

I. Section 2(d) Refusal.

The Examining Attorney has refused registration based on a likelihood of confusion with the mark in U.S. Reg. No. 3472406.

The mark in Reg. No. 3472406 (the '406 Registration) is in the following stylized format:



The '406 Registration is registered for "table cloths not of paper; curtains of textile fabric; table linen, namely, coasters; non paper doilies; textile place mats in Int. Class 024. The '406 Registration is owned by a corporation named Qingdao Kingtex Co., Ltd.

Applicant's mark is SUNFLOWER in the following design format:



The identification is "bed pillows; beds, mattresses; pillows and bolsters; head supporting pillows" in Int. Class 020.

Applicant has revised, narrowed, and clarified the recitation of services to more accurately describe Applicant's goods. As indicated by the revised recitation, the goods of Applicant do not include goods identical to or related to the goods of the Registrant. Based on the revised recitation, Applicant respectfully requests the Examining Attorney reconsider, and withdraw, the Section 2(d) refusal.

A. The DuPont Factors Weigh in Applicants Favor.

In *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals (CCPA) announced thirteen factors relevant for determining likelihood of confusion under §2(d). These factors are:

1. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use);
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
9. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
10. The market interface between applicant and the owner of a prior mark: (a) a mere “consent” to register or use, (b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party, (c) assignment of mark, application, registration and good will of the related business, or (d) laches and estoppel attributable to the owner of the prior mark and indicative of lack of confusion;
11. The extent to which the applicant has a right to exclude others from use of its mark on its goods;
12. The extent of potential confusion, i.e., whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.

See *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

No single factor is dispositive. However, Applicant believes that the *Du Pont* factors weigh in Applicant's favor and requests the Examiner reconsider and withdraw the Section 2(d) refusal.

B. The Doctrine of Foreign Equivalents is Not Applicable.

In order to conclude that SUNFLOWER is confusingly similar with non-Latin characters in the Registration, the examiner has misapplied the doctrine of foreign equivalents and has improperly conflated "transliteration" with "translation."

As summarized by the examiner, "Under the doctrine of foreign equivalents, a mark in a common, modern foreign language and a mark that is its English equivalent may be held confusingly similar" (emphasis added). The examiner further notes that "marks comprised of foreign wording are translated into English to determine similarity in meaning and connotation with English word marks" (emphasis added).

Registrant's mark is in non-Latin characters which have a transliteration to TAI YANG HUA. That does not have the equivalent sound as Applicant's mark. As noted by the TMEP, "Where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar." TMEP 1207.01(b)(vi)(B), *citing Sarkli*, 721 F.2d at 354-55, 220 USPQ at 112-13 (holding REPECHAGE for various skin-care products, and SECOND CHANCE for face creams and other toiletries, not likely to cause

confusion, where the evidence failed to show that the terms were direct foreign equivalents); see also *In re Buckner Enters.*, 6 USPQ2d 1316 (TTAB 1987) (holding DOVE (with design) for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, not likely to cause confusion, because, *inter alia*, the Spanish word "paloma" and the English word "dove" are not exact synonyms in that "paloma" can be translated into either "dove" or "pigeon"). Where, as here, the evidence shows variation in the English meaning, the doctrine of foreign equivalents should not be applied. TMEP 1207.01(b)(vi)(B).

C. The Marks Must Be Considered in their Entireties.

In comparing Applicant's and Registrant's marks, the marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. See e.g., *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Dreyfus Fund, Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 213 U.S.P.Q. 872 (S.D.N.Y. 1981) (quoting treatise);

In re National Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (“[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features.”); *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996) (“Rather than consider the similarities between the component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products.”).

A significantly different display of the same term or an addition of a distinctive element (i.e. term or design) can avoid a likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). The use of a design as part of a mark minimizes any likelihood of confusion. *Harlem Wizards*, 952 F. Supp. At 1096 (citing McCarthy at §23:15[5]). See also, *In re NBA Properties, Inc.*, 2000 TTAB LEXIS 863 (TTAB 2000) (when considered in their entireties, the marks differ in appearance and create distinctly different commercial impressions; applicant’s mark is a composite consisting of a word and a design, both of which must be considered in determining the overall commercial impression the mark conveys).

Applicant respectfully submits that the Examiner erred in failing to give due weight to the differences between Applicant's Mark and the mark in the cited registration. "Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, the Applicant sought to register VARGA GIRL for calendars. The Trademark Trial and Appeal Board refused registration in light of the prior registration VARGAS, registered for posters, calendars, greeting cards" and related goods. On Appeal, the Federal Circuit reversed the Board's refusal.

The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl." By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark. Although the weight given the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word "girl". When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely. *Id.*

Similarly, Applicant's SUNFLOWER design mark must be viewed in its entirety. Applicant respectfully submits that the two marks have been able to coexist without any confusion since 2000. Applicant did not file an acceptable Section 8 declaration in a previous registration prior to the deadline and the mark was inadvertently cancelled. Applicant's registration was able to coexist since 2012. See Exhibit A, attached. Applicant submits that the Examiner has effectively removed these significant portions

from its mark. When all portions of Applicant's mark are given proper consideration, Applicant contends that the two marks are sufficiently distinguishable in sight, sound and meaning to create distinguishable overall commercial impressions.

When viewing Registrant's mark and Applicant's mark in their entireties, it is clear that the Examiner could not have arrived at the 2(d) refusal by comparing the marks as a whole.

In support of the 2(d) refusal, the Examiner cited TMEP § 1207.01(c)(ii) for the proposition that "When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services." With all due respect, the TMEP provides no such hard-fast rule, and indeed § 1207.01(c)(ii) explicitly states that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." Moreover, the TMEP also emphasizes that "the *fundamental* rule in this situation is that **the marks must be considered in their entireties.**" TMEP § 1207.01(c)(ii) (emphasis added).

Because it appears that both the Examiner and Applicant agree that TMEP § 1207.01(c)(ii) (Composite Marks Consisting of Both Words and Designs) provides relevant guidance in examining the marks at issue, Applicant has reproduced the

section in its entirety, highlighting in bold print the four fundamental principles that argue for withdrawal of the 2(d) refusal:

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently, the marks at issue are similar in only one element. **Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion.** *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, **the fundamental rule in this situation is that the marks must be considered in their entireties.** See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974).

If a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or services. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (APPETITO and design of two broad stripes lined for the colors red and green, for Italian sausage, held likely to be confused with A APPETITO'S and design and A APPETITO'S INC. and design of a sandwich (with "INC." and sandwich design disclaimed), both for restaurant services). The Court of Appeals for the Federal Circuit has cautioned, however, that **"[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue."** *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

The comparison of composite marks must be done on a case-by-case basis, without reliance on

mechanical rules of construction. See, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (finding a likelihood of confusion between SPICE VALLEY and SPICE ISLANDS, both for tea); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices); *In re Sun Supermarkets, Inc.*, 228 USPQ 693 (TTAB 1986) (SUN SUPERMARKETS and design of sun held likely to be confused with SUNSHINE and design of sun and SUNRISE and design of sun, all for retail grocery store services).

TMEP § 1207.01(c)(ii) (emphasis added).

The above represents TMEP § 1207.01(c)(ii) in its entirety. Paring out the case citations, § 1207.01(c)(ii) can be boiled down to the following four key principles, all of which argue for withdrawal of the 2(d) refusal:

1) Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature;

2) the fundamental rule in this situation is that the marks must be considered in their entireties;

3) “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.”; and

4) The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction.

