

TRADEMARK

In re Application of: 14 Twelve Holdings Pty Ltd.
Serial No.: 86/918,815
Filed: February 24, 2016
Mark: ANNEX (Int. Class 25)

Trademark Examining Attorney: Emma Sirignano
Trademark Law Office: 113

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

Madam:

REQUEST FOR RECONSIDERATION

In response to the Final Office Action dated July 18, 2017, Applicant respectfully requests that the Examining Attorney give this matter reconsideration and withdraw the refusal to register its application in view of the amendments to the recitation of goods and services submitted concurrently herewith and the Remarks provided below.

REMARKS

Refusal to Register under Trademark Act § 2(d)

The Office Action refuses registration of Applicant's mark under Trademark Act § 2(d), 15 U.S.C. § 1052(d), asserting that there is a likelihood of confusion between Applicant's ANNEX mark, as used in connection with "clothing, namely, denim pants, hooded sweatshirts, jackets, jeans, jumpers, pants, scarves, shirts, shorts, sweaters, swim shorts, tee-shirts and tops; headwear; and footwear" in Int. Class 25, and the mark ANNEX that is the subject of Registration No. 3,177,971 ("Cited Registration") for "luggage, duffle bags, messenger bags, all purpose carrying bags, namely, satchels, backpacks" in Int. Class 18 ("Cited Goods"), which is owned by Starite International Ltd. ("Cited Registrant").

Applicant respectfully submits that there is no potential for confusion between Applicant's use and registration of the ANNEX mark and the mark that is the subject of the Cited Registration for several reasons. First, Applicant's goods and the Cited Goods are distinctly different, including having entirely different functionality and purchasing considerations. This is the reason the Office classifies Applicant's goods and the Cited Goods in different international classifications. Second, Applicant's goods and the Cited Goods will be marketed and sold under entirely different purchasing conditions. These distinctions are the basis for Applicant's contention that its ANNEX mark is suitable for registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney reconsider its application based upon the comments contained hereinbelow.

1. Applicant's goods and Cited Goods are distinctly different.

The Examining Attorney must compare the goods as recited in the present application and in the Cited Registration in determining whether a likelihood of confusion exists. *See In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). On page 1 of the Office Action, the Examining Attorney contends that "the applicant offers online retail stores services that sells "bags," which encompasses the registrant's goods. *See attached definition of "bag" from the Oxford Dictionary defining the term as "a container made of flexible material with an opening at the top, used for carrying things" and "a piece of luggage."* The Examining Attorney further cites Internet evidence that the Examining Attorney contends "consists of third parties who offer applicant and registrant's goods via their online retail stores, all under the same mark." Applicant

thanks the Examining Attorney for clarifying the Office's rationale for the present rejection. Concurrently herewith, Applicant has amended the identification of goods and services to delete Int. Class 35 and the services recited therein in their entirety.

Applicant submits that the identification of goods of the present application, as amended, is sufficiently distinct from the Cited Goods so as to preclude any likelihood of confusion in this matter. Applicant seeks to register the mark ANNEX for use in connection with "clothing, namely, denim pants, hooded sweatshirts, jackets, jeans, jumpers, pants, scarves, shirts, shorts, sweaters, swim shorts, tee-shirts and tops; headwear; and footwear" in Int. Class 25. The Cited Goods comprise "luggage, duffle bags, messenger bags, all purpose carrying bags, namely, satchels, backpacks" in Int. Class 18.

As noted in the Office Action, the Cited Goods function as "*a container made of flexible material with an opening at the top, used for carrying things*". Purchasers of "luggage, duffle bags, messenger bags, all purpose carrying bags, namely, satchels, backpacks" primarily purchase the goods based on the capacity of the bags, including the available storage space and number of compartments that can be used for storage, and the durability of the material used to construct the bags, *i.e.*, the ability of the bags to undergo the ordinary rigors of air travel and the like.

In contrast, Applicant's goods are various items of clothing, headwear and footwear. Purchasers of Applicant's goods primarily purchase the goods based on whether the color and style of the clothing goods match with the individual preferences of the buyer, the ability of the goods to keep the buyer warm (e.g., in the case of "hooded sweatshirts, jackets, and sweaters; headwear;

and footwear), the type of fabric or material used to manufacture the goods and the wearability of the goods.

