

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINING DIVISION

Applicant: Innovative Design & Sourcing LLC
Trademark: PETSSENT CLIPS
App. Serial No.: 88210769
Filing Date: November 29, 2018
Examining Attorney: Linda A. Powell
Law Office: 106

RESPONSE

Applicant Innovative Design & Sourcing LLC (“Applicant”), through its undersigned counsel, respectfully submits this response to the Office Action dated March 1, 2019, in which the Examining Attorney issued for the mark PETSSENT CLIPS that is the subject of Application Serial No. 88210769 (the “Application”):

- (1) a likelihood of confusion refusal under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with the mark PET SCENTS (the “Cited Mark”) registered for use with “air fresheners” in Class 5;
- (2) a merely descriptive refusal, under Section 2(e)(1) of the of the Trademark Act, 15 U.S.C. § 1052(e)(1);
- (3) an advisory regarding the Supplemental Register;
- (4) a request for additional information and responses to six questions; and
- (5) a disclaimer request.

1. There is no likelihood of confusion between PETSSENT CLIPS covering Class 11 “Scent diffusers for attachment to dog collars” and PET SCENTS covering Class 5 “air fresheners”

As explained in detail below, consumers are not likely to be confused between Applicant’s PETSSENT CLIPS mark and the Cited Mark due to (a) differences between the marks, (b) differences between the products for which the marks are registered/used, including significant differences in the purposes for which the products are used and designed, (c) differences in the targeted consumers, (d) differences in trade channels, (e) the number of registered, in-use marks that begin with the word “PET” and are used for Class 5 products, and

(f) the number of registered, in-use marks that include “SCENT” and are used for Class 5 products.

To determine whether there is a likelihood of confusion between two marks, the Federal Circuit, Trademark Trial and Appeal Board (the “Board”), and USPTO consider the *du Pont* factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973). There are thirteen *du Pont* factors, though the court has declared that it need not consider each *du Pont* factor in a likelihood of confusion determination, but only those factors that are relevant in a particular case. 5 Gilson on Trademarks § 5.02 (2018); *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1241, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004). *See also Bose Corp. v. QSC Auto Products, Inc.*, 293 F.3d 1367, 1370, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002) (“Our precedent establishes that the determination of a likelihood of confusion does not require examination and findings as to each and every *DuPont* factor.”). “Not all of the DuPont factors are relevant to every case, and **only factors of significance to the particular mark need be considered.**” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 U.S.P.Q.2d 1257, 1259 (Fed. Cir. 2010) (emphasis added). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003), citing *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 1406-07, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997); 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:43. Furthermore, the significance of a particular factor may differ from case to case. *See du Pont*, 476 F.2d at 1361-62, 177 U.S.P.Q. at 567-68; *In re Dixie Rests., Inc.*, 105 F.3d at 1406-07, 41 U.S.P.Q.2d at 1533 (noting that “any one of the factors may control a particular case”).

The Board has observed that in “any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.” *In*

re SL&E Training Stable, Inc., 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008). See also 4 MCCARTHY ON TRADEMARKS § 24:43. These are *du Pont* factors one and two. With respect to this PETSSENT CLIPS matter, the following *du Pont* factors are most relevant: 1, 2, 4, 5, and 6.

A. There Is No Likelihood Of Confusion: First *du Pont* Factor

There is no likelihood of confusion between Applicant's mark and the Cited Mark with respect to the first *du Pont* factor: "similarity or dissimilarity of the marks *in their entirety* as to appearance, sound, connotation and commercial impression." *du Pont*, 476 F.2d at 1361 (emphasis added). When comparing 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." TMEP § 1207.01(b) (quoting *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d at 1899 (Fed. Cir. 2000)).

In addressing the similarity or dissimilarity of Applicant's mark with the Cited Mark, the question is whether one party's mark so resembles the other party's mark as to be likely to confuse relevant purchasers and prospective purchasers. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261 (Fed. Cir. 2002). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 U.S.P.Q.2d 1264, 1268 (TTAB 2007). The test of likelihood of confusion, then, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. See *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 103 U.S.P.Q.2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1551 (TTAB 2012); *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (TTAB 2010);

TMEP §1207.01(b); *Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q.2d 1283 (TTAB 2007); 4 MCCARTHY ON TRADEMARKS § 24:43. A particular feature of a mark may be more dominant or salient and therefore ought to be given greater weight than other features in considering the overall effect of the mark on the minds of consumers. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261.

The fact that Applicant's mark includes a portion, or even the entirety, of the Cited Mark is not dispositive of a likelihood of confusion. Courts and the Board have found no likelihood of confusion between marks even where one mark incorporates a portion, or the entirety, of another mark, and the marks are used with related products or services. *See, e.g., Plus Prod. v. General Mills, Inc.*, 188 U.S.P.Q. 520, 522 (T.T.A.B. 1975) (applicant's PROTEIN PLUS mark used for breakfast cereal not confusingly similar to registrant's PLUS mark used for vitamin products, food supplements, and fortifiers, even though both marks contain the word "PLUS" and are used on similar products); *Bell Lab., Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 550 (S.D. Fla. 1986) (applicant's FINAL mark used in connection with rat poison not confusingly similar to registrant's FINAL FLIP also used with rat poison even though both marks shared the common term FINAL and were used on identical products). In sum, the fact that one party's mark contains the same words found in another party's mark – or even if the mark includes the other party's entire mark – is not, by itself, enough for a likelihood of confusion. *See Bell Lab Inc.*, 644 F. Supp. at 545 (FINAL not confusingly similar to FINAL FLIP).

