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

Proceeding	78806669
Applicant	SL&E TRAINING STABLE, INC.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Application of: Edelman Shoe, Inc.	:
Serial No.: 78/806,669	:
Filed: February 3, 2006	:
Trademark: SAM EDELMAN	:
Law Office: 101	:
Attorney: George M. Lorenzo	:

REPLY BRIEF FOR APPELLANT

(FILED ELECTRONICALLY)

Hon. Commissioner:

Applicant Edelman Shoe, Inc. ("Applicant") submits this Reply Brief on Appeal pursuant to 37 C.F.R. § 2.142 from the Final Office Action dated March 10, 2007 finally refusing registration of the instant mark, SAM EDELMAN ("Applicant's Mark"), as applied to luggage, handbags, purses, wallets, all-purpose tote bags, all-purpose sports bags, and backpacks pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d) on the grounds that it is likely to be confused with Registration No. 3,000,104 for the mark EDELMAN for articles made from leather and imitations of leather, and not included in other classes, namely-- wallets, handbags, traveling bags, luggage trunks, umbrellas, harnesses and saddlery; animal skins and hides; tanned leather adapted for use in upholstering furniture, namely-- seating for use in airplanes, cars, and other vehicles; and building materials, namely leather floor tiles (the "Cited Mark").

Applicant maintains that confusion is not likely between its Mark and the Cited Mark since the Marks are different in sight, sound and commercial impression, Applicant's Mark is already recognized by consumers since it is the name of Applicant's principal, Sam Edelman, who is well regarded in the fashion industry, and consumers are sophisticated.

I. THERE IS NO LIKELIHOOD OF FORWARD CONFUSION

Although the Examining Attorney, in his Opposition Brief, argues that it is "well settled" that the addition of a first name to a surname is not sufficient to distinguish the marks, the only case cited in support of this position, *In re Chatam International Inc.*, 380 F.3d 1340 (Fed. Cir. 2004), involving the marks GASPAR'S ALE and JOSE GASPAR GOLD is clearly distinguishable. GASPAR is a much more unusual last name than EDELMAN, and, therefore, entitled to greater protection. More importantly, in *Chatam*, unlike the instant case, there was no evidence that the applicant's mark was well known to consumers.[1]

Indeed, in *Brennan's, Inc. v. Brennan's Rest., L.L.C.*, 360 F.3d 125, 133 (2d Cir. 2004), a case with striking similarities to the instant case, the Second Circuit affirmed the lower court's holding that there was no likelihood of confusion between plaintiff's mark, BRENNAN, and defendant's mark, TERRENCE BRENNAN, both as applied to restaurant services, finding "the addition of the first name 'Terrance' . . . meaningful" because defendant Terrance Brennan was already well known to consumers.

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[1] The Examining Attorney also ignored contrary case law on the issue cited by Applicant in its moving Brief, including the strong public policy to allow individuals to use their names. *See M. Fabrikant & Sons v. Fabrikant Fine Diamonds*, 17 F. Supp. 2d 249 (S.D.N.Y. 1998); *Paco Sport, Ltd. v. Paco Rabanne Parfums*, 86 F. Supp. 2d 305 at 316 *Ptak Bros. Jewelry, Inc. v. Ptak*, 83 U.S.P.Q.2d 1519 (S.D.N.Y. 2007).

In addition, as discussed in Applicant's moving Brief, consumer sophistication weighs in favor of finding no likelihood of confusion. *See Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.,* 2006 U.S. Dist. LEXIS 32844 (S.D.N.Y. May 22, 2006) (sophistication of consumers of handbags weighed against finding confusion likely); *Sara Lee Corp. v. American Leather Prods.*, 1998 U.S. Dist. LEXIS 11914 (N.D. Ill. July 27, 1998) ("purchasers of leather handbags are relatively sophisticated consumers").

II. THERE IS NO LIKELIHOOD OF REVERSE CONFUSION

Although the Examining Attorney continues to argue that registration was properly refused on the basis of a likelihood of reverse confusion, as indicated in Applicant's moving Brief (and not challenged by the Examining Attorney), in order for reverse confusion to occur, the senior user's mark must be weak.[2] Since the Cited Mark was registered on the basis of a claim of acquired distinctiveness, it is presumed not to be weak (*see* Exhibit B to Applicant's moving Brief).

There is no likelihood of reverse confusion for the additional reasons that, as discussed above in connection with forward confusion, the Marks are not similar, consumers are sophisticated, and there is a policy in favor of allowing an individual to use his name.

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[2] *See A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 232 (3d Cir. 2000) ("in a reverse confusion claim, a plaintiff with a commercially weak mark is more likely to prevail than a plaintiff with a stronger mark").

III. CONCLUSION

For the reasons stated above, as well as in Applicant's moving Brief, Applicant respectfully requests the Board to overrule the refusal to register Applicant's Mark on the grounds of a likelihood of confusion with the Cited Mark.

Respectfully submitted,

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April 18, 2008

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