

## Likelihood of Confusion

### CITED REGISTRATION

The Examiner has refused registration of the subject mark based on a likelihood of confusion with Reg. No. 3256611 for VANQUISH owned by LVMH Swiss Manufactures SA. Applicant respectfully asserts that, for the reasons set forth below, there is no likelihood of confusion between the applied for mark and the cited registration.

The factors to be applied when evaluating a likelihood of confusion between two trademarks are found in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). Among the premier factors to be considered under *duPont* are the similarity of the marks, similarity of the goods, and the similarity of the channels of trade.

In order to refuse registration under Section 2(d), there must be shown more than a mere possibility of confusion; instead, there must be demonstrated a probability, or likelihood, of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 418 F.2d 1403, 164 USPQ 43 (CCPA 1969) as follows: “We are 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.” See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987). The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace.

As the Court of Customs and Patent Appeals stated in the *duPont* case, there is no litmus test for assessing confusion.

[T]rademark law must necessarily be flexible responding to particular circumstances disclosed by particular fact situations thereby making a hard and fast rule in these cases anathema to its concept and application. That is, this is contrary to the principle of trademark law that each case must be decided on the basis of all relevant facts which include the marks and the goods as well as the marketing environment in which in which a purchaser normally encounters them and the experience generated as a result of their use in the marketplace providing such use has been of sufficient length and depth to make an impact in the market. *Interstate Brands Corporation v. Celestial Seasonings, Inc.* 196 USPQ 321, 324 (TTAB 1977).

Here, the Examiner has refused registration because “the marks of the parties are identical in all aspects.” Applicant disagrees. The marks do share the common term VANQUISH, however, similarity of the marks in *one respect* – sight, sound or meaning - will not automatically result in a finding of likelihood of confusion even if the goods are identical or

closely related. *See TMEP* §1207.01(b)(1). 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., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field).

In this case, the marks are similar in sight only. The differences in the parties' respective goods are sufficient to obviate any likelihood of confusion. Registrant uses its mark in connection with time measuring apparatus and related instruments, in Class 9; and jewelry, precious stones, and timepieces including watches and clocks in Class 14. As amended herein, Applicant's mark is limited to "spectacles, eyeglasses and goggles for sports," in Class 9. Applicant no longer seeks registration for its mark in connection with any goods in Class 14. Accordingly, there is no overlap between the parties' respective goods, trade channels, or intended consumers. Based on the above, Applicant asserts that use of the same mark on non-competing goods is not likely to cause confusion, and requests that the refusal to register be withdrawn.