

I. Overview

1. The Examiner's 10/23/2017 Office Action (the "Office Action") cited US Trademark Registration Nos. 4973022 for "REBEL;" 4857596 for "REBEL SURF;" 4813034 for "REBEL BY ZIGI;" 4578212 for "REBEL QUEEN;" 4215923 for "HOGAN REBEL;" and 3720715 for "REBEL GREEN" as creating a likelihood of confusion under § 2(d) of the Trademark Act in view of Applicant's mark, "REBEL." Applicant respectfully disagrees that the above-referenced marks cause or would cause any likelihood of confusion as compared to Applicant's mark, "REBEL," and now provides argument as allowed by the Examiner in the Officer Action.

II. There is No Likelihood of Confusion

2. When testing for likelihood of confusion under § 2(d), multiple factors, when of record, must be considered, but no single factor is dispositive. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997). These factors are:

- a. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- b. 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;
- c. The similarity or dissimilarity of established, likely-to-continue trade channels;
- d. The conditions under which, and buyers, to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing;
- e. The fame of the prior mark (sales, advertising, length of use);
- f. The number and nature of similar marks in use on similar goods;
- g. The nature and extent of any actual confusion;
- h. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;

- i. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- j. The market interface between applicant and the owner of a prior mark:
 - i. a mere “consent” to register or use,
 - ii. agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party,
 - iii. assignment of mark, application, registration and good will of the related business, or
 - iv. laches and estoppel attributable to owner of prior mark and indicative of lack of confusion;
- k. The extent to which applicant has a right to exclude others from use of its mark on its goods;
- l. The extent of potential confusion, i.e., whether de minimis or substantial; and
- m. Any other established fact probative of the effect of use.

Application of E. I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); *In re Dixie Restaurants, Inc.*, 105 F.3d at 1406. Based on the following analysis of these factors, focused primarily on the factors cited by the Examiner in the Office Action, as well as additional relevant factors, Applicant now shows why it respectfully disagrees with the Examiner’s § 2(d) rejection and why the rejection should be withdrawn.

III. The Nature of the Goods and/or Services Associated with the Marks Are Entirely Dissimilar

3. Regarding the second *DuPont* factor, the Federal Circuit held:

“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”

Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 942 (Fed. Cir. 1990) (citing cases that compare goods and services by solely relying on description in the registrant's application).

4. A comparison of the description of goods and services used by the several marks cited by the Examiner as confusingly similar to Applicant's mark reveals key differences that obviate any alleged confusion. Below are the specific goods and services of the allegedly confusing marks cited by the Examiner in the Office Action compared to the corresponding specific goods and services listed for Applicant's mark, related by Class:

A. The '022 and '715 Marks

5. The '022 mark's goods and services of record are listed as:

International Class 012 – Mobile storage cart for domestic and commercial use.

The '715 mark's good and services of record are listed as:

International Class 018 – All-purpose carrying bags.

Applicant's mark's goods and services of record are listed as:

International Class 012 – Trolleys; and

International Class 018 – Cosmetic cases sold empty; Cosmetic carrying cases sold empty; Luggage; Vanity cases sold empty; Trunks.

6. A review of the goods and services claimed by the '022 and '715 marks and Applicant's mark reveals that the '022 and '715 marks' goods are overly broad in nature for Classes 012 and 018 and unrestricted so as to allow Applicant's good to be easily distinguishable from the lexicon of goods potentially identified by the '022 and '715 marks. Further, although the Examiner states that both the '022 and '715 marks and Applicant's mark contain identifications that are identical in part and have no restrictions as to nature, type, channels of trade, or classes or purchasers, this is simply untrue.

7. Applicant's mark identifications for Classes 012 and 018 contain very specific and limiting qualifications regarding its goods and services. While the '022 and '715 marks posit that it provides

a broad range of “mobile carts” in the area of “domestic and commercial use” and “carrying bags” used in the area of “all-purpose,” respectively, Applicant’s mark identifies limiting categories such as “trolleys” and “cosmetic cases.” These limitations clearly distinguish Applicant’s goods and services from the goods and services cited by the ‘022 and ‘715 marks and serve to eliminate any potential confusion between consumers of the products associated with both marks. Further, the ‘022 and ‘715 marks’ identification of “mobile” and/or “carrying” goods does not inherently identify with the “trolleys” identified in Applicant’s mark. A case of any type is inherently mobile and can be carried, due to its ability to be transported to any destination, but that mobility does not automatically denote that said case is specifically designed and created for cosmetics or as a trolley.

