

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Comme Des Garcons Co., Ltd.

Application No.: 88/081,415

Filed: August 16, 2018



Mark:

Examiner: Deborah Meiners

Law Office: Law Office 110

RESPONSE TO OFFICE ACTION

This memorandum is filed in response to the Office Action mailed on October 19, 2018 (“Office Action”).

I. REFUSAL TO REGISTER IN CLASS 25

Registration of Applicant’s stylized mark CDG (“Applicant’s Mark” or “CDG”) as shown above, in Appl. Serial No. 88/0081,415, (the “Application”) has been refused registration in Class 25 based on a likelihood of confusion with Reg. No. 5,162,182 for the mark CDG NY registered in Class 25 for “Women’s, men’s, and children’s clothing and accessories, namely, dresses, pants, shirts, sweaters, jackets, shoes, scarves, belts and hats” (“Registered Mark” or “CDG NY”).

The United States Patent and Trademark Office has the burden of proving a likelihood of confusion. *In re Giovanni Food Co.*, 97 U.S.P.Q.2d 1990, 1992 (T.T.A.B. 2011). The principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d) are described in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973). However, not all of the Du Pont factors are relevant or given equal weight

in the analysis, and any one factor may be dominant in a given case. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003); *In re E. I. du Pont*, 476 F.2d at 1361-62.

Here, Applicant's Mark is not likely to be confused with the Registered Mark due to the dissimilarity of the marks in their entirety and the sophistication of the consumers. Therefore, Applicant requests that the refusal to register in Class 25 be withdrawn.

A. WHEN COMPARED IN THEIR ENTIRETIES, THE MARKS AT ISSUE ARE DISSIMILAR

In ex parte examination, the first step in determining the issue of likelihood of confusion involves a comparison of the marks for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont*, 476 F.2d at 1361; T.M.E.P. §1207.01. Importantly, the marks must be viewed in their entirety and not dissected into their component parts. *See* T.M.E.P. § 1207.01.

The basic principle in determining confusion between marks is that marks must be compared in their entirety and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted).

T.M.E.P. § 1207.01, *citing In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985); *See also Packard Press, Inc. v. Hewlett Packard Co.*, 227 F.3d 1352, 1357-58, 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000) (reversing TTAB opinion that improperly dissected marks HEWLETT PACKARD and PACKARD TECHNOLOGIES and placed undue weight on the shared word PACKARD); *Playboy of Miami, Inc. v. John B. Stetson Co.*, 426 F.2d 394, 395-396, 165 U.S.P.Q. 686 (C.C.P.A. 1970) (determining there was no likelihood of confusion when marks were compared as a whole instead of improperly dissected). Applicant's stylized mark

CDG and the cited “CDG NY”, when properly considered in their entirety, are significantly different in terms of appearance, sound, and commercial impression.

It is well established that marks must be compared in their entirety, and a finding that one portion of two marks is similar does not outweigh the differences in overall impressions of the marks. *Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d (BNA) 1041, 1042 n. 4 (T.T.A.B. 1987) (similarity as to one aspect of a mark does not automatically result in a likelihood of confusion); *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY mark not confusingly similar with BED & BREAKFAST INTERNATIONAL mark when marks are considered in their entirety); *Colgate-Palmolive Co. v. Carter-Wallace Inc.*, 58 C.C.P.A. 735,737, 432 F.2d 1400 (1970) (likelihood of confusion must arise from a consideration of the respective marks in their entirety).

In this case, the Examiner concluded that Applicant’s Mark and the Registered Mark are similar because both marks contain the acronym “CDG”. However, merely sharing a common term is not sufficient to establish similarity between marks. *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827, 830, 50 U.S.P.Q.2d 1047, 1049 (8th Cir. 1999) (“The use of identical dominant words [here, LEAN CUISINE and LEAN ‘N TASTY] does not automatically mean that two marks are similar, however. We must look to the overall impression created by the marks, not merely compare individual features.”); *Nestle’s Milk Prods., Inc. v. Baker Importing Co.*, 182 F.2d 193, 196, 86 U.S.P.Q. 80, 83 (C.C.P.A. 1950) (holding that marks must be considered in their entirety).

**B. THE EXISTENCE OF A COMMON TERM DOES NOT MEAN
CONFUSION IS LIKELY**

A finding of likelihood of confusion in the instant case cannot be based on the mere argument that the parties' marks contain the term "CDG". The case law makes clear that marks which share a common term (or terms) have been found not confusingly similar, even when applied to related goods. Indeed, it is well established that trademarks may share common words without causing consumer confusion. Ample authority supports a finding of no likelihood of confusion between marks incorporating one or more of the same or nearly identical words. *See, e.g., Jet Inc. v. Sewerage Aeration Sys.*, 49 U.S.P.Q. 1355 (6th Cir. 1999) (JET and AEROB-A-JET are visually and verbally distinct); *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (despite prominent component shared by PIZZA CAESAR USA and LITTLE CAESARS, the differences in sound and appearance made them dissimilar); *M-F-G Corp. v. EMRA Corp.*, 817 F.2d 410 (7th Cir. 1987) (no likelihood of confusion between SUPERCUT for shears and SUPERCUTS for haircutting salons); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (no likelihood of confusion between COUNTRY VOGUES for women's clothing and VOGUE for women's fashion magazine); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541 (T.T.A.B. 1983) (no likelihood of confusion between MEAT PLUS for pet food and PLUS for food supplements for dogs and cats); *Color Key Corp. v. Color 1 Assocs., Inc.*, 219 U.S.P.Q. 936 (T.T.A.B. 1983) (no likelihood of confusion between COLOR 1 for color counseling services including wardrobe, makeup and interior design and COLOR KEY 1 and KEY 1 COLORS for instructional materials and educational services concerning color selection for the home, industry and personal fashions).

