

Mark is not Geographically Descriptive

The Office Action refuses registration of application 88/144,752 for the mark "Hollywood Vanity Mirrors" (hereinafter "the '752 registration") on the basis of being geographically descriptive under Trademark Act Section 2(e)(2), 15 U.S.C. 1052(e)(2). Applicant respectfully disagrees.

The geographic proximity of the city of Hollywood to Applicant's physical location in the city of Torrance is merely coincidental, and has no bearing on where the goods are actually sold. Moreover, usage of the word "Hollywood" in the applied-for mark is not indicative as to the source of goods or the exclusive location where the goods are sold.

The *Merriam Webster Online Dictionary* defines "Hollywood" as "the American motion-picture industry" and further describes "Hollywood" as an adjective for "of or characteristic of people in the American motion-picture industry" and "of or characteristic of a Hollywood film." Hollywood, *Merriam Webster Online Dictionary*, <https://www.merriam-webster.com/dictionary/Hollywood> (last retrieved Feb. 7, 2019) (attached as evidence). Applicant's use of "Hollywood" and the significance of the word within the overall mark "Hollywood Vanity Mirrors" is consistent with these definitions. In particular, Applicant sells beauty products (e.g., vanity mirrors), and therefore the primary significance of "Hollywood" within the mark, is not geographic, but is used to convey a status of celebrity, glamour, fashion, etc. consistent with the film and entertainment industry (i.e., the primary definition of "Hollywood"). This use and significance are further consistent with established precedent. See *In re International Taste, Inc.*, 53 U.S.P.Q.2D 1604, at 1605 (TTAB 2000) (finding "significant meaning of the term 'Hollywood' as referring to the entertainment industry").

Examining Attorney cites to *In re Hollywood Lawyers Online*, 110 USPQ2D 1852 (TTAB 2014), which interpreted *In re International Taste* to reject a trademark registration for its geographic significance. However, unlike the Applicant in *Hollywood Lawyers*, the '752 registration "increase[s] the commercial impression of the term as connoting the entertainment industry" by combining the Hollywood term with "Vanity" and also "Mirrors". *In re International Taste*, at 1857 (internal citations omitted). Per *Hollywood Lawyers*, "[g]eographic descriptiveness . . . 'must be evaluated in relation to the particular goods for which registration is sought. . ..'" *Hollywood Lawyers* at 1856 (citing *In re Chamber of Commerce of the U.S.A.*, 675 F.3d 1297 (Fed. Cir. 2012)). The '752 registration does not refer to a product one would expect to see exclusively in the geographic region of Hollywood, California. See *Hollywood Lawyers*, at 1857.

Moreover, Applicant submits that the goods do not originate in the same geographic area. Hollywood, California is not the same geographic area as Tustin, California. Examining Attorney correctly notes the distance between the cities of Tustin and Hollywood, but these are, in fact, entirely different cities and it is not common parlance to indicate one is from Hollywood, California when one is from Tustin, California. Similarly, it is not common parlance for every California resident, Los Angeles County resident, Beverly Hills resident, or other resident in neighboring cities to indicate they are from Hollywood.

Examining Attorney cites to *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (PTAB 2007), which rejected a trademark registration for a beer based on its geographic proximity to Yosemite National Park. However, the PTAB noted that "[a]pplicant's business is located in a city whose economy, and largely its identity, center around its association with Yosemite National Park. . . ." *Id.* at 1621. Examining Attorney

has failed to show significant economic nexus between Hollywood, CA and Tustin, CA, and merely relies on distance between the two locations.

As such, there is no basis by which to conclude that Applicant's use of the mark "Hollywood Vanity Mirror" from the city of Tustin would have geographic significance. Applicant submits that the '752 registration is not geographically descriptive.

Likelihood of Confusion

The Office Action identifies a potential likelihood of confusion with co-pending application 87/918,471 (hereinafter "the '471 application") for the stylized logo of "Hollywood Mirrors". Applicant does not believe there is a likelihood of confusion between Applicant's mark and the mark of the '471 application. Applicant preemptively addresses the issue of the potential conflict with the following arguments.

DuPont Likelihood of Confusion Factors

In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563 at 567 (CCPA 1973) sets forth the factors that are relevant to a determination of likelihood of confusion. Some of these factors are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
2. The number and nature of similar marks in use on similar goods.
3. The nature and extent of any actual confusion.
4. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.

