

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

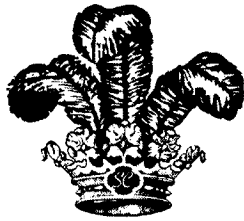
In re Application of:

SC Licensing, LLC

Serial No.: 85/135,970

Filing Date: September 22, 2010

Mark: SC & Design



Classes: 20, 21 and 24

Examiner :

Stephanie M. Ali

Law Office: 109

APPLICANT'S APPEAL BRIEF



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Applicant SC Licensing, LLC (“Applicant”) hereby submits its brief in support of its appeal of the Examiner’s refusal to register Applicant’s trademark SC & Crown Design under Section 2(b) of the Lanham Act. The goods at issue are various furniture, housewares and fabrics in Classes 20, 21 and 24.

I. PRELIMINARY STATEMENT

Applicant’s founder is Rachel Ashwell, who is world famous for popularizing her unique home décor style under the brand SHABBY CHIC. (Response to Office Action, December 18, 2014, Ex. B.) In connection with its successful SHABBY CHIC brand, Applicant seeks registration of the SC & Crown Design trademark for various goods in Classes 20, 21 and 24.

The Examiner refused registration of Applicant’s mark under Section 2(b) of the Lanham Act on the ground that Applicant’s mark resembles a governmental insignia, namely, the official emblem of the United Kingdom’s Prince of Wales, as depicted in U.S. Trademark Application Serial No. 89/001,177 (“Prince of Wales Emblem”). Contrary to the Examiner’s position, Applicant’s mark does not resemble the Prince of Wales Emblem.

For the reasons given in Applicant’s Response to Office Action dated December 18, 2014, its Request for Reconsideration dated August 18, 2015, and all other filings Applicant has made for this application, all of which are expressly incorporated herein by reference, Applicant respectfully maintains that the refusal to register Applicant’s SC & Crown Design mark is misplaced. The Board should reverse the Examiner’s refusal to register SC & Crown Design mark and allow the present application to proceed to publication.

II. STATEMENT OF FACTS

For the Board’s convenience, the facts are summarized below:

A. Information About Applicant

Applicant produces home décor and houseware products under the well-known brand SHABBY CHIC, made famous by Applicant’s founder Rachel Ashwell. (Response to Office Action, December 18, 2014, Ex. B.) The SHABBY CHIC brand signifies a romantic, relaxed

and comfortable style and aesthetic, influenced by Ms. Ashwell's roots and background in the English style. (Request for Reconsideration, August 15, 2015, Ex. G.) In connection with its successful SHABBY CHIC brand, Applicant seeks registration of the SC & Crown Design trademark for various goods in Classes 20, 21 and 24. Applicant's use of the SC & Crown Design trademark dates back at least as early as June 2003. (*Id.* at Ex. E.)

B. Procedural Background

Applicant filed its multi-class application to register the SC & Crown Design mark on September 22, 2010 under Section 1(b) of the Lanham Act for the following goods:

