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

Proceeding	91201703
Party	Plaintiff Michael Brandt Family Trust d/b/a Eco-Safe Industries, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Melissa Alcantara for Barth X. deRosa/
Date	10/29/2012
Attachments	Second_Amended_Notice_of_Opposition.pdf (12 pages)(63671 bytes) Exhibit A to Second Amended Notice of Opposition.pdf (17 pages)(1750645 bytes) Exhibit B to Second Amended Notice of Opposition.pdf (8 pages)(209204 bytes)

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

_____)	
MICHAEL BRANDT FAMILY TRUST)	
d/b/a ECO-SAFE OF DALLAS,)	
)	Opposition No. 91201703
Opposer,)	
)	Application Ser. No. 77/960,950
v.)	
)	
ISTITUTO ITALIANO SICUREZZA)	
DEI GIOCATTOLI S.R.L.,)	
)	
Applicant.)	
_____)	

SECOND AMENDED NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 77/960,950 covering the mark “ECO-SAFE & Leaf Design” filed March 17, 2010 under Section 44(e) by Istituto Italiano Sicurezza dei Giocattoli S.r.L., a limited liability company doing business under the laws of Italy (hereinafter, “Applicant” or “IISG”), having a principal place of business at Via Europa, 28 Cabiato (COMO) 22060, Italy, published May 24, 2011, time being extended to October 29, 2012 to file a Second Amended Notice of Opposition, Opposer, Michael Brandt Family Trust d/b/a Eco-Safe of Dallas (hereinafter, “Opposer”), a Trust organized under the laws of Texas, located and doing business at 3001 Wheelock Street, Dallas, Texas 75220-2944, believes that it will be damaged by registration of Application Serial No. 77/960,950 and hereby opposes the registration of the mark “ECO-SAFE & Leaf Design.” The grounds for opposition under Section 2(d) of the Lanham Act, as amended, for violation of the anti-use rule for certification marks, for

lack of bona fide intent to use the mark on the stated goods and services, and for fraud, on information and belief, are as follows:

Likelihood of Confusion Under Section 2(d)

1. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer has, through its predecessor, been and is now engaged in the offering and selling of pest control and janitorial related services and also in the manufacture, distribution and sale of pet related products, pest control and sanitary related products, including, but not limited to, carpet freshening preparations, flea control agents, liquid hand soaps, insecticides in spray, powder or liquid forms for domestic, commercial and industrial use, and pest control traps for rats, roaches and other pests, and has continuously used in interstate commerce in connection with such products and services the "ECO-SAFE" mark and name.

2. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer did, through its various licensees, trade as Eco-Safe and presently trades under said name.

3. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer did sell the products and services identified in paragraph 1 herein to customers in the United States in connection with the "ECO-SAFE" mark and name, and is presently using said mark and name in commerce.

4. Opposer relies upon and is the owner of the following registrations, all of which are valid, subsisting, unrevoked and, where applicable, incontestable.

Registration No. 1,749,733
"ECO-SAFE" in International Classes 3, 5, 21, 25, 26, and 37
Dated: February 2, 1993
Renewed: March 26, 2003

Registration No. 1,631,876
“ECO-SAFE and Design” in International Class 37
Dated: January 15, 1991
Renewed: March 21, 2001

Registration No. 1,303,116
“ECO-SAFE” in International Class 37
Dated: October 20, 1984
Renewed: August 7, 2004

Certified status and title copies of the above registrations will be provided at a later date.

5. The products of Applicant, namely, Ropes, string, fishing nets, tents, awnings, tarpaulins, sails, sacks and bags for the transportation or storage of materials in bulk; padding and stuffing materials not of rubber, paper or plastic; raw fibrous textile materials; Yarns and threads, for textile use; Textile fabrics for use in making clothing and household furnishings; knitted fabrics, curtains, pillow cases, bed quilts, quilt covers, duvets, duvet covers, bed sheets, bed spreads, bed blankets, comforters for bed, table cloths not of paper, textile napkins, towels, textile place mats; Clothing, namely, coats, mantles, raincoats, dusters, fur coats, dresses, suits, skirts, jackets, knitwear shirts, trousers, shorts sets, Bermuda shorts, jeans, waistcoats, shirts, t-shirts, tops, blouses, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, brassiere, underpants, night-gowns, shifts, pajamas, nightwear, outerwear coats, hosiery, overalls, salopettes, dungarees, bonnet, clogs, bathrobes, bathing suits, beach-wraps, sun suits, sport jackets, waterproof jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, mufflers, foulards, caps, hats, hoods, gloves, sashes, belts; footwear, beach footwear, athletic footwear, boots, shoes and slippers; Carpets, rugs, mats and matting, linoleum for covering existing floors, Floor coverings of rubber and synthetic rubber, Hard surface coverings for floors, Non-textile wall hangings; and Testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification, are apt to move within similar

channels of trade as the goods and services offered by Opposer and as described in paragraphs 1-4 herein. Many of the products and services distributed and sold by Opposer under the ECO-SAFE mark and name are likely to be purchased and used by the same class of persons who are likely to purchase Applicant's various products and services set forth in paragraph 5 herein.

