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

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Applicant	Chow Tai Fook Jewellery Company Limited
Applied for Mark	SOINLOVE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Chow Tai Fook Jewellery Company Limited	Trademark Law Office 125
Serial No.: 87959197	Examining Attorney: Patrick Carr
Filing Date: June 12, 2018	
Mark: SOINLOVE (stylized)	

APPEAL BRIEF FOR APPLICANT

INTRODUCTION

Applicant, Chow Tai Fook Jewellery Company Limited, appeals to the Trademark Trial and Appeal Board from the Examining Attorney's refusal to register the mark SOINLOVE (stylized) for goods and services in classes 14 and 35. The Examining Attorney contends that Applicant's Mark is likely to be confused under Section 2(d) of the Trademark Act with Registration No. 3298809 for the mark SO IN LOVE for "personal care products, namely, body mist, cream for the body, fragrant body mist, lotion for the body, perfume" in Class 3. Applicant, however, maintains there is no likelihood of confusion between the marks because 1) SO IN LOVE is a weak mark, as evidenced by third party uses; and therefore 2) the mark SOINLOVE (stylized) and its associated goods and services differ sufficiently from the cited mark to avoid a likelihood of confusion.

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I. DESCRIPTION OF RECORD

A. PROSECUTION HISTORY

The logo for SOINLOVE is displayed in a stylized, black, serif font. The letters 'S', 'O', 'I', 'N', 'L', 'O', 'V', and 'E' are connected in a continuous, flowing script. The 'O's are notably large and rounded, and the 'I' and 'N' are smaller and more upright. The overall appearance is elegant and modern.

Applicant filed an application for the mark , claiming an intent to use and section 44e filing basis, on June 12, 2018, for the following goods in class 14 and services in class 35:

“Precious metals and their alloys; Goods in precious metals or coated therewith, namely, jewelry cases, watches, jewelry charms, medals, tie clips, cuff links, decorative pins in the nature of jewelry, decorative boxes, jewelry ornaments in the nature of jewelry; Jewelry; Precious stones; Semi-precious stones; Gemstones; Pearls; Jades; Diamonds; Rubies; Sapphires; Emeralds; Horological and chronometric instruments; Clocks; Watches; Jewelry charms made of precious metal or precious stones; Trinkets of precious metals and stones in the nature of jewelry, namely, rings, earrings, bracelets, brooches and necklaces; Trinkets, namely, precious metal key rings and decorative fobs for key rings; Goods in precious metal, namely, figurines, statues and statuettes; Goods primarily of precious metal, namely, figurines, statues and statuettes, all coated in precious metal; Hat ornaments of precious metal, namely, hat jewelry; Beads for making jewelry made of precious metal or precious stones; Trinkets and fobs, namely, key rings made of precious metal or precious stones; Trinkets and fobs, namely, key chains made of precious metal or precious stones; Silver thread jewelry; Silver, unwrought or beaten; Cases for jewelry in class 14; and Retailing and wholesaling of, import and export agency services relating to, and advertising and promotion services for precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments,

clocks, watches, and cases for jewelry; Franchising services, namely, offering business management assistance in the establishment and operation of commercial enterprises in the nature of retail and wholesale distributorship enterprises and import and export agency enterprises featuring precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewelry; Providing advice and consulting services relating to retail and wholesale distributorship, import and export agency, advertising and franchising services relating to precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewelry; Organization and conducting of exhibitions, trade fairs and fashion shows for commercial or advertising purposes; Sales promotions for others; Auctioneering; Advertising; Business management; Business administration; Office functions; Providing office functions; Presentation of goods on communication media, namely, providing television, computerized and online shopping services in the nature of an online shopping site in the field of precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewelry in class 35.

The Examining Attorney issued an office action on October 1, 2018 refusing registration on the grounds that Applicant's mark SOINLOVE (stylized) will cause a likelihood of confusion under Section 2(d) of the Trademark Act with Registration No. 3298809 for the mark SO IN LOVE for "personal care products, namely, body mist, cream for the body, fragrant body mist, lotion for the body, perfume" in Class 3. Applicant filed a response denying any likelihood of confusion between the marks on April 1, 2019.

