

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

August 7, 2019

Ms. Evonne M. Neptune
United States Patent and Trademark Office
Examining Attorney
Law Office 127

RE: Serial No. 88249805
Mark: VERSAFLEX
Applicant: Unisafe, Inc.
Office Action of: March 25, 2019

RESPONSE TO OFFICE ACTION

In response to the Office Action issued on March 25, 2019, Applicant respectfully submits the following Response.

Section 2(d) – Likelihood of Confusion Refusal

The Examining Attorney has refused registration of the Mark pursuant to Trademark Action Section 2(d), 15 U.S.C. §1052(d), on the grounds that the Mark is likely to be confused with the mark “VERSAPRO” in U.S. Registration No. 4819852 (“Cited Mark”). Because the Mark and Cited Mark create significantly different commercial impressions, Applicant respectfully requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant’s Mark.

Likelihood of confusion between two marks is determined by an analysis of all probative facts that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (CCPA 1973); *see also In re Majestic distilling Co.*, 315 F.3d 1311, 65 U.S.P.Q.2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services, the first two *DuPont* factors. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (CCPA 1976)(“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of different in the essential characteristics of the goods and differences in the marks.”).

Under *DuPont*, the marks are compared for similarity or dissimilarity in their entirety as to appearance, sound, connotation and commercial impression. *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. at 567. Comparison of the marks is not predicated on dissecting the marks into their various components; that is, it must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *see also*

Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 212 U.S.P.Q. 233, 234 (CCPA 1981)(“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). The “touchstone of this factor is consideration of the marks in total.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA v. New Millennium Sports, S.L.U.*, 707 F.3d 1363, 116 U.S.P.Q.2d 1129, 1134 (Fed. Cir. 2015).

Applicant seeks to register the standard character mark:

VERSAFLEX

The Cited Mark is for a standard character mark:

VERSAPRO

The Mark and Cited Mark are striking in their distinct connotations and significantly different overall commercial impression.

First, the marks convey a different connotation. Applicant’s Mark is a combination of the marks “VERSA” and “FLEX.” The term “versa” is derived from the adjective “versatile” which is defined as “having many uses or applications.” *See* Merriam-Webster dictionary at Exhibit “A.” The term “flex” is a verb defined as “to bend especially repeatedly.” *See* Merriam-Webster dictionary at Exhibit “B.” The term “versa” is used in the Mark to modify the term “flex.” Combined together, “flex” is the dominate portion of the Mark and conveys an amplified meaning of flexibility.

In contrast, although “VERSAPRO” also uses the term “versa,” its use of the term “pro” creates a different meaning because the dominate portion of the mark is the term “pro.” As used, the term “pro” is defined as “professional.” *See* Merriam-Webster dictionary at Exhibit “C.” Combined together, “versa” acts to modify “pro.” Combined together, “VERSAPRO” conveys a amplified meaning of professional.

Second, as to appearance, the dominate portion of the marks serves to distinguish the Mark from the Cited Mark. The dominate portion of Applicant’s Mark is clearly “FLEX,” while the dominate portion of the Cited Mark is “PRO.”

Applicant submits that the Cited Mark is not distinctive and well-known; thus, limited consideration should be afforded the strength of the Cited Mark in determining whether there is a likelihood of confusion. *See i.e. American Intern. Group., Inc. v. American Intern. Airways, Inc.*, 726 F.Supp. 1470, 14 U.S.P.Q.2d 1933 (E.D. Pa 1989)(no likelihood of confusion where mark American Int’l was used by many companies in fields which are unrelated); *Sam’s Wines & Liquors, Inc. v. Wal-Mart Stores, Inc.* 32 U.S.P.Q.2d 1906, 1907-08, 1994 WL 529331 (N.D. ILL 1994)(allowing showing of third-party registrations as evidence of the weakness of a mark and of the narrow scope protection to which it is entitled).

There are currently forty-five (45) active third-party trademark registrations that contain the term “versa” in the mark and have goods under Class 010. A screen-shot of the TESS database listing the registrations is below, and attached as Exhibit “D.”