Appearance

The composite mark PETSCENT CLIPS is different from PET SCENTS visually due to the CLIPS portion of Applicant's mark, and because the PETSCENT element appears as one fanciful word. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir.

1985) (“in articulating reasons for reaching a conclusion on the issue of confusion, there 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 entirety”); TMEP §§ 1207.01(b)(iii) and 1207.01(b)(viii). The fundamental rule in this situation is that the marks must be considered in their entirety. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371, 116 U.S.P.Q.2d 1129, 1134 (Fed. Cir. 2015); *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q.2d 1687, 1688 (Fed. Cir. 1993).

The fact that Applicant is being required to disclaim the word “CLIPS” (see Section 5 of this response) does not matter. In analyzing marks for likelihood of confusion, **disclaimed matter must not be ignored**. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (the filing of a disclaimer does not remove the disclaimed matter from the purview of determination of likelihood of confusion; the marks must be considered in the way in which they are perceived by the relevant public).

Sound

Second, the marks are pronounced differently and these aural differences result in no likelihood of confusion. The word “CLIPS” makes Applicant’s mark so auditorily distinct that Applicant’s mark could not be misperceived as the Cited Mark. As discussed below in more detail, there are numerous marks registered and used in connection with Class 5 products that incorporate the word “PET” or the word “SCENT” so the fact that Applicant’s mark includes the word “CLIPS” is significant and is enough to avoid a likelihood of confusion.

Connotation

Turning to connotation, the “CLIPS” portion of Applicant’s mark creates an entirely different meaning than PET SCENTS used for air fresheners. The “CLIPS” portion suggests that there is a fastener of some sort or that the product may be portable. The Cited Mark includes no reference to a fastener and suggests no purpose other than smell. *See In re Chase Products Co.* (TTAB Oct. 20, 2000) [not precedential] (“Notwithstanding the relatedness/identity of the goods involved herein, in our view, applicant’s mark SPRING LINEN differs from the cited marks FRESH LINEN and CRISP LINEN in sound and appearance. Applicant’s mark also differs from the cited marks in meaning...”), available at <https://e-foia.uspto.gov/Foia/RetrievePdf?system=TTABIS&flNm=75361738-10-20-2000>.

Commercial Impression

Fourth, the commercial impression created by Applicant’s mark differs from the commercial impression created by the Cited Mark. A mark’s commercial impression on an ordinary prospective consumer is created by viewing the mark **as a whole**. *See e.g., Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 U.S.P.Q. 272, 272 (C.C.P.A. 1974) (“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 “CLIPS” portion of Applicant’s mark creates an entirely different commercial impression than PET SCENTS used for air fresheners. As stated above, the “CLIPS” portion suggests that there is a fastener of some sort or that the product may be portable, and the Cited Mark includes no such suggestion as to anything but smell. *See Approved Pharm. Corp. v. P. Leiner Nutritional Prods. Inc.*, 5 U.S.P.Q.2d 1219 (TTAB 1987) (finding the marks HEALTHY LIFE and HEALTH FOR LIFE, for goods including vitamins and dietary food supplements, to have different meanings and to present different commercial impressions).

In sum, the first *du Pont* factor weighs against a likelihood of confusion and can even be considered dispositive of the issue in this case. See *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 U.S.P.Q.2d 1286, 1290 (Fed. Cir. 2016) (“a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93, U.S.P.Q.2d 2030, 2032 (Fed. Cir. 2010) (“[A] single DuPont factor ‘may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.’”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q.2d 1459, 1460-61 (Fed. Cir. 1998) (affirmed finding of no likelihood of confusion between the mark CRYSTAL CREEK for wine and the marks CRISTAL and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks); *In re Druz*, Serial No. 86614598 (January 22, 2018) [not precedential] (considering the first *du Pont* factor dispositive due to dissimilarity of marks, reversing 2(d) refusal of FIT IN YOUR GENES in standard characters for, among other services, a weight loss program due to prior-registered design mark FITGENES and Design also for weight loss services, in part), available at <http://ttabvue.uspto.gov/ttabvue/ttabvue-86614598-EXA-8.pdf>.

B. There Is No Likelihood Of Confusion: Second *du Pont* Factor

The second *du Pont* factor (the relatedness of the goods or services as described in the application) is important in this matter. *du Pont*, 476 F.2d at 1361; TMEP § 207.01. The mere dissimilarity of goods/services can be enough to obviate a likelihood of confusion. See *in re American Olean Tile Co.*, 1 U.S.P.Q.2d 1823 (T.T.A.B. 1986) (no likelihood of confusion between MILANO for ceramic tile and MILANO for wood doors for exterior and interior use,

based on the fact that “the goods are substantially different”), and *Triumph Machine Co. v. Kentmaster Mfg. Co.*, 1 U.S.P.Q.2d 1826, 1829 (T.T.A.B. 1987) (no likelihood of confusion between HYDRO-CLIPPER for power-operated de-horning shears, and HYDRO-CLIPPER and Design for a power mower attachment, because “there is no likelihood of confusion from the virtually identical marks on these widely disparate products”).

