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Subject: U.S. TRADEMARK APPLICATION NO. 79142611 - JÖRG HEINZ - N/A - Request for
Reconsideration Denied - Return to TTAB - Message 1 of 5

Attachment Information:

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Files: f-01.jpg, f-02.jpg, f-03.jpg, f-04.jpg, f-05.jpg, f-06.jpg, f-07.jpg, f-08.jpg, f-09.jpg, f-10.jpg, f-11.jpg,
f-12.jpg, f-13.jpg, f-14.jpg, f-15.jpg, f-16.jpg, f-17.jpg, f-18.jpg, f-19.jpg, f-20.jpg, f-21.jpg, f-22.jpg, f-
23.jpg, j-1.jpg, j-2.jpg, j-3.jpg, j-4.jpg, Emporio Armani- Jewelry1.jpg, 79142611.doc

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

U.S. APPLICATION SERIAL NO. 79142611

MARK: JÖRG HEINZ



CORRESPONDENT ADDRESS:

BURTON S EHRlich

LADAS & PARRY LLP

224 S MICHIGAN AVENUE SUITE 1600

CHICAGO , IL 60604

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Jörg Heinz GmbH & Co. KG

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

CHIUSTM@LADAS.NET

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/8/2015

INTERNATIONAL REGISTRATION NO. 0552530

The trademark examining attorney has carefully reviewed applicant's request for reconsideration 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). The following refusal made final in the Office action dated October 10, 2014 is maintained and continues to be final: Trademark Act Section 2(d) Refusal. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues 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.

Applicant contends that differences exist in the appearance, sound, meaning, and overall commercial impression of applicant's mark and the cited registered mark. However, applicant merely adds the name JÖRG to the registered mark. 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) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2D 1651, 1660-61 (TTAB 2014) (finding PRECISION and PRECISION DISTRIBUTION CONTROL confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Applicant further contends that the goods covered by applicant's mark differ considerably from the goods listed in the cited registration. However, the goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Additionally, applicant will note the attached Internet evidence consisting of third party websites. This evidence establishes that the same entity commonly manufactures jewelry, clasps for jewelry and watches and markets the goods under the same mark. It demonstrates that jewelry, clasps for jewelry and watches are sold or provided through the same trade channels and used by the same classes of

consumers in the same fields of use. The evidence also establishes that the goods are used together, similar or complementary in terms of purpose or function. Therefore, these goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). Specifically, the attached evidence includes:

- Armani website featuring jewelry and watches: <http://www.armani.com>
- Kate Spade website featuring jewelry and watches: <http://www.katespade.com>
- March Jacobs website featuring jewelry and watches: <http://www.marcjacobs.com>
- Signals website featuring jewelry and watches: <http://www.signals.com>
- The Paragon website featuring jewelry and watches: <http://www.theparagon.com>
- Rolex website featuring clasps for jewelry and watches: <http://www.rolex.com>
- TAGHeuer website featuring clasps for jewelry and watches: <http://www.tagheuer.com>
- Ben Sherman website featuring watches with clasps for jewelry: <http://www.bensharman.com>
- Target website featuring watches with clasps for jewelry: <http://www.target.com>
- Kohl's website featuring watches with clasps for jewelry: <http://www.kohls.com>
- Atlantic Gems website selling clasps and watches: <http://www.atlanticgems.com>
- Beadalon website selling clasps and watches: <http://www.beadalon.com>
- Bello Modo website selling clasps and watches: <http://www.bellomodo.com>
- Goody Beads website selling clasps and watches: <http://www.goodybeads.com>
- Shipwreck Beads website selling clasps and watches: <http://www.shipwreckbeads.com>

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Although applicant argues that the parties' respective consumers differ, no evidence has been provided to indicate as such. Regardless, with respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and

broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in registrant's more narrow identification.

Moreover, applicant has not provided evidence that the consumers are sophisticated and knowledgeable enough to obviate this refusal. The examining attorney has attached evidence of jewelry, clasps, and watches sold at low price points on the Forever 21 and JCPenney websites. "Generally, casual purchasers of low-cost, every-day consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods." *In re Davia*, 110 USPQ2d 1810, 1818 (TTAB 2014) (citing *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984)).

