



ARGUMENTS AGAINST SECTION 2(d) REFUSAL
Office Action Dated November 13, 2011
Application Serial No. 77/375,071 – ICE OPTICS
Applicant Ref: 68843-1003

The Examining Attorney has maintained his refusal to register U.S. Application Serial No. 77/375,071 for ICE OPTICS ("Applicant's Mark") on the basis that Applicant's Mark, when used in connection with the identified goods so resembles the mark HIELO in Registration No. 3489693, when used in connection with the identified goods, as to be likely to cause confusion, mistake, or to deceive under Trademark Act Section 2(d). The Examining Attorney has also added the following marks as basis for his refusal:

- (1) U.S. Registration No. 2726570 - 
(2) U.S. Registration No. 3686161 - 
(3) U.S. Registration No. 2927698 – PINK ICE - ; and

Registration Nos. 3489693, 2726570, 3686161, and 2927698 are herein collectively referred to as "the Cited Marks."

For the reasons set forth below, Applicant respectfully seeks reconsideration of the Examining Attorney's position and requests that the foregoing refusal be withdrawn and Applicant's Mark be allowed to proceed to publication.

In re E.I. DuPont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973), sets forth factors to be considered in determining whether concurrent registration or use of two marks is likely to cause confusion. Among the factors are the similarity or dissimilarity of the marks in appearance, sound, connotation and commercial impression, and the number and nature of similar marks in use on similar goods.

When applied in the instant case, the *Du Pont* factors demonstrate that there should be no likelihood of confusion among consumers. Considered in their entireties, as they must be, the Cited Marks and Applicant's Mark do not look or sound substantially alike. Additionally, consideration of the number and nature of similar marks in use on similar goods is relevant to show that Applicant's Mark can co-exist with the Cited Marks without causing consumer confusion, and that the strength of the Cited Marks is relatively weak and the Cited Marks should be afforded only a narrow scope of protection.

Doctrine of Foreign Equivalents

Applicant re-asserts and re-states herein its arguments regarding the Doctrine of Foreign Equivalents as set forth in its Response to the Office Action dated June 4, 2011 that was filed with the U.S. Trademark Office on October 17, 2011.

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine similarity of connotation with English words in a likelihood of confusion analysis. *Palm Bay Imports v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005). The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.[']" *Id.*, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). See generally, J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:36 (4th ed. 2006).

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline. *In re N. Paper Mills*, 64 F.2d 998, 999 (C.C.P.A. 1933); *McCarthy on Trademarks*, at § 11:34. The doctrine should be applied only when it is likely that the ordinary American purchaser would "stop and translate [the word] into its English equivalent." *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B. 1976). Even assuming a sufficient similarity of connotation between "ICE" and "HIELO", a consumer would not stop and think to translate "ICE" and "HIELO", or vice versa, when encountering the marks ICE OPTICS and HIELO as they would appear in their channels of commerce before the consumer made a purchase decision. Indeed it is far more likely that a consumer will see "HIELO" as "HELLO" rather than as "ICE." Where the only similarity between marks is in connotation, a much closer approximation is necessary to justify refusal to register on that basis alone where marks otherwise are totally dissimilar. Lanham Trade-Mark Act, § 2(d), 15 U.S.C.A. § 1052(d).

Even when determining similarity of connotation under the Doctrine of Equivalents, a complete inquiry into the likelihood of confusion between a foreign word mark and an English word mark requires one to "consider the marks in their entirety in terms of sound, appearance, meaning, and commercial impression." *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006).



Applicant asserts that even under the precedent defining the doctrine of foreign equivalents, Applicant's Mark and the Cited Mark still fail to create a likelihood of confusion in the marketplace.

The Marks Do Not Look Confusingly Similar - Marks Must Be Considered In Their Entirety

(1) Registration No. 3489693



HIELO and ICE OPTICS do not look confusingly similar. ICE OPTICS is two words; HIELO is one word. And while the doctrine of foreign equivalents may be used to consider whether a mark in a foreign language and a mark that is its English equivalent are confusingly similar in meaning and connotation, the doctrine cannot be applied when determining if the marks are similar in terms of appearance. Thus, the marks share no common element and cannot be confused.

