

APPLICANT'S RESPONSE TO OFFICE ACTION

Response to Primary Basis for Refusal of Registration
Under Trademark Act Section 2(d), 15 U.S.C. §1052(d)

In the Office Action of September 4, 2012 the examining attorney refused registration under Trademark Act Section 2(d), on the ground that the applicant's mark, when used on or in connection with the identified services, so resembles the marks in **U.S. Registration Number 4183592** as to be likely to cause confusion, to cause mistake, or to deceive. Applicant does not agree with this conclusion and in further support of its original application ("Application"), hereby submits this Response and requests that the examining attorney reconsider their refusal of the Application.

A. The Nature of the Mark the Examining Attorney Concluded Could Lead to Confusion, Mistake, or Deception under 15 U.S.C. 1052(d).

U.S. Registration No. 4183592

The mark covered by this registration is a mark containing the literal elements RETRACTABLEDESIGNS.

The application fits into International Class 024 for "Quilting design wall, namely, a non-woven textile surface for arrangement of quilt material."

B. Explanation of the DuPont Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The test for likelihood of confusion is whether a 'reasonably prudent consumer' in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A 1973). The examining attorney is to apply each of the applicable factors set out in *In re DuPont*, otherwise known as the *DuPont* factors, which are, as relevant to the present case:

- (1) the similarity or dissimilarity as to appearance, sound, connotation, and commercial impression;
- (2) the similarity or dissimilarity and the nature of the goods or services as described in the application or registration in connection with which a prior mark is in use;
- (3) the degree of care/sophistication likely to be exercised by consumers; and
- (4) the absence of actual confusion between the marks.

See id.

C. Application of the DuPont Factors to the Pending Application

Applying the relevant *DuPont* factors to the instant case, Applicant hereby submits the following arguments in response to Examiner's refusal to register Serial No. 85561669.

1. Similarity or Dissimilarity as to Appearance, Sound, Connotation, and Commercial Impression

It is well established that in comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for resemblances in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion, even if the services are identical or closely related. TMEP §1207.01(b)(i). It is also accepted that the use of identical, even dominant, words in common does not necessarily mean that two marks are similar. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 687 (8th Cir. 1987) (holding defendant's OATMEAL RAISIN CRISP did not infringe plaintiff's APPLE RAISIN CRISP trademark). This is because marks must be considered in their entirety. *See, e.g.*, TMEP §1207.01.

The examining attorney is required to look at to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the two marks is confusingly similar, not simply whether the marks sound alike or look alike *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole) (citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. Also, in *First Savings Bank F.S.B. v. First bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for "FirstBank" and for "First Bank Kansas" were found not to be confusingly similar. Furthermore, in *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark "Lean Cuisine" was found not to be confusingly similar to "Michelina's Lean 'N Tasty" even though both marks use the word "Lean" and are in the same class of goods, namely, low-fat frozen food.

i. *Appearance*

Concerning the respective goods with which the marks are used, the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). *See generally* TMEP § 1207.01(a)(iii).

In *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, the Supreme Court laid down the **Anti-Dissection Rule** and held that composite conflicting marks are to be compared by looking at them as a whole rather than breaking the marks up into their component parts for comparison. The rationale of this rule is that the commercial impression of a composite trademark on an ordinary prospective buyer (customer) is created by the mark as a whole, not by its component parts.

Where dominant terms are to be considered, consumers are generally more inclined to focus on the first word, prefix, syllable, or element in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In examining the Applicant’s mark with the registered mark, there is an obvious visual and textual difference. First, the Applicant’s mark is THE ORIGINAL RETRACTABLE DESIGN WALL whereas the registered mark is RETRACTABLEDESIGNS. It is apparently visible that the Applicant’s mark includes the words THE ORIGINAL and WALL, as well as a space between RETRACABLE and DESIGN which is completely missing in the registrants mark. Furthermore, even if broken up, Registrant's mark contains the plural of DESIGNS which consumers will take note of in addition to the addition of the additional words in Applicant's mark which appear before the words that are claimed to be similar to that of Registrant. Pursuant to the anti-dissection rule, the use of the words before RETRACTABLE enhance and lengthens the visual text of Applicant’s trademark in its entirety. As such, consumers will likely focus on these terms when observing Applicant’s mark. Given the above analysis, it is unlikely that a consumer would find confusion between the marks based on their significantly different appearance.

ii. *Sound*

In the present case, the phonetic difference between the Applicant’s mark THE ORIGINAL RETRACTABLE DESIGN WALL and the registered mark RETRACTABLEDESIGNS are clear, particularly since the Applicant’s mark requires the additional emphasized pronunciation of the words THE, ORIGINAL, and WALL. As the first two words precede Applicant's mark, consumers would pronounce that first resulting in a clearly dissimilar pronunciation when compared to Registrant's mark which does not require such a pronunciation.