The surname significance of the registered mark does not diminish the likelihood of confusion. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register or the Principal Register with a claim of acquired distinctiveness. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

If 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).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP

§715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Joanna E. H. Fiorelli/

Trademark Examining Attorney

Law Office 105

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Watches
- Body Jewelry**
Sets
Watches
Rings & Vials
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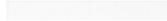
FOREVER 21
Clear Cutout Choker
\$10.90



FOREVER 21
Etched Curve Fringe Necklace
\$6.90



FOREVER 21
Southwestern-Embroidered Bracelet Set
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Layered Charm Choker
\$9.90



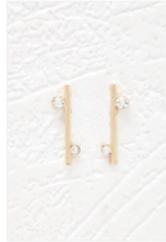
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FOREVER 21
Half Cutout Cuff
\$6.90



21 MEN
Cross Pendant Necklace
\$5.90
BACK IN STOCK



FOREVER 21
Rhinestone Matchstick Studs
\$3.90



FOREVER 21
Moon and Star Pendant Necklace
\$5.90



FOREVER 21
Flower and Earcuff Earring Set
\$5.90



FOREVER 21
Faux Wood Pendant Necklace
\$4.90



FOREVER 21
Geo Wood Pendant Choker Necklace
\$5.90





FOREVER 21
Faux Stone Pendant Necklace Set
\$8.90



FOREVER 21
Faux Leather-Trimmed Cuff
\$7.90



FOREVER 21
Women's Adjustable Cuff
\$7.90



FOREVER 21
Cis-Oh Septum Ring Set
\$4.90



FOREVER 21
Geo Collar Necklace
\$4.90



FOREVER 21
Etched Faux Stone Bangle Set
\$9.90





FOREVER 21
Etched Leaf Necklace Set
\$5.90



FOREVER 21
Angique Faux Marble Pendant Necklace
\$5.90



FOREVER 21
Etched Tier Drop Earrings
\$6.90



FOREVER 21
Faux Leather Hinge Cuff
\$7.90



FOREVER 21
Southwestern-Inspired Statement Necklace
\$16.90



FOREVER 21
Elephant Etched Ring
\$3.90





FOREVER 21
Faux Stone Engraved Bracelet Set
\$8.90



FOREVER 21
Figue Charm Necklace
\$4.90



FOREVER 21
Rhinestone Almond Charm Necklace
\$4.90



FOREVER 21
Faux Pearl Hoop Earrings
\$2.90



FOREVER 21
Multi-Tone Faux Crystal Necklace
\$4.90



FOREVER 21
Faux Leather Buckle Bracelet
\$4.90





FOREVER 21
Cat Portrait Studs
\$2.90



FOREVER 21
Bamboo Hoop Earrings
\$3.90



FOREVER 21
Faux Leather Buckled Bracelet
\$7.50



FOREVER 21
Layered Celestial Charm Necklace
\$4.90



FOREVER 21
Crescent Moon and Starburst Drop Earrings
\$4.90



FOREVER 21
Faux Pearl Button Studs
\$2.90



FOREVER 21
Etched Fake Stone Studs
\$3.90



FOREVER 21
Horseshoe Charm Layered Necklace
\$8.90



FOREVER 21
Ornate Cuff Bracelet
\$4.90





FOREVER 21
Faux Marble Ear Jackets
\$4.90



FOREVER 21
Etched Faux Stone Earrings
\$4.90



FOREVER 21
Rhinestone Cuff Hand Chain
\$5.90



FOREVER 21
Layered Matchstick Necklace
\$6.90



FOREVER 21
Mixed Charm Bracelet Set
\$6.90



FOREVER 21
Faux Stone Pendant Necklace
\$4.90





FOREVER 21
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\$5.99



FOREVER 21
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\$6.99



FOREVER 21
Crescent and Fringe Necklace Set
\$5.99



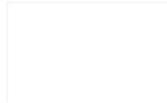
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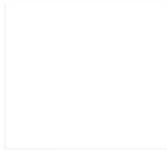


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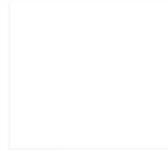


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Triangle Charm Threader Earrings
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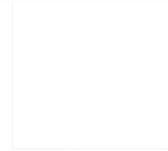




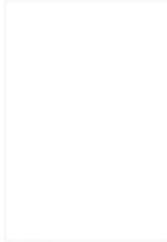
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Etched Crescent Medallion Necklace
\$9.90



FOREVER 21
Cord and Wire Wrapped Bangle Set
\$5.90



FOREVER 21
D-Shaped Bracelet Set
\$5.90



FOREVER 21
Arrowhead Charm Necklace
\$2.90



FOREVER 21
Facet Stone and Leaf Bracelet Set
\$5.90



FOREVER 21
Flat Bar Wrist Cuff
\$4.90





FOREVER 21
Etched Faux Stone Bracelet
\$1.99



FOREVER 21
Rhinestone Band Midi Ring Set
\$3.99



FOREVER 21
Faux Stone Bracelet Set
\$4.99



FOREVER 21
Onyx Midi Ring Set
\$3.99



FOREVER 21
Faux Gem Stud and Ear Cuff Set
\$3.99



FOREVER 21
Longline Cube Bead Necklace
\$5.99



FOREVER 21
Matnick Duster Earrings
\$3.90



FOREVER 21
Fair Stone Ring Set
\$4.90



FOREVER 21
Rhinestone Drop Earring Set
\$4.90



FOREVER 21
Elephant Statement Necklace
\$12.90



FOREVER 21
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\$3.90



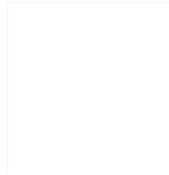
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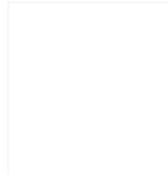
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FOREVER 21
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\$4.90





