


Responsive to the Office action mailed October 29, 2018, Applicant addresses below all the grounds for refusal raised by the Examining Attorney and requests that the Examining Attorney approve the application for publication.


As an initial matter, Applicant voluntarily amends the identification of goods, as shown below:

Class 25: Footwear, excluding ski boots, snowboard boots, and other goods specially adapted for skiing and snowboarding

With respect to the Section 2(d) Refusal and the potential Section 2(d) Refusal, Applicant traverses the refusal and potential refusal for at least the reasons that follow. The Examining Attorney



refused registration of Applicant's mark  , due to a perceived likelihood of confusion with U.S. Reg. No. 4449681 for LE ATOME. The Examining Attorney also noted prior-filed U.S. Serial

No. 87538850 for  as a potential basis to refuse registration of Applicant's mark. Applicant notes that the owner of U.S. Serial No. 87538850 recently filed a request to divide the application, which resulted in the child application in U.S. Serial No. 87980346. Applicant also reserves the right to present additional arguments and evidence in favor of registration, should the Examining Attorney proceed to refuse the present application under Section 2(d) based on either of these applications.





As discussed below, there is no likelihood of confusion between Applicant's mark and the cited marks because: (1) the cited marks are narrow in scope as multiple different parties own federally registered and pending marks and common law marks with ATOM or similar; (2) there are significant, cumulative differences between Applicant's mark and the cited marks and purchasers of Applicant's goods are already conditioned to distinguish between marks like the cited marks and Applicant's mark; and (3) the goods in the cited mark LE ATOME are different from Applicant's goods and are sold through different channels of trade.

1. The cited marks are narrow in scope because there are multiple federal trademark registrations and common law marks with ATOM

As an initial matter, the cited mark in U.S. Reg. No. 4449681 for LE ATOME did not bar registration of the mark in the later-filed cited U.S. Serial No. 87538850 for L'ATOME (Stylized). Both purportedly translate from French to mean "The Atom" and both include clothing items in Class 25. The two cited marks are closer to each other, than either is to the applied-for mark ATOMS + Design, which is not in French and covers only footwear.

As shown below in Table 1, there are multiple federally registered marks with ATOM or similar already in coexistence for goods in Class 25, meaning that there is no likelihood of confusion between the applied-for mark ATOMS + Design and the cited marks LE ATOME and L'ATOME (Stylized). Additionally, Table 2 below shows several common law marks, emanating from various sources that use marks with ATOM in the marketplace. Copies of the registrations and pending applications identified in Table 1 are attached as Exhibit A. Copies of the common law marks identified in Table 2 are attached as Exhibit B.

TABLE 1

Mark	Reg. No./ Ser. No.	Brief Goods/Services	Owner
	RN: 5322398 SN: 87367264	Class 25: beanies; bottoms as clothing; footwear; hats; headwear; hooded sweatshirts; pants; shirts; shoes; socks; sweaters; t-shirts; tops as clothing; underwear	Above the Ordinary Man Apparel, Inc. (North Carolina Corp.)
ATOMS FAMILY	RN: 5628086 SN: 86503862	Class 25: athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms	Anthony Iodence, Dba Atoms Fmily (United States Citizen)
ATOMBOMB	RN: 5274004 SN: 87020043	Class 25: short-sleeved or long-sleeved t-shirts	Bordeaux, John (United States Citizen)
	RN: 5694297 SN: 87237244	Class 25: Shirts	Department of Defense, United States Navy, Portsmouth Naval Shipyard (United States Agency of the United States Government)
SAILS TO ATOMS	RN: 3656293 SN: 76695356	Class 25: hats and shirts	
	SN: 88087310 (allowed)	Class 25: Clothing for men, women and children, namely, shirts, t-shirts, sweatshirts, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps being headwear, sunvisors being headwear, gloves, belts, scarves, sleepwear, pajamas, lingerie, underwear, boots, shoes, sneakers, sandals, socks, booties, slipper socks...	Hanna-Barbera Productions, Inc. (Delaware Corp.)
	RN: 4850272 SN: 86572054	Class 25: hats; wearable garments and clothing, namely, shirts	Harley, Erika (United States Citizen)
ATOM & ETHER	RN: 3485762 SN: 77143036	Class 25: short-sleeved or long-sleeved t-shirts; hats; caps; aprons; tank tops...	Iamedia, Inc. (Montana Corp.)
FUNKY ATOM	RN: 4266229 SN: 79107453	Class 25: footwear; clothing for men, women and children, namely, shirts, t-shirts...	Laurence John Wildman (United Kingdom Citizen)


