IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK EXAMINING DIVISION

APPLICANT	:	Georgia-Pacific Consumer Products LP)	
MARK	•	GP PRO)))	Erin M. Falk Trademark Examining Attorney Law Office 101
		PRO))	
SERIAL NO.	:	86762278)	
CLASS	•	3)	

SECOND RESPONSE

Applicant Georgia-Pacific Consumer Products LP ("Applicant" or "Georgia-Pacific") submits the following second Response to the August 2, 2016 Office Action issued regarding the above-referenced GP PRO application (the "Applicant's Mark").

I. NO LIKELIHOOD OF CONFUSION

Applicant maintains that no likelihood of confusion exists between Applicant's Mark and the prior registration for GP CLEANER (Reg. No. 2188603) (the "Cited Mark"). As previously stated in its July 8, 2016 Response to Office Action ("First Response"), the Court of Customs and Patent Appeals in *In re Du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) cited thirteen factors that may be considered in making the determination regarding whether there exists a likelihood of confusion between two marks under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) (1994). Of those thirteen factors, a minimum of seven weigh in favor of finding no likelihood of confusion with regard to Applicant's Mark and the Cited Mark. Specifically:

1. The similarity or dissimilarity of the mark in their entireties as to appearance, sound, connotation, and commercial impression;

- 2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- 3. The conditions under which, and buyers to whom, sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;
- 4. The number and nature of similar mark in use on similar goods;
- 5. The fame of Applicant's Mark;
- 6. The nature and extent of any actual confusion; and
- 7. Any other established fact probative of the effect of use.

A. Applicant's Mark and Cited Mark are Vastly Different When Viewed In Their Entireties as to Appearance, Connotation, and Commercial Impression.

Although the Applicant's Mark and the Cited Mark share the abbreviation GP, both marks must be viewed in their entireties to determine if confusion is likely. See Genesco Inc. v. Martz, 66 U.S.P.Q.2d 1260, 1269 (T.T.A.B. 2003). "[T]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. H.D. Lee Co. v. Maidenform Inc., 87 U.S.P.Q.2d 1715, 1727 (T.T.A.B. 2008). The inclusion of a common term in two marks is itself insufficient to render marks confusingly similar. Lever Bros. Co. v. American Bakeries Co., 693 F.2d 251, 257, 216 U.S.P.Q. 177, 182 (26 Cir. 1982) (finding AUTUMN GRAIN for bread and AUTUMN for margarine not confusingly similar). Thus, the use of a common element does not automatically mean that two marks are similar. Lever Bros. Co. v. Barcolene Co., 463 F.2d 1107, 174 U.S.P.Q. 392 (CCPA 1972) (finding ALL and ALL CLEAR!, both covering cleansing products, were not confusingly similar). Rather, a court must look to the overall impression created by the marks and not merely compare individual features. General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (OATMEAL RAISIN CRISP and APPLE RAISIN CRISP for breakfast cereals not likely to be

confused). Other marks sharing common elements have been found to avoid consumer confusion for related and sometimes even identical products:

- MAGIC (dehydrated onions, garlic, potatoes) and SOUR MAGIC (imitation sour cream mix). See Basic Vegetable Prods. Inc. v. General Foods Corp., 165 U.S.P.Q. 781, 784 (T.T.A.B. 1970).
- ROMANBURGER (sandwiches) and ROMAN (bread). See Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co., 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986).
- SILK' N SATIN (face lotion) and SILK (face cream). See Pacquin-Lester Co. v. Charmaceuticals, Inc., 484 F.2d 1384, 179 U.S.P.Q. 45 (C.C.P.A. 1973).
- CORN-ROYAL (butter) and ROYAL (liquid frying shortening). See Standard Brands, Inc. v. Peters, 191 U.S.P.Q. 168, 172 (T.T.A.B. 1975).
- FINAL and FINAL FLIP (both for rodenticide). See Bell Lab. Inc. v. Colonial Prods. Inc., 644 F.Supp. 542, 231 U.S.P.Q. 569 (S.D. Fla. 1986).
- CONDITION and CURL & CONDITION (both for hair care products). See *Redken Labs Inc. v. Clairol Inc.*, 501 F.2d 1403, 183 U.S.P.Q. 84 (9th Cir. 1974).
- EASY and EASYTINT (both for paint products). See Murray Corp. of America v. Red Spot Paint and Varnish Co., 280 F.2d 158, 126 U.S.P.Q. 390 (C.C.P.A. 1960)
- SILK and SILKSTICK (both for cosmetic products). See Melaro v. Pifzer, Inc., 214 U.S.P.Q. 645, 648 (T.T.A.B. 1975).

