
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: GrandVision Group Holding B.V.

Application Serial No.: 79167884

Filing Date: March 4, 2015

Mark: FUZION

Class: 9

Examining Attorney: Robert Clark

Law Office: 101

APPLICANT'S RESPONSE TO OFFICE ACTION

Pursuant to 37 C.F.R. §2.62(a) and TMEP § 711, Applicant GrandVision Group Holding B.V. (“Applicant”), by and through its attorneys, respectfully submits this Response to Office Action regarding Application Serial No. 79167884 (“Application”) for the mark FUZION (“Applicant’s Mark”). Applicant is responding to the Office Action dated July 6, 2015 and mailed on July 7, 2015 (“Office Action”). Applicant responds to the issues raised in the Office Action as follows:

I. Entity Information

The Examining Attorney asks that Applicant specify its form of business and foreign country of incorporation. In response, Applicant submits that it is a Besloten Vennootschap, organized and existing under the laws of The Netherlands.

II. Significance of Applicant’s Mark

The Examining Attorney further asks Applicant to explain whether FUZION has any meaning or significance in the industry in which the goods are manufacture or provided, if Applicant’s Mark is a term of art within Applicant’s industry, or if Applicant’s Mark identifies a geographic place.

Applicant’s Mark has no meaning or significance in the industry in which Applicant’s goods are manufactured or provided, Applicant’s Mark is not a term of art within Applicant’s industry, and Applicant’s Mark does not identify a geographic place.

III. No Likelihood of Confusion Exists between Applicant's Mark and Registrant's Mark

The Examining Attorney has refused to register Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) on the ground that it is likely to be confused with the mark in U.S. Registration No. 3848245 for FUSION BY STEPPER (Stylized) for "spectacles, optical frames, sunglasses, contact lenses, sunglass lenses, eyeglass lenses, eyewear accessories, namely, eyeglass chains, bags, cases, cords; and parts therefor," in Class 9 ("Registrant's Mark").

Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register based the Registrant's Mark because the marks are different and Applicant's Mark should be able to coexist with Registrant's Mark on the Principal Register.

The standard for determining whether two marks are likely to be confused is set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01. The *DuPont* case establishes a number of factors to be considered in the analysis of whether two marks are likely to be confused under Trademark Act Section 2(d). Each factor may play a more dominant or diminished role, depending on the facts of each case. *DuPont*, 177 USPQ at 567. No single factor is dispositive. *Id.* The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. *See In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985).

The most relevant *DuPont* factors in this case are: (1) the dissimilarities between the marks; and (2) number and nature of similar marks in use on similar goods.

Under the Trademark Act, a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods be likely, not just possible. As the Second Circuit has stated, "likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible.'" *Estee Lauder, Inc. v. The Gap, Inc.*, 42 USPQ2d 1228, 1232 (2nd Cir. 1997) (internal quotations omitted) *quoting* 3 J. McCarthy, *Trademarks and Unfair Competition*, § 23:2 (1996) (now at 4 *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2015)). When the relevant *DuPont* factors are considered in relation to Applicant's Mark, each factor weighs in favor of allowing Applicant's Mark to register.

A. The Differences in Applicant's Mark and Registrant's Mark Preclude a Likelihood of Consumer Confusion

When Applicant's Mark FUZION and Registrant's Mark FUSION BY STEPPER (Stylized) are viewed in their entirety, as they must be, the differences are sufficient to avoid a likelihood of confusion. The similarity between the respective marks in their entirety as to appearance, sound, connotation, and overall commercial impression are primary factors to consider in a *DuPont* analysis. 177 USPQ at 567. It is well settled that in assessing likelihood of confusion, marks may not be dissected, nor any element of a mark ignored. TMEP 1207.01(b); *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Since marks tend to be perceived in their entirety, similarities between marks are based upon the overall impression of the marks. *Opryland USA, Inc. v. Great American Music Show Inc.*, 23 USPQ2d 1471, 1473

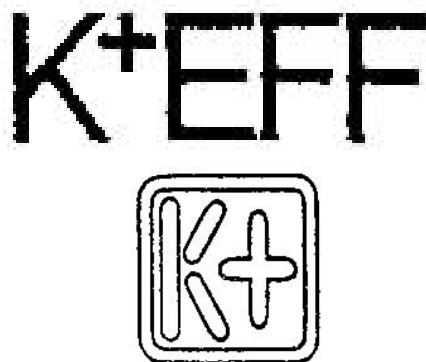
(Fed. Cir. 1992) (“When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared.”).

