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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**

On November 15, 2014, the Examining Attorney filed her Appeal Brief with the Board in support of the Final Refusal regarding the rejection of the applied-for mark RS RED SEAL THE ORIGIN based on a likelihood of confusion with the registered mark RED SEAL registered under U.S. Reg. No. 3,978,673. In the Examiner's Appeal Brief, the Examiner's main arguments were: 1) Applicant's mark was similar to the registered mark, 2) the clothing products included in the instant application would be deemed related to the bags included in the cited Class 18 registration and 3) that "RED SEAL" is not diluted in Applicant's and registrant's field of use. Applicant takes this opportunity to specifically rebut a few of the key points raised by the Examining Attorney in his Brief.

II. **Argument**

A. **Applicant's RS RED SEAL THE ORIGIN mark is not confusingly similar to the registered RED SEAL word mark**

The Examining Attorney's Statement states that "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" and further states that a likelihood of confusion can be found where "the entirety of one mark is incorporated within another". (Examiner's Statement pgs. 3 - 4). However, this assertion is a general one, and not a rule that must be followed at all times. Further to this point, the cases cited by the Examining Attorney in support of this contention are distinguishable from the present case. In the case of *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984), the registered mark was COLLEGIENNE, and the applicant's mark was COLLEGIAN OF CALIFORNIA with a disclaimer of the wording CALIFORNIA. In the case of *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479 (TTAB 1983) the registered

mark was LITTLE LADY, and the applicant's mark was LIL' LADY BUGGY with a disclaimer of the wording BUGGY. In both of these instances, the applicant added a descriptive word to an existing registered mark, and in both instances, the Board determined that such an addition was not sufficient to create a distinction between the relevant marks. While this may be the general rule, it is not disputed by the Examining Attorney that the RS lettering, the phrase "THE ORIGIN", as well as the Applicant's circular are in no fashion descriptive or suggestive terms. Therefore, the cases cited by the Examining attorney are not applicable.

In fact it has been held that there would be no likelihood of confusion when it has been determined that the marks in their entireties convey significantly different meanings or commercial impressions or the incorporated matter has been so merged with the other matter that it "loses its separate identity". See, e.g., *Castle & Cooke, Inc. v. Oulevay, S.A.* 152 USPQ 115 (CCPA 1967) (FARANDOLE not confusingly similar to DOLE for related food products because DOLE is so merged into FARANDOLE that it loses its individual identity therein). See also, *Lever Brothers Company v. The Barcolene Company*, 174 USPQ 392 (CCPA 1972) (mark ALL CLEAR! not confusingly similar to ALL); and *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) (no likelihood of confusion found between marks PEAK for dentifrice and PEAK PERIOD for personal deodorant). In the present case, there are so many other source indicating elements in Applicant's mark, as previously discussed, and detailed herein, it is clear that the wording RED SEAL as contained therein, is just one of many elements comprising said mark that merges with the other elements of the mark, allowing it to create an entirely different commercial impression.

Applicant asserts that a more comparable case is *In Re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 363 (TTAB 1984). In *Martin's*, the Board held that the applicant's mark, which

contained the wording MARTIN'S FAMOUS PASTRY SHOPPE with a unique design element was not confusingly similar to the word mark MARTIN'S.¹ In this case, the Board determined that the additional terms, as well as the design element, which when considered cumulatively, rendered a "likelihood of confusion remote". *Id.* at 367. In the instant case, the additional elements are such that the additional words in Applicant's mark other than RED SEAL are in no capacity descriptive when used in conjunction with Applicant's listed goods. The present case is highly distinguishable from the cited cases in that Applicant has added multiple source identifying elements, namely, a distinctive circular design, the letters RS as well as the phrase "THE ORIGIN".