On October 31, 2019, the Examiner issued a Final Office Action, maintaining the likelihood of confusion refusal. Applicant filed its Request for Reconsideration and Notice of

Appeal on April 30, 2020. The Examiner issued her Denial of Applicant's Request for Reconsideration on May 21, 2020.

B. APPLICANT'S EVIDENCE

In its Request for Reconsideration filed on April 30, 2020, Applicant attached as Exhibit 1 copies of internet print-outs of third party uses of the mark SO IN LOVE for perfumes, jewelry and clothing items.

Attached as Exhibit A to this brief is a print out from the web site for Louis Vuitton at <https://us.louisvuitton.com/eng-us/homepage>.

Attached as Exhibit B to this brief is a print out from the web site for Coach at <https://www.coach.com/shop/women#prefn1=silhouette&prefv1=Apparel>.

In the Examiner's October 31, 2019 Final Office Action, the Examiner attached print-outs from both web sites for Louis Vuitton and Coach to show the relatedness of the goods. The Examiner's print-outs were not complete print-outs of the web site, and do not show all the goods offered by the web site. Applicant is offering the pages from the web sites to give a more complete understanding of the goods offered on the web sites.

II. STATEMENT OF THE ISSUES

This appeal presents the Board with the following issue: Whether a likelihood of confusion exists between Applicant's mark SOINLOVE (stylized), for goods and services in classes 14 and 35, with the Registered mark SO IN LOVE, for goods in class 3.

III. ARGUMENT

The Examining Attorney refused registration of Applicant's mark, SONINLOVE (stylized) for jewelry related goods in class 14 and services in class 35, on the grounds of a likelihood of confusion with Victoria's Secret Stores Brand Management's Registration No.

3298809 for SO IN LOVE for personal care products, namely, body mist, cream for the body, fragrant body mist, lotion for the body, perfume in class 3. Applicant respectfully disagrees that there is a likelihood of confusion between the marks and presents the arguments below in support of registration.

A. “SO IN LOVE” is a weak mark.

It is accepted that consumers are more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. TMEP 1207.01(b)(viii). Indeed, if the common element of two marks is descriptive or highly suggestive of the named goods, then consumers typically will be able to avoid confusion unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 U.S.P.Q. 74 (TTAB 1985) (COBBLER’S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes). Here, SO IN LOVE is a highly laudatory phrase, and therefore a weak formative entitled to only a narrow scope of protection.

Here, the cited mark SO IN LOVE is a laudatory and highly suggestive mark for goods such as body care products, perfume and jewelry, as the mark evokes a positive and romantic emotional response in the consumer, that of being in love. For example, perfumes are promoted by suggesting that wearing the perfume will make the wearer smell attractive and sexy, which will lead to romance and love. Thus, the mark “SO IN LOVE” reinforces the idea that the wearer will be more likely to meet the person of their dreams and be in love, since it has the very

positive connotation of a romantic feeling or sentiment. *See, In re FabFitFun, Inc.*, 127 USPQ2d 1670 (TTAB 2018) ("smokin(g) hot" is conceptually weak and at best highly suggestive for cosmetics, because "the purpose or intended result of the cosmetics offered under the marks at issue is to render the user's appearance 'smoking hot.'")

