

ESTTA Tracking number: **ESTTA813098**

Filing date: **04/12/2017**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Kadine SPRL		
Entity	Corporation	Citizenship	Belgium
Address	Chaussee De Waterloo 950 Bruxelles, BELGIUM		

Correspondence information	Jeff Liebenson Liebenson Law 411 Lafayette St, 6th Floor New York, NY 10003 UNITED STATES jeff@liebensonlaw.com Phone:9175923262
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Applicant Information

Application No	87003369	Publication date	03/14/2017
Opposition Filing Date	04/12/2017	Opposition Period Ends	04/13/2017
Applicant	Aumnie Hong Kong Limited 99 Wellington Street Central Hong Kong, HONG KONG		

Goods/Services Affected by Opposition

Class 025. First Use: 2012/00/00 First Use In Commerce: 2012/00/00 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts (based on use); Jackets, T-shirts, Dress Shirts, Jeans, pants, dresses, shorts, blouses, sweaters, skirts and sweatshirts (based on intent to use)
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ESSENTIEL		
Goods/Services	#Clothing, namely, trousers, pants, shirts, sweaters, t-shirts, coats, jackets, blazers, skirts, dresses, tops, ponchos, raincoats, scarves, belts; footwear, namely, sandals, boots, half boots, heels; headgear, namely, hats, caps, scarves#.		

Attachments	Kadine Opposition SSENTIEL .pdf(492865 bytes)
Signature	/Jeffrey M. Liebenson/
Name	Jeff Liebenson
Date	04/12/2017

Explanation of grounds

The company **Aumnie Hong Kong Limited** (hereinafter referred to as the "**Applicant**") has filed the word United States trademark application "**SENTIEL**" no.87003369 on April 16th, 2016, for the following goods in class 25:

"Athletic apparel, namely, shirts (based on use); Jackets, T-shirts, Dress Shirts, Jeans, pants, dresses, shorts, blouses, sweaters, skirts and sweatshirts (based on intent to use)".

(Exhibit 1)

The company **KADINE SPRL**, (hereinafter referred to as the "**Opponent**") owns several trademarks composed of the word "**ESSENTIEL**" alone and/or with other verbal and/or figurative elements, notably:

- the international word trademark "**ESSENTIEL**" no. 780041 registered on March 04th, 2002 for goods in classes 18 and 25 as follows:

- o **Class 18:** "handbags";
- o **Class 25:** "clothing and shoes";


(Exhibit 2)

- the international word trademark "**ESSENTIEL ANTWERP**" no. 1311137 for United States, registered on April 14th, 2016 for notably the following goods in class 25:

"Clothing, namely, trousers, pants, shirts, sweaters, t-shirts, coats, jackets, blazers, skirts, dresses, tops, ponchos, raincoats, scarves, belts; footwear, namely, sandals, boots, half boots, heels; headgear, namely, hats, caps, scarves".

(Exhibit 3)




- the international figurative trademark "  " no.0843032 for United States registered on August 25th, 2004 for notably the following goods in class 25:

“Clothing, namely, men's, ladies' and children's jerseys, sweaters, shirts and T-shirts, trousers, shorts, slacks, jackets, coats, skirts, dresses, belts, scarves; ties, gloves, socks, hosiery, sleepwear, footwear, hats, caps and ear muffs”.

(Exhibit 4)

Therefore, the request of the Opponent is based on the following trademarks (hereafter referred to as the: **“Prior Kadine’s Trademarks”**):



- the international figurative trademark "  " no.0843032 for United States registered on August 25th, 2004;
- the international word trademark **“ESSENTIEL ANWERP”** no. 1311137 for United States, registered on April 14th, 2016.

According to the Lanham Act, 15 U.S.C. § 1052(d):

“Trademarks registrable on the principal register; concurrent registration

No 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:

(...)

d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons”.

According to the Lanham Act, 15 U.S.C. § 1063:

“Opposition

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

(b) Unless registration is successfully opposed —

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.”

The court listed the principal factors to be considered when determining whether there is a likelihood of confusion under the Lanham Act, 15 U.S.C. § 1052(d) (*In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A) 1973).

However, not all of the factors are necessarily relevant or of equal weight, and any factor may be dominant in a given case, depending upon the evidence of records (*In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567).

In our case, the following factors are the most relevant:

- the similarity of the goods of the Prior Kadine’s Trademarks and those included in the United States word trademark application "**SSENTIEL**" no. 87003369 **(I)** ;
- the similarity of the United States trademark "**SSENTIEL**" no. 87003369 with the Prior Kadine’s Trademarks for United States **(II)**.

Therefore, as it is developed below, and according to the Article 15 of the US CODE § 1052, the Trademark Trial and Appeal Board (hereinafter referred to as the "**Board**") shall reject the registration of the United States trademark application "**SSENTIEL**" no. 87003369 for all the goods designated.

