

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Essilor of America, Inc.
Serial Number: 88/250297
Class: 35
Filed: January 04, 2019
Examining Attorney: Kyle Christopher Peete
Examining Attorney
(571) 272-8275

Mark:



RESPONSE TO OFFICE ACTION

The above-identified application has been carefully reviewed in light of the Official Action mailed March 24, 2019. It is believed that each of the objections raised by the Examining Attorney is satisfied by this amendment and the following remarks in response.

Identification of Services

Applicant adopts the following identification of services:

Class 35 – “Business management and consultation in the field of optical dispensary services for independent eye care practitioners”

Disclaimer

No claim is made to the exclusive right to use “VISION ASSOCIATES” apart from the mark as shown.

Arguments in Response

The Examining Attorney has initially refused registration of the above-identified mark on the basis that Applicant’s mark, when used with the identified services, is likely to be confused with U.S. Registration No. 1298626 for “VISION ASSOCIATES and rainbow design” citing Trademark Act § 2(d), 15 U.S.C. § 1052(d); TMEP § 1207.01. This rejection is respectfully traversed and reconsideration and withdrawal of the Examining Attorney’s rejection are requested in light of the following arguments and authorities.

Applicant’s mark is not so similar to the cited mark as used in connection with the recited services as to cause confusion within the meaning of 15 U.S.C. § 1052(d). The Court of Customs and Patent Appeals in *In Re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) set forth thirteen (13) factors to be considered in determining whether a likelihood of confusion exists. Therein, the court noted that the determination should be based upon the evidence in its entirety. In addition, the court rejected the theory that a “litmus rule”

existed which could serve to decide all cases concerning the likelihood of confusion. The thirteen (13) factors set forth by the Court of Customs and Patent Appeals are as follows:

1. **The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.**
2. **The similarity or dissimilarity and nature of the services or services as described in an application or registration 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 buyers to whom sales are made, i.e. “impulse” versus careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar services.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of services on which a mark is or is not used (house mark, “family” mark, product mark).
10. The market interface between the applicant and the owner of a prior mark.
11. The extent to which an applicant has a right to exclude others from use of its mark on its services.
12. The extent of potential confusion, i.e. whether de minimus or substantial.
13. Any other established fact probative of the effect of use.

The Court of Appeals for the Federal Circuit acknowledged the role of the *Du Pont* factors in *Specialty Brands v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) and expressly disapproved of the old “sight, sound and meaning” test applied in the past. The Trademark Trial and Appeal Board applied the *Du Pont* standards in *In Re Drums Ltd.*, 210 USPQ 222 (TTAB 1981), recognizing the principle that for the purpose of determining a likelihood of confusion, marks should be considered in their entireties and not scrutinized in an analytical vacuum. Authorities are clear that in determining the likelihood of confusion, the marks should be viewed in their entireties. *Franklin Mint Corp. v. Master Manufacturing Co.*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974).

The Official Action dated March 24, 2019 refusing registration of Applicant's mark on the basis of a likelihood of confusion does not reflect the holistic evaluation mandated by *Du Pont, Specialty Brands, and Drums*. When viewed in light of the factors from *Du Pont*, there is no likelihood of confusion between Applicant's mark and the mark of Registration No. 1298626 as cited by the Examining Attorney. As demonstrated below, it is clear that registration of Applicant's mark will not likely cause confusion or cause mistake or deception. In addition, the evidentiary factors of *Du Pont* are not listed in order of merit, "[e]ach may from case to case play a dominate role." *Du Pont* at 1361-1362; TMEP § 1201.01. Addressing the relevant *Du Pont* factors in turn, Applicant demonstrates that no likelihood of confusion is apparent and hereby respectfully requests reconsideration and withdrawal of the rejection under § 2(d).

1. Likelihood of Confusion is not Automatically Found Even When the Marks are Identical



Even when the marks are identical (which these are not), likelihood of confusion is not automatically found where the totality of circumstances surrounding the use of the marks in commerce is sufficiently different in this case, Applicant's mark is for "VISION ASSOCIATES YOUR PARTNERS IN VISION and design" for business management and consultation in the field of optical dispensary services for independent eye care practitioners and Registrant's mark is for "VISION ASSOCIATES and rainbow design" for optometry services and retail optical store services involving the sale of eyeglasses, eyeglass frames, lenses, contact lenses and accessories. For example, the Trademark Trial and Appeal Board found that the identical marks "PALM BAY" for women's shoes and "PALM BAY" for men's, women's and children's shoes and shorts were not confusingly similar. Considering the totality of the facts and circumstances, the TTAB decided that the difference in the channel of trade (retail vs. wholesale), a design feature in one of the marks and the differences in the services made confusion unlikely. *In re The Shoe Works, Inc.*, 6 USPQ 2d 1980, 1891 (TTAB 1988).

