

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : AJ UNION GROUP, INC.
Serial No. : 88369513 Examiner: Troy F. Knight
Mark : BENITO Law Office 107

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

APPLICANT’S RESPONSE TO OFFICE ACTION DATED JULY 09, 2019

Applicant’s amendment of the list of goods is below.

Applicant respectfully disagrees with the Examiner’s likelihood of confusion refusal based on one prior registered mark. The competing marks are different in appearance, sound, meaning and commercial impression, and the degree of care exercised by consumers of Applicant’s and Registrants’ goods is heightened to a degree that consumers will readily distinguish the marks. Moreover, the goods provided by both Applicant and Registrant are not generally known to emanate from a single source.

1. Amendment to List of Goods

Applicant amends the list of goods as follows:

Class 25: “Shoes only”

2. The Marks are Dissimilar, and the Goods are Orthogonal

Applicant respectfully contends that BENITO (“Applicant’s Mark”) for “Shoes (“Applicant’s Goods”) does not resemble in sound, appearance or meaning BENITO & BENITA (“Cited Mark”) for “Children's and infants' apparel treated with fire and heat retardants.....”

(“Cited Goods”). Nor is registration of Applicant’s Mark likely to cause confusion, or to cause mistake, or to deceive.

An examination of the relevant factors under TMEP §1207 and *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973), warrants the conclusion that Applicant’s Mark cannot be said to so resemble the Cited Mark that it is likely to cause confusion, or to cause mistake, or to deceive given careful consideration of the differences between: (i) the marks themselves, especially in light of the differences in sound, appearance, meaning, and commercial impression; (ii) the parties’ respective goods; and (iii) the sophistication of the relevant consumers.

A. The Goods are Statistically Unrelated

Applicant’s goods are in classes 25 and are identified as “Shoes only” In contrast, the cited goods are “Children's and infants' apparel treated with fire and heat retardants, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Down jackets; Hats for infants, babies, toddlers and children; Hooded sweatshirts for children; Knit dresses; Knit jackets; Knit skirts; Outer jackets; Sweaters for children; Sweatshirts for children; Tops for children; Wind coats; Coats for children; Dresses for children; Pajamas for children; Shirts for infants, babies, toddlers and children; Shorts for children; Sweatpants for children; T-shirts for children; Trousers for children”. The importance of Children's and infants' clothing appears to be paramount to registrant. In contrast, Applicant’s goods are not for Children's and infants' purposes.

It is well-held that a small number of third-party registrations featuring similar or identical goods is insufficient to show that a certain type of a good may emanate from a single source. *See In re Band-It-IDEX, Inc.*, Serial No. 77363240 (T.T.A.B. October 20, 2009) (non-

precedential) (finding third-party registrations that contained similar, but not identical, goods to have “less probative value, under *Trostel* and *Mucky Duck*, as evidence that applicant’s goods and the goods in the cited registration are related.”); *In re Carrier Corp.*, Serial No. 78329277 (T.T.A.B. February 15, 2008) (nonprecedential) (“Upon closer examination of the evidence submitted by the examining attorney, we find that only one use-based third-party registration includes fan coils and ceiling fans This single registration is insufficient to show that applicant’s fan coils and registrant’s ceiling fans are of a type which may emanate from a single source.”); Indeed, a low number may, under some circumstances, suggest that the goods/services are in fact not related. See *In re Coors Brewing, Co.*, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003) (“although the Board had before it a few registrations for both restaurant services and beer, . . . the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark.”).

Applicant’s Goods are not for Children or Kids

Additionally, Applicant has further amended its goods to “Shoes only” in class 25. This limitation of its goods further distinguishes Applicant’s Goods from Registrant’s Goods and ultimately distinguishes Applicant’s Mark from the Cited Mark. Indeed, in at least one case, the Board held that, without a showing of the specific limitation in third-party registrations, an amendment to a list of goods was enough to obviate a likelihood of confusion. *In re Vafiadis*, Serial No. 78509712 (T.T.A.B. January 24, 2007) (nonprecedential) (applicant amended its goods to mineral water distributed in the dental field – “None of the third-party registrations includes ‘mineral water distributed in the dental field.’ Therefore, we do not find the examining attorney’s evidence persuasive on this point.”)

B. The Marks Have an Entirely Different Commercial Impressions

Applicant's Mark is a mark comprised of six letters, BENITO, and the Cited Mark consists of thirteen letters BENITO & BENITA.

The Marks Are Different in Appearance, Sound and Meaning

Here, Applicant's Mark is comprised of six letters. When compared sidewise, the mark creates an incongruity and an entirely different commercial impression from the Cited Mark. The Cited Mark, on the other hand, is composed entirely of the word BENITO & BENITA. When compared, Applicant's Mark and the Cited Mark convey highly dissimilar commercial impressions.

The appearance, sound and meaning conveyed by the competing marks is highly dissimilar. Specifically, Applicant's Mark does include additional symbol and characters. The Board has, on at least one occasion, found different meanings AND different commercial impressions to outweigh any other similarities. Specifically, in *In re Allegiance*, no confusion was found by the Board between ALLEGIANCE STAFFING and ALLEGIS for employment agency services. ALLEGIANCE and ALLEGIS were separated by a few letters. The Board found the differences in meaning of the marks, and the differences in commercial impression, outweighed any similarities in appearance and pronunciation caused by the common prefix ALLEGI. The Board concluded that ALLEGIANCE and ALLEGIS are two words that include similar sections, "ALLEGIS" and are separated by one letter "N," but were not similar enough to rise to a likelihood of confusion.

Similarly, here, BENITO is comprised of six letters while the Cited Mark is a 13 letters mark. The difference in meaning in the marks here coupled with the difference in appearance, sound and commercial impression is highly significant and no confusion should be found.

C. Sophistication of the Relevant Consumer

Given the commercial reality, it is not just unlikely, but almost inconceivable that the respective relevant consumers would mistakenly believe that the parties' goods originate from the same source or that a connection or sponsorship exists when faced with the Cited Mark versus Applicant's Mark. In determining whether the parties' goods are so related that a likelihood of confusion will result from registration of BENITO, the practicalities of the commercial world should be guiding. Consumers seeking to utilize the Cited Goods exercise great care when choosing a dress or clothing for kids and shoe for an adult, which is likely to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985) (no likelihood of confusion between NARCO and NARKOMED because only sophisticated purchasers exercising great care would purchase the relevant goods). Here, as the Cited Goods are marketed to sophisticated consumers, the purchasing decision made is one of great care and is not a spontaneous decision. In contrast, Applicant's Goods are also purchased by sophisticated and adult consumers – sophisticated consumers seeking specific shoes not clothing for kids' purposes. As a result, consumer confusion is not likely to result from the registration of Applicant's Mark.

For all the foregoing reasons, Applicant respectfully requests that the Examining Attorney find that BENITO, when used in connection with Applicant's amended Goods, is not likely to cause consumer confusion with the Cited Mark, and pass the Application to publication.