- Furniture, namely, chairs, sofas, ottomans, couches, pillows, love seats, tables, room divider screens, fireplace screens, wall cabinets, dressers, fitted fabric slip covers for furniture, wall units, chair pads, end tables, night stands, vanity tables, coffee tables, dining room tables, armoires, and book cases; clothes hangers in International Class 20;
- Toothbrush holders; toothbrushes; tumblers; meal trays; lotion dispensers and pumps; soap dishes; fitted vanity cases; wastebaskets; shower hooks; towel bars; shower caddies; perfume sprayers sold empty; mugs; mug trees; glass and porcelain fabric mitts for cleaning; napkin holders; nail brushes; hair combs; hair brushes; bottle openers; Christmas, ceramic, and holiday ornaments; mops; brooms; dinnerware; china dinnerware; dishes; cups; drinking glasses; glass bowls; glass pans; paper cups and plates; pitchers; plates; salt and pepper shakers; serving spoons; spice racks; lunch boxes; jugs; non-metal keepsake boxes; non-metal decorative boxes; decorative glass boxes; non-metal trinket boxes; candle holders not of precious metal; and candle sticks not of precious metal; plates and cups made of plastic; gift card holders in International Class 21; and
- Fabrics and linens for furniture and home furnishings; and unfitted fabric slip covers for furniture; fabrics, linens and textiles for children's bedding and clothing; infant receiving blankets; blankets; crib duvets; crib sheets, bumpers; dusters; comforters; bed sheets; bed linens; pillow cases; towels; bed skirts; fabrics, linens and textiles for the further manufacture of housewares; fabric, linen and textile piece goods for the further manufacture of housewares; furniture; home furnishings; household goods; window treatments; bed spreads; fabric canopies for beds; bed duvets; bed pads; dust ruffles; pillow shams; decorative fabric pillows; textile bath mats; fabric curtains and draperies; dish cloths; cloth doilies; fabric, cloth and textile napkins; wash cloths; cloth and textile place mats; fabric table runners; table cloths not of paper; textile tapestries; fabric valances; fabric chair pads; quilts; quilted shams; shower curtains; pot holders; mattress pads; plastic table covers; fabrics for home decor; and kit comprised of fabric for making quilts in International Class 24.

Applicant claimed ownership of prior Reg. No. 2,898,987 and claimed acquired distinctiveness of its SC & Crown Design mark under Section 2(f) of the Lanham Act based on acquired distinctiveness.

On January 16, 2011, the Examiner issued an Office Action requiring amendment of the identifications of goods on the ground that certain of the wording was unacceptable as indefinite. (Office Action, January 16, 2011 at 2-3.) The Examiner noted that certain of the goods may require reclassification dependent on the amendment of the identification. (*Id.* at 3.)

On June 14, 2011, Applicant filed its response to the Office Action, amending the identification of goods. (Response to Office Action, June 14, 2011.)

On July 25, 2011, the Examiner issued an Office Action making final the requirement to further amend and reclassify the identification of goods. (Office Action, July 25, 2011 at 1-2.)

On January 17, 2012, Applicant filed its Request for Reconsideration amending and reclassifying its identification of goods to the following:

- Furniture, namely, chairs, sofas, ottomans, couches, pillows, love seats, tables, room divider screens, fireplace screens, wall cabinets, dressers, wall units, chair pads, end tables, night stands, bathroom vanity tables, coffee tables, dining room tables, armoires, and book cases; fitted fabric slip covers for furniture; clothes hangers; shower curtain hooks; decorative fabric pillows; decorative memory keepsake boxes made primarily of wood; furniture, home furnishings and household goods, namely chairs, sofas, tables, cabinets, bed frames, mirrors, and pillows; and decorative fabric pillows in Class 20;
- Toothbrush holders; toothbrushes; tumblers; meal trays; lotion dispensers and pumps sold empty; soap dishes; fitted vanity cases; wastebaskets; towel bars; shower caddies; perfume sprayers sold empty; mugs; mug trees; fabric mitts for cleaning glass and porcelain; napkin holders; nail brushes; hair combs; hair brushes; bottle openers; holiday ornaments of ceramic; mops; brooms; dinnerware; china dinnerware; dishes; cups; drinking glasses; glass bowls; glass pans; paper cups and plates; pitchers; plates; salt and pepper shakers; serving spoons; spice racks; lunch boxes; jugs; candle holders not of precious metal; and candle sticks not of precious metal; plates and cups made of plastic; cleaning dusters; decorative memory keepsake boxes made of glass or ceramic in Class 21; and
- Furnishing and upholstery fabrics; interior decoration fabrics; and unfitted fabric slip covers for furniture; cotton, linen, silk, rayon, or polyester fabrics and textiles

for children's bed linens and children's apparel; infant receiving blankets; crib blankets; crib duvets; crib sheets; crib bumpers; comforters; bed sheets; bed linens; pillow cases; towels; bed skirts; fabrics, linens and textiles and fabric, linen and textile piece goods for the further manufacture of furniture, upholstery, and decorative items; window treatments, namely draperies, drapery panels, curtains, and valances; bed spreads; bed duvets; bed pads; dust ruffles; pillow shams; dish cloths; cloth doilies; fabric, cloth and textile napkins; wash cloths; cloth and textile place mats; fabric table runners; table cloths not of paper; textile tapestries; fabric valances; quilts; quilted shams; shower curtains; pot holders; mattress pads; plastic table covers; textile fabrics for home interiors; and kit comprised of fabric for making quilts in Class 24.