Applicant’s **Class 11** goods are “scent diffusers for attachment to dog collars.” The goods identified for the cited mark are **Class 5** “air fresheners.” Applicant’s goods are not air fresheners and are not intended or designed to freshen air or to change the smell of air. Applicant’s goods are designed to emit and diffuse molecules from specific therapeutic oils that will soothe and comfort dogs. *See* copies of Applicant’s marketing material attached hereto as **Exhibit A**. The products are designed to assist dogs, are intended for use with dogs, and have a therapeutic purpose. *See* Exhibit A. The products are not intended to freshen the air for humans, to neutralize the odor of dogs, or to serve humans in any way like the registrant’s “air fresheners” categorized in Class 5. *See Homeowner’s Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991) (marks are not related merely “because they coexist in the same broad category”); *see also In re Automated Securities Clearance, Ltd.*, 2002 WL 1225264, *1 (TTAB April 23, 2002) (holding that the nearly identical UMA Marks were not likely to be confused because the goods and services broadly related to investment were not sufficiently related for purposes of a likelihood of confusion analysis).

The goods for Applicant’s mark are classified in International Class 11 – a different class than the goods associated with the Cited Mark. The goods have different purposes as explained above. Even if one ignores the different International Classes/purposes and lumps them together in a broad category having to do with smells, the products are still quite different and this weighs

against a likelihood of confusion. *See In re Pure & Natural Co.*, Ser. No. 77433737 (TTAB May 13, 2013) [not precedential] (finding TROPICAL ESCAPE for various soaps and body washes in Class 3 found not confusingly similar to TROPICAL ESCAPE for room fragrances and similar goods in Class 30 and air fresheners and similar goods in Class 5, and stating “It is clear that the goods are not the same or even complementary.”) (attached hereto as Exhibit E); *H. Lubovsky, Inc. v. Espirit de Corp.*, 228 U.S.P.Q. 814, 821 (S.D.N.Y. 1986) (no likelihood of confusion between ESPRIT, used for women’s and children’s sportswear, and ESPRIT, used for women’s shoes, even though the marks are identical and used with related (but different) goods). *See also In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987) (reversing refusal to register because, *inter alia*, the parties’ respective goods/services “are not so related that they would come to the attention of the same kinds of purchasers”).

The relevant consuming public is not likely to be confused because the parties’ respective goods function very differently and serve distinct purposes. Purchasers will understand that the mark PETSCENT CLIPS, when viewed in its entirety, is different from the PET SCENTS mark that is used for entirely different Class 5 products that are simply “air fresheners.” *See, e.g., Triumph Machine Co.*, 1 U.S.P.Q.2d at 1829 (no likelihood of confusion between HYDRO-CLIPPER for power-operated de-horning shears, and HYDRO-CLIPPER and Design for a power mower attachment).

C. There Is No Likelihood Of Confusion: Fourth *du Pont* Factor

The fourth *du Pont* factor requires examination of the conditions under which, and the buyers to whom, sales are made (i.e., “impulse” vs. careful, sophisticated purchasing). *du Pont*, 476 F.2d 1357, 177 U.S.P.Q. 563. Purchasers of Applicant’s goods will be those looking for a way to soothe and comfort dogs, not those looking for air fresheners. Because of the purpose of

Applicant's goods and how they will be used by dog owners looking for a particular outcome – and thus the purchasers will be making a deliberate choice for a therapeutic device as opposed to an impulse purchase – the relevant public is not likely to be confused between the parties' respective goods. *See In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 1987) (PURITAN & Design used for laundry and dry cleaning services not likely to be confused with PURITAN for commercial dry cleaning machine filters or PURITAN for a variety of cleaning preparations; while the goods/services are related in that they all exist in the laundry/dry cleaning industry, they “are not so related that they would come to the attention of the same kinds of purchasers”).

D. There Is No Likelihood Of Confusion: Fifth *du Pont* Factor

The fifth *du Pont* factor considers the fame of the prior mark. *du Pont*, 476 F.2d at 1361. Fame is a legal consideration of strength of a mark based on extensive consumer recognition and association. The fifth *du Pont* factor is considered in tandem with the sixth *du Pont* factor, discussed below, as they both are used to determine the strength of the prior mark and the scope of protection it deserves. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340, 1345 (TTAB 2017). “In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.” *Id.*; *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 U.S.P.Q.2d 1681, 1686 (Fed. Cir. 2010) (“A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). Considering there is no evidence that the PET SCENTS mark is in current use, much less famous, and (as discussed below with respect to the sixth factor) the Cited Mark is weak in the Class 5 marketplace, this *du Pont* factor weighs against a likelihood of confusion.