(2) Registration No. 2726570

 and ICE OPTICS do not look confusingly similar.  which includes an "X" and "-" that, along with the very distinctive stylized form of the mark, distinguishes it apart from Applicant's Mark.

By contrast, Applicant's Mark is a standard word mark that includes the word OPTICS.

(3) Registration No. 3686161

 and ICE OPTICS do not look confusingly similar.  includes the word "ICEBERG" that, along with the very distinctive stylized form of the mark, distinguishes it apart from Applicant's Mark.

By contrast, Applicant's Mark is a standard word mark that includes the word OPTICS.

(4) Registration No. 2927698

PINK ICE and ICE OPTICS do not look confusingly similar. While both PINK ICE and ICE OPTICS include the word "ICE," PINK ICE includes the word "PINK" at the beginning of the mark, while Applicant's Mark includes the word OPTICS at the end of the mark. The only way to find similarity in appearance between PINK ICE and ICE OPTICS is to dissect the marks.

It is well established that such dissection of the marks as described to find confusion is not appropriate. The Federal Circuit has made clear that the Patent and Trademark Office may not ignore elements in marks in order to find that there is a likelihood of confusion. *See, In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) ("[t]he appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component 'girl'" and "[w]hen GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely"); *In re Electrolyte Laboratories, Inc.*, 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990), corrected, 929 F.2d 645 (Fed. Cir. 1990) ("No element of a mark is ignored simply because it is less dominant or would not have trademark significance if used alone").

In evaluating marks in a likelihood of confusion analysis, it is well-settled that marks must be considered in their entirety, and that even minor differences between the marks may be sufficient to avoid a likelihood of confusion. *See, Chaussures Balley Society Anonyme de Fabrication v. Dial Shoe Co.* 145 U.S.P.Q. 488 (C.C.P.A. 1965) (Adding the word "LA," the word "the" in French and Italian, to Applicant's Mark was enough to distinguish it from the plaintiff's mark and avoid a likelihood of confusion. "[W]e cannot dissect and set aside any portion of a mark and eliminate it from consideration in judging the matter of similarity or dissimilarity of competing marks") (emphasis added). Numerous decisions hold that a difference of even one or two letters is sufficient to avoid confusion between two marks. *Celanese Corp. v. Shelcon, Inc.* 174 U.S.P.Q. 189 (TTAB 1972), aff'd. 180 U.S.P.Q. 403 (C.C.P.A. 1974) (SHELCON for conveyor

belt systems and CELCON for raw materials fashioned into conveyor belt system parts sufficiently different to avoid confusion); *In re Reach Elec., Inc.* 175 U.S.P.Q. 734 (TTAB 1972) (REAC not confusingly similar to REACH, both relating to electronics equipment); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, (finding that "The term ZU appears significantly larger and very prominently above the smaller font-sized ELEMENTS" when compared with opposer's ELEMENTS mark).

Marks tend to be perceived in their entireties, and all components must be given appropriate weight. *See, Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). *See, also e.g. Plus Products v. Redken Laboratories, Inc.*, 199 U.S.P.Q. 111 (TTAB 1978) (finding that PH PLUS for skin care products and PLUS for cosmetics and vitamin preparations for the hair and skin were dissimilar); *Dans un Jardin v. Les Jardin des Plantes*, 226 U.S.P.Q. 956 (TTAB 1985) (finding that JARDIN DES PLANTES and DANS UN JARDIN, both for toiletries, perfume and cosmetics, were not confusingly similar even though both marks include the term "JARDIN"); *Estee Lauder, Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997) (the mark 100% BODY CARE for body care products is not likely to be confused with the mark 100% for moisturizer).

