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

Proceeding	91217033
Party	Plaintiff Kiko S.p.A.
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KIKO S.p.A.,	:	
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Opposer,	:	
	:	
v.	:	Opposition No. 91217033
	:	
DOOYEON CORP.,	:	
	:	
Applicant.	:	
_____	X	

**REPLY TRIAL BRIEF FOR OPPOSER
KIKO S.p.A.**

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I. Introduction

Applicant, Dooyeon Corp. (“Applicant” or “Dooyeon”), owner of the pending KICHO and Design Application that is the subject of the present Opposition No. 91217033, submitted its Trial Brief on 9 May 2016. In addition to its arguments refuting a Likelihood of Confusion, Applicant set forth certain legal and factual arguments that are both inconsistent with and/or contradictory to U.S. trademark law and the procedural rules of the United States Patent and Trademark Office’s Trademark Trial and Appeal Board (“TTAB”).

In its Reply, Opposer Kiko, S.p.A. (“Opposer” or “Kiko”), herein raises a limited number of narrowly focused issues that are both highly relevant to the TTAB’s ultimate decision of this Opposition and in direct response to issues raised in Applicant’s Trial Brief.

II. Legal Argument

A. Applicant’s References to a Korean Opposition Decision (or any Foreign Decision) is Irrelevant and Immaterial to the Present Dispute.

In support of its position Applicant relies upon a decision of the Patent and Trademark Office of South Korea where it purportedly prevailed against the Opposer. Applicant Brief at 7, 8, 18. This type of information has specifically been held in the past to be inappropriate evidence in a Board proceeding and is thus, irrelevant to a U.S. opposition proceeding. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991)(foreign decisions regarding trademark registrability have no effect in the United States and are not relevant to opposition proceedings). This argument applies equally to any other country (outside of the U.S.) wherein the Applicant contends either coexisting use or registration of the respective marks may exist. *See* Applicant Brief at 7, 8, 18.

Moreover, not only must the Korean decision be barred by the TTAB as irrelevant to a likelihood of confusion analysis (as there are certainly a myriad of practical and legal obstacles

for consideration), but the decisions themselves submitted by the Applicant in its Notice of Reliance are in Korean, and likewise impermissibly relied upon by the Applicant. TBMP 104, 37 CFR § 2.191 (“Board proceedings are conducted in English. If a party intends to rely upon any documents that are in a language other than English, the party should also submit a certified translation of the documents. If a translation is not submitted, the documents may not be considered”). Thus, neither the document in its present form nor the content is relevant in the present proceeding and must be given no consideration. Essentially, unless Applicant relies upon a decision from a U.S. tribunal that has been appropriately submitted into the Record, all other determinations as to registrability are moot and must be ignored.

B. Applicant Inappropriately Attempts to Re-Characterize The Parties Goods.

In any likelihood of confusion analysis, the goods at issue must be compared based on what exists in the Applicant’s application and in the Opposer’s registration. That is, the “nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration”. TMEP 1207.01(a)(iii); *see also Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

Applicant’s goods (as filed and of record) are listed as “*Eyebrow pencils; Lip liner; Mascara; Make-up foundations; Hair colorants; Cosmetic preparations for bath and shower; Body lotions; Bath lotion; Shower gels; Skin lotions; Eyeliner; Eye cream; Face and body lotions; Perfumes; Hair gel; Hair spray; Make-up powder; Make-up removing lotions*”. See Application Serial No. 86/053,930, currently of Record. Nothing therein restricts the goods by price, sophistication of intended customers, channels of trade or intended type of customer. Accordingly, where there is no limitation/restriction in the description “as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration [or application]

encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers.” See, e.g., *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) (applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence, for example, as to the quality or price of the goods).

Despite these clear prohibitions, Applicant attempts to mischaracterize (or recharacterize) the nature of the respective goods and channels of trade of the parties by inserting limitations as to differing market place conditions, characterizing Applicant’s goods as high-end Korean goods while the Opposer’s goods are described as moderately-priced Italian made products. Applicant Brief at 17-18. Whether or not any of this characterization is true is of little consequence, as absent a clear limitation appearing in both Applicant’s and Opposer’s goods descriptions (which there are not), all goods are presumed to flow in all channels of trade, be offered to all types of consumers and encompass all price points. Applicant’s arguments are thus both irrelevant and immaterial to the TTAB’s likelihood of confusion determination and must be ignored.

C. Applicant Relies Upon Obscure Legal Authority to Support the Requirement of Interchangeability when Comparing Pronunciation.

Applicant disputes that consumers may pronounce the “CH” appearing in KICHO as a “K” sound and argues that the legal authority supplied by Opposer is inapplicable on account of the letters “CH” and “K” not being interchangeable generally. While Opposer is unaware of such principal of interchangeability, Opposer notes that the decision relied upon by the Applicant for this theory is a 2002 non-precedential opinion, a theory not found in either the 2002 precedential and 2012 Federal Circuit decisions relied upon by Opposer. See *In Re Zolo Technologies, Inc.*, 2002 WL 1844232 (TTAB 2002). In the *Zolo* case, the applicant had appealed the decision of

the Examining Attorney rejecting an application under Section 2(d), ultimately finding marks ZOLO and SOLO unlikely to cause confusion.

Notably different in the foregoing case (which itself fails to cite any TTAB or Federal Circuit precedent for Applicant's interchangeability argument) is that the phonetic equivalents disputed were the first letter in the two marks and not the last two/three, as are at issue here. *See id.* at 8 ("As applicant points out, when these letters are substituted for each other at the beginnings of ordinary words, it is clear that they are not interchangeable.") (emphasis added). This is important, as it is a hallmark of trademark likelihood of confusion analysis that the first portion of a mark can be dominant and of greater relevance for likelihood of confusion purposes, as consumers are generally more inclined to focus on the first word, prefix or syllable in a trademark. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Here, the marks both share the "KI" beginning portion of the word. Thus, following the Applicant's logic, this interchangeability requirement is far more relevant when addressing the first letters of the disputed marks.

At the end of the day "there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner." *In re Vittera, Inc.*, 671 F.3d 1358, 1367, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012). Because consumers are entitled to pronounce trademarks however they wish, so long as the pronunciation is a reasonable construction of the wording, Opposer contends confusion is likely on account of the potentially similar phonetic pronunciation of the respective marks.

III. Conclusion

Opposer reaffirms that based on the factual and legal arguments both set forth in its Trial Brief and the present Reply Brief, it has adequately demonstrated priority and a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and that it would be

damaged by the registration of Applicant's mark. Accordingly, the Opposition should be sustained, and Applicant's application for registration of KICHO and design should be refused.

Dated: 23 May 2016

Respectfully submitted,

Kiko S.p.A.

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CERTIFICATE OF SERVICE

I hereby certify that on 23rd May 2016, the foregoing Reply Brief for Opposer is being served upon the attorney for Applicant via email and by mailing a true copy thereof by first class mail, postage prepaid, addressed to:

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