6. Applicant's mark "ECO-SAFE & Leaf Design" is so confusingly similar in all respects to Opposer's "ECO-SAFE" mark and name, which the public and the trade have long associated and recognized with Opposer, as to be likely, when applied to the goods and services of the Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the products and services of the Applicant emanate from, are offered for sale, or are sold under Opposer's approval, sponsorship, or control all to the great damage of Opposer. Said use by Applicant is also apt to create reverse confusion or confusion as to sponsorship and certification by leading purchasers to believe that Opposer's products are sponsored or certified by Applicant or vice versa when they are in fact not so sponsored or certified, leading such potential purchasers to believe that Opposer is in fact an unauthorized user of the ECO-SAFE mark for its products and services, when in fact it is the lawful owner.

7. On information and belief, Applicant has made no use of the mark "ECO-SAFE & Leaf Design" in the United States for any product or service prior to March 17, 2010, which is Applicant's alleged constructive use date for the mark listed in International Classes 22, 23, 24, 25, 27 and 42.

8. Opposer has expended considerable time, effort and money in advertising and otherwise promoting the sale of its goods and services and encouraging the public and trade to recognize its "ECO-SAFE" mark and name, that unless refused, the registration obtained by Applicant will enable the Applicant to reap the benefits of such good will attached to Opposer's

mark and name, and Opposer will suffer irreparable damage and injury as a result of the confusion that is likely to arise from its inability to control its reputation, as well as its inability to control the ill effects associated with the likelihood of reverse confusion and confusion as to sponsorship and improper certification.

Violation of the Anti-Use by Owner Rule for Certification Marks

9. Opposer hereby incorporates Paragraphs 1 through 8 as fully set forth herein.

10. On information and belief, Applicant is an institution based in Italy that certifies products manufactured by others as to whether such products meet specific standards related to environmental friendliness and safety. Applicant was “founded over thirty years ago, and is today one of the most respected quality and safety **certification** bodies worldwide.” *See* Ex. A (emphasis added), printed pages from Applicant’s websites at <http://www.icqglobal.com/eng/iisg/> and <http://www.ecosafetextile.com/en/>.

11. A review of Applicant’s websites shows that Applicant holds itself out to be a “leading company in the field of toys safety *and certification* for childhood products.” *See* Ex. A (emphasis added).

12. A review of Applicant’s websites shows that Applicant does not, and never has, manufactured or otherwise produced the various products listed in Classes 22, 23, 24, 25 and 27 of its Application. *See generally* <http://www.icqglobal.com/eng/iisg/>.

13. A review of Applicant’s current websites shows that Applicant “grants manufacturers the right to use its [Applicant’s] marks on their products upon the successful **certification** of products[] samples, the inspections during the production and signing jointly the appropriate agreement according to codified procedures,” and that the applied for mark, “ECO-SAFE and leaf design” is one such mark which Applicant grants others, such as manufacturers,

the right to use upon proper **certification**. See Ex. A (emphasis added), printed pages from Applicant's websites at <http://www.icqglobal.com/eng/iisg/> and <http://www.ecosafetextile.com/en/>; see also Ex. B, pertinent portion of the Office Action issued on June 26, 2010 regarding Applicant's ECO SAFE mark, attaching (at p. 5) an "excerpt retrieved from the Internet on June 26, 2010 as evidence that applicant's marks are used in conjunction with products to show a product was tested and *meets a certification standard*" (emphasis added).

14. According to Applicant's current website at <http://www.ecosafetextile.com/en/>, in order for a manufacturer's products to be considered eligible to display the ECO-SAFE mark, the products must be compliant with requirements regarding "chemical safety" and "physical-mechanical safety". See Ex. A.

15. According to Applicant's current website at <http://www.ecosafetextile.com/en/>, when consumers see and recognize Applicant's applied-for mark, consumers will understand the presence of the mark to mean that the products to which the mark is affixed are, in fact, compliant with the Applicant's requirements regarding "chemical safety" and "physical-mechanical safety". See Ex. A. Specifically:

- (a) "The commitment undertaken by the company in attaching the eco safe mark to its products is to guarantee that the articles of clothing intended for children are monitored in order to prevent the harmful effects that may be connected with the presence of these substances [cancerogenous and allergenic colorants]";
- (b) "With reference to phthalates, the eco safe mark defines certain limitations on all articles of clothing intended for children";
- (c) "The eco safe mark defines certain specific requirements in relation to the presence of formaldehyde in textiles and leather";

- (d) “The heavy metals included in the requirement shall not exceed the acceptability levels of the eco safe mark, defined as concentration or migration maximum values”;
- (e) That the product does not have hazardous drawstrings or small parts. *See generally* Ex. A.

16. Applicant’s website at <http://www.ecosafetextile.com/en/> shows that Applicant is using the applied-for mark as a certification mark, and not as a trademark for the products in Classes 22, 23, 24, 25 and 27, and not as a service mark to designate the source of services in Class 42 related to “[t]esting, analysis and evaluation of...textile products of others and toys of others[.]”

17. Insofar as Applicant has declared that it has a *bona fide* intention to use the “ECO-SAFE & Leaf Design” mark as a trademark in connection with the goods in Classes 22, 23, 24, 25 and 27 in commerce in connection with the sale or offering of such products, but in reality intends to use and is in fact using the applied for mark as a certification mark, said *bona fide* intention is, as a matter of law, inconsistent with the anti-use by owner rule for certification marks under 15 U.S.C. §1054, and Applicant’s Serial No. 77/960,950 is therefore *void ab initio*.

18. Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a service mark in connection with the testing, analysis and evaluation of the goods and services of others for the purposes of certification, but, in reality, intends to and is, in fact, using the applied-for mark as a certification mark, said *bona fide* intention, is as a matter of law, inconsistent with the anti-use by owner for certification marks under 15 U.S.C. Section 1054, and Applicant’s Serial No. 77/960,950 is therefore *void ab initio*.

Application is void for a lack of bona fide intent to use the mark for the stated goods and services

19. Opposer hereby incorporates Paragraphs 1- 18 as full set forth herein.

20. Upon information and belief, based upon a review of Applicant's website, particularly the excerpts attached herewith as Exhibit A, Applicant is a certifying entity, and is an entity that has never manufactured products nor licensed its marks for use as trademarks or service marks, but rather as certification marks, and has never manufactured, either directly or indirectly, the various goods stated in Classes 22, 23, 24, 25 and 27. Nor has it provided or offered "testing, analysis and evaluation of the goods and services of others for **purpose** of certification," other than for purposes of permitting use of its **own** certification marks, rather than the certification marks of other certifying agencies.

21. Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a trademark for the goods identified in Classes 22, 23, 24, 25 and 27, and as a service mark for the services in Class 42, upon information and belief, Applicant had no such *bona fide* intention at the time it filed the application, and continues to have no such *bona fide* intention to use the mark as a trademark for the goods identified in Classes 22, 23, 24, 25 and 27 and services in Class 42.

22. Because Applicant lacks a *bona fide* intent to use the mark as a trademark and service mark, and never had such *bona fide* intent, the application should be declared void.

Fraud

23. Opposer hereby incorporates Paragraphs 1- 22 as fully set forth herein.

24. Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a trademark and as a service mark, but in reality, is using, and had every intention of using, the

mark as a certification mark, Applicant has fraudulently misrepresented and falsely represented to the United States Patent and Trademark Office its true *bona fide* intention with regard to the use of the mark in commerce with the United States, and the application should be refused by reason of Applicant's fraud, misrepresentation, and false representation before the U.S.P.T.O., upon which the Examining Attorney relied.

25. Upon information and belief, based upon Applicant's advertising and marketing of the applied-for mark on Applicant's website (*See* Ex. A), Applicant had knowledge of its fraudulent misrepresentation set forth in Paragraphs 20-24 herein, and had an affirmative intent to deceive the U.S. Patent and Trademark Office by seeking a trademark for the goods specified in Classes 22, 23, 24, 25 and 27, as well as a service mark in Class 42 for the "testing, analysis and evaluation of the goods and services of others for the purpose of certification," when in reality, Applicant's true *bona fide* intention was and is to use the mark as a certification mark.

26. On information and belief, Applicant's declared *bona fide* intent to use the mark as a trademark for the goods identified in Class 22, 23, 24, 25 and 27 is a fraudulent and false representation made to the U.S. Patent and Trademark Office, since Applicant's website shows that Applicant is not in the position of manufacturing the various products listed in Classes 22, 23, 24, 25, and 27. Nor does Applicant's website show that Applicant is in the position to grant licenses under the mark to third parties for the use of the mark as a trademark, in contrast to use as a certification mark, in connection with the products listed in Classes 22, 23, 24, 25 and 27. Under the circumstances, Applicant lacks the necessary *bona fide* intent to use the mark as a trademark in connection with the listed products in Classes 22, 23, 24, 25 and 27.

27. On information and belief, Applicant's declared *bona fide* intent to use the mark as a service mark for the services stated in Class 42, is a fraudulent and false representation made

to the U.S. Patent and Trademark Office, since Applicant's website shows that while Applicant may provide testing, evaluation and analytical related services, it provides such services for the purpose of permitting use of its own certification mark by the third party, not the certification mark of an unrelated certifying agency. In other words, Applicant's web site shows that it is using the applied for mark as a certification mark, not as a service mark. Under the circumstances, Applicant lacks the necessary *bona fide* intent to use the mark as a service mark, in contrast to a certification mark.

28. On information and belief, Applicant made its declaration of a *bona fide* intent to use the mark as a trade and service mark with full knowledge that it had no such intent, and said false declaration of *bona fide* intent was made with the intent to deceive the U.S. Patent and Trademark Office in an effort to fraudulently obtain a trademark and a service mark to which it is not otherwise entitled. The U.S. Patent and Trademark Office relied upon such a fraudulent representation when it cleared and passed the mark on to publication.

29. By reason of Applicant's fraud, the application should be refused, and the opposition sustained.

30. In the alternative or in tandem with the foregoing, the opposition should be sustained by reason of the likelihood of confusion and potential for reverse confusion with Opposer's previously used marks, and/or otherwise declared void by reason of Applicant's violation of the anti-use by owner rule with respect to certification marks, and/or by reason of Applicant's lack of *bona fide* intent to use the mark truly as a trade and/or service mark.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant be refused and the Notice of Opposition be sustained.

The \$1,800.00 government fee (International Classes 22, 23, 24, 25, 27 and 42) was previously submitted with the initial filing of the opposition. Please charge any deficiency or credit any overpayment to Deposit Account No. 04-1061.

Please recognize Barth X. deRosa, Steven D. Lustig and Melissa Alcantara, all members of a Bar, and the firm of Dickinson Wright PLLC, 1875 Eye Street, N.W., Suite 1200, Washington, D.C. 20006, as attorneys for Opposer.

Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST
d/b/a ECO-SAFE OF DALLAS

Dated: October 29, 2012

/Melissa Alcantara for Barth X. deRosa/

Barth X. deRosa
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Fax (202) 659-1559
Counsel for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the Second Amended Notice of Opposition has been served upon Applicant this 29th day of October 2012, via first class mail, postage prepaid, as identified below:

Mark Lebow
Young & Thompson
209 Madison Street
Suite 500
Alexandria, VA 22314-1764

/Melissa Alcantara/

Melissa Alcantara

Exhibit A



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SAFE TOYS FOR THE BENEFIT OF CHILDREN

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IISG



IISG – Italian Institute for Toy Safety – founded in 1978, is a leading company in the field of toys safety and certification for childhood products.

Since it's birth the Institute has anticipated and promoted the evolution of the safety Standards and the quality in toys productive area and not only. The Institute mission is, indeed, to control and certify the safety and whatever belongs to the kid's world: from toys, to playgrounds, from childcare articles to kid's apparels and furniture, the Institute ensures safety.

The multi-year expertise developed in the area of products safety led the Institute to be officially recognized by the Italian Ministero delle Attività Produttive (number 0376), as a Notified Body to the European Commission. The Institute takes constantly part in behalf of UNI (Italian National Standards Body) to different Technical Commissions and to several Working groups of CEN (European Committee for Standardization).

The Institute is always updated about Standards development and improvement and it has frequently connections and interactions with the staff of other European Notified Bodies.

A team of technicians, engineers and chemists has been working for several years at the Institute, studying and analysing the different types of toys and infant products that are being launched in the market.

A team of psychologists contributes to enhance safety of the products by evaluating the ways of interaction of children with specific toys at different phases of their development (age grading of toys and ad hoc researches on specific toys and on the abilities that children need to be able to play with them).

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Marks

HOW ICQ-IISG GRANTS SAFETY AND QUALITY

The safety of products is an indispensable requirement and a primary duty that every successful company has with consumers. A product cannot be classified as of a good quality if safety hasn't been previously guaranteed.

The Institute grants manufacturers the right to use its marks on their products upon the successful certification of products' samples, the inspections during the production and signing jointly the appropriate agreement according to codified procedures.

The manufacturer or the importer that decides to tag on its products IISG-ICQ mark, commits to submit its products to deepen analysis that are listed in the mark regulation. The regulation includes that goods have to go through inspections during the production and constant supervision on the market carried out by ICQ-IISG. ICQ-IISG marks increase product's value and make immediately visible to consumer energy spent for product safety.

- [SAFE TOYS](#)
- [CHECKED SAFETY](#)
- [ECO SAFE](#)
- [CHECKED SAFETY PETS](#)

THE SAFE TOYS MARK



A toy cannot be classified as of a good quality if safety hasn't been previously guaranteed. When consumers are children to give a safety and quality guarantee allow us to comply with a fundamental ethical principle and it's an important instrument to be competitive inside a market more and more careful and sensitized.

WHAT DOES ICQ DO BEFORE GRANTING THE SAFE TOYS MARK

1. AGE GRADING EVALUATION OF THE TOY

At ICQ-IISG the proper age grading is determined by an experienced psychologist who establishes the playing age of the toy according to cognitive and motor abilities possessed by the children during their development. The recommended age of a toy is an essential element to guarantee the safety of the product, and it is important that parents are aware of its importance on the packaging.

2. RISK ASSESSMENT

Toys under development are studied in technical sessions by an ICQ-IISG team of experts with diversified skill sets to appraise possible risks connected with their use and abuse. Based on these evaluations the team establishes specific tests necessary for the certification and the granting of the mark SAFE TOYS.

3. PHYSICAL AND MECHANICAL TESTS

The ICQ-IISG laboratory technicians check for the presence of any sharp edges or sharp points in the toy structure, the possibility of detaching parts that can provoke traumas or could cause choking hazards. Toys intended to bear the weight of a child (for example electrical or mechanical vehicles), must pass the crash test of the structure launched against an obstacle. Teddy bears are put through hard tests of torsion, tension, simulated bites, in order to withstand the accidental removal of small parts.

4. CHEMICAL ANALYSIS, HYGIENE AND RADIOACTIVITY

A chemical analysis is carried out on toys and all the other articles related to children. The objective is to check raw materials, varnishes, adhesives and more to verify they are not hazardous and they conform to all safety requirements related to heavy metals and toxic substances.

5. ELECTRICAL TESTS

At our labs we test electromagnetic compatibility and radio frequencies. Special tests are performed to evaluate the overheating of toy parts which could be in contact with the child. Special tests are carried out for electrical toys operating in contact with water such as bath toys.

6. FLAMMABILITY TESTS

Soft toys and other toys made of textile or cushioned material are submitted to flammability tests. We analyze the ignition and the fire reaction of the materials with our special equipment. To successfully pass the test, the speed of flame spreading on the toy must be inferior to an industry established safety threshold.

7. PRODUCTION INSPECTIONS

Certifying a product with our SAFE TOYS mark doesn't end with laboratory tests. We also follow the product through the production and inspection phases with sampling procedures. This allows us to ensure that the toys conform to safety requirements established by law and quality standards required by the purchaser.

8. GRANTING THE MARK SAFE TOYS"**THE CHECKED SAFETY MARK**

The CHECKED SAFETY mark guarantees that the tested products comply with all the safety requirements and with the General Product Safety Directive – GPSD, that is not all.

