

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
Noble Sports, Inc.)	
)	Nicholas A. Coleman
Serial No. 87/571,628)	Law Office 107
)	
Filed: May 21, 2018)	
)	
Mark: NOBLE)	

RESPONSE TO OFFICE ACTION

I. Introduction

The Examining Attorney has refused registration based on the presence of a likelihood of confusion between Applicant’s mark and U.S. Registration No. 5271114 (“N NOBLE BIKES”).

Applicant respectfully disagrees with the Examining Attorney’s refusal to register. For the reasons set forth here, Applicant’s mark does not present a likelihood of confusion with the cited registration. Therefore, Applicant respectfully requests that the Examining Attorney remove the rejection under section 2(d) and permit the application to proceed to publication. Because the mark and goods covered by the cited registrations are different than the goods sought for registration by Applicant, the cited registration does not present a likelihood of confusion with Applicant’s mark.

II. The goods covered by the cited registration are sufficiently distinct from Applicant’s goods.

Applicant has applied for NOBLE to cover the following goods in Class 12, as amended with this response- “Bicycles and bicycle parts; namely, shirts, baskets, water bottles, helmets, gloves, bells, locks, pads, and lights.” The cited registration of N NOBLE BIKES is directed

toward “Bicycle frames; bicycles” in Class 12. These marks and goods are sufficiently distinct as amended to preclude a finding of a likelihood of confusion.

Law and Argument

“[T]he commercial impression of a trade-mark 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....” In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1345- 46, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001) (quoting Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538, 545- 46, 40 S.Ct. 414 (1920); see also China Healthways Inst., Inc. v. Wang, 491 F.3d 1337, 1340, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007) (“[t]he marks must be compared in their entirety, at least when the overall commercial impression is reasonably based on the entirety of the marks”).

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board’s dismissal of opposer’s likelihood-of-confusion claim, noting “there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source” though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and

advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

Comparison of Marks

Applicant has applied for the mark NOBLE, whereas the cited registration in Registration No. 5271114 is for N NOBLE BIKES.

Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. See, e.g., *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ 390, 395 (Fed. Cir. 1983); see also TMEP §1207.01(b)(iii). However, the fundamental rule in this situation is that the marks must be considered in their entireties. See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (C.C.P.A. 1974) (emphasis added).

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to

appear on the label”); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Instead of considering the entirety of Registrant’s marks, the Examining Attorney determined that the word NOBLE was the dominant feature. Applicant asserts that the beginning of the cited mark should be considered more significant for consumers.

The stylized N portion of the mark is what distinguishes it for consumers looking to purchase Registrant’s goods. This beginning has a different commercial connotation, and therefore can be distinguished by consumers.

Comparison of Goods

Applicant has applied for NOBLE to cover the following goods in Class 12, as amended with this response- “Bicycles and bicycle parts; namely, shirts, baskets, water bottles, helmets, gloves, bells, locks, pads, and lights.” The cited registration of N NOBLE BIKES is directed toward “Bicycle frames; bicycles” in Class 12.

The mere fact that Applicant’s goods and those in the cited registrations are categorized in the same International Class does not dictate a finding of likelihood of confusion. The classification of goods and services is to facilitate the searching of marks and does not dictate the extent to which goods are similar or related for purposes of assessing likelihood of confusion. *See* 37 CFR § 2.85(g) (“Classification schedules shall not limit or extend the applicant’s rights.”); *INB Nat’l Bank v. Metroblast Inc.*, 22 USPQ2d 1585, 1586 (TTAB 1992) (noting that the likelihood of confusion determination cannot be restricted by the artificial boundary created by the trademark classification system, which is used purely as a matter of convenience).

The goods offered by Registrant are sufficiently narrower than Applicant's goods such that there is no likelihood of confusion for consumers seeking the goods of Applicant and Registrant. *See Quartz Radiation Corp. v. Comm/Scope Co., supra.*

III. Conclusion

For the reasons set forth herein, Applicant's application does not present a likelihood of confusion with the cited registration. The marks themselves are sufficiently distinct as to prevent a likelihood of confusion with consumers. Also, the goods covered by the cited mark are sufficiently narrow enough to conclude that there is no likelihood of confusion. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC, supra.* Therefore, Applicant respectfully requests that the Examining Attorney remove the rejection based on likelihood of confusion and permit the application to proceed to publication.

Respectfully Submitted,



Vincent E. Sawyer IV
Keener & Associates, P.C.
161 N. Clark Street, Suite 1600
Chicago, IL 60601
(312) 523-2164
vincent.sawyer@keenerlegal.com