

Response to Office Action

Applicant hereby responds to the Office Action dated September 14, 2018 for the mark REPRESENT (“Applicant’s Mark”), wherein the Examining Attorney identified Registration No. 4863391 for the mark REPRESENT (the “Cited Registration”) as a potential basis to refuse registration of Applicant’s Mark in Classes 3, 9, 14, 18 and 35 based on a likelihood of confusion.

Applicant respectfully submits that a likelihood of confusion refusal with respect to the Cited Registration would be inappropriate because: (i) the parties’ offerings are sufficiently different so as to avoid a likelihood of confusion; and (ii) the past practice of the U.S. Patent & Trademark Office (USPTO) indicates that the Cited Registration is entitled to a narrow scope of protection.

Accordingly, and based on the arguments and evidence set forth below, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) objection and approve the subject application for publication.

I. The Likelihood of Confusion Objection With Respect to the Cited Registration Should be Withdrawn.

In issuing the initial Section 2(d) objection of Applicant’s Mark, the Examining Attorney alleges that consumers will mistakenly believe that the parties’ respective offerings emanate from the same source because both applications cover goods in International Class 18. Applicant respectfully disagrees with the Examining Attorney’s analysis and ultimate conclusion.

The likelihood of confusion between Applicant’s Mark and the Cited Registration “is determined on a case-specific basis, applying the factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563, 567 (CCPA 1973) (enumerating factors that may be considered when relevant evidence is of record).” *Recot, Inc. v. Becton*, 214 F.3d 1322, 1326, 54 U.S.P.Q.2D (BNA) 1894 (2000). These factors include:

- the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- the similarity or dissimilarity of established, likely-to-continue trade channels;
- the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing; and
- the market interface between applicant and the owner of a prior mark.

Id. (citing *DuPont* 476 F.2d at 1361).

Applicant submits that based upon the specific facts of this case, careful analysis of these factors supports registration of Applicant’s Mark.

A. The Parties’ Respective Offerings are Sufficiently Distinguishable to Avoid a Likelihood of Confusion

In the Office Action, the Examining Attorney's analysis indicates that, because the subject application and Cited Registration both cover products in International Class 18, *all* of the parties' goods and services are related for purposes of a likelihood of confusion analysis. Applicant disagrees. Applicant's goods/services are distinct and distinguishable from those offered by registrant under the mark in the Cited Registration.

At the outset, Applicant respectfully submits that the registrant is essentially a made-to-order shop and online marketplace for others' brands, which is completely distinct and distinguishable from Applicant's offerings. This distinction is evident on the face of the Cited Registration, as the majority of the registrant's offerings in Class 35 are administrative and focus on advertising *for others* (e.g. invoice management services, rental of advertising space, dissemination of advertising for others via an on-line electronic communications network). Further, the specimen of record submitted by the registrant to the USPTO depicts an image of the registrant's website prominently stating "Show the world what *you* stand for...create and sell custom merchandise with no up-front costs". **See Exhibit A** (emphasis added). The registrant's current website also prominently states "Official merchandise *by influencers, celebrities and independent artists.*" **See Exhibit B** (emphasis added). Thus, it is clear that the registrant's consumer base is businesses and individuals to launch and sell their *own brands*.

The USPTO has acknowledged this nuance because, as further discussed below, it has permitted the registration of various third party marks for REPRESENT (or formatives) for consumer products in the nature of clothing apparel, print publications, and audio and video products, notwithstanding the nature of registrant's retail services in the Cited Registration. It would be improper, and inconsistent with past precedent, to extend the scope of protection of the registrant's services to preclude third parties from using or registering the applied-for mark in any product or service area.

Furthermore, there are significant differences between Applicant's products in the subject application and those included in the Cited Registration. The products covered by the Cited Registration include various paper goods and office supplies in International Class 16, including photographs, stationery, desk pads, gift wrap, and paper napkins, as well as printed publications in the field of "online ordering of clothing, accessories and general merchandise and promotional efforts therefore." The Cited Registration also covers various luggage and bag products in International Class 18.

