

Response to Office Action

MARK: SLAY
SERIAL NO.: 87852352
APPLICANT: Louise Hazel Ltd.
FILING DATE: March 27, 2018
INTERNATIONAL CLASS: 025
TO: Anne C. Gustason
Examining Attorney
USPTO, Law Office 117

Dear Ms. Gustason,

Applicant, Louise Hazel Ltd. (“Applicant”) respectfully submits this Response to the Office Action issued on July 13, 2018 Office Action against Application Serial No. 87852352 for the SLAY design mark. The Examining Attorney has refused registration on the grounds of a likelihood of confusion with the SLAY standard character mark bearing Registration No. 5008221 (for Class 025 – Clothing, namely, tops, bottoms, headwear, footwear; Shirts; Men's T Shirts; Women's T Shirts; Kids T Shirts; Hooded Sweatshirts; Pullovers; Sweatshirts; Crewneck Sweatshirts; Tank Tops; Thermal Sweatshirts, fleece sweatshirts, sweatpants, hats, socks, and scarves) (“Registrant”) and the prior-filed application for the SLAY standard character mark bearing Serial No. 86215961 (for Class 009 – Downloadable software in the nature of a mobile application for locating and making reservations and bookings for beauty spas, beauty salons, barber shops, health clubs and hotels; downloadable software in the nature of a mobile application for arranging subscriptions to beauty and wellness services of others whereby users purchase credits to pay for cosmetic facial treatments, body waxing services, hair styling, manicure services, pedicure services, eyebrow threading services, men's and women's grooming services featuring haircuts, shaves, manicures, massages and face treatments, makeup application services, massages, hair cutting services and beauty consultation services) (the “Prior-Pending Application”). For the reasons set forth herein, Applicant respectfully disagrees and believes its application should be permitted registration on the Principal Registration.

I. LIKELIHOOD OF CONFUSION

1. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with the application of the factors identified in *Application of E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Under the likelihood standard, it must be probable that confusion as to source will result from the simultaneous registration of two marks; the mere possibility of confusion is insufficient. Trademark law is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969).

As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording, as demonstrated in numerous federal cases and Board proceedings. See, e.g., *IN RE HARTZ HOTEL SERVICES, INC.*, 2012 WL 1267900 (T.T.A.B. 2012) (no likelihood of confusion between GRAND HOTELS NYC and GRAND HOTEL for hotel services); *IN RE INTELISTAF HEALTHCARE MANAGEMENT, L.P.*, 2006 WL 936990 (T.T.A.B. 2006) (no likelihood of confusion between INTELLICASH for consumer debit card services and INTELECASH for business services involving debit cards); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON TEA PARTY for tea and BOSTON SEA

PARTY for restaurant services); *Omaha Nat. Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231 (D. Neb. 1986) (no likelihood of confusion between BANK IN A BILLFOLD and BANK IN A WALLET for banking credit card services); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344 (Fed. Cir. 2011) (no likelihood of confusion between CAPITAL CITY BANK and CITIGROUP for banking and financial services); *Franklin Resources, Inc. v. Franklin Credit Management Corp.*, 988 F. Supp. 322 (S.D. N.Y. 1997) (no likelihood of confusion between FRANKLIN for investment services and same mark for debt collection services); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029 (S.D. N.Y. 1990) (no likelihood of confusion between COMSTOCK for stock and commodity trade information services and same mark for money management services); *Allstate Ins. Co. v. Allstate Inv. Corp.*, 210 F. Supp. 25 (W.D. La. 1962), judgment aff'd, 328 F.2d 608 (5th Cir. 1964) (no likelihood of confusion between ALLSTATE for insurance services and same mark for mortgage brokerage services).