While greater force is generally given to the significant and dominant features of a mark, however, even in cases in which the dominant portion of both marks is found to be the same word,

no confusion is likely when additional word elements are contained in one of the marks. For example, in *Sullivan v. CBS Corp.*, 385 F.3d 772, 777-778 (7th Cir. 2004), the United States Court of Appeals for the Seventh Circuit held that although the marks in question shared the same dominant feature, the registered mark “Survivor” was not likely to be confused with CBS’s use of the word “Survivor” because, in part, of CBS’s use in connection with other words (“Outplay, Outlast, Outwit”). Likewise, here, the addition of “NY” to the Registrant’s Mark cannot be ignored in determining confusion.

Here, the marks at issue are completely different in appearance. Specifically, Applicant’s Mark consists of the stylized letters “CDG” in a unique upper case font, with a distinctive design element consisting of three sharp pointed lines emanating from the top of each letter. Applicant’s Mark is presented as follows:



In stark comparison, the Registered Mark is a plain standard character word mark for “CDG NY”. Clearly, Applicant’s Mark and the Registered Mark do not look or sound alike, and coupled with the addition of the distinctive design element in Applicant’s Mark and the addition of “NY” in Registrant’s Mark, the parties’ marks are distinguishable in meaning, connotation and commercial impression.

Moreover, design elements help to distinguish marks that contain similar wording even when one of the marks does not contain a design element. *See, e.g. Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q.2d 1390, 1396 (T.T.A.B. 1991). *See also In re*

Healthcare Management Advisors, Inc., 2001 WL 1298855 (T.T.A.B. 2001) (comparing HMA and three HMA-formative word marks to highly stylized registration for HMA and noting that composite marks with highly stylized letters that arguendo are pronounced the same can differ substantially in appearance and create different commercial impressions); *In re Rodix, Inc.*, 187 U.S.P.Q. 255 (T.T.A.B. 1975) (persons familiar with or exposed to registrant’s distinctive “R” mark would not be likely, upon encountering applicant’s distinctive and different “R” mark, to equate the two or form an association therewith). In *Hewlett-Packard*, the TTAB held that the mark HP was not likely to be confused with HPM & Design, although the products were “closely related”. In considering the marks in their entireties, the TTAB found that applicant’s mark was not confusingly similar to any of opposer’s marks, in part because “[t]he design elements of applicant’s mark are significant features [] which are at least as prominent as, if not more prominent than, the letters “HPM”.” *Id.* Accordingly, the TTAB found that contemporaneous use of the mark “HPM” and Design for “medical instruments for clinical measurement of human performance functions, e.g., manual dexterity, reaction time and memory”, and use of the marks “HP”, with and without various designs, for a wide range of laboratory and medical laboratory and medical instruments and services incident thereto, including such closely related medical instruments, would not be likely to cause confusion. *Id.* (citing *In re Electrolyte Labs, Inc.*, 913 F.2d 930, 932, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990)). Like in *Hewlett-Packard*, in the instant case, notwithstanding the fact that the parties’ goods may be classified in the same international class, the stylized lettering of the words in Applicant’s Mark coupled with the fact that Applicant’s mark does not identify a geographical location, sufficiently distinguishes it from the Registered Mark such that there is no opportunity for confusion as to source in the marketplace.

Further, if the Examiner maintains that there is phonetic similarity due to both marks containing the term “cdg”, many courts have found no likelihood of confusion, despite phonetic similarity or identity among marks. *See, e.g., Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F. Supp. 692 (D.N.J. 1982) (no likelihood of confusion between CREAM OF WHEAT and CREAMY WHEAT, although marks were “similar, if not identical,” and both products were competing cereal products marketed through the same channels of distribution); *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213 (7th Cir. 1978) (no likelihood of confusion between TELEMED and TEL-MED, although both marks involved medical help by telephone); *Greentree Lab. v. G.G. Bean, Inc.*, 718 F. Supp. 998 (D. Me. 1989) (no likelihood of confusion between ODOKLEEN and ODOR KLEEN, despite the fact that the products were similar and there was an overlap of channels of trade).

Thus, based on the foregoing case law, where aspects of the respective marks’ overall commercial impressions are distinguishable, the fact that the parties’ marks both contain a common term is not sufficient to conclude that there is a likelihood of confusion. It is clear that more is necessary to a finding of likelihood of confusion. In the instant case, when considered in their entireties, the parties’ marks are visually distinguishable and are sufficiently dissimilar in appearance to negate any likelihood of confusion in the marketplace despite the common use of “cdg”.

Accordingly, it is respectfully submitted that Applicant’s Mark and the Registered Mark are sufficiently distinct in appearance, sound, connotation and overall commercial impression so as to avoid any confusion as to source in the marketplace.

II. PRIOR-FILED PENDING APPLICATION

As to the prior-filed pending application No. 86/814,932 for the mark “CDG LA”, applicant asserts that the same legal arguments, as stated above, apply to this application. However, applicant reserves the right to make additional arguments at a later date should this mark be cited as a bar to registration.

III. CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register in Class 25.