

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Arctic Paper Grycksbo AB Serial No.: 79/219,189 Filing Date: Sept. 27, 2017 Mark: ARCTIC	Examining Attorney: Joan Blazich Law Office 122
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RESPONSE TO OFFICE ACTION
DATED January 5, 2018

On Sept. 27, 2017, Arctic Paper Grycksbo AB (“Applicant”) filed an application to register the mark ARCTIC in connection with “Machine coated (glazed) wood-free printed paper” in International Class 16 (“Applicant’s Mark”). The Examining Attorney refused registration on January 5, 2018 based on a purported likelihood of confusion with the following U.S. registrations (“the Cited Marks”):

Mark	Relevant Goods	Reg. No.	Owner
ARCTIC ART	16: Coated paper for printing	3409183	Cohber Press, Inc.
ARCTIC PACKAGING INDUSTRIES	16: bags, namely, general purpose plastic bags, plastic pouches for shipping and mailing, padded plastic pouches for shipping and mailing, plastic grocery and hardware bags, reclosable plastic pouches for shipping and mailing; packaging materials, namely, plastic sheets for shipping and mailing; self-adhesive shipping labels, printed, blank, and partially printed labels not of textile, paper mailing pouches, adhesive and non-adhesive plastic bubble packs for wrapping and packaging, padded paper mailing pouches, corrugated paper mailing pouches, packaging envelopes for shipping documents, cardboard cartons, kraft paper rolls and sheets, newsprint paper rolls and sheets, cap paper, namely, paper for sealing and lining cartons for shipping and packaging, tissue paper	2191192	ARCTIC PACKAGING INDUSTRIES INC.
ARCTIC STAR	16: Notebooks; Pen and pencil cases	5157415	Bay Sales LLC

The Examining Attorney also required amendments to the identification of goods and clarification regarding Applicant's entity type.

I. IDENTIFICATION OF GOODS AMENDMENT

Applicant amends the identification of services in Class 16 as indicated below. The amendment is also reflected in the TEAS response submitted herewith.

Class 16: Machine coated **in the nature of** glazed wood-free **printing** paper

II. ENTITY INFORMATION

Applicant is an Aktiebolag, the equivalent of a "Joint Stock Company," organized under the laws of Sweden. This information is also reflected in the TEAS response submitted herewith.

III. NO LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT'S MARK AND THE CITED MARKS

The Examining Attorney initially refused registration of Applicant's Mark based on a likelihood of confusion with the Cited Marks. Applicant respectfully submits that there is no likelihood of confusion and the refusal should be withdrawn because: (1) Applicant's ARCTIC registrations have coexisted with the Cited Registrations since as early as 2006 with no apparent confusion; (2) the Office should examine the present application consistent with Applicant's previous registrations; and (3) the distinctions between the marks and goods at issue appear to be sufficient to avoid consumer confusion.

Considering the record as a whole, there is no likelihood of confusion between Applicant's Mark and the Cited Marks. Likelihood of confusion determinations must be made based on all of the facts in evidence that are relevant to the factors bearing on the likelihood of




confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In some circumstances, “a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors.” TMEP 1207.01.

A. Applicant’s longstanding use of ARCTIC alongside the Cited Registrations indicates that consumer confusion is not likely

In *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012), the Board reversed a refusal to register the mark ANYWEAR for footwear based on a likelihood of confusion with the registered mark ANYWEAR BY JOSIE NATORIE (and design) for “jackets, shirts, pants, stretch T-tops and stoles.” The Board stated that it would ordinarily have concluded that confusion was likely due to the similarities between the marks and goods; however, the Board was compelled “to balance the similarities between the marks and goods against the facts that applicant already owns a registration for a substantially similar mark for the identical goods, and that applicant’s registration and the cited registration have coexisted for over five years.” *Id.*

Similarly, in this case, Applicant owns several registrations incorporating the term ARCTIC that cover “paper” and similar goods that encompass the goods in the present application. These registrations have overlapped with the Cited Marks since as early as 2006 with no apparent confusion. Charts showing Applicant’s ARCTIC marks and the Cited Marks, including the dates these records have been or were active (from date of filing on), are below:

Applicant's ARCTIC marks

Mark	Goods	Reg. No.	Active Dates
ARCTIC	16: paper	3427551	11/21/2006 – 12/19/2014
 ARCTIC PAPER	16: paper	77611729	11/11/2008 – present
 Munken BY ARCTIC PAPER	16: Paper, namely, uncoated paper, papers for use in the graphic arts industry and book paper, text and cover/design papers, magazine paper, printing paper, writing paper, laminated paper, fine paper, namely, writing and drawing paper, copying paper, offset paper, continuous stationery paper, label paper, envelope papers	5338274	10/31/2016 – present
 Munken BY ARCTIC PAPER	16: Paper, namely, uncoated paper, papers for use in the graphics arts industry and book paper, text and cover/design papers, magazine paper, printing paper, writing paper, laminated paper, fine paper, namely, writing and drawing paper, copying paper, offset paper, continuous stationery paper, label paper, envelope papers	5344422	10/31/2016 – present

Cited Marks

Mark	Relevant Goods	Reg. No.	Active Dates
ARCTIC ART	16: Coated paper for printing	3409183	6/29/2006 – present
ARCTIC PACKAGING INDUSTRIES	16: bags, namely, general purpose plastic bags, plastic pouches for shipping and mailing, padded plastic pouches for shipping and mailing, plastic grocery and hardware bags, reclosable plastic pouches for shipping and mailing; packaging materials, namely, plastic sheets for shipping and mailing; self-adhesive shipping labels, printed, blank, and partially printed labels not of textile, paper mailing pouches, adhesive and non-adhesive plastic bubble packs for wrapping and packaging, padded paper mailing pouches, corrugated paper mailing pouches, packaging envelopes for shipping documents, cardboard cartons, kraft paper rolls and sheets, newsprint paper rolls and sheets, cap paper, namely, paper for sealing and lining cartons for shipping and packaging, tissue paper	2191192	2/2/1996 – present
ARCTIC STAR	16: Notebooks; Pen and pencil cases	5157415	12/11/2015 – present

While Applicant's Reg. No. 3427551 is no longer active, it coexisted with two of the Cited Marks—ARCTIC ART and ARCTIC PACKAGING INDUSTRIES—from filing (Nov. 21, 2006) to registration (May 13, 2008) to expiration (Dec. 19, 2014), spanning nearly twelve years altogether. Applicant's active Reg. No. 77611729 for ARCTIC PAPER and design similarly demonstrates longstanding coexistence. This registration was filed on Nov. 11, 2008 and registered on Nov, 24, 2009, meaning that it has coexisted (since the time of filing) with ARCTIC ART and ARCTIC PACKAGING INDUSTRIES for nearly ten years. The Cited Mark ARCTIC STAR was filed in 2015 (and was not refused based on Applicant's registrations or any others) and has coexisted with Applicant's ARCTIC PAPER registration since that time. Applicant's longstanding registration of its ARCTIC marks, which have coexisted without issue with the Cited Marks for years, weigh heavily in Applicant's favor and demonstrate that consumer confusion is not likely.

B. The Office should maintain consistency

Consistency in examination is an important goal of the USPTO. *See* Exhibit A, an excerpt from the USPTO's website discussing the Office's Consistency Initiative. While every application must be decided based on its own facts, the Office strives to achieve consistency, particularly regarding substantive issues, in order to promote overall high quality examination. *Id.*

In the present case, none of Applicant's four ARCTIC registrations identified above were refused based on any of the Cited Marks during examination. Similarly, ARCTIC STAR, which was later filed than Applicant's ARCTIC registrations, was not refused based on any of Applicant's marks. This indicates that, due in part to various parties using ARCTIC in

connection with related goods, the distinctions in the marks and/or goods have been repeatedly held to be sufficient to distinguish the marks. While Applicant recognizes that every application must be decided based on its own facts, the facts in the present application are largely the same as during the prosecution of Applicant's expired ARCTIC registration, Applicant's active ARCTIC PAPER registration, and Applicant's remaining active ARCTIC registrations. Since the Office strives to achieve consistency, Applicant respectfully requests consistency in the examination of the present application.

C. The distinctions between the marks and goods at issue are sufficient to avoid consumer confusion

When comparing marks to determine whether confusion exists, the marks must be compared in their entireties and in connection with the particular goods or services for which they are used. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749 (Fed. Cir. 1985). The Federal Circuit has repeatedly held that when marks contain additional or different elements, those differences alter the sight, sound, and meaning. *See, e.g., Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1390, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) (finding no likelihood of confusion between the marks PECAN SHORTIES and PECAN SANDIES, both in connection with cookies); *In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (finding no likelihood of confusion between VARGA GIRL and VARGAS, both in connection with calendars). Additions or deletions to marks also may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey different commercial impressions or the matter common to the marks is not likely to be perceived by purchasers as distinguishing source. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 U.S.P.Q.2d 1350, 1356-57 (Fed. Cir. 2004) (held that use of THE RITZ KIDS for

clothing items and RITZ for various kitchen textiles not likely to cause confusion because THE RITZ KIDS creates different commercial impression); Trademark Manual of Examining Procedure (“TMEP”) § 1207.019(b)(iii). Even when additional matter is disclaimed or descriptive, the differences between the marks as a whole must be considered, because a disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F. 3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010).