Applicant respectfully submits that the registrant's paper and bag products are wholly unrelated to Applicant's applied-for goods, especially in Class 3, Class 9, and Class 14. Notably, the Examining Attorney has furnished no evidence of record that supports the contention that such goods have any relation to the products in the Cited Registration. TMEP 1207.01(a)(vi).

In particular, paper and bag products are wholly unrelated to the applied-for perfumery, cosmetics, beauty, and skincare products in International Class 3. In the United States, personal care products of this nature are commonly purchased and sold in retail stores that specialize in such products (e.g. Origins, Kiehl's, The Body Shop, Ulta, Sephora, etc.), or in specific sections of department store and retail store locations dedicated to such products. Further, because personal care products and cosmetics are applied to the human body and are used to enhance and beautify appearance, consumers of such products carefully evaluate the source of such products

and the quality of the goods both from a health perspective (to ensure that they are not allergic to ingredients) and from a cosmetic perspective (to ensure that the products will work well for the consumer's particular skin type, complexion, hair style, etc.) Further, whether cosmetics and personal care products are cruelty-free and humanely produced is also an important factor for many purchasers of such goods, which results in further review and analysis of the source of such goods. The same careful consideration is not afforded to disposable paper products or luggage, for example, which are not topically applied and are not commonly evaluated based on a consumer's individual health and cosmetic profile.

The applied-for technology accessories in Class 9 are distinctly different from the goods in the Cited Registration. The speakers, portable speakers, earphones and headphones in the subject application are evaluated for both technical proficiency and audio quality, as well as compatibility with a consumer's particular device(s) or electronics set up. Consumers in the market for Applicant's goods are not likely to believe that the maker of looseleaf binders, paper ribbons, and briefcases, for example, also are in the business of making audio equipment and accessories.



Further, the eyewear and jewelry products in Applicant's application are also distinctly different in nature from the registrant's goods, and are not complementary items. As such, the parties' respective products are not likely to be displayed together nor sold to the same class of purchaser.

There is no rule holding that certain goods or services are *per se* related – even when used in connection with similar marks – and will result in a likelihood of confusion simply by their use in a similar field. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); TMEP § 1207.01(a)(iv); *see e.g. In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (no likelihood of confusion between PLAYERS for men's underwear and PLAYERS for shoes because the goods “are distinctly different in nature” and not complementary items; when sold in the same stores they would ordinarily be displayed in different sections); *In re STMicroelectronics NV.*, Ser. No. 77500550 (T.T.A.B. 2010) (finding no likelihood of confusion between FLEXILOGIC for “computer hardware and software for noise reduction, spatial and strength processing, temporal tracking and gesture recognition of touch input devices” and FLEXILOGIC for “computer software design for others” in part because there is no *per se* rule that every computer software is related to all computer software design services).

Applicant submits that the Examining Attorney has not met her burden of proof to produce evidence showing that the parties' respective offerings are related to the extent required to support a likelihood of confusion. TMEP 1207.01(a). Moreover, the Examining Attorney's conclusion that the parties' respective offerings render the marks confusingly similar discounts the numerous other marks comprised of the term REPRESENT that are used in connection with various products, including goods that fall within the same trademark categories as those covered in the Cited Registration.


B. Applicant's Mark Should be Approved Given the Trademark Office's Treatment of Similar Marks.

Applicant notes from the Federal Register that there are several co-existing registrations and approved applications for the mark REPRESENT (or an phonetically identical formatives) in the trademark categories of interest. The co-existence on the Federal Register shows that the USPTO believes that consumers can and do distinguish between the sources of products sold under marks comprised of the same wording. In this respect, Applicant includes below an illustrative chart of various REPRESENT marks. Attached are the corresponding registration records from an online trademark database of the Federal Register (**Exhibit C**).

