

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Northwood Media Inc.

Serial No. 76/719212

Trademark Attorney: Kristina Morris

Filed: April 14, 2016

For: ANNE

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

This amendment and response is a reply to the Office Action dated August 5, 2016.

In the Office Action, the trademark examining attorney refused registration of ANNE. The Examiner partially refused classes 14, 18, 25 under Section 2(d) likelihood of confusion in view of several marks. Applicant (herein “Northwood Media Inc.” or “Northwood”) respectfully disagrees with the Examining Attorney’s partial refusal for the reasons identified below. Applicant also herein amends the description of the identification of goods, corrects the entity type, pays the remaining filing fee due on six of the seven classes and requests the application be suspended pending the issuance of the foreign registration certificate.

I. Amendment to Identification of Goods

Please enter the following amendments to the description of the goods in Classes 9, 16, and 25. These amendments generally adopt the Examiner’s suggested amendments.

Proposed red-line changes: Class 9: Digital media, ~~including namely~~, pre-recorded DVDs containing recordings of television shows and movies, pre-recorded CDs containing music, pre-recorded CDs containing audio recordings of dramatic performances, downloadable ~~audio and video recordings~~ television shows and movies, downloadable music, and streaming of television shows and movies via the Internet ~~high definition discs~~; Computer game cartridges, video game cartridges; Interactive multimedia software for playing games; Downloadable software for playing games for use with computers, portable digital electronic communication devices; mobile devices, namely cell phones, tablet computers, and laptop computers; Video game software on electronic discs; Sunglasses and magnets.

Proposed final version: Class 9: Digital media, namely, pre-recorded DVDs containing recordings of television shows and movies, pre-recorded CDs containing music, pre-recorded CDs containing audio recordings of dramatic performances, downloadable television shows and movies, downloadable music, and streaming of television shows and movies via the Internet; Computer game cartridges, video game cartridges; Interactive multimedia software for playing games; Downloadable software for playing games for use with computers, portable digital electronic communication devices; mobile devices, namely cell phones, tablet computers, and laptop computers; Video game software on electronic discs; Sunglasses and magnets.

Proposed red-line changes: Class 16: Children's activity books, children's storybooks, coloring books, calendars, stickers, stamp pads or inking pads, rubber stamps, pencils, pens, posters, art pictures, envelopes for stationery use, greeting cards, crafts paint kits, and notebooks; Pencil cases; Paper party decorations; paper party supplies, ~~including~~ namely, paper napkins, paper place

mats, giftwrapping paper, and paper gift wrapping ribbons, paper gift wrap bows, paper table cloths, and paper party bags.

Proposed final version: Class 16: Children's activity books, children's storybooks, coloring books, calendars, stickers, stamp pads or inking pads, rubber stamps, pencils, pens, posters, art pictures, envelopes for stationery use, greeting cards, crafts paint kits, and notebooks; Pencil cases; Paper party decorations; paper party supplies, namely, paper napkins, paper place mats, giftwrapping paper, and paper gift wrapping ribbons, paper gift wrap bows, paper table cloths, and paper party bags.

Proposed red-line changes: Class 25: Apparel, ~~including~~ namely, T-shirts, pants, dresses, sweatshirts, sweat pants, skirts, hats, jeans, caps, pajamas, robes, sleepwear, hosiery, shoes, underwear, cloth baby bibs, and Halloween costumes.

Proposed final version: Class 25: Apparel, namely, T-shirts, pants, dresses, sweatshirts, sweat pants, skirts, hats, jeans, caps, pajamas, robes, sleepwear, hosiery, shoes, underwear, cloth baby bibs, and Halloween costumes.

II. Multiple -Class Application Fees and Entity Type

Applicant submits herewith the required remaining filing fee for six of the seven classes. Accordingly, the full filing fee has been paid for all seven classes pursuant to 37 C.F.R. §2.86(a)(2) and (b)(2).

Applicant herewith is electronically updating its entity type. Applicant is a corporation incorporated under the laws of the Province of Ontario, Canada.