Indeed, as the Board has frequently held, registrations for identical marks for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion. *See, e.g., In re Itec Manufacturing, Ltd.*, 2008 WL 885926, *4–5 (T.T.A.B. 2008) (PAL for a patient-lifting medical device and PAL for lithotomy medical devices and patient support mattress pumps); *In re Hyundai Motor America*, 2009 WL 4086577 (T.T.A.B. 2009) (ECHELON for automobiles and ECHELON for automotive tires); *In re Kaemark, Inc.*, 2008 WL 5256390 (T.T.A.B. 2008) (LUXE for salon furniture and LUXE for furniture); *IN RE HAGEMEYER NORTH AMERICA, INC.*, 2007 WL 2698300 (T.T.A.B. 2007) (VERSAPRO for weed killer and VERSAPRO for garden tools); *IN RE APOLLO COLORS, INC.*, 2005 WL 1787221 (T.T.A.B. 2005) (APOLLO for color pigments in the graphic arts industry and APOLLO for dye and pigments used in the leather and textile industry).

The Examining Attorney is correct that the similarity of the marks should be considered, however, it is just one of many relevant factors to be considered here. Though Applicant acknowledges that the Mark and the Cited Mark are identical in sound, equally significant is the dissimilarity of the appearance of the marks, the dissimilarity of the nature of the services, and the dissimilarity of the trade channels used to target the respective customers.

2. The Applicant's Mark Is Visually Dissimilar From The Cited Marks and The Marks Create Distinct Commercial Impressions In Their Respective Contexts

The Applicant's Mark is dissimilar from the Cited Marks in overall commercial impression. In fact, there is no *per se* rule that confusion automatically exists between marks containing the same term. Here, a proper comparison of the marks in their entirety reveals that confusion is unlikely.

Applicant's mark is visually different from Registrant's standard character mark because of its design element. Specifically, Applicant's mark consists of a stylized version of the literal element "SLAY" which appears in a slender, modern sans serif font. As such, consumers who regularly encounter Registrant's mark will immediately recognize the visual difference between the marks, since Applicant's Mark does contain a design element, while Registrant's Mark does not. Though it may be true that consumers focus on the word portion of a mark with a design element, Applicant respectfully holds the view that the peripheral elements in Applicant's mark, when compared to the Applicant's pure word mark, create enough distance between them that consumers face little danger of being confused.

Additionally, the marks create distinct connotations in their respective contexts. In determining the commercial impression created by a mark, the mark must be viewed in its entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, in assessing the connotation presented by marks as a whole, courts must evaluate how words within a mark function together to create particular meanings. For example, in *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1408–09, 1998 WL 766704 (T.T.A.B. 1998) the Board examined the meaning implied by the marks HARD ROCK CAFÉ & Design and COUNTRY ROCK CAFÉ & Design by addressing the connotation of the word ROCK as determined by the word preceding it. The Board determined that each

mark presented an overall connotation of music, but suggested a distinct genre within the broad category of “music,” such that the respective marks created “quite different images for consumers.” *Id.* HARD ROCK CAFÉ evoked an image of a rock music restaurant, while COUNTRY ROCK CAFÉ evoked an image of a country music restaurant. *Id.*

The word “slay” has multiple definitions, dependent on the context in which the word is used. Traditionally, the word “slay” means either “to kill violently, wantonly, or in great numbers” or “to delight or amuse immensely”.¹ When used colloquially, the term “slay” may mean either “to dominate” or “to amaze, stun or otherwise incapacitate by awesomeness”.² With regard to Applicant’s mark, for athletic apparel, downloadable health and fitness applications, and fitness instruction services, the word “slay” is evocative of the strength and power of women athletes. With regard to Applicant’s mark, however, for clothing generally, the word “slay” is used to evoke a general feeling of coolness or hipness, as the word has become synonymous with current popular culture through its recently increased use.

