

RESPONSE TO OFFICE ACTION

The following remarks are in response to an Office Action dated January 21, 2016, which issued in connection with Applicant's application for the mark CLICK2CLOSE, U.S. Serial No. 76/718,805, for use in connection with "customer relationship management in the flooring and carpeting industry" in International Class 035.

The Examining Attorney has requested that Applicant clarify whether the CLICK2CLOSE mark is presented in standard characters or in a special form drawing format. Applicant respectfully submits that the subject application was filed through the traditional paper method during the USPTO e-filing outage that occurred on December 23, 2015. Therefore, even though the mark appears as though it is stylized, the Application is for CLICK2CLOSE in standard characters. Applicant has submitted the requested language clarifying the same, namely, "the mark consists of standard characters without claim to any particular font, style, size or color."

The Examining Attorney has also refused registration of Applicant's trademark based on a finding of a likelihood of confusion with Registration No. 4405044 for the mark CLICK2SALE (and Design) ("Cited Registration"). Applicant respectfully disagrees with the Examining Attorney as the Cited Registration differs in appearance, sound, connotation, and commercial impression, and is offered in connection with different services than Applicant's CLICK2CLOSE mark. Therefore, there is no likelihood of confusion.

1. Applicant's Mark is Not Confusingly Similar to the Cited Registration

Applicant respectfully disagrees with the Examining Attorney's refusal and requests that the Examining Attorney reconsider and withdraw this refusal because there is no potential likelihood of confusion between Applicant's trademark, CLICK2CLOSE, and the Cited Registration, CLICK2SALE (and Design).

The Examining Attorney fails to apply the rule that the marks must be considered in their entireties as to appearance, sound, connotation, and commercial impression, rather than dissected into component parts for comparison purposes. See, *Recot, Inc. v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000) (reversing the TTAB decision for improperly dissecting conflicting marks to determine whether the commercial impression of the marks was confusing); *Estate of Beckwith*,

Inc. v. Comm'r of Patents, 252 U.S. 538, 545–46, (1920) (holding that the commercial impression is derived from a mark as a whole, not from its elements separated and considered in detail). Additionally, and contrary to the Examining Attorney’s analysis, it is well settled that two or more trademarks may share common terms without causing consumer confusion. See, e.g., *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2005) (finding no likely confusion between the identical marks RITZ for kitchen textiles, owned by a registrant, and RITZ for cooking and wine selection classes, owned by an applicant); *Citigrp., Inc. v. Capital City Bank Grp., Inc.*, 94 U.S.P.Q.2d 1645 (T.T.A.B. 2010) (precedential) (dismissing an opposer’s Section 2(d) claim based on its ownership of CITIBANK mark, versus applicant’s CAPITAL CITY BANK mark); *In re White Rock Distilleries, Inc.*, Serial No. 77/093,221, 2009 WL 4081675 (T.T.A.B. 2009) (precedential) (reversing refusal to register the mark VOLTA for an alcoholic energy drink that had been refused based on a prior registration for TERZA VOLTA with wine).

A review of the appearance, sound, and connotation of the marks, as well as the distinct commercial impressions and differing services offered in connection with each of the marks, make it abundantly clear that the marks are in fact dissimilar.

a. The Marks are Different in Appearance, Sound, and Connotation

Applicant’s mark and the Cited Registration have distinct differences in appearance, sound, and connotation, which make them dissimilar in their entireties (as they must be viewed). An ordinary consumer of the relevant services would easily be able to distinguish between the marks based on sight alone. Applicant’s mark CLICK2CLOSE contains the term “close” at the end of the word creating a unique appearance. On the other hand, the Cited Registration is a design mark and includes the term “sale” at the end of the word creating its own unique appearance. Therefore, each mark has a separate and distinct appearance.

The marks are also completely different phonetically. Although there is no “correct” pronunciation of a trademark, and consumers may pronounce marks differently than intended by brand owners, in this case, the differences in the marks are so obvious that a consumer would never pronounce them so that they sounded alike. See, e.g., *Interlego AG v. Abrams/Gentile Entm’t Inc.*, 63 U.S.P.Q.2d 1862, 1863 (T.T.A.B. 2002) (finding similarity between LEGO and MEGO, despite the applicant's contention that consumers would pronounce MEGO as “me go”).