I- Comparison of the goods

The opposition request is made against the entire US trademark application "**SSENTIEL**" no. 87003369 and more precisely against the following goods in class 25:

"Athletic apparel, namely, shirts (based on use); Jackets, T-shirts, Dress Shirts, Jeans, pants, dresses, shorts, blouses, sweaters, skirts and sweatshirts (based on intent to use)".

As it is summed up in the table below, these goods of the contested US trademark application "**SSENTIEL**" no. 87003369 are identical or at least similar to those of the Prior Kadine's Trademarks on which the opposition relies on.

Prior Kadine's Trademarks « <i>ESSENTIEL ANTWERP</i> »	Application for the trademark « <i>SSENTIEL</i> » no. 87003369	Analysis
<i>men's, ladies' and children's jerseys</i>	<i>Athletic apparel, namely, shirts (based on use)</i>	These goods are identical or similar
<i>shirts and T-shirts</i>	<i>T-shirts; blouses</i>	These goods are identical or similar
<i>jackets</i>	<i>Jackets</i>	These goods are identical
<i>Dresses, tops</i>	<i>Dress Shirts, blouses, dresses</i>	These goods are identical or similar
<i>shorts</i>	<i>shorts</i>	These goods are identical
<i>sweaters</i>	<i>sweaters</i>	These goods are identical
<i>skirts</i>	<i>skirts and sweatshirts (based on intent to use)"</i>	These goods are identical or similar
<i>trousers, pants, slacks</i>	<i>Jeans, pants</i>	These goods are identical or similar

The comparison of the goods of the contested trademark «*SSENTIEL*» no. 87003369 with goods in class 25 of the Prior Kadine's Trademarks reveals that the goods of the former are identical or at least similar to the goods of the latter in the same class.

Therefore, the Board must consider that goods of the contested trademark are identical or at least similar to the goods of the prior trademark.

II- The similarity of signs

The following signs are to be compared:

Prior Kadine's Trademarks « <i>ESSENTIEL ANTWERP</i> »	Application for the trademark « <i>SSENTIEL</i> » no. 87003369
<div data-bbox="375 510 598 616" data-label="Image"> </div> <p data-bbox="188 656 790 750"><i>international figurative trademark no.0843032 for United States registered on August 25th, 2004</i></p> <p data-bbox="316 864 667 898">“ESSENTIEL ANTWERP”</p> <p data-bbox="188 936 790 1003"><i>international word trademark no. 1311137 for United States, registered on April 14th, 2016</i></p>	<p data-bbox="1043 725 1190 759">SSENTIEL</p>

According to the Board rulings, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression (*In re Viterro Inch*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du pont de Nemours & Co*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v)).

Similarity in any one of these elements may be sufficient to find the marks confusingly similar (*In re White Swan Ltd*, 8 USPQ2d 1534, 1535 (TTAB 1983); see *In re In USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)).

As demonstrated below, the marks are visually, aurally and conceptually similar.

(i) Visual comparison

The Board reminds frequently that it is not improper to give more or less weight to a particular feature of a mark (*See In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed.Cir.1985)).

Indeed, it has been established by the Board that an ordinary design element or a generic term is insufficiently distinctive to create a different commercial impression (*In re Dixie Restaurants, Inc.* 105 F.3d 1405 (U.S. Court of Appeals, Federal Circuit 1997).


More precisely, the Board has considered in this case that:

“Indeed, as the board found, the design is an ordinary geometric shape that serves as a background for the word mark.

The identity of the dominant portion of Dixie's mark and the registered mark is especially important in the restaurant industry "because restaurants are often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant's mark which is more likely to be impressed on the consumer's memory." *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed.Cir.1983)”.


In our case, the request is based on the following trademarks:



- the international figurative trademark "  " no.0843032 for United States registered on August 25th, 2004;
- the international word trademark “**ESSENTIEL ANTWERP**” no. 1311137 for United States, registered on April 14th, 2016.

Theses prior trademarks are composed of the verbal elements “**ESSENTIEL ANTWERP**” and one of these of the figurative element which represents a crown.

The verbal element “**ANTWERP**” does not constitute a distinctive element since ANTWERP is a town in Belgium.

Moreover, the figurative element of the the international figurative trademark "  "

is not visible at first glance because the verbal element “**ESSENTIEL**” is reproduced in capital letter.

Finally, it has to be stressed out that the Opponent owns numerous trademarks all around the world only composed of the word “**ESSENTIEL**”, which indicates that the verbal element “**ESSENTIEL**” is the distinctive element of the KADINE’s trademarks.

Therefore, in our case the terms to be compared are the following:

Prior Kadine’s Trademarks « ESSENTIEL ANTWERP »	Application for the trademark « SSENTIEL » no. 87003369
ESSENTIEL	SSENTIEL

In the present case, both numerous similarities stand out, such as:

- **The similarity of the letters:** 8 letters which composes the trademark application are all included in our client’s prior trademarks in the strictly same order, namely “**S**”, “**S**”, “**E**”, “**N**”, “**T**”, “**I**”, “**E**”, “**L**”;

- **The similarity of the font:** both signs are written in capital black letters with no specific font.