Mark	Reg. No./ Ser. No.	Brief Goods/Services	Owner
ATOM WHEELS	RN: 3768324 SN: 77491964	Class 25: jerseys, t-shirts, shorts and wind-resistant jackets	Nistevo Sport Manufacturing Corporation (Washington Corp.)
	RN: 4637734 SN: 85812430	Class 25: clothing, namely, t-shirts, shirts	Professional Bowlers Association LLC (Delaware Limited Liability Company)

TABLE 2

Mark	Source	Brief Goods/ Services	Owner/Seller
STYLMARTIN ATOM SHOES	https://www.revzilla.com/motorcycle/stylmartin-atom-shoes	Shoes	Calzaturificio Antis Srl
ATOM SHARK WHITE	https://www.etsy.com/listing/672562047/atom-shark-white?gpla=1&gao=1&utm_campaign=shopping_us_RedMeteorDesign_sfc_osa&utm_medium=cpc&utm_source=google&utm_custom1=0&utm_content=18615486&gclid=CjwKCAjw tYXmBRAOEiwAYsYl3NriCE4diOF WtXNDIoOyzvq8F74sxmmyXeemx P7xlQxMJxFej0LaNRoCETAQAvD_BwE	Shoes	Etsy seller RedMeteorDesign
ATOM SHOES	https://www.hotter.com/us/en/atom-shoes	Shoes	Beaconsfield Footwear Limited
ATOM RETRO	https://www.atomretro.com/shoes	Online retail of clothing and footwear	Indie Apparel Ltd
ATOM BASICS	https://eu.muroexe.com/collections/eternal	Shoes	Muro.exe Industries S.L.
ATOM LITTLE	https://www.amazon.com/Atom-Little-Breathable-Platform-Sneakers/dp/B07M637YTK	Shoes	Amazon seller Atom Little

As shown in the above tables, there are several pertinent federally registered and common law marks in coexistence that use ATOM for goods in Class 25. Accordingly, the cited marks have a narrow scope of protection limited to use of each particular mark with their particular goods. *See* TMEP § 1207.01(d)(iii) (“If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’ *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).”). Accordingly, to the extent that the

above marks can coexist, as applied to each owner's respective goods and/or services, so too can Applicant's mark ATOMS + Design.

2. The cumulative differences between Applicant's mark and the cited marks are significant.

The Board and federal courts have ruled that there is no likelihood of confusion between marks where there are cumulative differences between the marks. *See, e.g., iCARumba Inc. v. Inter-Industry Conference on Auto Collision Repair*, 57 USPQ2d 1151 (W.D. WA Oct. 5, 2000). The fact that a mark merely contains additions or deletions from the cited mark is not necessarily sufficient for finding a likelihood of confusion when the marks in their entirety convey significantly different commercial impressions. *See* TMEP § 1207.01(b)(iii) ("Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted."). *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) [hereinafter referred to as *Ritz Hotel*].