The addition of different terms to the marks distinguishes the pronunciation of the marks greatly from one another. Here, CLICK2CLOSE would be pronounced by consumers as “click to close” whereas the Cited Registration would be pronounced by consumers as “click to sale.” Because of the aural dissimilarities between the marks, in addition to the visual dissimilarities, consumers are in no way likely to confuse Applicant’s CLICK2CLOSE mark with the Cited Registration.

In addition, the TTAB has held that marks which share a common term and are used with goods or services in the same class are not necessarily confusingly similar. See *In re British Bulldog Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984); *MTD Prods. Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56. In fact, there is settled case law that holds that even identical trademarks are not necessarily confusingly similar. See, e.g., *Shen Mfg. Co.*, 393 F.3d 1238 (Fed. Cir. 2005) (holding that identical RITZ marks, used in connection with goods that could be used together, would not necessarily mean that “the consuming public would perceive them as originating from the same source”); *In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. Cir. 2003) (holding that a brewing company’s BLUE MOON (and Design) mark for beer was not sufficiently related to registrant’s BLUE MOON (and Design) mark for restaurant services to preclude registration); *CNL Tampa Int’l Hotel P’ship, L.P. v. Palazzolo*, Opp. No. 91163724 (T.T.A.B. 2007) (non-precedential) (holding that an applicant’s PELAGIA mark for clothing did not cause confusion with an opposer’s PELAGIA mark for restaurant services); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. at 856 (finding no likelihood of confusion between PLAYERS for shoes and PLAYERS for men’s underwear); *MTD Prods. Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56, 60 (T.T.A.B. 1976) (holding that the mark COLUMBIA for automobile tires was not confusingly similar to the mark COLUMBIA for bicycle, tractor and minibike tires).

Here, Applicant respectfully submits that a finding of confusing similarity must be predicated on more than the fact that the marks share a common term as the marks are certainly not identical, or even similar in sight or sound. Thus, the sharing of the term “click2” is not in and of itself sufficient for a finding of likelihood of confusion when considering Applicant’s mark and the Cited Registration in their entireties.

b. The Marks have Different Commercial Impressions

Based upon the distinct commercial impressions of the respective marks, there is no similarity that would give rise to a likelihood of confusion. The presence of the different terms

“close” and “sale” plus the design elements that make up the Cited Registration provide key distinguishing characteristics that in turn create a unique commercial impression. In fact, “a mark should not be dissected . . . and each part then compared with corresponding parts of the conflicting mark to determine likelihood of confusion. It is the *impression* that the mark as a whole creates on the average reasonably prudent buyer and not parts thereof, that is important.” Emphasis added. 2 McCarthy on Trademarks & Unfair Competition § 25.15 (4th ed.). The overall commercial impression created by the marks in their entireties is “of paramount interest” in determining whether the two marks are likely to be confused. *New England Fish Co. v. Herwin Co.*, 184 U.S.P.Q. 817, 818 (C.C.P.A. 1975) (finding that BLUE MOUNTAIN KITTY O’S and KITTY were not confusingly similar for cat food). “Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion.” T.M.E.P. § 1207.01(b)(v), citing *In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987) (CROSS-OVER mark for bras was not likely to be confused with CROSSOVER for ladies’ sportswear).

In this case, not only do the marks differ greatly in appearance, sound, and connotation, but also Applicant’s mark CLICK2CLOSE gives a different commercial impression than that of the Cited Registration. Here, the Examining Attorney has mistakenly focused on the fact that the marks share the term “click2” rather than the fact that Applicant’s mark contains the term “close” and the Cited Registration contains the term “sale” in evaluating the marks’ commercial impressions. Indeed, the definition of the term “close” is “to bring to an end or period, to conclude discussion or negotiations, and/or to bring or bring together the parts of an object.” See, “close.” *Merriam-Webster.com*. 2016. <http://www.merriam-webster.com> (22 February 2016). The definition of term “sale” is “the act of selling or the transfer of ownership of and title to property from one person to another for a price.” See, “sale.” *Merriam-Webster.com*. 2016. <http://www.merriam-webster.com> (22 February 2016). Therefore the CLICK2CLOSE mark and the CLICK2SALE mark give entirely different commercial impressions where the CLICK2CLOSE mark implies that consumers can click on something to end, conclude, and/or bring together something or a certain process whereas the CLICK2SALE mark implies that consumers can click on something to engage in a sale or sell a property. Moreover, the Examining Attorney has failed to provide any evidence supporting the assertion that the

CLICK2CLOSE mark and the CLICK2SALE mark will project the same commercial impression.