E. There Is No Likelihood Of Confusion: Sixth *du Pont* Factor

The sixth *du Pont* factor considers the number and nature of similar marks in use on

similar goods. *du Pont*, 476 F.2d at 1361. Based on searches of the USPTO database for marks currently in use in commerce, there are a multitude of parties using similar marks to the Cited Mark, including more than 96 registrations for marks that begin with “PET” that are used in connection with Class 5 goods, as well as the used-based application for the mark R PET SCIENCE & design in Class 31. *See* Exhibit B. With respect to the following list of 96 examples from Class 5, printouts of the registration certificates and TSDR status pages from the USPTO database for the first 10 registrations listed below are attached hereto as Exhibit C:

	Mark That Begins With “PET”	Registration No.
1	PET SCENE	5493479
2	PET SELECT	4612511
3	PETSPORT	4213553
4	PETSHOPPE	4422591
5	PET-SOOTHE	5406127
6	PETSCAN	5187461
7	PET ASSURED	4032405
8	PETZUP	3432824
9	PET FRESH	1600279
10	PETCLEAN	3709144
11	PETSWEARE	5732463
12	PET GLIDER	5724108
13	PETTEST	5766238
14	PET HELP	5631739
15	PETJOY	5705126
16	PET PARENTS	5349059
17	PET COMPLEX	5676955
18	PET CURE SOLUTIONS	5666132
19	PET FAVES	5660271
20	PET HEALTH DEPOT	5663100
21	PETGIRL	5655339
22	PET PROBIOTICS	5651808
23	PET FLORA	5319020
24	PET SOL	5616066
25	PETSFILE	5618978
26	PETPUP	5473428
27	PET-CHEER	5452924
28	PET ULTIMATES	5411347
29	PET LIFE SCIENCE	5394978
30	PET.RELEAF	5389381

31	PETRELIEF	1608002
32	PET CBD	5304977
33	PET-EMA	5274763
34	PET VIGOR	5264662
35	PETGLOVE	5638211
36	PETGLOVE	5638210
37	PET IQ	4990174
38	PET ACTION	4796686
39	PETLOCK	4760963
40	PET LOVERS	5576183
41	PET PROPHECY	5223416
42	PETEXCELCBD	5092962
43	PETEXCELCBD	5092961
44	PET UNIVERSE	5196644
45	PET MD	5192095
46	PET-NET	5064652
47	PET KELP	5028770
48	PETACTIVE+	4960220
49	PET KISS	4907853
50	PET FIT FOR LIFE	4636003
51	PET LINKS	4756833
52	PET WELLNESS ACADEMY	4749650
53	PET FUEL	4537183
54	PETRENEW	4528667
55	PET WELLBEING	4326709
56	PET BALANCE	4606626
57	PET LONGEVITY	4827306
58	PET GLUCO	4332401
59	PET-B-WELL	4368434
60	PET-ENZYMES PLUS	4207728
61	PETSPORT USA	4213554
62	PET-ALOE	4113830
63	PET-PHOS	4589967
64	PET CARESS	4664024
65	PET-PROPEL	4630767
66	PETGENIX	4544369
67	PET PARAMEDIC	4320731
68	PET HEAD	4003450
69	PET POWER	3179840
70	PET NATURALS	3095248
71	PETCAPS	3152401
72	PET CARE CONCEPTS	2991977
73	PETVISION	2953927
74	PET ESSENCES	2582354
75	PETARMOR	3990404

76	PETECTION	3803160
77	PETVITALS	3702937
78	PETREM	3613221
79	PET ORGANICS	3703952
80	PETFLEX AFD	3590135
81	PET-EASE	3467572
82	PET-TRITION	2543526
83	PETLAC	2608762
84	PET THERAPY	2955822
85	PETFLEX	2854293
86	PETSPREFER	2500212
87	PET PALS	2698155
88	PET NATURALS	2439647
89	PETSAGE	2171570
90	PET CALM	2191988
91	PET-FORM	0926704
92	PET AIR	1618404
93	PET AID	1759420
94	PETCOR	1641877
95	PET-TINIC	1305713
96	PET-TABS	0706787

Such use by multiple third parties for Class 5 goods indicates that “PET” is a weak, commonly used element such that consumers will look to other features in marks to differentiate them in appearance, sound, meaning and commercial impression. When an element of mark is used extensively in commerce by third parties, the mark has little commercial strength and the consuming public, having seen such similar marks, can distinguish them based on minor differences. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 2015). The Cited Mark is not distinctive and is entitled only to a narrow scope of protection. “The weaker [a registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.*

Similar to the word “PET,” the word “SCENTS” is used extensively in commerce by third parties, so consumers can distinguish various SCENT-formative marks based on minor differences.

There are a multitude of parties using similar marks to the Cited Mark, including over 100 registrations for marks that include “SCENT” that are used in connection with Class 5 goods.

With respect to the following 65 examples of “SCENT” registrations for Class 5 goods, printouts of the registration certificates and TSDR status pages from the USPTO database for the first 10 marks listed below are attached hereto as Exhibit D.