III. Foreign Registration- Suspension Request

Applicant requests that the current application be suspended pending the issuance of its foreign registration. 15 U.S.C. §1126(e); TMEP §716.02(b).

IV. Partial Refusal under Section 2(d) for Classes 14, 18, 25

The Examining Attorney refused the mark as to classes 14, 18, 25 under Section 2(d) likelihood of confusion in view that the applied for mark would create likelihood of confusion with U.S. Registrations 3,410,833; 3,020,741; 3,848,118; 4,504,568; and 4,202,497. In respect of the refusal as to Classes 14, 18 and 25, the examining attorney relies upon the argument that the marks are similar, alleges that the goods are similar, and alleges that the trade channels of the goods are similar. Applicant respectfully disagrees for the reasons outlined below.

Whether a likelihood of confusion exists between an applied-for mark and a previously registered mark is determined on a case-by-case basis, aided by application of the du Pont factors. See *Citigroup Inc. V. Capital City Bank Group, Inc.*, 637 F.3d 1344 (Fed. Cir. 2011). Not all of the du Pont factors are relevant to every case, and only factors of significance to the particular mark need be considered. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010). The question is whether a potential consumer viewing Applicant's mark ANNE would be confused, mistaken, or deceived as to the source of its services. See 15 U.S.C. §1052(d). In testing for likelihood of confusion under Sec. 2(d), the following must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;

- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);
- (10) The market interface between applicant and the owner of a prior mark;
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) The extent of potential confusion, i.e., whether de minimis or substantial; and
- (13) Any other established fact probative of the effect of use.

See *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

The cited marks are:

- ANN in Class 18 (US Registration 3,410,833) for “shoulder bags and tote bags” owned by Annco, Inc.
- ANN INC. in Class 35 (US Registration 4,202,497) for “retail store services featuring apparel and accessories” owned by Annco, Inc.
- ANN in Classes 14, 25, and 35 (US Registration 3,848,118) for “jewelry,” “clothing, namely, dresses, skirts, suits, sweaters, shirts, tank tops, gloves, sleepwear, robes, blouses, shoes, pants, shorts jackets, coats, hosiery, hats, belts, scarves and underwear,” and “online and in store retail store services in the fields of clothing, footwear, handbags, small leather accessories and jewelry” by Annco, Inc.
- ANN in Class 25 (US Registration 3,020,741) for “pants” by Annco, Inc.
- CHEMISSETTES BY ANNE in Class 26 (US Registration 4,504,568) for “clothing accessories, namely, chemisettes” by Making A Life, LLC.

Applicant's mark is ANNE in respect of merchandise (from refused classes 14, 18, 25) sold in connection with its television series based on the book *Anne of Green Gables*, by Lucy Maud Montgomery.

The relevant *DuPont* factors are each examined below. The pertinent factors support a finding that there is no likelihood of confusion between Applicant's mark ANNE and Annco, Inc.'s marks for ANN and ANN INC., nor CHEMISSETTES BY ANNE by Making a Life, LLC.

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

In terms of appearance, Applicant's mark ANNE is distinguishable from Annco, Inc.'s ANN. The inclusion of the "E" in Applicant's mark creates a visually distinct mark. Applicant's mark ANNE is also visually distinguishable from CHEMISSETTES BY ANNE due to the inclusion of the words "CHEMISSETTES BY" in Making a Life, LLC's mark.

In assessing commercial impression, the proper inquiry is whether the marks at issue are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); See also *Bd. of Regents v. S. Ill. Miners, LLC*, 2014 TTAB LEXIS 92 (TTAB Mar. 13, 2014). Additionally, the nature of the respective services must be considered. See *Coach Servs*, 668 F.3d at 1368. See also *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470 (Fed. Cir. 1997).

