

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TO THE HONORABLE COMMISSIONER FOR TRADEMARKS:

This is in response to the Office Action dated November 20, 2009 wherein the Trademark Attorney refused registration because, according to the Trademark Attorney, Applicant's design mark ("Applicant's Mark"), when used on or in connection with the identified goods and services, so resembles the mark that is the subject of U.S. Registration No. 3,001,232 ("Cited Mark") as to be likely to cause confusion, to cause mistake or to deceive.

I. REMARKS

As the Trademark Attorney is aware, in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A.) 1973), the Court of Customs and Patent Appeals "set forth a reliable guide for decision-making in cases involving Sec. 2 (d)" of the Act and identified thirteen factors which, when of record, must be considered. See also T.M.E.P. 1207.01 ("In considering what factors are relevant to determination of likelihood of confusion, it is helpful to turn to *In re E.I. DuPont DeNumours & Co.,...*"). As shown herein, a comparison of Applicant's Mark and the Cited Mark using the *DuPont* factors demonstrates that Applicant's Mark is not confusingly similar to the Cited Mark and, therefore, Applicant's Mark is entitled to registration on the Principal Register.

A. The DuPont Factors

1. The similarity of the marks in their entirety as to appearance, sound, connotation and commercial expression

It is well established that when determining whether two marks are confusingly similar, one must consider the marks in their entirety. As explained by Professor McCarthy:

[C]onflicting marks must be compared in their entirety. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the marks as a whole create on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."

J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (“MCCARTHY” § 23.15[1][a] (3d ed. 1995) (citation omitted).

In fact, it is error to fail to compare marks in their entirety, for, as stated by the Federal Circuit in *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 851, 23 U.S.P.Q.2d 1471 (Fed. Cir. 1992) (citations omitted):

The Board compared the CAROLINA OPRY marks with Opryland’s marks such as GRAND OLE OPRY or OZARK OPRY after excluding the word “opry”. The incorrectness of this analytical approach is apparent, for marks must be considered in the way they are perceived by the relevant public, in determining likelihood of confusion. Although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared. Thus it is not dispositive whether generic or descriptive words are included as part of the mark; that is simply a factor to be considered when viewing the mark as a whole.

In *In re Hearst Corp.*, 982 F. 2d 493 (Fed. Cir. 1992), the Federal Circuit reviewed the Board’s decision to refuse registration of the mark “VARGA GIRL” on the ground of likelihood of confusion with the registered trademark “VARGAS.” The Court observed that the Board found that “VARGA” was the dominant element of the “VARGA GIRL” mark, and that “GIRL” was merely descriptive and thus should be entitled to little weight in comparing the marks. In reversing the Board’s decision, the court first noted that “marks tend to be perceived in their entirety, and all components must be given appropriate weight.” *Id.* at 494. After examining the marks in their entirety, the Court found that “[t]he appearance, sound, sight, and commercial impression of ‘VARGA GIRL’ derive significant contribution from the component ‘girl.’ By stressing the portion ‘varga’ and diminishing the portion ‘girl,’ the Board inappropriately changed the mark.” *Id.* The Court concluded that the marks “VARGA GIRL” and “VARGAS” were sufficiently different in sight, sound, connotation and commercial impression to negate the likelihood of confusion under § 2(d) of the Lanham Act.

Under this factor, the similarity or dissimilarity of the marks must be examined in their entirety as to the appearance, sound, connotation and commercial impression. Applicant’s Mark has a very different appearance and commercial impression than that of the Cited Mark. In this case, the owner of Cited Mark lists the following description: “the mark consists of a broken circle design which resembles

the letter G.” The circle shape of the Cited Mark is broken in four points, each at a 90 degree interval resulting in the appearance of a life preserver. In fact, among the design search codes for the Cited Mark is: “18.11.06 - Jackets, life; Life jackets; Life preservers; Vests, life; Water wings.” The Applicant’s Mark, on the other hand, is the letter “G” divided into two

The circle or “G” shape of the Cited Mark is double the width of the “G” shape comprising Applicant’s Mark. Conversely, the lines within each circle or “G” shape in the Applicant’s Mark are twice the size of those of the Cited Mark. The visual effect of these differences is immediately apparent when the two marks are viewed side-by-side. While the Applicant’s Mark is immediately and clearly identified as the letter “G”, the Cited Mark is more noticeably a circle than a “G” shape. Further, the Trademark Attorney noted that Applicant’s Mark and the Cited Mark both depicted the letter “G” at an angle, and specifically, at a similar angle. In fact, Applicant’s Mark commonly appears as an upright “G” as evidenced by Applicant’s use of the Mark in connection with the other goods and services listed on the Application. Consumers seeking Applicant’s goods and services would readily identify the Mark as the source of Applicant’s record label whether the Mark was depicted at an angle or as an upright “G.”

