

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of The Sugar Art Inc,

Serial No. 88351411

Trademark: DIAMOND

Filing Date: Mar. 22, 2019

RESPONSE TO OFFICE ACTION

COMES NOW the Applicant The Sugar Art Inc, (hereinafter “Applicant”) and respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s trademark DIAMOND, Serial No. 88351411, under Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

ARGUMENT IN SUPPORT OF REGISTRATION

The Examining Attorney refused registration of Applicant’s mark on the basis that, if registered, it would create a likelihood of confusion with the trademark(s) DIAMOND DUST as more fully set forth in U.S. Ser. / Reg. No(s). 88230018.

The Likelihood of Confusion Standard

A determination of a likelihood of confusion between trademarks is made on a case-by-case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). An examining attorney is required to apply *each* of the applicable factors set forth in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). As the Examining Attorney is aware, the relevant *du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods 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 number and nature of similar marks in use on similar services; and
- (6) The absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

Id.

Applying the legal standards as enumerated above, it is clear that confusion is not likely as between Applicant’s trademark and the cited trademark(s) and, accordingly, it respectfully requested that the refusal to register DIAMOND be withdrawn.

Differences in Appearance

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973)). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related. Additions or deletions to marks are often sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

An examining attorney is tasked with evaluating the overall impression created by the marks and not merely comparing individual features of the same. *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 regard, an

examining attorney must determine whether the total effect conveyed by involved 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 if the marks contain the same dominant word or terms such does not automatically lead to a conclusion that the two trademarks are confusingly similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. 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. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

In the instant case, Applicant’s trademark DIAMOND differs in appearance from the blocking trademark in that it is spelled differently has less words than the blocking trademark. My product is Food Color that you can eat. All the other ones that are shown on those other websites such as cakeart.com and <https://www.fondantsource.com/> sell are non toxic you cant eat it. Also some of them are made from plastic glitter that can not be eaten, and others are mica that's not approved for food use. They are only good for decorations, not edible. As you can see non of them you looked at have a ingredients on the label and depending on how the labels are shown they say non toxic on there. Every one of those people are miss leading about the product which is important

why I should have a trade mark for that name. Everyone is assuming that those colors edible but they are not. In this regard, Applicant's trademark creates an overall separate and distinct commercial impression apart from the cited trademark(s) given the differences in the appearances of the marks.

Given these separate and distinct commercial impressions, it is respectfully submitted that this *du Pont* factor favors a finding of an absence of a likelihood of confusion between the Applicant's and the cited trademark(s).

Differences Between Goods and Services

The nature and scope the goods or services offered in connection with the Applicant's and the registrant's trademarks must be determined on the basis of the goods or services identified in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010).

The issue is not whether the goods and services will be confused with each other, but rather whether *the relevant consuming public* will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). 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. *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); *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).

There is no rule that certain goods or services are *per se* related such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (regarding alcoholic beverages); *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer

hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171–72 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (regarding clothing); *see also M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate).

In the instant matter, Applicant provides the following identification in the subject application:

Food coloring.

To the contrary, the registered trademark provides the following:

Decorative glitter.

Within this context, there is little to no similarity between the goods and services of the Applicant and those provided in connection with the cited trademark(s). Returning to the rule at hand, based upon the goods and services identified in the Application and cited trademark(s), *the relevant consuming public* would simply be confused as to their respective sources. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000).

Given these separate and distinct goods and services, it is respectfully submitted that this *du Pont* factor favors a finding of an absence of a likelihood of confusion between the Applicant's and the cited trademark(s)

.Distinctions Between Trade Channels

The Applicant's goods and services travel in separate and distinct channels of trade apart from the registered trademark's goods and services. Specifically, Applicant's goods and services

bearing Applicant's trademark reach the end consumer by and through Retail Store Internet Store Wholesale Other (Goods).

In contrast, there is no evidence of record that would indicate that the registered trademark's goods and services reach end consumers by and through these same means. In this regard, there is no evidence of an overlap as between the channels of trade of the Applicant and the cited trademark(s).

Accordingly, it is respectfully submitted that this *du Pont* factor favors a finding of an absence of a likelihood of confusion.

Distinctions Between Marketing Channels

The Applicant's goods and services are marketed in a manner distinct from the marketing of the cited trademark(s). Specifically, Applicant markets its goods and services by and through Internet / Website Pay-Per-Click Advertising Social Media (e.g., Facebook, Instagram, Twitter).

In contrast, there is no evidence of record that would indicate that the registered trademark's goods and services are marketed by and through these same means. In this regard, there is no evidence of an overlap as between the marketing channels of the Applicant and the cited trademark(s).

Accordingly, it is respectfully submitted that this *du Pont* factor favors a finding of an absence of a likelihood of confusion.

Absence of Actual Confusion

Finally, there is no evidence of record indicating that there has been actual confusion in the marketplace as between Applicant's trademark and the cited trademark(s).

The absence of any instances of actual confusion is a meaningful factor where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have

been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or all affected trademark owners. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

As the Examining Attorney has alleged, the Office believes that the Applicant's goods and services and those of the registered trademark travel in similar trade channels and are marketed in a similar enough manner to create a likelihood of confusion. While not conceding this point, provided that this is, in fact, the Office's position it would be contradictory to discount the absence of actual confusion as between the trademarks at issue where the Office contends there is an overlap in marketing and trade channels.

Accordingly, consistency in the Office's position, whether or not countered by the Applicant in the instant Argument, suggests that the Office should consider the absence of evidence of actual confusion to be a meaningful factor in the instant analysis, a factor which clearly supports registration of Applicant's Trademark under this *du Pont* factor.

CONCLUSION

Based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's Trademark.

WHEREFORE it is respectfully requested that the Examining Attorney reconsider the instant refusal, remove as an impediment the cited trademark(s), and approve the instant Application for publication.

Respectfully submitted this January 9, 2020,

The Sugar Art Inc,
844 N. Crowley Rd

Crowley, TEXAS 76036