TM/SN/RN/Disclaimer	Status/Key Dates	Goods	Owner
REPRESENT (Stylized)  RN: 4537270 SN: 86089868	Registered May 27, 2014 Int'l Class: 09 First Use: February 1, 2012 Filed: October 11, 2013	(Int'l Class: 09) prerecorded digital audio tape featuring a series of religious sermons; prerecorded digital video disks featuring a series of religious sermons	Dharius M. Daniels (United States Citizen) 1005 Whitehead Road Ext. Ewing New Jersey 08638
REPRESENT (Stylized)  RN: 4484606 SN: 85974188	Registered February 18, 2014 Int'l Class: 16 First Use: February 1, 2012 Filed: July 1, 2013	(Int'l Class: 16) a series of printed sermons, books, and writings in the nature of written articles, brochures, and pamphlets of a spiritual, inspirational and motivational nature in the field of religion	Dharius M. Daniels (United States Citizen) 1005 Whitehead Road Ext. Ewing New Jersey 08638
REPRESENT RN: 3246116 SN: 78441951	Renewed May 29, 2017 Int'l Class: 16 First Use: February 28, 2003 Filed: June 26, 2004 Registered: May 29, 2007	(Int'l Class: 16) magazines for the promotion of sexual abstinence until marriage	Operation Keepsake, Inc. (Ohio Corp.) 2305 E Aurora Rd Twinsburg Ohio 44087
REPRESENT RN: 3518704 SN: 76555656	Renewed October 21, 2018 Int'l Class: 16 First Use: July, 2003 Filed: October 10, 2003 Registered: October 21, 2008	(Int'l Class: 16) magazine written by and for teens concerning foster care life	Youth Communication (New York Corp.) 224 West 29th Street, 2nd Floor New York New York 10001
REPRESENT RN: 4863391	Registered December 1, 2015 Int'l Class: 35	(Int'l Class: 16) photographs; stationery; books in the field on-line	Represent Holdings LLC (Delaware Limited Liability

TM/SN/RN/Disclaimer	Status/Key Dates	Goods	Owner
SN: 86976052	First Use: April 30, 2015 Filed: August 8, 2014	ordering of clothing, accessories and general merchandise and promotional efforts therefore; calendars; greeting cards; bookmarks; loose-leaf binders; magazines in the field on-line ordering of clothing, accessories and general merchandise and promotional efforts therefore; music greeting cards; notebooks; paper ribbons; paper napkins; paper handkerchiefs; paper bags; newsletters in the field on-line ordering of clothing, accessories and general merchandise and promotional efforts therefore; writing sets; desk pads; drawing pads (Int'l Class: 18) luggage; duffel bags; leather bags; wallets; general purpose sport bags; handbags; waist packs; backpacks; gym bags; attache cases; billfolds; briefcases; fanny packs; key cases; purses; umbrellas (Int'l Class: 35) order fulfillment services; invoice management services, namely, accounts receivable and billing services; rental of advertising space; rental of advertising space on web sites; retail store services featuring clothing; online retail store services featuring clothing; computerized on-line ordering and wholesale distributorship services featuring clothing, accessories and general merchandise; dissemination of advertising for others via an on-line electronic	Company) 1880 Century Park East Los Angeles California 90067

TM/SN/RN/Disclaimer	Status/Key Dates	Goods	Owner
		communications network	
REPRESENT SN: 87828268	Published March 5, 2019 Filed: March 9, 2018	(Int'l Class: 35) Charitable services, namely, organizing and conducting volunteer programs and community service projects; promoting the public interest and awareness of the need for change in the policies and attitudes concerning youth, women and African-Americans and related social issues	TV One, LLC (Delaware Limited Liability Company) 10th Floor 1010 Wayne Avenue Silver Spring Maryland 20910
RPRSNT RN: 4281229 SN: 79110064	Registered January 29, 2013 Filed: January 13, 2012 Int'l Reg Date: January 13, 2012	[Select Services] Int'l Class: 35) advertising; business management; business administration; office functions; direct mail advertising, arranging newspaper subscriptions for others; business management and organization consultancy; book-keeping; document reproduction; employment agencies, computerized file management; organization of exhibitions for commercial or advertising purposes; on-line advertising on a computer network, rental of advertising time on communication media; publication of publicity texts; rental of advertising space; dissemination of advertising matter, public relations	Rprsnt (France Limited Liability Company) Boite 4 15 Rue De Navarin F-75009 Paris France
REPR3SENT SN: 87099501	Allowed - Intent to Use 2nd Extension of Time Granted January 23, 2019 Filed: July 11, 2016	(Int'l Class: 25) shirts; shorts; sweatshirts; sweatpants; arm sleeves, namely, athletic sleeves; hoodies; sweaters; jackets; hats; visors, being headwear; headbands; socks; shoes; belts	DhTK, LLC (Florida Limited Liability Company) Suite 100 2850 Greene Street Hollywood Florida 33020

