

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Law Office 103
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RE: Serial No.: 88/011,282

Mark: 
Applicant: Complex Media, Inc.
Office Action of: May 14, 2019

APPLICANT'S REQUEST FOR RECONSIDERATION

The following is the response of Applicant, Complex Media, Inc., by Counsel, to the above referenced Final Office Action dated May 14, 2019.


LIKELIHOOD OF CONFUSION REFUSAL

The Examining Attorney has maintained a registration refusal of the proposed  mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the mark in Registration No. 5,058,289, for **hotone**. For the following reasons, Applicant respectfully disagrees with this finding and requests that the Examining Attorney reconsider the statutory refusal.

Likelihood of confusion between two marks at the USPTO is determined by a review of all relevant factors under the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion is typically determined based primarily upon the similarity or dissimilarity of the marks and the relatedness of the goods or services, “there is no mathematical test for determining likelihood of confusion and each case must be decided on its own merits.” TMEP § 1027.01 (citing *du Pont* 476 F.2d at 1361, 177 USPQ at 567). Here, we will be focusing on the first *du Pont* factor, namely, the

similarity or *dissimilarity* of the marks in their entireties as to appearance, sound, connotation, and commercial impression (emphasis added).



The Applicant's  mark and the cited *hotone* mark differ significantly in appearance, and depending on how the cited mark is perceived and understood by consumers, it would also differ significantly from Applicant's mark in terms of sound and meaning. When these differences are given the proper weight, it is clear that the overall commercial impression created by Applicant's mark would also be very different from the cited mark. As such, it is not likely that consumers would believe that goods sold under the cited mark would emanate from the same source as Applicant's mark, and vice versa.


The Marks are Sufficiently Different to Avoid Confusion

The Examining Attorney inappropriately evaluates Applicant's mark and the cited mark as being confusingly similar, claiming that the "visual, phonetic and overall commercial impressions derived from the respective marks are substantially similar." *See* Final Office Action of May 14, 2019. Here, the respective marks are not similar visually or phonetically and also differ in overall commercial impression. Even where marks share a common portion, confusion is unlikely if they create a different commercial impression. *See Long John Distilleries, Ltd. v. Sazerac*, 426 F.2d 1406, 166 USPQ 30 (CCPA 1970). Further, non-verbal features such as spacing, location, layout, design, and typeface may affect the overall appearance and commercial impression of the marks. *See Packman v. Chi. Tribune*, 267 F.3d 628, 60 USPQ 749, 751, (Fed. Cir. 1985) (Although the words on [the parties' products] are the same, the words' appearances do not resemble each other and are not likely to cause confusion. Different packaging, coloring, and labeling can be significant factors."), *Henri's Foods Prods. Co. V. Kraft, Inc.* 717, F.2d 352, 220 USPQ 386, 388-89 (7th Cir. 1983) (words on separate lines), *Land v. Ret. Living Publ'g Co.*, 949 F.2d 576, 582, 21 USPQ 2d 1041, 1045 (2nd Cir. 1991) (typeface and location).

A. Appearance and Sound

The Examining Attorney maintains that the Applicant's mark and the cited mark's visual and phonetic impressions are confusingly similar. However, Applicant respectfully disagrees with this assertion.




Applicant's  mark is comprised of two distinct words, "HOT" and "ONES," and a drawing of a chicken head within the letter "O" in "HOT", with a flame shooting out of the beak. By contrast, the cited **hotone** mark can either be construed as a compound word mark comprised of the words "HOT" and "ONE" or the coined term, "HOTONE," one word. As such, the marks look and sound dissimilar.

The Examining Attorney also claims that although marks must be compared in their entireties, the "word portion [of a composite mark consisting of words and a design] is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar." *See* Final Office Action.

While marks must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). However, we disagree with the



Examiner's assertion that the words in Applicant's  mark are the dominant feature. There is no general rule that the letter portion of the mark will form the dominant portion of the mark. *See In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed.Cir.1990). Indeed, the design element of Applicant's mark, namely, a fire breathing chicken within the letter "O" in "HOT," is certainly the dominant feature. Specifically, the creative way in which the design element and the words are depicted creates a visual impression that is different from the appearance of the cited **hotone** mark.

The Examining Attorney further suggests that because the cited **hotone** mark is registered in standard characters, Applicant's mark "will not avoid likelihood of confusion with [the cited mark] because the word portion could be presented in the same manner of display," citing *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909. *See* Final Office Action.

However, although the cited mark is not limited to any particular manner of display, it does not

mean that the cited mark can encompass all possible design elements of Applicant's




mark. *See In re Viterra Inc.*, 671 F.3d at 1365 (finding that the XCEED mark could not be considered to have taken on the precise depiction shown in the cited registration, with full color and design; it only found that the XCEED mark could be depicted as a capital “X” followed by “ceed” in small letters, making it similar to the X–Seed Mark). Thus, because Applicant’s mark is so highly stylized, when taken in its entirety it does not fall within the range of a reasonable variation that should be reserved for the cited standard character mark. *Id.*

Because these marks differ visually and phonetically, consumers will look to these differences to distinguish between the marks. *See Recot Inc. v. Becton*, 50 USPQ 2d 1439 (TTAB 1999) (no likelihood of confusion found between “FRITO LAY for snack foods and FIDO LAY for canine snacks, due to the differences in sound, appearance, and meaning.”)


B. Meaning and Connotation

The marks also differ in meaning and connotation when examined in connection with the goods they identify. A mark’s distinctiveness must be evaluated in relation to the particular goods for which registration is sought. *See In re Chamber of Commerce of the U.S.* 675 F.3d 1297, 1300 (Fed. Cir. 2012). When the recited goods are read in connection with the cited **hotone** mark, it either connotes the attractiveness level of an individual wearing those particular goods, were the mark to be interpreted as being comprised of the words “HOT” and “ONE”; if the mark were to be interpreted as a coined term, “HOTONE,” it would have no apparent meaning, as “HOTONE” has no meaning in the English language.




By contrast, Applicant’s  mark conveys no readily apparent interpretation, but suggests that something may be spicy or hot to the taste, which is inapplicable to the identified goods.




As such, Applicant’s  mark and the cited **hotone** mark have different connotations with respect to the goods sold under each of these marks.

C. Overall Commercial Impression



The stylization of Applicant's  mark, which is comprised of the words "HOT" and "ONES, and a fire breathing chicken within the letter "O" in "HOT, is so extreme and striking that it is different in appearance, sound and connotation from the cited **hotone** mark, thereby creating a distinct overall commercial impression from the cited mark. These differences "outweigh any similarities between the cited mark and applicant's mark." *See In re Sajen, Inc.*, Serial No. 77257189 (June 4, 2009) [not precedential]. When viewed in its entirety, the



stylization of Applicant's  mark makes it unlikely that purchasers would recognize this mark as the cited **hotone** mark. As each of these marks create a distinct overall commercial impression among consumers, this weighs heavily against a finding of a likelihood of confusion



between Applicant's  mark and the cited **hotone** mark.

CONCLUSION

For all of the reasons stated above and in the prior office action responses, Applicant respectfully requests that the statutory refusal be withdrawn, and the application be permitted to proceed to publication.