(Request for Reconsideration, January 17, 2012.)

On January 18, 2012, Applicant filed a Notice of Appeal. (TTAB Docket No. 1.) On the same day, the Board acknowledged and instituted the appeal. (TTAB Docket Nos. 2-3.) The Board also suspended the appeal and remanded the application back to the Examiner for the Request for Reconsideration. (*Id.*)

On February 27, 2012, the Examiner approved the application for publication. The next day, the Board terminated the appeal. (TTAB Docket No. 5.)

On May 6, 2012, the Examiner issued an Office Action stating that the application was withdrawn from publication because the Commissioner's Office determined that Applicant made an unnecessary claim of acquired distinctiveness under Section 2(f) of the Lanham Act. (Office Action, May 6, 2012 at 1.). The Examiner stated that Applicant could request to withdraw the claim or it would remain in the application record and be printed on the registration certificate. (*Id.*)

On October 11, 2012, Applicant filed its response to the Office Action deleting the claim of acquired distinctiveness. (Response to Office Action, October 11, 2012.)

The Notice of Publication issued on January 2, 2013 and the Notice of Allowance issued on March 19, 2013.

On September 19, 2013, Applicant filed a first Request for Extension of Time to File a Statement of Use. (Request for Extension of Time to File a Statement of Use, September 19, 2013.) The Office issued a Notice of Approval of Extension Request on September 21, 2013.

On March 18, 2014, Applicant filed a second Request for Extension of Time to File a Statement of Use. (Request for Extension of Time to File a Statement of Use, March 18, 2014.) The Office issued a Notice of Approval of Extension Request on April 15, 2014.

On June 18, 2014, the Examiner issued an Office Action stating that the application was withdrawn from publication and the Notice of Allowance issued on March 19, 2013 was withdrawn. (Office Action, June 18, 2014 at 1.) The Examiner stated that registration of Applicant's mark was refused under Section 2(b) of the Lanham Act, on the ground that Applicant's mark resembled a governmental insignia, namely, the design depicted in U.S. Application No. 89/001,177 filed under Article 6ter, described as the "Official Emblem of the Prince of Wales." *Id.*

On December 18, 2014, Applicant filed its response to the Office Action, arguing that Applicant's mark did not resemble a governmental insignia. (Response to Office Action, December 18, 2014.) Applicant pointed out that there were material visual differences between Applicant's mark and the Prince of Wales Emblem. (Response to Office Action, December 18, 2014 at 1-3.) Applicant also pointed out that the Office has registered analogous marks that resemble other governmental insignias, such as the fleur-de-lis. (*Id.*, Ex. G.)

On February 18, 2015, the Examiner issued an Office Action making final the refusal to register Applicant's mark under Section 2(b). (Office Action, February 18, 2015.)

Applicant responded to the final refusal by filing a Request for Reconsideration on August 18, 2015. (Request for Reconsideration, August 18, 2015.) Applicant reiterated that Applicant's SC & Crown Design mark was uniquely associated with Applicant's founder Rachel Ashwell and the SHABBY CHIC brand. (*Id.* at 2.) Applicant also submitted 243 third party registrations of crown designs. (*Id.*, Ex. I.)

Finally, to preserve its rights, Applicant filed a Notice of Appeal concurrently with its Request for Reconsideration.

On November 12, 2015, the Board instituted and then suspended the appeal, remanding the application to the Examiner. (TTAB Docket No. 7.)

On December 7, 2015, the Examiner denied Applicant's Request for Reconsideration. (Office Action, December 7, 2015 at 1.) This appeal brief is timely filed.

