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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



CORRESPONDENT ADDRESS:

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APPLICANT: STEFANO RICCI S.P.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

T74817

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/20/2015

INTERNATIONAL REGISTRATION NO. 1187327

The trademark examining attorney has carefully reviewed applicant's Request for Reconsideration of April 27, 2015, and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a).

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- The likelihood of confusion refusal is withdrawn for the goods in International Class 25.
- The requirement for a definite identification of the goods and services is withdrawn.

Likelihood of Confusion Refusal – Final Refusal Maintained – Classes 3, 9, and 18 Only

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3543709, 3930615, 2770611, and 2381337 for the goods in International Classes 3, 9, and 18. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the registrations enclosed with the first Office Action.

The same registrant owns cited Reg. Nos. 3543709 and 3930615. Another registrant owns the remaining cited registrations, namely, Reg. Nos. 2770611 and 2381337.

The applicant has submitted a Request for Reconsideration to the Final refusal. Applicant's arguments have been considered and found unpersuasive for the reason(s) set forth below. Therefore, the Request for Reconsideration of the likelihood of confusion refusal is denied.

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 and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). 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 re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

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 marks are "SR" in a typed drawing format.

The applicant's and registrants' 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 Viterro 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.

The applicant confusingly argues that “there comes a point where the 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,” and the applicant incorrectly goes on to state that a mark in a standard character or typed drawing format “has little or nothing to do with stylization....If the mark includes an essential element or feature that cannot be produced by the use of standard characters like interlocking letters, it cannot be standard character. *See Request for Reconsideration of April 27, 2015, p. 1.* Then, the applicant incorrectly accurately cites to TMEP §§807.03 and 807.04(b).

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 DistillingCo.*, 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, in the instant case 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); *Amcor, Inc. v. Amcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

Applicant's goods subject to the likelihood of confusion in this registration are:

“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.

Registrant's goods include:

“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; nailgloss; 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; all-purpose household cleansers; dishwasher detergent; cleaning detergent for clothes; dish detergent; cleanser for produce; and perfumes,” in International Class 3.

The applicant's and registrant's goods are identical. Furthermore, with a prior final 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.

Reg. No. 3543709

Applicant's goods subject to the likelihood of confusion in International Class 9:

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

Registrant's goods in International Class 9 include:

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

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. Nos. 3930615 and 2770611

Applicant's goods subject to the likelihood of confusion in International 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; suitcases, attaché cases, rucksacks; saddlery, horse halters, horse collars, horse blankets, riding saddles, horseshoes," in International Class 18.

Registrants' goods in International Class 18 include:

"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.

The applicant's and registrants' goods are identical. 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.

Third-Party Application Is Not Relevant to the Instant Case

The applicant submitted in a prior Office Action a printout of third-party Trademark App. No. 86126129. This third-party application is not relevant to the instant case. Third-party applications have no probative value because they are not entitled to the Section 7 presumptions of the Lanham Act. See 15 USC § 1057.

Third-Party Registrations Are Not Relevant to the Instant Case

The applicant submitted with a prior Office Action copies of a mere three third-party Reg. Nos. 3976647, 2633395, and 2948602 for the goods in International Class 9 and a mere one third-party Reg. No. 4587893 for the goods in International Class 18. This tiny number of third-party registrations for each

class of goods is *de minimis* and therefore insufficient to be relevant to the likelihood of confusion analysis in this case.

It is settled law 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”) (emphasis added).

Therefore, the third-party registrations applicant has submitted have no probative value in this case.

Conclusion

For all of the reasons listed above, applicant’s arguments and evidence are insufficient to rebut the examining attorney’s *prima facie* case of a likelihood of confusion. The examining attorney includes even more arguments to the previously-submitted arguments and evidence in this Denial of a Request for Reconsideration to corroborate the finding of a likelihood of confusion. Consequently, all of the evidence of record weighs very heavily in favor of a finding of likelihood of confusion and against registration of applicant’s mark.

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

As the applicant has already filed a timely Notice of Appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

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