

Response to Office Action CRESCENT, Ser. No. 88/282,866

Applicant Apex Brands, Inc. (“Applicant”) is in receipt of the Office Action dated March 11, 2019, issued against the word mark CRESCENT (the “Mark”), Ser. No. 88/282,866 (the “Application”), in which the examining attorney (“Examiner”) preliminarily refused registration based on an alleged likelihood of confusion under Section 2(d) with six cited prior registrations and one cited prior-filed application. The Examiner also requested revisions to the specification of goods in the Application. Applicant responds to the Office Action as follows:

I. Deletion of Class 25 Goods

As an initial matter, Applicant will delete all Class 25 goods enumerated in its Application.

By deleting Class 25 in its entirety from the Application, Applicant believes it has mooted the Section 2(d) refusal with respect to registration numbers 2929376, 4685944, 4595529, and 4301690, as well as the prior-filed application number 88065210. All of the aforementioned registrations and prior-filed application were cited by the Examiner as a bar to registration for the Application with regard to Class 25 only. Since the Class 25 goods have been deleted, these registrations and the prior-filed application are no longer relevant, so the Examiner should withdraw the basis of the refusal with regard to those cited applications.

II. Revisions to Specification of Class 18 Goods

Per the Examiner’s request, Applicant agrees to delete “bags” from its Class 18 specification of goods, as well as make the following revisions to the remaining goods:

Class 18: Bags for tool storage sold empty; cases of leather for tool storage sold empty; backpacks; tool bags, empty

As further explained below, the deletion of “bags” from the specification of goods supports the withdrawal of the Section 2(d) refusal with respect to cited mark No. 2921440.

III. No Likelihood of Confusion With Cited Mark No. 2921440

Given Applicant’s deletion of all Class 25 goods from the Application, the only remaining registration cited by the Examiner in connection with the Section 2(d) refusal for Class 18 is registration No. 2921440 (the “Cited Mark”). However, confusion is not likely because the Mark and Cited Mark differ in terms of sight, sound, meaning, and connotation. Moreover, the goods covered by the Mark and Cited Mark are not commercially related, travel through different channels of trade, target different consumers, and are not the types of goods consumers would believe emanate from a single source.

A. The Mark is Distinguishable From the Cited Mark in Terms of Sight, Sound, Meaning, Connotation, and Overall Commercial Impression

Although both marks share the common element “CRESCENT,” the Cited Mark contains additional matter that distinguishes it from the Mark, including the words “MOON YOGA.” Even when two marks share a common element, additions to one mark can be sufficient to avoid a likelihood of confusion when the marks in their *entireties* convey significantly different commercial impressions. See *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir. 2004).

In *Shen Mfg.*, the Court held that the marks THE RITZ KIDS and RITZ were distinguishable despite the fact that the marks covered “legally identical” goods and contained the identical word “RITZ.” As an initial matter, the Court rejected the TTAB’s original dissection of the mark “THE RITZ KIDS” by viewing the word “RITZ” in isolation, holding instead that the mark must be viewed in its entirety to fully understand the mark’s overall commercial impression. To that end, the Court reasoned that the overall commercial impression of the composite mark THE RITZ KIDS was indicative of wealth and was affiliated by the registrant’s identity as The Ritz Hotel, whereas the defendant’s RITZ mark did not suggest the same commercial impression or association. *Id.*

Just as the Court rejected the dissection of the mark THE RITZ KIDS in *Shen Mfg.*, the Examiner likewise should not dissect the Cited Mark into separate component parts but rather should consider the overall commercial impression of the Cited Mark as a whole. Applicant respectfully disagrees that the word “CRESCENT” is the dominant portion of the Cited Mark. Instead, the dominant portion of the Cited Mark is the unitary term “CRESCENT MOON.” The term “crescent moon” refers to one of the phases of the moon, specifically when the moon is illuminated less than fifty percent. Attached hereto as Exhibit 1 is a Wikipedia article that explains the phases of the moon, including the crescent moon, available online at https://en.wikipedia.org/wiki/Lunar_phase. School children often learn about the phases of the moon in elementary school science classes, so the phrase “crescent moon” has a known meaning to consumers and creates a distinct commercial impression of a partially illuminated moon. Conversely, the term “crescent” by itself has multiple potential meanings and connotations, including a general shape, the emblem of Turkey, a musical percussion instrument, or a curved street. The term “crescent” can also be used as an adjective to mean increasing or growing. Attached hereto as Exhibit 2 is a list of the various dictionary definitions that can be attributed to the term “crescent,” available online at <https://www.dictionary.com/browse/crescent>. Thus, when the Cited Mark is properly considered in its entirety, it has a specific meaning and gives the commercial impression of a *crescent moon*, whereas the Mark is open to interpretation and devoid of any specific meaning or commercial impression. At the very least, the Mark has no immediate or obvious relationship to the *moon*, unlike the Cited Mark. The addition of the term “MOON” in the Cited Mark therefore distinguishes it from the Mark in terms of sight, sound, meaning, connotation, and overall commercial impression. This negates any finding of likelihood of confusion.