The weakness of the phrase “SO IN LOVE” is evidenced by the number of common law uses of SO IN LOVE in connection with perfume, jewelry and clothing. Under the sixth *du Pont* factor, the fact finder must consider evidence pertaining to the number and nature of similar marks in use on similar goods. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). Third-party uses of a mark are relevant to show that customers have become so conditioned by a plethora of similar marks that customers ‘have been educated to distinguish between different such marks on the bases of minute distinctions.’” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Here, the following uses of SO IN LOVE for perfume, make-up, jewelry and clothing co-exist in the marketplace:

Mark	URL
Lomani So In Love perfume	https://www.fragrancenet.com/perfume/lomani/lomani-so-in-love/eau-de-parfum?mv_pc=fragrantica&utm_campaign=348524&utm_content=top&utm_medium=affiliate&utm_source=fragrantica#348524
Bench / So In Love Matte Lipstick	https://shop.bench.com.ph/benchbeauty/beauty-lips/thl3030b.html
Institut KaritÃ Paris So In Love Shea Hand Cream	https://www.amazon.com/Institut-karit%C3%A3-Paris-Karit%C3%A9-Crema/dp/B00LHBQU64/ref=sr_1_7?dchild=1&keywords=%22so+in+love%22&qid=1588285916&s=beauty&sr=1-7
ella+mila Nail Polish, Mommy Collection - So in Love	https://www.amazon.com/ella-mila-Polish-Mommy-Collection/dp/B00MYIC1EY/ref=sr_1_9?dchild=1&keywords=%22so+in+love%22&qid=1588286019&s=beauty&sr=1-9
Persimmon Jewelry’s SO IN LOVE jewelry set	https://www.etsy.com/listing/266037609/so-in-love-jewelry-set

So In Love Diamonds By the Yard	https://poshmark.com/listing/Diamonds-by-the-Yard-Rose-Gold-Diamond-Ring-5c78a003c2e9fe95d12676e1
Bling By Faye's So In Love- silver Paparazzi jewelry	https://blingbyfaye.com/products/so-in-love-silver
So In Love Larimar-Amethyst Stone Silver Jewelry Necklace	https://www.ebay.com/itm/So-In-Love-Larimar-Amethyst-Stone-Silver-Jewelry-Necklace-/163290242624
Chvker Jewelry's So In Love Heart Choker	https://www.chvker.com/products/so-in-love-choker
BB Style Jewelry's So IN Love Heart Necklace	https://www.bbstylemiami.com/products/so-in-love-heart-necklace
AmeriMark So In Love ring	https://www.amerimark.com/jewelry/rings/so-in-love-ring/135645.html?afsrc=1&media=PAP0221&gclid=EA1aIQobChMI n5eCpICR6QIVxZFbCh3AWwXZEAQYAyABEgIiHvD_BwE&gclid=aw.ds
Novica's So In Love Pearl Garnet necklace	https://www.overstock.com/Jewelry-Watches/Handmade-Sterling-Silver-So-in-Love-Pearl-Garnet-Necklace-6-mm-Indonesia/6008069/product.html
Stephanie Deydier So In Love Open ring	https://justoneeye.com/stephanie-deydier-so-in-love-open-ring.html
So In Love !! 925 Sterling Silver Labradorite Pendant	https://www.zifiti.com/aff-detail/so-love-925-sterling-silver/30519/GS?gclid=Cj0KCQjw7qn1BRDqARIsAKMbHdaE0G_BY1fUfan0YU8RHY7Njzevdk5cy50eOMYD3mbiAJLww7HsAUaAiG4EALw_wcB
Vanessa Arizaga SO IN LOVE bracelet	https://www.venessaarizaga.com/products/so-in-love-bracelet
So In Love Diamond Heart Shaped Pendant Necklace for Women with 18 Inches Free Chain by Sparkle Bargains	https://www.amazon.com/Diamond-Necklace-Sterling-Silver-Inches/dp/B01IW1AS8C
Caroline Neron Bracelet So in love	https://www.carolineneron.com/en/bracelet-so-in-love.html
Blue Steel So In Love cubic zirconia ring in stainless steel	https://www.buybluesteel.com/products/so-in-love-aqua-red-purple-white-or-pink-solitaire-cubic-zirconia-ring-in-stainless-steel

