

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK LAW OFFICE 115  
SERIAL NUMBER 88171880

MARK:  
**FOTOMAT**

**RESPONSE TO OFFICE ACTION**

**TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS:**

IN RESPONSE TO THE ABOVE-REFERENCED OFFICE ACTION, the Applicant hereby submits the following.

In the Office Action of February 5, 2019, the Examining Attorney stated that the application for FOTOMAT (hereafter the “Application”) may ultimately be refused registration under Trademark Act section 2(d) because of a likelihood of confusion with Registration No. 5116090 for PHOTOMATIC (hereafter “Prior Mark”).

The Applicant respectfully disagrees, and hereby responds as follows.

**Response to Section 2(d) Likelihood of Confusion:**

**Explanation of the *DuPont* Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely**

The test for likelihood of confusion is whether a “reasonably prudent consumer” in the marketplace is likely to be confused as to the origin of the goods or services bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A 1973). Consequently, the Federal Circuit Court of Appeals adopted multiple factors for the purpose of deciding likelihood of confusion on a case-by-case basis, otherwise known as the *DuPont* factors.

## **Application of the *DuPont* Factors**

Applying the *DuPont* factors to the instant case, Applicant hereby submits the following arguments in support of its argument that there would be no likelihood of confusion between the Application and the Prior Mark.

### **1) Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation, and Commercial Impression (The Sight, Sound, and Meaning Analysis)**

In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their *appearance, sound, connotation, and commercial impression*. TMEP §§1207.01, 1207.01(b) (emphasis added). The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing).

Even though marks may be similar in appearance when they share "similar terms or phrases," the Trademark Trial and Appeal Board (the "Board") has consistently held that confusion is not likely if the marks in their entireties convey significantly different commercial impressions, or the matter common to the marks is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive or diluted. *See, e.g. Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). The Board has stated that similarity as to one aspect of the sight, sound, and meaning trilogy will *not* automatically result in a finding of likelihood of confusion when the goods are identical or closely related. 4 McCarthy on

Trademarks and Unfair Competition § 23:21 (4th ed.) (emphasis added).

Looking at the commercial impression of the respective marks, it is clear to the average consumer that the respective marks are from more than one source based upon their appearance. Specifically, both the Applicant and the Prior Owner present their respective marks using distinct logos or fonts, each connoting a particular and distinct commercial impression.

<b>Application</b>	<b>Prior Mark</b>
FOTOMAT	PHOTOMATIC

Here, Applicant's word mark is for FOTOMAT, whereas the Prior Mark is for PHOTOMATIC. Each respective mark contains a unique spelling that immediately makes each mark visually distinctive.

Furthermore, splitting a mark into its various components and comparing only certain portions of one mark with another mark is improper. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (C.C.P.A. 1974); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) (holding that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely). Here it is highly inappropriate to compare Applicant's mark to the Prior Mark merely upon a small phonetic similarity. The anti-dissection rule requires that Applicant's mark for FOTOMAT, be considered in its entirety.

This creates a significant commercial impression upon the consumer in that from merely seeing either of the above marks, they know that they are viewing and purchasing services made by the respective owner.

It is well established that merely because two marks contain a similar term that there is not a likelihood of confusion. In fact, there is no rule that confusion automatically exists between marks containing the same term. *See Application of Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) (no confusion between TIC TAC and TIC TAC TOE both for impulse foods); *see also White Rock Distilleries, Inc. v. Franciscan Vineyards, Inc.*, 2009 WL 498673 (N.D. Cal. 2009) (unpublished) (Board reversed Examining Attorney and found no likelihood of confusion between VOLTA for vodka and TERZA VOLTA for wine).

In *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970), the Court of Customs and Patent Appeals affirmed the Board's decision that there was no likelihood of confusion between PEAK and PEAK PERIOD for personal care products. Likewise, in *IN RE JOHNSON & JOHNSON*, 2002 WL 649081 (T.T.A.B. 2002), the Board reversed the Examining Attorney's refusal to register the mark EPIC MICROVISION for a medical device, despite the existence of a prior registration for the mark EPIC also for a medical device. The present case is analogous. Here, consumers will discern the differences between the Prior Mark and Applicant's mark because of the respective marks' unique wording.

Moreover, the Prior Mark contains more syllables than the Application, with significant differences in commercial impression resulting. As such, the cited Prior Mark conveys a different commercial impression when compared to the Applicant's mark.

“Similarity is not limited to the eye or ear. The mental impact of a similarity in meaning may be so pervasive as to outweigh any visual or phonetic differences. That is, the ‘psychological imagery evoked by the respective marks’ may overpower the respective similarities or differences in appearance and sound.” 4 McCarthy on Trademarks and Unfair Competition § 23:26 (4th ed.).