In the present case, the only common element between Applicant's Mark and the Cited Mark is "GP," which is not sufficient to support a likelihood of confusion. Applicant's Mark GP is an abbreviation for "Georgia-Pacific" while the Cited Mark is an abbreviation for "General Purpose," a descriptive and weak term when used with the Cited Mark's cleaning products. In fact, the three Specimens of Use filed by the owner of the Cited Mark each define the cleaning products as "General Purpose" cleaner in the description of the product. See Exhibit A. It is also notable that the Cited Mark is not registered on the Principal Register but on the Supplemental Register, which affords the Cited Mark only a very narrow scope of protection:

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

TMEP 1207.01(b)(ix) citing In re Hunke & Jochheim 185 USPQ 188, 189 (TTAB 1975).

In comparison, Applicant's use of GP is in reference to Applicant's famous, well-known and distinctive company name - "Georgia-Pacific." As Applicant set forth in detail in the First Response, Georgia-Pacific companies have been using the "GP" abbreviation continuously as both a word mark alone and in conjunction with the distinctive GP logo, as used in Applicant's Mark, to refer to Georgia-Pacific's family of companies and products for nearly 90 years since 1927. The GP mark has become famous and well-known within the industries and channels where Georgia-Pacific conducts business because of this extensive, continuous and long-standing use of the GP mark. It is not likely that the relevant consumers would confuse the only common element between the marks — "GP" especially when considering the respective abbreviations for "Georgia-Pacific" and "General Purpose."

Another distinguishing factor between the marks is that Applicant's Mark consists of the term "Pro", which is wholly different in sound, sight and meaning when compared to the other term used in the Cited Mark- the descriptive term "Cleaner." Pro and Cleaner do not look alike - Pro starts with the letter P and has 3 letters, Cleaner starts with the letter C and has 7 letters. Pro and Cleaner do not sound alike. Pro has one syllable, Cleaner has 2 syllables. In fact, Cleaner is a generic term that describes the general purpose cleaning product attributes identified in the Cited Mark. Pro and Cleaner do not have similar meanings nor are they interchangeable terms. All of these differences distinguish Applicant's Mark from the Cited Mark.

Further, Applicant's Mark is comprised of a distinctive logo. In contrast, the Cited Mark is a word mark that does not share any common design or logo elements with Applicant's Mark. As the Board previously held, design elements are particularly important with regard to the overall commercial impression of a mark. *See Genesco*, 66 U.S.P.Q.2d at 1269. These additional design elements contribute substantially to the overall commercial impression of Applicant's Mark such that Applicant's Mark and the Cited Mark are not confusingly similar even though they share a common element.

When visually comparing Applicant's Mark to the Cited Mark, their distinctive commercial impressions become even more prominent:

Applicant's Mark	Cited Mark As Used
PRO	GP CLEANER

For all the reasons set forth above as well as in the First Response the marks and their overall commercial impressions are distinct and will not be confused.

