

## **OFFICE ACTION RESPONSE**

Applicant's mark is **INVISIBLE**, U.S. Trademark Application Serial No. 88/322,950, depicted as follows:

**INVISIBLE**

for use in connection with, as amended, "Innovation consulting services, namely, advising others in the areas of product development; New product design services; none of the foregoing in the field of bio-medical imaging, environmental monitoring, high speed imaging, remote sensing, UV, X-ray, IR and neutron imaging and 3D imaging" in International Class 42 ("Applicant's Mark")<sup>1</sup>. Registration of Applicant's Mark has been refused under Section 2(d) based on a finding of likelihood of confusion with Reg. No. 4,014,250 for the mark **INVISIBLE**, depicted as follows:



for use in connection with, in relevant part:

DESIGN AND DEVELOPMENT OF NEW PRODUCTS FOR OTHERS IN THE FIELD OF BIO-MEDICAL IMAGING, ENVIRONMENTAL MONITORING, HIGH SPEED IMAGING, REMOTE SENSING, UV, X-RAY, IR AND NEUTRON IMAGING AND 3D IMAGING; DESIGN AND DEVELOPMENT OF COMPUTER HARDWARE AND SOFTWARE; INFORMATION, ADVISORY AND CONSULTANCY SERVICES RELATING TO THE DESIGN AND DEVELOPMENT OF NEW PRODUCTS FOR OTHERS

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<sup>1</sup> Applicant has narrowed its goods identification in class 42, as follows:

Innovation consulting services, namely, advising others in the areas of product development; New product design services; **none of the foregoing in the field of bio-medical imaging, environmental monitoring, high speed imaging, remote sensing, UV, X-ray, IR and neutron imaging and 3D imaging**

The Examining Attorney should consider Applicant's arguments in light of the amended identification.

in International Class 42 (the “Cited Mark”). Applicant respectfully disagrees and submits the following response to the Examining Attorney’s refusal based on the following arguments.

**THE SERVICES ARE NOT RELATED**

The Examining Attorney found that “the marks are used on encompassing services in Class 42.” Applicant respectfully disagrees.

The Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009). The relatedness of goods or services may not be assumed, and the Examining Attorney must show “something more” than that different goods or services are in the same environment or trade channels to demonstrate that the goods are sufficiently related to weigh in favor of a finding of likelihood of confusion. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Here, the relevant services are “Innovation consulting services, namely, advising others in the areas of product development; New product design services; none of the foregoing in the field of bio-medical imaging, environmental monitoring, high speed imaging, remote sensing, UV, X-ray, IR and neutron imaging and 3D imaging” (Applicant’s services, as amended), on the one hand, and various bio-medical imaging product design services (Registrant’s services) on the other. It is clear, based on Registrant’s services as listed in the registration, that the services provided under the Cited Mark are specifically in the field of bio-medical imaging, and that the product design services offered under the Cited Mark are primarily for such purposes. In contrast, Applicant’s services are not for the creation or production of bio-medical imaging products, but instead are for companies creating consumer products. Accordingly, the services are not related for likelihood of confusion purposes.

**THE MARKS ARE NOT SIMILAR**

In the likelihood of confusion analysis, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). When comparing marks that share a literal element, the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey

significantly different commercial impressions. TMEP §1207.01(b)(iii); *see Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

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). While it is often true that the word portion of a mark is more likely to be impressed upon a purchaser's memory, that is not the case in every situation. The Court of Appeals for the Federal Circuit has cautioned 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); *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). Further, the visual impact of the marks on the minds

of the prospective purchasers who view them must be considered and the design portion of a mark can be the dominant part of a mark. *Finn v. Cooper's Inc.*, 130 U.S.P.Q. 269, 272 (CCPA 1961). Images create a lasting impression in the minds of consumers. *Id.* (“[We must consider the visual impact of the marks on the minds of the prospective purchasers who view them . . . . Symbolic marks speak a universal language; they lend themselves to effective display in advertising and sales promotional activity and can thus become the dominant part of the mark on labels, packages, and point of purchase displays. They can catch the eye of the customer and create a lasting general impression. Current mass advertising media utilize symbols which are visually projected into millions of homes of prospective purchasers by television and these symbols frequently are associated with pictures of the goods of a particular user”).

Applying these principles, in *In re Fairview Imp. Corp.*, 2013 TTAB LEXIS 447 (TTAB Aug. 16, 2013), the Board reversed a refusal to register the following combined word/design mark:



for, *inter alia*, “sunglasses” in International Class 9 (with the descriptive term “collection” disclaimed) was not likely to cause confusion with the mark HERITAGE 1981, for, *inter alia*, “eyewear, namely, sunglasses” in International Class 9 (with “1981” disclaimed).