Additionally, it has been held that even where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. *See National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed; including fact that while DUET was a familiar word, DUVET was not). Ultimately, as outlined in *DuPont* and other jurisprudence above, an ultimate determination on likelihood of confusion must be made taking into account all the various factors. (See also *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (“The basic principle in determining confusion between marks is that marks must be compared in their

entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted).”). As stated above, the visual differences between Applicant's mark and the prior registration present explicit differences refuting a claim of likelihood of confusion. Furthermore, as will be discussed below, the connotation/commercial impression of the marks and sophistication of the consumers will support a finding that likelihood of confusion does not exist between Applicant's mark and the prior registration.

iii. *Connotation/Commercial Impression*

Another factor in determining whether likelihood of confusion exists requires an examination into the meaning or connotation of the marks at issue. It has been held that even where marks share similar appearances and sound, the connotation and/or commercial impression derived from the marks may be sufficiently different enough where the likelihood of confusion is not established. *See, e.g., In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987) (finding that CROSS-OVER when applied to bras carried different connotation and/or commercial impression from CROSSOVER as applied to women's sportswear); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (finding that PLAYERS for men's underwear carried different connotation and/or commercial impression from PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q 629 (TTAB 1977) (finding that BOTTOMS UP for ladies' and children's underwear held a different connotation and/or commercial impression from BOTTOMS UP for men's clothing). Furthermore, such connotation and/or significance can be determined based upon a mark holder's current use in commerce. *In re Nationwide Industries*, 6 USPQ2d 1882, 1884 (TTA B 1984) (“Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to Ser No. 764198257 purchasers”).

In the present case, the context of the marks greatly differ. It is unclear as to Registrant's usage from the proof of use that was submitted to and accepted by the USPTO (*see Registrant POU*). However, looking the context and arrangement of Registrant's mark, it implies that the designs are retractable (hence Retractable-Designs) especially considering the pluralized form of DESIGN. Applicant's mark on the other hand makes reference to the fact that it can be used as a display rack as well as a portable mounted "wall" which can then be moved and is therefore a "retractable wall." This changes the context of not only the marks but the use and function of the goods as will be described below.

Consequently, taking the prior mark in its totality pursuant to the Anti-Dissection rule above, consumers would likely be able to differentiate the at-issue mark based not only on its visual differences when compared to Applicant's mark, but also the differing commercial connotation and impression derived from the prior registered mark.

2. Similarity as to Nature of Goods and Services/Trade Channels

As Examiner notes, the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP § 1207.01(a)(i). Examiner also points out that if the goods and/or services of the respective parties are "similar in kind and/or closely related," the

degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). However, 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 similar, confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener not held confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g. lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Even where marks are placed within the same class, it is possible to avoid a likelihood of confusion where the goods and/or services vary. *See, e.g., Taj Mahal Enterprises, Ltd. v. Trump*, 16 U.S.P.Q. 2d 1577 (D.N.J. 1990). In *Taj Mahal*, the marks under scrutiny were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort. The court held that the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for casino-hotel evokes images of grandeur, opulence and extravagance. Therefore, despite both falling under the same class of services for the purposes of registration, the *Taj Mahal* court found that there was no likelihood of confusion.

Examiner makes the argument that "the relationship of the goods is evident because both marks are for goods used in the arrangement or display of quilts. The proposed mark contains the identifier "design wall" and the registrant's goods are identified as design walls." However, as noted in Applicant's identification, Applicant's offerings are more in line with furniture as opposed to simple decor as that of Registrant. Applicant's goods can be used in a variety of ways, while including a display for quilts, also double as a "wall" which consumers can put up in a room to create a removable or "retractable" partition which is completely absent from Registrant's ID or usage. Applicant's goods can be mounted to act as decor as well as functional partitions which is very different in usage from that of the prior registered mark. Applicant's goods would be sold in home decor stores and furniture stores as adding aesthetic qualities to people's homes, while Registrant's goods would be sold exclusively to quilt-makers to arrange quilt material. These uses and trade channels differ to the point of alleviating any potential confusion as to the marks.