The Sparkled Shell So In Love Swarovski Crystals Bracelet	https://www.etsy.com/listing/761272146/so-in-love-swarovski-crystals-bracelet?gpla=1&gao=1&&utm_source=google&utm_medium=cpc&utm_campaign=shopping_us_ts1-b-jewelry-bracelets-other&utm_custom1=d3d99bd4-3fa8-42c4-b753-4459a469e912&utm_content=go_1848514046_69493291603_346522582235_aud-496171762479:pla-311089094589_c_761272146&utm_custom2=1848514046&gclid=Cj0KCQjw7qn1BRDqARIsAKMbHDYAsiLrMtcXrxQgS_-avmsAp99fj5D74EukRNXYnziyPQ9Dsf_cnYwaArTnEALw_wcB
Coldwater Creek So In Love Long-Sleeve Blouse	https://www.coldwatercreek.com/shirts-and-blouses/long-sleeve-and-3%2F4-sleeve/so-in-love-long-sleeve-blouse/183110115220.html?gclid=Cj0KCQjw7qn1BRDqARIsAKMbHDbjN2pZNWyxjJtCIV3N-CBy0DubOt-nTEQH6qrfSoD-4GqZy-Wb72QaAvNjEALw_wcB&src=PGOG5001
Free People So in Love Embroidered Blouse	https://www.amazon.com/Free-People-Love-Embroidered-Blouse/dp/B07F83KJND
So In Love Maternity Graphic Tee	https://www.motherhood.com/so-in-love-maternity-graphic-tee/006-96297-012-001.html
So In Love / MM Apparel	https://teespring.com/shop/so-in-love-mm-apparel?pid=641
Shoptiques So In Love Tee	https://www.shoptiques.com/products/ya-ya-club-clothing-so-in-love-tee
Sundance So In Love Short Sleeve Top	https://www.sundancecatalog.com/product/so+in+love+short+sleeve+top.do
Bella Ella Boutique So In Love Cream Waffle Knit Top	https://bellaellaboutique.com/products/so-in-love-cream-waffle-knit-top
Pink Boutique So In Love Green Chain Print Wrap Midi Dress	https://www.pinkboutique.co.uk/products/so-in-love-green-chain-print-wrap-midi-dress
Perfectly Priscilla So In Love Sweater	https://www.perfectlypriscilla.com/products/so-in-love-sweater-white-pink
Jocelyn The So In Love Denim Vest	https://www.shopjocelyn.com/products/the-so-in-love-denim-vest
Moe & Arrow So In Love Burgundy Floral Top	https://moeandarrowboutique.com/products/so-in-love-burgundy-floral-top

See, print-outs attached as Exhibit 1 to Applicant's Request for Reconsideration filed on April 30, 2020.

Applicant has presented extensive evidence that SO IN LOVE is commonly used in connection with cosmetics, jewelry and clothing. The Federal Circuit has held that evidence of third party use of a mark, "even where the specific extent and impact of the usage has not been

established," is relevant to show that a term "may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that [term] is relatively weak," and "can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). Thus, Applicant's evidence of third party use is entitled to consideration regarding the weakness of the phrase SO IN LOVE.

All of the items being sold in Applicant's examples in the above table, perfume, make-up, jewelry and clothing items, are goods that consumers buy as sentimental or romantic gifts or to make themselves more attractive and romantic. It is therefore clear that "SO IN LOVE" is a widely adopted term because of its highly suggestive meaning. "SO IN LOVE" is therefore entitled only to a narrow scope of protection. *See, Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (evidence of third-party use is relevant to show that a term "may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that [term] is relatively weak.).

