

The examiner cited U.S. Registration 4823170 for SISU & Design (the “Cited Mark”) against Applicant’s SISU mark (“Applicant’s Mark”) on the belief that Applicant’s Mark is so resembles the Cited Mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services.

The crucial factor in trademark cases is whether “an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused as to the source of the goods in question.” *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978), cert. denied, 439 U.S. 1116; see also *McGregor-Doniger, Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1130 (2d Cir. 1970). The likelihood of confusion issue is “always one that is unique to each set of facts.” *Stern’s Miracle-Gro Prods., Inc. v. Shark Prods., Inc.*, 823 F. Supp. 1077, 1089 (S.D.N.Y. 1993).

With regard to the cited registration, Applicant respectfully submits that there is no potential likelihood of confusion with Applicant’s mark because of:

- (1) dissimilarities of the marks in their entirety as to appearance, connotation, and commercial impression;
- (2) dissimilarities in the goods covered under the marks;
- (3) differences in the channels of trade;

When considering the similarity of the marks, “[a]ll relevant facts pertaining to the appearance and connotation must be considered.” *Recot, Inc. v. M.C.U. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000); see also TMEP §1207.01(b) (2011). When analyzing the potentially conflicting marks, the examiner will focus on the appearance, sound, connotation, and commercial impression of the marks. *McGregor-Doniger, Inc.*, 599 F.2d at 1130. “Even close similarity between two marks is not dispositive of the issue of the likelihood of confusion Whether the similarity is likely to provoke confusion is the crucial question.” *Id.* at 1133 (emphasis added). In making this determination, it is important to look at the marks in their entirety, the way consumers would encounter them, to understand the overall impression. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987).

The registered mark appears as:



Applicant's mark as it is used and appears on the specimens submitted with the application appears as:



In the registered mark it is very difficult to see the lettering SISU. In Applicant's mark the lettering couldn't be clearer.

In the Registrant in its mark has created a symbol that stands for the meaning of the word SISU, namely "strength of will", "determination", "unwavering perseverance", and "acting rationally in the face of adversity".

The key fobs sold by the Registrant contain a blazoned image of the symbol. In fact it seems clear that the symbol is itself the value of the Registrant's product, people buy the key fobs to identify with the characteristics represented by the symbol: namely "strength of will", "determination", "unwavering perseverance", and "acting rationally in the face of adversity". The other products listed in the registration are similarly adorned with the symbol in an ornamental manner.

Thus, the purchasers of the Registrant's products are buying the product to display the symbol, as a reminder of traits they themselves hold valuable or aspire to.

In the case of Applicant's mark, the word and meaning pertain to quality and workmanship of the product itself and have represented quality watches for over 8 years.

The Registrant's goods in class 014 are key fobs made of rubber with a metal key ring. Although Applicant is unable to find the key fobs for sale in the marketplace currently, the specimen submitted on that application has a price tag of \$1.00: Applicant's watches cost over \$1000.00

Applicant and Registrant have co-existed since 2015, when the Registrant claims first use, and there has never been any instance of actual confusion. Which could be expected given the vast differences in the manner in which the marks appear, and the price point and purpose of the respective products.

The registrant applied for its highly stylized symbol during the time this Applicant's prior registration was active, and at that time there was no refusal issued, no likelihood of confusion found between registrant's design and this Applicant's word mark.

Applicant believes that if these factors are carefully considered, the meaning of the letters has a different connotation, one being a symbol identified with the person buying the product, traits they seek or value, and one where the word SISU is reflective of the quality of the watches listed for Applicant's mark. The purpose of the products are therefore different, one being an ornamental rubber key fob, the other a luxury time piece, and the price point, and channel of trade are altogether different. Where Applicant's watches are something found under glass at a jeweler, the Registrant's key fobs can presumably be found at ETSY or a craft show, a metaphysical bookstore or yoga studio.

There has been no actual confusion and there is reasonable likelihood that the source of the Registrant's goods, and Applicant's goods would be confused as the same. They appear different, on different products for different purposes. There are noticeable differences between Applicant's Mark and the Cited Mark with respect to appearance, connotation and commercial impression, and when coupled with the dissimilarities in the goods covered under the marks, the dissimilarities in the channels of trade, there should be no likelihood of confusion between Applicant's Mark and the Cited Mark.

Accordingly, Applicant respectfully requests that its application be allowed to proceed to publication