Although the marks do share common elements of design, the variance is such that each mark creates a significantly different commercial impression. The letter “G” is encountered often. A search of the PTO’s website revealed that, as of May 19, 2010, there are five hundred eight one (581) trademark applications filed in Class 25 that include a “G” as an design element of the mark are pending and/or registered (see printout), including, to name a few, Registration No. 2166039; Registration No. 3193828; Registration No. 3258812 Registration No. 3260282; Registration No. 3521449; Registration 3100488; Registration No. 3377245; Registration No. 3502258; Registration No. 2781599; and Registration No. 2289891; each of which, like both Applicant’s Mark and the Cited Mark, depict nothing more than a “G” shape (see printouts).

As in *Hearst*, the Applicant’s Mark and the Cited Mark, when viewed in their entireties, are different. By finding that Applicant’s Mark is confusingly similar to the Cited Mark based solely on the common design element of a broken circle resembling the letter “G”, the Trademark Examining Attorney

has engaged in the exact analysis criticized by the *Hearst* court. Accordingly, under the first *DuPont* factor, when considered in their entirety, Applicant's Mark and the Cited Mark are dissimilar in sight and commercial impression and there is no likelihood of confusion.

2. & 3. The similarity of the goods or services identified by the marks & the similarity of established, likely-to-continue trade channels

The next factors to be considered under *DuPont* are "the similarity or dissimilarity and nature of the goods or services as described in an application or registration..." And the similarity of trade channels. While some of the goods listed on the Application are the same as those identified by the Cited Mark, the goods identified by Applicant's Mark and the Cited Mark will not be sold through similar or identical channels of trade. Further, Applicant's Mark and the Cited Mark will not be used on related apparel and the activities surrounding their marketing are significantly different.

Applicant's Mark will be associated with apparel related to Applicant's record company "Greensleeves Records". The Cited Mark appears to be associated with an apparel company, specifically Marc Ecko Enterprises found on the website URL: www.shopecko.com, and sold through normal retail outlets for apparel. Goods bearing the Applicant's Mark will be sold primarily through Applicant's own retail channels or in connection with other goods identified by the Applicant's Mark (e.g. records). Applicant's goods will not be sold in retail establishments related only to apparel unless such merchandise is sold, promoted or advertised in connection with the record label "Greensleeves Records". It is highly unlikely that a consumer seeking a t-shirt bearing the Cited Mark would mistakenly purchase a T-Shirt identifying the record label "Greensleeves Records" through one of Applicant's own retail channels.

4. Conditions of purchase

Under the fourth *DuPont* factor, the conditions under which, and buyers to whom, sales are made are to be examined. The reasonably prudent person standard normally used to determine likelihood of confusion is elevated to the standard of the discriminating purchaser when the goods or services are purchased only after careful consideration. *See Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546

(Fed. Cir. 1990). It is well established that, under such circumstances, confusion is less likely. *See, e.g., Goldenrod Ice Cream Co. v. Louisville Pecan Co.*, 305 F.2d 473 (C.C.P.A. 1962) (“Other things being equal, confusion is less likely where goods are...purchased after careful consideration than where they are purchased casually.”); *See Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669 (C.C.P.A. 1956).

Under this factor, the Examining Attorney must consider the conditions under which purchasing decisions are made. In considering the question of likelihood of confusion, the only relevant application of the law to the facts is in the context of the marketplace because it is where confusion of prospective purchasers would occur. *See Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875 (C.C.P.A. 1979). Goods identified by the Cited Mark would be purchased by consumers seeking contemporary fashion apparel. Consumers of contemporary fashion typically search out such goods by looking in locations such as fashion boutiques, department stores and similar retail outlets. None of these locations would be likely to carry apparel that identifies a record label. On the other hand, consumer’s seeking Applicant’s goods would likely visit applicant’s website, or seek Applicant’s apparel at outlets selling other items related to “Greensleeves Records” such as retail establishments specializing in music or concert venues.

Consumers shopping in retail outlets where clothing is sold are not likely to be impulse buyers. On the contrary, those shopping for such clothing are *very* “brand name” conscious. In fact, a case could be made that such consumers purchase clothing based almost exclusively based on brand names. Given such a sophisticated buyer, it is almost unimaginable that such a buyer would be confuse an item identified by the Applicant’s Mark with an item identified by the Cited Mark.

5. Fame of senior mark

The fame of the senior mark(s) must also be taken into consideration. Applicant respectfully submits that the Cited Mark is not well known. A search of the Internet reveals little information about the goods associated with Cited Mark apart from the website identified above. The lack of fame of the goods identified by the Cited Mark makes it highly unlikely that the discriminating consumers who

purchase Applicant's goods or services would believe that there is any association or affiliation between Applicant and the goods identified by the Cited Mark.