3. The Respective Goods and/or Services Are Distinguishable

The Examiner is correct that Applicant seeks registration for “*Athletic tops and bottoms for training and sports, namely, high intensity interval training, yoga, running, dance, swimming, boxing, pilates and resistance training; Athletic footwear*” in Class 025. However, Applicant respectfully points to the fact that it also seeks registration of “*Downloadable software in the nature of a mobile application for instructing health, fitness, wellness and nutritional plans.; Downloadable software in the nature of a mobile application for subscriptions to nutritional plans, namely, for weight loss, weight gain, vegan, vegetarian, pescatarian, ketogenic and gluten free diets.; Downloadable software in the nature of a mobile application for subscriptions to health, fitness and wellness plans, namely, high intensity training, yoga, pilates, running, swimming, cycling, boxing, rehabilitation, dance and resistance training*” in Class 009 and “*Physical fitness instruction*” in Class 041. Registrant’s mark, however, is only registered for “*Clothing, namely, tops, bottoms, headwear, footwear; Shirts; Men's T Shirts; Women's T Shirts; Kids T Shirts; Hooded Sweatshirts; Pullovers; Sweatshirts; Crewneck Sweatshirts; Tank Tops; Thermal Sweatshirts, fleece sweatshirts, sweatpants, hats, socks, and scarves*” in Class 025.

As such, the goods and services offered under the respective marks are dissimilar. There is no *per se* rule that goods or services which fall into the same broad, general field are “related” for Section 2(d) purposes. *See Umc Industries, Inc. v. Umc Electronics Co.*, 207 U.S.P.Q. 861, 879, 1980 WL 30155 (T.T.A.B. 1980) (“[T]he fact that one term, such as ‘electronic’, may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.”). The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. *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); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010). TMEP §1207.01(a)(iii).

There are fundamental differences in the goods and services offered by the Applicant and the goods offered by the Registrant. The parties are not in direct competition with one another. Applicant is a former Olympian and heptathlete from the United Kingdom who targets modern health-conscious women while

¹ <https://www.merriam-webster.com/dictionary/slay>

² <https://en.wiktionary.org/wiki/slay>

Registrant, an American-based online retail company that sells and prints custom apparel, primarily targets schools, sports teams and trade shows. Applicant offers a wide range of goods and services including stylish and high-quality sports training apparel, downloadable mobile fitness applications, downloadable podcasts, and private training services, among others, while Registrant offers solely apparel. As such, if consumer was to encounter Registrant's mark, it would be a matter of seconds before he or she realized that Applicant's marks and Registrant's mark refer to different, unrelated services.

Indeed, the differences between the goods and services as recited in Applicant's application and the goods as recited in Registrant's application obviate any confusion. Even the broadest reading of Applicant's recitation of goods, makes it unlikely that consumers would confuse the two the marks. In the real-world context, consumers are accustomed to differentiating between sportswear or activewear and regular clothing. "Athletic tops and bottoms for training and sports" are often distinct from ordinary clothing because of the material out of which they are made, namely moisture-wicking fabrics. Typically, "sports fabrics are technical materials which help to keep the wearer comfortable during exercise," though the specific type of fabric required will depend upon the intensity of the exercise and the activity.³ Additionally, in the real-world context, consumers interested in purchasing activewear will visit a sportswear retailer or specialty store, either online or in person, while those interested in purchasing apparel generally will visit any clothing retailer or department store, either online or in person.

The Examiner's argument for the relatedness of Applicant's goods and Registrant's goods is that typically, the same entity commonly provides the relevant goods of Applicant and Registrant and markets them under the same mark. While the Applicant acknowledges this, Applicant does not believe this fact to be dispositive. The Examiner's attached Internet evidence further supports Applicant's position. Tops and Bottoms, Salaam Clothing, and Target, all entities to which the Examiner referred in the Office Action, indeed carries both "Athletic tops and bottoms for training and sports, namely, high intensity interval training, yoga, running, dance, swimming, boxing, pilates and resistance training; Athletic footwear," and "Clothing, namely, tops, bottoms, headwear, footwear; Shirts; Men's T Shirts; Women's T Shirts; Kids T Shirts; Hooded Sweatshirts; Pullovers; Sweatshirts; Crewneck Sweatshirts; Tank Tops; Thermal Sweatshirts, fleece sweatshirts, sweatpants, hats, socks, and scarves." However, none of those entities carry any goods or services under Registrant's or Applicant's marks. Because, as described in greater detail above, Applicant's mark is highly unlikely to cause any confusion with Registrant's Mark, particularly when examining each mark in their respective contexts, Applicant respectfully submits that the Mark is entitled to registration on the Principal Register.