	Mark Incorporating “SCENT”	Registration No.
1	ANIMAL SCENTS	5652772
2	POWERSCENT	5106537
3	PURRFECT SCENTS	4643291
4	PERFECT SCENTS	2849362
5	PERMA SCENTS	1897282
6	SPRAYSCENTS	3757428
7	NATURE SCENT	2542061
8	GREEN SCENTS	4852120
9	GREAT SCENTS	4690125
10	BOWL SCENTS	5278596
11	LEAVE FRESH SCENTS BEHIND	5810370
12	SCENT BISCUIT	5746653
13	SCENTAREST	5143484
14	SCENTS APPEAL	5731045
15	SCENT CELEBRATIONS	5704118
16	ROCKET SCENT	5493856
17	HEALTH SCENTS NATURAL ESSENTIAL OIL	5461108
18	FRESH SCENT EVERY STEP OF THE WAY!	5396288
19	SCENT2GO	5344655
20	SIGNASCENTS	5305428
21	FLORIDA SCENTS	5240697
22	SCENT THIEF	4830668
23	MAGIC SCENT	5094177
24	STRIPPER SCENT	5021644
25	CANDLE SCENTS ON THE GO	4965575
26	ACTSCENT	4635505
27	SCENT SYSTEMS BY YANKEE CANDLE	4828564
28	SCENTS SANCTUARY	5347018
29	SERIOUS SCENTS	4789267
30	AROSCENT	4988097
31	HELL SCENT	4972353
32	LIFE SCENTS	4871228
33	VAPORSCENT	4866833
34	ESSENCE SCENTS	4848140

35	SIT SCENT	4767626
36	SCENTS AND SENSIBILITY	4678889
37	PACIFIC COAST ORGANIC SCENTS	4604634
38	SCENTSCAPES	4259927
39	SCENTS	4269563
40	ADJUSTA-SCENT	4322146
41	COOL WAVE SCENT	4144025
42	CURASCENTS	4176355
43	GOOD SCENTS TO HELP YOUR DOG	4070754
44	SCENTEFFECTS	4070620
45	MAGNASCENT	3899800
46	SCENT SPRAY	4538292
47	SCENTAWAY	4273256
48	SOOTHING SCENTS	3113679
49	HERBESCENT	2976150
50	CITRUSCENT	2938235
51	MINI-SCENTS	3714847
52	SCENT MELODIES	3920373
53	SCENTPORTABLE	3541672
54	LEAF SCENTS	3948233
55	VIVA-SCENT	3624478
56	FRESH SCENT	3438487
57	BOUQUET SCENTS	3606977
58	TROPIC SCENTS	3599771
59	COOL SCENTS	2836806
60	SERIOUS SCENTS	3128554
61	SWIRLING SCENTS	2208891
62	SUITE SCENTS	2147743
63	CALIFORNIA SCENTS	1940353
64	AIR-SCENT	1790092
65	SOFT SCENT	1377855

Such use by multiple third parties indicates that “SCENT” is a weak, commonly used element such that consumers will look to other features in marks to differentiate them in appearance, sound, meaning and commercial impression. As noted above, when an element of mark is used extensively in commerce by third parties, the mark has little commercial strength and the consuming public, having seen such similar marks, can distinguish them based on minor differences. *Juice Generation, Inc.*, 794 F.3d 1334, 115 U.S.P.Q.2d at 1674. The Cited Mark is not distinctive and is entitled only to a narrow scope of protection. “The weaker [a registrant’s] mark, the closer an

applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Id.*

Considering the number and nature of similar PET-formative and SCENT-formative marks in use for similar and identical services, this *du Pont* factor clearly weighs against a likelihood of confusion.

F. There Is No Likelihood Of Confusion

For the foregoing reasons, and considering the key *du Pont* factors relevant to this case and the parties' marks, there is no likelihood of confusion between the PETSSENT CLIPS used for scent diffusers for attachment to dog collars (in International Class 11), and PET SCENTS used for air fresheners (in International Class 5). Applicant respectfully requests that the Application be approved for publication on the Principal Register and published for opposition in due course.

2. PETSSENT CLIPS is not merely descriptive of the applied-for goods in Class 11 but is suggestive of diffusers used for aromatherapy

The mark PETSSENT CLIPS is not merely descriptive of the goods identified in the Application: "scent diffusers for attachment to dog collars" in International Class 11. In particular, the mark PETSSENT CLIPS is not descriptive with respect to diffusers used to treat anxiety or other emotional trauma of dogs. *See, e.g., In re Scott Paper Co.*, 180 U.S.P.Q. 283 (T.T.A.B. 1973) (finding MICRO-WIPES "merely suggestive of an article which is smaller than normal size and which performs a wiping operation"); *In re Shop-Vac Corp.*, 219 U.S.P.Q. 470 (T.T.A.B. 1983) (WET/DRY BROOM is suggestive of electric vacuum cleaners, not merely descriptive); *Manpower v. Driving Force, Inc.*, 212 U.S.P.Q. 961 (T.T.A.B. 1981) (DRIVING FORCE is suggestive of truck driving services because imagination is required to reach a conclusion about the nature of the services); *In re Colonial Stores, Inc.*, 394 F.2d 549 (C.C.P.A.

1968) (SUGAR & SPICE not merely descriptive of bakery products); *In re Chesapeake Corp. of Va.*, 420 F.2d 754, 755-56 (C.C.P.A. 1970) (SUPERWATERFINISH papers not descriptive of paper). As discussed below, PETSCENT CLIPS, when considered in its entirety and in connection with the services identified in the Application, is not merely descriptive, but is suggestive.

