

Response Argument Section


Applicant: Cactus Communications Pvt. Ltd

Mark: The logo for the word "CACTUS" is displayed. The letters "C", "A", "T", "U", and "S" are in a bold, black, sans-serif font. The letter "C" is the first letter and is in black. The letter "A" is the second letter and is in red. The letter "T" is the third letter and is in black. The letter "U" is the fourth letter and is in black. The letter "S" is the fifth letter and is in black.

Serial No.: 79155969

I. SUMMARY


In the Office Action, the Examining Attorney requested that Applicant claim ownership of U.S. Reg. No. 3916466 (which covers text editing, proofreading, translation, teaching and medical technical writing services in Classes 35, 41 and 42). The Office Action also required Applicant to amend the mark

description for the  mark and include a color claim for red and black. Such revisions appear in the electronic portion of the Response. While no amendments to the specification of goods were requested for the present application, Applicant has amended the specification along the lines of revisions suggested for a companion application.

Finally, the Office Action sets forth a number of likelihood of confusion refusals (and potential refusals) for a variety of CACTUS-formative marks in Class 16 by four different owners. Applicant has further amended the specification of goods to clarify its relevant field, thus obviating any issues raised relative to the cited registrations and prior pending applications. Applicant's application has thus been amended as follows:

PRINTED PROMOTIONAL MATERIALS, NAMELY, BROCHURES AND PAMPHLETS ABOUT COPY EDITING, TRANSLATION AND COPY WRITING, HOARDINGS IN THE NATURE OF BILLBOARDS, PRINTED ADVERTISING BOARDS OF PAPER AND CARDBOARD; PRINTED TEACHING MATERIALS IN THE FIELD OF COPY EDITING, TRANSLATION AND COPY WRITING; PRINTED NEWSLETTERS IN THE FIELD OF COPY EDITING, TRANSLATION AND COPY WRITING; PRINTED PUBLICATIONS NAMELY BOOKS, MAGAZINES, NEWSLETTERS IN THE FIELD OF COPY EDITING, TRANSLATION AND COPY WRITING, in Class 16.

Such amendments distance Applicant's mark from the citations, making it clear there is no overlap in the parties' respective goods, and no likelihood of confusion with the cited registrations and prior pending applications set forth in the summary chart immediately below:

Mark	Class 16 Goods	Owner	Number
	Stationery, including printed paper used for letters, printed envelopes, postcards and greeting cards	Cactus Gluckwunschkarten GMBH	1628251
CACTUS CANYON	Printed religious books, religious pamphlets, religious magazines, religious newsletters, religious bulletins, printed religious teaching materials	Lifeway Christian Resources of the Southern Baptist Convention	3436654
Happy Cactus Designs	Greeting cards; Notepads; Paper stationery; Stickers	Happy Cactus Designs LLC	4300949
CACTUS RESTAURANTS	Books and magazines in the field of food and cooking	Cactus Restaurants Ltd.	4455205
CACTUS	Books and magazines in the field of food and cooking; all the foregoing relating to restaurants and bars and not relating to baseball or softball or a baseball or softball team, league, mascot or stadium	Cactus Restaurants Ltd.	77597770
CACTUS CLUB	Books and magazines in the field of food and cooking; notecards and postcards; all the foregoing relating to restaurants and bars and not relating to baseball or softball or a baseball or softball team, league, mascot or stadium	Cactus Restaurants Ltd.	85307646

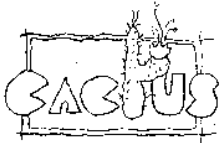
Applicant notes that the cited registration for CACTUS CANYON of U.S. Reg. No. 3436654 is now cancelled and no longer a barrier to registration. Moreover, given the amendments to Applicant's specification of goods, the differences in the parties' respective marks, the coexistence of the cited registrations with no confusion, and the coexistence with Applicant's prior registration (of which Applicant claims ownership), there is no confusion between the present application as amended and the cited registrations. Applicant requests withdrawal of the likelihood of confusion refusal and that the present application be approved for publication.

II. ARGUMENT

A. The Marks Are Not Confusingly Similar.

1. The Amendment To Applicant's Specification Removes The Opportunity For Confusion.

Applicant respectfully submits that its **CACTUS** mark, particularly as amended above, is not likely to cause confusion with the cited registration for the mark



for “stationery, including printed paper used for letters, printed envelopes, postcards and greeting cards,” nor “Happy Cactus Designs” for “greeting cards; notepads; paper stationery; stickers,” nor “CACTUS RESTAURANTS” for “books and magazines in the field of food and cooking.” Applicant notes that despite covering identical goods (stationery and greeting cards), the



mark of U.S. Reg. No. 1628251 by Cactus Gluckwunschkarten and the “Happy Cactus Designs” mark of U.S. Reg. No. 4300949 by Happy Cactus Designs LLC, both peaceably coexist on the Principal Register. Likewise, the CACTUS RESTAURANT mark of U.S. Reg. 4455205 by Cactus Restaurant Ltd. for food/restaurant publications coexists with these two prior registrations for stationery and greeting cards, and all registrations coexisted with the CACTUS CANYON mark of U.S. Reg. No. 3436654 for religious publications prior to its cancellation. In short, the US Patent and Trademark Office has already determined that there is no confusion relative to the cited CACTUS-formative registrations (and the prior pending applications),¹ even for identical goods.

