

RESPONSE TO OFFICE ACTION

The Examining Attorney refused to register Applicant's mark based on several issues addressed below. Based on these arguments, Applicant respectfully requests the Examining Attorney withdraw these refusals and objections and allow this application to proceed to registration.

Likelihood of Confusion Refusal Under Section 2(d)

The Examining Attorney refused registration under Trademark Act 2(d), claiming a likelihood of confusion between the Applicant's mark, GPS, (Serial No. 88254793) and registered marks GPS USA DIVISION (Reg. No. 4085602) and GPS (Reg. No. 4914274). Applicant respectfully disagrees and requests withdrawal of the refusal in light of the following arguments.

The Examining Attorney utilized two of the factors set for in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A 1973) in finding there was a likelihood of confusion. Applicant respectfully argues further consideration of those two points shows there is no likelihood of confusion in this case. In analyzing the following elements of the *du Pont* test, Applicant's application for federal registration of GPS should be granted.

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.

With regard to Reg. No. 4085602, the Examining Attorney argued Applicant's mark and Registrants' marks are identical due to the presence of the term GPS in both marks. However, a likelihood of confusion analysis based on the marks' similarity must review the "marks in their entireties." *du Pont*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (emphasis added). The Examining Attorney's concentration on the term GPS improperly dissects Registrant's mark without giving consideration to Registrant's whole mark, GPS USA DIVISION. "The ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 U.S.P.Q.2d 1351, 1353 (Fed. Cir. 200) (finding the TTAB improperly dissected PACKARD TECHNOLOGIES and focused solely on the word PACKARD in finding confusion similarity to HEWLETT-PACKARD); *see also Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 U.S.P.Q.2d 1286 (Fed. Cir. 2016) (finding MAYA and MAYARI not confusingly similar); *In re N.A.D. Inc.*, 754 F.2d 996, 224 U.S.P.Q. 969 (Fed. Cir., 1985) (finding NARKOMED not confusingly similar to NARCO and NARCO MEDICAL SERVICES); *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374 (Fed. Cir. 2017) (finding the TTAB improperly dissected EARNHARDT COLLECTION in opposition by EARNHARDT). This factor alone can be dispositive in determining likelihood of confusion. *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991). *See also Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571, 4 U.S.P.Q.2d 1942 (6th Cir. 1987) ("a trademark 'should not be split up into its component parts and each part then compared with parts of the conflicting mark to determine the likelihood of confusion.") (citation omitted); *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749 (Fed. Cir. 1985) ("Likelihood of confusion cannot be

predicated on dissection of a mark, that is, on only part of a mark.”); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007, 212 U.S.P.Q. 233 (C.C.P.A. 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.”).

Not only must the marks be considered in their entirety as to their similarity, the marks as a whole must also be compared as to their connotation and commercial impression. “It is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof which is important.” *Little Caesar Enterprises, Inc.*, 834 F.2d at 571. In *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 U.S.P.Q.2d 1671 (Fed. Cir. 2015), the Court found the TTAB improperly determined PEACE LOVE AND JUICE was confusingly similar to several PEACE AND LOVE marks, as it only considered the words PEACE and LOVE while ignoring the word JUICE without evaluating the overall commercial impression of the mark as a whole. “[The TTAB] does not display any consideration of how the three-word phrase in Juice Generation’s mark [PEACE LOVE AND JUICE] may convey a distinct meaning—including by having different connotations in consumers’ minds—from the two-word phrase used by GS [PEACE AND LOVE].” *Id.* at 794 F.3d 1341.

Furthermore, when, as here, part of the mark is highly suggestive or merely descriptive, the Examining Attorney may give greater weight to the other part(s) of the mark, the full analysis must evaluate the mark as a whole. “Although it is proper to indicate that more weight is given to a particular component of the mark[,] . . . that does not excuse consideration of the other components of the mark as a whole.” *Packard Press, Inc.*, 227 F.3d at 1357 (citing *Sleepmaster Prods. Co. v. American Auto-Felt Corp.*, 241 F.2d 738, 741, 113 U.S.P.Q. 63, 66, and *National Data Corp.*, 753 F.2d at 1058, 224 U.S.P.Q. at 751).

In the present case, the Examining Attorney only considered the term GPS that appears at the start of both marks, concluding that Registrant’s full mark, GPS USA DIVISION (and design) included disclaimed terms, USA DIVISION, that were not considered in the evaluation. “It is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion.” *Giant Food, Inc. v. Nations’ Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983) (citations omitted).

Additionally, Registrant’s mark includes a design element, as shown below:



The design is significant as to the sight and connotation, and contributes to the commercial impression of the mark as a whole.

