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

Proceeding	86051465
Applicant	Fashion Box S.P.A.
Applied for Mark	RS RED SEAL THE ORIGIN
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I. INTRODUCTION

Applicant appeals from the Examining Attorney's refusal to register Applicant's mark RS RED SEAL THE ORIGIN & Design on the Principal Register on the basis that the mark is likely to be confused with the mark RED SEAL (U.S. Reg. No. 3,978,673) under Section 2(d).

II. PROCEDURAL HISTORY

On August 29, 2013, Applicant filed an intent-to-use application for the mark RS RED SEAL THE ORIGIN & Design for proposed use in connection with "Men's clothing, namely, denim pants, denim shirts, denim jackets, jeans, trousers, jackets, sweaters, shorts, polo-shirts, T-shirts, sweatshirts, coats, belts, hats, bucket caps, caps with visor, sports caps, skull caps, knot caps, swim caps".

On October 11, 2013, the Examining Attorney issued an Office Action indicating that there would be a likelihood of confusion between Applicant's RS RED SEAL THE ORIGIN & Design and the cited RED SEAL mark (U.S. Reg. No. 3,978,673).

On March 10, 2014, Applicant filed a response to the Office Action asserting that Applicant's mark was not confusingly similar to the registered mark.

On March 24, 2014, the Examining Attorney issued a Final Refusal maintaining the arguments included in its initial Office Action and including evidence allegedly establishing the relatedness of the goods included in the applied-for mark as compared to those goods covered by the cited mark.

On July 29, 2014, Applicant filed a Notice of Appeal to the Final Refusal which was acknowledged by the Board on the same day.

III. ARGUMENT

It is well settled that the present standard for determining likelihood of confusion is based on an evaluation of the “DuPont factors.” *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). The Dupont factors are listed as follows:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity of and nature of the goods or services described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which, and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing.
5. The conditions under which, and buyers to whom sales are made.
6. The fame of the prior mark (sales, advertising, length of use).
7. The number and nature of similar marks in use on similar goods.
8. The nature and extent of any actual confusion.
9. The length of time during, and conditions under which there has been concurrent use without evidence of actual confusion.
10. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
11. The market interface between the applicant and the owner of a prior mark.
12. The extent to which applicant has a right to exclude others from use of its mark on its goods.
13. The extent of potential confusion, *i.e.*, whether *de minimis* or substantial.
14. Any other established fact probative of the effect of use.

Applicant will now discuss the above-listed factors to the extent they are relevant in determining a likelihood of confusion between the cited registrations and Applicant's mark.

- A. The cited mark RED SEAL is highly dissimilar as compared to the applied-
for mark

Applicant's mark, as applied for, is shown below



As the Board can very easily see, Applicant's mark is comprised of several distinct elements in the nature of wording/lettering. One such element is the lettering RS. The second element is the wording RED SEAL. The third element is for the wording THE ORIGIN. In addition, Applicant's mark is comprised of a highly eye-catching design element where all of the wording/lettering contained therein is within a circle, and the RS lettering is contained within a separate distinct circle. By comparison, the registered mark is only comprised of the wording RED SEAL.

It is true that the cited mark is entirely encompassed within the body of Applicant's mark, but that fact alone does not necessarily establish that confusion is likely between the relevant marks as it is well-settled that when evaluating between two marks, said marks must be compared in their entireties. TMEP § 1207.01(b), *DuPont at 563*.

In the Examining Attorney's Final Refusal, the Examining Attorney asserted, in part, that the marks in question are confusingly similar because the word portion of a mark is generally

given greater weight than the design aspect of a mark when determining whether marks are confusingly similar. Final Refusal p. 2.

While it is true that at times the word portion of a mark may be considered to be the dominant aspect thereof, "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement), *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1669 (TTAB 2007) (finding that the mark PAPER DOLL A WOMEN BY ANY DEFINITION was not confusingly similar to the mark PAPER DOLL PROMOTIONS in part "because of the prominent design element in the registered mark"), *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (finding that BODYMAN and BOD MAN are not likely to be confused in part because of the prominent design element utilized in the applicant's mark).

