

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : GRAVITY
Serial No. : 88306860
For : Estrada Mangual Daisy
Examiner : Sara Anne Helmers
Law Office : 126

RESPONSE TO OFFICE ACTION DATED 5/1/2019

This is responsive to Office Action dated 5/1/2019. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Estrada Mangual Daisy seeks registration of U.S. Serial No.88306860 for GRAVITY with designs in relation to "Necklaces; Necklaces made of stainless steel, leather; Choker necklaces" in Class 14 and "Graphic T-shirts" in Class 25. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *see* TMEP § § 1207.01 *et seq.*

Table 1

| Registration No. | Mark | Identification of Services | Owner |
|------------------|-----------------|---|------------------------|
| 4539182 | GRAVITY | Class 14: Jewelry | FMTM Distribution Ltd |
| 5688532 | GRAVITY | Class 14: Timepieces and chronometric instruments, namely, watches, wrist-watches and chronometers | FMTM Distribution Ltd |
| 5159789 | GRAVITY TRADING | Class 25: Hats; Headwear; Scarfs; Ties; Bottoms; Braces; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Gloves as clothing; Tops; Women's clothing, namely, shirts, dresses, skirts, blouses | Gravity Trading, Inc. |
| 4655693 | GRAVITY THREADS | Class 25: Clothing, namely, shirts, leggings, belts, money belts; and children's, toddler's and infant's apparel, namely, jumpers, sleepwear, pajamas, rompers and one-piece garments | Gravity Trading, Inc. |
| 3227383 | GRAVITYGEAR | Class 25: Clothing, namely, tank tops, pants, T-shirts, tops, sports jackets, short-sleeved or long-sleeved T-shirts, muscle tops, polo shirts, jackets, caps | TOTAL GYM GLOBAL CORP. |

APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF CONFUSION

Applicant respectfully disagrees with the Examining Attorney's decision for the reasons discussed below.



1. Applicant's Mark is Different in Sight, Sound and Impression

Applicant's trademark consists of wavy lines with tribal shape on the top and bottom of the word "GRAVITY".

While neither of the marks cited above in Table 1 consists of similar features.

In comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for compare the marks for resemblance in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity in one respect - sight, sound, or meaning - does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 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."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

The basic principle in determining confusion between marks is that marks must be compared in their entireties. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. *In Re National Data Corporation*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). Applicant's mark must be considered in the way in which it is perceived by the relevant public, and not considered after hyper-technical dissection. *In Re Shell Oil Company*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (The marks must be considered in the way in which they are perceived by the relevant public); See, also *In re Best Products, Co., Inc.* 231 USPQ 988 (TTAB 1986)

(BEST JEWELRY and design for retail jewelry store services held not likely to be confused with JEWELERS BEST for jewelry). Furthermore, phonetic similarity alone is insufficient to establish likelihood of confusion. See, *Old Tyme Food, Inc. v. Roudy's Inc.*, 961 F.2d 200, 203 (Fed. Cir. 1992).

Here, applicant's trademark looks apparently different from each of the cited marks in their entireties and consumers should be able to differentiate each of them easily.

Additionally, there is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole or part of another mark. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to incorporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). *In Hearst*, Applicant registered VARGA GIRL for calendars and was

refused registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion.

Here, applicant's GRAVITY Mark contains the whole or part of the cited registered marks by including the literal elements GRAVITY, however, we should not inappropriately change the mark by diminishing the portion of the design features and stylization of the wordings in applicant's mark. This partially similar term is not enough to support a finding of likelihood of confusion.

Thirdly, the cited registrations belong to different entities and they coexist for quite a long period of time without creating any confusions. Therefore, there is no reason to say that the registration of merely one more trademark that containing the literal elements of GRAVITY will create confusion.

Applicant submits that the differences in sight, sound, appearance and connotation of Applicant's GRAVITY designed Mark is distinct and different enough from the cited registered marks such that there is no likelihood of confusion.

**The dissimilarity and nature of the goods or services as described in an
application or registration**

If the marks of the respective parties are very similar or virtually identical, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009). The obviously differences of the goods and

services as described in the application and registration can be an important factor which is a key consideration in any likelihood of confusion determination.

If the goods or services in question are not related or 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 if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

Here, each of the marks owned by different entities covers for different goods and services, and

that's also the reason why they can coexist with each other. Although the trademarks share the same literal element as "GRAVITY", they are written in different forms and the goods identified in each registration are different or limited enough to differentiate them from one another. The co-existence of the cited registrations which belong to three different entities is also an evidence to show that merely sharing some common elements will not cause likelihood of confusion.

CONCLUSION

Given the above arguments, Applicant's GRAVITY Mark is unlikely to cause consumer confusion. For the foregoing reasons, Applicant respectfully requests reconsideration of the refusal to register Applicant's GRAVITY Mark under Section 2(d) of the Trademark Act.

Respectfully submitted: Estrada Mangual Daisy