

Applicant REGISMARK, S. DE R.L. DE C.V. seeks registration of the trademark



for “On-line retail store services featuring uniforms, clothing, headwear, business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses, footwear, chef’s coats, chef’s hats, work shoes and boots; Retail clothing boutiques; Retail clothing stores; Retail stores featuring uniforms, headwear, business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses, footwear, chef’s coats, chef’s hats, work shoes and boots” (“Applicant’s Mark”). The examining attorney has issued a refusal to register the mark under Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq., because of likelihood of confusion with the registered mark **COTAIL** for “Hats; Pants; T-shirts” (“the Cited Mark”). Applicant respectfully disagrees for the reasons discussed herein.

NO LIKELIHOOD OF CONFUSION BASED SOLELY ON THE DIFFERENCES IN
THE TRADEMARKS

In determining likelihood of confusion, evidence relating to the thirteen factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973) must be considered. Not every DuPont factor need be considered. *Han Beauty, Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). Rather, only those factors that are most relevant to a

particular case and any one of the factors may be controlling. *In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); see also, *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973) (“[E]ach [of the thirteen factors] may from case to case play a dominant role”).

The Federal Circuit and the Board have consistently held that one DuPont factor may be dispositive in the likelihood-of-confusion analysis, especially when that single factor is the dissimilarity of the marks. See *Champagne Louis Roederer S.A. v. Delicato Vinyards*, 47 USPQ2d 1459, 1461 (Fed. Cir. 1998) (sustaining the Board’s holding of no likelihood of confusion between CRYSTAL CREEK for wine and CRISTAL for champagne based on dissimilarities between marks); *Kellogg Co. v. Pack’em Enterprises*, 951 F.2d 330, 332-33 (Fed. Cir. 1991) (affirming the Board’s holding of no likelihood of confusion between the marks FROOT LOOPS and FROOTIE ICE and elephant design based on the differences between the marks alone); *Keebler Co. v. Murray Bakery Prods.*, 9 USPQ2d 1736, 1739-40 (Fed. Cir. 1989) (sustaining finding of no likelihood of confusion between PECAN SANDIES and PECAN SHORTIES marks based only on dissimilarity-of-marks factor). Here, the differences between Applicant’s Mark and the Cited Mark, in overall appearance, sound, connotation, and commercial impression, compel a finding of no likelihood of confusion.

In determining the similarity or dissimilarity of two marks, the marks must be compared in their entireties and a likelihood of confusion “cannot be predicated on dissection of a mark, that is, on only part of the mark.” *In*

re Nat'l Data Corp., 224 USPQ 749, 750-51 (Fed. Cir. 1985); *Franklin Mint Corp. v. Master Mfg. Co.*, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”); and *Castle & Cooke, Inc. v. Oulevay, S. A.*, 152 USPQ 115 (CCPA 1967) (FARENDOLE not confusingly similar to DOLE for related food products because DOLE is “so merged into [FARANDOLE] that it loses its individual identity therein”)(emphasis added). Although the letters “COTAIL” are contained in both Applicant’s Mark and the Cited Mark, it is so integrated



into Applicant’s Mark that it loses its individual identity therein. See also *J. P. Stevens & Co. Inc. v. Farbenfabriken Bayer Aktiengesellschaft*, 124 USPQ 432, 433 (TTAB 1960) (RAMA not confusingly similar to CUPRAMA). *In re Masco Corporation of Indiana*, 2007 TTAB LEXIS 596, *10 (TTAB May 24, 2007) (TREVI not confusingly similar to TREVISO; TREVI formed only an “incidental” part of TREVISO mark as a whole and TREVI was so integrated into TREVISO as to create a distinct commercial impression).

The examining attorney’s arguments and the cases cited in support are inapposite. This is not a case where the first words of each mark are the same, as the holdings in *Palm Bay* and *Detroit Athletics* require. Applicant’s Mark contains the word “tailor” which consumers would

immediately recognize, given its relevance to apparel (this is true even though COTAILOR is a coined word with no meaning). On the other hand, the Cited Mark suggests “coat tail”, given its pronunciation and appearance. In any event, it certainly does not suggest the word “tailor”. Finally, Applicant’s Mark contains the word “GROUP”, and a design, further distinguishing it from the Cited Mark. The difference in the overall commercial impressions of these two marks obviates any possibility for confusion, much less a likelihood of confusion. *See In re Product Innovations Research LLC* Serial No. 77912065 (January 22, 2014) (“Accordingly, we find that the marks have differences in connotation and are different in overall commercial impression. Moreover, we find this factor to be pivotal in that even considering the other du Pont factors, this factor of the dissimilarities of the marks outweighs the other factors”). *See also Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“As has often been said, each case must be determined on the particular facts. Under the facts of this case, because of the very different commercial impressions due to the different secondary meanings in each mark resulting, in part, due to the differences in the respective goods, we find that confusion is not likely”).

For the reasons stated herein, applicant respectfully requests that the examining attorney reverse the refusal to register applicant’s mark under Section 2(d) and pass the mark to publication in due course.