The commercial impression of the marks are distinct. ANN on women's business and dress clothing, leaves customers with the commercial impression of Ann Taylor the store and its clothing. ANN as used by Annco, Inc. is a secondary brand sold predominantly, if not exclusively,

under the Ann Taylor name and stores. On the other hand, ANNE will be used by Applicant on merchandise sold in connection with its series. The distinct commercial impressions in conjunction with the fact that the parties' goods are unrelated outweighs any similarities that may exist in the sound or appearance of the marks. *See Coach Servs*, 668 F.3d at 1368.

The meaning or connotation of a mark must be determined in relation to the named goods or services. 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. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear). *See also Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1820-21 (TTAB. 2005) (finding that BLUE MAN GROUP "has the connotation

of the appearance of the performers" and that applicant's BLUEMAN mark "has no such connotation for cigarettes or tobacco. Thus, the marks differ in their connotations and commercial impressions").

Viewers and consumers of the marks understand that the connotation for the mark ANN on women's business and dress clothing, directly implies that the goods emanate from Ann Taylor. ANN as used by Annco, Inc. is a secondary brand sold predominantly, if not exclusively, under the Ann Taylor name and stores. Applicant's goods sold under ANNE will not be available in Ann Taylor stores and will not compete with women's business and dress clothing. Instead, Applicant's goods will be merchandise sold in connection with its series. The connotation of ANNE on Applicant's goods will immediately impart a relation to Applicant's series due to the context, the goods and the relatedness of the goods to the Applicant's series. Likewise, CHEMISETTES BY ANNE will not be sold alongside Applicant's goods and will not be related to the series. Therefore, the goods will be distinct and distinguishable and this supports a finding of no likelihood of confusion.

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

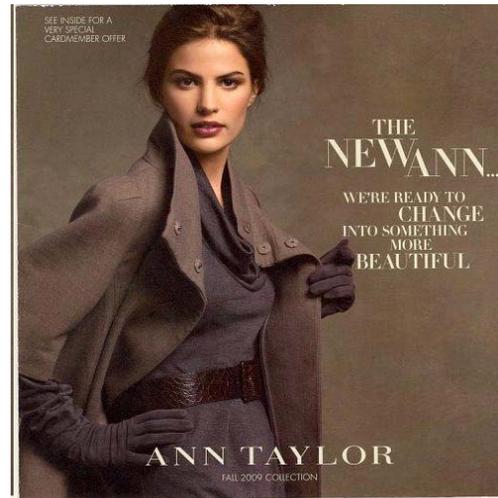
Under this factor, the similarity or dissimilarity of the nature of the goods is considered. As such, the analyses focuses on whether consumers would be confused as to the source of the goods. See *Cognis Corp. v. HANA Co.*, 2007 TTAB LEXIS 117 (TTAB Feb. 28, 2007). Although the marks both fall within similar classes, a careful examination of the parties respective goods highlight the major differences between them.

The marks owned by Annco, Inc., namely, ANN and ANN INC., are used in respect of high end women's clothing and related goods, such as purses and jewelry, which are sold primarily in specialty stores known as "Ann Taylor" and "Ann Taylor Loft." The following images are specimens submitted by Annco, Inc. showing their very specific use of ANN and ANN INC.

