

<b>ARGUMENTS IN RESPONSE TO OFFICE ACTION</b>	Attorney Docket No.: TM2713US00
Applicant: NEXXFIELD INC. Serial No: 87788566 Filing date: August 13, 2018 For: REVERSE (design) Law Office: 125 Examining Attorney: Nicole Passman Agent/Attorney: Mihaela Dumitrean	

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
USA

Dear Examining Attorney,

These written arguments are filed in response to the Office Action issued May 22, 2018.

U.S. Application Serial No. 87410466 for REVERSO has been cited against the registration of the applied-for mark. For the reasons stated below, Applicant respectfully requests that the Examining Attorney withdraws the refusal and approves the application for publication.

**A. Difference between the nature of the goods and clientele**


From the outset, we would like to bring the examiner’s attention to the intrinsic differences in the nature and function of the goods covered by each mark. In fact, since the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application<sup>1</sup>, we highlight the fact that the applied-for mark contains specific limitations as to the nature, type, scope and field of use of the goods in question. The TMEP states that “the question is not whether people will confuse the marks, but rather whether the marks

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<sup>1</sup> See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

will confuse people into believing that the goods they identify emanate from the same source".<sup>2</sup>

In considering the similarity of the goods offered under two marks, the inquiry must focus on the relation of the goods in the minds of consumers<sup>3</sup>. Confusion is not necessarily likely simply because the goods can be described as being in the same category or field<sup>4</sup>. In the case at hand, each mark covers different types of goods with different and specific functions, and targets a different clientele as summarized in the table below:

<b>Trademark</b>	<b>REVERSO</b> (Serial No. 87410466)	 (Serial No. 87788566)
<b>Goods</b>	Vinyl floor coverings	Synthetic grass surfaces; artificial turf system for the installation of synthetic grass surfaces developed for optimal traction, stability, comfort and softness for the playing of soccer, American football, lacrosse, field hockey, golf, mini golf, tennis and other athletic activities.
<b>Field/Trade Channel</b>	Construction	Sports
<b>Targeted clientele</b>	« Off the rack purchasers » who are looking for home construction goods and that will never be confronted to the cited mark REVERSE (design) in the course of their purchases activities.	Mostly specialized representatives and distributors, municipalities, school boards, colleges and private sports centers, professional teams and professional organizations who are looking to cover sport fields with artificial grass.

<sup>2</sup> TMEP § 1207.01 (October 2017), quoting *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

<sup>3</sup> See *Packard Press, Inc. v. HewlettPackard, Inc.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000).

<sup>4</sup> See *Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002).

<b>Visual aspect of the goods</b>		
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It clearly appears from the respective statements of goods (which are very narrowly drafted) that the specific functionality and purpose of both marks are sufficiently different and distinct not to overlap. Consumers who are looking for floor coverings will not be confused by a specialized sports synthetic grass company and vice versa.

Furthermore, the marks are very unlikely to confuse people into believing that the goods they identify emanate from the same source, since the respective targeted consumers are completely different and the goods of the applied-for mark are intended for sophisticated purchasers who buy with care (the goods covered by the applied-for mark are very specific “niche” products and are generally very expensive). It is therefore unlikely that a prospective purchaser of either company's product would believe there is any relationship between the two companies or their respective goods.

Where the goods covered by the applied-for and cited mark are different, the Examining Attorney bears the burden of showing that the different goods would commonly be provided by the same source. E.g., *In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987) (Examining Attorney's argument that small segment of market would be familiar with both Applicant's use of PURITAN in connection with dry cleaning services and Registrants' uses of PURITAN in connection with dry cleaning equipment and dry cleaning chemicals rejected due to lack of proof of trade practices and failure to show likelihood, rather than possibility, of confusion; refusal reversed). There is no evidence of record that the two companies' respective goods are in any way related for purposes of the likelihood of confusion analysis.

For these reasons, the Examining Attorney should withdraw his refusal of registration under Section 2(d) of the Trademark Act. The mere possibility that relevant consumers might relate the two different marks does not meet the statutorily established test of likelihood of confusion. E.g., *In re Hughes Aircraft Company*, 222 U.S.P.Q. 263, 264

(TTAB 1984) ("the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source or origin, only where such confusion is likely").