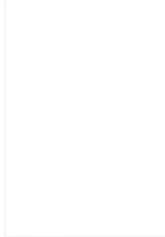
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FOREVER 21
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\$4.50



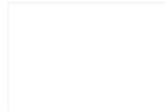
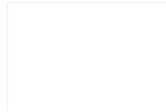
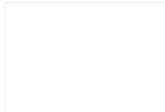
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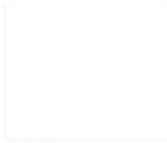


FOREVER 21
Wing-Shaped Studs
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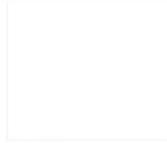


FOREVER 21
Crochet and Filigree Foot Chain Set
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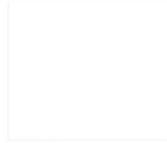




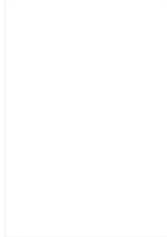
FOREVER 21
Acrylic Set Earrings
\$4.90



FOREVER 21
Layered Circle Bead Bracelet
\$3.90



FOREVER 21
Faux Crystal Layered Necklace
\$7.90



FOREVER 21
Geo Cubit Bangle Set
\$7.90



FOREVER 21
Floral Rhinestone Ring
\$4.90



FOREVER 21
Plated Faux Leather Cuff
\$6.90





FOREVER 21
Qeo Single Set
\$4.90



FOREVER 21
Rhinestone Pendant Statement Necklace
\$14.90



FOREVER 21
Half Circle Pendant Necklace Set
\$6.60



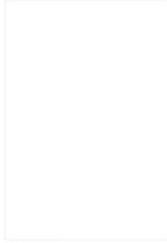
FOREVER 21
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FOREVER 21
One Sided Ear Pins
\$3.90



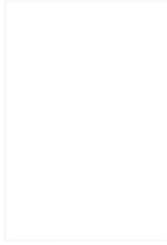
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Thread-Wrapped Threader Earrings
\$4.90



FOREVER 21
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\$9.90



FOREVER 21
Layered Coin Statement Necklace
\$15.90



FOREVER 21
Longline Arrowhead Pendant Necklace
\$3.90



FOREVER 21
Paua Shell Threader Earrings
\$3.90



FOREVER 21
Classic Hoop Earrings
\$7.90

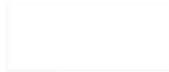


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Open-Front Seashell Ring
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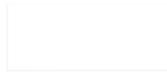


FOREVER 21
Choker Necklace Set
\$7.90

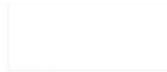




FOREVER 21
Beaded Satchel Pendant Necklace
\$5.99



FOREVER 21
Faux Gem Charm Necklace
\$3.99



FOREVER 21
Matte Cutout Arm Cuff
\$6.99



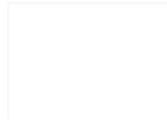
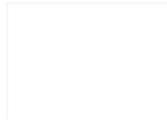
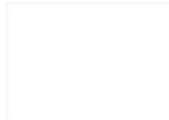
FOREVER 21
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\$4.99

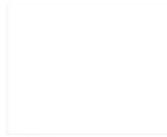


FOREVER 21
Beetle Set Charm Necklace
\$2.99

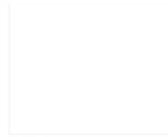


FOREVER 21
Shell and Star Stud Set
\$3.99

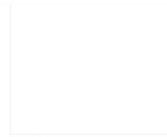




FOREVER 21
Trapezoid Pendant Collar Necklace
\$6.90



FOREVER 21
Rhinestone Pyramid Studs
\$2.90



FOREVER 21
Mixed Bangle Set
\$10.90



FOREVER 21
Pentagonal Pendant Necklace
\$4.90



SHASHI
Shashi Arushi Earrings
\$38.00



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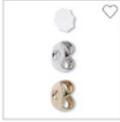
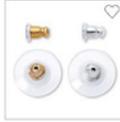
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Must™ Cozy Infinity Scarf
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