In *Ritz Hotel*, the registered mark was RITZ and the accused mark was THE RITZ KIDS. However, the court reversed the Board's finding that THE RITZ KIDS, for clothing items (including gloves), was confusingly similar to RITZ, for various kitchen textiles (including barbeque mitts), even though both marks used the word "RITZ" and both marks were found by the Board to have related goods. The court reasoned that although the perceived dominant feature of each mark was RITZ, the ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety, such as the appearance, sound, connotation, and commercial impression of the two marks. The *Ritz Hotel* court reasoned as follows:

We cannot sanction the board's dissection of RHL's mark. While it is accurate that terms such as "the" and "kids" often have little impact on consumers, this is not universally true. In this case, for instance, "the" has elevated significance because of the well-known manner in which people refer to RHL as "*The Ritz*" or "*The Ritz Hotel*," but not as "Ritz" or "Ritz Hotel." Therefore, "the" operates as an indicator of source in RHL's mark even though it has diminished importance in most other marks. And, while "kids" is undeniably used to indicate that the product is geared toward children, it distinguishes RHL's mark from Shen's; it is unlikely that consumers would mistakenly believe that Shen, the manufacturer of kitchen textiles, has expanded into children's clothing. In addition, the pronunciation of THE RITZ KIDS sounds like "The Rich Kids," leaving the impression of wealth, a concept tied strongly to RHL and not associated in any way with Shen's RITZ mark. Thus, taking into consideration the "appearance, sound, connotation, and commercial impression of the two marks," we reverse the board's finding that THE RITZ KIDS is similar to RITZ.

Id. at 1245-46.

Other decisions from the Federal Circuit emphasize the importance of considering the marks *in their entirety* and also evidence of third-party uses of elements of the applied-for and cited marks. For example, in *Juice Generation, Inc. v. GS Enterprise LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015), the Federal Circuit remanded a TTAB decision where the TTAB sustained an opposition and refused registration of the mark PEACE LOVE AND JUICE for juice bar services over a family of marks containing the phrase PEACE & LOVE for restaurant services. The TTAB had given little weight to the term JUICE as a disclaimed element and also to evidence of third-party use and registration presented by applicant. The court in *Juice Generation* instructed that the proper analysis is as follows:

As the Board understood, sufficient evidence of third party use of similar marks can “show that customers . . . ‘have been educated to distinguish between different . . . marks on the basis of minute distinctions.’” 2 *McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed. 2015) (quoting *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383 (T.T.A.B. 1976)). More broadly, evidence of third-party use bears on the strength or weakness of an opposer’s mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Id.* (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”); *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 (Fed. Cir. 2003) (third-party use can establish that mark is not strong); *Fleetwood Co. v. Mende*, 298 F.2d 797, 799 (CCPA 1962) (“Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”).

Id. at 1674

...

The Board paid insufficient heed to that important principle in analyzing the three-word combination “PEACE LOVE AND JUICE.” The Board declared that “PEACE LOVE” is the “dominant” portion of that combination, compared that portion to GS’s “PEACE & LOVE” phrase, found that they are “virtually identical,” and then simply added that “the additional disclaimed word ‘JUICE’ . . . do[es] not serve to sufficiently distinguish” Juice Generation’s mark from GS’s marks. GS Enters., 2014 WL 2997639, at *5–6. That analysis is inadequate. It does not display any consideration of how the three-word phrase in Juice Generation’s mark may convey a distinct meaning—including by having different connotations in consumers’ minds—from the two-word phrase used by GS. Cf. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000) (“To be sure, the Board stated that it had considered the marks in their entireties. But this statement, absent further explanation of the agency’s reasoning, is simply insufficient for proper review of PTO factfinding.” (citation omitted)).

While the Board may properly afford more or less weight to particular components of a mark for appropriate reasons, it must still view the mark as a whole...

Id. at 1676.

Moreover, in *Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KGaA v. New Millennium Sports SLU*, 116 U.S.P.Q. 2d. 1129 (Fed. Cir. 2015), the Federal Circuit reversed the TTAB, and found no likelihood of confusion between stylized paw prints used by applicant and opposer for clothing. The *Jack Wolfskin* court also emphasized the importance of considering each mark in their entirety and evidence of third-party use, stating as follows:

In this case, Jack Wolfskin’s evidence demonstrates the ubiquitous use of paw prints on clothing as source identifiers. Given the volume of evidence in the record, consumers are conditioned to look for differences between paw designs and additional indicia of origin to determine the source of a given product. Jack Wolfskin’s extensive evidence of third-party uses and registration of paw prints indicates that consumers are not as likely confused by different, albeit similar looking, paw prints. The Board’s conclusion that this factor was neutral is not supported by substantial evidence.

