

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Elliott Aviation, Inc.

Serial No.: 88059360

Filed: July 31, 2018

Mark: PRIZM

TRADEMARK ACT REFUSAL RESPONSE

On November 20, 2018, the Examining Attorney mailed a refusal notice for the above applied-for mark for a likelihood of confusion with the marks in U.S. Registration No. 1859613 (PRISM for use with electric light bulbs) and U.S. Registration No. 4843454 (PRISMA and design for use in Class 11 with light fittings).

I. No Likelihood of Confusion

The Lanham Act 2(d) prevents registration of a mark on the principal and supplemental register that is likely to be confused or mistaken or deceived, by potential consumers, as to the source of the goods of the applicant and the registrant. 15 U.S.C 1052(d). Applicant argues that the applied-for-mark, PRIZM, will not likely confuse consumers as to the origin of the goods in the application, specifically, as amended, lighting, namely electronically controllable LED lighting systems for aircraft cabins comprised of LED modules, LED lighting fixtures, electronic controls, and wiring.

There is no likelihood a potential consumer will be confused, mistaken or deceived between the Applicant's mark and the cited marks as to the source of the goods offered in commerce. Federal courts and the Board have consistently held that a likelihood of confusion exists between two marks only if a reasonably prudent purchaser is likely to be confused as to the source or sponsorship of the services. See *In re E.I. du Pont de Nemours & Co*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Thirteen principal factors are to be considered in a likelihood of confusion analysis; 1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impressions, 2) the similarity or dissimilarity of and the nature of goods described in an application or registration in connection with which a prior mark is in use, 3) the similarity or dissimilarity of established, likely to continue trade channels, 4) the conditions under which potential consumers purchase – impulse versus careful sophisticated purchasing, 5) the fame of the prior mark, 6) the number and nature of similar marks in use on

similar goods, 7) the nature and extent of actual confusion, 8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, 9) the variety of goods on which the mark is or is not used, 10) the market interface between the applicant and the owner of the prior mark, 11) the extent to which application has a right to exclude others from use of its mark on its goods, 12) the extent of possible confusion – de minimus or substantial, and 13) and other established fact probative to the effect of use.

The Examining Attorney rejected Applicant's mark based on the similarity of the marks and the similarity of the goods. In addition to the DuPont factors examined by the Examining Attorney, the channels of trade, the sophistication of the consumer, and the number and nature of similar marks in use on similar goods are also applicable in this case. The Applicant will demonstrate how the consumer will differentiate the current mark from each of the cited marks. Analysis of the applicable factors illustrates that there is no likelihood of confusion between Applicant's applied for mark and the cited marks.

a. Similarity of the Marks

I. PRISM (U.S. Registration No. 1859613)

Although the marks are similar in sound, they are different in appearance. The cited mark uses an "S" and the Applicant's mark uses a "Z."

In determining whether a mark will give rise to a likelihood of confusion an examining attorney should note that the fundamental issue is not whether a court, an Examining Attorney, or a lawyer finds confusion between two marks, but whether the relevant buyers would be confused. *Daddys Junky Music v. Big Daddy Family Music*, 109 F.3d 275, 42 U.S.P.Q. 1173 (6th Cir. 1997). As observed by the Eighth Circuit in *Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc.*, 815 F.2d 500, 504 (8th Cir. 1987):

[V]isual inspections by the court are permissible as an aid in determining likely confusion. However, caution should be exercised to avoid putting too much stock in subjective inspection done in-chambers that is devoid of market characteristics. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do.

Applicant respectfully disagrees that the difference in the letters in the marks does not obviate the likelihood of confusion in the present case. Marks must be considered on a case-by-

case basis. Applicant believes that the Examiner fails to give adequate weight to the differences in the marks. In evaluating the similarity or dissimilarity of the marks, a particular feature or portion may be accorded more weight if it makes a memorable impression that consumers will remember and rely upon to identify the services at issue. In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987); In re Apparel Ventures, Inc. 229 USPQ 225, 226 (TTAB 1986). In this situation, much like the situation in Redneck Racegirl, the marks are likely to be encountered visually. See In re Covalinski, 113 USPQ2d 1166 (TTAB 2014). This suggests that visual differences between the marks should be given the greatest weight. And because there are visual differences, this DuPont factor supports the Applicant.

II. PRISMA (U.S. Registration No. 4843454)

Much like above with PRISM, the Applicant's mark and PRISMA are different visually. Here, two of the letters of a 5/6 letter mark are different. The rest of the analysis is the same as above. Therefore, this DuPont factor supports the Applicant.

b. Differences in the Goods

The second DuPont factor cited by the Examiner concerns the similarity or dissimilarity and nature of the goods or services. The Examiner states that "consumers familiar with the registrants' goods will also expect applicant's goods to be provided by the registrants." To support this contention, the Office Action includes the names of companies that appear to sell both the goods associated with the cited marks and the goods associated with the Applicant's applied for mark.