The Examiner should also not discount the “YOGA” portion of the Cited Mark. In *Shen Mfg.*, the Court overturned the TTAB’s decision finding the marks THE RITZ KIDS and RITZ confusingly similar. The Court reasoned, in part, that the Board failed to consider the mark THE

RITZ KIDS in its entirety and assess its overall commercial impression. To that end, the Court, unlike the Board, found that “while ‘kids’ is undeniably used to indicate that the product is geared toward children, it distinguishes [cross appellant’s] mark from [appellant’s]; it is unlikely that consumers would mistakenly believe that [appellant], the manufacturer of kitchen textiles, has expanded into children’s clothing.” *Shen Mfg.*, 393 F.3d at 1245. Here, the term “YOGA” likewise distinguishes the Cited Mark from the Mark. That term “YOGA,” even if descriptive in the Cited Mark, underscores the Cited Mark’s association with yoga as well as “gym bags” and “athletic bags,” the very goods covered by the Cited Mark. It is highly unlikely that consumers would mistakenly believe that Applicant, one of the largest manufacturers of professional hand and power tools in the world, has expanded into the realm of yoga. The Mark, unlike the Cited Mark, has no immediate or obvious relationship to *yoga* in any way. The addition of the term “YOGA” in the Cited Mark therefore distinguishes it from the Mark in terms of sight, sound, meaning, connotation, and overall commercial impression. This negates any finding of likelihood of confusion.

Visually and aurally the marks are also distinguishable when the Cited Mark is properly taken as a whole. Specifically, the Cited Mark contains other words in addition to “CRESCENT,” “making both its visual appearance and pronunciation longer.” See *Shen Mfg.*, 393 F.3d at 1242 (finding the marks RITZ and PUTTING ON THE RITZ both visually and aurally distinguishable despite the common “RITZ” component). As previously argued, the terms “MOON” and “YOGA” should not be discounted or dissected from the Cited Mark. They are integral portions of the Cited Mark and combine to create an overall commercial impression that is highly distinguishable from the Mark, negating any finding of likelihood of confusion.

In sum, confusion is not likely because the Mark and the Cited Mark are distinguishable in terms of sight, sound, meaning, connotation, and overall commercial impression. For these reasons the Examiner should withdraw the Section 2(d) refusal and permit the Application to proceed to publication for Class 18.

B. The Goods Covered by the Mark and the Cited Mark are Not Commercially Related, Travel Through Different Channels of Trade, Are Directed to Different Consumers, and Are Not the Types of Goods Consumers Would Believe Emanate From a Single Source

As an initial matter, Applicant believes that the deletion of “bags” fully resolves the Examiner’s concern regarding the relatedness of the goods. The Examiner only cited the “broad wording to describe bags” as the source of the alleged relatedness of the goods between the Mark and the Cited Mark. Applicant’s deletion of “bags” from the Application resolves this issue, and therefore the refusal should be withdrawn.

The remaining goods in the Application are not commercially related to the goods covered by the Cited Mark because consumers would not believe the parties’ goods would emanate from the same source. Here, the goods used in connection with the Cited Mark are restricted to “athletic bags” and “gym bags,” whereas the goods enumerated in the Application are limited to

“bags for tool storage.” Athletic and gym bags and bags for tool storage have different uses, travel in different channels of trade, and are marketed to different classes of consumers. A consumer would not take a bag for tool storage to the gym, nor would a consumer store tools in a gym bag or athletic bag.

The restriction on the goods in the Cited Mark is underscored by the inclusion of the term “YOGA” in the Cited Mark. There is an obvious connection between the word “YOGA” as used in the Cited Mark and “athletic bags” and “gym bags.” Consumers would not expect to find “athletic bags” and “gym bags” marked with the word “YOGA” in a factory, workshop, or hardware store, yet these are the very places where consumers would encounter Applicant’s Mark. These differences in goods along with the fact that the Cited Mark and Mark are unlikely to travel in similar channels of trade or be marketed to similar classes of consumers mitigates against any likelihood of confusion.

Finally, it is incumbent on the Examiner to “provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.” TMEP § 1207.01(a)(vi); *see also In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding the examiner had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Here, the Examiner has not provided any evidence showing that “athletic bags” and “gym bags” are related to “bags for tool storage” or that such products would emanate from a single source under a single mark. The reality is that no such evidence exists because these types of goods have different purposes, travel in different channels of trade, and are marketed to different classes of consumers.

In sum, likelihood of confusion does not exist because the Mark and the Cited Mark are not used in connection with commercially related goods, travel through different channels of trade, and are direct towards different consumers. For these reasons the Examiner should withdraw the Section 2(d) refusal and permit the Application to proceed to publication for Class 18.

IV. Conclusion

Applicant has fully addressed and resolved all the issues raised in the office action and therefore requests that the Mark be approved for registration on the principal register with respect to the revised goods covered in Class 18.