1. Applicant's evidence is relevant.

The Examiner argues that Applicant's evidence regarding third party usage of the wording SO IN LOVE, should be discounted because goods such as clothing, that the wording is used in connection with, are not as closely related to the registrant's bodycare and perfume products as applicant's jewelry goods are. *See, Denial of Applicant's Request for Reconsideration dated May 21, 2020.* However, the Examiner's evidence to support his argument that perfume and jewelry are sold under the same mark also shows that clothing items

are sold under the same brands. For example, page 4 of the Examiner's October 1, 2018 office action shows that VICTORIA SECRET offers clothing items such as lingerie besides perfume and key fobs. Furthermore, page 17 of the October 1, 2018 office action shows that MADEWELL offers clothing, perfume and jewelry. Likewise, page 26 of the Examiner's October 1, 2018 office action shows that clothing designer KATE SPADE offers clothing as well as jewelry and perfume; page 31 of office action shows that the CHARLOTTE RUSSE web site offers clothes in addition to jewelry and beauty products such as perfume; page 40 of the office action shows that the web site for CLAIRE'S offers "fashion" besides jewelry, hand lotion and body lotion; and page 50 of the office action shows that H & M offers clothing in addition to perfume and jewelry products

Likewise, on page 2 of the Oct. 31, 2019 Office Action, the print out from clothing designer CALVIN KLEIN's web site shows that women's socks, hats gloves and scarves are also sold on the web site in addition to watches, jewelry and fragrance products. The Examiner's evidence included print-outs from the famous French clothing brand LOUIS VUITTON, which also sells clothing. See, print out from <https://us.louisvuitton.com/eng-us/homepage> attached Exhibit A. Moreover, the famous brand COACH offers clothing, besides the jewelry and perfume products shown in the Examiner's exhibit. See, print-out from <https://www.coach.com/shop/women-clothing> attached as Exhibit B. Finally, on page 56 of the Oct. 31, 2019 Office Action, the Examiner included a print out of the clothing design Tory Burch's web site, which clearly shows at the top that clothing is also sold by the brand, besides jewelry and perfume products.

Accordingly, if the Examiner's evidence is accepted to show that perfume and jewelry products are related, then it also shows that clothing is related to perfume and jewelry. Thus,

Applicant's table showing use of SO IN LOVE in connection with make-up, perfume, jewelry and clothing is sufficient to show the general weakness of the wording SO IN LOVE for such products.

B. The Examiner's evidence does not support a finding that Applicant's goods and services and Registrant's goods are sold under the same mark.

The relatedness of the goods or services as described in the application and registration(s) is a key factor in a likelihood of confusion analysis. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976). Similarity of marks needed to prove likelihood of confusion will vary with the difference in the goods and services between marks. J. McCarthy, *Trademarks and Unfair Competition* § 23:20.5 (4th ed. 2008). For goods and services that are directly competitive, the degree of similarity necessary to prove a likelihood of confusion is less than in the case of dissimilar products. *Id. citing In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed. Cir. 2010) (When the conflicting marks appear on virtually identical goods or services, less similarity is needed for likely confusion to occur.). However, if the associated goods and channels of trade are sufficiently different, then there is no likelihood of confusion, even if the marks are identical. *See, In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015) ("the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers supports the conclusion that applicant's mark TERRAIN for "recreational vehicles, namely, towable trailers" is not likely to cause confusion with the mark TERRAIN for "motor land vehicles, namely, trucks.").

Moreover, the examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish

that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). When the relatedness of the goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.*, 774 F.3d 747, 754 (Fed. Cir. 2014) (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness).

1. The Examiner's evidence does not support a finding that goods in class 14 are offered under the same mark as goods in class 3.

The TTAB has previously held that there is no per se rule that jewelry is related to cosmetic products. *See, In re Deutsche Calypsolgesellschaft Mbh & Co.*, 220 U.S.P.Q. 922 (T.T.A.B 1983). Here, the Examiner argues that Applicant's goods are related to Registrant's because goods such as jewelry and perfume are commonly provided by the same entity under the same mark and travel in the same channels of trade. Applicant respectfully disagrees. The Examiner's evidence shows that jewelry and perfumes are offered under different marks, even if offered by the same entity. For example, Victoria's Secret is not offering its key chain under the mark SO IN LOVE. In fact, the examiner's evidence shows that Victoria's Secret offers scented products such as fragrance lotions under different marks than its key chains. Likewise, Madewell offers its fragrance products under the mark BON PARFUMEUR, but does not offer earrings under the same mark. Similarly, Kate Spade offers perfumes under the marks IN FULL BLOOM and WALK ON AIR, but there is no evidence that Kate Spade offers jewelry under the marks IN FULL BLOOM or WALK ON AIR. Calvin Klein's watches and jewelry are offered under