HOW TO GET THE CHECKED SAFETY MARK

The presence of the CHECKED SAFETY mark on a product highlights that:

- an appropriate internal commission has previously evaluated any possible risk linked to the use of the product either from children or adults (RAP – Risk Assessment Protocol);
- an eco-toxicological commission has preventative evaluated all the chemical and microbiological risks;
- appropriate inspections have been carried out in the productive poles in order to ensure global safety of the production.

THE ECO SAFE MARK

ECO SAFE is an ICQ project aimed especially at those companies that undertake to observe increasingly higher quality and safety standards.

The ECO SAFE mark constitutes a guarantee that the products have been designed in compliance with chemical and mechanical safety standards, especially as regards articles intended for children.

HOW TO GET THE ECO SAFE MARK

The goal of ECO SAFE is to provide products with added value.

The ECO SAFE project brings together commercial development and tangible safety and sustainability results.

ECO SAFE requires a growing commitment, in terms of time and resources, by those companies that choose to become increasingly socially responsible.

The ECO SAFE mark is a distinctive feature highlighting the efforts made by companies to develop products that meet the needs of their consumers.

The long-term commitment of ECO SAFE is to offer consumers increasingly safe quality products. It is a commitment to future generations.

For further information about ECO SAFE mark please visit the website <http://www.ecosafetextile.com/en/>

**THE CHECKED SAFETY PETS MARK**

The CHECKED SAFETY PETS mark has been created to meet the need to provide safe products to our pets. The presence of the mark on a product guarantees that it complies with the safety requirements and with the General Product Safety Directive – GPSD, that is not all.

HOW TO GET THE CHECKED SAFETY PETS MARK

The presence of the CHECKED SAFETY PETS mark on a product highlights that:

- an appropriate internal commission has previously evaluated any possible risk linked to the use of the product (RAP – Risk Assessment Protocol);
- an eco-toxicological commission has preventative evaluated all the chemical and microbiological risks;
- appropriate inspections have been carried out in the productive poles in order to ensure global safety of the production.

As for other marks of ICQ-IISG, the Institute grants manufacturers the right to use the CHECKED SAFETY PETS mark on their products upon the successful certification of products' samples, the inspections during the production and signing jointly the appropriate agreement according to codified procedures.

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eco safe COMMITMENT TO SAFETY AND QUALITY

The eco safe mark	The requirements of eco safe	<p>The requirements of eco safe</p> <p>In order to be considered eligible to display the eco safe mark, products must be compliant with requirement regarding:</p> <p>CHEMICAL SAFETY</p> <ul style="list-style-type: none"> • carcinogenic dyes • allergenic dyes • phthalates • formaldehyde • heavy metals <p>PHYSICAL-MECHANICAL SAFETY</p> <ul style="list-style-type: none"> • small parts that can be swallowed • hazardous cords or drawstrings <p>DISCOVER MORE ></p>	<p>LOVE THE ECO SAFE</p>	Recognise the eco safe mark	The commitment of eco safe
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<p>Select an ICQ location in the world <input type="text"/></p>	ICQ in the World	<p>The ICQ Group was founded over thirty years ago, and is today one of the most respected quality and safety certification bodies worldwide.</p> <p>Expertise, advanced technology and a team of highly qualified technicians and collaborators enable ICQ to verify, through a wide range of tests and analyses, the compliance of numerous product categories.</p> <p>[read more]</p>	ICQ Global
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eco safe COMMITMENT TO SAFETY AND QUALITY

The **eco safe** mark

The clothes we put on our children must be **safe**.

One of the greatest risks is posed by the presence of small parts, normally decorative trims, which, if not firmly attached to the garment, could be removed by children and accidentally swallowed.

Another fundamental aspect relates to **preventing** the risk of strangulation by drawstrings, in particular in the vicinity of the head and neck. If present, drawstrings must be very short in order not to risk getting tangled with other objects with which the child interacts.

Perhaps less obvious, but no less important, is the **chemical assessment** of children's clothing. This is because chemicals can be absorbed by the body in a variety of ways.



SEE ALSO

[RECOGNISE THE **eco safe** MARK](#)
[THE REQUIREMENTS OF **eco safe**](#)
[THE COMMITMENT OF **eco safe**](#)
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The **eco safe** mark

Remember

- ☞ danger of choking: **NO to small parts**
- ☞ danger of strangulation: **NO to hazardous chords and drawstrings**
- ☞ possible adverse health effects, carcinogenic or otherwise: **NO to certain carcinogenic dyes and certain heavy metals**
- ☞ possible allergic reactions in case of contact with the skin: **NO to certain carcinogenic dyes, certain phthalates, formaldehyde and certain heavy metals**
- ☞ possible sensitising effects: **NO to certain allergenic dyes**
- ☞ possible dermatitis: **NO to certain allergenic dyes**
- ☞ possible itching: **NO to certain allergenic dyes**
- ☞ possible reddening of the skin: **NO to certain allergenic dyes**

- possible irritation of the skin: ***NO to certain heavy metals and formaldehyde***
- possible harmful effects on the reproductive system: ***NO to certain phthalates***
- possible liver and kidney damage: ***NO to certain phthalates***
- possible damage to the central nervous system: ***NO to certain heavy metals***

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eco safe COMMITMENT TO SAFETY AND QUALITY

The requirements of **eco safe**

Carcinogenic dyes are still used by many manufacturers due to their being cheap, despite the fact that European laws prohibit their use. These dyes can cause a variety of adverse health effects, carcinogenic or otherwise, as well as allergic reactions when brought into contact with the skin.

