

U.S. APPLICATION SERIAL NO.: 88050976

MARK: 

APPLICANT: Balenciaga

CORRESPONDENT'S REFERENCE: X737

DESCRIPTIVENESS REFUSAL

Registration is refused, under Trademark Act Section 2(e)(1), on the basis that the Examiner contends the mark is merely descriptive of Applicant's goods. Applicant respectfully requests that the refusal be withdrawn.

The mark is a composite under TMEP Section 1213.02 with a unitary commercial impression under TMEP Section 1213.05. The unitary mark is not descriptive, since the mark as a whole is more than the sum of its parts. *Under Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991), the italicized letters leaning to the right to suggest motion, and the outlined design element suggesting the outline of a footprint, work together to create a composite, unitary design that immediately identifies Applicant as the source of its goods.

The mark has many meanings and connotations. According to Merriam Webster (attached and reprinted below), the term "track" means:

1. "a footprint whether recent or fossil"
2. "detectable evidence (such as the wake of a ship, a line of footprints, or a wheel rut) that something has passed"
3. "the parallel rails of a railroad"
4. "a sequence of events : a train of ideas"
5. "the course along which something moves or progresses"
6. "a way of life, conduct, or action"
7. "where one stands or is at the moment : on the spot, such as 'in his tracks'"
8. "to follow; to search for by following evidence until found"
9. "to observe or plot the moving path of something"

Under TMEP Section 1209.01(a), "a designation does not have to be devoid of all meaning in relation to the goods to be registrable." Indeed, "if one must exercise mature thought and follow a multi-stage reasoning process in order to determine what product characteristics the term indicates, the term is suggestive rather than merely descriptive." The commercial impression of the word, combined with the design elements of Applicant's mark suggests a *footprint*. Applicant's mark is registrable under TMEP Section 1209.01(a).

If the consumer must make a mental leap in order to understand the relationship between the mark and the nature of its goods, then the mark is suggestive. A degree of imagination, or a mental leap, is required to connect Applicant's mark with the nature of the goods in the instant application. See *Xtreme Lashes, LLC. V. Xtended Beauty, Inc.*, 576 F3d 221 (5th Cir. 2009).

Section 2(e)(1) of the Trademark Act does not prohibit registration of the mark unless the *primary* significance of the word in the mark is descriptive of Applicant's goods. See, e.g., *In re Realistic Co.*, 440 F.2d 1393 (C.C.P.A. 1971) (CURV not descriptive of permanent wave curling solution); *In re Waldorf Paper Prods. Co.*, 155 U.S.P.Q. 174 (T.T.A.B 1967) (finding STRIP-FLAP for an opening device for paper board containers not merely descriptive despite the goods comprising strips and flaps); *Ex parte Great West Lubricants, Inc.*, 118 U.S.P.Q. 169 (Comm'r Pats. 1958) (TUBE-O-LUBE not descriptive but suggestive of cartridges of lubricating grease); *Ex parte Aluminum Prods. Co.*, 105 U.S.P.Q. 44 (Comm'r Pats. 1955) (COOK-N-LOOK for transparent glass covers for cooking utensils considered not merely descriptive). In the U.S., the average American purchaser does not refer to the goods as "tracks." Applicant's goods are not fitted with spikes, as the narrow definition and evidence from the Office Action would presume. Applicant's mark is a suggestive play on words for the print left behind by the goods.

"A mark is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods." *Stix Prods. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (CONTACT for self-adhesive decorative plastic held not descriptive). The primary significance of the mark TRACK is suggestive of *a course, a way of life, a path or a footprint to follow*.

Applicant's mark fits the statutory definition of suggestiveness. The mark requires "imagination, thought, or perception to reach a conclusion as to the nature of those goods." TMEP Section 1209.01(a). Without further explanation or context, Applicant's mark has no meaning in the relevant industry to the average American purchaser, apart from operating as a source-identifier for Applicant's goods. The overall commercial impression of the mark is unique to the Applicant. Accordingly, Applicant respectfully requests that the Examiner withdraw the refusal to register the mark under Trademark Act Section 2(e)(1).

LIKELIHOOD OF CONFUSION REFUSAL

The Examiner has stated that registration is refused, under Trademark Act Section 2(d), based on a likelihood of confusion with the stylized design mark in U.S. Registration No. 3845418. Applicant respectfully requests that this refusal be withdrawn.

It is well established that when examining marks for a likelihood of confusion, the *DuPont* factors should be considered. The first *DuPont* factor to be considered in this case is, the marks should be analyzed as to their appearance, sound, commercial impression and meaning. When examining the marks for likelihood of confusion, each mark should be examined as a whole.

Applicant's mark differs from the cited mark in appearance, sound, commercial impression and meaning. Applicant's mark comprises a unitary, bold, stylized term, outlined and italicized, as described above, to suggest a footprint in motion. The combined wording and design elements in Applicant's mark create a unique commercial impression that distinguishes Applicant's mark from the cited mark.

The cited mark also appears in its own unique, stylized format that in no way resembles Applicant's mark. The cited mark is comprised of simple, blurred lines. The stark stylization would suggest that the mark in the cited mark is pronounced "trace," as in, *barely detectable*. (www.merriam-webster.com/dictionary/trace.) Without the "e," the cited mark, however, is an invented term with no meaning. A dictionary search of "trac" reveals no entries other than an abbreviation for "tractor" and a proposed search of the term, "trace." (See attached.)

Further, if a mark comprises both a word and a design or stylization, the Court of Appeals for the Federal Circuit ruled, "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement). The stylization in each of the marks is immediately recognizable and bears no resemblance to one another. The marks differ in appearance, commercial impression and meaning.

