

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Trademark Application of:	)	<b>Trademark Law Office: 115</b>
<b>ENDURA</b>	)	
	)	<b>Trademark Examining</b>
<b>Serial No.:</b> 85776534	)	<b>Attorney: April K. Roach</b>
	)	
<b>Applicant:</b> EBA Design, Inc.	)	AMENDMENT & RESPONSE
	)	TO OFFICE ACTION No.: 01
_____	)	

**AMENDMENT & RESPONSE**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear April:

EBA Design, Inc. (“Applicant”), hereby responds to the Office Action, for the above-referenced trademark application. The Office Action raises issues regarding refusal for registration under Section 2(d) of the Trademark Act regarding likelihood of confusion with respect to the prior Registered Marks. Applicant will address the issue raised. Applicant will provide argument that there is no likelihood of confusion between Applicant’s mark and the United States Registrations cited by the Examiner. Based upon this response, Applicant submits that the application is in proper condition for registration, and, as such, should be approved for publication.

The trademark Examiner has requested that Applicant clarify the identification and classification of goods. As such, the applicant is amending the goods as follows:

1. Original Goods – Class 002  
Paints; Paints for airbrushing, make-up, face painting, and body painting

**AMENDED GOODS – Class 003**

Paints for face painting and human body painting; Airbrush paints namely for temporary tattoo

**2. Applicant Is Entitled to Registration as There Will Be No Likelihood of Confusion Between Applicant’s Mark and the Cited Prior Registrations**

It is important to recognize at the outset that “likelihood of confusion” is a term of art which means the probability of confusion, not merely the possibility of confusion. See, e.g., Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 168 (5th Cir.), cert. denied, 355 U.S. 894 (1957); see generally Carter Wallace Inc. v. Procter & Gamble, Co., 434 F.2d 794 (9th Cir. 1979). Moreover, it is also important to consider that fact that probable confusion requires a finding of probable confusion of a substantial number of reasonable buyers as to the source or connection of the sellers whose products or services are at issue. See, e.g., Motorola, Inc. v. Griffith Electronics, Inc., 317 F.2d 391 (C.C.P.A. 1963). Accordingly, a finding of likelihood of confusion must not be made lightly, but instead must be supported by a rigorous consideration of all elements of the marks and their respective goods/services.

The Examiner raised the issue that there may be a likelihood of confusion with the cited registrations with respect to limiting goods, and, as such, refused registration asserting the cited registration is a bar to registration of Applicant’s mark. Applicant argues that there is and will be no likelihood of confusion between Applicant’s mark and the cited registrations. Applicant submits that there is no potential conflict between Applicant’s mark and the cited registrations as there is no likelihood of confusion.

The Examiner cited the following Registered marks in INTERNATIONAL CLASS 002 and 003 for Exterior Paint and Automobile Paint:

**ENDURA (& Design)**

United States Application No.: 85094663

United States Registration No.: 4,014,915

Registration Date: Augsut 23, 2011

**International Class: 002 & 003**

**Goods:** Coating in the nature of automobile finish..... paint for automotive use ... automobile wax, automobile polish, and automobile cleaner

Registrant: A.M.E. International, Inc.

**ENDURAWALL**

United States Application No.: 74472804

United States Registration No.: 1873502

Registration Date: January 17, 1995

**International Class: 002**

**Goods:** Exterior Paint for distribution exclusively through company retail stores

Registrant: DUNN EDWARDS CORPORATION

**ENDURA-COAT**

United States Application No.: 76169051

United States Registration No.: 2678801

Registration Date: January 21, 2003

**International Class: 002**

**Goods:** Exterior Paint

Registrant: DUNN EDWARDS CORPORATION

**A. Statement of law on refusal based on likelihood of confusion, mistake, or deception.**

Title 15 U.S.C. § 1052 provides in pertinent part: No trademark by which the [goods] of the applicant may be distinguished from the [goods] of others shall be refused registration on the principal register on account of its nature unless it ... [c]onsists of or comprises a mark which so resembles a mark registered in the Patent

and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.... (15 U.S.C. § 1052(d).)

