

UNITED STATES PATENT AND
TRADEMARK OFFICE

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Estate of Vincent Paul Abbott
Estate of Darrell Abbott

Mark: PANTERA
Ser. No: 88/238,364
Filing Date: December 21, 2018
Law Office: 106
Examining
Attorney: Sally Shih

RESPONSE TO OFFICE ACTION

Applicant respectfully submits this Response to Office Action, mailed on March 18, 2019, concerning Application Serial No. 88/238,364, to register the mark PANTERA in International Classes 25.

I. LIKELIHOOD OF CONFUSION

The Examining Attorney initially has refused registration of the mark PANTERA that is the subject of this application in International Class 25 (“Applicant’s Mark”) on the ground that it is likely to be confused with U.S. Registration No. 3,518,906 for PANTHERS for goods in Class 25 owned by Panthers Football, LLC (“Panthers Football”), under Trademark Act Section 2(d), 15 U.S.C. 1052(d); TMPEP § 1207 (the “Cited Mark”).

Applicant respectfully disagrees with the Examining Attorney’s preliminary refusal. Applicant’s Mark is not confusingly similar to the Cited Mark, because of, *inter alia*,: (A) there are sufficient differences in sight, sound and commercial impressions of each mark; (B) the consumers and conditions of sale are different; (C) Applicant’s Mark and the Cited Mark have co-existed in the marketplace for many years without confusion; and (D) the Cited Mark is entitled to only a narrow scope of protection.

A. The Marks Are Sufficiently Dissimilar.

An important factor in determining whether there is a likelihood of confusion between marks is the degree of similarity between the marks. *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 501 (5th Cir. 1979). It is well settled that the use of identical, even dominant, words in common does not automatically mean that two marks are confusingly similar. See *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987), citing *Freedom Savings & Loan Assoc. v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985). In analyzing the similarity of marks, one must compare the marks in terms of sight, sound, connotation, and overall commercial impression. *Du Pont*, 476 F.2d at 1361 (C.C.P.A. 1973); TMEP § 1207.01(b)(i) (“The points of comparison for a word mark are appearance, sound, meaning, and commercial impression”). Furthermore, the marks must be compared in their entireties as they appear in the marketplace, *id.*, and both “the similarities and dissimilarities between the two marks must be considered.” *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (K+ not confusingly similar to K+EFF because the K+EFF mark contained both literal and design elements different than those present in the K+ mark). Even the use of identical marks in the same or related fields does not mean that purchasers will likely be confused as to the source of the goods. *In re Shoe Works*, 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (wearing apparel) (no likelihood of confusion between PALM BAY women’s shoes and PALM BAY shorts and pants); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (wearing apparel) (no likelihood of confusion between PLAYERS for shoes and PLAYERS for men’s underwear).

1. The Marks are Readily Distinguishable in Terms of Sight and Sound

Without question, there are visual and phonetic differences between Applicant’s Mark and the Cited Mark, which render the marks not confusingly similar to one another. Here the Cited Mark is PANTHERS which consists of two syllables with the accent being placed on the first syllable (PAN-

thers). Applicant's Mark consists of three syllables in Applicant's Mark with the accent being placed on the second syllable (Pan-TE-ra). Furthermore, the English translation of the Spanish word Pantera in Applicant's Mark is the singular "Panther" as opposed to the plural "Panthers" in the Cited Mark. These differences in sound, grammatical number and translation are evidence that the marks are not likely to be confused. *See, e.g., Lebow Bros., Inc. v. Lebole Euroconf S.p.A.*, 503 F. Supp. 209, 212 (E.D. Pa. 1980) (finding no likelihood of confusion between LEBOW and LEBOLE, due in large part to the differences in pronunciation of the two terms); *see also Republic Steel Corp. v. M.P.H. Mfg. Corp.*, 312 F.2d 940, 942 (C.C.P.A. 1962) (finding no likelihood of confusion between TRUSON and TRUSS-SKIN due, in part, to the fact that the words were likely to be pronounced differently because "normal of casual pronunciation would distinctly emphasize a difference in sound.").