B. Applicant's Mark Is Intended to be Used For Goods Wholly Different From the Goods Offered Under the Cited Mark.

When the goods offered under two marks are distinctive, this factor can tip the scales against confusion. See In Re Columbia Insurance Co., 2008 WL 1741892, at *5 (T.T.A.B. 2008) (finding no likelihood of confusion between CROSSPOINT FABRICS for textile wallcoverings and CROSSPOINT for furniture). In In Re Columbia Insurance Co., the applicant sought to register CROSSPOINT FABRICS for "textile wall coverings not sold through retail outlets" and CROSSPOINT in connection with "furniture." Id. at *1. The Board found that:

[T]he respective goods involve different manufacturing processes. Although furniture and textile wallcoverings both 'equip' and decorate a room or other

interior space, textile wallcoverings typically require permanent installation and they are primarily decorative. Furniture, on the other hand, is typically not installed as a permanent fixture, and it is primarily functional.

Id. at *1. The Board thus found no likelihood of confusion and reversed the refusal to register. *Id.* at *5.

Here, Applicant's Mark is intended to be used in connection with a particular product, disposable wipes. The Cited Mark is used in connection with a completely different product – a general purpose liquid cleaner that does not include disposable wipes anywhere in the recitation of goods of the Cited Mark. For all these reasons, the goods intended to be used under Applicant's Mark are wholly distinct and not confusing with the Cited Mark's goods.

C. Applicant's Prospective Consumers are Sophisticated Professionals.

It is well-settled that where the "relevant buyers class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar." 3 McCarthy § 24:101, 23-196. Where consumers "exercise heightened care in evaluating the relevant products before making purchasing decisions," this factor weighs against finding likelihood of confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.* 269 F.3d 270, 284, 60 U.S.P.Q.2d 1609, 1617 (3d Cir. 2001) (finding no likelihood of confusion where the sophisticated consumers of the respective products place great importance on and take great care in purchasing security products). As previously discussed in the First Response, both Applicant's goods and those sold under the Cited Mark will be marketed to sophisticated, professional buyers whom are unlikely to be confused by the two different marks.

D. There Is Extensive Coexistence On The Registry For Marks
Incorporating Variations of "GP" and several of Applicant's other GP PRO
applications already have been approved for registration.

As set forth in the First Response, there are numerous GP marks owned by Applicant as well as other marks incorporating GP owned by third parties that all peacefully coexist. In particular, there are 16 other pending U.S. trademark applications for the identical GP Pro mark as shown in Applicant's Mark that already have been published and approved for registration, including two other pending applications in International Class 3, the same International Class for Applicant's Mark:

Trademark	Status	Application Number	Application Date	Class	Goods
Hademark	Status	Number	Date	Class	Antibacterial soap; Hand lotions;
					Industrial soap; Liquid soap; Room
	×				fragrance refills for non-electric
					room fragrance dispensers; Room
PRO	Published	86/761,051	09/18/2015	3	fragrances
					
PRO	Published	86/794,353	10/21/2015	3	Hand soaps
4	121 201 320			<u>, 222</u>	
PRO	Published	86/760,851	09/18/2015	5	Air deodorizer
4	en et ekst sen en				
PRO	Published	86/854,189	12/18/2015	5	Hand-sanitizing preparations
					Fixed dispensers of metal for
					cellulose wipes; Fixed napkin
					dispensers of metal; Fixed towel
GP					dispensers of metal; Towel
PRO	Published	86/762,277	09/20/2015	6	dispensers of metal
GP.					
PRO					Plastic cutlery, namely, knives, forks,
	Published	86/807,659	11/03/2015	8	and spoons
PRO	Published	86/760,884	09/18/2015	11	Dispensing units for air fresheners
					Cooking products, namely, liners for
					conventional ovens in the nature of
					heat-transmitting containers for
					providing uniform heat and
PRO	Published	86/807,666	11/03/2015	11	humidity during cooking

