


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant	SUNVALLEY COMPANY DMCC
Serial No.	88/082,026
Trademark	

**RESPONSE TO OFFICIAL ACTION**

Dear Examiner Pollack:

In response to the Office Action mailed on December 7, 2018, please enter the following Remarks.

**REFUSAL BASED ON LIKELIHOOD OF CONFUSION**

Determination of likelihood of confusion under Section 2(d) is based on analysis of all of the facts which are relevant bearing on the likelihood of confusion issue. Examination of all of the relevant facts, notably the differences in the marks, the differences in the products and services and their use, the nature of Registrant's mark, the sophistication of purchasers and the conditions of purchase, establish that there is no likelihood of confusion between Applicant's mark and Registrant's mark.



The Office Action has initially refused registration of Applicant's mark under Trademark Act Section 2(d), on the ground that Applicant's mark is likely to cause confusion with – **VAULT**, Registration No. 5,511,107 over the following goods “Precious metals; jewellery; precious stones; chronometric instruments” in class 014.

Applicant respectfully disagrees with the assertions set forth in the Office Action regarding the likelihood of confusion between Applicant's mark and the Registration No. 5,511,107 ("Registrant's mark") as will be explained below.

### **RELEVANT LEGAL AUTHORITY**

The phrase "likely to cause confusion" may be restated as: *Likely* means probable; it is irrelevant that confusion is "possible." See *Westchester Media v. PRL USA*, 214 F.3d 658, 663-64, 55 U.S.P.Q.2d 1255 (5<sup>th</sup> Cir. 2000) ("likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion."); See also *Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1486, 1 U.S.P.Q.2d 1175 (Fed. Cir. 1987). In requiring proof of a "substantial likelihood of confusion," one court said that [t]his is more than mere semantics" and declined "to speculate as to any imaginable confusion..." *Church of Larger Fellowship Unitarian Universalist v. Conservation Law Fund of New England, Inc.*, 221 U.S.P.Q. 869, 871 (D. Mass. 1983).

The determination of whether there is a likelihood of confusion is a multifaceted test. The thirteen factors that make up this test were clearly articulated by the Federal Circuit Court of Appeals in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The thirteen *DuPont* factors are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity in the nature of the goods/services described in the application or registration of the mark, or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and the buyers to whom sales are made; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between Applicant and the owner of a prior mark; (11) the extent to which Applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. *DuPont*, 476 F.2d at 1361. Some of these factors which were not discussed by Office Action are examined herein. Trademark Manual of Examining Procedure ("TMEP") §1207.01.


## ARGUMENT

Turning to the relevant *DuPont* factors with regard to this case, Applicant respectfully submits that a thorough analysis of the significant differences in the marks, goods and services, and channels of trade leads inexorably to the conclusion that the Office Action has not carried its burden of establishing a likelihood of confusion in this case.

### 1. COMPARISON OF THE MARKS (DU PONT FACTOR #1)

Applicant's mark **does not resemble** Registrant's Mark and it is not likely that the mark will cause any confusion, mistake or deceive. Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." When considering the similarity of the marks, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

Applicant's mark and Registrant's Mark are different in appearance, sound, connotation and commercial impression.

Applicant's mark	Registrant's Mark
	VAULT

Registrant's mark is a wordmark, VAULT. Registrant's wordmark "VAULT" for items in class 14 is not distinctive.



On the contrary, Applicant's mark is a logomark , with a very distinctive triangular logo and a striking yellow background. The distinctive logo and striking yellow background make the marks dissimilar.

Additionally, the facts that the logos are strikingly different is sufficient for consumers to differentiate both trademarks as they are visually very different overall.

In any case, it should be reminded that the USPTO, in various cases, has allowed coexistence of two or more trademarks with higher degree of similarity than in the present case, for same class of goods, when the goods included in the trademarks were highly related to one another or even overlapping, for example:

- MESA, no. 4655199, was registered by M Cubed Technologies, Inc. in class 9, including the goods: COMPONENTS MANUFACTURED FROM METAL AND CERAMIC COMPOSITE MATERIALS, NAMELY, MOTION CONTROL ASSEMBLIES, PLATES, BEAMS, FRAMES, HOUSINGS AND STAGES, FOR USE IN THE MANUFACTURE OF SEMICONDUCTOR CAPITAL EQUIPMENT, FLAT PANEL DISPLAYS, ROBOTIC INDUSTRIAL DEVICES, AND PRECISION MOTOR CONTROL AND OPTICAL DEVICES.
- MESA, no. 4052608, was registered by Juniper Systems, Inc. in Class 9, including the goods: Computers; computer hardware and peripheral devices; Computer software for the collection and sharing of data and information; Computer software for the collection and sharing of data and information through the use of a global positioning system (GPS); Global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices.
- MESA, no. 3268301, was registered by Mesa/Boogie, Ltd. in Class 9, including the goods: AMPLIFIERS FOR MUSICAL INSTRUMENTS, AUDIO SPEAKERS, AND CABINETS FOR AUDIO SPEAKERS.
- MESA, no. 2544506, was registered by Horiba, Ltd. in Class 9, including the goods: X-ray fluorescence analyzer

- MESA, no. 1894580, was registered by Reliance Comm/Tec Corporation in Class 9, including the goods: cabinets for housing electronic equipment in the telecommunications industry.
- MESA, no. 1857216, was registered by Green Mountain Geophysics, Inc. in Class 9, including the goods: computer programs and program manuals sold as a unit for use in seismic processing.


As set forth above, the USPTO has previously enabled registration of six identical marks under Class 9, wherein the goods in the trademarks are highly related to one another (both 1857216 and 4052608 include computer software; both 1894580 and 3268301 include cabinets for electronic equipment).

In another example, the trademark "POWER" or "POWERS" was registered under class 9 by four different applicant for similar or even identical goods:

- POWER, no. 3949865, registered by Power Music, Inc. in class 9, including the goods: Downloadable musical sound recordings; digital audio, music and video for use for health, fitness or exercise, downloadable from the Internet; downloadable video recordings for use for health fitness and exercise; downloadable audio/video recordings for use for health, exercise, fitness or exercise; digital video for use for health, fitness or exercise, downloadable from the Internet.
- POWER, no. 2310126, registered by Power Productions International, Inc. in class 9, including the goods: Pre-recorded [ audio and video tapes, ] compact discs [ and/or phonograph records ] featuring music for aerobic, exercise, motivational, health and workout.
- POWERS, no. 4826854, registered by Paradise Publishing, LLC in class 9, including the goods: Pre-recorded audio and audio-visual recordings featuring musical performances; compact discs featuring music; video recordings and downloadable videos featuring musical performances; downloadable musical sound recordings; downloadable audio-visual recordings featuring music.
- POWER, no. 5078383, registered by Starz Entertainment, LLC in class 9, including the goods: Prerecorded video recordings featuring a television series;

computer game software; downloadable multimedia files containing artwork, text, audio, video, games and Internet web links, all featuring content from or relating to a television series; downloadable video games accessible via the Internet, computers and wireless devices, all featuring content from or relating to a television series; computer software downloadable to communication devices for use in accessing, playing, reviewing and streaming audio, video and multimedia content relating to a television series; downloadable photographs featuring content from or relating to a television series.

It is clear, that if the US trademark registry suffers such extent of similarity without

contending likelihood of confusion, then all the more so the mark , being in itself considerably different and consisting different goods from the trademark VAULT, should raise no concern of likelihood of confusion.