6. Number and nature of similar marks

The sixth *DuPont* factor recognizes that the less distinctive a mark, the greater the likelihood that use on competitive goods or services will not cause confusion. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 comment i (Tentative Draft No. 2, 1990); *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999 (2d Cir. 1983); *Cotton Club Bottling Co. v. American Brands, Inc.*, 174 U.S.P.Q. 343 (T.T.A.B. 1972); *Nestles Milk Products, Inc. v. Baker Importing Company*, 182 F.2d 193 (C.C.P.A. 1950). For example, the use of "KICK-ER" was found unlikely to cause confusion with "KIK-IT" when both were used on tabletop soccer games, because the common element "kick" is suggestive of such games. *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183 (2d Cir. 1975); *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984) (no likelihood of confusion found between "KEY" for banking services and other marks for banking services containing the word "Key"; the common word "Key" is weak and is widely used in the financial field and is suggestive of a desirable characteristic of banking); *Worster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316 (T.T.A.B. 1986) (no likelihood of confusion between "POLY PRO" and "POLY FLOW" for paint brushes, because of weak descriptive "Poly" (made of polyester or polymers), weak "PRO" (professional quality) and weak "FLO" (flows easily)).

When a mark is merely one in a crowd of marks, "customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other." MCCARTHY § 11.85 p.11-144, citing *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385 (T.T.A.B. 1976); *Miss World (UK) Ltd. v. Mrs. America Pageants*, 856 F.2d 1445 (9th Cir. 1988). Thus, courts have held that marks and words which are in common use, such as ROYAL, BLUE RIBBON, ADVANTAGE, PREMIUM and NATIONAL have all been classified as "weak." See MCCARTHY § 11.86 and cases cited therein. The realities of the marketplace are that small differences are important in distinguishing among goods and services.

In this case, the number or nature of similar marks in use for similar goods supports the conclusion that there is not a likelihood of confusion between Applicant's Mark and the Cited Mark. As stated above, the Patent and Trademark Office has previously determined that there is no likelihood of confusion among numerous registered marks that identify clothing or related goods or services, and consist of the letter "G" in stylized form as the registered mark.

As stated by Professor McCarthy:

[A] mark that is hemmed in on all sides by similar marks on similar goods cannot be very "distinctive." It is merely one of a crowd of marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other...Thus, in a "crowded" field of similar marks, each member of the crowd is relatively "weak" in its ability to prevent use by others in the crowd.

MCCARTHY § 11.26[1], at 11-141.

7. & 8. Concurrent use and the length of such concurrent use without actual confusion

The *DuPont* court also held that the nature and extent of any actual confusion between the two marks should be considered. The Court also found that if there is no evidence of actual confusion between the two marks, and then the length of time and the conditions, under which there has been concurrent use without such confusion, should be examined.

Applicant's Mark has been in use in connection with merchandise related to its record company since as early as 1978. The owner of the Cited Mark has used the mark in commerce since February 1, 2004. In other words, these two marks have co-existed for over six (6) years. Applicant is not aware of a single instance of actual confusion between its goods and the clothing identified by the Cited Mark. This factor supports the conclusion that there is no likelihood of confusion.

9.-11. Other Factors

The next three *DuPont* factors, which are (9) the variety of goods on which a mark is or is not used, (10) the market interface between applicant and the owner of a prior mark, and (11) the extent to

which applicant has a right to exclude others from use of its mark on its goods, do not compel a different conclusion.

12. Any other established fact probative of the effect of use

Because there has been no actual confusion of Applicant and its services and goods with the owner of the Cited Mark and the goods identified by them, and because the vast majority of other *DuPont* factors discussed above militate against a likelihood of confusion, the potential for confusion is nil.

B. Summary

According to the TTAB, the *DuPont* factors are to be applied on a case-by-case basis to the facts in evidence. *DuPont* at 1361. The Applicant's Mark is used in connection with apparel that identifies the record label, "Greensleeves Records". The Cited Mark identifies contemporary fashion apparel that will be sold at boutiques and similar retail outlets.

If one considers the dissimilarity of the marks in appearance, meaning and commercial impression, the dissimilarity of the goods and services, the difference in the channels of trade through which the goods are sold, the sophistication of the average purchaser of the goods and services, and the care with which buying decisions are made and the absence of any actual confusion, it becomes clear that there is no likelihood of confusion between the Applicant's Mark and the Cited Mark.

CONCLUSION

Applicant has addressed all of the issues raised by the Trademark Attorney in the Office Action, and therefore Applicant respectfully submits that its Application should be passed on to publication.