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	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88237063	5800350	VERSASHIELD	TSDR	LIVE
2	87937196	5771179	HI-TORQUE VERSATURN	TSDR	LIVE
3	87753433	5758646	SYMMETRY VERSAGRIP	TSDR	LIVE
4	87441060	5556594	REVANESSE VERSA	TSDR	LIVE
5	87129899	5238248	VERSA FIT	TSDR	LIVE
6	87024369	5365720	OMNIVERSA	TSDR	LIVE
7	87067758	5408272	VERSABLOCK	TSDR	LIVE
8	87067741	5408271	VERSAROD	TSDR	LIVE
9	87067729	5408270	VERSARING	TSDR	LIVE
10	87067185	5408268	VERSARAY	TSDR	LIVE
11	87099449	5247655	VERSAPAK	TSDR	LIVE
12	86799500	5016359	VERSADISC	TSDR	LIVE
13	86521487	4808002	VERSA-SLING	TSDR	LIVE
14	86535351	5047723	VENUS VERSA	TSDR	LIVE
15	86186301	4597150	VERSAWOOL	TSDR	LIVE
16	86492757	4819852	VERSAPRO	TSDR	LIVE
17	86111954	4622454	VERSASTIM	TSDR	LIVE
18	86167637	4588412	VERSA-FLOAT	TSDR	LIVE
19	85624128	4397232	VERSA-TOE FLIP	TSDR	LIVE
20	79127763	4479414	VERSACRANE	TSDR	LIVE
21	79180391	5130830	VERSA	TSDR	LIVE
22	79162265	5033616	VICE VERSA	TSDR	LIVE
23	79131973	4557910	VENVERSA	TSDR	LIVE
24	78502262	3252286	VERSA	TSDR	LIVE
25	78080212	2728157	VERSANAIL	TSDR	LIVE
26	78077176	3382658	VERSA-DIAL	TSDR	LIVE
27	78203330	2864889	VERSA-PAC	TSDR	LIVE
28	78203329	2864888	VERSA-LASTIC	TSDR	LIVE
29	77674443	3679318	VERSASCOOP	TSDR	LIVE
30	77928962	3975453	VERSACLOSE	TSDR	LIVE
31	77910640	4099532	VERSATUBE	TSDR	LIVE
32	77844142	3875682	GREER VERSA VIAL RACK	TSDR	LIVE
33	76664069	3454256	VERSALOK	TSDR	LIVE
34	76322570	2804043	VERSASTEP	TSDR	LIVE
35	76337400	2707887	VERSA-KATH	TSDR	LIVE
36	76317547	2751092	VERSAJET	TSDR	LIVE
37	76110942	2646702	VERSA T	TSDR	LIVE
38	75843573	3348937	VERSA BATH SEAT	TSDR	LIVE
39	75812370	2452110	VERSALOOP	TSDR	LIVE
40	75211624	2239372	VERSA-TRAC	TSDR	LIVE
41	75436332	2337195	VERSAGRIP	TSDR	LIVE
42	74543680	1949671	VERSA FORM	TSDR	LIVE
43	74320368	1777763	VERSA POLE	TSDR	LIVE
44	74172622	1742228	VERSA-FX	TSDR	LIVE
45	73609566	1429125	VERSA STIM	TSDR	LIVE

As also reflected in the TESS database, in addition to the Cited Mark, the Trademark Office has registered other applications with the term “versa” in the mark and “gloves” described in the goods. See TESS search result at Exhibit “E.” This further demonstrates that many entities have used “versa” in relation to their goods, making it unlikely that consumers would give significant weight to this term in ascertaining the source of such goods. Examples of this practice are also set forth in the following table:

Mark/Owner	Class/Goods	Reg. No./Date
VERSASHIELD Medline Industries, Inc.	Class 010: Medical gloves .	5800350 7/9/2019
VERSA BY DAVID'S BRIDAL David's Bridal, Inc.	Class 025: Formal wear, namely, bridesmaids gowns, special occasion dresses; gloves , shawls, capes, wraps, shrugs, cover-ups, sashes, garters and slips, and head pieces, namely, headbands and veils.	5080756 11/15/2016
VERSA-POUCH Giaquinto, Marc J.	Class 022: Attachable armchair pouches made of natural fabrics, synthetic fabrics, blends of natural and synthetic fabrics, leather, plastics, and waterproof and water repellant materials for holding cell phones, eyeglasses, client or patient charts, records and files, file folders, school homework, notepads, magazines, remote controls, knitting and sewing materials, artist supplies, hair and clothes brushes, drafting and office supplies, educational and promotional reading material, books, directories, trash, gloves , hats, scarves, soap, shampoo, and personal hygiene products, and miscellaneous items.	3319378 10/23/2007
VERSA-GARD Saf-T-Gard International, Inc.	Class 009: protective industrial gloves .	2172747 7/14/1998

Most noteworthy from the above table is the registration for VERSASHIELD (U.S. Reg. No. 5800350) which was registered on July 9, 2019, for “medical gloves” under Class 010. This registration demonstrates that the combination of two words convey a different commercial impression – namely that “versa” is not the dominate portion of the mark. The term “versa” serves more of a modifier of the second term, which is “shield” here. The application for VERSASHIELD was granted despite the prior registration of the Cited Mark for VERSAPRO, and now both are currently co-existing on the Principal Register.

As seen from the above, use of the word “versa” in Class 010 and for “gloves” is quite common. As a result of being exposed to numerous marks containing “versa,” consumers are likely to consider the entire mark in ascertaining the source of the goods, and to differentiate the goods and services using the entire mark. Therefore, Applicant maintains that “versa” is not the dominant portion of Applicant’s Mark and no weight should be given in comparing Applicant’s Mark to the Cited Mark.

Balancing the *DuPont* factors in this case, confusion is unlikely. The differences in the marks in terms of their appearance, meaning, together with the different connotations and mental impressions that are conveyed by the marks and the weakness of the Cited Mark, support a finding that the Mark and Cited Mark do not convey confusingly similar commercial impressions.

Prior-filed Application – Potential Refusal

The Examining Attorney has noted a prior filed pending application that may cause Applicant's Mark to be refused under Trademark Section 2(d) because of likelihood of confusion between the two marks ("Pending Application"). The Pending Application has since matured into a registration at U.S. Reg. No. 5800350 for VERSASHIELD, which was discussed above.

Similar to the arguments set forth above for the Cited Mark, there will unlikely be any confusion between the Mark and the Pending Application. Namely, the dominate portion of the Pending Application is the term "shield," while the dominate portion of the Mark is "flex." Given the common use of "versa," as discussed above, consumers will look to the second portion for the mark to ascertain the source.

For the same reasons why the Cited Mark, VERSAPRO can co-exist on the Principal Register as VERSASHIELD, Applicant's Mark should be allowed registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant's Mark.