The Examining Attorney refused registration “because the applied-for mark merely describes purpose and manner of use of the applicant’s goods.” Selected dictionary definitions of the words “PET” and “CLIPS” were included in the Office Action. Having its individual words in dictionaries, however, is not the determining factor. The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 964 (Fed. Cir. 2007). Here, the context is important, and how the mark is intended to be used in connection with the identified goods must be taken into account. *See id.* Moreover, the possible significance that the mark would have to the average purchaser of the services in the marketplace should be considered. *Id.* *See also In re John H. Breck, Inc.*, 150 USPQ 397, 398 (T.T.A.B. 1966) (TINT TONE held suggestive for hair coloring, the Board finding the words overlap in significance and their combination does not immediately convey the nature of the products).

A term is suggestive if, when applied to the services, it requires some imagination, thought or perception to reach a conclusion as to the nature of the services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215 (C.C.P.A. 1978); TMEP § 1209.01(b). *See also Stix Prods. v. United Mfrs. Inc.*, 259 F. Supp. 479, 488 (S.D.N.Y. 1968) (holding CONTACT for self-adhesive decorative plastic suggestive instead of descriptive). In other words, a mark is suggestive, and not merely descriptive, (a) where some mental analysis is

required to understand the application of the mark to the applied-for goods, or (b) if it requires thought and imagination to determine the significance of the mark as it relates to the goods. *See In re On Tech. Corp.*, 41 U.S.P.Q.2d 1475 (T.T.A.B. 1996) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811). Put another way, to be merely descriptive “a name must clearly denote what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.” *R.R. Salvage of Conn., Inc. v. R.R. Salvage, Inc.*, 561 F. Supp. 1014, 1020, 219 U.S.P.Q. 167 (D.R.I. 1983) (emphasis added) (citing *Purolator, Inc. v. EFRA Distributors*, 524 F. Supp. 471, 477 (D.P.R. 1981), *aff’d* 687 F.2d 554 (1st Cir. 1982); 1 J. McCarthy, *Trademarks and Unfair Competition* § 11:18. On the other hand, suggestive terms “connote, rather than describe, some particular (products) or (services). . . .” *Id.*

Here, consumers are not immediately able to discern Applicant’s applied-for goods from reviewing the mark PETSSENT CLIPS because it is not readily apparent that the combined words PET, SCENT, and CLIPS specifically and clearly denote “scent diffusers for attachment to dog collars.” The mark PETSSENT CLIPS causes consumers to ponder the meaning of the mark in connection with Applicant’s applied-for goods. At a minimum, the public must make a “mental pause” to somehow fully comprehend what are Applicant’s applied-for goods. A term is suggestive if its “import would not be grasped without some measure of imagination and ‘mental pause.’” *In re Shutts*, 217 U.S.P.Q. 363, 364-65 (T.T.A.B. 1983) (SNO-RAKE not merely descriptive of “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”). None of the dictionary definitions supplied in the Office Action point toward “diffusers.” It takes an additional step, some mental analysis, some imagination to see the connection between the mark PETSSENT CLIPS and the applied-for goods. Such mental analysis is the multistep process discussed in the

TMEP and relevant case law in which marks were found “not merely descriptive” of the applied-for goods/services. *See, e.g., In re Scott Paper Co.*, 180 U.S.P.Q. 283 (T.T.A.B. 1973) (finding MICRO-WIPES “merely suggestive of an article which is smaller than normal size and which performs a wiping operation”); *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 U.S.P.Q.2d 1464 (T.T.A.B. 1993) (ACTION SLACKS not merely descriptive of pants and shorts); *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 222 U.S.P.Q. 292 (11th Cir.), *reh’g denied*, 731 F.2d 891 (11th Cir. 1984) (CITIBANK is suggestive, and is not merely descriptive, of an urban bank); *In re Shop-Vac Corp.*, 219 U.S.P.Q. 470 (T.T.A.B. 1983) (WET/DRY BROOM is suggestive of electric vacuum cleaners, not merely descriptive); *Manpower v. Driving Force, Inc.*, 212 U.S.P.Q. 961 (T.T.A.B. 1981) (DRIVING FORCE is suggestive of truck driving services because imagination is required to reach a conclusion about the nature of the services); *In re Werner Electric Brake & Clutch Co.*, 154 U.S.P.Q. 328 (T.T.A.B. 1967) (ELECTRO-MODULE not descriptive of goods even though each term, considered separately, was found to describe applicant’s goods); *Ex parte Candle Vase, Inc.*, 105 U.S.P.Q. 73, 74 (Comm’r of Patents 1965) (CANDLE VASE not merely descriptive of flower holder adapted for fitting around the base of a candle since the mark “stimulates speculation as to its intended meaning and leaves the mind in doubt”).