The Trademark Trial and Appeal Board has consistently held that if the goods and/or services in question are not marketed in a manner causing them to be encountered by the same persons in situations creating the incorrect assumption of origination from the same source, then confusion is not likely. *See, e.g., Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (TTAB 1990) (finding no likelihood of confusion between LITTLE PLUMBER for liquid drain opener and LITTLE PLUMBER & Design for advertising services); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 U.S.P.Q.2d 1668 (TTAB 1986) (finding no likelihood of confusion between QR for coaxial cable and QR for various products related to the photocopying field); TMEP § 1207.01(a)(i).

In this case, each of the Cited Marks contains additional matter not included in Applicant’s mark, such that the distinctions between the marks and/or goods at issue are sufficient to avoid consumer confusion.

1. ARCTIC ART

ARCTIC ART includes the wording ART, which sets the marks apart in terms of appearance and sound, and creates a different overall commercial impression. Specifically, the wording “art” brings to mind creative expressions, and the mark as a whole, ARCTIC ART, suggests illustrations or other works of visual art with a wintry theme. Applicant’s Mark has no such connotation, and therefore the marks as a whole are distinct. Overall, the marks are distinct in terms of appearance, sound, meaning, and commercial impression.

2. ARCTIC PACKAGING INDUSTRIES

ARCTIC PACKAGING INDUSTRIES includes the additional wording PACKAGING INDUSTRIES, which sets the marks apart in terms of appearance and sound. The additional wording in the Cited Mark, though descriptive, contributes to the mark’s meaning and commercial impression and indicates to consumers that the goods are packaging materials. ARCTIC by itself does not give this meaning, and in fact, Applicant’s goods are not packaging materials. The goods in the registration are mailing envelopes, shipping labels, and other similar goods used for the purpose of packing and shipping products. Applicant’s goods are paper used for high quality printing. The goods serve a distinct purpose and are offered to distinct consumers in different trade channels. Therefore, there is little chance that consumers of either party’s goods would be encountered by the same persons in a situation creating the incorrect assumption of origination from the same source.

3. ARCTIC STAR

ARCTIC STAR includes the additional wording STAR, which sets the marks apart in terms of appearance and sound, and creates a different overall commercial impression. Specifically, the wording “star” brings to mind a luminous point in the sky, and the mark as a

whole gives the impression of stars and constellations visible from the most northern part of the world. Additionally, “Arctic Star” is a British military campaign medal awarded to those who served on the Arctic Convoys during World War II. *See* Exhibit B. The many American consumers familiar with World War II-related history might also call this meaning to mind. Both potential meanings are distinct from the meaning of Applicant’s Mark. Additionally, the ARCTIC STAR registration covers pencil cases, notebooks, backpacks, and lunch bags—essentially, school supplies. The registrant’s pencil cases and notebooks are primarily sold to students through school supply trade channels. *See* Exhibit C. Applicant, on the other hand, sells high quality printing paper geared primarily towards professional designers, photographers, artists, and other professionals who require use of fine paper. *See* Exhibit D. Applicant’s goods are unlikely to be encountered by students shopping for school supplies, and overall, Applicant’s and Registrant’s goods are unlikely to be encountered by the same persons in situations creating the incorrect assumption of origination from the same source.

IV. CONCLUSION

The Board is “not concerned with the mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations, but with the practicalities of the commercial world with which trademark laws deal.” *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969). When considering all of the facts in evidence that are relevant to the *du Pont* factors, the practical reality is that consumers have not been confused by various uses of ARCTIC for related goods, and that there is no likelihood of confusion with the Cited Marks. In light of the foregoing arguments and evidence, Applicant

respectfully requests that the Examining Attorney withdraw the refusal under Section 2(d) and approve this application for publication in the Official Gazette.

Respectfully submitted,

Arctic Paper Grycksbo AB

Dated: July 18, 2018

/Danielle K. Johnson/

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