		Application	Application		
Trademark	Status	Number	Date	Class	Goods
GP.					Cellulose wipes; Disposable wipes
PRO					not impregnated with chemicals or
1-34-34.50	Published	86/760,919	09/18/2015	16	compounds; Toilet seat cover paper
GP.					bathroom tissue; facial tissue; paper
PRO	Published	86/794,355	10/21/2015	16	napkins' paper towels
					Packaging containers comprised of
GP.					paperboard for food and beverages;
PRO	Published	86/807,668	11/03/2015	16	Paper food wrap; Paper tray covers
					Fixed dispensers not of metal for
					cellulose wipes; Fixed napkin
(d)					dispensers not of metal; Fixed towel
PRO	Published	86/760,947	09/18/2015	20	dispensers not of metal
					Plastic containers and covers for the
PRO	Published	86/807,664	11/03/2015	20	food industry; Plastic lids
	1 donored	00,007,007	,		Automatic soap dispensers;
					Dispensers for liquid soap; Garbage
					cans; Napkin holders; Soap
PRO	Published	86/761,053	09/18/2015	21	dispensers; Toilet paper dispensers
					N. Property of the Control of the Co
					Non-woven disposable textile wipes
A		/	00/40/0045	24	not impregnated with chemicals or
PRO	Published	86/760,902	09/18/2015	21	compounds
					Beverage stirrers; Disposable
					dinnerware, namely, plates, bowls,
					serving trays; Drinking cups sold
					with lids therefor; Drinking straw
					dispensers; Drinking straws; Meal
	D. J.P. L.	00/007.003	11/02/2015	24	trays; Paper and plastic cups; Paper
PRO	Published	86/807,663	11/03/2015	21	baking cups

E. No Actual Confusion Exists, and Applicant Lacks Any Intent To Elicit Confusion In Consumers.

There is no evidence of any actual confusion between Applicant's Mark and the Cited Mark.

Furthermore, Georgia-Pacific has no intent or desire to trade on any goodwill or derive any benefit from the reputation of the Cited Mark. Georgia-Pacific is a long-established

company that has been operating for nearly nine decades. It is well-known as a leading

manufacturer of paper products, consumer products, packaging, cellulose and building products

and owns significant goodwill in its trademarks covering, among countless other goods,

including the wiper products in International Class 3 identified in Applicant's Mark.

II. REQUEST FOR INFORMATION

In response to the Examining Attorney's request, currently Applicant's Mark is not in use

in commerce yet, however, the type of wipes Applicant intends to offer under Applicant's Mark is

similar to Applicant's Brawny® wipes as shown in the attached Exhibit B.

III. PROPOSED NEW IDENTIFICATION OF GOODS

To further distinguish Applicant's goods from those offered under the Cited Mark,

Applicant proposes the following amendment to Applicant's recitation of goods:

Disposable wipes for industrial and commercial use.

IV. CONCLUSION

Having fully responded to the issues raised in the Office Action, Applicant respectfully

requests that all objections be withdrawn, and that its application pass to publication in due

course.

Respectfully submitted,

Date: January 26, 2017

Christine M. Cason

Katelyn N. Andrews

Georgia-Pacific Consumer Products LP

133 Peachtree Street

Atlanta, GA 30030

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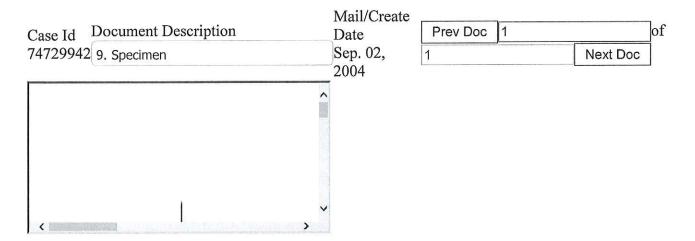
Exhibit A



TSDR Help

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STERIS* **GP Cleaner*** General Cleaning Detergent

1106-01 208.18 Liters (55 Gal.)