Clearly there is a strong dissimilarity between the nature of services and trade channels of the marks at issue. Since the marks are marketed in a unique manner and for a unique purpose, they will not be encountered by the same potential consumers and thus likelihood of confusion will not occur.

3. The Degree of Care/Sophistication Likely to be Exercised by Consumers

As analyzed in *DuPont, supra*: to the extent that a customer is likely to exercise a high degree of care and/or sophistication when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks. *See also TCPIP Holding Co., Inc. v. Haar*

Communications, Inc., 244 F.3d 88, 102 (2d Cir.2001) ("The more sophisticated the consumers, the less likely they are to be misled by similarity in marks."); *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 480 (2d Cir.1996) ("The sophistication factor recognizes that the likelihood of confusion between the products at issue depends in part on the sophistication of the relevant purchasers."). Furthermore, the degree of care factor plays a significant role in minimizing potential confusion where the subject goods fail to constitute "impulse" goods. See, e.g., *Astra Pharm. Prods. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) (finding that blood analyzers that cost between \$35,000 to \$60,000 require careful consideration likely to result in added consumer scrutiny and examination).

While the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. TMEP § 1207.01(vii). Here, Applicant and Registrant's services both are not "impulse" goods as discussed in *Astra Pharm*, as consumers will research and spend time on a products and services as complex as those that Registrant and Applicant offer. These goods and services are not offered for mere dollars. Furthermore, Applicant provides goods for consumers to not only add functionality in their homes by giving them the ability to create partitions in rooms, but also as displays for quilts, spools and bobbins, while Registrant provides an apparatus targeting quilt makers. The former deals with consumers that are interested in adding aesthetic and functional decor to their homes which leads to a certain sophistication. Registrant on the other hand sells something to arrange quilt material. Consumers are more likely to ensure who they are receiving these goods from and do research on the entity providing such. Furthermore, even using a least knowledgeable general consumer standard, it is unlikely that source confusion will take place. Where Applicant's services carry no express or implied association with the prior registered mark, consumers should easily be able to differentiate Applicant's mark as a unique source identifier.

4. The absence of actual confusion between the marks

Finally, Applicant is not aware of any instances of actual confusion as between the services offered in connection with its mark and the goods and services offered under the registered marks. Moreover, Applicant has used its mark in commerce since January 2010 and have coexisted with the registered mark without confusion which again suggests that confusion is not likely as between the marks should Applicant's mark be permitted to register. As such, it is submitted that this *DuPont* factor also favors registration of Applicant's mark.

D. **Conclusion**

In the Office Action, the Examiner contends that likelihood of confusion exist where Applicant's mark shares similarities in appearance, sounds, and channels of trade. However, Applicant asserts that an examination of the *DuPont* factors shows clear differentiation when comparing Applicant's mark to the prior cited mark. Thus, for all of the reasons set forth above, Applicant submits that there is no likelihood of confusion, mistake, or deception in the marketplace. The examiner may hence approve the mark for publication in the Official Gazette.

Request for Information/Merely Descriptive Analysis

A trademark is unregistrable on the Principal Register if it consists of a mark that is "merely descriptive or deceptively misdescriptive" of the applicant's goods or services. 15 U.S.C. § 1053(e)(1). It is well established that a mark is merely descriptive *only* if it *directly* conveys information concerning the function, characteristics, purpose or use of the goods or services. *Towers v. Advent Software, Inc.* 913 F.2d 942, 16 U.S.P.Q.2d 1039, 1040 (Fed. Cir. 1990). Furthermore, as Professor McCarthy explains:

Under the Lanham Act, as under the common law, one of the tests to determine whether a mark is "merely descriptive" is based upon what the mark would mean to the potential consumer when applied to the applicant's goods.

The word "merely" in the Act apparently means that if the mark clearly does not tell the potential customer *only* what the goods are, their function, characteristics, use or ingredients, then the mark is not "merely descriptive." The words "merely" also means that if a composite mark is not totally descriptive in all its parts, then the mark as a whole is not "merely" descriptive.