Applicant respectfully disagrees with the Examiner's contention that the marks are phonetically equivalent. It is well established that, for purposes of a likelihood of confusion analysis, there is no "correct" pronunciation of a mark. Under TMEP Section 1207.01(b)(iv), "[I]t is impossible to predict how the public will pronounce a particular mark." If pronunciation cannot be relied upon to avoid a likelihood of confusion, neither can it be relied upon to support a likelihood of confusion. *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). The cited mark has no definition, and therefore no "correct" pronunciation. The marks differ in sound.

When the marks are viewed in their entirety, as required by the Federal Circuit, confusion is unlikely. *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351 (2000). Prospective purchasers are capable of distinguishing between marks comprising their own unique stylization and wording, and so they are not likely to be confused by the goods or their respective sources.

The goods in the cited registration are limited to "shoe soles." The second *DuPont* factor to consider in this case is that the goods and their established, likely-to-continue trade channels differ. Prospective purchasers seeking the cited owner's goods will not encounter Applicant's goods and be confused as to the respective sources.

Under TMEP Section 1207.01(a)(i), the issue is not whether the goods will be confused with each other, but whether the public will be confused as to their sources. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). The visual and commercial distinctions between the marks, when compared in their entirety, are not confusingly similar. The goods, when sought in the marketplace, are not marketed or sold in such a way as to be encountered by the same purchasers in the same channels of trade or for the same purposes.

Applicant's goods are finished, ready-to-wear products offered through retail channels of trade to the general purchasing public. The circumstances under which the respective goods are

marketed and sold would not give rise to the mistaken belief that they originate from a common source.

The cited owner's *shoe soles*, on the other hand, are a reparative part of a product. Shoe soles are purchased not by the general public, but by a highly sophisticated consumer, namely someone specializing in or knowledgeable about shoe repair.

The cited owner's website demonstrates that its goods are offered and marketed as a component part of a finished product, relegated to a separate section of their website and even separately branded from any finished products (see attached, and see bottom left corner of cited owner's web page, reprinted below):

<https://www.lowaboost.com/about-lowa/lowa-sole-technology>

LOWA
100% HANDCRAFTED IN EUROPE

MEN'S - WOMEN'S - KIDS' ACCESSORIES STORES - ABOUT - NEWS/BLOG - Q

About

- Corporate Responsibility
- Technology
- LOWA Demo Centers
- Warranty and Repair
- Pro Team & Ambassadors
- Boot Care Instructions
- Size Chart
- Non-Profit Alliances
- Contact Us
- Newsletter Sign Up
- Privacy Policy
- Sponsorship Requests

About • LOWA Sole Technology

LOWA Sole Technology

We believe in polyurethane (PU). It's a terrific shock absorber and longer lasting than the more common EVA midsole. Plus, PU involves a much cleaner, environmental manufacturing process than EVA.

Combine a LOWA PU midsole with one of LOWA's patented sole units, or a VIBRAM® acclaimed sole unit *and you get a double dose of durability, comfort and superb performance.*

<p>Vibram® Mulaz</p> <p>Medium tread depth for the best friction and step characteristics on rock. Ideal also for combined terrain.</p> <p>"Climbing Zone" at the tip of the sole for precise stepping - undercut heel front for excellent grip</p>	<p>Vibram® Masai</p> <p>Excellent grip on all surfaces thanks to self-cleaning mountaineering tread</p> <p>Rough braking and rappelling studs</p> <p>Undercut heel front for excellent grip</p> <p>"Climbing Zone" at the tip of the sole</p>	<p>Vibram® Approacher</p> <p>Large "Climbing Zone" at the tip of the sole for precise stepping</p> <p>Medium tread depth and enlarged contact surface for the best friction and step characteristics on rock</p>
<p>Vibram® Dolent</p> <p>Mountaineering profile design</p> <p>High edge stability for optimum precision foot placement</p> <p>Self-cleaning profile</p>	<p>Vibram® AppTrail</p> <p>Modern trekking boot tread with increased contact area</p> <p>Self-cleaning tread for excellent grip</p> <p>Pronounced front heel edge for good traction downhill</p>	<p>LOWA Approach Lite</p> <p>Climbing style toe & heel push-off zones</p>
<p>LOWA Elika</p> <p>Tread aids the support function of the shoe</p> <p>Ideal roll-off motion thanks to special stud configuration</p> <p>Soft sole rubber increases cushioning and walking comfort</p>	<p>Vibram® Tactis DST</p> <p>Tread aids the support function of the shoe</p> <p>Ideal roll-off motion thanks to special stud configuration</p> <p>Soft sole rubber increases cushioning and walking comfort</p>	<p>LOWA Trac Lite II</p> <p>Profile designed for outdoor use</p> <p>Very good flexing action</p> <p>Perfect grip</p>

The instant application may be compared to *In re G.H.L. Int'l, Inc.*, 2012 TTAB LEXIS 379 (TTAB Sept. 25, 2012), where the Board held: "... the goods are sufficiently distinct and the channels of trade are sufficiently different that we find that applicant's mark NATURE'S SPRING FOUNTAIN for 'automated pet waterers' is not likely to cause confusion with the registered mark NATURE'S SPRING for 'water filtration and purification units for domestic use.'" Applicant's goods and its channels of trade are distinguishable from those of the cited mark. Such differences are key in precluding any likelihood of confusion between the marks.

The respective goods are not marketed or sold in such a way that consumers would confuse their sources. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir.2000). Accordingly, Applicant respectfully requests that the likelihood of confusion refusal under Trademark Act Section 2(d) be withdrawn, and the mark be passed to publication in the Official Gazette of the U.S. Trademark Office.