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U.S. Reg. 3,020,741



U.S. Reg. 3,848,118



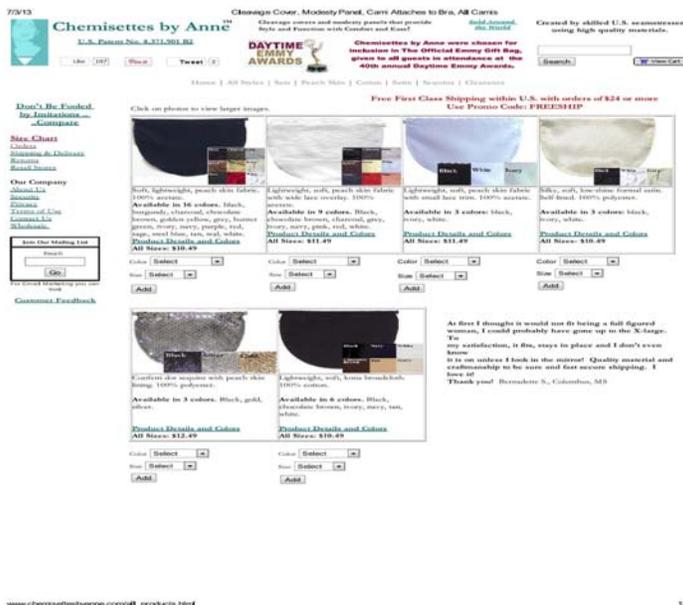
U.S. Reg. 3,410,833

U.S. Reg. 4,202,497

ANN, as used by Ancco, Inc., is a secondary brand sold exclusively under the Ann Taylor name and store. As shown, ANN on pants is used for pants sold predominantly, if not exclusively, at Ann Taylor stores. ANN in respect of jewelry, clothing, and online and in store retail store

services is clearly branded under the house brand Ann Taylor. It is abundantly clear that these goods and services will be sold predominantly, if not exclusively, at Ann Taylor stores. Likewise, the ANN mark on shoulder bags and tote bags clearly indicates it is from Ann Taylor |Loft. The bags include the Ann Taylor |Loft mark. The mark ANN INC. for retail store services also shows the Ann Taylor |Loft marks as the retail store names. ANN as used by Annco, Inc. is not used apart from the Ann Taylor house mark. ANN goods are also predominantly, if not solely, sold in the house-branded Ann Taylor |Loft stores.

The mark CHEMISSETTES BY ANNE is registered and used specifically for clothing accessories, namely, chemisettes. See the below specimen showing the very limited use in the banner alone.



U.S. Reg. 4,504,568

Applicant does not claim use on clothing accessories, nor chemisettes. The goods of Applicant and Making a Life, LLC are distinguishable and very distinct.

The analysis focuses on whether the parties' services are related in some manner, or that the circumstances surrounding their use be such that the services would likely be encountered by the same persons in situations that would give rise to a mistaken belief that the services originate from the same source or that there is a connection between the sources of the respective services. See *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (discussing related goods).

If the goods or services in question are not related or marketed 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, confusion is not likely. T.M.E.P. §1207.01(a)(1) citing to 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); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given 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); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and

advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *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).

The Applicant has demonstrated that its mark ANNE is not confusingly similar to Annco, Inc.'s ANN marks or ANN INC., nor Making a Life, LLC's CHEMISSETTES BY ANNE mark, because the goods would not likely be encountered by the same persons in situations that would give rise to a mistaken belief that the goods originate from the same source or that there is a connection between the sources of the respective goods. See *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). Annco, Inc.'s ANN and ANN INC. marks are used predominantly used with their store name Ann Taylor or Ann Taylor Loft. Additionally the marks ANN and ANN INC. are used on high-end women's business clothing and related goods. CHEMISSETTES BY ANNE is used solely on chemisettes. All of these goods are distinct from Applicant's goods, which will include merchandise sold in connection with its series. The dissimilarity in the goods removes any chance that consumers will be confused. There will be no confusion between the goods, 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. This factor supports a finding of a finding of no likelihood of confusion.

(3) The similarity or dissimilarity of established, likely-to-continue trade channels.

Another relevant *du Pont* factor concerns the similarity or dissimilarity of established, likely-to-continue trade channels. See *Bd. of Regents v. S. Ill. Miners, LLC*, 2014 TTAB LEXIS 92 (TTAB Mar. 13, 2014). A channel of trade includes distribution channels. For instance, channels of trade are considered identical when products are sold under opposing marks in supermarkets and grocery stores across the country. See *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992).

As noted above, Annco, Inc. sells the ANN goods through its Ann Taylor|Loft stores. Applicant's ANNE goods include merchandise that will be sold in connection with its series . Applicant's goods will not be sold in Ann Taylor stores nor at Ann Taylor's online store. Therefore, Applicant's goods and Annco, Inc.'s goods are in separate, distinct trade channels. Additionally, Making a Life, LLC's CHEMISSETTES BY ANNE are sold online through its own website. Applicant's goods will not be sold on Making a Life's website. Therefore, Applicant's goods and Making a Life's goods are in separate, distinct trade channels. Consumers will not find Applicant's goods and Annco, Inc.'s goods or Making a Life's goods in the same channels of trade. Accordingly, there is very little opportunity for consumers to come across the goods together and therefore, no chance of consumer confusion.

