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Subject: U.S. TRADEMARK APPLICATION NO. 86051465 - RS RED SEAL THE ORIGIN - 456/1162 - EXAMINER BRIEF

Attachment Information:

Count: 17

Files: Cited Registration.jpg, 77751991P001OF002.JPG, 77751991P002OF002.JPG, Third Party Registrations.jpg, 85093148P001OF003.JPG, 85093148P002OF003.JPG, 85093148P003OF003.JPG, 85566259P001OF003.JPG, 85566259P002OF003.JPG, 85566259P003OF003.JPG, 85724503P001OF003.JPG, 85724503P002OF003.JPG, 85724503P003OF003.JPG, 85745932P001OF003.JPG, 85745932P002OF003.JPG, 85745932P003OF003.JPG, 86051465.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<p>U.S. APPLICATION SERIAL NO. 86051465</p> <p>MARK: RS RED SEAL THE ORIGIN</p>	
<p>CORRESPONDENT ADDRESS: KEITH A WELTSCH SCULLY SCOTT MURPHY & PRESSER PC 400 GARDEN CITY PLAZA STE 300 GARDEN CITY, NY 11530-3319</p>	<p>GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp</p> <p>TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp</p>
<p>APPLICANT: Fashion Box S.P.A.</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO: 456/1162</p> <p>CORRESPONDENT E-MAIL ADDRESS: intprop@ssmp.com</p>	

EXAMINING ATTORNEY'S APPEAL BRIEF

I. FACTS

Applicant has appealed the examining attorney's refusal to register applicant's mark RS RED SEAL THE ORIGIN for "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" based on a likelihood of confusion with the mark RED SEAL for "Carry-all bags, leather pouches, rucksacks, duffle bags, travel bags, tool bags sold empty, backpacks, purses, trunks, suitcases, garment bags for travel, billfolds, wallets, harnesses, leather bags, leather bag laces, valises" in U.S. Registration No. 3978673 under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The only issue before the Trademark Trial and Appeal Board is the Trademark Act Section 2(d) refusal based on U.S. Registration No. 3978673.

II. ARGUMENTS

A. THE MARKS OF THE PARTIES ARE CONFUSINGLY SIMILAR AND THE GOODS OF THE PARTIES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(D) OF THE TRADEMARK ACT.

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 of the applicant and registrant. See 15 U.S.C. §1052(d). The Court in *In re E. I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be

considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the listed DuPont factors may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are most relevant: similarity of the marks, and similarity of the channels of trade.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i).

The Examining Attorney has determined that the Applicant's goods travel in the same channels of trade as the Registrant's goods, therefore creating a likelihood of confusion and the marks are confusingly similar such that they create a likelihood of confusion.

1. THE MARKS ARE CONFUSINGLY SIMILAR

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Here, applicant's mark, and Registrant's mark both have the wording "RED SEAL." Marks may be confusingly

similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); TMEP §1207.01(b)(ii)-(iii).

In this case, Registrant's mark, RED SEAL, is wholly incorporated by applicant's mark, RS RED SEAL THE ORIGIN. As such, applicant's mark is identical in part to the mark in the cited registration in appearance and sound. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. In *re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983)(LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

Applicant argues their mark comprises several distinct elements including the wording RED SEAL while Registrant's mark is only the wording RED SEAL. The dominant portion of applicant's mark is the top portion RED SEAL in large letters, and this is identical to Registrant's mark RED SEAL.

The wording RED SEAL, in applicant's mark, is given greater weight because that is the wording which consumer will refer to applicant's goods. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed").

Applicant also argues the examining attorney ignores the overall commercial impression of applicant's mark which they believe is different from Registrant's mark. The connotation and

commercial impression of the wording RED SEAL in each mark does not differ when considered in connection with applicant's and registrant's respective related goods given that they travel in the same fashion trade channel.

Furthermore, Registrant's mark is in standard characters, and a mark in 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); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark such as applicant's, presented in stylized characters with a design element 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 Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909.

One must remember that when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

In this case, consumers will refer to applicant's mark as RED SEAL, and thus there is a likelihood of confusion with Registrant's mark of RED SEAL.

B. THE APPLICANT'S GOODS AND REGISTRANT'S GOODS ARE HIGHLY SIMILAR AND IN THE SAME TRADE CHANNELS

In accordance with the practice established in *In re August Storck KG*, 218 USPQ 823 (TTAB 1983), in addition to examining the similarities of the marks to determine likelihood of confusion, similarities between the goods or services associated with the marks must be considered. The goods of the parties, however, need not be identical or even competitive to find a likelihood of confusion. See *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 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.” *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

The applicant's goods comprise “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.” The registrant's goods comprise “Carry-all bags, leather pouches, rucksacks, duffle bags, travel bags, tool bags sold empty,

backpacks, purses, trunks, suitcases, garment bags for travel, billfolds, wallets, harnesses, leather bags, leather bag laces, valises.”