To an individual encountering the mark PETSCENT CLIPS, there is an element of incompleteness that the consumer must interpret in order to arrive at the conclusion that Applicant’s mark is used for “scent diffusers for attachment to dog collars.” In *In re Southern National Bank of North Carolina*, the Trademark Trial and Appeal Board (the “Board”) held that the mark MONEY 24 was suggestive, and not merely descriptive, of “banking services, namely,

automatic teller machine services.” *In re Southern Nat’l Bank of North Carolina*, 219 U.S.P.Q. 1231, 1232 (T.T.A.B. 1983). The Board explained that:

[t]he term ‘MONEY 24’ involves, in applicant’s words, ‘an element of incongruity’ or incompleteness which we believe an individual encountering the mark must interpret in order to arrive at the conclusion that one has access to his or her money by use of applicant’s services on a twenty-four hour-a-day basis.

Id. Even though “banking services” involve money, the MONEY 24 mark is still suggestive, not merely descriptive. The Board went on to explain:

We cannot say that the term [MONEY 24] as a whole does ***nothing*** but describe applicant’s services since the characteristics or functions of applicant’s services are not instantly apparent or immediately indicated by the mark sought to be registered. Moreover, ***this term is not of such a nature that competitors have a need to use these words in describing their automatic teller machine services.***

Id. (emphases added).

Similarly, in *In re TMS Corp. of the Americas*, the Board found the mark THE MONEY SERVICE is not merely descriptive of “financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution.” *In re TMS Corp. of the Americas*, 1978 TTAB LEXIS 97 at *1, 200 U.S.P.Q. 57, 57 (T.T.A.B. 1978). The Board explained that:

...because the mark “THE MONEY SERVICE” is composed of commonly used words of the English language, ***it suggests a number of things, but yet falls short of describing applicant’s services in any one degree of particularity.***

Id. at *5-6 (emphasis added). Here, the mark PETSCENT CLIPS is incomplete in terms of telling consumers about the diffuser goods provided under the mark. Even though the three individual words “pet,” “scent,” and “clips” are found in dictionaries, these three words (like THE MONEY SERVICE in the case cited above) can suggest a number of things related to pets

or smells or attachments, but fall short of describing Applicant's applied-for goods in any one degree of particularity. It requires extra thought, imagination, or analysis to get to "scent diffusers for attachment to dog collars." Thus the mark PETSSENT CLIPS is suggestive and not merely descriptive. When considered in its entirety in the context of "scent diffusers for attachment to dog collars," PETSSENT CLIPS cannot be descriptive. It requires an extra step to think of "diffusers" or "dog collars" as opposed to many other things that could be related to the words PETSSENT CLIPS.

Although "various tests" for determining the difference between descriptive marks and suggestive marks have been used, a number of courts have used the "imagination" or "degree of imagination" test. *See, e.g., Bose Corp. v. Int'l Jensen, Inc.*, 963 F.2d 1517, 1519-20, 22 U.S.P.Q.2d 1704 (Fed. Cir. 1992); *Continental Grain Co. v. Central Soya Co.*, 1995 U.S. App. LEXIS 31379 at *9 (Fed. Cir. 1995); *Equine Techs. v. Equitechnology*, 68 F.3d 542, 544, 36 U.S.P.Q.2d 1659 (1st Cir. 1995). The mark PETSSENT CLIPS does not immediately inform consumers about Applicant's goods in providing "diffusers," but requires "imagination, thought, or perception to reach a conclusion as to the nature of" the goods at issue. This indicates the mark is not merely descriptive.

Additionally, "as it has often been held by this [the Board] and other tribunals, it does not follow as a matter of law that because the component words of a mark may be descriptive and therefore unregistrable, the combination thereof or unitary mark must necessarily be likewise descriptive and likewise in capable of functioning as a trademark." *In re Warner Electric Brake & Clutch Co.*, 154 U.S.P.Q. 328, 1967 T.T.A.B. LEXIS 99, at *4 (T.T.A.B. 1967) (citations omitted). In the *Warner Electric Brake & Clutch Company* decision, the Board explained that a mark made up of descriptive words is not, by itself, necessarily descriptive:

the fact that "ELECTRO-MODULE" is composed of two terms which separately have a descriptive significance does not militate against the registration of the unitary mark as a whole unless the combination, as applied to friction clutches and brakes, is a term of art or description. There is no reference to the term "ELECTRO-MODULE" in any of the unabridged dictionaries and technical dictionaries available to us or in the trade publication relied on by the examiner; nor are we persuaded on what has been made of record herein that the designation "ELECTRO-MODULE" is generally known and used in the trade by anyone other than applicant or that it has a readily understood significance in the field. There is nothing to support the examiner's statement that "ELECTRO-MODULE" is "a natural product name for the goods".

Id. at *5. See also *R.R. Salvage of Conn., Inc. v. R.R. Salvage, Inc.*, 561 F. Supp. 1014, 1019-21, 219 U.S.P.Q. 167 (D.R.I. 1983) (RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods was held to be suggestive and protectable without proof of secondary meaning because the term required some use of consumer's imagination to determine nature of services). Like the ELECTRO-MODULE and RAILROAD SALVAGE marks composed of dictionary words, the Examining Attorney here has indicated that parts of the PETSCENT CLIPS mark are in dictionaries. However, even if the individual words themselves have definitions, it is not the case that the composite mark PETSCENT CLIPS is descriptive of the applied-for goods: "scent diffusers for attachment to dog collars."