However, the companies cited in the Office Action do not provide the same goods as the goods provided by the owners of the cited marks. Thus, the Office Action is comparing apples to oranges. The companies cited in the Office Action provide lighting for airline cabins, i.e. they are similar to the Applicant. They do not provide lighting to the general public such as Halco, the owner of the 1859613 mark, and Performance in Lighting, the owner of the 4843454 mark. Both of these companies only sell lighting to the general public. See <https://www.halcolighting.com/index.jsp?path=aboutus> and <https://www.performanceinlighting.com/us/us/company> (last visited March 4, 2019; Exhibit A). Certainly if a consumer tried to replace the light above their seat the next time they are on a flight with the light from their kitchen, they will likely not be successful. In fact, they'll likely

be in jail. This is because aircraft lights are specifically dealt with as part of the U.S. code, see <https://www.law.cornell.edu/cfr/text/14/91.209> (last visited March 4, 2019; Exhibit A).

Further, the following bullet-point list contains trademarks similar to this case where no likelihood of confusion existed even between the same or highly related goods:

- “LEAN CUISINE” and “LEAN LIVING” *Stouffer Corp. v. Health Valley Natural Foods*, 1 USPQ2d 1900 (TTAB 1987);
- “PECAN SHORTIES” and “PECAN SANDIES” *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 (Fed. Cir. 1989);
- “TEKTRONICS” and “DAKTRONICS INC.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976);
- “BED & BREAKFAST REGISTRY” and “BREAKFAST INTERNATIONAL” *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986);
- “SANDWICH CHEF” and “BURGER CHEF” *Burger Chef Sys., Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875 (CCPA 1979);
- “DUTCH APPLE” and “DUTCH MASTERS” *Consolidate Cigar Corp. v. M. Landaw, Ltd.*, 474 F.2d 1402 (CCPA 1973);
- “K+” and “K+EFF” *In re Electrolyte Labs, Inc.*, 929 F.2d 646 (Fed. Cir. 1990);
- “RED ZINGER” and “ZINGERS” *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926 (CCPA 1978);
- “RITE WAY” and “RITE AID” *Rite Aid Corp. v. Rite-Way Discount Corp.*, 508 F.2d 828 (CCPA 1978);
- “SILK” and “SILK ‘N SATIN” *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (CCPA 1973);
- “STUDIO ONE” and “STUDIO GIRL” *Studio Girl-Hollywood, Inc. v. H/P Consultants, Ltd.*, 453 F.2d 768 (CCPA 1972);
- “PARTY PARADE” and “PARTY PRIDE” *Safeway Stores, Inc. v. Dunkirk Ice Cream Co.*, 455 F.2d 576 (CCPA 1972);
- “ROB SCOT” and “ROB ROY” *Rob Roy Co. v. Thurman Mfg. Co.*, 455 F.2d 605 (CCPA 1972);
- “CHERRY JUBILEE” and “CHERRY JULEP” *Jack Poust & Co. v. John Gross & Co.*, 460 F.2d 1076 (CCPA 1972);

- “DURAGOLD” and “EVERGOLD” *Claremont Polychemical Corp. v. Atlantic Powdered Metals, Inc.*, 470 F.2d 636 (CCPA 1972);
- “ROMANBURGER” and “ROMAN MEAL” *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884 (Fed. Cir. 1986);
- “GREEN JADE” and “JADE EAST” *Swank, Inc. v. Ravel Perfume Corp.*, 438 F.2d 622 (CCPA 1971);
- “MIGHTY MIKE” and “MIGHTY MO” *Marrion-Hot Shoppes, Inc. v. McKee Baking Co.*, 442 F.2d 978 (CCPA 1971); and
- “CANADIAN BELLE” and “CUMBERLAND BELLE” *Continental Distilling Corp. v. Norman Williams Co.*, 443 F.2d 392 (CCPA 1971).

Authorities deemed the above listed marks could co-exist with no likelihood of confusion despite the highly related goods.

Thus, this Dupont factor favors the Applicant.

c. Channels of Trade

Although the cited marks contain no limitations on the channels of trade, it can only be presumed that the goods will be sold in all normal trade channels to all the normal classes of purchasers. See *i.am.symbolic*, 866 F.3d at 1327 (“In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers.”)

But a channel of trade that is specifically controlled by United States law and which is important to the safety of those that fly, cannot be considered a “normal trade channel” for light bulbs, nor can the purchasers be considered part of a “normal class.” The current Applicant’s goods, as amended, are lighting, namely electronically controllable LED lighting systems for *aircraft cabins* comprised of LED modules, LED lighting fixtures, electronic controls, and wiring. These goods travel in a highly specialized trade channel, which has highly specialized purchasers.

Therefore, this Dupont factor must favor the Applicant.

d. Impulse Buy Versus Careful Purchase

The fourth DuPont factor is the condition under which and the buyers to whom sales are made, i.e. impulse purchase vs. careful, sophisticated purchase. In evaluating the next DuPont factor impulse purchase vs. careful, sophisticated purchase, this factor weighs heavily against a likelihood of confusion. Only Applicant's goods require a careful, sophisticated purchaser. Purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). This is a case where this prong should be dispositive.

