

From: Kozak, Evin

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To: TTAB E filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85748352 - IMPRESS - T-4456.001-A - Request for  
Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 1

Files: 85748352.doc

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

**U.S. APPLICATION SERIAL NO.** 85748352

**MARK:** IMPRESS



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

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

**APPLICANT:** Gamila Company

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

T-4456.001-A

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 10/25/2013

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. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated 04/08/2013 is maintained and continues to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Specifically, applicant continues to assert that the marks differ in appearance, sound, meaning and commercial impression. In support of its contention that the ending letter "A" in registrant's mark sufficiently differentiates the marks, applicant relies on *McGergor-Doninger, Inc., v. Drizzle Inc.* However, that case is readily distinguishable on the facts. Specifically, the Court in that case placed great emphasis on the fact that "the label in each DRIZZLER jacket prominently features the McGregor name, which is printed in striking plaid letters. In addition, although there was testimony that retail stores on occasion in independent advertisements omit the McGregor logo, the evidence showed that McGregor always emphasizes the company name in its own advertising of DRIZZLER jackets." *Id.* at 1133-1134. The Court goes on to clarify that, "if Drizzle had chosen consistently to present its mark in red plaid lettering or to advertise its coats as the McGregor DRIZZLE line, we would be compelled to conclude that the similarity between the DRIZZLER mark and the DRIZZLE mark, as generally presented to the public, had been heightened and that the likelihood of confusion had been enhanced is misplaced." *Id.* In this case, both applicant and registrant identify marks in standard and/or typed characters, and 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, 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").

Furthermore, applicant contends that the refusal is based on "the incorrect presumption that 'impress' and 'impressa' are foreign equivalents." However, rather than basing the refusal on the doctrine of foreign equivalents, the translations of record are included simply to bolster that the applied-for mark, in addition to consisting in its entirety of the root word of the registered mark and carrying the impression of a foreign version of registrant's mark, may be interpreted by consumers as a translated version of registrant's mark because IMPRESSA may be translated to mean IMPRESS. Furthermore, applicant's arguments regarding the rarity of American consumers who speak Italian is unfounded.

Specifically, it is well established that common, modern languages include Italian. *See, e.g., In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (Italian).

Moreover, applicant's attempts to limit the applied-for and/or registered goods based on external evidence, including registrant's specimen of record and/or applicant's website, are impermissible. It is well-established that the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). And, absent restrictions in an application and/or registration, the identified goods 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 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). Moreover, the evidence of record confirms that the applied-for and registered goods are similar in nature, frequently emanate from a common source, and target the same consumer. Furthermore, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

As discussed in the prior Office actions with accompanying evidence, because the applied-for and registered marks are nearly identical in appearance, sound and meaning, carry the same overall commercial impression and will be used on goods that are similar in nature, frequently emanate from a common source and target the same consumers, the request for reconsideration is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to overcome any outstanding final refusal and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Evin L. Kozak/

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