TTAB

In The United States Patent and Trademark Office
Before the Trademark Trial And Appeal Board

92044693

CONCORDE APPAREL, LLC	)
Petitioner,	)
v.	)
INTERNATIONAL MARK MANAGEMENT S.A.	)
Registrant,	)

PETITIONER'S REPLY BRIEF IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT

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INTRODUCTION

The motion for summary judgment filed by Petitioner Concorde Apparel, LLC should be granted because the Petitioner is entitled to judgment as a matter of law and there are no genuine issues of material fact. Registrant has not demonstrated any genuine issues of material fact to be tried which would bar the Board from granting Petitioner's motion.

Registrant's Brief in Opposition to Petitioner's Motion for Summary Judgment failed to provide any conflicting evidence on any material issue which would bar entry of judgment in favor of Petitioner. Instead, Registrant's answering brief offered mere conclusory statements. See FRCP §56(e) ("[A]n adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial.")

Registrant merely contends, without evidentiary support, that genuine issues of material fact exist with respect to certain Dupont factors, such as actual confusion proof and consumer sophistication which could allow Registrant to prevail, or at least survive summary judgment, herein. Yet in a case cited by Registrant, Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.2d 1373, 47 USPQ2d 1459 (Fed Cir. 1988), the Court of Appeals for the Federal Circuit affirmed the Board's holding that the appearance, sound, significance, and commercial impression were the dispositive DuPont factors when the parties' goods were identical or closely related. Here, the parties' goods are identical or

closely related and the similarities of the appearance, sound, significance, and commercial impression of the marks strongly support Petitioner's position. Registrant's opposition is without valid foundation, and summary judgment is appropriate because the record clearly demonstrates that Petitioner has priority and that there exists a likelihood of confusion between the parties' marks.

Argument

I. The Parties' Marks are Confusingly Similar

There is an absence of any genuine issue of material fact with respect to a finding that Registrant's mark is substantially similar to the mark of Petitioner's incontestable Registration No. 1,310,165 for "ZAGATO (Stylized)". The visual and aural appearances of the parties' marks are self-evident. Neither party contends that their marks are different than as presented on page 5 of the Registrant's brief.

Furthermore, the law clearly supports a finding of a likelihood of confusion. The additional elements to the Registrant's mark, namely, the letter Z in a stylized form and a rectangular border design, are insignificant differences, which do not serve to distinguish the mark either visually or aurally from Petitioner's mark. It is uniformly held that if the dominant portion of both marks is the same, then confusion is likely notwithstanding peripheral differences. See, e.g., In re Chatam International Inc., 380 F.3d 1340, 1343, 71 USPQ2d 1944 (Fed Cir. 2004).

Registrant cites several cases wherein additional modifying terms in the marks create different connotations e.g., ALL CLEAR compared with ALL, OLD TIME compared with YE OLDE TYME, CRISTAL compared with CRYSTAL CREEK or involve goods that are different, i.e., CROSS-OVER for bras compared with CROSSOVER for sportswear, PLAYER'S for underwear compared with PLAYERS for shoes. However, these cases are inapposite, as the Z and the border in Registrant's mark do not alter the meaning of the mark and the parties' goods are identical.

II. The Sophistication of the Consumers is Irrelevant

Registrant's argument that the purchasers of the parties' goods are sophisticated is irrelevant where the marks are virtually identical and the goods are identical or closely related. See In re Hester Industries, Inc., 231 USPQ 881 (TTAB 1986). "While we do not doubt that these [consumers] are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products." Id. at 883. Nonetheless, it should be noted that the Registrant's clothing items as described in the identification of goods are not specialized garments. Rather, the goods are conventional garments that are available in any mass-market outlet. Indeed, Registrant has offered no evidence that the consumers for its goods are in any way sophisticated. Without supporting evidence, the consumers of the Registrant's or Applicant's goods cannot in any way be deemed sophisticated purchasers.

III. The '587 Registration has No Probative Value

Registrant argues that the co-existence of its Registration No. 2,089,587 for the mark Z ZAGATO & Design (the "'587 Registration") with Petitioner's registration is probative of a lack of likelihood of confusion between the subject marks. However, the '587 Registration involves widely disparate goods from Petitioner's clothing goods. More specifically, the mark in the '587 Registration is used in connection with the custom design of automobiles for others and engineering services. Such services have absolutely no relationship to Petitioner's goods and the '587 Registration is of no relevance whatsoever.

IV. Petitioner will be Injured by the Continued Registration of Registrant's Mark

Finally, the Registrant contends that Petitioner will not be harmed by the continued registration of Registrant's mark because even if consumers were mistakenly lead to believe that there is an association between Petitioner and Respondent or that the goods of Respondent are in some manner associated with Petitioner, "it [would] certainly not injur[e] the public." Registrant's Brief, p. 9.

In fact, Registrant's continued use of a virtually identical mark in connection with identical or closely similar goods is likely *to injure both the public and Petitioner* by causing consumer confusion in violation of §2(d) of the Trademark Act. Section 2(d) is precisely designed to protect the rights of an owner of a registered trademark against injury due to a likelihood of consumer confusion with a similar mark used in connection with related goods, and the

public has the right to be free of source confusion in the marketplace. The injury to Petitioner is self evident given the likelihood of confusion between the marks and the Petitioner's incontestible registration.

CONCLUSION

Since the Registrant has not demonstrated genuine issues of material fact which would bar the Board from granting Petitioner's motion for summary judgment, this motion should be granted and the '903 Registration should be cancelled as a matter of law.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in a postage prepaid envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on May 15, 2006

Sender: Carol L. Wood

CERTIFICATE OF SERVICE

It is hereby certified that on May 15, 2006, a true copy of the foregoing PETITIONER'S REPLY BRIEF IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT, is being served by first-class mail, postage prepaid, to the attorney for Respondent at the following address:

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By: _____
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