

## **RESPONSE TO OFFICE ACTION**

The following remarks are in response to the First Office Action, dated June 13, 2009, which issued in connection with Applicant's mark ALLEGIANCE, U.S. Serial No. 77/710,316, for use in connection with "laminated flooring" in International Class 019.

### **REMARKS**

#### **THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED REGISTRATION.**

Pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), the Examining Attorney has refused to register Applicant's mark ALLEGIANCE, to be used in connection with "laminated flooring," based on an alleged likelihood of confusion with U.S. Registration No. 3,231,683 for the mark ALLEGIANCE, used in connection with "concrete segmental retaining wall units" (hereinafter referred to as the "Cited Registration").

For the reasons set forth below, Applicant respectfully submits that there is no potential confusion between its mark and the Cited Registration, because the marks are not confusingly similar when considering the relevant *DuPont* factors, in particular the wholly distinguishable goods offered under the respective marks, as well as the high level of sophistication among the purchasing audience. Applicant respectfully presents the following evidence demonstrating the differences between its ALLEGIANCE mark and the Cited Registration.

***1. The Goods Offered by Applicant And Those in the Cited Registration Are Not Sufficiently Related to Warrant a Finding of a Likelihood of Confusion.***

Applicant's goods, namely "laminated flooring," and the goods used in connection with the Cited Registration, namely "concrete segmental retaining wall units," barely overlap, if at all,

and certainly not enough to warrant a finding of a likelihood of confusion. The Federal Circuit's decision in Shen Manufacturing is instructive. Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238 (Fed. Cir. 2005). In Shen, two of the marks at issue were an applicant's RITZ mark for cooking and wine classes, and a registrant's RITZ mark for kitchen textiles. Id. at 1240. Although the marks were identical, and the goods and services were arguably related, the court found no indication that the consuming public would perceive them as originating from the same source. Id. at 1245. The court analogized the relevant goods and services to restaurant services and beer, which conceivably could overlap but were not adequately related to find likely confusion in a prior Federal Circuit opinion. Id. at 1244, citing In re Coors Brewing Co., 343 F.3d 1340 (Fed. Cir. 2003). The court also held that the applicant's mark THE RITZ KIDS for children's clothing, including gloves, was not likely to lead to consumer confusion with the registrant's mark RITZ for oven mitts. Id. at 1245. Again, the court emphasized that an ordinary consumer would not believe that the two products emanated from the same source. Id.

In the Office Action, the Examining Attorney offered examples of Internet evidence to show that a single company could provide both of the respective goods (laminated flooring and concrete segmental retaining wall units). In this case though, the key point for comparison should be whether a manufacturer of laminated flooring would also be likely to offer concrete segmental retaining wall units, such that a consumer would believe the respective goods emanate from a single source. Despite the references submitted by the Examining Attorney, there has been no evidence to support this leap in logic. See, e.g., In re Boler Co., 2009 WL 625568, Serial No. 77/059,048 (T.T.A.B. Feb. 17, 2009) (non-precedential) (holding that an Examiner's third party evidence of a single retailer offering an applicant's trailer suspension systems under

the mark QUAANTUM and a registrant's tires under the mark QUANTUM to be insufficient to show that purchasers would believe the goods originate from the same source).

Applicant also submits that the present factual circumstance should be considered in light of a recent Section 2(d) analysis by the TTAB. In re Wentz Bros. d/b/a Tamas Estates, Serial No. 77/314,718 (T.T.A.B. 2009) (non-precedential). In Wentz Bros., the Board reversed a refusal to register the mark ANDIAMO for wine on the basis of a prior registration for the identical mark ANDIAMO with restaurant services. The Board, relying upon the Federal Circuit's decision in In re Coors Brewing Co., 343 F.3d 1340 (Fed. Cir. 2003), held that the goods were not sufficiently related to warrant a finding of a likelihood of confusion. The Board held that the Examiner's evidence, which consisted of an admission by the applicant that it offered restaurant services and a prior advertisement for the registrant's restaurant services that included wine, did not meet the "something more" requirement that is often applied in the context of restaurant services and food products analysis. Applicant submits that the same reasoning should apply to this application.