In light of the foregoing, Applicant's and Annco, Inc.'s or Making a Life's goods do not travel in similar trade channels. See *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011). This supports a finding of no likelihood of confusion.

(4) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

Viewers and consumers are immediately given the impression that ANN on women's business and dress clothing, is related to Ann Taylor. ANN as used by Annco, Inc. is a secondary brand sold predominantly, if not exclusively, under the Ann Taylor name and stores. When consumers see the ANN mark, they are either in an Ann Taylor store or shopping the Ann Taylor website. Accordingly, consumers immediately know that ANN is a secondary brand of Ann Taylor.

However, when consumers see ANNE on merchandise sold in connection with Applicant's series, they will know ANNE refers to the series and won't be confused with ANN on women's high end clothing sold predominantly, if not exclusively, through Ann Taylor stores. The use by both parties to represent their broader brand, ie. Ann Taylor and the Applicant's series, allows the consumers to differentiate between the source of the goods. This supports a finding of no likelihood of confusion.

(5) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). Purchasers of high-end business clothing and accessories from Ann Taylor, some of which may include the ANN mark, are careful, sophisticated purchasers.

These purchasers will proceed directly to Ann Taylor stores or the Ann Taylor website to purchase high-end business clothing made by Ann Taylor or sold under the ANN mark. The purchase of women's high-end business clothing is a careful, sophisticated purchasing decision. These customers will be wearing the clothing every day at work and want it to be comfortable, fit well and look nice, particularly, when they are spending a fair amount of money on the business clothing. When these buyers enter an Ann Taylor store, they have made the careful purchasing decision that they will purchase high-end business clothing and accessories from Ann Taylor. These consumers would simply not be confused when they see Applicant's ANNE mark on merchandise sold in connection with Applicant's series. This factor weighs in favor of finding no likelihood of confusion.

(6) The market interface between applicant and the owner of a prior mark.

There is no market interface between Applicant's ANNE mark on merchandise sold in connection with Applicant's series and ANN on women's business and dress clothing sold predominantly, if not exclusively, at the Ann Taylor store and website. There is no market interface between Applicant's ANNE mark on merchandise sold in connection with Applicant's series and CHEMISETTES BY ANNE on chemisettes sold exclusively online by Making a Life, LLC.

The goods would not be sold in the same market. The cited marks' goods would be sold in the women's fashion market, while the Applicant's goods would be sold in the merchandise or novelty market. This factor weighs in favor of finding no likelihood of confusion.

(7) The extent of potential confusion, i.e., whether de minimis or substantial.

There is no potential confusion between the goods of the parties. The extent of potential confusion is therefore de minimus. The goods travel in different trade channels, are sold in different markets, and are easily distinguishable. The extent of Applicant's ANNE merchandise that is sold in connection with Applicant's series being confused with Annco, Inc.'s ANN for women's business and dress clothing sold by Ann Taylor, is de minimis. Likewise, the extent of Applicant's ANNE merchandise, that is sold in connection with Applicant's series, being confused with Making a Life, LLC's CHEMISSETTES BY ANNE, is de minimis. The goods are clearly distinguishable in the context and market in which they are sold. This factor supports a finding of no likelihood of confusion.

IV. CONCLUSION

After careful consideration of all of the evidence of record as it pertains to the relevant *du Pont* likelihood of confusion factors, there is no basis for refusing Applicant's registration of ANNE since, the applied-for mark would not create likelihood of confusion with the cited registrations.

Accordingly, it is respectfully requested that the Examiner withdraw the partial refusal to register ANNE, enter the proposed amendments, and suspend the application pending the issuance of the registration of the foreign mark.

Respectfully submitted,

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