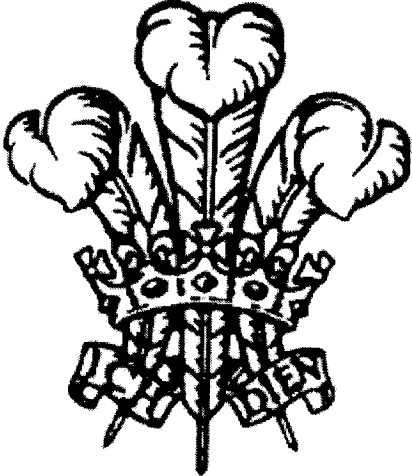

III. THE REFUSAL TO REGISTER UNDER SECTION 2(b) SHOULD BE WITHDRAWN BECAUSE APPLICANT'S MARK DOES NOT RESEMBLE OR SIMULATE A GOVERNMENTAL INSIGNIA

The only issue on appeal is whether Applicant's SC & Crown Design mark resembles or simulates the Prince of Wales Emblem. Applicant respectfully maintains that its SC & Crown Design mark resembles a house brand, not the Prince of Wales Emblem or any other official governmental insignia and that the Examiner's refusal should be reversed. The overall commercial impression conveyed by Applicant's mark is *not* that of trademark owner trying to convince a viewer of a false association with a government, a governmental entity or other official designation.

A. Applicant's Mark does not Resemble a Governmental Insignia

Section 2(b) of the Lanham Act provides, in relevant part, that "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." 15 U.S.C. §1052(b).

Applicant's mark does not "consist of or comprise" a governmental insignia. A side-by-side comparison with the Prince of Wales Emblem demonstrates the obvious differences between the two designs:

Prince of Wales Official Emblem	Applicant's Mark
	

The numerous differences between the designs include the following:

- Applicant's mark incorporates the two letters "SC", whereas the Prince of Wales Emblem incorporates the German phrase "Ich Dien", which means "I serve" in English. (Response to Office Action, December 18, 2014, Ex. A.)
- Applicant's letters "SC" are displayed on the band of the crown, whereas the Prince of Wales Emblem's phrase "Ich Dien" are displayed on a banner underneath the crown, wrapping around the tips of the feathers used in the Prince of Wales Emblem.
- Applicant's crown design is more fanciful and floral looking, whereas the Prince of Wales Emblem's crown displays jewels or stones and a fleur-de-lis pattern.
- Applicant's crown design has a large band around the bottom, that finishes the bottom of the crown, which is absent from the Prince of Wales Emblem crown.

- The feathers in the Prince of Wales Emblem are full feathers, with the tips intact, which extend beyond the crown about 1/3 of the length of the design.
- Applicant's feathers are darker and do not protrude underneath the crown, whereas the Prince of Wales Emblem's feathers are lighter and protrude underneath the crown.

It cannot be said that Applicant's mark consists of or comprises a governmental insignia.

B. Applicant's Mark does not Simulate a Governmental Insignia

Applicant's mark does not "simulate" a governmental insignia either. In *In re Advance Industrial Security, Inc.*, 194 USPQ 344 (TTAB 1977), the Board held:

In determining this issue, it is our opinion that the term "simulation" is used in the context of Section 2(b) of the Statute in its usual and generally understood meaning, namely, to refer to something that gives the appearance or effect or has the characteristics of an original item (Webster's Third New International Dictionary, Unabridged Edition, 1965.) Whether or not a simulation exists in a proceeding of this character must necessarily be one of first impression gathered from a view of such mark without a careful analysis and side-by-side comparison with the Coat of Arms or Great Seal of the United States.

Advance Industrial Security, 194 USPQ at 346. In *Advance Industrial Security*, the Board held that a triangular shield design in gold and brown with the words "ADVANCE SECURITY" displayed in the upper central portion of the mark created an overall commercial impression distinctly different from the U.S. Coat of Arms and did not falsely suggest a connection with the U.S. Government. *Id.* at 346-47.

