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July 22, 2008

ATTORNEYS AT LAW

**MADRID PROTOCOL FILING**

KYOKO IMAI  
(703) 412-6040  
KIMAI@OBLON.COM

Trademark Assistance Center  
James Madison Building  
East Wing, Concourse Level  
600 Dulany Street  
Alexandria, Virginia 222314

Attn: MPU

Re: DAMIANI INTERNATIONAL BV  
Mark: DAMIANI  
U.S. Application No.: 79/035,122  
Class(es): 3, 9, 14  
Atty Dkt. No.: 306659US35MP

Dear Commissioner:

We enclose the following Madrid Protocol related papers for filing in the U.S. Patent and Trademark Office:

Request to Divide Application Under Trademark Rule 2.87

Also enclosed is the credit card payment form for the required filing fee in the amount of \$100.00.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

OBLON, SPIVAK, MCCLELLAND,  
MAIER & NEUSTADT, P.C.

Kyoko Imai

RSB/KI/cli



07-22-2008

Attorney Docket No.: 306659US35MP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK EXAMINING OPERATION**

In re the Application of:

DAMIANI INTERNATIONAL BV

Examining Attorney

Application Serial No.: 79/035,122

Nora Buchanan Will

Filed: February 13, 2006

Law Office 116

Mark: DAMIANI

**BOX FEE**

Honorable Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Commissioner:

**REQUEST TO DIVIDE APPLICATION**  
**UNDER TRADEMARK RULE 2.87**

Pursuant to 37 CFR §2.87, the Applicant, by and through its appointed counsel, hereby requests that the application be divided. It is submitted that the attached Request for Reconsideration places Classes 3, 9 and 14, the subject of the "child" application, in condition for publication.

The request to divide is as follows:


Please separate the application into two applications leaving the goods in Classes 18 and 25 in the original "parent" application file and creating the "child" application for Classes, 3, 9 and 14.

Please find attached credit card payment form in the amount of \$100.00 to cover fees associated with the division of the case as set forth in 37 CFR §2.6(a)(19). In the event that further fees are required, a charge against our deposit account, Account No. 50-2014, is hereby authorized.

Respectfully submitted,

DAMIANI INTERNATIONAL BV

By:

  
\_\_\_\_\_  
Roberta S. Bren  
Kyoko Imai  
Oblon, Spivak, McClelland,  
Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314  
(703) 413-3000  
fax (703) 413-2220  
e-mail: [tmdocket@oblon.com](mailto:tmdocket@oblon.com)

Date: July 22, 2008  
RSB/BAC/cli {I:\atty\RSB\0490-306659US-req.doc}

# **EXHIBIT 1**

Attorney Docket No.: 306659US35MP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK EXAMINING OPERATION**

In re the Application of:

DAMIANI INTERNATIONAL BV

Application Serial No.: 79/035,122

Filed: February 13, 2006

Mark: DAMIANI

Class: 3, 9, 14, 18, 25

Examining Attorney

Nora Buchanan Will

Law Office 116

**BOX RESPONSES**

**NO FEE**

Honorable Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

Dear Commissioner:

**REQUEST FOR RECONSIDERATION**

Pursuant to Trademark Rule 2.64(b), Applicant, Damiani International B.V., requests reconsideration of the Examining Attorney's final refusal dated January 22, 2008. The Examining Attorney is advised that concurrently with this Request for Reconsideration, Applicant has filed a Notice of Appeal under Trademark Rules 2.141 and 2.142(a), requesting that the appeal be suspended pending the Examining Attorney's determination on Applicant's Request for Reconsideration.

**AMENDMENTS**

Please amend the identification of goods and services to read as follows:

Perfumes, body and beauty care cosmetics; toilet water, personal deodorants, essential oils for personal use, body lotions, shower gel, bubble bath, bath oils, bath pearls, skin soaps, shaving balms, shaving cream, aftershave lotions, cosmetic pencils, foundation make-up, face powders, talcum powder, rouges, lipsticks, mascaras, skin cleansing creams, skin cleansing lotions, sun screen preparation, face creams, body

creams, hair shampoos, hair sprays, hair lotions, dentifrices, in International Class 3.

