

Applicant Thomas Kent York seeks registration of the trademark

JUNIOR

for “hair brushes” (“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 trademark **DISNEY JUNIOR** for “hair brushes” (the “Cited Mark”). Applicant respectfully disagrees that registration of its mark should be denied for the reasons discussed herein.

Likelihood of Confusion

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).

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (emphasis added). Here, the significant differences between the respective marks in overall appearance, sound, connotation, and commercial impression compel a finding of no likelihood of confusion.

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”). Applicant respectfully submits that the examining attorney placed undue emphasis on the single point of similarity between the two marks, namely, the shared word “JUNIOR”, that, in the context of the Cited Mark, is a merely descriptive term that describes a line of Disney licensed products intended for very young children (i.e. “juniors”). See **Exhibit A**, the specimen of record for the Cited Mark. The dominant portion of the Cited Mark is thus, not “JUNIOR”, but “DISNEY”. Applicant’s

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Mark does not convey the meaning of “young children”, as it does in the Cited Mark. It is an arbitrary design mark for goods that are not designed or intended for use by children alone (as the specimen of record makes clear). Thus, the marks have distinctly different commercial impressions. This difference in the overall commercial impression 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”).

Furthermore, similarity must be determined in light of the strength or weakness of the portions of the marks that are similar. If a registered mark, or a portion thereof, is inherently weak, it will be limited to a more narrow scope of protection. *Trans World International, Inc. v. American Strongman Corporation*, Cancellation No. 92050860 (May 8, 2012) (“when a mark, *or a portion of a mark*, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use the descriptive term”) (emphasis added); *Sure-Fit Prods. Co. v. Saltzon Drapery Co.*, 254 F. 2d 158, 117 USPQ 295, 296 (CCPA 1958) (“Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”). Where a mark or portion thereof is weak, a consumer will look to other source-identifying features of the mark to differentiate them. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (“[T]he mere presence of a common, highly suggestive portion [of a mark] is usually insufficient to support a finding of likelihood of confusion”). “JUNIOR” in the Cited Mark is simply too weak to be given the scope of protection afforded it by the examining attorney. *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (applicant was allowed to register the mark NORTON MCNAUGHTON ESSENTIALS in the face of an opposition filed by the owner of

the mark ESSENTIALS for, in part, identical items of clothing. The Board found that the registered mark (i.e., the shared term) was “highly suggestive as applied to the parties’ [clothing]” and that applicant’s addition of its house mark sufficed to distinguish the marks. Id. at 1315).

Conclusion

For the reasons stated herein, Applicant respectfully requests that the examining attorney withdraw the refusal to register under Section 2(d) and approve Applicant’s Mark for publication in due course.