TM/SN/RN/Disclaimer	Status/Key Dates	Goods	Owner
REPR3SENT SN: 87099494	Allowed - Intent to Use 2nd Extension of Time Granted January 23, 2019 Filed: July 11, 2016	(Int'l Class: 25) shirts; shorts; sweatshirts; sweatpants; arm sleeves, namely, athletic sleeves; hoodies; sweaters; jackets; hats; visors, being headwear; headbands; socks; shoes; belts	Dhtk, LLC (Florida Limited Liability Company) Suite 100 2850 Greene Street Hollywood Florida 33020
REPRE23NT RN: 4823759 SN: 86413899	Registered September 29, 2015 Int'l Class: 25 First Use: November, 2014 Filed: October 3, 2014	(Int'l Class: 25) shirts; shorts; sweatshirts; sweatpants; hats; headbands; socks; belts	Dhtk, LLC (Florida Limited Liability Company) 2850 Greene Street, Suite 100 Hollywood Florida 33020
REPRE2ENT SN: 87099479	Allowed - Intent to Use 2nd Extension of Time Granted January 23, 2019 Filed: July 11, 2016	(Int'l Class: 25) shirts; shorts; sweatshirts; sweatpants; arm sleeves, namely, athletic sleeves; hoodies; sweaters; jackets; hats; visors, being headwear; headbands; socks; shoes; belts	Dhtk, LLC (Florida Limited Liability Company) Suite 100 2850 Greene Street Hollywood Florida 33020
REPRESENT and Design  RN: 4281449 SN: 85433438	Registered January 29, 2013 Int'l Class: 25 First Use: September 27, 2011 Filed: September 27, 2011	(Int'l Class: 25) a-shirts; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; baseball caps and hats; hooded sweat shirts; sweat shirts; t-shirts; tee shirts	Life Is Sports LLC (Massachusetts Limited Liability Company) P.O. Box 81234 Wellesley Massachusetts 02481
REPRESENT LTD. RN: 5179843 SN: 87092215 Disclaimer: "LTD."	Registered April 11, 2017 Int'l Class: 25 First Use: January 1, 2008 Filed: July 3, 2016	(Int'l Class: 25) athletic tops and bottoms for fighting; shirts; shirts and short-sleeved shirts; athletic shirts; graphic t-shirts; hooded sweat shirts; hoodies; long-sleeved shirts; short-sleeve shirts; short-sleeved shirts; sport shirts; sports shirts; sweat shirts; t-shirts; tee shirts; tee-shirts; tops	Diaz Ventures, LLC (California Limited Liability Company) 3764 Massimo Cir Stockton California 95212

The foregoing references are by no means exhaustive. However, significantly, the foregoing references indicate that consumers do distinguish among REPRESENT marks in the U.S. marketplace. For example, the USPTO has permitted the registration of *four* different REPRESENT marks for magazines, and seven REPRESENT (or essential equivalents) in the clothing field. If the Cited Registration and the above marks have been approved for registration

contemporaneously (thus indicating that the USPTO has determined they can coexist on the Principal Register without any likelihood of consumer confusion), Applicant's Mark should not be denied registration. Although the past practice of other Examining Attorneys is not binding on the examination of the subject application, there is a strong public policy in favor of reaching consistent decisions within the USPTO. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (acknowledging that consistency in examination is a goal of the U.S. Patent and Trademark Office). In an effort to reach such consistency, Applicant's Mark should also be allowed to coexist with the above-referenced marks and the mark in the Cited Registration on the Principal Register and in the marketplace.

II. Conclusion

Applicant respectfully submits that a refusal to register Applicant's Mark based on the Cited Registration would be improper. The evidence of record conclusively demonstrates that Applicant's Mark and the Cited Registration are used in connection with sufficiently distinctive offerings. Further, the co-existence among similar marks indicates that the Cited Registration is entitled to a very narrow scope of protection.

Therefore, for all of the above reasons, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) objection and permit Applicant's Mark to proceed to publication.