Id. at 1374.

As mandated by the Federal Circuit and controlling law, the marks must be considered *in their entirety*. Here, there are significant differences in appearance, sound, connotation and commercial impression between the cited marks and Applicant's mark when the marks are considered in their entirety, especially given that the cited marks are entitled to a narrow scope.



• is distinguishable from LE ATOME

With regards to the cited mark LE ATOME in U.S. Reg. No. 4449681, there are significant cumulative differences from Applicant's mark in appearance, sound, connotation and commercial impression. Given that the cited marks are entitled to a narrow scope, these differences are the critical, distinguishing features, especially when considering the marks *in their entirety*, as required by the Federal Circuit.

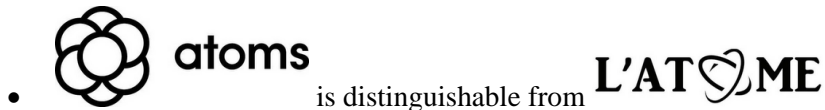
As an initial matter, although the cited mark purportedly translates in English to "The Atom," customers would still see a French language mark first and would not necessarily stop and translate the mark. The cited mark LE ATOME for "bikinis; swimwear" is a reference to one of the first bikini swimsuits ever made, which was called LE ATOME due to its small size, see Exhibit C. To emphasize this connection, Registrant's specimen of use filed in 2012 (Exhibit D) advertised its swimsuit as the "world's first bikini" and "cannes 1946 [sic]" which refers to the LE ATOME bikini which was first shown in Cannes, France in 1946. Because there is historical use of LE ATOME for swimwear, customers that see the mark LE ATOME would not stop and translate the mark, because LE ATOME has meaning in the field of swimwear apart from the direct English translation. *See* TMEP § 1207.01(b)(vi)(B) Typically, the doctrine will not be applied where the foreign wording has developed an alternate meaning in the relevant marketplace that is different from the translated meaning in English, and the evidence shows that the alternate meaning would be understood by the relevant purchasing public. *See La Peregrina*, 86 USPQ2d at 1649 (finding that if sufficient evidence had been provided to show that the Spanish-language mark LA PEREGRINA, which translates to mean "the pilgrim," for goods including pearls and pearl jewelry, was viewed by the relevant purchasing public as the "name of a very famous and unique pearl," such would be a situation "where purchasers would not translate the name")."

In any event, under the likelihood of confusion test, the marks ATOMS + Design and LE ATOME are different. For one, the cited mark begins with LE. The first part of a mark is likely to have a greater impact on consumers and be remembered by consumers. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); *see also Palm Bay Imports v. Veuve Clicquot Ponsardin*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label). This is particularly true here where there is evidence of extensive third-party use, as discussed above.

In contrast, Applicant's mark begins with a stylized image of an atom that also resembles a flower. This design element appears at the beginning of Applicant's mark and is larger in size than the word element of the mark. Moreover, even if only considering the word portion of each mark, the word portion of the cited mark begins with "LE" while the word portion of the applied-for-mark is "ATOMS". The Federal Circuit in *Juice Generation, Inc.* emphasized that marks must be considered in their entirety and, when there is evidence of third-party use, third party evidence can establish that consumers can become educated to distinguish between marks, even based on "minute distinctions." Here, in addition to the stylized image in the applied-for mark, and like in *Ritz Hotel*, the word "LE" (which translates to "the") positioned at the beginning is the type of minute distinction, along with the trailing E at the end of the cited mark, that

consumers are conditioned to look for when distinguishing between marks in a crowded field. Additionally, Applicant's mark is ATOMS plural, and is not in French, while LE ATOME is in French and if translated into English refers to a single atom.

Indeed, the mark LE ATOME needed to be dissected to extract the ATOM portion in order to make a comparison in the Office action to the applied-for mark, which means the marks were not properly considered in their entirety as mandated by Federal Circuit law. When considered in their entirety, there is no likelihood of confusion. For at least the above reasons, Applicant's mark and the cited mark are distinguishable.