Optical products, namely, spectacles and sunglasses, eyeglass frames, lenses, and cases therefor; sport goggles for use in skiing, swimming, motorcycling; eyeglass chains, in International Class 9.

Jewelry, namely, belt buckles of precious metals, bracelets of precious metals, brooches, cuff-links, diamonds, earrings, necklaces, pearls, rings; precious metals and their alloys, bracelets, charms, earrings in precious metal or coated therewith; precious stones; horological (timepieces) and chronometric instruments including timepieces, wristwatches, watches, clocks and parts therefore, in International Class 14.

Leather goods, namely, handbags, purses, wallets, brief cases, toiletry cases sold empty, cosmetic cases sold empty; traveling bags, luggage, beach bags, all purpose sport bags, school bags, knapsacks, suitcases, umbrellas, parasols, walking sticks, in International Class 18.

Trousers, skirts, jeans, sweat pants, shorts, sweatshirts, suits and dresses, jerseys, neckwear, track suits, gym suits, T-shirts, lounge wear, underwear, beachwear, sleepwear, headwear, hats and caps, in International Class 25.

#### REMARKS

Applicant appreciates the Examining Attorney's full withdrawal of the refusal to register based on cited Registration Nos. 2,410,781, 3,174,284, 1,181,662 and 3,216,881, and the Examining Attorney's withdrawal of the refusal to register based on cited Registration No. 2,228,432 as to Classes 3, 9 and 14.

Regarding the Examining Attorney's refusal based on Registration No. 2,228,432 as to Classes 18 and 25, Applicant has amended the identifications limiting the goods to:

"Leather goods, namely, handbags, purses, wallets, brief cases, toiletry cases sold empty, cosmetic cases sold empty; traveling bags, luggage, beach bags, all purpose sport bags, school bags; knapsacks, suitcases, umbrellas, parasols, walking sticks" (Class 18); and "Trousers, skirts,

jeans, sweat pants, shorts, sweatshirts, suits and dresses, jerseys, neckwear, track suits, gym suits, T-shirts, lounge wear, underwear, beachwear, sleepwear, headwear, hats and caps” (Class 25).

The determination of likelihood of confusion involves an analysis under the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 513 (CCPA 1973). The test of likelihood of confusion requires consideration of all of the relevant *du Pont* factors, including, in this application, that marks are dissimilar; the scope of protection afforded the registered mark is limited; and Applicant’s goods, as amended, are not related to the identified goods in the cited registration.

The first *du Pont* factor set out by the Court is “The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” In determining likelihood of confusion, marks must be considered in their entirety because the commercial impression of a mark on purchasers/consumers is created by the mark as a whole. *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) (VARGA GIRL for calendars not likely to cause confusion with VARGAS for, *inter alia*, calendars). That is, it is well settled in evaluating likelihood of confusion the marks must be considered in their entirety and not dissected into their component parts. The commercial impression is derived from the marks as a whole, not from their elements separated and considered in detail. 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2008).

In this case, Applicant’s mark is DAMIANI, while the cited registration is for the mark shown below.



The words are not identical as the registration includes an apostrophe and the letter "S." In addition, the cited registration includes a prominent design feature of a building which appears to be the well known and world renowned "Leaning Tower of Pisa." (Exhibit A) The design of this famous building is quite memorable to the purchasing public. Further, the mark in the cited registration includes a partial outline, the upper corner of which resembles a cathedral arch,<sup>1</sup> framing the building design and the word. These differences create readily recognizable and significant differences between Applicant's mark and the cited mark, particularly as each mark must be considered as a whole. *In re Hearst Corp., supra.* The building design and the partial outline with a cathedral arch are significant elements of the cited mark and are noticeable and memorable to purchasers.

There are numerous cases where marks having terms in common for the same or similar goods are sufficiently distinct to preclude a likelihood of confusion. *In re Ferrero & C. S.p.A.*, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973)(TIC TAC for candy not confusingly similar to TIC TAC TOE for ice cream); *Long John Distilleries, Ltd. v. Sazerac*, 426 F.2d 1406, 166 USPQ 30 (CCPA 1970)(LONG JOHN for Scotch whiskey not confusingly similar to FRIAR JOHN for brandy); *Colgate Palmolive Co. v. Carter Wallace Inc.*, 432 F.2d 400, 167 USPQ 529 (CCPA 1970) (PEAK PERIOD personal deodorants not confusingly similar to PEAK for dentifrice); *Information Resources, Inc. v. X\*Press Information Services*, 6 USPQ2d 1034 (TTAB

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<sup>1</sup> The Leaning Tower of Pisa building is a part of the Cathedral of Pisa complex. Exhibit A.