## B. Difference between the marks

After consideration of the marks in connection with the particular goods for which they are used, the basic principle in determining confusion is that marks must be compared in their entireties. This factor requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." <sup>5</sup>

We respectfully submit that the cited mark is not likely to cause confusion with the applied-for mark, due to obvious visual differences, notably because Applicant's mark is drastically different in its visual appearance from the cited mark and bears a distinct and unique commercial impression, which makes consumer confusion highly unlikely:



The clear commercial impression communicated to consumers is not simply the wording "REVERSE" or "REVERSO", but instead is the fanciful design and color of the marks. It is not exclusively the use of similar words or letters that should be considered, but the entirety of the marks in question<sup>6</sup>. The applied-for mark consists of the wording "REVERSE" in stylized font in the color green at the top, two black symmetrical arrows in the middle and the wording "REVERSE" in stylized font in the color green with each letter appearing upside down below. The cited mark incorporates none of the design elements of the applied-for mark. Consumers encountering the applied-for mark get a very different

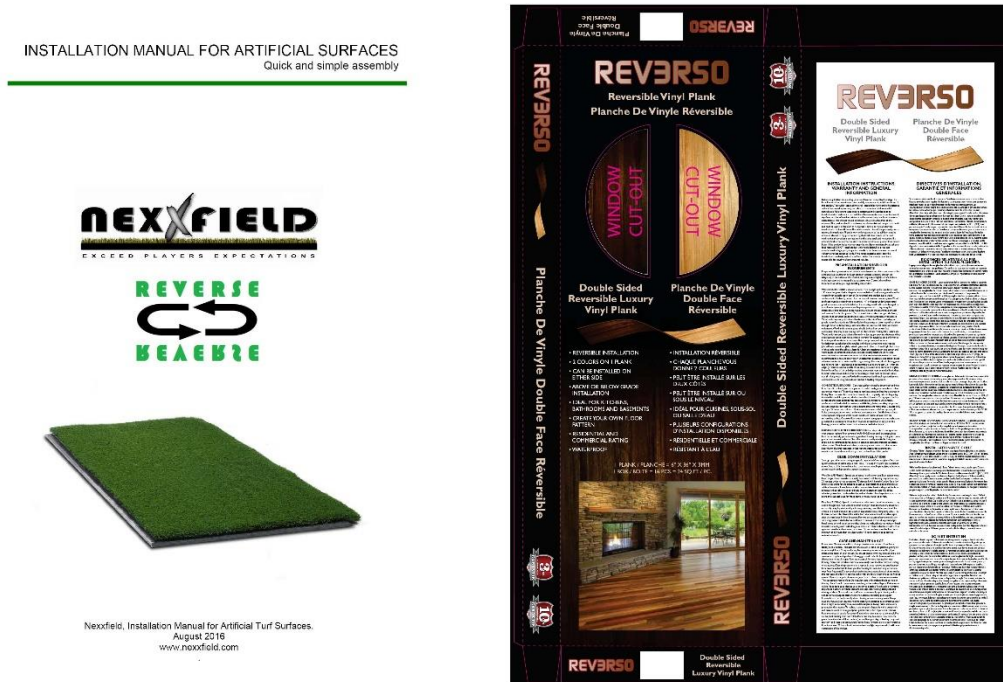
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<sup>5</sup> See : *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

<sup>6</sup> See e.g. *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 1097 (8th Cir. 1996) ("Rather than consider the similarities between component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser...")

commercial impression than that created by the cited mark. This distinct commercial impression clearly distinguishes Applicant's Mark from the cited mark. Thus, there is no likelihood that a consumer would be confused into believing that the goods and services identified under each emanate from the same source.

Furthermore, to ascertain the manner or use and the commercial impression engendered by the term sought to be registered, one must look at the specimen of record<sup>7</sup>. Based on the specimens of record provided to the USPTO for both marks (as reproduced below), we submit that the visual impression conveyed to the consumer "somehow in rush" is very different:



The intention is not to make a side-by-side comparison of the marks, but to demonstrate that the idea and meaning conveyed by both marks clearly differ. These specimens prompt further evaluation as to the actual visual impression conveyed to the consumer. In particular, the specimen shows not only the mark itself, but the manner in which it is displayed to potential customers, and the surrounding text and images necessarily

<sup>7</sup> See *In re Wakefern Food Corp.*, 205 USPQ; *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976); *In re Restonic Corp.*, 189 USPQ 248, 249 (TTAB 1975).

contribute to the overall commercial impression. In this sense, the presence of the mark in the specimen should not be considered in isolation but, rather, as part of the overall impression conveyed by the specimen itself. Therefore, we submit that it is very unlikely that consumers be confused by both marks because of their divergent commercial impressions when viewed in their entirety. We are thus of the opinion that it reasonably precludes any likelihood of confusion in the marketplace.