The applicant argues their goods are not closely related to Registrant’s goods. The evidence of record, comprising consumer webpages and third-party registrations, clearly demonstrates the overlap and similar channels of trade of applicant’s and Registrant’s goods, and that the goods are complementary in nature. Providers of goods similar to Registrant’s such as bags, wallets, and valises etc., often also provide clothing including men’s clothing. Where evidence shows that the goods at issue have complementary uses, and thus are often used together or otherwise purchased by the same purchasers for the same or related purposes, such goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (holding bread and cheese to be related because they are often used in combination and noting that “[s]uch complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion”). Applicant’s and registrant’s goods, therefore, are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009).

Applicant goes on to argue that “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.” Again, in a likelihood of confusion refusal, the applied for goods and cited goods need not be identical.

Applicant also argues the third-party registrations showing relatedness of the goods, submitted by the Examining Attorney, feature only women's clothing. The Examining Attorney disagrees and highlights a few previously submitted Registrations featuring "clothing" in general and clothing for men, specifically, Registration Nos. 4492058, 4476677, 4473451, 4332798, to list a few:

- 4492058 – **018** "Backpacks, book bags, sports bags, wallets and handbags; Carry-all bags; Duffel bags; Leather and imitation leather bags; School bags; Travel bags."

025 "Men's, women's and children's apparel and clothing of all types, namely, jerseys, pants, shirts, blouses, slacks, shorts, belts, underwear, socks, hosiery, swimwear, coats, jackets, pullovers, sweatshirts and sweaters; headwear."

- 4476677 - **018** "traveling bags, tote bags, flight bags, travel bags, business card cases, credit card cases, pocket wallets, wallets, passport cases, key cases."

025 "Men's clothing, namely, bathrobes, socks, sleepwear, underwear; headwear, namely, hats, caps; suspenders, wrist bands, footwear; women's clothing, namely, pants, dresses, coats, jackets, skirts, sleepwear."

- 4473451 – **018** "Backpacks, schoolbags, purses, tote bags and wallets for men, women and children."

025 "Men's, women's and children's pants, overalls, coveralls, jeans; shirts; jackets; Men's, women's, and children's blouses, dresses; denim jackets; gloves; Men's,

women's and children's capri pants, vests, shorts, T-shirts, sport shirts; polo shirts; skirts; wind resistant jackets; jacket liners; coats, suspenders; work aprons; school uniforms for children, namely, jackets, shirts, pants, shorts, skirts, skirtalls, socks, hosiery, bowties, neckties; belts; women's and children's sleepwear, men's and boy's pajamas, underwear; Men's, women's and children's headwear, namely, visors, caps, hats, bandanas, baseball caps, and beanies; footwear, namely, boots and shoes; Men's, women's, and children's athletic wear, namely, sweat bands, sweatshirts, hooded sweatshirts, sweatpants; Men's, women's and children's footwear, namely, athletic footwear, sneakers; Men's and women's lab coats; nurses apparel, namely, tops, pants, scrubs not for medical purposes.”

- 4332798 – **018** “Trunks; traveling trunks; suitcases; traveling bags; luggage; garment bags for travel; hat boxes for travel not of paper or cardboard; shoe bags for travel; umbrellas; animal carriers; rucksacks; haversacks; leather and textile shopping bags; beach bags; handbags; vanity cases sold empty; attaché cases; tote bags; travel satchels; clutch bags; briefcases; wallets; pocket wallets; credit card cases and holders; business card cases; key cases; change purses; briefcase-type portfolios.”

025 “Men's, women's, and children's clothing, namely, T-shirts, sweatshirts, sweatpants, swim trunks, walking shorts, pants, belts, jackets and hats.”

The previously submitted third-party registrations clearly support the conclusion that the goods at issue are related and that it is not difficult to imagine that the goods of applicant and Registrant are of

a type that emanate from the same source. The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. In re Majestic Distilling Co., 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); In re Shell Oil Co., 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

1. "RED SEAL" IS NOT DILUTED

IN APPLICANT'S AND REGISTRANT'S FIELD OF USE

The applicant contends "RED SEAL" is used for a variety of products and has become weak or diluted. For applicant's goods, the wording "RED SEAL" is not weak. Applicant has submitted printouts of third-party registrations for marks containing the wording RED SEAL to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in

actual use in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). Furthermore, the goods and/or services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods at issue.

CONCLUSION

The examining attorney submits that the evidence of record establishes the prima facie case that consumers are likely to be confused by the use of similar marks on or in connection with applicant's and registrant's goods. For the foregoing reasons, refusal on the grounds that the proposed mark is likely to be confused with U.S. Registration No. 3978673, within the meaning of Trademark Act Section 2(d), 15 U.S.C. §1052(d) of the Trademark Act, should be upheld. The trademark examining attorney respectfully requests that the Board affirm the refusal on this ground.

Respectfully submitted,

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/gy/

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Cited | Registration

Third Party Registrations