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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79140651
Applicant	Stefano Ricci S.P.A.
Applied for Mark	SR
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Applicant: STEFANO RICCI S.P.A.

Serial number: 79140651

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APPLICANT'S APPEAL BRIEF

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CASES CITED

Alkali Co. v. Dundee Cement Co. 145 USPQ 211 (CCPA 1965)

Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 259, 205 U.S.P.Q. 969, 975 (5th Cir. 1980)

In re Clutter Control inc. 231 USPQ 588 (TTAB 1966)

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)

First Sav. Bank, F.S.B. v. First Bank System, Inc., 40 U.S.P.Q.2d 1865 (10th Cir. 1996)

Liberty Mut. Ins Co. v. Liberty Ins Co. 127 USPQ 312 (E.D. Ark 1960)

Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)

In re TSI Brands, Inc. 67 USPQ2d 1657 (TTAB 2002)

Wooster Brush Co. v. Prager Brush Co., 231 U.S.P.Q. 316, 318 (T.T.A.B. 1986)

I. BACKGROUND

Applicant filed an application to register the mark SR in a stylized form for goods including 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 class 3, Eyeglasses, spectacle frames, eyeglass cases in class 9 and ; Key cases being leather goods, canes, umbrella sticks, traveling trunks, athletic bags, carry-all bags, traveling 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 class 18 on August 5, 2013. It was assigned Serial No. 79140651. Additional goods in classes 8, 14, 16, 20, 21, 25, 34, 35 which are also in the application but are not part of this appeal.

On January 13, 2014, the Examining Attorney refused registration under Section 2(d) of the Act, citing U.S. Registration Nos. 3543709, 3930615, 2770611, and 2381337. RN 3543709 applies only to the goods in International Class 009; RN 3930615 applies only to the goods in International Classes 018 and 025; RN 2770611 applies only to the goods in International Class 018; and RN 2381337 applies only to the goods in International Class 003. These registrations all consist of the letter SR in typed form. RN 3543709 owned by Sonia Rykiel Creation et Diffusion de Modeles is for eyeglasses, eyeglass cases, eyeglass frames, optical goods, namely, sunglasses, optical frames. RN 3930615 owned by Sonia Rykiel Creation et Diffusion de

Modeles is for 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 and Clothing, namely, underwear, socks, stockings, footwear excluding orthopedic footwear. RN 2770611 owned by the Sunrider Corporation DBA Sunrider International is for bags, namely, handbags, shoulder bags, purses, and cosmetic bags sold empty. RN 2381337 owned by Sunrider Corporation, DBA Sunrider International is for 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.

The Examining Attorney reasoned that a typed lettering style, like Registrant's marks, could be depicted in any lettering style. A mark presented in stylized characters generally will not avoid likelihood of confusion with a mark in typed characters because the marks could be presented in the same manner of display and therefore the marks are highly similar and the goods are highly related. The Examiner offered a definition of walking stick and ads for eye wear to support his claims.

Applicant responded on July 14, 2014. It argued that the marks had different connotations and looks.

The Examining attorney issued a final refusal on September 7, 2014 and on October 25, 2014 issued a final Office Action incorporating and superceding the prior final Office Action of September 7, 2014. The refusals were maintained. The marks are legally identical and the goods are identical. The Examiner offered more evidence to back up his conclusion.

On April 27, 2015, Applicant requested reconsideration. It argued that the cited marks were weak and have a limited degree of protection.

The Examining attorney denied the reconsideration request on May 20, 2015 for the goods in classes 3, 9, and 18. The likelihood of confusion refusal was withdrawn for the goods in International class 25.

Applicant filed a timely notice of appeal on April 27, 2015.

II. ARGUMENT

A. The registered marks are weak

The cited registrations are owned by two different entities, THE SUNRIDER CORPORATION and Sonia Rykiel Creation et Diffusion de Modeles. Both cited registrants own a registration for SR for class 18 goods. Their respective goods overlap or are related. This shows that the SR mark is weak for class 18 goods. Evidence of third-party use falls under the sixth du Pont factor – the "number and nature of similar marks in use on similar goods." In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Therefore, SR is weak for goods in class 18 and applicant should also be allowed to register its trademark for class 18 goods.

Registration is prima facie evidence that the mark is not confusingly similar to other registered marks. Liberty Mut. Ins Co. v. Liberty Ins Co. 127 USPQ 312 (E.D. Ark 1960). The registrant's themselves both have registrations in classes 18 for standard character marks that are the same. Besides the SR trademarks owned by the two different cited registrant entities for class 18 goods there are also SR-72 and SR2 (April 27, 2015 Request for reconsideration, TSDR p. 18 and 16) that are also registered or allowed registration. SR2 has been allowed based on use in commerce. There is no confusion in the market place between the SR trademarks in class 18 then there also would be no likelihood of confusion for applicant's SR design mark. Applicant should be allowed to register its trademark for its class 18 goods.