Any similarities as to appearance or sound between the respective marks, if any, are overpowered and obviated by the differences in the meaning between the respective marks, as well as the overall commercial impression and presentation of the marks in commerce.

The Applicant and the Prior Owner present, use, and advertise their respective marks in unique ways. Upon viewing Applicant's goods, the difference in commercial impression is immediately apparent.

## **2) Similarity as to Nature of the Goods or Services**

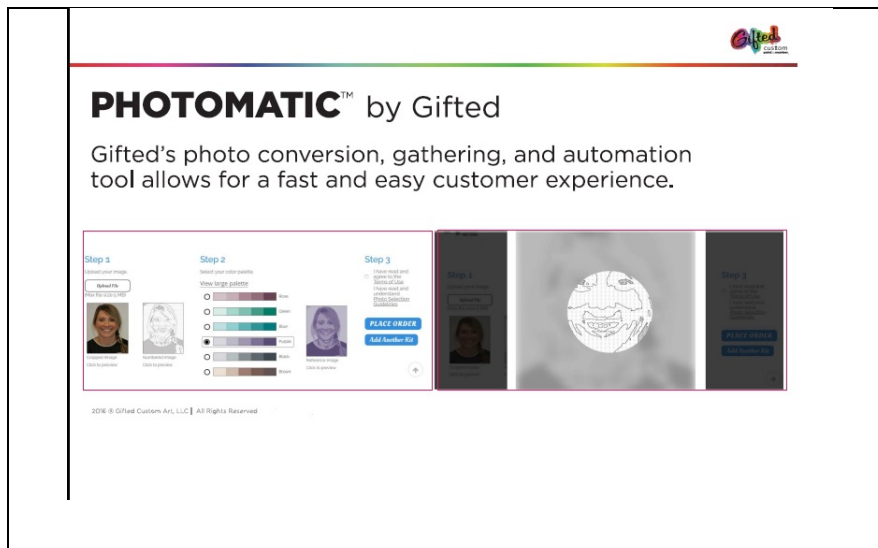
Where the goods and services are directly competitive, the degree of similarity required to prove a likelihood of confusion is less than in the case of dissimilar products. 4 McCarthy on Trademarks and Unfair Competition § 23:20.50 (4th ed.); *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 77 U.S.P.Q.2d 1641 (1st Cir. 2006). Here, there is no evidence that the Prior Marks and the Applicant's mark are competing or being confused with one another.

Applicant is seeking to register the trademark FOTOMAT. It is Applicant's contention that there is such an overwhelming dissimilarity between the marks in terms of appearance,

sound, and commercial impression that the goods on which they are respectively used are not likely to result in confusion.

Here, Applicant has accepted the Examining Attorney’s suggested identification of goods and services, and seeks registration for “Computer services, namely, electronic digitizing of photographic images via the Internet; Providing a web site for the electronic storage of digital photographs; Providing a web site featuring technology that enables users to host, share and archive digitized photographic images of consumers; Peer-to- peer photo sharing services, namely, providing a website featuring technology enabling users to upload, view, and download digital photos for consumer photo sharing; providing a website featuring technology enabling consumers to upload, view, and download digitized photographic images; Computer services, providing consumers a web site featuring technology that enables consumers to share, bookmark, index, store, collect digitized photographic images, and collect electronic imaging of photographs to be used on photographic products such as calendars and other photographic image products with resources from digitized photographic image form in the nature and field of consumer digitized photographic images ” in International Class 042. The Prior Mark is for a service that allows a consumer to print their photos onto canvases. While both marks are used more broadly for photographic goods and services, respectfully, this is not enough to establish that the goods are in fact similar.

Specifically, attached as Exhibit A, please find a screenshot of the Prior Owner’s goods as they appear in commerce. The picture from Exhibits A is included below:



Here, the question is whether a consumer, in commerce will confuse the source of above goods with the Applicant or vice versa. Given the strong differences in the overall presentation and commercial impression of the respective marks, this question must be answered in the negative. Consumers will not confuse a peer-to-peer photo sharing service (like that of the Applicant) with a service that prints photos onto canvases (like the Prior Owner).

The Application, through its accompanying identification of goods and services amendment, does not cover canvases (or printing thereon), and as such is unlikely to cause confusion.

### **3) Conditions Under Which and Buyers to Whom Sales are Made**

Here, the buyers of the respective goods and services will be a sophisticated. In other words, consumers making purchases of services from either the Applicant or the Prior Owner are well educated, and not likely to make such purchases on impulse.