1. Applicant’s Mark and Registrant’s Mark Differ in Appearance

The differences in appearance and wording between the respective marks obviate a likelihood of confusion. Registrant’s Mark consists of the wording FUSION BY STEPPER with FUSION appearing in one font and “by Stepper” appearing in another. The letter “O” in FUSION is broken in two places. These design elements and the wording “by Stepper” are absent from Applicant’s Mark. Applicant’s Mark also includes the fanciful letter “Z” rather than the letter “S” in FUSION in Registrant’s Mark.

The integration of the stylization and design elements in Registrants’ Mark, and the unique wording in the respective marks, render the appearance, sound, connotation and overall commercial impression of the respective marks very different. To reach a conclusion that the marks are visually similar, one would have to ignore these distinct components.

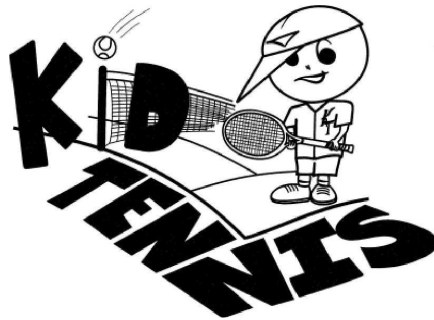
While wording that sounds similar may be common in the respective marks, the word portion of a mark is not solely dispositive of a likelihood of confusion determination. *See e.g., In re Electrolyte Laboratories*, 16 USPQ2d at 1240. In *Electrolyte Laboratories*, the Federal Circuit held that the overlapping marks, depicted below, for dietary potassium supplements were not likely to be confused because, even though the chemical symbols for potassium (K), potassium ion (K+) and the abbreviation for “effervescent” (EFF) in the marks could be vocalized, the combined design and letter features of the marks prevented confusing similarity. In reversing the decision of the TTAB, the Court stated that the Board erred in its focus on K+ in the marks to the exclusion of the other elements of the marks.



Similarly, while Applicant’s Mark and Registrant’s Mark may share wording that sounds alike, the marks are readily distinguishable. The stylization, design and distinct wording elements in the respective marks described above avoid a likelihood of confusion.

In re Jacquelyn Silberberg and Courtney Silberberg, Proceeding No. 78712155 (TTAB July 24, 2007) (annexed hereto as **Exhibit A**) is another pertinent case on this issue. The Board reversed the determination by the examining attorney that KID TENNIS (Stylized) and Design, depicted below, to identify clothing items, was likely to be confused with the word mark TENNISKIDS for clothing items. The Board found that the wording alone in the applicant’s KID TENNIS (Stylized) and Design mark was not necessarily the dominant feature, as contended by the

examining attorney. Rather, the word and design elements of the applicant's mark were found to be equally prominent in view of the way they were integrated, just as the textual portions in Registrant's Mark in this case are integral to the stylization and design elements. The *Silberberg* applicant's combined word and design mark therefore created a different impression than the registrant's plain word mark. In fact, the presentation of TENNISKIDS in standard characters arguably enhanced the distinction between the two marks: the Board deemed the applicant's mark to be "so highly stylized that it [did] not fall within the range of 'reasonable' manners of display that should be reserved to the registered standard character mark." *Id.* at 6-8.



Likewise, the wording in Registrant's Mark is so visually integrated with the stylization and design elements that they are inseparable, making it improper to reduce the essence of Registrant's Mark to just the word "FUSION". The prominent stylization and design components in Registrant's Mark therefore readily distinguish it from Applicant's Mark.