Allergenic dyes have considerable sensitising potential.

Their use in products intended to come into contact with the skin must be avoided in order to safeguard children against the onset of allergic conditions such as, for example, dermatitis, itching and redness.

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The requirements of **eco safe**

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Their use in products intended to come into contact with the skin must be avoided in order to safeguard children against the onset of allergic conditions such as, for example, dermatitis, itching and redness.

Colorants are one of the most important groups of substances used in the clothing industry.

On account of their properties the molecules of some colorants can be absorbed by the skin.

In this case the presence of cancerogenous and allergenic colorants may be harmful to the health of the consumer.

Since the colorants are used on articles of clothing intended for prolonged contact with the skin, the release of the eco safe mark is subject to analysis of certain cancerogenous and allergenic colorants in order to limit the exposure of consumers to these substances and consequently also the risks connected with their properties.

The test method used to examine colorants is based on extraction of the colorants (from the material or leather) with a solvent.

This analysis is aimed at extracting all the colorants present from the sample analyzed.

On obtaining the extract the laboratory determines the presence of the colorants in question using chromatographic analysis.

The analysis has the purpose of determining the presence of certain colorants in order to ascertain whether they are present in quantities below the levels allowed for release of the eco safe mark.

Phthalates are organic chemicals produced from petroleum and are among the most common plasticisers in the world.

Their purpose is to soften plastics. In clothing, they are generally used to produce T-shirt prints and other soft plastic elements. Many phthalates are classified as toxic to reproduction and in some cases are suspected of being responsible for adverse health effects, such as allergies and liver and kidney damage.

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Phthalates are a group of substances used in the textile industry mainly for the production of soft plastic articles prints and coatings.

The presence in toys and articles used in early childhood care of certain phthalates has been limited by an EU directive for a long time.

The reasoning behind the EU decision to introduce this limitation is connected with the toxicity of some phthalates and the fact that children, especially the very young, have the habit of putting objects that they find in their mouths.

This behavior makes them particularly exposed to the introduction of these substances into their bodies if they are present in the products intended for them.

Since small children have this habit with all the objects surrounding them, and since even older children may be exposed to these substances through contact with the skin and the mouth, clothing may also represent a source of exposure to these substances.

Therefore, to obtain the eco safe mark, the presence of certain phthalates probably contained in the materials of all articles of clothing intended for children is determined.

The test method used involves extraction of the substances present in the sample of soft plastic parts or coatings.

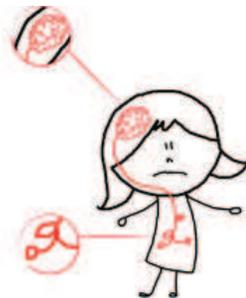
The sample thus obtained is then analyzed by gas chromatography.

The purpose of the analysis is to ascertain the presence of one or more of the phthalates selected in order to determine whether the quantity present is below the level allowed for use of the eco safe mark.

 **Heavy metals** include lead, often used for buttons and plastic elements, nickel, used for the metal finish of belt buckles and so on, and chromium, often found in leather, as well as cadmium, mercury, arsenic and other metals present as residues of the industrial processes undergone by clothing.

Heavy metals can have diverse adverse health effects, depending on the type of metal, and can be carcinogenic, can affect the central nervous system, can be sensitising, or can cause irritation of the skin. Many metals are also potentially dangerous for the environment.

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Heavy metals may be present in articles of clothing as the residues of production processes (coloring for example).

These elements may cause numerous effects harmful to the consumers' health (from allergic reactions to cancerogenous effects) and the environment.

Consumers, and especially children, may be exposed to the metals contained in articles of clothing both orally (putting products in their mouths) or by skin contact (during normal use of clothing).

Given the highly toxic properties of certain metals and their possible presence due to numerous sources of contamination, release of the eco safe mark is subject to the observance of certain concentration limits

of these metals. Concentrations are determined, depending on the case, as total content or as an extraction.

Determination of the total content is connected with an evaluation that also takes into account implications for the disposal of the finished product and therefore its impact on the environment.

The test methods used for determining the content of heavy metals are of two types:

- methods for determining the total content of heavy metals
- methods for determining the release of heavy metals from the materials tested

In the first case the method requires the dissolution of the sample in order to determine the total content of heavy metals in the part tested.

In the second case, the method requires the extraction of the sample using a solution that simulates the effect of sweat and successive analysis of the solution obtained.

In this way the method determines the concentration of heavy metals which can be extracted from the material in question during the foreseeable use of the product by the consumer.



 **Formaldehyde** is a volatile organic compound mainly used for the production of resins, and is sometimes used in the textile industry to make fabrics crease resistant. Being a powerful bactericide, formaldehyde is also used to treat fabrics for conservation purposes. Formaldehyde can cause irritation of the skin and allergic reactions, and is suspected of being carcinogenic.

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Formaldehyde is a substance used in articles of clothing to prevent shrinking and creasing.

This substance, when present in articles of clothing, may cause contact allergic reactions.

Given its properties, this substance has been included among the parameters to examine in order to obtain the eco safe mark with limits that vary depending on the type of product.

The test method involves extraction in water (of the free and partially free formaldehyde), treatment of the extract and analysis of the solution obtained using colorimetric analysis.