2 J Thomas McCarthy, McCarthy On Trademarks And Unfair Competition, § 11:51 at 11-95 to 11-96 (4TH Ed. 1999) (emphasis added); *See also In re Application of Quik-Print Copy Shops, Inc.* 616 F.2d 523, 525 U.S.P.Q. 505, 507 (C.P.A. 1980) ("mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services...").

The Trademark Trial and Appeal Board (TTAB) has stated the test for mere descriptiveness as follows:

It is well established that a term is considered to be merely descriptive of goods or services, within the measure of Section 2 (e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services.

In re Pennzoil Products. Co., 20 U.S.P.Q.2d 1753, 1755 (T.T.A.B. 1991).

As is made clear by such commentary and case law, the component of the "merely descriptive" test is not whether the mark can, in some manner, be considered descriptive, but whether the function, characteristics or use of the mark are *immediately* and *directly* conveyed, or in other words, whether there are always and only conveyed. TTAB, by using such terms as "immediately" and "directly," has set a high threshold under which a mark can be categorized as "merely descriptive." Applicant's mark for NUCIFERA does not cross this threshold. When analyzed according to these established standards, the mark is not merely descriptive because it conveys, in the very least, a number of different commercial impressions which do not immediately or directly describe Applicant's goods or their purpose, their nature of use, or the class of customers to whom those goods are offered.

The Court of Appeals for the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 1976 537 F.2d 4, identified four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these categories are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.

The court also recognized that the lines of demarcation are not always clear. Moreover, the difficulties are compounded because a term that is in one category for a particular product may be in quite a different category for another product. This is because a term may shift from one category to another in light of differences in usage through time as a term may have one meaning to one group of users and different meaning to others because the same term may be put to different uses with respect to a single product. The courts further described that a term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. In the present case, the applicant's mark falls under the category of either "arbitrary" or "suggestive" marks, rather than descriptive because it requires at the very least that a reasonable and prudent consumer go through a thinking process and apply some imagination to find out the exact nature of the applicant's goods and services. The applicant's mark does not immediately convey any idea as to the nature, ingredient, quality or any other characteristics of the applicant's goods.

The determination of whether or not a mark is merely descriptive also must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Ultimately, "a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception is required in order to determine what attributes of the goods or services the mark indicates". *In re Health Facts, Inc.*, 2001 TTAB LEXIS 16 (TTAB 2001) (citing, e.g., *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)); see also *West & Co., Inc. v. Arica Institute, Inc.*, 557 F.2d 338, 195 USPQ 466 (2d Cir. 1977).

Furthermore, "where there is doubt in the matter of deciding whether a mark is suggestive or descriptive, the doubt should be resolved in applicant's favor and the mark should be published for opposition." *In re Idiag*, 2001 TTAB LEXIS 475 (TTAB 2001) (citing See *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981) and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972); *In re Atavio*, 25 USPQ 2d 1361 (TTAB 1992); *In re Bed-Check Corp.*, 226 U.S.P.Q. 946 (TTAB 1985).

Applicant does not have advertisements of the products as all advertising up to this point has been done word of mouth and there are no similar goods of the same type as Applicant's that are currently out on the market. As Examiner notes, a "design wall" is found quite often, however, the

unitary mark references Applicant's product as not only a design wall, but a retractable wall partition as well. Applicant's goods are used as a display rack as well as a retractable wall which creates an aesthetic yet functional partition to any room.

Applicant's products range in dimensions, but are generally about 9 feet long, which would act as a complete wall in most standard rooms. The product can be mounted to the ceiling or wall to wall to set up a display rack and furniture home decor accessory as moveable wall partition which can retract back into the housing to eliminate the partition.

Thus, Applicant's trademark has multiple meanings and is used suggestively to convey that not only are the goods design walls, but also retractable walls and such usage is unique not only in reference to applicant's product but the name as well. The potential consumers of Applicant's goods, as stated earlier, are those people who are in the market for a display rack that functions as a retractable and moveable wall partition as well. Applicant's goods would be available right now through direct purchase from the Applicant, but may also be found in home decor stores or departments as furnishings.

In view of the argument above, Applicant respectfully requests that the Examiner withdraws all objections listed in the office action and allow the applicant's trademark application to proceed for publication in the Official Gazette.