The goods offered under the Cited Registration are quite narrow and specific. The Cited Registration merely covers "concrete segmental retaining wall units." By focusing on the broader term "building materials" in the Office Action, Applicant respectfully submits that the Examining Attorney consider the actual goods description in the Cited Registration. In re Wentz Bros. d/b/a Tamas Estates, Serial No. 77/314,718 (T.T.A.B. 2009) (non-precedential) ("Of course, we must view the goods and services as they are identified in the application and registration."), citing Paula Payne Products v. Johnson Publishing, Inc., 473 F.2d 901 (C.C.P.A. 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

While the Examiner provided evidence of third parties that could conceivably sell both concrete blocks and laminate flooring, there is absolutely no proof that the owner of the Cited Registration provides these goods, such that consumers would believe that Applicant's goods emanate from the owner of the Cited Registration. Notwithstanding, the third-party evidence from the Examining Attorney is of limited utility in determining whether the respective marks at issue could cause consumer confusion. The fact that only a few companies or vendors might sell or display both products does not prove that consumers will be confused. The goods offered by Applicant and those offered under the Cited Registration are not only different but are very specific as to their customers.

Even if the Board were to conclude from the third-party evidence that the respective goods may emanate from a single source (which Applicant submits that the Examining Attorney failed to prove), that conclusion does not necessarily demonstrate that the goods are related such that confusion is likely to result from the use of the same or a confusingly similar mark or both. See In re Apollo Colors, Inc., 2005 WL 1787221, Serial No. 75/942,300 (T.T.A.B. 2005) (non-precedential). “[M]ere recognition of the greater diversity and expansion of businesses in a modern economy is not, in and of itself, sufficient to support an inference that purchasers are apt to believe that disparate products or services emanate from the same source.” CNL Tampa Int'l Hotel P'ship, L.P. v. Palazzolo, 2007 WL 760521, Opp. No. 91163724 (T.T.A.B. 2007) (non-precedential), citing In re American Olean Tile Co., 1 U.S.P.Q.2d 1823, 1826 (T.T.A.B. 1986). In CNL Tampa, the Board stated that acceptance of third-party registrations alone as evidence of relatedness of the goods and channel of trade overlap would create a *per se* rule of a likelihood of confusion, rather than a case-by-case analysis. Id. Third-party references are not enough in themselves to warrant a finding of likelihood of confusion.

Based upon the wholly distinguishable goods of the respective mark owners, there is insufficient similarity between the goods to give rise to a likelihood of confusion.

**2. *The Respective Goods Travel in Different Channels of Trade.***

Not only are the respective goods distinguishable, but the respective marks are targeted towards different consumers and interests (i.e., flooring purchasers versus wall unit purchasers). Consequently, consumer confusion is unlikely between the marks because of these distinguishable, sophisticated target audiences.

There is no *per se* rule that certain goods or services are by their nature related, such that a likelihood of confusion must emanate from the use of similar marks in connection with such goods or services. In Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 U.S.P.Q.2d 1169, 1171 (T.T.A.B. 1987), the TTAB determined that just because each party's goods—fruit juice and beef jerky, respectively—could be purchased in grocery stores was not sufficient to find that the goods were sold in similar channels of trade. The Board determined that the goods would be sold in different sections of food stores and no likelihood of confusion existed despite the fact that the respective trademarks were identical. Id.; see also In re Wimbledon Shops, Inc., 2002 WL 1844153, Serial No. 75/874479 (T.T.A.B. 2002) (finding that, even though FRITZ'S BASKET BABIES collectible porcelain dolls were sold on the same websites as FRITZ puppets, there was no likelihood of confusion because consumers would not necessarily assume that the products emanated from the same source); Information Resources, Inc. v. X\*Press Information Servs., 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988) (holding that no *per se* rule mandated a finding of likely confusion). The present situation is directly analogous to Hi-Country Foods. Here, each party's goods could conceivably be purchased from a single source. However, much like a

grocery store, Applicant's flooring goods would be sold in a completely different "section" of the "store" versus the concrete wall unit products described in the Cited Registration.

The respective goods at issue would not be encountered by the same persons. The goods offered by Applicant under its ALLEGIANCE mark and those offered under the Cited Registration plainly travel in different channels of commerce and will not cause consumer confusion, mistake or deception.

**3. *The Relevant Consuming Public for the Respective Goods Is Highly Sophisticated.***

Even assuming, *arguendo*, that the markets of the respective goods overlap, or that they are even sold in the same "store," such overlap is not enough to demonstrate that a likelihood of confusion would arise based on the use of the respective marks among discriminating purchasers. See, e.g., Electronic Design & Sales v. Electronic Data Systems, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (finding that the fact that applicant sold goods in some of the same fields as opposer's services was not sufficient to deny registration); In re Boler Co., Serial No. 77/059,048 (T.T.A.B. Feb. 17, 2009) (non-precedential) (consumers of applicant's trailer suspension systems offered under the mark QUAANTUM and a registrant's tires sold under the mark QUANTUM were knowledgeable purchasers who exercised a "high degree of care"). Flooring and siding customers are particularly sophisticated and discriminating purchasers.