2. Applicant's Mark and Registrant's Mark Differ in Sound

Further preventing a likelihood of confusion are the differences in sound between the marks. Registrant's Mark is more than double the length of Applicant's Mark; pronounced with five syllables. Applicant's Mark is pronounced with just two syllables. *See* TMEP § 1207.01(b)(iv) (similarities in sound and word structure are additional factors to consider in determining whether a likelihood of confusion exists); *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 USPQ 848, 851 (TTAB 1983) (BABE v. BABOR; double as opposed to single sound); *HQ Network Sys. v. Executive Headquarters*, 18 USPQ 2d 1897, 1902 (D. Mass. 1991) (between HEADQUARTERS COMPANIES and EXECUTIVE HEADQUARTERS different total number of syllables, and use of HEADQUARTERS in one mark as a noun and in the other mark as an adjective).

3. Applicant's Mark and Registrant's Mark Differ in Connotation

The respective marks also differ in connotation. Registrant's Mark includes the word "FUSION", which has a recognized meaning related to the process of joining two or more things together. *See* definition at **Exhibit B**. Moreover, Registrant's Mark clearly denotes the source of its goods because it includes the words "BY STEPPER". Accordingly, when consumers see Registrant's Mark, they will immediately understand the source of the goods, namely, the registrant, Stepper Eyewear Limited.

Applicant's Mark, on the other hand, consists of the fanciful mark FUZION, which has no recognized meaning. Moreover, Applicant's Mark does not refer to the registrant, Stepper Eyewear Limited.

The inclusion of the source of the goods and the design elements in Registrant's Mark, and the use of the "Z" in Applicant's Mark to create a fanciful mark, readily distinguish the marks and prevent a likelihood of confusion.

B. Established Case Law Demonstrates that the Alleged Shared Element in the Respective Marks Is Not Sufficient to Render Confusion Likely

The fact that the marks at issue share a similar sounding word does not automatically compel a finding that confusion is likely. Even when word marks with overlapping elements are applied to arguably related goods, they can function to signify different sources. *See Gen. Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442, 1445 (8th Cir. 1987) (Kellogg, which used APPLE RAISIN CRISP for cereal, failed to show entitled to preliminary injunction against General Mills' use of OATMEAL RAISIN CRISP for cereal); *Little Caesar Enterpriser Inc. v. Pizza Caesar Inc.*, 4 USPQ2d 1942, 1444-45 (6th Cir. 1987) (LITTLE CAESARS for pizza not infringed by PIZZA CAESAR USA for an Italian restaurant).

Many TTAB and Federal Circuit decisions reiterate this requirement to compare marks in their entireties in order to assess whether they create a distinct commercial impression. Additional examples of cases in which marks with overlapping wording were found unlikely to be confused include the following:

- PECAN SANDIES versus PECAN SHORTIES (both for cookies)
- HEALTHY LIFE versus HEALTH FOR LIFE (both for vitamins and dietary supplements)
- CHIRO-MATIC versus CHIROPRACTIC (both for mattresses)
- TACO TOWN versus TACO TIME (both for restaurant services)
- CRISTAL (for champagne) versus CRYSTAL CREEK (for wine)

Keebler Co. v. Murray Bakery Prods., 9 USPQ2d 1736 (Fed. Cir. 1989); *Approved Pharmaceutical Corp. v. P. Leiner Nutritional Products Inc.*, 5 USPQ2d 1219 (TTAB 1987); *Land-O-Nod Co. v. Paulison*, 220 USPQ 61 (TTAB 1983); *Taco Time Intl., Inc. v. Taco Town, Inc.*, 217 USPQ 268 (TTAB 1982); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 USPQ 1459 (Fed Cir. 1998).

If all components of the respective marks are considered, as with the examples above, Applicant Mark and Registrant's Mark are not likely to be confused.

C. USPTO Precedent Demonstrates that Applicant's Mark and Registrant's Mark Can Coexist

Applicant further submits that its Mark is not likely to be confused with Registrant's Mark because the USPTO has demonstrated that multiple third party marks containing "FUSION" can coexist on the Principal Register to identify goods that are the same as or related to those identified by Registrant's Mark and Applicant's Mark.