During examination by the United States Patent and Trademark Office (the “USPTO”), the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. (Trademark Manual of Examining Procedure (“TMEP”) § 1207.01, 109 (Mary E. Hannon ed., 4th ed., USPTO Apr. 2005).) There is no mechanical test for an examiner to use in determining likelihood of confusion and the issue is not whether the actual goods or services are likely to be confused, but whether there is a likelihood of confusion as to the source of goods or services. (In re Shell Oil Co., 992 F.2d 1204, 1208 (Fed. Cir. 1993); TMEP at § 1207.01, 109.) The examiner must decide each case on its own facts. (TMEP at § 1207.01, 109.)

The USPTO, when assessing the likelihood of confusion between compound word marks, must compare the marks by looking at them as a whole, and not by “breaking the marks up into their component parts for comparison.” (J. Tomas McCarthy, McCarthy on Trademarks and Unfair Competition (“McCarthy”) § 23:41, 23-123 (4th ed., West Mar. 2004).) This is known as the “anti-dissection” rule. (Id.) The rationale for the “anti-dissection” rule is that the general consumer perceives the mark as a whole, the commercial impression is created by the whole, and that it is not correct to dissect the mark into sub-parts and compare the sub-parts. (Id.) The marks must be compared in their entireties. The Supreme Court stated that “[t]he commercial

impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” (Est. of P.D. Beckwith, Inc. v. Commr. of Pats., 252 U.S. 538, 545-46 (1920). See also Fisons Horticulture, Inc. v. Vigoro Indus., Inc., 30 F.3d 466 (3d Cir. 1994) (holding that the overall marks should be compared and not a detailed analysis of the components); Off. Airline Guides, Inc. v. Goss, 6 F.3d 1385 (9th Cir. 1993) (holding that the “anti-dissection” rule requires viewing the marks as a whole as they appear in the marketplace); Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc., 656 F.2d 186 (5th Cir. 1981) (holding that the test is overall impression and not a dissection of individual features); Massey Junior College, Inc. v. Fashion Inst. of Tech., 492 F.2d 1399 (C.C.P.A. 1974) (holding that it is axiomatic that a mark should not be dissected and considered piecemeal in determining likelihood of confusion).) Also, its has been determined to be a violation of the “anti-dissection” rule to focus upon a prominent or dominant feature of the marks and decide likelihood of confusion solely upon the prominent or dominant feature. (J. Tomas McCarthy, McCarthy § 23:41, 23-125-26 (4th ed., West Mar. 2004) (citing Massey Junior College, Inc., 492 F.2d 1399 (C.C.P.A. 1974)).)

These principles have been used in making determinations on the issue of likelihood of confusion. It has been held that there is no likelihood of confusion for the following compound word marks:

BED & BREAKFAST REGISTRY

BED & BREAKFAST INTERNATIONAL

BOSTON TEA PARTY

BOSTON SEA PARTY

BANK IN A BILLFOLD

BANK IN A WALLET

CREAM OF WHEAT

CREAMY WHEAT

NUTRI/SYSTEM

NUTRI-TRIM

PECAN SANDIES

PECAN SHORTEES

STREETWISE

STREET-SMART

WHEATIES

OATIES

Likewise, there is no likelihood of confusion between the following Registered Marks: “ENDURA (& DESIGN)”, “ENDURAWALL”, and “ENDURA-COAT” and the Applicant’s mark “ENDURA”.

The Trademark Office recognizes that registration for a mark should not be refused based on any similar registered mark, but only on the basis of those similar marks whose effect in the marketplace would be to create a likelihood of confusion or mistake on the part of the purchasing public. T.M.E.P. § 1207.01. The test for determining likelihood of confusion consists of several factors, no one factor being necessarily determinative. The factors the Examining Attorney must look at include: (1) the number and nature of similar marks in use on similar goods or services; (2) whether the marks are similar; (3) whether the goods and services are similar; (4) whether the purchasers will most likely be made on “impulse” or in a “careful, sophisticated” manner; and (5) any other established fact probative of the effect of use. *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). These factors are not listed in the order of merit, and each may play a dominant role, depending on the facts of the case. *Id.* at 1361-62.

In applying these relevant factors to the instant case, the differences between the marks, the goods, the number of similar marks, and the context of actual use, are more than sufficient to preclude a likelihood of customer confusion.

a. The Marks Must Be Compared In Their Entireties

In making a determination of a likelihood of confusion, the marks must be compared in their entireties and should not be dissected and their parts compared separately. Despite the Examining Attorney's contention to the contrary, the Federal Circuit has held that "[t]here is no general rule as to whether letters or design will dominate in composite marks. . . . No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." In re Electrolytes Laboratories, Inc., 913 F.2d 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990), corrected 929 F.2d 645 (Fed. Cir. 1990) (holding no likelihood of confusion between the marks K+ (Stylized) and K+EFF (Stylized) both for a dietary potassium supplement). Moreover, it has been held that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely. Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). In other words, splitting a mark into its various components and comparing only certain portions of one mark with another mark is not proper. Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974).