If picture or symbol marks are distinctly different in overall visual appearance, confusion is not likely, even if the marks are used on competing products. *McCarthy on Trademarks; Ziebart International Corp. v. After Market Associates, Inc.*, 802 F.2d 220, 231 U.S.P.Q. 119 (7th Cir. 1986) (Two logos, both for automobile rust proofing compounds and applied to the window of a new car after being rustproofed, were held not to be confusingly similar).

Even when allowance is made for the fallibility of consumers' memory of marks, Applicant's Mark and the Cited Marks, in their entireties, are not so similar in sound, appearance, connotation or commercial impression that, merely because such marks share the term "ICE" confusion as to origin or association is likely. *In re TSI Brands, Inc.*, 67 U.S.P.Q.2d 1657, 2002 WL 834465 (T.T.A.B. 2002) (Registration of applicant's proposed mark "AK American Khakis" and design, for sportswear, is not likely to cause confusion with other marks consisting of stylized letters "AK," registered for athletic clothing, even though goods in question are closely related, since applicant's mark includes elements that distinguish it from registered marks). *See also, Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, (finding that "ZU visually dominates applicants mark and, consequently, is the term that will most likely be impressed in the minds of consumers").

The courts have found no likelihood of confusion even when identical marks were used for the same broad category of goods or services. *See, e.g. Dynamics Research Corp. v. Langenau Mfg Co.* 704 F.2d 1575, 1576 (Fed. Cir. 1983) (no likelihood of confusion between two "DRC" marks even though both were used for goods in the metal fabrication industry); *Electric Design & Sales v. Electronic Data Sys.*, 21 U.S.P.Q. 2d 1388, 1391 (Fed. Cir. 1992) (no likelihood of confusion between EDS and E.D.S., where both marks were used on products designed for the medical field). Here, the marks are obviously not identical.

There are many instances where the courts and the Board have held that marks with suffixes or portions in common, for similar goods or services, were not likely to be confused because the marks included other elements that served to distinguish the marks. *See Witco Chem. Co. v.*

Whitfield Chem. Co., 418 F.2d 1403, 1406 (1965) (finding that the WHIT-prefix marks and the WIT-prefix marks, both of which were used for industrial chemicals, are "readily distinguishable in sound, appearance, and possible suggestive significance"); *In re P. Ferrero & CSPA*, 178 U.S.P.Q. 167 (T.T.A.B. 1973) (finding TIC TAC is not confusingly similar to TIC TAC TOE even though both marks were used for confections); *Time, Inc. v. Petersen Pub'g Co.*, 173 F.3d 113 (2d Cir. 1999) (TEEN not confusingly similar to TEEN PEOPLE); *Nutri/System, Inc. v. Con-Stan Ind., Inc.*, 809 F.2d 601 (9th Cir. 1987) (NUTRI/SYSTEM not confusingly similar to NUTRI-TRIM).

The Two Marks Do Not Sound Alike

The Cited Marks and Applicant's Mark sound different. Courts have recognized that there is no likelihood of confusion between marks that sound different.

In *Coca-Cola Co. v. Essential Products Co.*, the court found no likelihood of confusion between COCA COLA and COCO LOCO for drinks because they sounded different when pronounced, even though the two marks looked similar at first glance. 421 F.2d 1374, 1376 (C.C.P.A. 1970). Similarly, in *Lever Bros. Co. v. Babson Bros. Co.*, the court rejected plaintiff's contention that SURF and SURGE, both for soap products, were phonetically similar, even though both products had the same syllables and contained many of the same letters. 94 U.S.P.Q. 161, 164 (C.C.P.A. 1952).

The sounds of the Cited Marks are easily distinguished from that of Applicant's Mark because each mark contains additional literal terms not present in Applicant's Mark. These additional elements produce different sounds when spoken or heard. As such, consumers hearing or articulating Applicant's Mark and the Cited Marks would not confuse one for the other. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, (finding that applicant's mark ZU ELEMENTS will be pronounced differently than opposer's mark ELEMENTS because it begins with the term ZU, and that the term ZU differentiates applicant's mark from opposer's mark even though pronunciation of the term ELEMENTS in applicant's mark is nearly identical to opposer's ELEMENT mark).