Applicant's goods offered under its ALLEGIANCE mark are sold to various flooring customers, such as builders, contractors and construction companies. These customer segments are relatively sophisticated in terms of purchasing building products, such that they will not be confused as the source of Applicant's flooring goods. Applicant requests that the Board consider the issue of consumer sophistication in light of the Board's recent decision in In re Itec

Manufacturing, Ltd., 2008 WL 8825826, Serial No. 78/621,722 (T.T.A.B. 2008) (non-precedential). In that case, the Board reversed an Examiner’s refusal to register an applicant’s mark PAL for a “medical device, namely a patient lifting apparatus” because of an alleged likelihood of confusion with the following prior registrations: PAL for “pumps for inflating patient support mattresses,” PAL for “surgical and medical patient support devices for use in lithotomy procedures,” and AIRPAL (and Design) for “medical devices, namely, inflatable patient transfer and therapy pads.”

The Board held that the relevant purchasing audience, which included medical entities such as hospital administrators and physicians, were particularly sophisticated in the medical equipment field. The Board also stated that the goods were not likely to be purchased on impulse. These factors led the Board to hold that the marks were not confusingly similar.

Applicant maintains that, like physicians and hospital administrators, residential and commercial builders and contractors are discriminating consumers of wall and flooring goods, as those goods are vital to the success of their business and are generally not purchased in small quantities. Further, the respective goods are not impulse purchases. Thus, Applicant submits that the Board should apply the logic of In re Itec Manufacturing to the facts of this situation.

***4. The Fact That Applicant’s Mark Is Identical to the Cited Registration Does Not Require a Finding That the Respective Marks Are Confusingly Similar.***

It is well settled that two trademarks may share common terms without causing consumer confusion. See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238 (Fed. Cir. 2005) (finding no likely confusion between the identical marks RITZ for kitchen textiles, owned by a registrant, and RITZ for cooking and wine selection classes, owned by an applicant). “Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions

when applied to the respective parties' goods or services so that there is no likelihood of confusion." T.M.E.P. § 1207.01(b)(v), citing In re Sears, Roebuck and Co., 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987) (CROSS-OVER mark for bras was not likely to be confused with CROSSOVER for ladies' sportswear); In re Sydel Lingerie Co., 197 U.S.P.Q. 629 (T.T.A.B. 1977) (BOTTOMS UP for ladies' and children's underwear was not likely to be confused with BOTTOMS UP for men's clothing).

Applicant respectfully requests that the Examining Attorney consider the following instances where identical marks were allowed to coexist based on distinguishable goods. See, e.g., In re Wente Bros. d/b/a Tamas Estates, Serial No. 77/314,718 (T.T.A.B. 2009) (non-precedential) (finding that an applicant's ANDIAMO mark for wine was not confusingly similar to a registrant's ANDIAMO mark for restaurant services); CNL Tampa Int'l Hotel P'ship, L.P. v. Palazzolo, 2007 WL 760521, Opp. No. 91163724 (T.T.A.B. 2007) (non-precedential) (holding that an applicant's PELAGIA mark for clothing did not cause confusion with an opposer's PELAGIA mark for restaurant services); Shen Mfg. Co., 393 F.3d 1238 (holding that identical RITZ marks, used in connection with goods that could be used together, would not necessarily mean that "the consuming public would perceive them as originating from the same source"); In re Coors Brewing Co., 343 F.3d 1340 (Fed. Cir. 2003) (holding that a brewing company's BLUE MOON (and Design) mark for beer was not sufficiently related to registrant's BLUE MOON and design mark for restaurant services to preclude registration); In re British Bulldog, Ltd., 224 U.S.P.Q. 854, 856 (T.T.A.B. 1984) (finding no likelihood of confusion between PLAYERS for shoes and PLAYERS for men's underwear); MTD Prods. Inc. v. Universal Tire Corp., 193 U.S.P.Q. 56, 60 (T.T.A.B. 1976) (holding that the mark COLUMBIA for automobile tires was not confusingly similar to the mark COLUMBIA for bicycle, tractor and minibike tires).



In the In re British Bulldog and Universal Tire cases cited above, the parties' marks were not only identical, but were also used in connection with similar goods and services in the same International Class. However, the Board found that the marks were not confusingly similar in each case. Here, Applicant respectfully submits that a finding of confusing similarity must be predicated on more than the fact that the marks share the term "allegiance."

### **CONCLUSION**

Applicant reiterates that there is no likelihood of confusion between its ALLEGIANCE mark and the Cited Registration. Thus Applicant requests that the refusal to register be withdrawn and the application be approved for publication in the Official Gazette.