Consequently, the sole difference between the signs is the suppression of the letter “**E**” in attack in the trademark application. Therefore, the overall impression remains very similar.

This fact is not capable of invalidating the visual similarities created by the reproduction of 8 letters of the Kadine’s trademark in the same order.

In this respect, the Board rules on a regular basis that the removal of a letter or a syllable and/or the adjunction of a letter or a syllable is not sufficient to prevent from a likelihood of confusion between two similar signs.

For instance, the following signs have been considered similar:

-  and “**Espacenet**” (*Commissioner for Patents and Trademarks, us-wo-1176016-p, October 21th, 2013, Spacenet and Gte Spacenet vs. Europäische Patentorganisation*);
-  and “**Powernap**” (*Commissioner for Patents and Trademarks, us-wo-1163591, August 26th 2013, Jetlog and Pownaps Retail Concepts vs GN NETCOM and GN NETCOMGN Audio*);
- “**LASHCARE**” and “**ILASHARE**” (*Trademark Trial and Appeal Board, uspto-ex-85152005-no, April 03th, 2013*).

In this regard, the Board must consider that the Prior Kadine’s Trademarks and the contested trademark “SSENTIEL” are visually similar on an extremely high degree.

(ii) Aural comparison

The verbal elements “**ESSENTIEL**” and “**SSENTIEL**” are aurally similar.

The prior trademark is composed of three syllables [ai] [san] and [ciel].

It has to be stressed out that if the public pronounces the application trademark by decomposing the verbal element “**SSENTIEL**” as “**S**” “**SENTIEL**”, the pronunciation is also composed of three syllables [ès] [san] and [ciel] which are similar of the prior trademark “**ESSENTIEL**”.

Moreover, slight differences in the sound of similar marks will not avoid a likelihood of confusion (*In re Energy Telecomm. & Elec. Ass’n, 2.22 USPQ 350,351 (TTAB 1983)*; see *In re Viterra Inc., 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012)*).

Finally, in our case there is no correct pronunciation of the trademarks because it is impossible to predict how the public will pronounce the particular marks “**ESSENTIEL**” and “**SSENTIEL**” which have no meaning in English (*See In re Vierra Inc., 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012)*; *Centrazlna’us. Inc. v. Spartan Chem. Ca, 77 USPQ2d 1698, 1701 (TTAB 2006)*; *TMEP §1207.1)1(b)(iv)*).

Therefore, the trademarks in question could clearly be pronounced the same way, which creates a likelihood of confusion.

In this regard, the Board must consider that the Prior Kadine's Trademarks and the contested trademark "SSENTIEL**" are phonetically similar.**

(iii) Conceptual comparison

The signs are conceptually identical to the extent that the relevant public will associate with nothing.

"**ESSENTIEL**" has no particular meaning in English but looks like the word "**ESSENTIAL**", such as the term "**SSENTIEL**".

Thus, "**ESSENTIEL**" will be seen by the American public as a distinctive trademark.

The assessment of the likelihood of confusion indicates that the aural, visual and conceptual identity are certain and capable to suggest to the public that the trademarks are economically linked.

"ESSENTIEL" and "SSENTIEL" are visually, phonetically and conceptually similar.

The similarities between the trademark «SSENTIEL» no. 87003369 and the Prior Kadine's Trademarks are obviously preventing the prior trademark from guaranteeing the identity of origin of the marked goods.

CONCLUSION

In regard of the above considerations, the contested trademark must be considered as raising a likelihood of confusion in the consumer's mind.

The global assessment test of the Board, according to *In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A) 1973, implies interdependent factors to be taken into account and notably the similarity of signs and products.

In the present case, not only the signs are closely similar, but the goods of the contested Trademark are to be considered as identical or at least as very similar to the goods of the Prior Kadine's Trademarks.

For all these reasons, the Opponent considers that the Prior Kadine's Trademarks and "**SSENTIEL**" cannot guarantee the essential function of a trademark and especially, the indication of origin. "**SSENTIEL**" would prevent the Prior Kadine's Trademarks from being capable of distinguishing its goods.

Therefore, the Opponent asks for the total refusal of registration of trademark «SSENTIEL» no. 87003369 in the United States.

EXHIBITS

Exhibit 1: United States application "**SSENTIEL**" no.87003369 filed on April 16th, 2016


Exhibit 2: International word trademark "**ESSENTIEL**" no.780041 registered on March 04th, 2002

Exhibit 3: International word trademark "**ESSENTIEL ANTWERP** " no.1311137, for United States of America registered on April 14th, 2016

E S S E N T I E L



Antwerp

Exhibit 4: International figurative trademark "  *Antwerp* " no.0843032, for United States of America registered on August 25th, 2004