The Examining Attorney has merely compared one portion of Applicant's mark **ENDURA** to the cited marks ENDURAWALL, ENDURA-COAT and ENDURA & Design and not looked at whole marks as well as the goods. Such a comparison is contrary to

the anti-dissection rule and relevant case law. Instead, a proper comparison of Applicant's entire mark to the cited marks shows that Applicant's mark and the cited marks are quite dissimilar in sight, sound, and meaning, as well as overall commercial impression. See *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (holding that, despite prominent component shared by PIZZA CAESAR USA and LITTLE CAESARS, that differences in sound and appearance made them dissimilar).

Likewise, the Examining Attorney has merely compared one portion of Applicant's mark ENDURA to the cited marks and not looked at Applicant's whole mark. Such a comparison is contrary to the anti-dissection rule and relevant case law. Instead, a proper comparison of Applicant's entire mark to the cited marks shows that Applicant's mark and the cited marks are quite dissimilar in sight, sound, and meaning, as well as overall commercial impression.

b. It Is Possible For Identical Marks To Be Used On Closely-Related Goods or Services Without A Likelihood Of Confusion

Although Applicant's mark and the cited mark are not even close to being identical, the TTAB and the courts have consistently found that even if a mark incorporates the entire trademark of another, there may still be no likelihood of confusion between the two marks. For example, the court in *Giorgio Beverly Hills Inc. v. Revlon Consumer Products Corp.* found that there was no likelihood of confusion between RED and CHARLIE RED for perfume. 33 U.S.P.Q.2d 1465, 1467 (S.D.N.Y. 1994). In fact, Professor McCarthy writes that "[i]t should be noted that under the



overall impression analysis, there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark." 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:41 (4th ed. 2007).

Likewise, the TTAB found no likelihood of confusion between ACCULINK and opposers' ACCU marks for computer products. Reynolds and Reynolds Co. v. I.E. Systems Inc., 5 U.S.P.Q.2d 1749 (T.T.A.B. 1987). Similarly, Applicant directs the Examining Attorney's attention to Bell Laboratories, Inc. v. Colonial Products, Inc., where the Court found no likelihood of confusion between "FINAL" and "FINAL FLIP," both for rodenticides. 231 U.S.P.Q. 569, 571-572 (S.D. Fla. 1986). Moreover, in In re Surf Line Hawaii, Ltd., the Board allowed registration of the mark "THE BODY SURFER" for men's swimming suits even though prior registrations for the marks SURFER and SURFERS (owned by the same registrant) existed for men's, women's and children's swimming suits. 183 U.S.P.Q. 757 (T.T.A.B. 1974).[1]

Furthermore, the TTAB and the courts have held that it is even possible for identical marks to be used on closely related goods and/or services without a likelihood of confusion.

The present case is clearly analogous to these cases. Applicant submits that under the analysis of the TTAB and the courts in the cases cited above, there is no likelihood of confusion between Applicant's mark ENDURA to the cited marks ENDURAWALL, ENDURA-COAT, and ENDURA & Design. This is especially true in light of the fact that the Registered marks all contain additional words and/or designs, which are not found in Applicant's mark. While Applicant's mark and the cited marks are similar, this is not tantamount to a likelihood of confusion between the marks.

c. There Is No Likelihood Of Confusion Between Applicant's Mark & Cited Marks

1. Applicant's Mark And The Cited Marks Are Dissimilar

The Federal Circuit has made it clear that “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Packard Press Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351, 1353 (Fed. Cir. 2000). In *Packard Press*, the Federal Circuit vacated the Board’s finding that **PACKARD TECHNOLOGIES** was likely to be confused with **HEWLETT-PACKARD** because the Board improperly dissected the marks. In this case, the Board only considered the similar commercial impression of part of the marks – the shared word **PACKARD** – before concluding that the marks were similar. . . . However, the Board failed to make any findings at all as to the appearance or sound of the marks, and without any explanation, considered only the **PACKARD** portion of **HEWLETT-PACKARD**. To be sure, the Board stated that it had considered the marks in their entireties. . . . But this statement, absent further explanation of the agency’s reasoning, is simply insufficient for proper review of PTO fact finding. *Id.* at 1354 (emphasis added).