B. The ‘596 and ‘923 Marks

8. The ‘596 mark’s goods and services of record are listed as:

International Class 018 – Leather and imitations of leather, and goods made of leather and imitations of leather, namely, all purpose bags and wallets; animal skins and hides; trunks and travelling bags, namely, suitcases, and sport bags; umbrellas, parasols; walking sticks; whips, harnesses and saddlery.

The ‘923 mark’s goods and services of record are listed as:

International Class 018 – Bags, namely, handbags, traveling bags, briefcases, leather briefcases, leather credit card holders, wallets, leather document briefcases, leather key cases, purses, trunks, suit cases, cosmetic bags sold empty, sports, athletics bags; evening and shoulder bags for ladies; leather shopping bags, school bags, garment bags for travel, suit carriers for travel, show bags for travel, beach bug, rucksacks, diaper bags, backpacks, Boston bags, traveling trunks, duffel bags, overnight bags, carry-on bags, all purpose sports bags for mountain-climbing; satchels, opera bags being purses; unfitted vanity cases, hides, cases, and boxes made of leather, bags made of leather for merchandise packaging, leather straps, umbrellas leather leashes.

Applicant’s mark’s goods and services of record are listed as:

International Class 012 – Trolleys; and

International Class 018 – Cosmetic cases sold empty; Cosmetic carrying cases sold empty; Luggage; Vanity cases sold empty; Trunks.

9. As with the '022 mark, a brief review and comparison of the '596 and '923 marks and Applicant's mark reveal distinct differences which should allow Applicant's mark to pass to publication. Specifically, Applicant includes in its Class descriptions several qualifications and other limiting language which distinguish Applicant's mark from the '596 and '923 marks.

10. While the '596 and '923 marks generally identify as travel bags and riding goods made of leather and/or other animal skins, Applicant's mark identifies specifically as trolleys and cases *specifically designed for cosmetics and vanity items*. (emphasis added). Although the three marks may share some of the same words, the qualifications listed by Applicant's mark easily distinguish Applicant's specific intent and use for Applicant's mark's goods from the comprehensive "bags and wallets" comprised of "leather and imitations of leather" related to the '596 mark. It also distinguishes Applicant's mark from the "bags," "bags for travel," and "cases and boxes made of leather" related to the '923 mark. Stated simply, the '596 and '923 marks do not at all associate themselves with specific cosmetic and vanity-related cases, which are entirely different from leather wallets, bags for travel, sports bags, umbrellas, animal hide-trunks, satchels, or walking sticks, as identified by the '596 and '923 marks, and Applicant's mark does not concern itself with exotic animal suitcases, whips, harnesses, and saddlery.

11. In fact, Merriam-Webster defines "cosmetic case" as "a small piece of luggage especially for cosmetics." *See Exhibit 1, Merriam-Webster Webpage*. While the '596 and '923 marks deal with exotic leather bags intended as luggage or sportsbags, for example, Applicant's mark deals very specifically with cases designed for the transport and storage of cosmetics. The mere fact that the three marks generally pertain to receptacles of some type cannot disallow registration as marks of all types and all classes identify with receptacles while still providing enough distinction to delineate said mark's good and services. If this were not true, then the Examiner would not be able to cite so many alleged examples of similarly confusing marks, as those marks would create even more among one another than the Examiner contends is created by Applicant's mark.

12. Further, the ‘923 mark identifies with bags and travel luggage and/or carriers, but a brief review of the ‘923 mark’s owner’s webpage clearly distinguishes said “bags” from the cosmetic cases represented by Applicant’s mark. *See Exhibit 4, Hogan Rebel “Bags” Webpage.* Not only are the goods represented by Applicant’s mark and the ‘923 mark completely different, but it is difficult to imagine that said goods are even used for the same purpose. While the goods represented by the ‘923 mark are “bags” in the sense that they are purses, or could be used for carrying literally anything which fits within them, there is absolute no doubt as to what the intended use is for the goods represented by Applicant’s mark.

C. The ‘034 and ‘212 Marks

13. The ‘034 mark’s goods and services of record are listed as:

International Class 018 – Bags, namely, handbags, purses, sport bags, athletic bags, beach bags, cosmetic bags sold empty, garment bags for travel, overnight bags, shoes bags for travel, travel bags.