It is recognized that not all thirteen DuPont factors are weighed the same in a likelihood of confusion analysis, the most relevant factors must be considered in the present case to make an accurate and correct final determination. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 224 (CCPA 1976); *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

No Likelihood of Confusion Because of Their Appearance, Sound, Meaning, and Commercial Impression

The marks have several significant visual differences. The '471 application is a stylized logo that uses a specialized font to display the lettering "Hollywood Mirror" in a similar manner as the famous Hollywood sign in the city of Hollywood, California. For instance, the lettering of the '471 application is suspended over rocks or hills with ladder-like extensions. Moreover, the words "Hollywood" and "Mirror" are on different lines, and skulls are placed on either side of the word "Mirror" in the second line. The creates an entirely different visual appearance than Applicant's standard character mark where all three words of "Hollywood Vanity Mirrors" are in a single line.

Applicant's mark also includes the word "Vanity" which is omitted from the '471 application. The word "Vanity" is placed in between the words "Hollywood" and "Mirrors" to break the visual flow and compound construction of the mark from the '471 application.

Furthermore, the '471 application uses the singular word "Mirror" whereas Applicant's mark uses the plural word "Mirrors".

These differences also collectively produce a different commercial appearance. Applicant further notes that the Examiner cannot merely look at the common elements between the marks, but must consider the entirety of each mark when conducting the comparison. See *Massey Junior College Inc. v. Fashion Institute of Technology*, 492 F. 2d 1399, 1402 (stating that "marks must be considered in their entireties in determining whether there is a likelihood of confusion"); See also *General Mills, Inc. v. Kellogg Co.*, 824 F. 2d 622 (stating that "in analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall commercial impression created by the marks and not merely compare individual features"); *In re National Data Corp.*, 753 F. 2d 1056 (stating that "likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark").

In considering the marks as a whole, there are only two common elements (e.g., the words "Hollywood" and "Mirror" versus "Mirrors"), and at least five significant visual differences including 1) omission of the word "Vanity" from the '471 application, 2) wording on separate lines in the '471 application versus the single line wording of Applicant's mark, 3) rock, hill, and skull imagery in the '471 application versus no imagery, 4) stylized font and lettering raised on ladders of the '471 application versus Applicant's standard character mark, and 5) "Mirror" in the '471 application versus "Mirrors" in Applicant's mark). In other words, there are significantly more visual differences than visual similarities between the marks. A side-by-side comparison of the two marks would not lead an ordinary consumer to conclude that there is association between the marks, let alone create a likelihood of confusion. Moreover, the middle placement of the word "Vanity" also causes Applicant's mark to have a different sound than the mark of the '471 application.

No Likelihood of Confusion Because of the Number and Nature of Similar Marks in use on Similar Goods

The number and nature of similar marks in use on similar goods further evidences that there would be no likelihood for confusion should the '471 application and Applicant's application register. Both applications are directed to goods and services in class 20. However, there are at least 15 live registrations in the same class (i.e., class 20) for two or three word compound marks starting with the word "Hollywood" (e.g., registration numbers: 5,506,788; 5,452,880; 5,452,056; 5,452,055; 5,452,054; 5,452,052; 5,452,041; 4,981,930; 4,778,034; 4,622,736; 4,004,749; 4,362,572; 3,705,086; 3,647,135; 2,484,632).

Moreover, Applicant (e.g., Impressions Vanity Company) has prior registered use of several different compound marks that begin with "Hollywood" in class 20, such that other compound marks, including the applied- for mark of "Hollywood Vanity Mirrors", would be associated with the Applicant in the minds of the ordinary consumer. For instance, Applicant has/owns registration 5,452,880 for "Hollywood Reveal", registration 5,452,056 for "Hollywood Reflection", registration 5,452,055 for "Hollywood Studio", registration 5,452,054 for "Hollywood Glamour", registration 5,452,052 for "Hollywood Glow", and registration 5,452,041 for "Hollywood Iconic". Accordingly, an ordinary consumer, seeing the mark "Hollywood Vanity Mirrors" for goods in the same class of goods (i.e., class 20) as these registrations, would associate this mark with the same owner (i.e., the Applicant) and not another (e.g., Applicant of the '471 application).

No Likelihood of Confusion Because of the Lack of Actual Confusion and Length of Time During Which There Has Been Concurrent Use Without Evidence of Actual Confusion

Applicant began actual, public, and first use of the mark "Hollywood Vanity Mirrors" back on November 2014 as evidenced on the record. The '471 application claims first use of their respective mark back on February 2014. Accordingly, over four years of concurrent use has gone by, and there has been no indicia of confusion. This serves as strong evidence that there is no potential or likelihood of any present or future confusion.

Thus, in consideration of the foregoing, Applicant requests registration of the applied-for mark.