In the present case, consumers who view Applicant's mark are unlikely to believe that Applicant's mark has any association or connection with the Prince of Wales of the United Kingdom. Instead, consumers will understand that Applicant's SC & Crown Design mark is a design associated with Applicant's famous SHABBY CHIC mark. *In re Advance Industrial Security, Inc.*, 194 USPQ at 346.

As previously stated, Applicant's founder is Rachel Ashwell, creator of the SHABBY CHIC brand that exemplifies a unique home décor style, extending to furniture, textiles, linens, bedding, lighting and other housewares. (Request for Reconsideration, August 15, 2015, Ex. A.) Applicant's marks include SC, which is an acronym for SHABBY CHIC, and RACHEL ASHWELL or R, for Applicant's founder Rachel Ashwell. (*Id.*, Ex. B.) Applicant's SC & Crown Design mark is used very often with Applicant's related marks. (*Id.*, Exs. C-D.) By way of example, Applicant's SC & Crown Design mark is used on nationwide retailer Target's website at <target.com> spotlighting Applicant's SIMPLY SHABBY CHIC line of home products. Applicant's mark is depicted with the mark SIMPLY SHABBY CHIC. (*Id.*, Ex. D.)

Applicant's crown and feather design resembles a house brand, rather than the Prince of Wales Emblem or any other official governmental insignia. The overall commercial impression conveyed by Applicant's mark is *not* that of a trademark owner trying to convince a viewer of a false association with a government, a governmental entity, or other official designation.

C. The Office has Previously Registered Applicant's Mark for the Same Goods

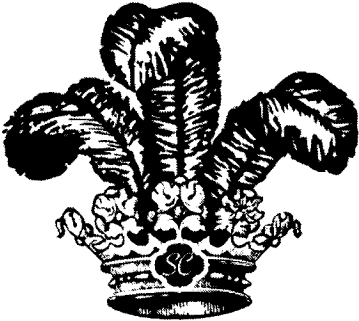
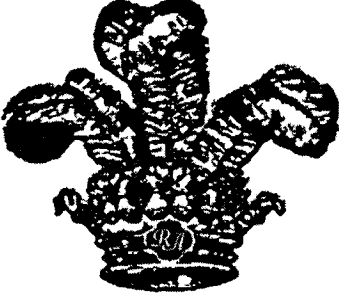

Applicant's crown design has been and is currently registered by the Office in different iterations. Applicant is the owner of canceled Reg. No. 2,898,987 for the mark RA & Crown Design, which was registered on November 2, 2004 for furniture in Class 20 and linens and bedding in Class 24. (Request for Reconsideration, August 15, 2015, Ex. E.) Applicant began use of that mark at least as early as June 2003. On November 5, 2009, Applicant filed a combined Affidavit of Use and Incontestability for Reg. No. 2,898,987 under Sections 8 & 15 of the Trademark Act for certain goods. Thereafter, the registration was canceled on June 5, 2015 for failure to file an Affidavit of Use and Application for Renewal under Sections 8 & 9 of the Trademark Act.

Applicant is also the owner of Reg. No. 2,967,641 for the mark RACHEL ASHWELL HOME RA SHABBY CHIC EST. 1989 & Design, which was registered on July 12, 2005 for goods in Classes 3, 11, 16, 18, 20, 21, 24, 25 and 27. (Request for Reconsideration, August 15,

2015, Ex. F.) Applicant began use of that mark at least as early as August 2003. On June 21, 2011, Applicant filed a combined Affidavit of Use and Incontestability for Reg. No. 2,967,641 under Sections 8 & 15 of the Trademark Act for the goods in Classes 11 and 20.¹

Applicant's Reg. No. 2,898,987 and Reg. No. 2,967,641 were not renewed for certain goods or certain classes because Applicant's predecessor-in-interest went through bankruptcy proceedings in early 2009, subsequent to the financial crisis in 2008. (Request for Reconsideration, August 15, 2015, Ex. G.)