Despite the fact that the goods for both marks -- sunglasses -- were *identical*, and the marks shared the first term “Heritage” with the second terms “Collection” and “1981” disclaimed, the Board found that confusion was not likely because the “moose” design was “prominent” and contributed “greatly” to the visual impression of the applicant's mark:

[W]e note that applicant's mark Heritage Collection is similar to the mark HERITAGE 1981 in the cited registration solely to the extent that both contain the word HERITAGE as a prominent element thereof. However, the marks are dissimilar to a significant extent in that applicant's mark contains the prominently sized and arbitrary design of a moose. This design contributes greatly to the visual impression of applicant's mark. This is not a case in which the design portion of applicant's mark is an easily overlooked geometric carrier or an abstract pattern that is much smaller in size than the wording. We observe that in registrant's mark the term HERITAGE is the first and most prominent portion thereof. However, in applicant's mark, the term HERITAGE is located below the prominent moose design,

which is equal in size to the wording HERITAGE COLLECTION and appears to be arbitrary as applied to the goods. Even if consumers did not recognize the design as a moose per se, they nonetheless would be likely to recognize it as the design of an animal with a large rack of antlers. Thus, when viewed as a whole, applicant's mark is notably dissimilar from that of registrant in appearance.

*In re Fairview*, TTAB LEXIS 447 at 9-12. The Board further explained that even though the marks shared the first term “Heritage”, which has similar connotations as applied to identical goods, the sole fact that the mark contained a highly distinctive “moose” design was sufficient to obviate a likelihood of confusion:

[T]he wording HERITAGE COLLECTION and HERITAGE 1981 are likely to have similar connotations as applied to identical or otherwise related goods. However, the arbitrary moose design does not appear to have any meaning or connotation as applied thereto, and thus creates an arbitrary and noticeable addition to the connotation engendered by applicant's mark. Taken as a whole, the marks thus are different in connotation and commercial impression.

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks favors applicant. Moreover, we find this factor is determinative and, despite the in-part identity of the goods, we conclude that the marks are sufficiently dissimilar that confusion is not likely between applicant's mark and the mark in the cited registration.

*Id.* at 11-12.

The Board more recently held *again* that **design elements may be dominant and must be considered**. In a precedential decision, the Board reversed a refusal of REDNECK RACEGIRL (& Design) for clothing in class 25, depicted as follows:



finding no likelihood of confusion with the mark RACEGIRL in standard characters for similar clothing in class 25. *In re Covalinski*, 113 USPQ 2d 1166 (TTAB 2014). The Board found “crucial differences” between the marks, including that the graphic elements of the

applied-for mark “serve not only to draw attention to the RR letters apart from the wording, but also make the letters that for the 'a-c-e' of the word 'RACEGIRL' difficult to notice.” *Id.* at 5. The Board cited several prior decisions in which the design was deemed dominant.

Applying these principals in the present case, Applicant’s Mark and the Cited Mark must be considered in their entireties, including the distinctive “seven small circles” design in the Cited Mark and the distinctive “oval-shaped shadow” design in Applicant’s Mark, as well as the differences in the typeface in each mark. When the marks are properly considered in their entireties, the marks are very different in appearance, meaning, and commercial impression.

Specifically, the marks are different in their appearance owing to the inclusion of the “seven small circles” design in the Cited Mark, which does not appear in Applicant’s mark. Similarly, Applicant’s mark includes an “oval-shaped shadow” design, which is not present in the Cited Mark. Thus, the marks are completely different for at least the reason that the Cited Mark contains a “seven small circles” design whereas Applicant’s Mark contains an “oval-shaped shadow” design. Moreover, there are distinct differences in stylization of the letters in each mark. For example, Applicant’s mark displays the term “INVISIBLE” in all capital letters, and in the same color as the background. This creates minimal visual contrast between the shadow itself and the term “INVISIBLE” in Applicant’s Mark. In contrast, the Cited Mark displays the term “INVISIBLE” with only a capital “I”, while the remainder of the lettering is in the lower case. Additionally, the Cited Mark displays the term “INVISIBLE” as the forefront, and not the background of the mark. These differences in design elements, alongside the differences in the stylization of the letters completely distinguish the marks in appearance.

Furthermore, the meaning and commercial impression of the marks are completely different. Specifically, the term “INVISIBLE” in the context of the registrant’s goods appears to be in reference to the various medical apparatuses that the registrant designs and develops, such as x-ray machines, IR and neutron imaging machines, and the like, which are intended to provide images of the internal workings or structure of the human body that are otherwise “invisible” to the naked eye. Indeed, in the registrant’s most recent specimen, submitted as part of the renewal of the Cited Mark, the Cited Mark is displayed above the tagline “Making the invisible visible”. In contrast, Applicant’s Mark actually evokes the concept of invisibility as a feature both of the

mark itself and of Applicant's innovation consulting services, as can be seen by the background-colored font imposed on an oval-shaped shadow which fades into the background. This implies to companies seeking Applicant's services that the division between the customer and the company is made "invisible" through the use of Applicant's design services. Accordingly, the marks are not similar in appearance, sound, meaning, or overall commercial impression, thus weighing heavily against a finding of likelihood of confusion

### **CONCLUSION**

Based on the foregoing, Applicant respectfully submits that there is no likelihood of confusion among Applicant's Mark and the Cited Mark. Thus, Applicant respectfully requests that the Section 2(d) refusal be withdrawn and that Applicant's Mark be published for opposition.