In short, the Examining Attorney’s conclusory assertions are insufficient to support a finding that the prior pending marks are similar to Applicant’s mark. Instead, when a proper comparison of the Applicant’s complete mark and the cited marks are made, the marks do not create the same overall impression.

a. The Marks Are Dissimilar In Appearance

The Applicant's mark "ENDURA" does not look the same as either of the marks of the Registered Applications "ENDURAWALL" "ENDURA-COAT" or "ENDURA & design" mark when taken in their entireties. Under the Trademark Manual of Examining Procedure (TMEP) and prior case law:

Under this type of analysis, when taken in their entireties, applicant's mark and the prior pending mark are different, and not confusingly similar. Applicant's mark when taken as a whole is contained of one word whereas the Registered marks contain additional words and/or Designs.

Whereas the prior registered marks are comprised of the following two words 'WALL' and 'COAT' and one of the marks is also comprised of a DESIGN with the words ENDURA.

Accordingly, the appearance of applicant's mark is substantially different from the appearance of the prior registered marks.

b. Differences In Sound

Because of the additional words 'WALL' and 'COAT' in the registered marks, the Applicant's mark would sound substantially different.

However, Applicant's mark would be pronounced the same as the ENDURA Design marks since would sound similar for that portion of the mark.

As the Court of Customs and Patent Appeals held in comparing the marks PEAK and PEAK PERIOD – a situation in which one mark included the entirety of the other

mark – “[t]he difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike.” Colgate-Palmolive Co. v. Carter-Wallace Inc., 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970).

The differences in the overall appearance and sound of the cited marks and Applicant’s mark alone are sufficient to dispel of a likelihood of confusion and require the withdrawal of the cited marks as a bar to the registration of Applicant’s mark.

c. The Marks Have Different Connotations

Applicant’s mark is “ENDURA”.

Registered marks “ENDURAWALL” and “ENDURA-COAT”.

And the other Registered mark is “ENDURA & Design”.

In In re Sears, Roebuck and Co., the Board reversed a refusal to register CROSS-OVER for “bras,” finding no likelihood of confusion with the registered mark CROSSOVER for “ladies’ sportswear, namely, tops, shorts, and pants.” 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987). With respect to the marks, the Board found that they created different commercial impression when viewed in the context of the goods: We agree with applicant that its mark “CROSS-OVER”, when applied to brassieres, is suggestive of the construction of the brassieres. Registrant’s mark “CROSSOVER”, on the other hand, conveys no such meaning when applied to ladies’ sportswear, namely, tops, shorts, and pants. . . . As a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions,

notwithstanding the fact that they are legally identical in sound and appearance. Id. at 1314 (emphasis added).

The Registered marks “ENDURAWALL” and “ENDURA-COAT” both invoke an idea or feeling in addition to its literal or primary meaning of applying one or more ‘coats’ of “exterior paint” to a ‘wall’.

The Registered mark “ENDURA & Design” when applied to the goods of registrant invokes the impression that the product is a long lasting paint, polish, cleaner, and wax for “automobiles”.

Whereas the Applicant’s mark “ENDURA” when applied to the goods of the Applicant invokes the impression that the paint in the product creates long lasting temporary tattoos that are applied to faces and human bodies.

d. The Marks Have Different Commercial Impressions

Consumers will recognize the differences discussed above between the marks, and will be able to easily distinguish between them. Despite the Examining Attorney’s cursory conclusion to the contrary, the cited marks and Applicant’s mark are not similar in appearance, or connotation. Consumers hearing and viewing the marks will not hear or see a connection between the marks because the marks and terms therein have different appearances to consumers, and would project different meanings.

The Examining Attorney bases the refusal on the contention that the marks contain some of the same sounds from similar words. However, the TTAB’s past decisions support the viewpoint that consumers are able to distinguish between arguably similar marks that have distinguishing features, such as differences in

connotation and appearance. In fact, the TMEP sets forth a factor that is relevant in determining whether the marks are likely to be confused--the similarity in meaning of the marks. See TMEP Section 1207.01(b)(v). TMEP Section 1207.01(b)(v) states that “[e]ven marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods so that there is no likelihood of confusion.” *Id.* (emphasis added).