In another case, a district court found that the mark "TAJ MAHAL" for an Indian restaurant was not confusingly similar to "TAJ MAHAL" for a casino-hotel. *Taj Mahal Enterprises Ltd. v. Trump*, 745 F.Supp. 240 (D.N.J. 1990). A hotel would obviously offer food services, making the relationship between the services offered under these two marks similar to the relationship of the services seeking to be registered and the cited services at issue here. However, the district court above found no confusion between identical marks.

Further, case law supports Applicant's argument that services bearing identical marks do not necessarily give rise to finding of likelihood of confusion. In *Intext, Inc. v. Informatics, Inc.*, 185 USPQ 569 (TTAB 1975), no likelihood of confusion was found from the use of "ICS" as a service mark and trademark on instructional materials relative to the use of the mark "ICS" on educational materials. In *Sunbeam Lighting Co. v. Sunbeam Corp.*, 183 F.2d 969 (9th Cir. 1950), no likelihood of confusion was found from use of the mark "SUNBEAM" on fluorescent lamps relative to the use of mark "SUNBEAM" on electrical appliances. In *California Fruit Growers Exchange v. Sunkist Baking Co.*, 166 F.2d 971 (7th Cir. 1947), no likelihood of confusion was found from the use of the mark "SUNKIST" on bread, relative to the use of the mark "SUNKIST" on fruits and vegetables. In *Federal Telegraph and Radio Corp. v. Federal Television Corp.*, 180 F.2d 250 (2nd Cir. 1950), no likelihood of confusion was found from use of the mark "FEDERAL" on radio supplies in relation to the use of the mark "FEDERAL" on

television sets. These cases further support Applicant’s assertion that no likelihood of confusion will result from the registration of Applicant’s mark on its claimed services, as amended.

In this instance, the cited reference (Reg. No. 1298626 is visually distinctive. Here, a side by side comparison of the marks shows the clear difference in the marks in appearance and commercial impression.

Cited Registered Mark Reg. No. 1298626	Applicant’s Mark
	

Applicant’s mark consists of the words VISION ASSOCIATES YOUR PARTNERS IN VISION noting that the “O” in “VISION” has a design element along with the word “ASSOCIATES” has a black rectangular frame around it. Registrant’s mark consists of VISION ASSOCIATES in a stylized font along with a fanciful rainbow. There is absolutely no resemblance.

Clearly, in this case, this reference and Applicant’s mark are sufficiently distinctive as to appearance, commercial impressions, or connotation such that no likelihood of confusion exists, as consumers would not mistakenly believe that the services come from the same source simply because the portion of the marks have similar phonetic sounds. The reality of the marketplace is that consumers would perceive the marks differently and not associate them.

2. The Dissimilarity and Nature of the Services

The services marketed in connection with Applicant's mark are distinctively different from those services marketed by the cited Registrant under the cited registration. VISION ASSOCIATES and rainbow design (Reg. No. 1298626 is for *optometry services and retail optical store services involving the sale of eyeglasses, eyeglass frames, lenses, contact lenses and accessories* in Class 35).

The Applicant notes that the question of likelihood of confusion in an *ex parte* proceeding of the instant type must be determined on the basis of the identification of services/services set forth in the subject application and cited registrations. Pursuant to *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1996), neither the Applicant nor the Examining Attorney may engage in speculation or surmise as to the nature and character of Registrant’s services and the possible relatedness to Applicant’s services, but must rely on the facts of the record and the description of the services as recited in the application and registration. *Id.*; *see also In re Dennison Mfg. Co.*, 229 USPQ 141,144 (TTAB 1986); *In re Solar Energy Corp.*, 217 USPQ 743,745 (TTAB 1983). The Examiner cannot speculate as to what Applicant or Registrant may sale. The Examiner can only rely on the services listed in the Office records.

Further, Applicant's services are specialized services are for business management and consultation in the field of optical dispensary services for independent eye care practitioners directed exclusively to independent eye care practitioners. Whereas, Registrant services are for optometry services and retail optical store services involving the sale of eyeglasses, eyeglass frames, lenses, contact lenses and accessories. Applicant's and Registrant's services are clearly distinguishable, and the ultimate consumer will likely not be confused.

3. The Dissimilarity Of Established Likely to Continue Trade Channels

The market for Applicant's services is distinctively different than the market for the cited Registrant's services. Applicant's services are directed to independent eye care practitioners. Registrant, on the other hand, offers optometry services and retail optical store services involving the sale of eyeglasses, eyeglass frames, lenses, contact lenses and accessories. The ultimate end-users are different. In fact, there is no overlap and the consumer will not be confused.