1988)(EXPRESS for information analysis computer software packages not confusingly similar to X\*PRESS for services of transmittal of news and general information to home and business computers); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541 (TTAB 1983)(MEAT PLUS for pet food not confusingly similar to PLUS for food supplements for dogs and cats); *Miller Brewing Co. v. Premier Beverages, Inc.*, 210 USPQ 43 (TTAB 1981)(MILLER for beer not confusingly similar to OL' BOB MILLER for soft drinks).

The cited registration creates a different commercial impression from that engendered by Applicant's word mark DAMIANI. The Examining Attorney is urged to consider the importance of the overall mark in the cited registration vis-à-vis Applicant's mark. The marks, when considered in their entireties, are different in appearance, meaning and commercial impressions. *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990)(K+ mark for dietary potassium supplement not likely to cause confusion with K+EFF for potassium supplement).

Furthermore, in view of the existence on the USPTO Register of all of the registered marks originally cited by the Examining Attorney, it is clear that Applicant's mark and the registered marks (which are owned by different entities), are not likely to result in a likelihood of confusion.

Regarding the relatedness and the nature of the respective goods, Applicant has amended the identification of its goods in Class 25 by deleting footwear. The cited registration includes only "mens and ladies footwear." Applicant is not seeking to register the mark for footwear. The respective products, as limited in Applicant's application, and the Registrant's "mens and ladies footwear" are different types of products, with different uses, sold in different stores or in

different sections of large, mass-marketing stores. There is a competitive distance between the products. They are not related within the meaning of Section 2(d) of the Trademark Act. *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003); *In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976).

Footwear, clothing and leather bags are often sold in separate stores. Even if sold in the same store, the mere presence of goods in the same store does not necessarily lead to the conclusion that confusion would arise under such conditions. *Interstate Brands Corp. v. Celestial Seasonings Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978); *Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169 (TTAB 1981). Courts and the Board recognize that in today's department stores and mega-stores, a wide variety of products, some within an industry and others from diverse industries, have been brought together for the customer's convenience. Nonetheless, there is no *per se* rule that products are related because they may be sold in the same store. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715 (TTAB 2007). In fact, it is well-settled that "*per se*" rules relating to the issue of likelihood of confusion have been struck down as too inflexible and contrary to trademark law where each case is determined based on its own facts and circumstances. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985).

Applicant's identified amended goods are sufficiently different goods from those in the cited registration to obviate or negate any likelihood of confusion.

When the differences between the marks, the limited scope of protection afforded the cited registration, and the differences in the nature of Applicant's amended goods vis-à-vis Registrant's goods, are considered, a likelihood of confusion is simply not present. The mark in the cited registration and Applicant's mark can co-exist in the marketplace and on the USPTO Register without any likelihood of confusion.

Accordingly, considering all relevant *du Pont* factors, Applicant respectfully requests that the cited registration be withdrawn as a bar to registration of Applicant's mark DAMIANI for the identified goods in Classes 18 and 25 in Applicant's application.


With regard to the Examining Attorney's refusal of the mark as primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 USC §1052(e)(4), Applicant requests registration of the mark DAMIANI under Section 2(f) of the Trademark Act, 15 USC § 1052(f), based on Applicant's ownership of Registration No. 3,216,881 on the Principal Register for the mark DAMIANI. Trademark Rule 2.41(b). Accordingly, Applicant requests that the Examining Attorney withdraw the surname refusal.

In view of all of the foregoing, it is courteously urged that the instant application, as amended, is in condition for publication. Applicant respectfully requests that Applicant's application be approved for publication.

Respectfully submitted,

DAMIANI INTERNATIONAL BV

By:



Roberta S. Bren  
Kyoko Imai  
Oblon, Spivak, McClelland,  
Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314  
(703) 413-3000  
fax (703) 413-2220  
e-mail: [tmocket@oblon.com](mailto:tmocket@oblon.com)

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