Applicant further notes that "[I]t is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Franklin Mint Corporation v. Master Manufacturing Company*, 212 USPQ 233, 234 (CCPA 1981) (citing *Massey Junior College v. Fashion Institute of Technology*, 181 USPQ 272 (CCPA 1974)). Based on the language included in the Final Refusal, however, it appears that the Examining Attorney has done just that, in that the Final Refusal effectively solely focuses on the common language RED SEAL utilized in Applicant's mark and the registered mark, which ignores the other key elements in Applicant's mark, and more importantly ignores the overall commercial impression created by Applicant's mark as a whole, which is comprised of a variety of distinguishing elements to create an overall unique and distinctive sum of its parts. In merely

focusing on the comparison between the RED SEAL aspect of Applicant's mark and the same wording in the cited mark, the Examining Attorney has engaged in an improper "dissection of individual features" of the relevant marks as compared to the appropriate test which requires the Examining Attorney to make an assessment with regard to the marks' "overall impression." *Sun-Fun Products, Inc. v. Sontan Research & Development, Inc.*, 213 USPQ 91, 94 (5th Cir. 1981). Further to this point, it is necessary to consider the marks' "overall impression" when compared to each other because "[A]n average purchaser does not retain all the details of a mark, but rather the mental impression the mark creates in its totality." *T & T Mfg. Co. v. A.T. Cross Co.*, 197 USPQ 763, 770 (D.R.I. 1978), *aff'd* 201 USPQ 561 (1st Cir. 1978), *cert. denied*, 441 U.S. 908, 60 L. Ed. 2d. 377, 99 S.Ct. 2000, 202 USPQ 320 (1979).

In the present case, the registered mark is only comprised of the wording RED SEAL. By comparison, a consumer looking at Applicant's mark will notice not just the RED SEAL wording, but also, the red color contained in the stylized mark, as well as the RS lettering and the phrase "the origin". The fact that Applicant's mark contains all of these additional elements makes it highly unlikely that a typical consumer would look at Applicant's mark, and solely remember the RED SEAL element contained therein when making a comparison to the registered mark, which would tend to make confusion between the marks highly unlikely. Further to this point, a consumer asking for clothing sold under Applicant's brand is just as likely to ask for RS jeans as s/he theoretically might be inclined to ask for RED SEAL jeans.

Further, for reasons already stated herein, when making a likelihood of confusion analysis it is imperative to compare the marks as a whole, including the stylized/design elements of Applicant's mark. However, assuming *arguendo* that a typical consumer were to be focused solely on the wording in Applicant's mark, on the grounds asserted by the Examining Attorney

that a consumer is more likely to recall the wording aspect of a mark as compared to the design aspects, Applicant asserts that the commercial impression created by the wording in Applicant's mark is still quite dissimilar from the one created by the words included in the registered mark. The wording in Applicant's mark is not just "RED SEAL", but also, the lettering RS and the distinct phrase "THE ORIGIN", which all serve to very significantly distinguish Applicant's mark from the registered mark. In the Final Refusal, there is no basis for any assertion that the wording RED SEAL contained therein would be deemed to be the "dominant portion" of the wording comprising Applicant's mark. In fact, the lettering RS contained within Applicant's mark is much bigger, and more visibly prominent than the RED SEAL and THE ORIGIN wording included therein. As a result, if any singular portion of Applicant's mark is likely to resonate with a prospective consumer, it would likely be the RS lettering, as it is larger and more prominent than the remainder of Applicant's logo mark.

It is for all of the foregoing reasons that the overall commercial impression created by Applicant's mark is highly distinct from the registered RED SEAL mark, and that

B. The wording RED SEAL is very commonly used for a variety of products

Applicant further notes that the wording RED SEAL has been used by a multitude of different entities in a variety of different fields. Further to this point, Applicant's calls the Board's attention to certain third party registrations for the mark RED SEAL.

Of note are the registrations for HONG BAU (which when translated means RED SEAL) for use with wine and liquor in Class 33 (Reg. No. 3,027,759), RED SEAL for use with paint in Class 2 (Reg. No. 2,601,840), RUEDRICH'S RED SEAL ALE HAND MADE SINCE 1987 MENDOCINO COUNTY NORTH COAST BREWING COMPANY for use with beer in Class 32 (Reg. No. 2,009,351), a separate registration for RED SEAL in Class 34 for snuff (Reg. No.

