

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: OPPO MEDICAL INC. Attorney Docket No.: OPPO-2-54628  
Serial No.: 86/295091 Trademark Attorney: Tamara G. Frazier  
Filed: May 9, 2014 Law Office: 116  
Mark: OppO and Logo International Class: 25

REQUEST FOR RECONSIDERATION

Seattle, Washington 98101

October 7, 2015

TO THE COMMISSIONER FOR TRADEMARKS:

**I. INTRODUCTION**

This submission is made in response to the final Office Action mailed April 7, 2015. The Examining Attorney has refused registration based on the likelihood of confusion with Registration No. 4508756. Applicant respectfully requests reconsideration of the present application.

**II. APPLICANT'S MARK**

Applicant has applied to register its design mark set forth below for the following goods: Shoes and boots; hats and caps; socks, and stockings; shoe inserts for primarily non-orthopedic purposes; gloves as clothing accessories; cold-proof gloves; sleeping eye masks; puttees, namely, leg wrappings; underclothing, undergarments, sports clothes, namely, tight fitted clothing, namely, shorts, tights, athletic support tops, tops, girdles, compression shirts, compression shorts, compression pants, athletic sleeves, leggings, wrist bands.



### III. THE CITED REGISTRATION

The Examining Attorney refuses registration under Section 2(d) of the Trademark Act on the basis of a likelihood of confusion with the mark OPPO SUITS and Design in U.S. Registration 4508756, as shown below for clothing, namely suits, blazers, trousers, pants, waistcoats, shirts, T-shirts, ties, bow ties, socks and underwear; footwear, namely shoes and sneakers; headwear, namely hats and caps.



### IV. THE MARKS THEMSELVES ARE NOT SUFFICIENTLY SIMILAR TO FIND A LIKELIHOOD OF CONFUSION

In rejecting the present application, the Examining Attorney has simply cited the "standard doctrine" that the word portion of a composite mark is often considered the dominant feature in the mark. No actual analysis of the present mark versus the cited mark was provided when making the statement. The Examining Attorney does concede that composite marks must be compared in their entirety and be compared with the putative conflicting marks.

In the present situation, the design element of applicant's mark is very significant. The design element consists of a human-shaped torso wearing a hat or headwear with a circular brim. Moreover, a circular head shape is positioned above the human torso. Further, the head shape and torso are bisected vertically to divide the shapes into a white color on the left side and a black color on the right side. Further, the human torso and head shape are positioned above the word OppO in stylized lettering and thus a viewer's eyes are drawn to the first design.

In the present situation, the design element of applicant's mark should be considered with at least as much, if not more, weight as a word portion. "[W]ords or portions of words do not always dominate over design features. The issue turns on the facts of each case." *In re Elbaum*, 211 U.S.P.Q. 639, 641 (T.T.A.B. 1981). "The design, particularly if prominent . . . may dominate or at least be a significant factor in distinguishing the marks." Richard L. Kirkpatrick, *Likelihood of Confusion In Trademark Law*, § 4:9.2 (2006). Indeed, "differences in designs may outweigh similarity of words." *Id.* Professor McCarthy remarks that:

It has sometimes been stated that in a word-design composite mark, the words are always presumed to be the "dominant" portion. This might be labeled the "literacy" presumption, in that it assumes that words have more impact than designs, a dubious generalization. That this "rule" of word-dominance is merely a guideline is shown by cases finding that a design element is dominant if more conspicuous than accompanying words.

3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:47 (4<sup>th</sup> ed. 2006).

In the present situation, applicant's design is at least as conspicuous and striking as the wording of the mark. As noted above, the design portion of the mark is in the form of a unique torso with a circular head shape positioned above the torso. This design is of a height that is higher than the letters comprising the word portion of the mark. Applicant respectfully submits that this is a situation in which the design portion of a mark dominates the mark. See *In re Computer Communications, Inc.*, 485 F.2d 1392 (CCPA 1973); and *Association of Co-Operative Members, Inc. v. Farmland Industries, Inc.*, 684 F.2d 1134 (5th Cir. 1982).

Moreover, the present situation is distinguishable from the cases cited by the Examining Attorney for the proposition that the word portion of a mark may likely be more impressed on a purchaser's memory than the design portion. In the case of *CBS, Inc. v. Morrow*, 708 F.2d 1579 (Fed. Cir. 1983), the design portion of the mark consists of a small stylistic light bulb forming the dot over the word "Thinker." The design portion of the mark in the *CBS, Inc.* case was much smaller in scale than the mark in question. Further, in the case of *In re Vitterra Inc.*, 671 F.3d 1358 (Fed. Cir. 2012), the design portion of the mark is simply the letter "X". Moreover, in the case of *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565 (Fed. Cir. 1983), the design portion of the mark was simply the letter "Y". In *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ 2d 1424,1431, the design in question was a wave, and the goods were bottled water. As such, the design was considered to be descriptive of the goods. In the present situation, applicant's design is not descriptive of its goods.

In the *In re Dakin's Miniatures, Inc.* case, applicant filed two trademark applications. The first application included the mark DAKIN'S in large font, superimposed over a design of the heads of three horses. The TTAB held that this design could be merely mistaken for one of the registrant's designs since the registrant utilized designs in conjunction with its mark DAKIN's for toys, including stuffed toy animals. The applicant's second application included a B within a circle following the mark DAKIN'S CIRCLE. The TTAB held that the inclusion of the "Circle B" design was not significant. Applicant notes that the Circle B design followed the words DAIKIN'S CIRCLE, and also was of the same size as the font used in the word mark DAIKIN'S CIRCLE. The situation with respect to the two marks in the *In re Daikin's Miniatures, Inc.* case do not apply to the present application.

In the present situation, on the other hand, the design portion of applicant's mark is in the form of a stylized torso with a circular head shape positioned above the torso. This design portion above dominates the term "OppO" shown in stylized lettering. Accordingly, the "literacy" presumption being espoused by the Examining Attorney does not apply in the present situation.

Overall, the differences in the appearance of the parties' marks results in the marks conveying two different commercial impressions. It is unlikely that a consumer would encounter applicant's mark and assume that it designates the same source as the cited registered mark.

#### **V. OTHER THIRD PARTY REGISTRATION**

Applicant notes the existence of Registration No. 4523343 for the mark OPPOS for girls' clothing, namely, leggings, jeggings, pants, tops and skirts, registered April 29, 2014; as well as Registration 4519206 for the mark OPPOS and Design for girls' clothing, namely, leggings, jeggings, pants, tops and skirts, issued April 22, 2014. The TESS records for these two registrations are attached. These two registrations co-exist with the cited Registration 4508756. Applicant respectfully submits that if the cited Registration 4508756 can co-exist with Registration Nos. 4523343 and 4519206, such that consumers can distinguish the OPPOS and OPPOS and Design marks from the OPPO SUITS and Design mark, then surely in the present situation the public can also distinguish applicant's very distinctive OppO and Logo mark from the OPPO SUITS and Design mark.

#### **VI. CONCLUSION**

For the foregoing reasons, applicant respectfully submits that there is no likelihood of confusion between applicant's mark and the registered mark, and requests that the refusal to register be withdrawn.

Respectfully submitted,

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