With regard to Reg. No. 4914274, the Examining Attorney argued that Applicant's mark and Registrant's mark are identical, and therefore, have the same appearance, sound, meaning, and commercial impression. Applicant concedes that the marks themselves are identical, but argues that alone is not sufficient to refuse registration of Applicant's mark. All of the relevant *du Pont* factors and the evidence submitted in connection therewith must be considered. There are a number of coexisting registrations that demonstrate that consumers are able to decipher from which source the goods or services emanate. Thus, each mark, although identical, has a different commercial impression. The existence of the two marks cited here, Reg. No. 4085602 and Reg. No. 4914274, are evidence of this.

As such, there is no likelihood of confusion between Applicant's mark and Registrants' marks based on this *du Pont* factor.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

The Examining Attorney also claimed that the goods represented by the marks are related. Applicant's services are "business project management," while Reg. No. 4085602 services are "business consultation, namely, business consultation services; business development services, namely, providing start-up support for businesses of others; business management and consultation; business management planning; profit survey and analysis; business marketing consultation services; business organizational consultation; business planning; preparing business reports; providing business marketing information; business auditing; business acquisition and merger consultation; accounting services; and cost accounting"; and Reg. No. 4914274 services are "business training consulting services in the fields of healthcare operations management, leadership, strategy development and execution."

The Trademark Trial and Appeal Board and other courts have permitted trademark use on the same or similar goods or services, even though the marks, in some cases, were identical or nearly identical, and the goods or services shared a related feature or complementary function, demonstrating that there is no *per se* rule that even identical marks result in a likelihood of confusion. These cases make clear that similar or even identical marks for the same or similar goods or services, or those that share related or complementary features, can also be registered:

ALLSTATE (insurance) <i>Allstate Ins. Co. v. Allstate Inv. Corp.</i> , 328 F.2d 608, 141 U.S.P.Q. 280 (5th Cir. 1964).	ALLSTATE (mortgage brokerage services)
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AO (floor coating) <i>Am. Optical Corp. v. Am. Olean Tile Co.</i> , 185 U.S.P.Q. 405 (S.D.N.Y. 1974).	AO (ceramic tile)
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AUTUMN (margarine) <i>Lever Bros. Co. v. Am. Bakeries Co.</i> , 693 F.2d 251, 216 U.S.P.Q. 177 (2d Cir. 1982).	AUTUMN GRAIN (bread)
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BENEFICIAL
(consumer loans)
Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445, 213 U.S.P.Q. 1091 (S.D.N.Y. 1982).

BENEFICIAL CAPITAL
(business loans)

BLUE RIBBON
(beer)
Pabst Brewing Co. v. Decatur Brewing Co., 284 F. 110 (7th Cir. 1922).

BLUE RIBBON
(malt extract)

BRAVO'S
(crackers)
Vitzrooz Corp. v. Borden, Inc., 644 F.2d 960, 209 U.S.P.Q. 969 (2d Cir. 1981).

BRAVO'S
(tortilla chips)

CADET
(storage batteries)
Pep Boys-Manny, Moe & Jack v. Edwin F. Guth Co., 197 F.2d 527, 94 U.S.P.Q. 158 (C.C.P.A. 1952).

CADET
(lighting fixtures)

COLUMBIA
(university)
Trustees of Columbia Univ. v. Columbia/HCA Healthcare Corp., 964 F. Supp. 733, 43 U.S.P.Q.2d 1083 (S.D.N.Y. 1997).

COLUMBIA
(health care services)

CONSUMERS
(fuel oil)
Consumers Petroleum Co. v. Consumers Co. of Ill., 169 F.2d 153, 78 U.S.P.Q. 227 (7TH Cir. 1948).

CONSUMERS
(coal and wood fuel)

ESPRIT
(women's shoes)
H. Lubovsky, Inc. v. Esprit de Corp., 627 F. Supp. 483, 228 U.S.P.Q. 814 (S.D.N.Y. 1986).

ESPRIT
(women's overcoats and rain coats)

FEDERAL
(radio supplies)
Fed. Tel. & Radio Corp. v. Fed. Television Corp., 180 F.2d 250, 84 U.S.P.Q. 394 (2d Cir. 1950).

FEDERAL
(television sets)

HURRICANE
(outboard motors)
Kiekhaefer Corp. v. Willys-Overland Motors, Inc., 236 F.2d 423, 111 U.S.P.Q. 105 (C.C.P.A. 1956).

HURRICANE
(auto engines)

KINGSFORD
(charcoal briquettes)

KINGSFORD
(barbecue sauce)

Kingsford Prods. Co. v. Kingsford, Inc., 715 F. Supp. 1013, 11 U.S.P.Q.2d 1350 (D.Kan. 1989).

