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Subject: U.S. TRADEMARK APPLICATION NO. 79140651 - SR - T74817 - Request for Reconsideration
Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 79140651

MARK: SR



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GENERAL TRADEMARK INFORMATION:

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APPLICANT: STEFANO RICCI S.P.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

T74817

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RETURN OF FILE TO BOARD FOR CONTINUATION OF APPEAL

ISSUE/MAILING DATE: 12/21/2015

INTERNATIONAL REGISTRATION NO. 1187327

This Return of File to the Board for Continuation of Appeal is subsequent to and taking into consideration of the applicant's Request To Remand for Additional Evidence.

The likelihood of confusion refusals based on Reg. Nos. 2770611, and 2381337 are withdrawn.

Registration Refused – Likelihood of Confusion – Maintained for the Goods in Classes 9 and 18

The examining attorney has reviewed the applicant's Request To Remand for Additional Evidence and the Consent To Register attached therewith, and has withdrawn the likelihood of confusion refusals based on U.S. Reg. Nos. 2770611, and 2381337. Therefore, the likelihood of confusion for all of the goods in International Class 3 is withdrawn.

The applicant did not submit any additional arguments against the likelihood of confusion based on any of the above-identified marks in the cited registration. The applicant did, however, submit a Consent To Register to overcome the likelihood of confusion refusals based on Reg. Nos. 2770611, and 2381337.

The applicant did not submit any arguments against the likelihood of confusion based on any of the above-identified marks in Reg. Nos. 3543709 and 3930615. Registration is still refused for the applied-for mark because of a likelihood of confusion with the marks in Reg. Nos. 3543709 and 3930615 for all of the goods in International Classes 9 and 18. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* The applicant's Request To Remand for Additional Evidence and the Consent To Register attached therewith was and is not relevant to these refusals.

Applicant's and Registrants' Marks Are Legally Identical

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) (*quoting Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison*

Fondee En 1772, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *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).

Applicant’s mark is “SR (Stylized)”.

Likewise, in all of the cited registrations the mark is “SR” in a typed drawing format.

The applicant’s and registrant’s marks are legally identical because it is well-settled that 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, it is further well-settled that a mark presented in stylized characters generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re 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 applicant’s and registrants’ marks are legally identical.

All of the cited marks are in typed drawing format, which is equivalent to standard character format. The applicant’s word mark consists of the identical letters to each of the registrants’ word marks, “SR”, except that the applicant’s marks are each in a stylized format. As discussed above, it is well-settled that a word mark in typed drawing format or standard character format encompasses and is therefore legally identical to a word mark that is in a stylized format.

The degree of similarity of the parties’ marks also is an important factor in the likelihood of confusion analysis. The more similar the parties’ marks, the less related the parties’ good/services are required to be for a likelihood of confusion to be found. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). In the instant case, the applicant’s and the registrant’s marks are not merely similar, but in fact legally identical.

It is well-settled that “even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 U.S.P.Q.2d 1687, 1690 (Fed. Cir. 1993); *see also, In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812, 1815 (T.T.A.B. 2001) (“Where the applicant’s mark is identical to the registrant’s mark, as it is in this case, there need be only a viable relationship between the respective goods or services in order to find that a likelihood of confusion exists”); *In re Concordia Int’l Forwarding Corp.*, 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983) (“if the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion”).

In the instant case, applicant’s and registrant’s marks are legally identical. Therefore, the relatedness between the applicant’s and registrant’s goods can be minimal and still a likelihood of confusion will be found.

The fact that applicant’s and registrant’s marks are legally identical weighs very heavily in favor of a finding of a likelihood of confusion and against registration of applicant’s mark, not only for this *du Pont* factor, but for the *du Pont* factor of the relatedness of the parties’ goods/services as well.

Comparison of the Goods

The standard to determine whether the applicant's and registrant's goods/services are sufficiently related for a likelihood of confusion to occur is a very flexible one, especially when the parties' marks are identical. The goods/services of the parties need not be identical or even directly competitive. *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 the goods/services of the parties need only be related in some manner, or the conditions surrounding the marketing of the parties’ goods/services are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods/services come from a common source. *See In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

If the marks of the respective parties are identical, as in the instant case, the goods/services of the respective parties need not be as related to support a finding of likelihood of confusion as might apply

where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

Reg. No. 3543709

Applicant's goods subject to the likelihood of confusion in International Class 9 are "Eyeglasses, spectacle frames, eyeglass cases."

Registrant's goods in International Class 9 include "Eyeglasses, eyeglass cases, eyeglass frames."

The applicant's and registrant's goods are identical. Furthermore, with a prior Office Action, the examining attorney submitted evidence as to the relatedness of the goods.

Reg. No. 3930615

Applicant's goods subject to the likelihood of confusion in International Class 18 are "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, horse halters, horse collars, horse blankets, riding saddles, horseshoes."

Registrant's goods in International Class 18 are "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, attaché 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 and registrant's goods are identical or highly related. Furthermore, with a prior Office Action, the examining attorney submitted substantial amounts of evidence that applicant's and registrant's goods are made by the same manufacturers, and travel through the same trade channels to the same end consumers. The examining attorney submitted printouts from web sites of numerous

competitors of applicant. On these web sites applicant's competitors sell both the applicant's and registrant's goods. This evidence demonstrates that applicant's and registrant's goods are substantially related and are of a kind that do emanate from a single source.

Applicant's and Registrant's Marketing and Trade Channels Are Identical

Applicant's and registrant's marketing and trade channels are identical.

As discussed above, the fact that applicant's and registrant's goods/services are identical or closely related means that the parties' marketing and trade channels are considered identical. *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").

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.

Conclusion

In the instant case, the applicant's and registrant's marks, goods, and marketing and trade channels are identical, weighing very heavily in favor of a finding of likelihood of confusion and against registration of applicant's mark for any of the goods in International Classes 9 and 18.

Application File Will Be Returned to the TTAB To Continue Appeal Process

The Board is notified herewith to resume the appeal process.

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