¹ The Office Action highlighted two prior pending applications (U.S. Application Serial Nos. 77597770 for CACTUS and 85307646 for CACTUS CLUB), also in the name of Cactus Restaurants Ltd. and which cover food- and cooking-related books in Class 16, as set forth in the summary chart above. Both have been allowed despite the first receiving similar likelihood of confusion refusal. Applicant's remarks regarding the cited registration of U.S. Reg. No. 4455205 for CACTUS RESTAURANTS by this same entity (Cactus Restaurants Ltd.) are equally applicable to the cited prior pending applications. As such, Applicant requests that the potential likelihood of confusion refusal based on U.S. Serial Nos. 77597770 and 85307646 likewise be withdrawn and the present application approved for publication.

Against this backdrop, and given the differences between Applicant's stylized **CACTUS** mark for print, teaching and promotional materials all related to the fields of copy editing, translation and copy writing and the goods of the cited registrations, it is clear that there is no likelihood of confusion and Applicant's mark should be permitted to coexist as well.

The amendment to Applicant's identification of goods specifies Applicant's field, making it clear that Applicant is not offering greeting cards, regular stationery, or specialized food/cooking publications. Applicant's mark is targeted to translation, copy editing and copy writing materials – goods that serve a different purpose and different consuming public than those associated with greeting cards or food/cooking books. No confusion is thus likely to result from registration of Applicant's mark.

Given the differences between Applicant's mark and the cited registrants' marks, the amendments to Applicant's specification of goods, and the deletion of arguably overlapping goods, the differing nature of the parties' respective consuming publics, and the peaceable coexistence of the cited CACTUS-formative marks in Class 16, confusion is not likely to arise. Applicant requests withdrawal of the likelihood of confusion refusal and approval of the present application for publication.


2. The Marks Are Sufficiently Different To Avoid Confusion.

Applicant notes that In re E.I. DuPont de Nemours & Co., 177 U.S.P.Q. 56 (CCPA 1973) stands for the proposition that likelihood of confusion depends upon whether the purchasing public would mistakenly assume that an applicant's goods or services originate from, are sponsored by, or are in some way associated with goods or services provided under a cited registration. In DuPont, the court enunciated several factors relevant to determining likelihood of confusion. In this case, Applicant's clarification of its field (copy editing, translation and copy writing), deletion of the specific potentially

overlapping goods and the significant differences between the parties' marks support a determination that confusion is wholly unlikely.

In addition to being sufficiently differentiated by reason of discrete field, disparate goods, and differing target markets, Applicant's **CACTUS** mark is visually distinct from the cited registrations, including its dual color-scheme, a stylized font, and a highlighted second letter C



– aspects that are absent from the cited , “Happy Cactus Designs” and CACTUS RESTAURANTS marks. As such, the visual differences present in the parties' marks is sufficient to ward off any confusion.

Applicant additionally notes that the mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. McGregor-Doniger, Inc. v. Drizzle Inc., 202 U.S.P.Q. 81 (2d Cir. 1979). Thus, in holding the mark “DRIZZLE” for women’s overcoats was not likely to cause confusion with “DRIZZLER” for golf jackets, the Court of Appeals for the Second Circuit stated “[f]irst, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. ‘Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.’” Id. at 89 (citations omitted).

The basic principle in determining confusion between marks is that the marks must be compared in their entireties. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. In re Nat’l Data Corp., 224 U.S.P.Q. 749, 850-51 (Fed. Cir. 1985) (citations omitted); TMEP § 1207.01. For example, the Board in Hart Schaffner & Marx v. Marks Ltd., 229 U.S.P.Q. 544 (TTAB 1986) held that even though the goods of the parties were closely related, the mark “MARKS LTD” was not likely to create confusion with a composite mark “HART SCHAFFNER & MARX” stating that:

[a]lthough “MARKS” and “MARX” might be likely to create confusion if they were used by themselves as marks for the goods and services of the parties, we see no likelihood of confusion in the case presently before us, where these words are only one element of marks which are otherwise not at all alike in meaning, appearance or sound.

Id. at 546.