4. The Channels of Trade and Conditions Under Which Sales Are Made Render Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. See also *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); See also, *In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public). Additionally, where goods or services move in different channels of trade, confusion as to source is unlikely. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between opposer's mark E.D.S. for computer services and Applicant's mark EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets).

³ [https://en.wikipedia.org/wiki/Sportswear_\(activewear\)#Moisture-wicking_fabrics](https://en.wikipedia.org/wiki/Sportswear_(activewear)#Moisture-wicking_fabrics)

Here, Applicant's goods and services and Registrant's goods are sold in entirely different trade channels, under vastly different conditions. Specifically, Registrant's goods are sold through its own website, Amazon store, and Etsy store. Conversely, Applicant's goods and services are available exclusively through its website. Additionally, as mentioned above, Applicant's goods and services and Registrant's goods will appeal to different types of consumers. Applicant's stylish, high-quality sportswear will appeal to modern female athletes and fitness enthusiasts, while Applicant's unisex t-shirts will appeal to female and male more consumers generally.

II. PRIOR-PENDING APPLICATION

The Office has also advised Applicant of a prior-pending application, which would pose a likelihood of confusion if it were to register. The prior-pending mark is Serial No. 86215961, for the standard word mark SLAY. Applicant's stylized mark is distinct from the prior-filed application for the standard word mark SLAY in many of the same ways as enumerated above. Most notably, the marks are being sought for different goods and services.

The prior-filed application specifies "*Downloadable software in the nature of a mobile application for finding, booking and coordinating beauty services at spas, salons, barber shops, health clubs and hotels.; Downloadable software in the nature of a mobile application for subscriptions to beauty and wellness services, namely, facials, waxing, hair styling, manicure services, pedicure services, eyebrow threading, grooming, makeup application, massages, hair cut services and beauty-consultation services.*" in Class 009.

As mentioned above, Applicant's mark is being sought for "*Athletic tops and bottoms for training and sports, namely, high intensity interval training, yoga, running, dance, swimming, boxing, pilates and resistance training; Athletic footwear*" in Class 025, "*Downloadable software in the nature of a mobile application for instructing health, fitness, wellness and nutritional plans.; Downloadable software in the nature of a mobile application for subscriptions to nutritional plans, namely, for weight loss, weight gain, vegan, vegetarian, pescatarian, ketogenic and gluten free diets.; Downloadable software in the nature of a mobile application for subscriptions to health, fitness and wellness plans, namely, high intensity training, yoga, pilates, running, swimming, cycling, boxing, rehabilitation, dance and resistance training*" in Class 009, and "*Physical fitness instruction*" in Class 041. Registrant's mark, however, is only registered for "*Clothing, namely, tops, bottoms, headwear, footwear; Shirts; Men's T Shirts; Women's T Shirts; Kids T Shirts; Hooded Sweatshirts; Pullovers; Sweatshirts; Crewneck Sweatshirts; Tank Tops; Thermal Sweatshirts, fleece sweatshirts, sweatpants, hats, socks, and scarves*" in Class 025.

Additionally, the parties are not in direct competition with one another. Prior-filed Applicant is a Delaware LLC with its principle place of business in Miami. Indeed, the website associated with the prior-filed mark specifically states "We've partnered with *Miami's* best salons and provided them with an extra source of revenue to promote their growth".⁴ As such, if consumer was to encounter Registrant's mark, it would be a matter of seconds before he or she realized that Applicant's marks and Registrant's mark refer to different, unrelated services. Respectfully, Applicant believes that there would be little likelihood of confusion between the two marks should the SLAY (Serial No. 86215961) registration be granted.

III. CONCLUSION

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

⁴ <https://www.slaybeautypass.com/about/>

Respectfully submitted,

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