Importantly, a descriptive connotation does not preclude a mark from being suggestive: suggestiveness is not a bar to registration on the Principal Register. In this regard, TMEP § 1209.01(a) provides in pertinent part: "***a designation does not have to be devoid of all meaning relative to the goods or services to be registrable.***" TMEP § 1209.01(a) (emphasis added). A mark can have the capacity to draw attention to a possible aspect of a product or service, or information about a target audience, and still be registrable. The C.C.P.A. held that a suggestive, and therefore registrable, mark may even go so far as to possess a "descriptive connotation," which is a

connotation that conveys an impression of the goods: “The simple presence of that type of descriptive connotation, like the presence of suggestiveness, will not preclude registration where the mark is not merely descriptive of the goods.” *The Coca-Cola Co. v. Seven-Up. Co.*, 497 F.2d 1351, 182 U.S.P.Q. 207, 209 (C.C.P.A. 1974) (holding UNCOLA not merely descriptive of noncola soft drinks). Thus, even if the words “PETSCENT CLIPS” arguably convey an impression that pets or the owners of pets may be the end-users or target consumers of the relevant goods, the decision in *The Coca-Cola Co. v. Seven-Up. Co.* shows that such a “descriptive connotation” or impression shall not preclude registration of the words “PETSCENT CLIPS” for the applied-for goods.

For the reasons set forth above, PETSCENT CLIPS is ***not*** merely descriptive of the applied-for goods. However, if there is any doubt, the determination between suggestive and descriptive must be resolved in favor of Applicant here. As explained in the SNO-RAKE decision:

We recognize that the suggestive/ descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment. Indeed, this case may well present such a challenge in making the necessary classification. ***At the very least, however, we have doubts about the ‘merely descriptive’ character of the mark before us and, unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark Act, it is clear that such doubts are to be resolved in favor of applicants.***

In re Shutts, 217 U.S.P.Q. at 365 (emphasis added) (citing *In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (T.T.A.B. 1972) (“DRI-FOOT” for anti-perspirant foot deodorant); *In re Ray J. McDermott and Co., Inc.*, 170 U.S.P.Q. 524 (T.T.A.B. 1971) (“SWIVEL-TOP” for fuel transfer mooring buoys)). Any doubt with respect to whether PETSCENT CLIPS is descriptive or suggestive must be resolved in favor of Applicant.

Finally, “[a]n applicant need not conclusively establish distinctiveness but need only establish a prima facie case’ to warrant publication of a mark for opposition.” *In re Capital*

Formation Counselors, Inc., 219 U.S.P.Q. 916, 919 (T.T.A.B. 1983). Borderline cases should pass to publication. *See, e.g., In re Shutts*, 217 U.S.P.Q. at 365; *In re The Gracious Lady Serv., Inc.*, 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972) (“It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant’s behalf and publish the mark for opposition purposes. . . .”); *In re Entenmann’s Inc.*, 15 U.S.P.Q.2d 1750, 1751 n.2 (T.T.A.B. 1990) (“[I]n ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication.”); *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B. 1986) (doubts under § 2(e) about the merely descriptive nature of a term are resolved in favor of the applicant).

3. Advisory concerning the Supplemental Register

The Examining Attorney indicated that Applicant’ intent-to-use Application is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use has been timely filed.

4. Additional information required

The Examining Attorney asked that Applicant respond to the following six questions:

- a. What is the *purpose* of the applicant’s goods? Are the goods used to freshen the animal scent? Are the goods used to freshen the place where the animal lives and sleeps?
 - The purpose of Applicant’s goods is to impact the emotions of a dog via the release of essential oil molecules from the diffuser device. *See* Exhibit A. There are two versions of the device: (1) “Calming”: this version features a blend of essential oils including lavender that will calm a dog; and (2) “Rescue”: this version features a blend of essential oils that is intended to ease emotional trauma and feelings of abandonment (separation anxiety) that a dog may experience.

- No, Applicant's goods are not used to freshen any animal scent.
 - No, Applicant's goods are not used to freshen the place where the animal lives and sleeps (or the smells associated with such places).
- b. Do the goods house the scent of pets? No.
- c. To what do the words PET SCENT refer? The unitary term "PETSCENT" is intended to be suggestive of the essential oils and the way such oils are diffused into the air to be detected by the particular dog to which the device is attached. The term "PETSCENT" does not actually describe the purpose of the PETSCENT CLIPS therapy device: the release from the device, via evaporation into the air, of molecules of essential oils that have certain calming effects that will impact the emotions of dogs; aromatherapy).
- d. What is the purpose of the CLIP? The PETSCENT CLIPS therapy device includes polyurethane material that houses essential oil drops, and a fastener that attaches to any dog collar similar to the way a dog tag does.

5. Disclaimer required

The Examining Attorney indicated that Applicant must disclaim the term "CLIPS." Applicant submits the following disclaimer suggested by the Examining Attorney: "No claim is made to the exclusive right to use "CLIP" apart from the mark as shown."

6. Conclusion

Applicant respectfully requests that its mark PETSCENT CLIPS be passed to publication, as Applicant has established a prima facie case of the suggestive or distinctive nature of Applicant's mark when used with the identified goods. Any doubts concerning the mark should be resolved in Applicant's favor.

Respectfully Submitted,
/David Einhorn/

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