The Examining Attorney's analysis is focused merely on the presence of the term "click2", which contradicts well-settled trademark analysis and the anti-dissection rule, which must compare the marks in their entireties. Applicant respectfully submits that there is no potential likelihood of confusion between its mark and the Cited Registration, because the marks project entirely different commercial impressions and therefore there is no likelihood of confusion.

c. The Applicant's Services and Registrant's Services are Not Sufficiently Related as to find a Likelihood of Confusion

Further to the comments mentioned above, Applicant respectfully disagrees that Applicant's and Registrant's services are related in any way so as to create a likelihood of confusion. If the services are not related in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical (which in this case they are not), confusion is not likely. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).


Here, the nature and purpose of Applicant's services for the mark CLICK2CLOSE, in addition to the channels of trade and nature of the relevant consumers to whom the services are rendered, are not confusingly similar to that of the Cited Registration. Specifically, Applicant's


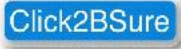


mark is used in connection with customer relationship management services for sales and lead generation between customers and retailers. The Cited Registration is limited to “services relating to automated customer satisfaction surveys for the purpose of customer satisfaction monitoring and customer retention.” Therefore, the services offered in connection with the marks are entirely different. Applicant is specifically using its mark narrowly for customer relationship management services within the flooring and carpeting industry. On the other hand, the Cited Registration is limited to customer satisfaction surveys. Thus, consumers are not likely to confuse sales and lead generation services connecting consumers to specific retailers and customer satisfaction surveys. Indeed, the two processes, lead generation (dealing with potential customers) and customer satisfaction surveys (receiving feedback from current or previous customers), take place at opposite ends of the sales process and are entirely unrelated. Applicant respectfully submits that there is no potential likelihood of confusion between its mark and the Cited Registration, because the marks are not confusingly similar when viewed in this manner.

Last, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant(s). TMEP §1207.01(d)(i); see, *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

d. Coexistence of Other CLICK2 Formative Marks

To remain consistent with prior PTO practice, Applicant respectfully submits that there are (28) registrations in addition to the Cited Registration for CLICK2 formative marks already coexisting on the federal register. See below:

Mark	Serial/Reg. No.
CLICK2TALK CLICK2TALK	75-444067 2,351,179
C2E CLICK2ENTER (and Design) 	75-681006 2,445,041
CLICK2LOCATE CLICK2LOCATE	75-899624 2,721,781
CLICK2GOV	76-016411 2,713,952

CLICK2GOV	
CLICK2LICENSE	76-159540 2,834,858
CLICK-2-CALL CLICK2CALL	76-562127 2,999,303
CLICK2CONNECT CLICK2CONNECT	76-630930 3,099,480
CLICK2MAIL CLICK2MAIL	77-071975 3,432,109
CLICK2FIND.ORG (Stylized) 	77-331626 3,566,621
CLICK2COACH	77-348284 3,487,855
CLICK2 (Stylized) click²	77-418598 3,768,140
CLICK2BSURE (and Design) 	77-685163 3,756,842
CLICK2PAYNOW (and Design) 	77-839081 3,839,209
CLICK2 (Stylized) click²	77-977924 3,700,336
CLICK2WIN	78-163745 2,841,695
CLICK2LICENSE (and Design) 	78-177714 2,938,777
CLICK2COLLABORATE	85-073836 4,039,418
CLICK2HOUSTON	85-075910 4,043,923
CLICK2LICENSE	85-423996 4,326,628
CLICK2LICENSE	85-424004 4,105,709
CLICK2CURB	85-680152 4,298,198
CLICK2SELL	85-779361 4,391,137
CLICK2PURCHASE	86-379497 4,719,847
CLICK2CREATE	86-536344 4,812,672
CLICK2COOK	86-633113 4,874,199

CLICK2CAST	86-707161 4,881,693
CLICK2CAST (and Design) 	86-710949 4,898,715

Accordingly, the term “click2” is diluted. In light of the above, Applicant’s application for the mark CLICK2CLOSE should be permitted to coexist with the Cited Registration. Applicant respectfully requests that the Examining Attorney remove the likelihood of confusion refusal. Applicant hereby reserves the right to address the prior pending application for the CLICK2SALE mark, Ser. No. 77/788,205 and any possible refusal(s) at a later date, if needed.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Examining Attorney reconsider his requests and allow the application to proceed to publication.