

The Examining Attorney has initially refused registration on the Principal Register of Applicant's GRAPEVINE mark in International Class 35 on the belief that Applicant's mark so resembles Registration No. 4131936 that is likely to cause confusion, to cause mistake, or to deceive. Applicant respectfully disagrees that confusion is likely.

As an initial matter, Applicant is the owner of prior existing registration No. 2639861 for the mark GRAPEVINE STAFFING for use in connection with "Temporary and permanent staffing placement services, namely for the fields of accounting, engineering, administrative, healthcare, financial, information technology, legal, labor, clerical, manufacturing and customized positions" and includes a disclaimer of "STAFFING". (Attached hereto as Exhibit A is a true and correct copy of Registration No. 2639861).

Applicant's GRAPEVINE STAFFING mark has a registration date of October 22, 2002, which predates the registration of THE GRAPEVINE for "employment agency services, namely, filling the temporary and permanent staffing needs of businesses" (which was registered on April 24, 2012) by nearly a decade. Notably Applicant's GRAPEVINE STAFFING Registration was not cited against the application for the cited mark as likely to be confused and the marks have co-existed on the registry for more than six years. The fact that Applicant's GRAPEVINE



STAFFING mark and the mark have now peacefully coexisted for more than six years is demonstrative of the fact that there is no likelihood of confusion between Applicant's GRAPEVINE mark and the cited mark. Certainly, had confusion been likely based on the dominant term in each mark and the similarity of services, Registrant's mark would have been rejected over Applicant's prior existing GRAPEVINE STAFFING registration.

The lack of confusion between these parties' marks is presumably because the parties offer significantly different services. As shown in Registrant's specimens, Registrant recruits chefs, nannies, personal assistants, executive assistants, estate/house managers, and housekeepers – all employees whose job it is to assist busy individuals with managing the day-to-day of their lives. (Attached hereto as Exhibit B are true and correct copies of the specimens submitted in connection with Registrant's Application and Section 8/15 declarations downloaded from TSDR). In stark contrast, as shown in Applicant's specimen, Applicant is a national search firm serving Fortune 100-500 global organizations in finding candidates for accounting/finance, manufacturing, project management, engineering, marketing quality/safety, customer service, operations, sales, human resource, product management and supply chain positions. (Attached hereto as Exhibit C is a true and correct copy of the specimen submitted in connection with Applicant's Application downloaded from TSDR). Consequently, the services offered by the parties are distinct, offered in different channels of trade to different classes of consumers, and it is highly unlikely that the respective services would be encountered by the same purchasers under circumstances which could give rise to the mistaken belief that such goods originate from a common source.

The design element in Registrant's mark further serves to distinguish Applicant's mark from the cited mark in appearance. Applicant respectfully directs the Examining Attorney to *Hewlett Packard Co. v. Human Performance Measurement, Inc.*, 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991), in which the Board stated:

There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. No element is ignored simply because it is less dominant, or would not have trademark significance if used alone. *See Spice Islands, Inc. Frank T. and Spice Co.*, 505 F.2d 1293 (C.C.P.A. 1974) (improper to ignore portion of a composite mark). (emphasis added).

Because the distinctive design of Registrant's mark weighs heavily in the overall impression of the mark, Applicant's mark and the cited marks are distinctively different.

The Federal Circuit considered a case similar to the case at hand in *In re Electrolyte Lab. Inc.*, 929 F.2d 645 (Fed. Cir. 1990). The Court considered whether there was a likelihood of confusion between the mark K+ & Design and the mark K+EFF. The Court found that there was no likelihood of confusion, despite the fact that the marks were used on the exact same products (dietary potassium supplements), both incorporated the term "K+" and were sold in the same channels of trade. In reversing the Trademark Trial and Appeal Board's and the Trademark Office's refusal to register Applicant's mark, the *Electrolyte Lab* court stated, "the nature of stylized letter marks is that they partake of both visual and/or indicia, and both must be weighed in the context in which they occur." *Id.* at 647. The Court held that the Applicant's mark, viewed as a whole, was capable of distinguishing Applicant's goods from those of the Registrant. Likewise, here, Applicant's GRAPEVINE mark is visually different from Registrant's



mark and thus serves to further eliminate any possible confusion.

Because the services are distinct, the marketing channels and class of consumers are not competing, and in light of the different visual appearance of the marks, there is no likelihood of confusion between Applicant's mark and the cited mark. Accordingly, there is no likelihood of confusion. Given Applicant's priority of rights in its prior-existing Registration, and the long-standing concurrent use between that Registration and the cited mark without confusion, and Registrant's inclusion of a distinctive design further differentiating these marks, favorable consideration and approval for publication is respectfully requested.