Thus, not only are Applicant's goods and the Cited Goods classified by the Office in an entirely different international class, but the respective goods have entirely different functionality and purchasing considerations. Applicant respectfully submits that Applicant's goods and the Cited Goods are unrelated and are distinct from one another. In view of the material differences between the respective goods, Applicant submits there is no likelihood of consumer confusion.

2. Applicant's goods are sold under entirely different purchasing conditions.

Any risk of confusion is further reduced by the fact that Applicant's goods and the Cited Goods will be sold under entirely different purchasing conditions. *See In re E. I. Du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). Specifically, Applicant's goods and Cited Goods will not be marketed together, but rather, because of the different functionality and purchasing considerations, will be presented to customers under entirely different purchasing conditions. In this regard, even retailers that sell both clothing and bags promote the products separately, including placing the products on different aisles in different parts of the store and presenting such products on their website on different webpages under entirely different category headings.

Applicant submits that the differences in the purchasing conditions further reduce any likelihood of purchaser confusion.

In addition, Applicant's goods are not an "impulse" purchase, but, instead, represent a significant investment by a purchaser in terms of cost and, but also in terms of matching the style of the goods with the personal preferences of the buyer. As such, the purchase of Applicant's goods are aptly characterized as a purchase requiring a significant degree of reflection and care on the part of the buyer. Consequently, the purchasers of Applicant's goods will be acutely aware of the source of the goods. *McCarthy* explains that "[i]f the goods and services are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation." *McCarthy on Trademarks and Unfair Competition* § 23:95, 23-401. The cost of Applicant's goods further supports the high degree of consumer care required by purchasers and further reduces the likelihood of confusion.

Similarly, the Cited Goods likewise require a significant degree of reflection and care on the part of the buyer as such goods will likely be a significant monetary investment and something that will be used to carry and protect the personal assets of the buyer. Thus, the purchasers of the Cited Goods will also be acutely aware of the source of the goods.

3. Applicant's predecessor-in-interest's prior registration and use of the ANNEX mark demonstrates that there is no likelihood of confusion.

Applicant's predecessor-in-interest owned Registration No. 1,605,661 for the mark ANNEX for "designer clothing namely, men's and women's jackets, coats, trousers, pants, slacks and shorts; women's skirts, dresses and sweaters; shoes" in Int. Class 25, which was registered on July 10, 1990. Applicant's predecessor-in-interest inadvertently allowed Registration No. 1,605,661 to expire on August 19, 2015. Nevertheless, it should be noted that

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the Office approved the registration of the Cited Registration over Registration No. 1,605,661, concluding that there was no likelihood of confusion between the existing registration of the ANNEX mark in connection with “designer clothing namely, men's and women's jackets, coats, trousers, pants, slacks and shorts; women's skirts, dresses and sweaters; shoes” in Int. Class 25 and the registration of the ANNEX mark in connection with “luggage, duffle bags, messenger bags, all purpose carrying bags, namely, satchels, backpacks” in Int. Class 18. Moreover, Applicant notes that the Cited Registration peacefully coexisting with Registration No. 1,605,661 for over nine (9) years.

Applicant respectfully submits that this prior registration evidences that Applicant’s ANNEX mark has and can peacefully coexist with the mark that is the subject of the Cited Registration.

4. The totality of the evidence demonstrates the complete absence of any danger of purchaser confusion in this matter.

When making a final determination as to likelihood of confusion, the Examining Attorney must consider *all* of the evidence bearing on the question of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Applicant submits that in light of the differences in goods and purchasing conditions; and the peaceful coexistence of the Cited Registration and prior Registration No. 1,605,661 for over nine (9) years, there is **no** danger of consumer confusion as to source under these circumstances.

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Applicant respectfully requests that the Examining Attorney give favorable reconsideration to its application in light of the amendment and Remarks submitted herewith directed to the issue of likelihood of confusion. Applicant submits that its mark is not likely to cause confusion with the Cited Registration and requests that the Examining Attorney withdraw this rejection. Such favorable action on the part of the Examining Attorney is respectfully solicited.