

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

MAY 1, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Andre Romanelli, Inc.**

Serial No. 74/**692,688**

Myron Amer of Myron Amer, P.C. for Andre Romanelli, Inc.

Katherine Stoides, Trademark Examining Attorney, Law Office
109 (Deborah S. Cohn, Managing Attorney).

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 23, 1995, applicant filed an application to register the mark "MARIO RINALDI" on the Principal Register for "men's clothing, namely, suits, pants, jackets, coats, rainwear, shirts, ties and sweaters," in Class 25. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark on these goods in commerce.

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's mark,

if it were to be used in connection with the goods set forth in the application, would so resemble the mark shown below,

The image shows a handwritten signature in a cursive script. The word 'Rinaldi' is written in a fluid, connected style. The 'R' is large and loops back to the left. The 'i' at the end has a small dot and a tail that loops back to the left.

which is registered¹ for "women's shoes," that confusion would be likely.

The Examining Attorney also required applicant to submit either a statement that the mark is not the name of a living individual, or, if this is not the case, a consent from the named individual to applicant's registration of his name.²

Applicant responded with argument and evidence in support of registration. The evidence was a copy of a page from the Manhattan telephone directory listing twenty-eight individuals whose surname is "Rinaldi." Applicant argued that this evidence shows that the name sought to be registered does not identify a couturier, but rather, is a common surname.

¹ Reg. No. 678,511, issued to Shwartz & Benjamin, Inc. on May 12, 1959, and renewed in 1979.

² Although applicant did not satisfy this requirement until after the appeal had commenced, applicant's statement that it does not know of a living individual whose name is "Mario Rinaldi" has been entered into the record.

The Examining Attorney was not persuaded to withdraw the refusal, and in the second Office Action, she made final the refusal under Section 2(d).

Applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing.

After careful consideration of the record and arguments in this case, we have determined that the refusal under Section 2(d) is well taken. Our analysis of the issue of likelihood of confusion in this case involves the two most basic factors identified in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563(CCPA 1973), the similarities between the marks and the commercial relationship between the goods set forth in the application and those specified in the cited registration.

Applicant argues that the marks are not so similar that they would be likely to cause confusion, especially in light of the differences between the goods. Applicant further contends that "MARIO RINALDI" would not be abbreviated as "RINALDI" alone; that applicant's mark is no more likely to cause confusion than are two other registered marks, "MARINA RINALDI" for "large size outer clothing for women,"³ or "AS I GOT OLDER, I GOT BETTER. CIAO! FRANCESCA RINALDI"

³ Reg. No. 1,563,440, issued to Max Mara Fashion Group S.R.L. on October 31, 1989;

for t-shirts,⁴ in view of the differences in commercial impression that these marks create; and that men's apparel and women's shoes, although all clothing items, are "not clearly associated with each other." (brief, p.4).

None of applicant's arguments persuades us that confusion is not likely in this case. To the contrary, we hold that confusion is likely because applicant's mark makes a commercial impression which is quite similar to that of the cited registered mark, and the goods with which applicant intends to use its mark are related to the goods set forth in the registration.

At the heart of our ruling is our conclusion that the ordinary consumers who are the potential purchasers of the kinds of clothing items specified in the application and the registration, respectively, are likely to confuse these marks because someone who is familiar with either one of them who then encounters the other is likely to assume that they are simply two variations of the same mark, one the complete name, and the other just the surname, but nonetheless that both indicate source in the same entity. As the Examining Attorney points out, in the clothing field, it is not unusual for designers to use as trademarks either their complete names, such as "Pierre Cardin" or "Giorgio

⁴ Reg. No. 1,600,957, issued to Constantino Foods, Inc. on October 31, 1988.

Armani," for example, or simply their surnames, i.e., "Cardin" or "Armani."

As noted above, applicant introduced telephone directory evidence upon which was based the contention that "Rinaldi" is a common surname, rather than the name of a couturier. We fail to see how twenty-eight entries in the Manhattan directory even relate to the question of whether there is a fashion designer known as either "Mario Rinaldi" or "Rinaldi." In any event, that the record does not establish that either this particular applicant or this particular registrant is a designer enterprise which engages in the practice of using both a long version and a short version of the designer's name is of no particular consequence. Consumers who are familiar with the fact that in the clothing field, sometimes both versions of a name are used, would understand "Rinaldi," in the script form shown in the drawing, as a shortened version of the full name, "Mario Rinaldi." Perhaps the registered mark would be perceived as the signature of such person. It might even be assumed that Mario Rinaldi uses the script version of his surname on his menswear, while he uses his full name on his line of women's shoes. In any event, it is likely that consumers would assume a common source for goods bearing these two marks as long as the goods in question are commercially related.

Further, we are not persuaded by applicant's argument concerning the third-party registrations which allegedly coexist without confusion. These two registrations are for marks which clearly differ in commercial impressions.

"MARINA RINALDI" is simply a woman's complete name. "AS I GOT OLDER, I GOT BETTER. CIAO! FRANCESCA RINALDI" combines the name of a clearly different woman with a slogan about being older. Confusion may not be likely when the marks consist of or include the complete names of people who have the same surname, but different given names, especially when one of the names is accompanied by a distinctive slogan. In the case at hand, however, as discussed above, the situation is quite different. These two names could easily be understood to refer to the same individual.

The second factor mentioned above is the relatedness of the goods, and, as we indicated there, we hold that the products at issue in this case are related in such a way that confusion would be likely if these similar marks were used on both registrant's goods and the goods specified in the application. Contrary to applicant's contention that women's shoes and the men's clothing items specified in the registration are "not clearly associated with each other," these goods are plainly related. Many of the same designers and makers of women's apparel, including shoes, also market men's clothing and shoes. Both types of goods move through

Ser No. 74/692,688

the same channels of trade to the same ordinary consumers, who use them for similar purposes. Men purchase clothing for women as well as for themselves, and women buy clothing not just for themselves, but for men as well. To take the position that these products are not commercially related ignores the reality of the marketplace in the United States today.

In the absence of evidence to the contrary, we must agree with the Examining Attorney that these goods are related, and that the use of these similar marks in connection with them would likely lead to confusion. Accordingly, the refusal to register under Section 2(d) of the Lanham Act is affirmed.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark Judges
Trademark Trial & Appeal Board

Ser No. 74/692,688