

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : CONNOISSEUR (and design)
Serial No. : 88446879
For : remarkable.legal
Examiner : Raymond Lee
Law Office : 127

RESPONSE TO OFFICE ACTION DATED 09/03/2019

This is responsive to Office Action dated 09/03/2019. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Connoisseur LLC seeks registration of U.S. Serial No.88446879 for CONNOISSEUR (and design) in relation to "Clothing, namely, base layers" in International Class 25. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); see TMEP § § 1207.01 et seq.

•U.S. Registration No. 5269286 for HANGJIA covering "Coats; Dresses; Knitwear, namely, shirts, dresses, sweaters and coats; Outer jackets; Shirts; Skirts; Sports jerseys; Tee-shirts; Trousers; Underwear" in International Class 25.

**APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF
CONFUSION**

Applicant respectfully disagrees with the Examining Attorney's decision for the reasons discussed below.

The Standard for Determining Likelihood of Confusion

A determination of likelihood of confusion between two marks is determined on a case by case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The Examining Attorney is to apply each of the applicable thirteen factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors as they relate to likelihood of confusion in this case are reviewed below.

**The similarity or dissimilarity of the marks in their entireties as to appearance, sound,
connotation, and commercial impression;**

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 in one respect - sight,

sound, or meaning - does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "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." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

1. No Explicit Rule that Likelihood of Confusion Applies Where Junior User's Mark Contains the Whole of Another Mark.

There is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole of another mark. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A.

1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to in-corporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion. Here, the marks don't share a term in common. Registrant's translation statement is inaccurate or at least ambiguous, as shown on a Google Search or Collins Dictionary. Exhibit 1 and 2.

2. The Doctrine Foreign Equivalentents Should Not Be Applied Mechanically.

The doctrine of foreign equivalentents is not intended to be applied in an inflexible manner and “is not an absolute rule and should be viewed merely as a guideline.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005). In some cases, the descriptive nature of the non-English word may depend on the way it is used and displayed. *McCarthy on Trademarks and Unfair Competition*, Vol. 2, Sec. 11:34. The average Spanish-speaking consumer would be unlikely to view a nonconcordant mark as merely descriptive of the applied-for goods or services. *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 78 U.S.P.Q.2d 1454 (1st Cir. 2006) (When used in the label “GALLETAS RICA SUNLAND,” the word “rica” is not descriptive of cookies or crackers (“rich” or “tasty”) because it is not grammatically correct.). Similarity of connotation and equivalency between foreign and English words is to be tested with the same stringency as with two English words. *In re Buckner Enterprises Corp.*, 6 U.S.P.Q.2d 1316 (T.T.A.B. 1987) (no likelihood of confusion was found between the PALOMA and DOVE marks, both for heating apparatus, inter alia on the ground that “paloma” is not an exact Spanish equivalent of the English “dove,” because “paloma” might also translate as “pigeon,” which is clearly not the synonym of “dove.”).

Even if we admit Applicant’s use will be widely recognized by the general American public, the term HANGJIA could potentially be translated to multiple English words among them: expert, professional, and connoisseur. (Exhibit 1 and 3). As such, Examiner’s assertion that **HANGJIA** and **CONNOISSEUR** have identical meanings is not accurate. There are a variety of different commercial impressions that could be derived from the different translations. Moreover, logic dictates that native mandarin speakers are accustomed to reading mandarin characters - not a transliteration into English.

Therefore Examiner's has applied mechanically the Doctrine of Foreign Equivalents, considering that Registrant's mark translation is ambiguous.

2. Marks Differ in Sight, Sound, and Commercial Impression



a. Marks Differ in Sight

Where there is an addition of a distinctive element, as in a term or a design, or there is a significantly different display of the same terms, there is little likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). Likelihood of confusion is minimized where a design is used as part of a mark. *Harlem Wizards*, 952 F. Supp. at 1096 (citing *McCarthy* at §23:15[51]).

A visual examination of the literal elements of the conflicting marks supports a finding that they are different. Applicant's mark consists of the wording "CONNOISSEUR" in black and a statue set in the letter "C". In contrast, the Registrant's mark consists of a stylized version of the term "HANGJIA". Given the significantly different literal elements discussed above, there is little likelihood of confusion.

b. Marks Differ in Sound

Here, the marks vary substantially in sound. Applicant's mark is pronounced with three syllables whereas Registrant's marks are pronounced with two syllables. Additionally, Applicant's mark has French style pronunciation, while Registrant's mark would inherit Chinese style pronunciation. As such, these marks sound little alike and have an entirely different phonetic profile.

However, 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 such as the term "duet" was a common word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

c. Marks Differ in Commercial Impression

The marks in this case vary substantially in commercial impression. Applicant's mark CONNOISSEUR (and design) for clothing gives the idea of apparel meant for thoughtful gentlemen, designed and made by knowledgeable craftsmen. The way the applicant's mark is presented also inspires the idea of clothing for members of high society. The use of a French word and its unique font communicates luxury. In contrast, Registrant's mark for clothing does not present a clear idea to the average American consumer. The average American consumer will conclude the brand is of Asian

origin, but won't know the meaning of the brand unless it's explained. Thus, consumers would think HANGJIA is a cheap and low quality clothing brand. (Exhibit 1). Alternatively, consumers could also interpret the brand to mean Hang or Hang out, leading to the conclusion it's clothing for hanging out. Recognizing that HANGJIA could potentially be translated to multiple English words among them: expert, professional, and connoisseur, Registrant's mark doesn't provide a clear idea to American consumers. Given the significant differences in commercial impressions, there is little likelihood of confusion between the marks.

CONCLUSION

For the reasons listed above, Applicant respectfully requests that the Examining Attorney should remove all refusals for the trademark CONNOISSEUR (and design) (U.S. Serial No. 88446879) and approve the mark for publication.

Respectfully submitted:



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