As such, the services offered by the Applicant and Prior Owner are aimed at discriminating purchasers. “Where the relevant buyer class is composed of professional or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers...they (the professional purchasers) are usually knowledgeable enough to be less likely to be confused by trademarks that are similar. For example, the First Circuit found no infringement in the case of ASTRA local anesthetic preparation versus ASTRA computerized blood analyzer machine. The ‘most critical factor’ was said to be the sophistication of the buyers of the products.” 4 McCarthy on Trademarks and Unfair Competition § 23:101 (4th ed.); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786 (1st Cir. 1983).

The Prior Owner and Applicant deal in respective goods and services that can be extremely expensive. If the goods or services are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation. 4 McCarthy on Trademarks and Unfair Competition § 23:95 (4th ed.); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 U.S.P.Q. 81, 92 (2d Cir. 1979).

#### **4) The Fame of the Prior Mark**

All trademarks are not equal. Some are strong, some are weak and most are somewhere in between. “Strong” marks are given “strong” protection—protection over a wide range of related products and services and variations on visual and aural format. 'The stronger the mark, the more likely it is that encroachment on it will produce confusion.' Conversely, relatively weak marks are given a relatively narrow range of protection both as to products and format variations. 2 McCarthy on Trademarks and Unfair Competition § 11:73 (4th ed.). Likewise, here, there is no evidence that the cited Prior Mark is famous or has acquired secondary meaning within the marketplace or that consumers associate the term PHOTOMATIC or FOTOMAT with the Prior Owner. To the contrary, and as explained below, there are other similar marks containing for use with photography-related goods and services.

#### **5) The Nature and Extent of Any Actual Confusion**

There has been no documented evidence that shows that any consumers have confused the respective marks in commerce. There have been no demonstrated events of confusion by consumers between the respective marks.

Courts have long held that concurrent use of such marks without instances of actual confusion is evidence of no confusion. 4 McCarthy on Trademarks and Unfair Competition § 23:18 (4th ed.); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490, 212 U.S.P.Q. 246 (1st Cir. 1981) (“[W]hen the marks have been in the same market, side by side, for a substantial period of time, there is a strong presumption that there is little likelihood of confusion.”); *Greentree Laboratories, Inc. v. G.G. Bean, Inc.*, 718 F. Supp. 998, 13 U.S.P.Q.2d 1161 (D. Me. 1989) (concurrent use for five years without confusion where plaintiff's mark is weak creates a presumption that confusion is unlikely; judgment of no infringement); *Aktiebolaget Electrolux v. Armatron Intern., Inc.*, 999 F.2d 1, 4, 27 U.S.P.Q.2d 1460 (1st Cir. 1993) (“[A]n absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that little likelihood of confusion exists.”).

## 6) The Number and Nature of Similar Marks in Use on Similar Goods

Other marks besides those belonging to the Applicant and Prior Owner have used similar marks for photography-related goods and services. As a result of such registrations continued co-existence, it cannot be said that Applicant's mark will create a likelihood of confusion. Please *see* Exhibit B that contains a list of numerous such marks.

<b>Trademark</b>	<b>Registration</b>	<b>Goods/Services</b>
PHOTOCOPIC	5571851	Photographic and video services
PHOTOMANIA	4562132	Computer graphics services
FOTOMATIC	3594647	Computer software for viewing and downloading photographs
PHOMAX	4252550	Photograph projectors
"PICTURE THIS" PHOTO MATS	314850	Photograph framing

If these marks as well, as the Prior Mark, are able to co-exist with so many other similar trademarks for analogously similar services, then it can also be said that there is room for Applicant's mark for FOTOMAT. Applicant submits that such extensive use of said words in this manner by third parties for similar goods or services entitles Applicant to a reduced scope of trademark protection, which weighs against a finding of likelihood of confusion.

### **Conclusion**

Consequently, taking the respective marks in their totality pursuant to the Anti-Dissection Rule, consumers would likely be able to differentiate between the respective marks because of the differences in goods and services, difference in appearance, as well as their overall commercial impression. Additionally, consumers of the owners' respective products are sophisticated and likely to exercise great care in purchasing their respective goods and services, and there has been no evidence of any actual confusion.

Therefore, the Applicant respectfully requests that the Examining Attorney allow Applicant's application for the mark FOTOMAT to proceed to publication. If for some reason the Examiner continues to believe that the present application is not in condition for publication, the Examiner is respectfully requested to call Applicant's attorney at (561) 295-7325 to discuss



any possible amendments of the like which places the case in condition for publication, or arrange an Examiner's amendment to put the case in condition for publication.

Thank you for your consideration.

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