GP Cleaner is a concentrated liquid, general purpose cleaner ocetaning writing agents to give facil periodizate parallean inclusively sade. It unablasts has been albut, prince de, or pelinders destructives or registers exceeding, sade is formationed with north and common industrial protect newly objected metallitician facilities. It is also computate an proper concentrations with soft metals such as alamman.

with self metals such as destroyean.

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GP Cleaner

GP Cleaner
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For exhibition and multiplicities of use only. Not for frame using See Material Safety Data Sheet for exhibitional information.

STEDS Corporation

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GP Cleaner®

Detersif à usage général

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GP Cleaner

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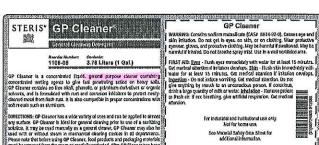
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Calgon Vestal

GP Cleaner



CONCENTRATED MULTI-PURPOSE CLEANER

Calgon Vestal Laboratories GP Cleaner is a concentrated, liquid, general purpose cleaner, containing concentrated wetting agents to give fast penetrating action on heavy soils. GP Cleaner contains no free alkali, phenolic or petroleum derivatives or organic solvents, and is formulated with rust and corrosion inhibitors to protect newly-cleaned metal from flash rust. It is also completely safe in proper concentrations for use on soft metals such as aluminum. GP Cleaner is authorized by the USDA for use in federally inspected meat and poultry plants, Category "A1".

DIRECTIONS FOR USE: GP Cleaner has a wide variety of uses and can be applied to almost any surface. Refer to your Calgon Vestal Laboratories Market Specialist or Technical Data Sheet for recommended concentrations and surfaces.

GP Cleaner may be used with or without steam in mechanical cleaning devices in all departments. Please note that before GP Cleaner is ideal for general cleaning prior to use of a sanitizing solution, It may be used manually as a general cleaner or using GP Cleaner, food products and packaging materials must be removed from the room or carefully protected. After GP Cleaner has been applied, equipment and utensils must be thoroughly rinsed with potable water.

WARNING: Contains sodium metasilicate (CAS #6834-92-0).

CAUSES EYE AND SKIN IRRITATION. Avoid contact with eyes, skin and clothing. Wash thoroughly after handling.

28009

FIRST AID: <u>Eyes:</u> In case of contact flush with plenty of water for at least 15 minutes. Call a physician. <u>Skin:</u> In case of cogtact flush with plenty of water for at least 15 minutes. If irritation develops call a physician. <u>Ingestion:</u> Give 1 or 2 glasses of water and call a physician.

FOR INDUSTRIAL AND INSTITUTIONAL USE ONLY. NOT FOR HOME USE.

CONTENTS: 55 U.S. GALLONS (208.18 Liters)



5011 Manchester Ave. St. Louis, Missouri 63110

1106-01A(394)

CALGON VESTAL LABORATORIES, INC.
SUBSIDIARY OF MERCK
& CO., INC.

PRODUCT MADE IN U.S.A.

Exhibit B



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☆ Catalog Home » Wipers & Dispensers » BRAWNY INDUSTRIAL® Cleaning Wipes » WET Hand Towel





Mfg: 21501

GP Brawny Industrial® Blue Wet Hand Towels

6 Pails @ 84 Towels, 504 Towels, Wiper (WxL) 8.600" x 12.200"

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- Pre-moistened hand towels clean grease and grime off hands.

Description

The Brawny Industrial® wet hand towel features cloth-like softness that allows you to easily wipe and clean greasy and grimy hands on the spot. Soft, durable & strong with no gritty residue and clean, fresh scent make these a perfect clean-up solution and portable pail with one-at-a-time dispensing and added wiper protection helps reduce waste and control costs.

Features Cloth-Like - soft durable & strong Cleans clean grease and grime off hands

	No gritty residue						
	Clean, fresh scent						
	Dispenses from a portable, water-resistant pail						
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