Furthermore, these differences highlight why the doctrine of foreign equivalents should not apply in this case. The doctrine is not a mechanical doctrine and should not be treated as such by the Examining Attorney. 4 J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.36 (4th ed. 2007). "[T]he doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline." *Palm Bay Imports, Inc. v. Veuve Clicquot Pnsardin Maison Fondée en 1722*, 396 F.3d 1369, 1377 (Fed. Cir. 2005). When the words sound different, and have a different number of syllables, and in fact are not exact foreign equivalents given the difference in number, it makes little sense to apply the doctrine of foreign equivalents. Furthermore, the foreign equivalent of Panthers is "Panteras" not "Pantera."

2. The Marks Create Different Connotations

Applicant's Mark is not only different from the Cited Marks in sight and sound, but it is also different in commercial impression. "Even marks which are identical in sound and/or appearance, which

is not the case here, may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." TMEP § 1207.01(b)(v); *see e.g., In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (T.T.A.B. 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing). *See also In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987) (holding that CROSS-OVER for bras and CROSSOVER for ladies' sportswear created different commercial impressions, notwithstanding the fact that they were "legally identical in sound and appearance," because they had "different meanings when applied to the goods of applicant and registrant.").

Although Applicant's Mark and each of the Cited Marks are both used in connection with apparel, Applicant's Mark is a reference to a well-known and commercially successful heavy metal band of the same name, Pantera (the "Band"). The Band was formed in 1983 and continued for approximately 20 years. The Band released nine (9) albums during that span which have collectively sold in excess of nine million (9,000,000) copies and was nominated for four (4) Grammy awards. The Band performed and played in front of hundreds of thousands of fans nationwide and world-wide. The Band is still well-known and recognized, despite disbanding in 2003; every result returned in the first three pages of search results for "Pantera" on Google refer to the Band.

Additionally, Applicant owns and has filed two trademark applications for registration of the mark PANTERA in standard characters (1) in Class 16 for "Notebooks; Posters; Stickers" (Ser. No. 88/313,290), which was published for opposition on September 3, 2019, and (2) in Class 41 for "Entertainment services, namely, providing information about a recording artist via an online network; Entertainment services, namely, providing non-downloadable playback of music via global communications networks; Production of sound and music video recordings; Rental of musical recordings that may be downloaded from an Internet web site" (Ser. No. 88/975,686), which was approved for publication on September 17, 2019. It is the Band that Applicant seeks to promote and exploit through

use of Applicant's Mark on apparel. Accordingly, consumers will immediately recognize Applicant's Mark as coming from Applicant.

The Cited Mark, on the other hand, is used connection with promoting and marketing a member club of the National Football League, Panthers Football LLC, better known as the "Carolina Panthers" or "Panthers." It is used in connection with the "Carolina Panthers" NFL football team, other NFL marks and/or insignia, or other indicia of football. It has no meaning outside of reference to the Carolina Panthers, and has no connection to anything involving musical groups and/or music in general.

Accordingly, there can be no doubt that the different elements which make up Cited Mark and Applicant's Mark cause them to have a different commercial impression from one another. This further makes confusion between the marks unlikely.

B. The Consumers and Conditions of Sale are Different.

1. The Applicant and Panthers Football Target Different Consumers

If the goods in question are not 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 among identical marks, confusion is not likely. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1207.01(a) (i) (emphasis added); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 U.S.P.Q.2d 1668 (T.T.A.B. 1986) (QR for coaxial cable held not confusingly similar to QR for various products related to the photocopying field).

Courts have held that different channels of trade, selling strategies and advertising techniques reduce the likelihood of confusion, particularly when the owners of the respective marks "target" different

groups for the sale of their goods. *Alltel Corporation v. Actel Integrated Communications, Inc.*, 42 F. Supp.2d 1265, 1271 (S.D. Ala. 1999); *Aero-Motive Co. v. U.S. Aeromotive, Inc.*, 922 F. Supp. 29, 42 (W.D. Mich. 1996); *Dieter v. B & H Industries of Southwest Florida, Inc.*, 880 F.2d 322, 326 (11th Cir. 1989). Confusion is also far less likely among more sophisticated consumers. *Polaroid v. Polarad Elects. Corp.*, 287 F.2d 492 (2d Cir.), cert. denied, 368 U.S. 820 (1961).

There is no likelihood of confusion between Applicant's Mark and the Cited Mark primarily because it is plainly evident that Applicant intends to use its mark to promote and garner support for the Band. Applicant's target consumer group is fans of heavy metal music and those that may be purchasing products for heavy metal fans they know.

Panther Football, on the other hand, is an NFL sports franchise company that offers its apparel to promote and garner support for its football team. Applicant's target consumer group is football fans and those that may be purchasing products for football fans they know.