Similarly, the Federal Circuit in In re Hearst Corp., 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), in reversing a decision of the Board, found “VARGAS” and “VARGA GIRL,” both for calendars, to be sufficiently different in sound, appearance, connotation and commercial impression to negate any likelihood of confusion. The Board, in analyzing the marks for confusing similarity, found that “VARGA” was the dominant element of the VARGA GIRL mark, and that “GIRL” was merely descriptive and thus could not be afforded substantial weight in comparing VARGA GIRL with VARGAS. The Federal Circuit determined that the Board had erred in its analytic approach, stating:

Although undoubtedly “VARGA” and “VARGAS” are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight. 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 to 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. at 1239.

CACTUS

In the instant case involving Applicant’s CACTUS mark, the mere identification of a common element does not mean that a likelihood of confusion exists. Sources Services Corp. v. Chicagoland Job Source, Inc., 1 U.S.P.Q. 2d 1040 (N.D. Ill 1986). Indeed, where the identification of goods in the present application has been amended to clarify the translation, copy editing and copy writing field, the very basis for the likelihood of confusion refusal has been removed. This amendment, coupled with the significant differences in the parties’ respective goods, targeted consuming publics, and in the parties’ respective marks (including the presence of design elements, the highlighted second letter “C” in Applicant’s mark, as well as the other visual elements and wording

present in the cited registrations), highlight the lack of confusion with regard to the parties' marks. This



is particularly evident given that the cited registrations for [redacted] and "Happy Cactus Designs," by different owners, coexist for identical goods, and that all four of the initially-cited registrations coexisted at least at one point. This coexistence underscores the Office's determination that differing visual aspects likely assist consumers in distinguishing between the marks, such that no confusion is likely to arise.

Just as the DRIZZLE and DRIZZLER marks for clothing and the VARGAS and VARGA GIRL marks for calendars were deemed capable of coexisting without confusion, so too can Applicant's mark for

CACTUS for print, promotional and teaching material relating to translation, copy editing and copy writing coexist with the cited registrations for



[redacted] for stationery and greeting cards, "Happy Cactus Designs" for stationery and greeting cards, and the CACTUS RESTAURANTS mark for food/cooking publications.

These differences, along with the amendment to Applicant's specification to identify its field and delete the potentially overlapping goods, make it clear that there is no opportunity for confusion with regard to the parties' respective marks.

Although differences in stylization may not always be sufficient to distinguish marks, Applicant submits that the stylization elements of its mark cannot be ignored and do, in fact, further render the marks distinguishable, particularly when coupled with the additional elements in the cited registrations



(Western-themed design of _____, additional wording in “Happy Cactus Designs” and “CACTUS RESTAURANTS”). Composite marks consisting of both words and designs still must be evaluated in their entireties. TMEP Section 1207.01(c)(ii). As recently noted by the TTAB, design elements can assist in distinguishing marks, even when one of the marks appears in standardized format. For example, in In re White Rock Distilleries, Inc., 92 USPQ2d 1282 (TTAB 2009), the Board reversed the examining attorney’s likelihood of confusion refusal of the standard-character VOLTA mark for caffeine-infused vodka based on a prior registration for TERZA VOLTA in stylized format for wine as shown below:



Notably, the Board stated that while all reasonable manners of display must be considered, it is “not reasonable to assume that the applicant’s VOLTA mark would be presented with the design element appearing in registrant’s mark.” Id. Given the appearance of the cited registrants’ marks (with differing design elements and/or wording), these additional features serve to further distinguish Applicant’s mark from those of the cited registrations.

As noted in the Electrolyte matter, there “is no general rule as to whether letters or design will dominate in composite marks ... the spoken or vocalized element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.” 16 USPQ2d 1239, 1240 (Fed. Cir. 1990); see also Georgia-Pacific Corp. v. Great Plains Bag Co., 204 USPQ 697, 699 (CCPA 1980) (noting, a stylized letter design cannot be treated simply as a word mark).

In short, the amendment to Applicant's identification of goods is sufficient to ward off any confusion and the differences in the parties' respective marks further underscore the lack of opportunity for confusion. Applicant thus requests withdrawal of the refusal to register and requests approval of the application for publication.

B. Confusion Must Be Likely, Not Merely Possible.

Finally, while Applicant submits that the above arguments and evidence are sufficient to address the likelihood of confusion refusal, Applicant also notes that a mere possibility of confusion is an insufficient basis for refusal under Section 2(d). In re Massey-Ferguson, Inc., 222 USPQ 367, 368; Witco Chem. Corp. v. Whitfield Chem. Co., 164 USPQ43 (CCPA 1969). In other words, a refusal to register based on likelihood of confusion as to the source of goods or services must not be merely possible, but likely. "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations, but with the practicalities of the commercial world with which trademark laws deal." Witco at 44.

III. CONCLUSION.

Inasmuch as all outstanding issues have been resolved, Applicant requests withdrawal of the refusal to register based on the cited registrations and prior pending applications, and requests that the

CACTUS mark of U.S. Serial No. 79155969 be approved for publication.