

## RESPONSE TO OFFICE ACTION

In response to the Office Action mailed June 15, 2019, please consider the following amendments and remarks submitted pursuant to 37 C.F.R. § 2.62 in support of Applicant's request for reconsideration of the Examining Attorney's refusal to register the composite mark for which registration is sought.


### REMARKS

In the aforementioned Office Action, the Examining Attorney refused registration of the applied-for design mark SIC for two reasons: (1) based upon an alleged likelihood of confusion with a registered mark; and (2) an alleged indefiniteness in the identification of goods. With this response, Applicant has amended the goods to clarify the terms "clothing," "clothing for athletic use," and "outerwear" in a manner that Applicant believes is consistent with the Examining Attorney's suggested edits to the identification of goods in IC 25. In addition, Applicant has amended the description of goods and services to clarify the channels of trade for the goods and services.


Applicant respectfully submits these amendments make it clear that Applicant's goods and services are limited to custom designed graphic clothing as requested by specific customers that hire Applicant to design a clothing item. These clothing items are not sold in retail stores or on-line but rather delivered to the customer that engaged Applicant for the graphic designed clothing items.

Thus, Applicant will address the likelihood of confusion rejection.

### **LIKELIHOOD OF CONFUSION REJECTION**

The Examining Attorney has asserted an alleged likelihood of confusion between Applicant's  design mark sought to be registered and U.S. Registration Nos. 4,279,966 and 4,876,555 for [SIC] ("the Cited Registrations"), owned by an unrelated third party. In particular, the Examining Attorney contended that the word portions of the marks are identical and, therefore, the addition of a design element does not obviate the similarity of the marks. The Examining Attorney also contended that the Applicant's goods and services and the goods and services of the Cited Registrations are presumed to be identical. From these contentions, the Examining Attorney concluded that confusion as to the source of the goods is likely under Section

2(d) of the Trademark Act and refused registration. The literal element of the mark consists of SIC. The color(s) red and black is/are claimed as a feature of the mark. The mark consists of red capital letters S, I, and C angled slightly from left to right with a solid black, five-pointed star centered between the arms of the letter C.



In response, Applicant respectfully submits that Applicant's registration of the composite mark  with the amendment to the identification of goods and services goods is not likely to cause confusion as to the source of the goods and services of the Cited Registrations under Section 2(d) of the Trademark Act for the reasons that follow.

**THE MARKS ARE NOT HIGHLY SIMILAR**

Applicant also respectfully contends that the mark sought to be registered and the Cited Registration are not highly similar in appearance, sound, connotation, and commercial impression, as required to support the refusal to register. Applicant's mark in comparison to the Cited registration is set forth below:



Composite works consisting of both words and designs must be considered in their entireties. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974); TMEP 1207.01(c)(ii). The Court of Appeals for the Federal Circuit has cautioned, however, that “[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).

In that case, the K<sup>+</sup> and design for dietary potassium supplement  was held not likely to be confused with K+EFF (stylized)  for dietary potassium supplement. Despite the common K<sup>+</sup>, the “design of the marks is substantially different.” *Id.*

In the present case, the design of the marks is even more different than that in the *In re Electrolyte Laboratories Inc.* case. In the present case, the angle and font used for the letters SIC are drastically different. Applicant's mark has the letters S, I, and C angled slightly from left to right. In addition, a solid five-pointed star is centered between the arms of the letter C in Applicant's mark. In stark contrast, the Cited Registrations have the letters SIC in a different font that is not angled. In addition, the Cited Registrations have the letters between brackets, a feature not present in Applicant's mark. Given these differences, the marks do not create the same commercial impression.

#### **THE GOODS ARE NOT RELATED AND THE CUSTOMERS ARE SOPHISTICATED**

Applicant further notes that the amended description of goods and services makes it clear that Applicant's goods and services are not related to the goods of the Cited Registrations. Applicant's goods and services are directed to customers that engage Applicant for custom graphic designed clothing before the clothing is designed and delivered to that specific customer. Thus, Applicant's customers are sophisticated buyers knowing exactly what entity is providing the custom graphic designed clothing per that customers specifications.

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. TMEP 1207.01(a)(i); citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain

opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by); *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED).

#### **THE CHANNELS OF TRADE ARE DIFFERENT**

By the present amendment, Applicant has clarified that its channels of trade are custom graphic designed clothing sold directly to the consumer requesting that custom designed item. The clothing items are not sold in retail stores or on-line, but rather to the direct consumer hiring out the customized item. Such a restriction in the channels of trade will "tend to avoid likelihood of confusion." *In re the Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988). "Applicant's restricted trade channels are not the normal channels in which registrant's goods would be found." *Id.*

#### **SUMMARY**

It is respectfully submitted that the differences in the marks, and the clarifications of the customers and channels of trade show that there is no likelihood of confusion between Applicant's mark and the Cited Registrations.