act. *See* 15 USC § 1057.

The applicant also points to various third-party registrations, concerning goods unrelated to the goods at issue in this case. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Thus, the third-party registrations for unrelated goods are not probative as to the weakness of applicant's mark for the applied-for goods.

Disregarding registrations for unrelated goods, applicant relies on only one registration concerning goods in International Class 18, and only two registrations concerning goods in International

Class 9. *See* Applicant's Request for Reconsideration, pp. 16 - 17 (Third-party Reg. No. 4587893 for goods in International Class 18); Applicant's Request for Reconsideration, pp. 21 - 24 (third-party Reg. Nos. 2633395 and 3976647 for goods in International Class 9). While arguing the importance of third-party use as a factor in this likelihood of confusion analysis, the applicant did not submit any third-party registrations concerning any of the goods in International Class 3.

The applicant merely submits one third-party registration concerning some goods in International Class 18 and two third-party registrations concerning some goods in International Class 9. This tiny number of third-party registrations concerning the goods in International Class 18 and International Class 9 is *de minimis* and therefore insufficient to be relevant to the likelihood of confusion analysis in this case. For comparison, the applicant cites *Amstar Corp. v. Domino's Pizza, Inc.* in support of the proposition that the use of third-party prior registrations shows weakness of a term. *See Amstar Corp. v. Domino's Pizza, Inc.*, 205 USPQ 969 (5th Cir. 1980). The *Amstar Corp.* case involved 72 prior third-party registrations, not the paltry three registrations and one application in the instant case. Id. at p. 975. Even with the evidence of 72 prior third-party registrations, the *Amstar Corp.* Court found that the prior registrations were not relevant. *Id.* at p. 976. Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009).

Further, in addition to the applicant's paucity of evidence of third-party use, the enclosed registrations and application are for marks that include more elements than just the letters "SR". As

discussed *supra* the applicant's and registrants' marks in this case consist solely of the letters "SR" and are legally identical.

It is well settled that the existence of third-party registration(s) does not obviate a likelihood of confusion and that each trademark application must be decided on its own merits. *See, In re Nett Designs*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits"); *In re Perez*, 21 USPQ2d 1075, 1077 (TTAB 1991) ("[W]e are, of course, not bound by an Examining Attorney's prior determination as to registrability"); *In re Mark Thomas*, 79 USPQ2d 1021 (TTAB 2006) ("[W]e will not compound the problem of the registration of a confusingly similar mark by permitting such a mark to register again").

For all of the above reasons, the third-party application and the three third-party registrations applicant has submitted have minimal probative value in the instant case.

B. <u>ARGUMENTS CONCERNING DIFFERENCES IN PARTIES' MARKS ARE INSUFFICIENT TO DISTINGUISH THEM</u>

The applicant interweaves many disjointed arguments to claim that the parties' marks differ sufficiently to obviate a likelihood of confusion.

The applicant first states, "Applicant's trademark has a unique stylization that is different from the registrant's marks." *See* Applicant's Appeal Brief of August 17, 2015, p. 8. The applicant claims "Fanciful script that is unique and unusual can create a distinct commercial impression." *Id.* at p. 10.

As discussed *supra*, it is well settled that the letters in a mark in typed form can be displayed in all possible stylizations. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012). However, the applicant claims the opposite, as well as claiming that some variegated rules exist in relation to likelihood of confusion analyses when typed form and stylized marks are involved:

> "More weight should be given to the stylization of applicant's mark….There comes a point where stylization of letters goes beyond mere differences in fonts and becomes a style in its own, distinguishing itself from the letters. Therefore applicant's mark is not confusingly similar with any of the cited marks in any of the refused classes."

See Applicant's Appeal Brief of August 17, 2015, p. 10 – 11.

The applicant does not submit any statutes, case law or rules to corroborate such claims. In fact, as discussed *supra*, the case law supports the opposite of applicant's argument. *See In re Vitera*, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012) ("That a standard character mark is not limited to any particular font, size, style, or color, it is entirely consistent with our case law, the relevant regulations, and the TMEP").

The applicant further states the following:

> "A standard character claim is only for Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color….It has little or nothing to do with stylization….If the mark includes an essential element or feature that might not be able to be produced by the use of standard characters…it cannot be standard character."

See Applicant's Appeal Brief of August 17, 2015, p. 10 – 11.

With these claims the applicant cited TMEP § 807.03. The citation to TMEP 807.03 misrepresents what the TMEP says and means in this section. This section says, "Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background." *See* TMEP § 807.03. This section merely states the requirements for submitting a drawing

in an application where the applicant wants to have a mark in a standard character format. *See Id.* Nothing more.

The applicant also cited TMEP § 807.04(b). The citation to TMEP 807.04(b) misrepresents what TMEP says and means in this section. This section merely states the requirements for submitting a drawing in an application where a mark is not in a standard character format. *Id.* For instance, the section says, "A special form drawing is required for marks that contain superscripts, subscripts, exponents, or other characters that are not in the USPTO's standard character set." *Id*. This TMEP section involves nothing more.

The applicant further claims that because the marks in question are letter marks, prospective consumers cannot use these marks to call for the goods as they would word marks. "For letter marks similarity of appearance is usually controlling because the marks cannot be pronounced." *See* Applicant's Appeal Brief of August 17, 2015, p. 10. However, prospective consumers do use the letters in letter marks to call for the goods. *See In re RSI Sys. LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008) (Because both parties have the identical letters "RSI", even though one of the party's marks is stylized, the prospective consumers are likely to refer to the sources of the goods and services of both parties by the letters "RSI"); *see also In re Mighty Leaf Tea*, 94 USPQ2d 1257 (Fed. Cir. 2010).

CONCLUSION

The examining attorney has made a *prima facie* case in this Appeal Brief and throughout prosecution of this application that a likelihood of confusion exists between the applicant's and the registrants' marks. The applicant's and registrants' goods are legally identical. The applicant's and registrants' marketing and trade channels are identical. The applicant's and registrant's marks are legally identical. Not merely one or two, but all three of the *du Pont* factors of the relatedness of the

goods, the marketing and trade channels, and the similarity of the marks are identical or legally identical. Furthermore, none of the applicant's evidence or arguments is adequate to overcome any part of the examining attorney's *prima facie* case of a likelihood of confusion.

For all of the foregoing reasons, the refusal to register the applicant's mark on the basis of Section 2(d) of the Trademark Act, 15 USC § 1052(d), for the reason that a likelihood of confusion exists between the applicant's and the registrants' marks in Reg. Nos. 3543709, 3930615, 2770611, and 2381337, should be affirmed.

Respectfully submitted,

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