

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 8, 00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gianfranco De Paoli Ambrosi

Serial No. 75/171,483

Request for Reconsideration

Jess M. Collen of Collen Law Associates for Gianfranco De Paoli Ambrosi.

Judy Grundy, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Walters, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Gianfranco De Paoli Ambrosi has requested reconsideration of the Board's decision of April 4, 2000 in which we affirmed the Trademark Examining Attorney's refusal to register the term "SYNCHROLINE"¹ because it was likely to be confused with the registered mark, "SYNCHRO SERUM," as applied to identical and closely-related skin care and cosmetic products.

¹ Serial No. 75/171,483, filed on September 20, 1996, based upon a *bona fide* intention to use the mark in commerce, and pursuant to Section 44(e) of the Lanham Act, based upon Italian Reg. No. 547,123, which registered on July 4, 1991.

Applicant bases this request for reconsideration on the grounds that it never received a copy of the Trademark Examining Attorney's appeal brief, and because the Board misapplied the law to the facts of the case.

In the normal course of Office practice, a copy of the Trademark Examining Attorney's appeal brief of May 20, 1999 would have been mailed to applicant at the correspondence address as listed, consistent with 37 C.F.R. §2.142. However, sometime between the filing of this application in September 1996 and applicant's response of October 1997, counsel changed his mailing address. The mere transmittal of a response to an Office Action bearing a new address for applicant's attorney does not result in a change in a correspondence address unless there is a written request by the applicant or his or her representative to do so. See 37 C.F.R. 2.18, TMEP §603. Accordingly, it appears from the computerized labels that the Trademark Examining Attorney's brief was sent to applicant's counsel in care of the McGlew & Tuttle firm. In fact, to this very day, that remains the correspondence address for this application in the Office's computerized database.

However, we note that applicant's appeal brief was filed with the U.S. Patent and Trademark Office on December 28, 1998, and the case file was forwarded on to the Trademark Examining Attorney by an order of the Board on March 23, 1999, setting in

motion the sixty day period in which the Trademark Examining Attorney's written brief was due. Given backlogs at the Trademark Trial and Appeal Board, the decision issued more than ten months after this responding brief was submitted. Hence, even if the Office did fail to mail a copy of the Trademark Examining Attorney's appeal brief to applicant at counsel's new address, it was sixteen months after applicant filed its appeal brief until this final decision issued. If this pending application were still alive, and the Office had decided not to file a brief, applicant should have expected to receive a communication from the Board, a further Office action, a telephone call, or even a notice of publication. In any case, applicant has a responsibility to monitor pending trademark applications with due diligence. Inquiries regarding the status of pending matters should be made within twelve months of the filing or receipt of any document for which further action by the Office is expected. See TMEP §413. Undeniably, if a copy of the Trademark Examining Attorney's brief was not received by applicant, and no due diligence inquiry was made, applicant did lose the opportunity to file a reply brief and/or request an oral hearing². However, many applicants do not avail themselves of these procedural steps in any event.

² Logically, if appellant was still waiting for the Trademark Examining Attorney's brief, it could not be expected to know time was

We turn now to the substance of applicant's request for reconsideration. Applicant argues that the Board incorrectly applied the law to the facts at hand. Specifically, applicant charges that the Board, in our decision of April 4, 2000, impermissibly dissected the mark. However, throughout the prosecution of this application, applicant has taken the position that prospective purchasers would parse this coined mark as "Syn·chroline" or "Synch·roline" (rather than as "Synchro·line") because "... it is visually quite difficult to extract the "Synchro" portion of the mark." (Applicant appeal brief, unnumbered p. 3). We simply disagreed with applicant's assertion for the reasons stated in that decision.

As to the third-party marks in International Class 3, applicant takes the position that the prefix herein is weak in the field of cosmetics and toiletries, and has repeatedly cited to four trademarks -- SYNCHRON, LIP SYNCH, SYNCHRO-CLIK AND COLOR SYNC. The conclusion in the penultimate paragraph of the decision of April 4, 2000 contained the following language:

"Finally, of the one or two marks having the two syllables "-syn·chro-" somewhere within the mark, (where the marks are used on cosmetics or toiletries), these marks are different from

running to file a reply brief. Further, if applicant desires an oral hearing, that request must be filed within ten days after the due date for a reply brief. However, applicant can always make a request for an oral hearing at an earlier date in the appeals process.

applicant's mark and from registrant's mark in overall appearance and connotation."

In so stating, we were essentially narrowing applicant's list of four other third-party marks to two - SYNCHRON and SYNCHRO-CLIK - both of which begin with the same seven letters as do registrant's cited mark and applicant's applied-for mark.³ Upon further reconsideration, this does not appear to be a mistake. Whenever an applicant makes the argument that its mark should be registered given the weakness of a mark, it is logical and entirely appropriate under the law to observe, if true, that the other third-party marks could more easily co-exist on the registry with registrant's mark without a likelihood of confusion than is the case with applicant's mark.

For the reasons stated herein, we stand by our earlier decision affirming the refusal to register in this case on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.

C. E. Walters

D. E. Bucher

³ By contrast, LIP SYNCH begins with the word LIP and then shares a five-letter string with the two marks at issue herein, while COLOR SYNC begins with the word COLOR and then shares only a four-letter string with the two marks at issue.

Serial No. 75/171,483

C. M. Bottorff

Administrative Trademark Judges,
Trademark Trial and Appeal Board