Clearly, the realities of the marketplace are such that the very services sold by the Applicant and the services offered by the Registrant under the respective marks are directed to very specific consumers in different channels of trade or industry (travel vs. dining), and thus, are not likely to be confused by the consumers. Consequently, no likelihood of confusion is apparent.

4. The Shared Portion of the Mark Use a Descriptive Phrase, Which Has Been Disclaimed By Both Registrant and Applicant

When a common English word or phrase is selected for a trademark, the scope of protection will be more limited than if an arbitrary or fanciful word or phrase is chosen. "In fairness to all others who desire to use the same word in a suggestive manner as a trademark, the protection to each user will usually be carefully confined to the particular services or those closely related since its source-identifying qualities are equally limited." *Home Decorators, Inc. v. Ekco Prod. Co.*, 130 USPQ 153, 155 (CCPA 1961).

Here, the common phrase is descriptive. Both Registrants and Applicants admit that his phrase is descriptive, and has disclaimed the phrase "VISION ASSOCIATES," which is the only common portion of the mark.

5. The Fame of The Prior Mark (Sales, Advertising, Length Of Use)

No evidence has been provided by the Examining Attorney to demonstrate the fame of the cited registration.

6. The Extent of Potential Confusion, i.e. Whether De Minimus Or Substantial

Based upon the foregoing discussion and in light of the distinctively different and very specialized nature of the specific services of Applicant and Registrant (not to mention the disclaimer by both parties of the common portion of the marks), Applicant asserts that any

potential confusion, which might exist from the registration of the above mark, would be de minimus.

Further, confusion is not probable. It has been said that likelihood of confusion is "synonymous with 'probable' confusion - it is not sufficient if confusion is merely 'possible'. See J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:3, p.23-11. See, for example, *Sears, Roebuck & Co. v. All States Life Ins. Co.*, 246 F.2d 161, 114 USPQ 19 (5th Cir. 1957), *cert. denied*, 335 U.S. 894, 2 L.Ed.2d 192, 78 S. Ct. 268, 115 USPQ 427 (1957). ("likely" not synonymous with "possible"); *Rodeo Collection, Ltd. V. West Seventh*, 812 F.2d 1215, 2 USPQ2d 1204, 1206 (9th Cir. 1987). ("Likelihood of confusion requires that confusion is probable, not simply a possibility."); and *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 46 USPQ2d 1737 (5th Cir. 1998). ("Likelihood of confusion is synonymous with probability of confusion, which is more than a mere possibility of confusion,"). A newcomer to the market is not required to so mark his services so that they are "foolproof" from the possibility of buyer confusion. *Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429, 56 USPQ 400 (7th Cir. 1943).

When considering all of the relevant *DuPont* factors applicable to this particular case, it is clear that no likelihood of confusion exists between Applicant's mark and the cited registration. As the Court stated in *Paula Payne products Company v. Johnson Publishing Company, Inc.*, 473 F.2d 910, 177 USPQ 76 (CCPA 1973), "the question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the services they identify emanate from the same source" (citing *In re West Point-Pepperell*, 468 F.2d 200, 201 (60 CCPA 1972)). Applicant submits that it is not probable that purchasers of Applicant's services and those of the Registrant's services might mistakenly confuse their respective sources. Accordingly, Applicant respectfully requests that refusal of the application be withdrawn.

CONCLUSION

It is incumbent upon the Examining Attorney to make the realistic appraisal of the likelihood of prospective purchasers being confused as to the source, origin or sponsorship of Applicant's services vis-à-vis those services of the cited registration. The Applicant's mark and the cited mark, as well as the services offered by Applicant and services offered by Registrant, are not the same. Any potential confusion caused by any minor overlap of Applicant's services and the cited Registrant's services is de minimus. These factors as well as the others discussed in detail above mitigate in favor of a finding that no likelihood of confusion exists and that the Applicant is entitled to registration of its mark.

For the foregoing reasons, Applicant asserts that no likelihood of confusion will result from its registration of the mark as used in connection with business management and consultation in the field of optical dispensary services for independent eye care practitioners. Applicant respectfully requests reconsideration and withdrawal of the Examining Attorney's rejection under § 2(d) of the Lanham Act.

The present response is intended to fully address each of the issues raised by the Examining Attorney. Applicant's attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in

resolving the issues pending in this matter. For the foregoing reasons, it appears that Applicant has complied with the outstanding requirements of the Examining Attorney and the present application is in condition for publication and such action is respectfully requested at the earliest possible date.