The strength and distinctiveness of a mark is a vital consideration in determining the

scope of protection it should be accorded." *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259, 205 U.S.P.Q. 969, 975 (5th Cir. 1980) . Third-party use of similar marks indicates that a mark is weak and should be afforded only a very narrow scope of protection. *Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316, 318 (T.T.A.B. 1986). When the primary term is weakly protected to begin with, minor alterations may effectively negate any confusing similarity between the two marks. *First Sav. Bank, F.S.B. v. First Bank System, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996). Applicant's trademark has an unique stylization that is different from the registrant's marks.

In class 9 for the goods related to eyewear besides the cited registration by Sonia Ryker there are two other registrations SR-1 and SR-91 owned by different entities (April 27, 2015 Request for reconsideration, TSDR p. 23 and 21) . Although all three registrations seem they could emanate from the same source, the number indicating different models of the SR trademark, they do not. Consumers know this. Likewise, Applicant's uniquely stylized SR gives a different source indication than, Sonia Rykiel's and should be allowed registration.

B. The respective marks have different connotations and meanings.

SR are the initials of the applicant and of the registrants. The SR has different meaning in each trademark. SR stands for Stefano Ricci in the application, Sonya Rykiel in reg. nos. 3543709 and 3930615, and SUNRIDER in reg. nos. 2770611 and 2381337. The initials stand for different words in each trademark. The trademarks have different connotations. Consumer's are aware of the underlying meaning to the letters. Sunrider's SR products can only be found in SUNRIDER stores or on their website. (July 14, 2014 Response to Office Action, TSDR p. 4.). It is, therefore, obvious what the SR means in SUNRIDER's trademark. SUNRIDER is

prominently displayed in their stores and on their website (July 14, 2014 Response to Office Action, TSDR p. 5.).

Sonia Rykiel SR marks are equally recognized by consumers as the initials of Sonia Rykiel. She is a well known designer who has been designing since the 1970's. (July 14, 2014 Response to Office Action, TSDR p. 2.) Consumer's of Sonya Rykiel's SR goods know they are from Sonya Rykiel. This is what attracts consumers, the knowledge the goods were designed by Sonya Rykiel. All of the SR trademarks of the registrations and the application are recognized abbreviations. Consumers can distinguish between the abbreviations. Stefano Ricci's name, likewise, is never far from the SR stylized trademark. Consumers of Stefano Ricci's SR marked goods are aware what SR stands for and it is what attracts consumers to the goods. (July 14, 2014 Response to Office Action, TSDR p. 3.). It is common practice for designer's to use their initials as a trademark also, for example, RL for Ralph Lauren, CK for Calvin Klein, DKNY for Donna Karan, AK for Anne Klein, and MK for Michael Kors. There would be no likelihood of confusion between the SR trademarks of the registrants and the applicant.

A picture of Sonia Rykiel eye wear (April 27, 2015 Request for reconsideration, TSDR p. 25) shows SR appears with the name SONIA RYKIEL on the lense at time of sale. Sunrider's SR trademarked goods are sold in Sunrider stores or the Sunrider website where Sunrider is prominently displayed. (July 14, 2014 Response to Office Action, TSDR p. 4 and 5) See evidence submitted with last response) SR is an abbreviation for a name. All cited registrations sell their goods with the full name prominently displayed on the goods or near the goods when selling. Consumer's know the initials are an abbreviation and they know the source of the respective goods.

C. The respective marks have different appearances.

For letter marks, similarity of appearance is usually controlling because the marks cannot be pronounced. In re TSI Brands, Inc. 67 USPQ2d 1657 (TTAB 2002). If marks cannot be pronounced their lettering style can be sufficient to prevent a likelihood of confusion Diamond Alkali Co. v. Dundee Cement Co. 145 USPQ 211 (CCPA 1965). Visually the respective marks contain significant distinguishing design elements. The trademarks of the registrations do not have the same design element of the application's trademark and cannot use the design of the application because it belongs to the applicant. Fanciful script that is unique and unusual can create a distinct commercial impression. It makes a striking commercial impression separate and distinct from the word portion of the mark. In re Clutter Control inc. 231 USPQ 588 (TTAB 1966). This is true of the applicant's trademark.

The registrant's standard character marks should not be given broader protection than they deserve. More weight should be given to the stylization of applicant's mark. The applicant's mark is stylized and the registrant's marks are in standard character. The Examiner claims that since the registered marks have a standard character claim they can be presented in the same manner of display as the applicant's. This tenet is attributable to type style not necessarily stylization. The applicant's mark is not just showing a different type style but also a stylization where the letters are intertwined. 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.

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.

TMEP 807.03 It has little or nothing to do with stylization. The applicant of a standard character drawing is not open to use any design element that it wants and still be covered by the standard character registration. It can use any font. If the mark includes an essential element or feature that might not be able to be produced by the use of standard characters like, perhaps, interlocking letters, it cannot be standard character. TMEP 807.04(b)

III. CONCLUSION

There would be no likelihood of confusion between the applicant's mark and the registrant's marks because consumer's have learned to look at other factors to distinguish the their respective goods, applicant's mark has an unique design, the differing connotations of all the marks concerned, and the coexistence of the cited registrations for the same marks and same goods indicating that the USPTO believes the marks are not in conflict. Applicant, therefore, requests the withdrawal of the refusal to register based on the cited registrations.

Respectfully submitted,
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