Moreover, in the case of the Applicant’s mark, it is evident that the mark has a separate and distinct commercial impression from the cited marks due to the differences in sight and connotation. The past decisions of the TTAB and the courts have held that there may be no likelihood of confusion between marks which differ only as to a few letters, even if the marks are used on related goods or services. The differences between the commercial impression of the marks discussed in the cases above are the same as, or even less than, those between Applicant’s mark and the cited mark. Thus, when a proper comparison of Applicant’s mark and the cited marks are made, the differences in overall sight, sound, connotation create separate and distinct commercial impressions that outweigh any perceived similarities and support the conclusion that there is no likelihood of confusion between the marks.

**C. Non-Related and Non-Competitive Goods**

It is well-known that a likelihood of confusion between marks may be found when the goods or services associated with the marks are “related”. An important first stage in making a determination as to whether a likelihood of confusion exists between similar marks used on related goods is making a finding as to whether or not the goods are

competitive". In this respect, while a multi-faceted analysis of the similar marks is needed if there are differences between the goods or services associated with the marks, there is no need for a far-ranging inquiry if the goods or services are directly competitive. See American Home Products Corp. v. Johnson Chemical Company, 200 USPQ 417 (2d Cir. 1978).

Applicant respectfully submits that the goods as recited in the present application and the cited registrations are not competitive and are different. Applicant's **goods** are in International Class 003 comprise Paints for face painting and human body painting; Airbrush paints namely for temporary tattoo

In contrast, the prior Registered marks ENDURAWALL and ENDURA-COAT **goods** are comprised of "exterior paint for building" in **international class 002**.

In contrast, the prior Registered mark ENDURA & Design **goods** are comprised of "paints, polishes, cleaners, and wax all for automobiles" in **international class 002 and 003**.

Thus, the goods as recited in the present application and the cited registrations are not competitive and are in fact different.

Applicant also respectfully submits that the goods as recited in the present application and the cited registrations are in different trade channels and as such would not be encountered by the same class of purchasers.

Applicant respectfully asserts that its goods are sold at "Body Art Stores / Tattoo Parlors" and on the Applicant's website to the general public.

Whereas, the ENDURAWALL and ENDURA-COAT exterior paint is distributed “exclusively through company retail stores” of DUNN EDWARDS, as stated in the goods description of the trademark.

The ENDURA & Design mark is a product that would be available at “Auto Part Stores”, since all of the products are used on and for automobiles.

Applicant further respectfully asserts that its goods are sold in small containers that hold ounces of the product and not gallons like the other registered marks.

Thus, the goods as recited in the present application and the cited registrations are in different trade channels and as such would not be encountered by the same purchasers.

Lastly, on this basis, Applicant respectfully submits that any analysis in determining whether a likelihood of confusion exists between the Applicant’s mark and the cited registrations must be conducted with respect to the considerations relating to “non-competing” goods / services.

**D. Actual Confusion**

Finally, with regard to instances of actual confusion, Applicant respectfully submits that it has no knowledge of any confusion occurring between Applicant’s goods sold under the mark ENDURA and the registered marks ENDURAWALL, ENDURA-COAT, and ENDURA & Design goods sold by the Registrants.

Additionally, the Applicant would like to respectfully point out to the Examiner that Applicant has been using the ENDURA mark in commerce since at least as early as



December 31, 2006. During that time there has been no actual confusion in the market place for over six (6) years.

Since, there has been no instances of actual confusion of the marks and the Registrants and Applicant have been using their marks in a similar geographic region for at least six (6) years, the Applicant respectfully asserts that there would be no likelihood of confusion.

### CONCLUSION

The Applicant respectfully asserts that there is no likelihood of confusion between similar marks used on related "non-competing" goods. With the foregoing remarks, it is believed that the present Amendment addresses all of the matters raised in the Office Action. Therefore, Applicant earnestly solicits the Examining Attorney's approval for registration of the mark. If you have any questions regarding this matter, please telephone the undersigned attorney.

DATED: September 9, 2013

GRANT'S LAW FIRM,

By:           /Allan Grant /            
ALLAN HOWARD GRANT  
Attorneys for Applicant,  
EBA Design, Inc.

ALLAN HOWARD GRANT  
GRANT'S LAW FIRM  
17351 GREENTREE DRIVE  
RIVERSIDE, CALIFORNIA 92503  
Phone: (951) 544-5248  
Facsimile: (866) 858-6637  
E-mail:allan\_grant@sbcglobal.net