

RESPONSE TO OFFICE ACTION

Applicant submits this response to the office action dated June 19, 2019. Reconsideration of this application is respectfully requested in view of the following remarks and evidence. Applicant would argue that the mark is not likely to be confused with the Cited Registration.

2(d) Refusal—Class 25

The Examining Attorney refuses registration of BAUM, in class 25 for “bottoms as clothing; headwear; hooded sweatshirts; pants; shirts; sweaters; tops as clothing.” (“Applicant’s Mark”) The refusal is based on an alleged likelihood of confusion with U.S. Reg. No. 3291220 for the mark BAUM UND PFERDGARTEN for “Clothing, namely, jeans, trousers, coats, jackets, skirts, dresses, pants, vests, coveralls, overalls, shirts, blouses, sweaters, sweatshirts, T-shirts, polo-shirts, shorts, underwear, ties; fashion accessories, namely, gloves, scarves, socks, belts, and hats.” (the “Cited Registration”).

While Applicant acknowledges that the Cited Registration shares similarities in the goods themselves, Applicant submits additional information for the Examining Attorney’s consideration, which, when considered under the relevant *DuPont* factors, reveals that there is no likelihood of confusion between Applicant’s Mark and the Cited Registration. Applicant, therefore, respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s Mark in class 25 because Applicant’s Mark is not likely to be confused with the Cited Registration: (1) there are substantial and significant differences in the marks in regards to sight, sound, and commercial impression; (2) the differences in channels of trade also show that there is no likelihood of confusion; and (3) the degree of purchaser care tips the scale squarely in favor of the Applicant in this case. Accordingly, when all the facts are evaluated and the marks at issue are considered as a whole, it becomes clear that there is no likelihood of confusion as to source.

Differences in Sight, Sound and Commercial Impression of the Marks

In examining the two marks, the marks must be viewed in their entirety. *In re Professional Wrestling Hall of Fame*, 2004 TTAB LEXIS 353 (TTAB June 23, 2004); see also *Official Airline Guides, Inc. v. Churchfield Publ., Inc.*, 6 F.3d 1385, 1392 (9th Cir. 1993) (stating that “under the anti-dissection rule, the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace.”). Here,

Applicant's Mark and the Cited Registration differ as to appearance, sound, connotation, and commercial impression. Similarity of the marks in one aspect will not automatically result in a finding of a likelihood of confusion even where the goods are closely related. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987).

Here, the marks at issue differ in several ways. To start, Applicant's mark is BAUM. Meanwhile, the Cited Registration is BAUM UND PFERDGARTEN. In the Examining Attorney's examination, they have omitted two necessary terms that distinguish the Cited Registration, the wording UND and PFERDGARTEN, to find that Applicant's and the Cited Registration are likely to be confused based on the similar term BAUM. The marks at issue are clearly different, as the Cited Registration includes the additional Danish terms UND PFERDGARTEN, which denotes a clear difference between the marks. The use of the Danish language in the Registrant's Mark makes differences clear and plays up origin of the Registrant themselves. The Registrant is a Danish fashion house, with its main offices in Copenhagen. *See* Exhibit A, Wikipedia article regarding Registrant. Thus, when the Cited Registration is viewed in the actual marketplace, consumers will see the entire term BAUM UND PFERDGARTEN, with a distinctly different connotation, Danish origin story, and clearly demonstrating to the consumer that the goods and services provided under the Cited Registration are easily distinguishable from the goods provided under Applicant's Mark. *See* Exhibit A, image from Registrant's website. The Danish background to the Registrant's mark is the key to Registrant's mark, to play up the fashion forward thinking of those European and Scandinavian countries.