As already stated in Applicant's initial brief, there is no hard and fast rule that the wording in a mark is necessarily the dominant portion thereof. However, assuming *arguendo* that the wording in Applicant's mark, is in fact, the dominant portion thereof, there is nothing in the Examiner's Statement supporting her position that the dominant portion of the subject wording would be RED SEAL. (Examiner's Statement pg. 4).

It is well-settled that although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. TMEP § 1207.01(b)(viii); *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB's finding that "DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). In this case,

¹ Applicant notes that the Board found that one of the applicant's marks, the word mark MARTIN'S was deemed to be confusingly similar to the registered MARTIN'S mark for use with the same goods covered by the applicant's co-pending MARTIN'S FAMOUS PASTRY SHOPPE. This holding was reviewed, and confirmed by the Federal Circuit. The Board's finding of no likelihood of confusion regarding the MARTIN'S FAMOUS PASTRY SHOPPE & Design mark was not appealed.

there has not been a request for a disclaimer of any of the other wording in Applicant's mark. As a result, it would appear that all of the wording in Applicant's mark would be deemed arbitrary or fanciful. Further, the lettering RS in Applicant's mark is, in fact, significantly larger than the size of the lettering in the RED SEAL component of Applicant's mark and is the central portion of the mark, making it more likely to catch the typical consumer's eye, thus making it much more likely that consumers would perceive the RS lettering to be the dominant word element therein. As a result, assuming *arguendo* that the wording in Applicant's mark was the dominant element thereof, there is no support for a contention that the respective marks share the same dominant element.

Further, while it is true that when a mark is registered in standard characters it may be displayed in any lettering style, the case cited by the Examiner in her statement in support of this contention, *In re Viterra, Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012), is highly distinguishable from the present situation. In the *Viterra* case, the applicant's mark was XCEED and the registered mark was the stylized X-SEED. While X-SEED and XCEED are not identical marks, they are phonetic equivalents of each other, and there was no other wording in either mark. The instant case is distinguishable because Applicant's mark contains multiple other source identifying elements. Thus, it would not be possible for the registered mark to be shown in the same exact manner as Applicant's mark which contains several other word elements therein.

Further, the Examiner has asserted that when comparing the marks, the test is not comparing the marks on a side by side basis, but rather, whether the marks are sufficiently similar in terms of their commercial impressions that confusion as to the source of the goods is likely to result. (Examiner's Statement p. 5). For the reasons stated herein, the overall commercial impression created by Applicant's mark is the combination of a multitude of elements comprising the same,

which permits Applicant's mark to make an entirely distinct commercial impression as compared to the registered mark.

Finally, the Examiner's Statement asserts that consumers will refer to applicant's mark as RED SEAL, which would create a likelihood of confusion with the registered RED SEAL mark. (Examiner's Statement p. 6). However, there is no evidence, in any fashion, of the way that consumers would refer to Applicant's mark. The products might be referred to as RED SEAL THE ORIGIN, RS Jeans, THE ORIGIN jeans, etc. Accordingly, this particular statement by the Examiner should be accorded no weight.

For all of foregoing reasons, it is apparent that the design element and the additional distinctive wording included in Applicant's mark allow it to make a distinct commercial impression as compared to the registered mark. Applicant has done much more than merely add non-distinctive elements to the registered RED SEAL mark, and as a result, its mark would not be considered confusingly similar by the typical consumer, exhibiting the typical amount of care in making this type of purchase.

B. The Applicant's Goods are not "Highly Similar" to the Registrant's Goods

Applicant has conceded throughout the prosecution of the instant application that an identity of goods is not required in order to establish a likelihood of confusion. However, the Examining Attorney has failed to provide evidence or submit arguments sufficient to establish that Applicant's clothing products are sufficiently related to the registrant's bags and the like in Class 18 in order to create the perception that Applicant's proposed goods and the registrant's goods emanate from the same source.