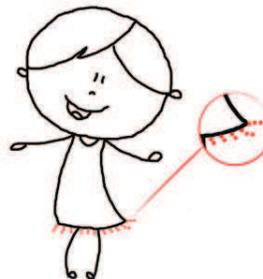
The purpose of the analysis is to determine the quantity of extractable formaldehyde in the materials tested.

 Particular attention is also paid to **small parts** such as sequins.

In order to simulate the force that the child may exercise with teeth and fingers children's clothing are tested to verify the force needed to separate small parts from clothing.

When small parts are not graspable the clothing articles are washed in a special equipment and after the test, the small parts should remain not graspable.

The scope of the verification is to assure small parts are not accessible to the children.



 Attention to **hazardous drawstrings**. The release of eco safe mark is dependent upon the verification of children's clothing with the scope to verify that the items have the correct design and construction. The scope of the verification is to underline the conformity for the use of the eco safe mark.

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eco safe COMMITMENT TO SAFETY AND QUALITY

Recognise the eco safe mark

How can I recognise the eco safe mark?

The following guidelines will help you determine whether the **eco safe** mark on the product you wish to purchase is authentic.

The picture below represents the exact logo:



The basic rules for recognising the logo

-  The corporate colours are: Blue, Light Blue, Grey, Green.
-  The **eco safe** mark is only available in two versions, one in the original colours and the other in a single hue.
-  The logo is always surrounded by an exclusion zone.

The corporate colours

Blue

Light Blue

Grey

White

Leaf

The leaf is depicted in two shades of green, one lighter and the other darker.

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Recognise the **eco safe** mark



Use of the Coloured Logo



Use of the One-Colour Logo

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eco safe COMMITMENT TO SAFETY AND QUALITY

The commitment of **eco safe** mark

The parameters necessary to obtain the mark have been selected considering some of the requirements that may affect consumers negatively and especially children.

Parameters include some substances subject to legislative regulation and others which, although not subject to limits specifically stated in the EU, are nevertheless substances which can be found in textiles a harmful to health.



An example of these substances are the **cancerogenous and allergenic colorants** which are a subject of interest for the part of national authorities, but which are not currently subject to EU legislation which limits their use in clothing products. The commitment undertaken by the company in attaching the **eco safe** mark to its products is

to guarantee that the articles of clothing intended for children are monitored in order to prevent the harmful effects that may be connected with the presence of these substances.

With reference to **phthalates**, the **eco safe** mark defines certain limitations on all articles of clothing intended for children. Specific phthalates are in fact banned, at EU level, but only in childcare articles and toys. With the **eco safe** mark the company undertakes testing to determine the presence of dangerous phthalates in all clothing products (containing plastic coated parts) intended for children and to ascertain a greater number of substances compared to those explicitly prohibited in toys and articles for early childhood care.



Formaldehyde is a substance that has been under consideration for some time due to the harmful effects it may cause when present in articles of clothing, especially those intended for small children and which come into contact with the skin. However, there is no EU legislation as yet which explicitly limits the presence of this substance in articles of clothing. Some states of the EU have national legislations that limit the presence of this substance. The **eco safe** mark defines certain specific requirements in relation to the presence of formaldehyde in textiles and leather.

ICQ has included certain **heavy metals** among the requirements of the **eco safe** mark. The **eco safe** mark sets limitations to both heavy metals subject to EU Community legislation and heavy metals for which the European Commission has not set specific limits. The heavy metals included in the requirement shall not exceed the acceptability levels of the **eco safe** mark, defined as concentration or migration maximum values.



SEE ALSO

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The commitment of **eco safe**



Children's clothing may contain cords or drawstring which may have functional or decorative purposes. In children's clothing **cords and drawstring** may be of potential hazard and, if not constructed following specific details, may cause serious injury.

Children's clothing may present **small parts** such as buttons, sliders, rivets and eyelets. These small parts present a potential hazard if they are not well fixed to the garment.



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Exhibit B

To: Istituto Italiano Sicurezza dei Giocatto ETC. (trademarks@young-thompson.com)

Subject: U.S. TRADEMARK APPLICATION NO. 77960950 - ECO SAFE - 2564-1198

Sent: 6/26/2010 3:46:37 PM

Sent As: ECOM104@USPTO.GOV

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

APPLICATION SERIAL NO. 77960950

MARK: ECO SAFE

77960950

CORRESPONDENT ADDRESS:

MARK LEBOW
YOUNG & THOMPSON
209 MADISON ST STE 500
ALEXANDRIA, VA 22314-1764

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Istituto Italiano Sicurezza dei
Giocatto ETC.

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

2564-1198

CORRESPONDENT E-MAIL ADDRESS:

trademarks@young-thompson.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/26/2010

The referenced application and voluntary amendment filed 06/18/2010 have been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

THIS REFUSAL APPLIES TO CLASS 42 ONLY

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 1303116, 1631876, 1749733, 2318583, 2908981, 2939501, 2792233, 2744511, 3662966, 2953820, 3084982, 3073320, 2695700, and 3403660. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

COMPARISON OF THE MARKS

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). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The applicant's proposed mark consists of the wording ECO SAFE and a design. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii). Accordingly, the wording ECO SAFE stands out as the most dominant feature of applicant's proposed mark.

The registrant's mark in U.S. Registration No. 1303116 is the wording ECO-SAFE, and this same

registrant's mark in U.S. Registration No. 1631876 is the wording ECO-SAFE and a design and the mark in U.S. Registration No. 1749733 is the wording ECO-SAFE.

