

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE IN RE TRADEMARK APPLICATION	
Applicant: Polabe Holding N.V.	
 Trademark:	
U.S. Serial No. 88/972,368	Date: November 9, 2020
Date: November 9, 2020	Our Ref: 314957-00003

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

#### RESPONSE TO OFFICE ACTION

This is in response to the Office action dated May 8, 2020 initially refusing registration of Applicant's mark under Section 2(d) of the Lanham Act, based on an alleged likelihood of confusion with the marks of U.S. Registration Nos. 1,251,535, 2,820,771 (for class 25 only), and 4,464,999.

Applicant Polabe Holding N.V. is the owner of the cited Registration Nos. 1,251,535 and 4,464,999 for the mark COMMODORE. Registration No. 4,464,999 for the mark COMMODORE was cancelled on August 21, 2020 for failure to file the Section 8 Declaration. This registration should no longer be a bar to registration.

Although TSDR has not yet automatically updated the ownership, Registration No. 1,251,535 is also owned by Polabe Holding N.V. A corporate change of name from the owner C= Holdings B.V. to Net B.V. was recorded on November 3, 2020. A further Assignment of the registration from Net B.V. to Polabe Holding N.V. was recorded on November 5, 2020. A copy of the Notice of Recordal is attached as Exhibit A.

With respect to Registration No. 2,820,771 for the mark COMMODORES in Class 25 for "clothing, namely t-shirts," (the "Registration") Applicant respectfully submits that there is no likelihood of confusion because Applicant's mark and the mark of the Registration are

sufficiently different in sight, sound, and commercial impression in connection with the goods such that consumers will not be confused by the use of the respective marks on the goods.

That the common element COMMODORE is shared by both marks is not dispositive of the issue of likelihood of confusion. “The use of identical, even dominant, words in common does not automatically mean that the two marks are similar... Rather in analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features.” *General Mills v. Kellogg Co.*, 824 F.2d 622, 627 (8<sup>th</sup> Cir. 1987). To analyze the commercial impression, the entirety of the marks must be considered in “the marketing environment in which a purchaser normally encounters” the marks. *In re Sydel Lingerie Co., Ltd.*, 197 USPQ 629,630 (TTAB 1997); See also *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (where CROSSOVER for brassieres and CROSSOVER for ladies’ sportswear were found to create different commercial impressions as a result of their different meanings and connotations when applied to the respective goods despite being identical marks).

The mark of the Registration, COMMODORES, as used by Registrant Vanderbilt University, has the meaning and connotation of the school mascot. Vanderbilt’s athletic teams are known as the COMMODORES, referring to Cornelius Vanderbilt’s nickname based on the Navy rank. See Exhibit B. A consumer encountering the COMMODORES mark on t-shirts in the marketing environment in which the mark is used, would understand the meaning of the COMMODORES mark to be that of the Vanderbilt mascot and nickname. See example of marking environment of Registrant’s t-shirts included in Exhibit B. The fact that the mark is plural and includes an -S is significant. Sports team nicknames are typically referred to in the plural, e.g. The Eagles, The Saints, The Nittany Lions, The Giants, The Owls, The Aggies, etc. See Examples of team names provided as Exhibit C.

Applicant’s COMMODORE mark is different in sight and sound from the mark of the Registration, as it is missing the final -S of Registrant’s mark. In addition, the COMMODORE mark of the instant application is employed in a different marketing context for a different set of purchasers, and thus creates a distinct meaning and commercial impression from those of the mark of the Registration. Applicant Polabe Holding N.V. owns the rights to the COMMODORE marks as used in connection with computers, computer peripherals, and other electronics since at least as early as 1977 (see, e.g. Reg. No. 1,251,535 discussed above and June 18, 2013 Specimen of use submitted by Registrant). The mark COMMODORE has long been connected with computers and related electronic devices in the minds of consumers and has become a beloved brand because of its history. See example attached as Exhibit D. Its meaning and commercial impression is distinct from that of the COMMODORES, the Vanderbilt University nickname.

In addition, Applicant’s mark has a very distinguishing design element which further distinguished the commercial impression of Applicant’s mark from that of Registrant’s mark. The C with the blue and red trapezoid shapes (or as it is affectionately known, the “chicken head” design) has been used in connection with applicant’s computer systems in various forms

since at least as early as 1977. See TDSR page of Reg. No. 1,242,650 owned by Applicant for C and design attached as Exhibit E; see also as examples: Exhibit D; June 18, 2013 specimen of use submitted with Reg. No. 1,251,535. Thus, the design element is well known as a source indicator for goods sold under the mark of the application, especially in connection with the COMMODORE name. The COMMODORE portion is also highly stylized.

When a mark at issue has eye-catching design or stylized features, more attention may be paid to the importance of the design, and there is less likelihood of confusion between the appearance and commercial impressions of the marks at issue. See *In re White Rock Distilleries, Inc.* 92 USPQ2d 1282, 1284 (TTAB 2009) (finding no likelihood of confusion between applicant's VOLTA mark in standard characters and Registrant's TERZA VOLTA mark for highly related goods due to the prominent design feature in registrant's mark that created a distinct appearance and commercial impression); *In re Covalinski*, 113 USPQ2d 1166, 1169 (TTAB 2014) (finding no likelihood of confusion for RACEGIRL and REDNECK RACEGIRL both for clothing due to the highly stylized letters in REDNECK RACEGIRL). Here, the design element is very eye-catching, prominent, and well known, and therefore distinguishes the commercial impression of the mark of the application from that of the mark of the Registration.

It is common for universities to promote their sports teams via t-shirts, and it is also common for brands in general to sell promotional goods such as t-shirts bearing their marks of their primary goods. Because of the differences in the meaning and commercial impression created by the long period of use of each of the marks and the very distinct and noticeable design element of Applicant's mark, consumers are not likely to be confused as to the source of the t-shirts sold under each mark.

Despite the common element, Applicant's mark and the mark of the Registration have distinct connotations in the commercial contexts in which they are used and understood by purchasers and potential purchasers. Confusion is accordingly unlikely granted the difference in marks, connotations and commercial impressions, and customers.

Applicant accordingly respectfully requests that the Examining Attorney reconsider and withdraw the refusal under Section 2(d) in light of the arguments and case law presented above and approve the mark of the instant application for publication.