IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Application Serial No. 87/621,782
Filing Date .....September 25, 2017
Applicant ..... Domex Superfresh Growers, LLC
Examining Attorney……..……Melissa S. Winter
Law Office 122
Counsel of Record .....Shamus T. O'Doherty
Attorney's Docket No. 37775-17070032
Mark: ..... MUSTANG and Design

RESPONSE TO OFFICE ACTION

In response to the Office Action dated January 17, 2018, Applicant respectfully submits the following remarks and argument in support of allowing the Application to proceed to publication. For the reasons indicated herein, favorable action with respect to this Response is respectfully requested.

REMARKS

In the Office Action dated January 17, 2018, the Examining Attorney refused the Application under the Trademark Act, Section 2(d), because the Examining Attorney determined the Applicant's mark MUSTANG, Serial Number 87/621,796, to be confusingly similar to Registration Number 1,337,038 and Registration Number 2,221,317. Applicant, by and through its attorney, contends that, pursuant to applicable law, Applicant's mark is not likely to cause confusion amongst consumers in relation to the two cited registrations. Therefore, Applicant respectfully requests the Examining Attorney reconsider and withdraw her original 2(d) refusal in light of the argument and modifications made in this Response, allowing the Application to proceed to publication.

"Likelihood of confusion cannot be predicated on dissection of a mark…the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data*

Corp., 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). In this instance the Examiner must consider the unique design features and colors associated with the mark as applied for. Such characteristics further differentiate Applicant's mark from the cited registration and are characteristics which make confusion unlikely. The mark, as applied for, when considered in its entirety, and when the differing nature of the goods are consider, is not likely to cause confusion.

In addition to the different characteristics of the mark, other *du Pont* factors need to be considered in the determination of likelihood of confusion. The Applicant draws the Examiner's attention to the dissimilarity and nature of the goods, as modified in this Response, the dissimilarity of trade channels, and the lack of any actual confusion over years of concurrent use.

In this Response to Office Action, Applicant has narrowed the scope of its goods description to "fresh fruit, namely, apples" to further differentiate it from the goods description contained in the registrations cited by the Examiner. Application has used the MUSTANG and Design mark in relation to "fresh fruit, namely, apples" for over seven years without ever experiencing confusion with the MUSTANG marks as applied to "grass seed and agricultural seed" by the owners of Registration No. 1,337,038 or "unprocessed edible black beans" by the owners of Registration No. 2,221,317. Simply stated, fresh apples are sufficiently different to avoid any confusion with the goods described in the cited registrations. Years of use of the mark without any confusion is evidence of this, and is its own *du Pont* factor, which must be considered.

Another element of the lack of confusion is the United States Patent and Trademark Office's willingness to grant registrations to the two cited registrations, without finding a likelihood of confusion amoung them. The mark is somewhat saturated, as evidenced by

the sixty eight (68) other live registrations for the mark MUSTANG in the USPTO database. Such saturation limits the applicable scope of the two cited registrations, providing further evidence that the goods, as described, are not confusingly similar with the proposed goods of Applicant.

Most importantly, the federal courts and Trademark Trial and Appeal Board have held that two completely unrelated food products, which are not commonly grouped together for meals, are not likely to be confusing to consumers simply because they both may be sold in the same grocery store or market. See, *Gen. Mills, Inc. & Gen. Mills Ip Holdings II, LLC*, 100 U.S.P.Q.2d 1584 (T.T.A.B. Sept. 14, 2011) ("the conditions surrounding [the goods] marketing must be such that the goods will be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they originate from the same source.") *citing Online Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *Mckee Foods Kingman, Inc.*, 91224476, 2017 WL 4675566, at *13 (Oct. 13, 2017) (fresh fruit and breakfast items may cause confusion, but salsa and breakfast items are not likely to cause confusion).

CONCLUSION

Applicant respectfully requests that the Examiner consider the arguments presented herein, along with the modifications made by the Applicant in this Response, and permit the Application to advance to publication. This, of course, would permit any third parties who would potentially be harmed by the Application to oppose the same, should they feel the need. Having complied with all other requirements in the Office Action, the Applicant believes that the Application is in condition for passage to publication, and prompt notice of publication is therefore courteously solicited. The Applicant, by and through its attorney,

would request that the Examining Attorney telephone the attorney of record in the event that a telephone conference could expedite the prosecution of the Application.