First, the Examining Attorney has asserted that Applicant's goods and the registrant's goods are deemed to be "complementary" and has asserted that when goods are "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”. (Examiner’s Statement pg. 7). The Examiner cited the Federal Circuit’s holding in *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir. 1984) in support thereof where it was determined that bread and cheese are related and complementary because they are used in combination with each other. This assertion however is of no moment in the instant case. Applicant’s goods could not be considered “complementary” to the registrant’s goods in that the bags and the like covered by the registrant’s mark would not be used in combination with clothing, as compared to different types of foods that might be eaten at the same time. In addition, Applicant’s goods would be used for warmth, whereas Applicant’s goods would be used for storing or transport of items. Therefore, Applicant’s goods and registrant’s goods would clearly be used for entirely separate purposes. Therefore, to the extent that the relevant goods must be complementary in order to establish relatedness, the Examiner failed to meet her burden in this regard.

Further, while it may be true that third-party registrations showing that Applicant’s goods and the registrant’s goods are allegedly offered under the same brand name, typically speaking, this evidence “*along with other types of evidence*” (emphasis added) is required in order to establish that the goods at issue are related. TMEP § 1207.01(d)(iii); *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509, 1511 (TTAB 2010). In this case, the “other types of evidence” provided by the Examining Attorney in support of the position that the registrant’s and applicant’s goods are related is quite limited. To a great extent, the first Office Action non-third party registration evidence is in the nature of websites showing the use of women’s clothing and purses. In light of the fact that the instant application is limited to men’s clothing, the inclusion of information showing the same mark

in conjunction with websites offering purses and clothing do not speak to the relevant issue. As far as the non-third party registration evidence included in the Final Office Action is concerned, it appears to be comprised of the John Varvatos website, and one other website that just says “BAGS” on it without any images of clothing on it but with the words “pants” and “shirts” thereon. This evidence is meager, at best, in establishing that consumers have become readily accustomed to seeing the relevant products emanate from the same source. Finally, the mere fact that Applicant’s goods and registrant’s goods might be offered on the same website does not establish that the relevant goods are related, if it cannot be established that typical users would be looking to purchase and use the relevant products under similar circumstances. To this end, if the Examiner’s attempted point with respect to this evidence were taken to its logical conclusion, every single item included on the Target® website, (or other similar large store) would be considered similarly “related”, which would of course be an absurd conclusion.

Finally, Applicant reiterates its earlier stance that assuming *arguendo* that its goods and the registrant’s Class 18 goods are tangentially related, the disparity between the parties’ marks is so great, it is difficult to support a contention that there would still be a likelihood of confusion, as the more dissimilar marks are, the greater relationship there must be between the relevant goods in order to support a likelihood of confusion refusal. *Cf.* TMEP § 1207.01(a) (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).

C. Applicant and Registrant’s Field of Use are not the same

The Examiner asserts in her statement that the third party registrations showing use of the wording RED SEAL are not relevant because they are not used in Applicant **and** the registrant’s

field of use. (Examiner's Statement pg. 10) This statement is significant for several reasons. First, Applicant's goods and the registrant's goods do not have a singular field of use in light of the fact that the goods used therewith are entirely distinct from each other. As a result, the evidence showing that RED SEAL is used in other disparate, and entirely unrelated fields is of relevance in that the public has generally come to see the RED SEAL wording not only diluted in a single field of use, but across a multitude of fields of use. As a result, the previously submitted third party registrations help to establish that the public has become accustomed to seeing marks containing the wording RED SEAL used in a variety of fields. Accordingly, Applicant's intended use of its mark on goods that are entirely different from those covered by the registrant's mark fits in with the overall dilution of this wording across a variety of fields of use with which consumers have become familiar, which will significantly decrease the chances of likelihood of confusion going forward.

III. **Conclusion**

Based on the multitude of distinctions between the applied-for mark and the cited mark, as well as the arguments initially set out in Applicant's Appeal Brief, Applicant respectfully requests that the Board reverse the Final Refusal based on likelihood of confusion, and further, permit the instant application to proceed towards publication on the Principal Register.

Respectfully submitted,



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