

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of: Berroco, Inc.
Examining Attorney: Tricia Sonneborn
Law Office: 110
Serial No.: 77/669,868
Filed: February 13, 2009
Mark: LUSTRA

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

RESPONSE TO OFFICE ACTION

Dear Attorney Sonneborn:

In response to the Office Action mailed May 11, 2009, Applicant respectfully requests reconsideration of the Trademark Office's refusal to register the instant mark on the basis of confusing similarity with cited Registration No. 2,735,416 for the mark LUSTRA KNIT, for "knit fabrics for use in manufacture of women's apparel."

Applicant respectfully disagrees that the instant mark is confusingly similar to the cited registration.

In the Office Action, the Trademark Office stated that the most relevant *DuPont* factors for determining likelihood of confusion in the instant case were the similarity of the marks, similarity of the goods and similarity of the trade channels. The Trademark Office also stated that the parties' goods need only be related in some manner, or the conditions surrounding their marketing such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source.

Applicant's goods are yarn, whereas the goods of the Registrant, QVC Inc. ("QVC"), are "knit fabrics for use in manufacture of women's apparel." In support of its position that the goods are related, the Trademark Office cited several cases as supporting the relatedness of fiber and finished clothing products. However, none of the cases cited by the Trademark Office relate specifically to the yarn sold by the Applicant, which does not lend itself to being woven into a fabric, other than by perhaps by hand-weaving. In further support of its position that the goods are related, the Trademark Office provided copies of third-party registrations of marks used in connection with the same or similar goods as those of Applicant and Registrant. However, as noted by the Office, the evidence supplied by the Office is not persuasive. Third party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991); *In re Hub Distribution, Inc.*, 218 U.S.P.Q. 284 (TTAB 1983).

Examining more closely the parties' goods, QVC sells women's apparel made from its LUSTRA KNIT branded fabric. An internet search using the phrase "QVC lustra knit" does not show any instances of QVC sales of LUSTRA KNIT fabric, or yarn under the mark LUSTRA KNIT, either online or available for purchase in retail stores. See Exhibit A. The evidence shows that QVC only sells women's' apparel made from LUSTRA KNIT fabric.

As to the conditions surrounding the marketing of the parties' goods, QVC is well-known for marketing its goods via television "infomercials," as well as on the internet. During or after viewing a QVC infomercial, consumers may call QVC to purchase the goods, or alternatively, they may purchase the goods on QVC's website. In contrast, Applicant's goods are marketed by its sales representatives and by independent distributors, to independent specialty yarn stores, for sale to end-users, who are knitting enthusiasts. Applicant's marketing also includes advertisements in trade magazines directed to hand-knitting enthusiasts. However, the yarn is only available for purchase at the independent specialty yarn stores.

As to the parties' target consumers, purchasers of QVC products share the common feature of enjoying QVC infomercials and the ease of ordering online or via the telephone after viewing such an infomercial. In contrast, Applicant has very specific target consumers: knitting

enthusiasts that use specialty yarn to make hand-knitted items. While it may be true that some of Applicant's target consumers may purchase goods from QVC's television ads or on QVC's internet site, they would not find QVC's products in independent specialty yarn stores. Similarly, while it may be true that some of QVC's target consumers may be knitting enthusiasts, they would not be able to purchase Applicant's yarn from QVC.

The Trademark Office stated that consumers familiar with finished goods having a label or hang tag that includes the wording "Made with LUSTRA fibers," who later comes across Registrant's knit fabrics for use in making apparel, would think that there is a commonality of source between the goods. As discussed above, the evidence provided by the Applicant shows that QVC does not sell LUSTRA KNIT fabric to end-users. As to purchaser's of Applicant's yarn, it is more likely that once completing a project, they would not include a label on the finished item, or if they did, it would be more likely to reflect the extensive work that the end-user invested in the project (e.g., a "Hand-made by NAME" label), rather than using a label indicating that the project was made with any particular yarn.

Finally, because hand-knitting projects require a considerable investment of time and money (depending on the price-point of the yarn), it is reasonable to assume that consumers purchasing yarn for hand-knitting through independent specialty yarns shops are not impulse purchasers, but rather consumers making carefully considered purchases after the careful planning of a knitting project, and careful consideration of alternative yarns. It is also reasonable to assume that consumers purchasing goods through QVC are impulse buyers that are not making carefully considered purchases, and are instead responding to the QVC infomercials and ease of purchasing through the QVC marketing channels.

The goods covered by the instant mark and the cited registration are sold in specific, non-overlapping channels of trade, and the target markets and target consumers toward which the goods are marketed are very different. In such circumstances, courts have not found a likelihood of confusion. See *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 U.S.P.Q.2d 1944 (Fed. Cir. 2006), cert. denied, 127 S.Ct. 836, 166 L.Ed. 2d 666 (U.S. 2006) ("[P]aramount to this case is the industry-specific focus of the parties' claimed goods.").

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In view of the foregoing, confusion as to the source of the parties' goods is unlikely, and withdrawal of the refusal is respectfully requested.

CONCLUSION

It is respectfully submitted that this application is ready for publication, and such action is courteously solicited. The U.S. Patent and Trademark Office is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to Deposit Account No. 50-1935.

Respectfully submitted,

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