

**APPLICANT'S RESPONSE TO OFFICE ACTION FOR
U.S. TRADEMARK APPLICATION NO. 87983428
SLAY**

RESPONSE TO FINAL OFFICE ACTION

This communication responds to the Final Office Action emailed on December 5, 2020 in which the Examining Attorney refused registration of Applicant "SLAY" mark on the grounds of an alleged likelihood of confusion. Applicant incorporates the arguments from the communication submitted on December 27, 2018 and respectfully disagrees that there is any likelihood of confusion and requests that the Examining Attorney consider Applicant's response below.

SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION

Applicant's mark, SLAY in stylized letters has been refused registration under Trademark Act Section 2(d) because the Office Action takes the position that it is likely to be confused with the Registered Mark: U.S. Registration No. 5008221, standard character mark "SLAY". For reasons discussed below, Applicant respectfully disagrees with this rejection and requests that the rejection be withdrawn.

Likelihood of confusion is determined on a case-by-case basis, with the application of the factors identified in *Application of E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Under the likelihood standard, it must be probable that confusion as to source will result from the simultaneous registration of two marks; the mere possibility of confusion is insufficient. Trademark law is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969).

As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording, as demonstrated in numerous federal cases and Board proceedings. *See, e.g., IN RE HARTZ HOTEL SERVICES, INC.*, 2012 WL 1267900 (T.T.A.B. 2012) (no likelihood of confusion between GRAND HOTELS NYC and GRAND HOTEL for hotel services); *IN RE INTELISTAF HEALTHCARE MANAGEMENT, L.P.*, 2006 WL 936990 (T.T.A.B. 2006) (no likelihood of confusion between INTELLICASH for consumer debit card services and INTELECASH for business services involving debit cards); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON TEA PARTY for tea and BOSTON SEA PARTY for restaurant services); *Omaha Nat. Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231 (D. Neb. 1986) (no likelihood of confusion between BANK IN A BILLFOLD and BANK IN A WALLET for banking credit card services); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344 (Fed. Cir. 2011) (no likelihood of confusion between CAPITAL CITY BANK and CITIGROUP for banking and financial services); *Franklin Resources, Inc. v. Franklin Credit Management Corp.*, 988 F. Supp. 322 (S.D. N.Y. 1997) (no likelihood of confusion between FRANKLIN for investment services and same mark for debt collection services); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp.

1029 (S.D. N.Y. 1990) (no likelihood of confusion between COMSTOCK for stock and commodity trade information services and same mark for money management services); *Allstate Ins. Co. v. Allstate Inv. Corp.*, 210 F. Supp. 25 (W.D. La. 1962), judgment aff'd, 328 F.2d 608 (5th Cir. 1964) (no likelihood of confusion between ALLSTATE for insurance services and same mark for mortgage brokerage services).

Indeed, as the Board has frequently held, registrations for identical marks for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion. *See, e.g., In re Itec Manufacturing, Ltd.*, 2008 WL 885926, *4–5 (T.T.A.B. 2008) (PAL for a patient-lifting medical device and PAL for lithotomy medical devices and patient support mattress pumps); *In re Hyundai Motor America*, 2009 WL 4086577 (T.T.A.B. 2009) (ECHELON for automobiles and ECHELON for automotive tires); *In re Kaemark, Inc.*, 2008 WL 5256390 (T.T.A.B. 2008) (LUXE for salon furniture and LUXE for furniture); *IN RE HAGEMEYER NORTH AMERICA, INC.*, 2007 WL 2698300 (T.T.A.B. 2007) (VERSAPRO for weed killer and VERSAPRO for garden tools); *IN RE APOLLO COLORS, INC.*, 2005 WL 1787221 (T.T.A.B. 2005) (APOLLO for color pigments in the graphic arts industry and APOLLO for dye and pigments used in the leather and textile industry).

The Examining Attorney is correct that the similarity of the marks should be considered, however, it is just one of many relevant factors to be considered here. Though Applicant acknowledges that the Mark and the Registered Mark are the same term, the dissimilarity of the products, target audience, and channels of trade are equally important.

The Term “SLAY” is Weak and Diluted

Confusion is less likely if the similarity between two marks derives from a commonly used term. When a mark or term is very frequently used in association with certain classes of goods, consumers are accustomed to distinguishing between such marks based on only small differences. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.* 797 F.3d 1363, (Fed. Cir. 2015). In such cases, only minor distinctions are necessary to avoid a likelihood of confusion. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 (Fed. Cir. 2015).