names such as REBEL or SEDUCE, while its perfume is offered under the names ETERNITY and OBSESSED. Similarly, Louis Vuitton, Coach and Tory Burch's jewelry and watches are offered under different names than the perfume product names. Accordingly, the Examiner's evidence shows that consumers are used to seeing jewelry, watches and perfume products offered under different product names.

Just because jewelry and perfume products are both offered by clothing designers, or are sold on the same store web site does not mean the goods are sufficiently related that consumers will expect that SOINLOVE jewelry is offered by the same entity as SO IN LOVE body care and perfume products. That is like reasoning that because Target offers garden products and toothpaste on the same website, the goods are related. Instead, the Examiner's evidence actually shows that while perfume, body care products, jewelry and watches may be sold on the same web site, they are generally offered under different brands. It would be different if Applicant's mark was confusingly similar to a famous designer mark such as KATE SPADE, CALVIN KLEIN, or COACH. Both the registered mark SO IN LOVE, and Applicant's mark SO IN LOVE, however, are not references to a famous designer brand. Instead, as shown by Applicant's evidence, SO IN LOVE is a highly suggestive and weak phrase.

The Examiner's evidence therefore does not support a finding jewelry and body care products are often promoted under the same mark. Accordingly, there is no likelihood of confusion between the co-existing uses of Registrant's mark and Applicant's mark for the associated goods. *See, Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusing similar to LIQUID PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field).

2. The Examiner’s evidence does not support a finding that Applicant’s services in class 35 are offered under the same mark or related to products in class 3.

The Examiner argues that printouts from Charlotte Russe, H & M and Claire’s, establishes that the same entity commonly provides perfume or body lotion as well as online shopping services for jewelry under the same mark, the relevant goods and services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and the goods and services are similar or complementary in terms of purpose or function. Applicant respectfully disagrees. Instead, the evidence shows that retail store services are offered under different brands. For example, in the Examiner’s evidence, retail store services are offered under the marks CHARLOTTE RUSSE, H & M AND CLAIRE’S, while jewelry products and perfumes are offered under different marks. For example, the Charlotte Russe web site offers Refuge perfume, and Roayl Citron Eau deToilette., See, pp. 37-39 of October 1, 2018 office action. The Claire’s web site offers Cat Hand Lotion and Unicorn Hand Lotion. See, pp. 41-42 of October 1, 2018 office action. Finally, H& M’s web site also shows perfume products sold under different brands than H&M. For example, on page 52 of the October 1, 2018 office action, the perfumes have names such as “Way Past Midnight.”

C. SO IN LOVE and SOINLOVE (stylized) are sufficiently different in appearance to avoid a likelihood of confusion.

Finally, given the inherent weakness in the mark SO IN LOVE, the differences between the cited mark and Applicant’s mark SOINLOVE (stylized) are sufficient to avoid a likelihood of confusion. First, the marks are different in appearance, as Applicant’s mark is a combined term, in a stylized font. Second, the fact that Applicant’s mark is a combined term means that

consumers may not pronounce Applicant's mark the same as SO IN LOVE. Instead, they are likely to pause and consider the mark to determine its sound and meaning.

Because Applicant has shown there is no likelihood of confusion between Examiner's cited registered marks and Applicant's mark, Applicant respectfully requests that its application be approved for publication.