With regards to the cited mark L' ATOME (Stylized) in U.S. Serial Nos. 87538850 and 87980346, there are significant cumulative differences from Applicant's mark in appearance, sound, connotation and commercial impression. Given that the cited marks are entitled to a narrow scope, these differences are the critical, distinguishing features, especially when considering the marks *in their entirety*, as required by the Federal Circuit.

As an initial matter, the cited mark begins with L'. The first part of a mark is likely to have a greater impact on consumers and be remembered by consumers. By contrast, Applicant's mark begins with a stylized image of an atom that also resembles a flower. This design element appears at the beginning of Applicant's mark and is larger in size than the word element of the mark. Moreover, even if only considering the word portion of each mark, the word portion of the cited mark begins with "L'" while the word portion of the applied-for mark is "ATOMS." Here, the "L'" positioned at the beginning of the cited mark is the type of minute distinction, along with the trailing E at the end of the cited mark, that consumers are conditioned to look for when distinguishing between marks in a crowded field.

Additionally, the cited mark is highly stylized, with a large double oval design taking the place of the O in L'ATOME. The oval design makes the O in the cited mark appear as if it is in motion, like a nuclear reaction. By contrast, the design element in Applicant's mark is also significantly different from the cited mark, because it resembles both an atom and a flower but does not suggest any motion. Further, the text of the mark is presented in all capital letters in a serif font. In contrast, Applicant's mark is presented in lower-case letters in a sans-serif font that mirrors the curved lines of the design element. Finally, Applicant's mark is ATOMS plural, and is not in French, while the stylized L'ATOME is in French and if translated into English refers to a single atom. All these are the types of minute distinctions that consumers are conditioned to look for when distinguishing between marks in a crowded field.

Indeed, the cited mark needed to be dissected to extract the ATOM portion from the middle of a unitary mark in order to make a comparison in the Office action to the applied-for mark, which means the marks were not properly considered in their entirety as mandated by Federal Circuit law. When considered in their entirety, there is no likelihood of confusion. For at least the above reasons, Applicant's mark and the cited mark are distinguishable.

Overall, neither of the cited marks – LE ATOME and L'ATOME (Stylized) – are identical in appearance, sound, or connotation to the applied-for mark ATOMS + Design. The differences between the cited marks and the applied-for mark act to create different commercial impressions, especially because consumers are already conditioned by the presence of so many coexisting marks to see and hear a different mark from the cited marks, obviating any possibility of confusion.

3. The goods in the cited mark LE ATOME are different from Applicant's goods and are sold through different channels of trade to different types of consumers

Applicant's mark covers only footwear, while U.S. Reg. No. 4449681 for LE ATOME covers only swimwear and bikinis. The Examining Attorney has not provided any evidence that there are entities that sell only footwear and swimwear. The evidence of record shows only that large retailers that sell clothing also sometimes offer both footwear and swimwear among their numerous offerings. Further, as noted above, the mark LE ATOME references a famous swimsuit first sold in 1946. Thus, customers would closely associate the mark LE ATOME with swimwear and would not be confused by Applicant's mark ATOMS + Design, which is used only for footwear.

Finally, swimwear/bikinis and footwear are directed at different target customers and offered in different channels of trade. For example, swimwear/bikinis and footwear would appear in different parts of a store, as evidenced by the evidence submitted in the Office action, where none of the online retailer search results show the sale of swimwear/bikinis and footwear on the same webpage.

In conclusion, there is no likelihood of confusion because the applied-for mark ATOMS + Design and cited marks are significantly different and create different commercial impressions; the cited marks are entitled to a narrow scope of protection and the pertinent purchasers are already conditioned to look for differences in these types of marks to distinguish between them; and the goods in the cited mark LE ATOME are different from Applicant's goods and are sold through different channels of trade.

Overall, Applicant has addressed all grounds for refusal in the Office action, and respectfully requests that the Examining Attorney approve the mark for publication. If there are any questions regarding this matter, please telephone the undersigned.