In this case, the term “SLAY” is very commonly used in popular culture and apparel branding. For example, the marketplace is exposed to SLAY (Reg. No. [5008221](#)), SLAY YOUR GOLIATH (Serial No. [90154617](#)), SLAYTHEDAY (Reg. No. [5449529](#)), and 41 other live trademarks (registered marks and pending applications)¹ among a multitude of other uses in popular culture. A glance at the first few pages of Google’s search results shows SLAY APPAREL, SLAY CLOTHING, SLAYCO, SLAYS and more, indicating that consumers are distinguishing between the various sources of clothing and apparel that use this term based on small differences in their marks.²

¹ Exhibit A - printout of <https://tmsearch.uspto.gov/bin/gate.exe>

² See printout of website located at _____, attached as Exhibit B.

The marketplace plainly shows that the term “SLAY”, or its equivalents, are very commonly used on Class 41 educational services. As a natural result, the purchasing public has come to distinguish one mark that utilizes “SCALE UP”, or its equivalents, from the next on the basis of very small differences. In a crowded field, minor differences such as descriptive words or disclaimed terms, or a minor variation in the goods, can be sufficient to avoid a likelihood of confusion. Such is the case here.

The Applicant’s Mark Is Visually Dissimilar From The Registered Mark and The Marks Create Distinct Commercial Impressions In Their Respective Contexts

The Applicant's Mark is dissimilar from the Registered Mark in overall commercial impression. In fact, there is no per se rule that confusion automatically exists between marks containing the same term. Here, a proper comparison of the marks in their entireties reveals that confusion is unlikely.

Applicant’s mark is visually different from Registrant’s standard character mark due to the inclusion of the stylistic elements and font used. As such, consumers who regularly encounter Registrant’s mark will immediately recognize the visual difference between the marks, since Applicant’s Mark uses these same elements across her various products and services, while Registrant’s Mark does not.³ Though it may be true that consumers focus on the dominant portion of a mark, Applicant respectfully holds the view that the peripheral elements in Applicant’s mark, when compared to the Registrant’s mark, create enough distance between them that consumers face little danger of being confused.

Relatedness of the Products

In addition to the arguments provided above, the Applicant argues that there is no likelihood of confusion for the following reasons. First, the type of apparel are not related, and even if they were, consumers will not encounter both the Applicant’s Mark and the Registered Mark in the same channels of trade. The athletic apparel of the the Applicant’s Mark are dramatically different from the generic t-shirt cited by the Examining Attorney. The goods are not likely to be sought by the same consumers. Thus, there is no likelihood of confusion based on the *du Pont* factors because as consumers will not be faced with the similar choices; there is no one consumer who will be faced with both services, and hence no confusion. *David Crystal, Inc. v Soo Valley Co.*, 471 F.2d 1245, 176 U.S.P.Q. 326 (C.C.P.A. 1973) (sales to industrial users and to consumers).

Second, if the goods in question are not 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); *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 121 U.S.P.Q. 430 (2d Cir. 1959) (wholesale donut mix versus retail donut sales). *See also Joseph Tetley & Co. v.*

³ See Exhibit C Registrant’s use of its mark on its website

Fant Milling Co., 111 F.2d 485, 45 U.S.P.Q. 433 (C.C.P.A. 1940). Here, the athletic apparel is only available on the Applicant's site. Meanwhile, the Registrant's products are only available on its own site. Therefore, those consumers who are familiar with and utilizing the Applicant's other products, will only encounter the apparel via Applicant's site and will immediately recognize they are at the wrong site, if they were to mistakenly visit the Registrant's site.

Finally, even if consumers encountered the marks in the same channels of trade, there would still be no likelihood of confusion. The mere fact that two parties may operate in the same broad industry, such as apparel, or that two products may move in the same channels of trade to the same class of purchasers does not, *ipso facto*, prove that there is a definite relationship between the two types of goods or services. *Champion Int'l Corp. v. Genova, Inc.*, 199 USPQ 301, 305 (TTAB 1978); *Saks & Co. v. Snack Food Assoc.*, 12 USPQ2d 1833, 1835 (TTAB 1989) ("Merely because opposer sells what can be characterized as snack foods, even snack foods bearing the 'SFA' logo, in its retail establishments, does not create a sufficient nexus with the association services applicant renders to the sack food industry"); *in re Quadra Corp.*, 228 USPQ 863, 865 (TTAB 1985) ("[W]e think that a *per se* rule relating to source confusion vis-a-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace"); *see also, Recot, Inc. v. M.C. becton*, 214 F.3d 1322, 54 U.S.P.Q.2d (BNA) 1894, 1899 (Fed. Cir. 2000) (although parties' goods are sold in some of the same channels of trade, including supermarkets and grocery stores, there is no *per se* rule that all products sold within supermarkets are related by virtue of being sold in same establishments).

Conclusion

In sum there is no likelihood of confusion because (1) the marks use weak or diluted terms and are distinct from each other, (2) the products provided by the Applicant and the Registrant are not related and (3) the products are not made available in the a manner as to cause a likelihood of confusion for consumers. Accordingly, this Application should be approved for publication, and action to such effect is respectfully requested.

Dated: June 11, 2021

Respectfully submitted,

/Benjamin E. Becker/

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