D. Amendment to the Identification of Goods and Services.

The Examiner also requested that the identification of goods and services be further clarified. The Applicant accepts the Examiner's suggested amendment, namely:

Class 14: Precious metals and their alloys; Goods in precious metals or coated therewith, namely, jewelry charms; Jewelry; Precious stones; Semi-precious stones; Gemstones; Pearls; Jades; Diamonds; Rubies; Sapphires; Emeralds; Horological and chronometric instruments; Clocks; Watches; Jewelry charms made of precious metal or precious stones; Trinkets of precious metals and stones in the nature of jewelry, namely, rings, earrings, bracelets, brooches and necklaces; Trinkets, namely, precious metal key rings and decorative fobs for key rings; Goods in precious metal, namely, figurines, statues and statuettes; Goods primarily of precious metal, namely, figurines, statues and statuettes, all coated in precious metal; Hat ornaments of precious metal, namely, hat jewelry; Beads for making jewelry made of precious metal or precious stones; Trinkets and fobs, namely, key rings made of precious metal or precious stones; Trinkets and fobs, namely, key chains made of precious metal or precious stones; Silver thread jewelry; Silver, unwrought or beaten; Cases for jewelry;

Class 35: Retail and wholesale distributorship services featuring precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and

chronometric instruments, clocks, watches, and cases for jewellery; import and export agency services relating to precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewellery; advertising and promotion services for of precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewellery; Franchising services, namely, offering business management assistance in the establishment and operation of commercial enterprises in the nature of retail and wholesale distributorship enterprises and import and export agency enterprises featuring precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi- precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewelry; Providing advice and consulting services relating to retail and wholesale distributorship, import and export agency, advertising and franchising services relating to precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewelry; Organization and conducting of exhibitions, trade fairs and fashion shows for commercial or advertising purposes; Sales promotions for others; Auctioneering; Advertising services; Business management; Business administration; Office functions; Providing office functions; Presentation of goods on communication media, namely, providing television, computerized and online shopping services in the nature of an online shopping site in the field of

precious metals and their alloys and goods in precious metals or coated therewith, jewelry, precious stones, semi-precious stones, gemstones, pearls, jades, diamonds, rubies, sapphires, emeralds, horological and chronometric instruments, clocks, watches, and cases for jewelry

IV. CONCLUSION

The cited mark SO IN LOVE is a diluted and weak term, as shown by Applicant's evidence. The mark is therefore entitled to a narrow scope of protection. Moreover, the Examiner's evidence does not support a finding that body products, perfume and jewelry are often offered under the same mark. Likewise, there is no evidence that perfume and services in class 35 are offered under the same mark. Accordingly, there is no likelihood of confusion between SO IN LOVE for body lotion and perfume in class 3, and SOINLOVE (stylized) for jewelry products and services in class 35.

Respectfully submitted,

Date: July 27, 2020

_____/djm/_____

By: Diane Mason
Attorney for Chow Tai Fook Jewellery Company
Limited

EXHIBIT A

LOUIS VUITTON

NEW WOMEN MEN ART OF LIVING MAGAZINE

Search 'Summer Staples' here

- Gifts for Women
- The Essentials
- Handbags
- Small Leather Goods
- Travel
- Fragrances
- Accessories
- Shoes
- Ready-to-Wear**
- Jewelry
- Watches
- Personalization
- Fashion Shows

- View by Look
- Must-Haves and Essentials
- Spring Edits
- All Ready-to-Wear
- Leather Collection
- Coats and Jackets
- Dresses
- Tops
- Knitwear
- Pants
- Skirts and Shorts
- Denim Collection
- Swimwear



EXHIBIT B

FILTERS [CLEAR](#)

169 Products

SORT BY: Best Matches ▾

Categories (1)

- Apparel
- Bags
- Bag Charms
- Bag Straps
- Belt
- Briefcases
- Cold Weather
- Cosmetic Cases
- Desk
- Fragrance
- Jewelry
- Key Rings
- Outerwear
- Pet
- Pouches
- Product Care
- Scarves
- Shoes

APPAREL X



Rainbow Signature T-Shirt

\$95



Rainbow Signature Rexy T-Shirt

\$95



Rainbow Rexy And Carriage T-Shirt

\$95



Rexy And Carriage T-Shirt

\$150