The ‘212 mark’s goods and services of record are listed as:

International Class 018 – Trunks; traveling bags; shoulder bags; handbags; boston bags; waist packs; reusable shopping bags; duffle bags; tote bags; evening handbags; clutch bags; wallets; purses; leather credit card cases; leather business card cases; briefcases; attache cases; pouches of leather; school bags; satchels; suitcases; garment bags for travel; leather key cases; backpacks; rucksacks; vanity cases sold empty; carry-on bags; beach bags; umbrellas; parasols; walking sticks.

Applicant’s goods and services of records are listed as:

International Class 012 – Trolleys; and

International Class 018 – Cosmetic cases sold empty; Cosmetic carrying cases sold empty; Luggage; Vanity cases sold empty; Trunks.

14. Like the ‘022 and ‘715 marks, the ‘034 and ‘212 marks concern themselves with either broad categories of “bags” or specifically limit themselves to certain classifications of “bags”. Applicant’s mark, however, is concerned only with “cases” that are specifically designed and intended for strict utilization only with cosmetics.

15. A quick Google search of “rebel cosmetic case” brings up, almost exclusively, Applicant’s mark’s goods. *See Exhibit 2, Google Search of “Rebel Cosmetic Case;” Exhibit 3, Google Shopping Search of “Rebel Cosmetic Case.”* Quite notably, the first three (3) websites, as well as the eight (8) of the eleven (11) images which appear on said Google search belong to Applicant. *Id.* The only other appearances on said Google search are for a “Rebel Athletic” bag, which is not one of the registrations cited by the Examiner, or known to have a registration at all, and several entities attempt to copy Applicant’s mark’s goods. *Id.*

16. Besides the clear differences in the goods and services associated with Applicant’s mark and the ‘034 and ‘212 marks, what is even more clear is that consumers who are searching for the types of goods associated with the ‘034 and ‘212 marks would not be seeking to consume, or be confused by, the qualitatively different goods and services associated with the ‘034 and ‘212 marks. Namely, consumers will not be confused by Applicant’s mark’s obviously professional cosmetic hard-cases with the soft, common, non-professional bags of the ‘034 and ‘212 marks.

IV. The Conditions Under Which Sales Are Made Regarding the Marks Are Sophisticated Rather Than Impulsive

17. Applicant’s mark involves the provision of certain specified goods, namely, professional, commercial grade, and sophisticated cosmetic cases which are designed only for utilization with cosmetics. Regardless of the clear distinctions between Applicant’s mark and each specific mark cited by the Examiner, the goods represented by Applicant’s mark are not simply stumbled upon by consumers. Rather, only sophisticated consumers seeking a very specific, highly-stylized, one-purpose cosmetic case will purchase Applicant’s mark’s goods. By comparison, the goods represented by each mark cited by the Examiner are so simple and unsophisticated as to be widely viewed and sought by lay-consumers. The specific, customized nature of Applicant’s mark’s goods, cited immediately, above necessitate that any consumer seeking to utilize said goods be sophisticated rather than impulsive. The sophistication of the consumers of the above-referenced

goods is actually a cut-above the ordinary sophisticated consumer considering the highly stylized, yet specific, and even more fully ensures an absence of confusion with Applicant's mark.

V. Additional *DuPont* Factors Favor Registrability of Applicant's Mark

18. With regards to the seventh and eighth *DuPont* factors, the Applicant is aware of no actual confusion during the time that Applicant's mark and the marks cited by the Examiner have been in use. In fact, to the best of Applicant's knowledge and belief, no such evidence has been acquired or supplied to the USPTO. Applicant acknowledges that actual confusion is not necessary for a finding of likelihood of confusion, however, Applicant asserts that every factor, when of record, must be considered in analyzing a likelihood of confusion rejection. *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A 1973); *In re Dixie Restaurants, Inc.*, 105 F.3d at 1406. Thus, the seventh and eighth factors are relevant in any likelihood of confusion analysis, and, here, favor the registrability of Applicant's mark.

19. The *DuPont* factors for which evidence exists favor Applicant's ability to register "LIVE HEALTHY" for its associated goods and services as identified in the record. Therefore, Applicant is entitled to registration. 15. U.S.C. §§ 1052, 1053. Applicant respectfully requests that the Examiner withdraw the § 2(d) likelihood of confusion rejection in the Office Action.

VI. Conclusion

20. For the foregoing reasons, Applicant respectfully submits that legal and factual support is presented for overcoming the Examiner's § 2(d) rejection of Applicant's "REBEL" mark. Upon acceptance by the Examiner, Applicant respectfully requests that its "REBEL" mark application be allowed to pass to publication.