A sophisticated consumer is one who is apt to spend more time, attention, or care in making a purchasing decision and who is thus deemed less likely to be confused as to the source or sponsorship of the trademarked products. Confusion is less likely where goods are dangerous if used improperly, i.e. like in the case of lighting systems on airplanes. Other factors that support the Applicant's position that the purchasers are sophisticated include the likely education, age, gender, and income of the purchaser and most importantly, the notion that the Applicant's goods are likely to be purchased by professional buyers. See *Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 166 USPQ 353 (CA 4 1970). Legal support for these contentions is well known in cases such as *Frances Rothschild, Inc. v. U.S. Cosmetic Fragrance Mktg. Corp.*, 223 U.S.P.Q. 817, 818 (N.D. Tex. 1983) (indicating that retailers' utilization of demonstrators (trained sales persons) in the sale of men's fragrance products informs customers of the differences in the products); *Moore Bus. Forms, Inc. v. Rite Aid Corp.*, 210 U.S.P.Q.2d 2024, 2029 (W.D.N.Y. 1991), modified, 1992 WL 125561 (W.D.N.Y. May 29, 1992), aff'd, 983 F.2d 1048 (2d Cir. 1992) (declaring that business executives are simply more sophisticated in many areas); *HQNetwork Sys. v. Executive Headquarters*, 755 F. Supp. 1110, 1119 (D. Mass. 1991) (holding that business executives are generally more sophisticated in all areas). Highlighting the importance of professional buyers, in *Oreck Corp. v. U.S. Floor Systems, Inc.*, the Fifth Circuit considered a trademark infringement claim by Oreck against a competitor in the carpet cleaning industry. One of Oreck's claims focused on professional grade cleaning machines that were used only by service contractors, professional carpet cleaning services, and building maintenance managers. Because these purchasers are directly responsible for carpet care and are in charge of buying for professional and institutional purchases, the court concluded that they are informed, deliberative buyers who

are unlikely to be confused. The same conclusion can be drawn with buyers of airline lighting systems.

Professional buyers are easily distinguishable from the prototypical case involving the spending of discretionary income on the primary basis of slick brochures and fancy advertising. See *Oreck Corp. v. U.S. Floor Systems, Inc.*, 803 F.2d 166 (5th Cir. 1986). Or in this case, the prototypical case of needing a light bulb for the lamp on the bedside table.

Further, in some cases, the courts have adopted a presumption of sophistication for products consumed by professional buyers. In *Trustees of Columbia University v. Columbia/HCA Healthcare Corp.*, for example, the district court found that purchasers of medical and healthcare services provided by hospitals are sophisticated professionals). Even though members of the general public are the technical purchasers of medical and healthcare services provided by hospitals (just like flyers are the technical purchasers), the court found that the real purchasers for the purposes of trademark analysis are the doctors who choose the hospitals to which they send their patients, and that doctors generally are a very sophisticated group of consumers who use great care in deciding which hospitals with which to affiliate themselves and to which they send their patients. This also applies to the current case where even though a member of the general public may be using the aircraft lighting system in its final form, they are unlikely to be the initial buyer. In *Trustees of Columbia University v. Columbia/HCA Healthcare Corp.*, 964 F.Supp. 733 (S.D. New York 1997).

In this case, the buyer is someone with a significant level knowledge of the aircraft industry. They aren't simply buying a light bulb. They need this knowledge as they are directly responsible for safety. This is supported by the presence of the FFA, an entire governmental entity related to aircraft and a more than 100 page Product Certification Guide for aircraft manufacturers. See https://www.faa.gov/aircraft/air_cert/design_approvals/media/cpi_guide.pdf (last visited March 4, 2019; Exhibit A).

Buyers of the Applicant's goods are highly sophisticated. Therefore, this DuPont factor strongly supports the Applicant in finding no likelihood of confusion and even on its own should be dispositive.

e. Co-existence of the cited marks

Importantly, the Trademark Office allowed both of the marks cited by the Examiner. The Office did not cite the mark owned by Halco when it allowed the PRISMA mark. This can only

be taken to mean that the Trademark Office did not think that a likelihood of confusion existed between PRISM and the Italian word for prism. But certainly the same mark just in different languages used with electric light bulbs and light fittings, both of which are sold to the general public, i.e. unsophisticated buyers, in the same channels of trade, must be more closely related than the Applicants mark and the cited marks.

This additional information strongly supports a finding of no likelihood of confusion in the current situation.

CONCLUSION

Applicant believes it has responded to the Examiner's rejection based on a likelihood of confusion. It is clear from a closer analysis of the DuPont factors, incorporating the evidence provided, that there is no likelihood consumers will be confused between Applicant's mark and the Cited Marks.

"In every case turning on the likelihood of confusion, it is the duty of the examiner to find, upon consideration of all the evidence, whether or not confusion appears likely." In re E.I. DuPont, 476 F.2d at 1362 (emphasis in original??). Here, the strongest consideration should be to the sophistication of the buyers, different channels of trade, differences in the goods, and differences in the marks.

In view of the foregoing, the Applicant respectfully requests that the Examining Attorney retract the refusal to register Applicant's Mark and approve Application No. 88059360 for publication.