Viewing the marks in their entirety, we believe that the specimens of record as well as the unique logos of both marks sufficiently distinguish Applicant's mark from the cited mark, as far as the general commercial impression is concerned.

### **C. Scope of protection of the mark REVERSO**

The cited mark REVERSO is meant to describe a quality of the related products, namely that they are reversible. This characteristic is explicitly indicated by the owner on its packaging: "Reversible Vinyl Plank" (see **Appendix A**). An Examining Attorney certainly can conclude that a mark like REVERSO is at least suggestive and recognize its narrow ambit of protection.

### **Conclusion**

In the light of the foregoing, namely:

- the differences between the applied-for mark and cited mark in appearance and commercial impression;
- the fact that the goods and fields of endeavour associated with the applied-for mark and the cited mark are different; and
- the narrow ambit of protection of the cited mark,

it is respectfully submitted that the reasonable potential for confusion in the marketplace is very unlikely between the applied-for mark REVERSE (design) (No. 87788566) and the cited mark. We therefore submit that the application is now in good form for approval, which is respectfully requested.

Respectfully submitted,

/Mihaela Dumitrean/  
BENOÎT & CÔTÉ, INC.

Date: August 21, 2018

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# Appendix A

**REVERSO**  
Planche De Vinyle Réversible  
Double Face

## REVERSO

Reversible Vinyl Plank  
Planche De Vinyle Réversible

WINDOW  
CUT-OUT

WINDOW  
CUT-OUT

**Double Sided  
Reversible Luxury  
Vinyl Plank**

**Planche De Vinyle  
Double Face  
Réversible**

- REVERSIBLE INSTALLATION
- 2 COLORS ON 1 PLANK
- CAN BE INSTALLED ON EITHER SIDE
- ABOVE OR BELOW GRADE INSTALLATION
- IDEAL FOR KITCHENS, BATHROOMS AND BASEMENTS
- CREATE YOUR OWN FLOOR PATTERN
- RESIDENTIAL AND COMMERCIAL RATING
- WATERPROOF

- INSTALLATION RÉVERSIBLE
- CHAQUE PLANCHE VOUS DONNE 2 COULEURS
- PEUT ÊTRE INSTALLÉ SUR LES DEUX CÔTÉS
- PEUT ÊTRE INSTALLÉ SUR OU SOUS LE NIVEAU
- IDÉAL POUR CUISINES, SOUS-SOL OU SALLE D'EAU
- PLUSIEURS CONFIGURATIONS D'INSTALLATION DISPONIBLES
- RÉSIDENTIELLE ET COMMERCIALE
- RÉSISTANT À L'EAU

1 PLANK / PLANCHE = 6" X 36" X 3MM  
1 BOX / BOITE = 16 PCS. = 24 SQ.FT. / P.C.



**REVERSO**  
Double Sided  
Reversible  
Luxury Vinyl Plank

## REVERSO

Double Sided  
Reversible Luxury  
Vinyl Plank

Planche De Vinyle  
Double Face  
Réversible

**INSTALLATION INSTRUCTIONS, WARRANTY AND GENERAL INFORMATION**

**DIRECTIVES D'INSTALLATION, GARANTIE ET INFORMATIONS GÉNÉRALES**

**INSTALLATION REQUIREMENTS**

**EXIGENCES RELATIVES À L'INSTALLATION**

**REQUIREMENTS**

**REQUIS**

**WOOD SUBFLOOR**

**SOUS-SOL EN BOIS**

**CONCRETE OR Gypsum BOARD**

**CONCRÈTE OU GYPSE**

**EXISTING RESILIENT FLOOR COVERING**

**COUVERTURE EN REVÊTEMENT ÉLASTIQUE EXISTANT**

**GLUE DOWN INSTALLATION**

**INSTALLATION À COLLE**

**CARE AND MAINTENANCE**

**ENTRETIEN ET RÉPARATION**

**SON ET ÉNTRAÏNEMENT**