The registrant's mark in U.S. Registration No. 2318583 is the wording ECOSAFE.

The registrant's mark in U.S. Registration No. 2908981 is the wording ECOSAFE.

The registrant's mark in U.S. Registration No. 2939501 is the wording ECO SAFE and a design.

The registrant's mark in U.S. Registration No. 2792233 is the wording ECO SAFE.

The registrant's mark in U.S. Registration No. 2744511 is the wording ECOSAFE.

The registrant's mark in U.S. Registration No. 3662966 is the wording ECOSAFE PREMIUM FOAM with the wording PREMIUM FOAM disclaimed as descriptive.

The registrant's marks in U.S. Registration No. 2953820 is the wording ECOSAFE BIOGRADABLE PLASTIC with the wording BIODEGRADABLE PLASTIC disclaimed as descriptive and this same registrant's mark in U.S. Registration No. 3084982 is the identical wording and a design feature and the mark in U.S. Registration No. 3073320 is the wording ECOSAFE.

Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

The registrant's mark in U.S. Registration No. 2695700 is the wording ECOSAFE.

The registrant's mark in U.S. Registration No. 3403660 is the wording ECOSAFE and a design.

The dominant portion of applicant's proposed mark, the wording ECO SAFE is identical or nearly identical to the dominant portion of each of the marks in the cited registrations.

COMPARISON OF THE GOODS/SERVICES

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In this case, among other goods, the applicant intends to use its proposed mark in conjunction with "Testing, analysis and evaluation of the goods and services of others for the purpose of certification." Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62

USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1637-38 (TTAB 2009); TMEP §1207.01(a)(iii).

The registrant in U.S. Registration Nos. 1303116, 1631876 and 1749733 is using its marks in conjunction with “pest control services” and other goods and services used in conjunction with pest control services such as janitorial services, insecticides, pest control traps and shirts and cloth patches presumably used by service personnel.

The registrant in U.S. Registration No. 2318583 is using its mark in conjunction with a full line of hydraulic fluids for mobile equipment and industrial applications.

The registrant in U.S. Registration No. 2908981 is using its mark in conjunction with chemical for use in environmental remediation and environmental remediation services.

The registrant in U.S. Registration No. 2939501 is using its mark in conjunction with dietary supplements.

The registrant in U.S. Registration No. 2792233 is using its mark in conjunction with electronically pasteurized fresh fruits and vegetables.

The registrant in U.S. Registration No. 2744511 is using its mark in conjunction with electrical cables.

The registrant in U.S. Registration No. 3662966 is using its mark in conjunction with building insulation.

The registrant in U.S. Registration Nos. 2953820, 3084982 and 3073320 is using its marks in conjunction with disposable plastic tableware, table mats, cloths, napkins and coasters and other disposable plastic goods.

The registrant in U.S. Registration No. 2695700 is using its mark in conjunction with vehicle paints, primers and undercoatings.

In this case, applicant’s services are identified broadly. Therefore, it is presumed that the application encompasses all services of the type described, including testing of those goods and services identified in each of the registrant’s more specific identification. Please see the attached excerpt retrieved from the Internet on June 26, 2010 as evidence that applicant’s marks are used in conjunction with products to show a product was tested and meets a certification standard.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, 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); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

APPLICANT MAY RESPOND

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by



I NOSTRI BRAND



Ita - **Eng**

➤ TOTAL QUALITY

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Safe toys

Product safety is of critical importance to the Group and ensuring our products meet Community Directive standard requirements for toy safety remains one of our key objectives.

The main consumers of our products are young boys and girls, who of course qualify for particular care and protection. For this reason, comprehensive checks are performed at every stage of production to ensure optimal safety standards for the end product.

To reinforce our reputation, Grani & Partners commits €350,000 annually to carry out all necessary safety tests and rigorously controlling all processes throughout each production phase.

Not satisfied with maintaining Community standards, Grani & Partners also:

- obtains the certification "CE" for all products;
- ensures all products are accorded the "Giocattoli Sicuri" ("Safe Toys") mark by the Italian Institute for Toy Safety

CE certification offers additional value to a product, having required it to have passed a further range of safety tests conducted throughout the planning and production phases in order to ensure fully comprehensive controls.

Grani & Partners has a contract in place with the Italian Institute for Toy Safety whereby the Institute is committed to providing ongoing technical support and to carry out rigorous safety tests of all items during each phase of the production process. Accredited by the European Commission, the Institute ascertains whether a toy meets the requirements of directive 88/378/EEC which reconciles member states' laws for toy safety.



page-abstract:
Toys safety certification and Istituto Italiano Sicurezza Giocattoli's partnership assure the attention for Grani&partners' gadgets and toys' quality and safety.

requirements of directive 88/378/EC which reconciles member states' laws for toy safety.

Having passed the analyses and inspections carried out by the Institute, the product is certified with the mark "Giocattoli Sicuri" ("Safe Toys"), leaving our customers confident that Grani & Partners remains committed to safety within what is a particularly demanding market.

>> For more information please visit the official website: Italian Institute for Toy Safety

[Iso certification >](#)

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Product catalogue



Consult technical sheets of Grani & Partners promotional products

Certifications



All Grani & Partners' products follow a wide range of safety rules

Giocchi Preziosi Group



Grani & Partners group is member of Giocchi Preziosi Group