Applicant's SC & Crown Design is **nearly identical** to Applicant's prior registrations:

Ser. No. 85/135,970	Reg. No. 2,898,987	Reg. No. 2,967,641
		

¹ Reg. No. 2,967,641 was a live registration at the time of filing of Applicant's Request for Reconsideration dated August 15, 2015. Thereafter, the registration was canceled on February 19, 2016 for failure to file an Affidavit of Use and Application for Renewal under Sections 8 & 9 of the Trademark Act.

Applicant also uses different crown designs as part of the overall SHABBY CHIC brand. For example, Applicant owns Reg. No. 3,827,333 for the following mark, registered in Classes 4, 11, 20, 24, 25 and 27:



(Request for Reconsideration, August 15, 2015, Ex. H.) Consumers who view Applicant's SC & Crown Design mark will recognize that Applicant uses a crown motif throughout the brand portfolio, which connotes luxury, exclusivity, and cachet to Applicant's consumers.

It is illogical to deny registration of Applicant's SC & Design mark given the Office's prior approval of the same or substantially indistinguishable design in Applicant's prior registrations. The Consistency Initiative promulgated by the Office states in relevant part:

An applicant may bring to the attention of the Office situations where, in applicant's opinion, the Office has acted inconsistently in its treatment of applicant's pending applications/recent registration(s). For Requests that address substantive or procedural issues (excluding issues involving identifications of goods and services), applicants' Requests may include registrations that have issued within five years. Applicants may submit a Request when a substantive or procedural issue has been addressed in a significantly different manner in different cases, subject to the following provisions: (1) the Request is based on co-pending applications or an application and a registration owned by the same legal entity or a successor in interest (e.g., assignee); (2) the registration(s) involved was issued less than five years prior to the date of the Request; (3) at least one of the applications in the Request is in a pre-publication status at the time of the Request; and (4) the allegedly inconsistent treatment has already occurred.

The present situation is exactly the type of situation the Consistency Initiative is intended to address, namely, Applicant's prior registrations for the same mark for the same goods dictate registration of the present application. Applicant has been using its crown design since 2003. Applicant is not aware of a single instance in which consumers were led to believe that Applicant's goods originated from or were connected with the Prince of Wales. Consumers who view Applicant's mark are unlikely to believe that Applicant's mark has any association or connection with the Prince of Wales of the United Kingdom, just as consumers were not confused by Applicant's prior registrations of the same design. If the Consistency Initiative does not apply in this instance, the purpose of its promulgation is defeated and it is of no value.

Further, the Board has also addressed inconsistent practices by the Office. In *In re Thomas Nelson Inc.*, 97 USPQ.2d 1712 (TTAB 2011), the Board held that the applicant's applied-for mark NKJV, which stood for NEW KING JAMES VERSION, had acquired distinctiveness because of, *inter alia*, evidence of the applicant's two previously registered marks NKJV & Design and NJKV NEW KING JAMES VERSION under Section 2(f) of the Lanham Act. *In re Thomas Nelson*, 97 USPQ.2d at 1718. The Board noted that to hold otherwise would be "illogical on its face." *Id.* The same is true here.

D. The Office has Registered Other Crown Design Marks and Fleur-de-Lis Marks

Finally, it is illogical to single out Applicant's SC & Crown Design mark when other "royal" looking designs have been approved by the Office for registration. The Office has registered at least 243 crown designs for various goods and services. (Request for Reconsideration, August 15, 2015, Ex. I.) The Office has registered more than one thousand marks incorporating the fleur-de-lis design. (Response to Office Action, December 18, 2014, Exs. F and G.) Given the pervasive number of crown design and fleur-de-lis registrations, consumers will understand easily that Applicant's SC & Crown Design mark is yet another trademark in the marketplace.

IV. CONCLUSION

For the reasons stated above, and in all of Applicant's other documents and evidence, Applicant respectfully requests that the Board reverse the decision of the Examiner and allow the mark to proceed to publication.

Applicant also requests oral argument for this appeal, as noted in the attached Request for Oral Argument filed concurrently herewith.

Respectfully submitted,

Dated: March 22, 2016

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail enclosed in a sealed envelope addressed to: Commissioner for Trademarks, Attn: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451, on this 22nd day of March, 2016.



LaFana A. Martin

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