Moreover, the anti-dissection rule prohibits granting undue weight to the one shared element of the marks, while ignoring all other dissimilar elements. See *American Cyanamid Co. v. S.C. Johnson & Son, Inc.*, 729 F.Supp. 1018, 1022 (D.N.J. 1989) (MAX cannot be considered separately from MAXFORCE); *Shen Mfg Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed.Cir. 2004) (RITZ cannot be considered separately from THE RITZ KIDS). Thus, the fact that Applicant's ICE OPTICS mark shares the common portion ICE (or its foreign equivalent) with the Cited Marks, is not determinative of their overall phonetic similarity.

The Marks Can Co-Exist

The fact that the Examining Attorney has responded to Applicant's arguments against a likelihood of confusion by citing three of the four registrations that Applicant cited in its first Office Action Response (in addition to the original cited registration for HIELO) proves Applicant's point that the marks can co-exist without, to Applicant's knowledge, causing consumer confusion. See, *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, ("The fact that the USPTO has allowed so many registrations containing a shared term may be used to establish

that [the] portion common to the marks involved in a proceeding has a normally understood and well-known meaning [and] that this has been recognized by the [USPTO]...; and that therefore the inclusion of [the shared term] in each mark may be an insufficient basis on which to predicate a holding of confusing similarity"). If the foregoing marks can coexist without any confusion, registration of Applicant's ICE OPTICS mark is not likely to cause confusion with the Cited Marks, or to cause consumers to believe that the goods in Applicant's Mark and the goods in any of the Cited Marks emanate from the same source.

Applicant submits that consumers are conditioned to not associate all marks containing the term "ICE" with only one source or industry, and to differentiate among them as long as the overall marks and goods/services are not identical.

The Cited Marks are in a crowded field of ICE Marks in Class 09 and are therefore only entitled to a narrow scope of protection

The number of marks containing the term ICE for goods in Class 09 indicates that this field is crowded. As a result, each such registration is relatively weak in its ability to prevent use by others in this crowded field. *McCarthy on Trademarks*, §11:85, pp. 150.2-150.4 (citing cases). If consumers don't have a clear sense of what plaintiff's mark represents, they are unlikely to purchase defendant's product or service thinking it is plaintiff's. *Ibid*, quoting *Source Services Corp. v. Chicagoland JobSource, Inc.*, 643 F. Supp. 1523, 1 USPQ2d 1048 (N.D. Ill. 1986).

Applicant's Mark will not create confusion in the minds of consumers because there are already many marks (including the Cited Marks) that exist in the marketplace. *Miss World (UK) Ltd. v. Mrs. America Pageants Inc.*, 856 F.2d 1445 (1988) (service mark "Miss World," for beauty pageant promotions, is weak, even though it is registered and incontestable, since mark is part of "crowded field" of beauty pageants marks, each of which is relatively weak in its ability to prevent use by others.)

Evidence of these third party uses of marks including the term ICE for goods in Class 09 is admissible and highly relevant to show that the cited registrations are relatively weak and entitled to only narrow scopes of protection *McCarthy on Trademarks*, §11:88, pp. 150.7 & n. 1 (citing numerous cases). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." (*Trademark Manual of Examining Procedure* ("TMEP") citing *Palm Bay Imports v. Veuve Clicquot Ponsardin*).

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. (*TMEP* citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984).

This "crowded field" effect provides an additional ground upon which to conclude there will be no likelihood of confusion between Applicant's Mark and the Cited Marks.

Conclusion

For all the foregoing reasons, Applicant submits there is no likelihood of confusion between Applicant's Mark and the Cited Marks. Applicant respectfully requests that the Examining Attorney reconsider his position in this regard and to pass the application to publication.