LOGO DEVICE (telephone services) <i>Alliance Mfg. Co. v. Allied Tel. Co.</i> , 182 U.S.P.Q. 237 (T.T.A.B. 1974).	LOGO DEVICE (antenna rotators)
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MICRONAUTS (toys) <i>Scott v. Mego Int'l, Inc.</i> , 519 F. Supp. 1118, 213 U.S.P.Q. 824 (D. Minn. 1981).	MICRO NAUTS (hobby items)
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MINI CINEMA (family movie theaters) <i>Modular Cinemas of Am., Inc. v. Mini Cinemas Corp.</i> , 348 F. Supp. 578, 175 U.S.P.Q. 355 (S.D.N.Y. 1972).	MINI CINEMA (erotic movie theatre)
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OLE (tequila) <i>Schenley Distillers, Inc. v. General Cigar Co.</i> , 427 F.2d 783, 166 U.S.P.Q. 142 (C.C.P.A. 1970).	OLE (cigars)
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RIVA (luxury power boats) <i>Riva Boats Int'l Spa v. Yamaha Motor Corp.</i> , 223 U.S.P.Q. 183 (C.D. Cal. 1983).	RIVA (motor scooters)
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SUNBEAM (electric appliances) <i>Sunbeam Lighting Co. v. Sunbeam Corp.</i> , 183 F.2d 969, 86 U.S.P.Q. 240 (9 th Cir. 1950).	SUNBEAM (fluorescent lamps)
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SUNKIST (fruits) <i>Cal. Fruit Growers Exch. v. Sunkist Baking Co.</i> , 166 F.2d 971, 76 U.S.P.Q. 85 (7 th Cir. 1947)	SUNKIST (bakery products)
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Further, in looking at whether goods or services are related to each other, one can describe the underlying goods and services at some common level of generality. For example, one could say that both golf clubs and fishing rods are both sporting goods, or that sugar and pizza are both goods. However, these types of wholesale generalities are consistently rejected by the Board and the courts, based on the rule that no monopoly right exists to a mark. Thus, the fact that products are sold in the same “field” or “industry” does not of itself provide a basis for regarding them as related. *See Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002) (“a broad general market category [electric sound products] is not a generally liable test of relatedness of products”); *Cooper Indus., Inc. v. Repcoparts USA, Inc.*, 218 U.S.P.Q. 81, 84 (T.T.A.B. 1983) (“the mere fact that the products involved in this case (or

any products with significant differences in characters) are sold in the same industry does not of itself provide an adequate basis to find the required ‘relatedness’’).

Applicant’s services are “business project management,” which differs from Registrants’ services. According to the Project Management Institute (PMI), project management “is the application of knowledge, skills, tools, and techniques to project activities to meet the project requirements.” Project management is a separate, distinct profession apart from consulting. When a consultant does not mention “project management” in their listing of services, it is a meaningful omission. When needing help with projects, businesses advertise for and hire “project managers,” and not generic “business consultants.”

Applicant’s services are not broad enough to include the services of either Registrants’ marks. Applicant’s services are restricted to only encompass business project management, which is a distinct practice. In providing project management services, the Applicant organizing the work of other consultants (who provide services aligned with their particular areas of expertise) in order to complete a “project.” According to PMI, a project is a “temporary endeavor undertaken to create a unique product, service or result.” Furthermore, the project management field is replete with various certifications, which can only be obtained by those providing such services.

As such, there is no likelihood of confusion between Applicant’s mark and Registrants’ marks based on this *du Pont* factor.

Based on these arguments, it is clear that Applicant’s marks is not likely to be confused with either Registrant’s mark. Therefore, Applicant respectfully requests the Examining Attorney withdraw the refusal on this basis.

Potential Refusal Under Section 2(d) – Prior Pending Application

The Examining Attorney also cites 2(d) likelihood of confusion with U.S. Application 87279544 as a basis for refusal. Applicant argues that there is no likelihood of confusion for the same reasons there is no likelihood of confusion between Applicant’s mark and either Registrant’s mark (Reg. No. 4085602 and Reg. No. 4914274) listed above.

Refusal under Sections 1 and 45

The Examining Attorney refused registration under Trademark Act Sections 1 and 45, stating that the specimen submitted does not show the applied-for mark in use in commerce in connection with any of the services specified in the application. With this response, Applicant submits a substitute specimen, showing the mark in use on the Applicant’s website. The substitute specimen is a screenshot of Applicant’s website, which shows the mark in the upper left hand corner, and includes a description of the services the Applicant provides. This substitute specimen demonstrates that Applicant provides “business project management” services as listed on the application. Therefore, Applicant respectfully requests the Examining Attorney withdraw her refusal on this basis in light of the submission of this substitute specimen.