As a result of the distinct wording and design elements in Registrant’s Mark and Applicant’s Mark, Applicant respectfully asserts that its Mark is no more similar to Registrant’s Mark or any of the other registered “FUSION” marks than such marks are to each other. Accordingly, Applicant’s Mark should be able to coexist with Registrant’s Mark for the same or similar reasons that Registrant’s Mark is permitted to coexist on the Principal Register with the marks listed in the chart below. *See e.g. Amstar Corp. v. Domino’s Pizza, Inc.*, 205 USPQ 969, 975-76 (5th Cir. 1980) (evidence of third party uses and registrations of identical or related marks reduces the risk of a likelihood of confusion); *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984) (Applicant’s stylized KEY mark for banking services was “no more likely to cause confusion with the five cited registered [KEY-formative] marks [for banking related services] than the five cited marks [were] likely to cause confusion with [each other and] the fifteen other registered marks that contain the term ‘KEY’” for banking related services).

Mark	Goods	Registration Number	Evidence of Use
FUSION	“Protective eyewear, namely, safety glasses,” in Class 9.	4181602	In use at http://www.abcsafetyglasses.com/gateway-fusion.html at Exhibit D
PhotoFusion	“Spectacle lenses,” in Class 9.	3956979	In use at http://www.zeiss.com/vision-care/en_us/products-services/coating-coloured-lenses/sun-filter-lenses/self-tinting-lenses/photofusion.html at Exhibit D
ARMOURFUSION	“Sunglasses,” in Class 9.	3646904	In use at https://www.underarmour.com/en-us/all/accessories/sunglasses/armourfusion at Exhibit D
FUSION ICE and FUSION ICE (Stylized) and Design	“Optical lenses having mirror coatings,” in Class 9.	4267949; 4264397	In use at http://www.icoatcompany.com/FusionIce.aspx at Exhibit D
FusionEtch	“Chemical preparations, namely, surface preparations for use as anti-reflective coatings of eyeglass lenses and sunglasses lenses,” in Class 2.	4670115	In use in February 28, 2014 USPTO specimen at Exhibit D
FUSION	“Machines, namely, an in-line coating system comprised of gravity flow processing vacuum roughing pumps,	4445967	In use at http://www.qtmi.net/equipment/fusion-m/ at Exhibit D

	turbo molecular pumps, multiple chambers for deposition coating of eyeglass lenses or sunglass lenses, human Interface touch screen, programmable logic controller, sputtering power supplies, load-lock chambers, vacuum gauges, and fixture wheels for the application of anti-reflective coatings for eyeglass lenses or sunglass lenses, mirror coatings and hydrophobic coatings for eyeglass lenses or sunglass lenses,” in Class 7.		
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Copies of the Certificates of Registration for the marks listed above are attached hereto as **Exhibit C**. Given the coexistence of these marks with Registrant’s Mark, Applicant respectfully asserts that the differences in Applicant’s Mark and Registrant’s Mark are sufficient to avoid a likelihood of confusion.

Moreover, in light of the number of third party registrations that incorporate the term “FUSION”, Applicant respectfully submits that it would arbitrarily contradict established and ongoing USPTO practice not to permit Applicant’s Mark to join this field, especially since it consists of the fanciful word FUZION. As such, Applicant respectfully requests that the refusal of the Application based on Registrant’s Mark be withdrawn.

In view of the foregoing, Applicant respectfully submits that the refusal under Trademark Act Section 2(d) is inappropriate because the threshold of a probability of confusion has not been met. The differences between the marks when viewed in their entireties compel the conclusion that a likelihood of confusion is remote. Applicant therefore respectfully requests that the Examining Attorney withdraw the refusal under Section 2(d) of the Trademark Act.

IV. Conclusion

Applicant asserts that with the responses and arguments above, all of the issues raised by the Examining Attorney in the Office Action have been resolved. Applicant therefore respectfully requests that the Application be passed to publication.

The Examining Attorney is invited to contact the undersigned with any remaining questions or concerns.

Respectfully submitted,
/Jamie E. Platkin/

Jamie E. Platkin
Cantor Colburn LLP
20 Church Street
22nd Floor
Hartford, Connecticut 06103-3207 U.S.A.
Phone: 860-286-2929
Fax: 860-286-0115
Email: TM-CT@cantorcolburn.com

Attorneys for Applicant GrandVision Group Holding B.V.
Our Ref: NO10406TUS