527,124), in addition to all of the other RED SEAL registrations attached to Applicant's response to the first non-final Office Action. It is clear from the multitude of these registrations that contain the word RED SEAL (or the translation thereof) contained therein, that the typical consumer has become highly accustomed to seeing the wording RED SEAL used for a variety of products, as the mark has become weak or diluted as a whole. Further to this point, Applicant notes that the cited Class 18 registration for the mark RED SEAL was approved by the Trademark Office over all of these other cited registrations containing the wording RED SEAL. This is despite the fact that there are a voluminous number of trademark registrations which have been registered for the bags in Class 18 covered by the registered mark, as well as smoker's articles in Class 34, beer in Class 32, wine in Class 33, and paint in Class 2, examples of which Applicant previously attached to its response to the First non-final Office Action. Under typical circumstances, this would demonstrate that the Class 18 goods covered by the cited registration would be deemed related to the aforementioned Class 2, 32, 33 and 34 goods covered by the other RED SEAL based applications. However, Applicant asserts that the coexistence of the cited RED SEAL Class 18 registration in conjunction with all of these other RED SEAL marks used for the referenced goods demonstrates that the Trademark Office has made the determination that the wording RED SEAL is quite common across a variety of products and services. It further demonstrates that in the absence of the use of the wording RED SEAL used in conjunction with goods that would be considered essentially identical to the goods or services covered by a prior registration that confusion would be unlikely amongst marks sharing the common, highly diluted, RED SEAL wording.

C. The Class 18 goods covered by the cited mark are not closely related to the Class 25 men's clothing covered by Applicant's mark

In support of the refusal, the Examining Attorney provided multiple registrations from the USPTO's X-Search database consisting of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. Applicant does not question the validity of these registrations, although it does note that the goods covered by the applied-for mark are limited to men's clothing so to the extent that any of the third-party registrations reference women's clothing only, those registrations would not be relevant for the purpose of showing relatedness between the goods covered by the applied-for application and the cited registration. In addition, the Examining Attorney included evidence from well-known clothing companies which allegedly establish that certain types of men's wear covered by Applicant's pending application would be related to the different Class 18 goods included in the cited registration. While it may be true, pursuant to the registrations and internet evidence provided by the Examining Attorney, that at times the same mark is used in conjunction with men's wear in Class 25, and certain types of bags in Class 18, this evidence does not necessarily show that the applied-for RED SEAL THE ORIGIN RS & Design mark is confusingly similar to the registered, cited RED SEAL mark in Class 18.

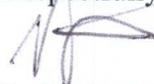
It is well settled that, when assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. TMEP § 1207.01 (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). Therefore, it stands to reason that the opposite holds true as well, namely, that the less similar the marks are, the closer the

relationship between the goods must be in order to support a finding of likelihood of confusion. As already stated herein, the applied for mark is visually and aurally quite distinct from the registered mark in that it contains multiple colors, the additional wording THE ORIGIN and a highly stylized RS design element. Accordingly, it is apparent to even the most casual observer that the comparative marks are not at all similar, and merely share a single element. As a result, because of this high degree of dissimilarity between the relevant marks, the goods in question would have to be highly related, if not identical, in order for there to be a likelihood of confusion between said marks. In this case, the men's clothing products covered by the applied-for mark are not identical, and not even very closely to the certain types of bags that are covered by the cited registration, despite the third-party registrations and third-party websites provided by the Examining Attorney in the Final Office Action. This is the case because while there may be some limited instances where the same name is used for both men's clothing and certain types of bags that are covered by the registered mark, these items would be sold in entirely different departments in the same department store, and consumers would be unlikely to encounter the parties' products being marketed on the same portions of websites and advertising circulars. As a result, it is not very likely that typical consumers would immediately associate Applicant's men's clothing products as items that are closely related to those allegedly offered by the registrant with its RED SEAL mark. Therefore, due to all of the circumstances set out herein, while there might be a slight relationship between the items covered by the registered mark in the abstract and clothing in the abstract, when making a final determination with respect to likelihood of confusion as a whole, Applicant asserts that when considering the actual goods in question, i.e., men's clothing, no such relatedness exists, and in light of the significant disparity between the marks, Applicant asserts that the goods in question are not sufficiently related to support a likelihood of confusion refusal.

IV. CONCLUSION

In light of all of the foregoing arguments, precedent and evidence, Applicant submits that its mark is not likely to be confused with the registered RED SEAL mark owned by K. Hansotia & Co., and that as a result, the likelihood of confusion rejection should be withdrawn, and accordingly, that Applicant's mark should be permitted to proceed to publication.

Respectfully submitted,



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