Thus, the target groups in issue are very distinct groups which are different in interests and focus.

2. The Applicant and Cartier Offer Their Products in Different Channels of Trade

Applicant sells and markets PANTERA through the Band's website at www.pantera.com and through officially licensed merchandise stores that feature merchandise from musical artists and groups. Consumers encountering Applicant's Mark will likely already have familiarity with Applicant's Mark. These same fans, already familiar with the current trademarks of musical artists and groups, are drawn to products and services bearing Applicant's Mark because of the enormous popularity and international reputation of the Band. These consumers seek out and are fully aware of the origin of Applicant's merchandise. Thus, it is highly doubtful that consumers would confuse Applicant's merchandise with

those offered in connection with the Cited Mark.

Panther Football sells and markets goods in connection with its PANTHERS products at officially licensed NFL sports outlets, NFL games, through the Carolina Panthers or the NFL websites, or at other sports outlets that offer football related fan paraphernalia. These channels of trade have nothing to do with music and musical artists and groups, and Applicant's merchandise would not be available for purchase via such channels.

Further, even the use of identical marks in the same or related fields, does not mean that purchasers will likely be confused as to the source of the goods. The Federal Circuit has recognized that the mere fact that an applicant and a registrant conduct business in the same general field does not establish similarity of trade channels or overlap of customers for purposes of showing likelihood of confusion. *Electronic Design & Sales, Inc.*, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992). Even if Applicant and Registrant intended to conduct business in the same field (which, as explained above, they do not), there is no true similarity in the channels of trade in which the potential like products of the parties would be offered, or in the consumer groups to which they are marketed.

In *Electronic Designs*, the Court of Appeals held that likelihood of confusion was not shown between the Applicant's E.D.S. mark for battery chargers and power supplies which are incorporated into medical instruments and devices and the cited EDS mark for computer services sold to customers in medical and other fields. The Court determined that confusion did not result based upon the differences between the goods and services and the sophisticated nature of the goods, services and purchasers thereof. *Id.* at 1391-92. The same reasoning applies here.

Although both parties could distribute certain types of clothing, this does not demonstrate that likelihood of confusion will exist. Likelihood of confusion means probable confusion, rather than the

mere possibility of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

C. Applicant's Mark and the Cited Marks Have Coexisted in the Marketplace for Years Without Confusion

As further confirmation that Applicant's Mark and the Cited Mark are not likely to be confused, and as discussed above, Applicant submits that it owned a prior registration for the mark PANTERA in standard characters in Classes 16, 25 and 41 (Registration No. 3,404,472), registered on April 1, 2008. This registration was cancelled on November 2, 2018 for failure to file Declarations of Use and/or Excusable Nonuse/Application for Renewal under Sections 8 & 9. Such failure was inadvertent, and Applicant has consistently and continuously used Applicant's Mark in all three Classes including Class 25 nationally since 1983. During this period, Applicant is unaware of any instances of actual confusion with the Cited Mark.

The Board has recognized that the absence of any known instance of actual confusion after many years of contemporaneous use of the marks is "strong evidence that confusion is not likely to occur in the future. *In re American Management Associations*, 218 U.S.P.Q. 477, 478 (T.T.A.B. 1983).

Accordingly, Applicant's Mark is not likely to cause confusion with the Cited Marks because they have already coexisted in the marketplace for years without any actual confusion.

D. The Cited Marks are Entitled to Only a Narrow Scope of Protection.

As further evidence that Applicant's Mark is not likely to be confused with the Cited Mark, Applicant submits that the Cited Mark already coexist, previously both on the Principal Register, and in the marketplace, with one another. This coexistence demonstrates that the Cited Mark is only entitled to a

narrow scope of protection and that small differences between the marks are enough to avoid a finding of likelihood of confusion. *See* TMEP § 1207.01(d)(iii). *See also Miss World (UK) Ltd. V. Mrs. Am. Pagents, Inc.*, 8 U.S.P.Q.2d 1237, 1241 (9th Cir. 1988) (“In a crowded field of similar marks, each member of the crowd is relatively weak in its ability to prevent use by others in the crowd.”). Accordingly, Applicant’s Mark can also coexist with the Cited Marks without a likelihood of confusion.

II. Conclusion

For the foregoing reasons, Applicant respectfully requests that the refusal be withdrawn and that its application be approved for publication.