

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Diamond Paper Box Company, Inc.
Serial No. : 88/130,404
Mark : DIAMOND LOCKBOX
Class : 016
Filed : September 25, 2018

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RESPONSE TO OFFICE ACTION

Applicant Diamond Paper Box Company, Inc. (“Diamond”) hereby responds to the United States Patent and Trademark Office’s Office Action dated January 9, 2019. In the Office Action, the Trademark Office identified U.S. Trademark App. No. 87/922,295 for LOCK BOX & Design, a pending application, as potentially being confusingly similar to the DIAMOND LOCKBOX mark (the “applied-for mark”). There were also issues with identification of goods, multiple-class application requirements, and a required disclaimer. Applicant respectfully submits that there is no likelihood of confusion between the ’295 mark and Applicant’s applied-for mark. Additionally, Applicant has addressed the issues regarding the identification of goods, multiple-class application requirements, and a required disclaimer

[POTENTIAL] Section 2(d) Refusal – Likelihood of Confusion

The Trademark Office asserts that there may be a likelihood of confusion between the applied-for mark (DIAMOND LOCKBOX) and pending mark 87/922,295 for LOCK BOX & Design, if the pending mark registers. Applicant respectfully submits that there is no likelihood for confusion between the registered mark and Applicant’s applied-for mark.

In evaluating likelihood of confusion between two marks, one must compare the entirety of the marks. *Estate of P.D. Beckwith, Inc., v. Commissioner*, 252 U.S. 538 (1920). When properly evaluated in their entireties, Applicant’s DIAMOND LOCKBOX mark and the LOCK BOX & Design mark appear different and convey distinct commercial impressions. A likelihood

of confusion determination is based on the factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973); TMEP § 1207.01.

The Marks Are Dissimilar in Appearance, Connotation, and Commercial Impression

The analysis begins with the first *du Pont* factor, that is, whether Applicant's DIAMOND LOCKBOX mark and the LOCK BOX & Design mark are similar when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014), (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

While the marks must be considered in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014); *see also In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”). When a mark comprises both words and a design, it is entirely appropriate to give greater weight to a design component of a composite mark.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015). This is especially true where, as here, one of the marks contain distinctive, unusual, or uncommon design features. *In re Primeway International, LLC* (Serial 87/059,786, 9 Jan. 2019).

Applicant's mark is a word mark consisting of “DIAMOND,” a very strong first word, followed by the word “LOCKBOX.” In contrast, the pending mark begins with a large design and the word “LOCK.” Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB

2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Here, the applied-for mark begins with the strong and forceful word DIAMOND, a word that does not appear in the pending mark. Consumers are going to focus on DIAMOND rather than on the following second word “LOCKBOX” in Applicant’s mark.

Additionally, the pending mark is dominated by the design, which is **BOTH** the full padlock that takes up approximately 33% of the mark **AND** the padlock design of the alleged word “LOCK”:



However, the pending mark does NOT contain the phrase “LOCK BOX” as the designed “LOCK” is a **design element** not a word element. This is further supported by the owner of the pending mark’s description of the mark: “The mark consists of a padlock on a left side followed on the right side by the word ‘Lock,’ above the word ‘Box,’ with the letters ‘oc’ in the word ‘Lock’ modified to resemble a padlock keyhole and a padlock shackle extending above the letters.”

A consumer viewing the pending composite mark is going to see and focus on the padlock designs. If any word might be the focus of the pending composite mark, it is the largest word “BOX,” which is a generic word and just a small fraction of Applicant’s DIAMOND LOCKBOX mark. Further, BOX is a single word in the composite mark, while it is a part of a full word (LOCKBOX) in the applied-for mark.

Although the word “BOX” (and allegedly “LOCK”) is present in both marks, this alone does not create a likelihood of confusion, and is not determinative of the issue of likelihood of confusion. *See, e.g., Colgate-Palmolive Co v. Carter-Wallace, Inc.*, 432 F.2d 1400 (CCPA 1970)

(“the mere presence of the word ‘peak’ in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion” with the mark PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (CCPA 1972) (“While appellant points out some similarities between the word ALL as it is used by both parties, inspection of the two marks [ALL CLEAR! and ALL] also shows obvious differences. Considering appellee’s mark in its entirety, we are convinced that there is no likelihood of confusion” even when both marks are used on identical products); *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992) (finding no likelihood of confusion between the marks VARGA GIRL and VARGAS on identical goods). Instead, of “paramount interest is the overall commercial impression derived by viewing the marks in their entireties in determining whether a likelihood of confusion exists.” *New England Fish Company v. The Herwin Company*, 511 F.2d 562 (CCPA 1975). As described in detail herein, the two marks have very different visual appearance and focus when viewed by the consumer.

Although not dispositive, the disclaimer issue in these two marks is *very strong* evidence that the DIAMOND of the applied-for mark and the DESIGN of the pending composite mark are the dominant feature of these marks. Not only did the applicant of the pending mark disclaim the phrase “LOCK BOX” in their application, the Trademark Office in this DIAMOND LOCKBOX application has requested that Applicant disclaim the word “LOCKBOX” as a descriptive unregistrable term. The Trademark Office has indicated that although “disclaimed matter may be dominant or significant in some cases,” “[t]ypically disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark.” TMEP §1213.10. Given that the applied-for mark comprises the dominant DIAMOND word and the pending mark comprises the dual PADLOCK design that dominates, there is no indication that the disclaimed content of the two marks would be dominant and no explanation from the Trademark Office as to why the disclaimed content would be dominant.

Conclusion

Based on the foregoing, when the marks are properly viewed in their entireties, Applicant respectfully asserts that Applicant’s mark should be allowed.

Response to Office Action dated January 1, 2019
Serial No. 88/130,404

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Respectfully submitted,

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