Further, the commercial impression of each mark is vastly different when encountered by consumers in the marketplace. Even though both marks include the term BAUM, that does not necessarily mean that the marks are the same or give off the same commercial impression. In fact, Applicant will use the mark BAUM to identify a music artist, Bailey Baum, and her fans in relation to the goods provided by Applicant. On the other hand, Registrant's use of BAUM is used in conjunction with the other Danish terms UND PFERDGARTEN, to create a commercial impression of fashion forward thinking European clothing company. The Cited Registration's decision to highlight the Danish origins to their Mark clearly shows that the Registrant intends to play up its role as a cutting edge fashion machine. This point is further driven home when reviewing Registrant's specimen on file, which include excerpts from Registrant's website that display artistic fashion pieces showing new designs selling for very high dollar amounts, on

average of \$200 per piece. *See* Exhibit B, containing Registrant's specimen on file. Thus, the complete commercial impression of Registrant's mark is that of new and trendy fashion company that has the high prices to match its ambitions. Therefore, when viewed in the marketplace, the differences in the marks are so great as to dispel confusion among consumers.

Differences in Trade Channels

The channels of trade in which Applicant's and Registrant's products will be offered differ so much as to preclude a likelihood of confusion. Registrant's products are provided in large upscale chain retail stores, such as Nordstrom's. *See* Exhibit C, showing a screen print out from a Baum Und Pferdgarten search on Nordstrom's website. Granted, Applicant will likely have a website; however, this website will not be marketed to the same group of individuals. Applicant is seeking and gearing their products to those individuals that are fans of Bailey Baum and her music. Additionally, Applicant will provide her products directly to her fans via merchandise sells at shows and social media. Meanwhile, Registrant's market is clearly those fashionistas that prefer to stay ahead of fashion trends. Due to the fact that both Applicant and Registrant are looking to fill unique needs for consumers, there is no chance a consumer is likely to confuse their products.

Purchaser Care

In determining likelihood of confusion, courts must decide whether there is a likelihood of confusion in the minds of the purchasers of the services sold under the marks of Applicant and registrants. Courts will generally apply a typical buyer standard. However, as in the instant case, factors such as the purchaser care can reduce the likelihood of confusion and result in the registration of what otherwise would be similar marks. *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841 (TTAB 1988). Circumstances suggesting care in purchasing can minimize likelihood of confusion. TMEP § 1207.01(d)(vii).

Neither Applicant's nor Registrant's products could be considered impulse purchases. Applicant's products will be available via merchandise sells at Applicant's live shows and via Applicant's social media outlets. Therefore, a consumer must first be a fan of Bailey Baum and know her music before being aware of the BAUM brand at all. Consumers of the Baum brand will be real fans and it is unlikely that they would confuse their favorite music artist for a high fashion brand. Further, Registrant's products are expensive and intended for those people with high fashion sense, with some pieces listed as high as \$800. *See* Exhibit D, showing Registrant's

webstore and other listings from Nordstrom's. Moreover, the costs associated with Registrant's products are high and therefore it is highly unlikely that consumers would purchase the clothing without first knowing exactly what they are purchasing. Thus, a consumer is highly unlikely to purchase either Registrant's or Applicant's software without doing copious amounts of research before making such a substantial decision.

“There is always less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Astra Pharm. Prod. Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786, 791 (1st Cir. 1983). Clearly, the level of purchaser care is a matter of importance in deciding the question of probable confusion, and in this case, serves to avoid confusion between the parties' respective services. As the parties' respective consumers make purchasing decisions with a high degree of purchaser care in selection, this factor also weighs heavily against a finding of likelihood of confusion.

Conclusion

Finally, under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as to the source of the goods must be not merely possible, but likely. A mere possibility of confusion is insufficient basis for rejection under § 2(d). *In re Massey Ferguson, Inc.*, 222 U.S.P.Q. 367, 368; *Witco Chem. Corp. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43 (CCPA 1969). “We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world with which trademark laws deal.” *Id* at 44. In view of the foregoing comments, Applicant submits that no likelihood of confusion exists in this case, Applicant respectfully requests withdrawal of the refusal to register for likelihood of confusion and descriptiveness.

EXHIBIT A

WIKIPEDIA

Baum und Pferdgarten

Baum und Pferdgarten is a Danish fashion house.

Rikke Baumgarten and Helle Hestehave began designing their collections as newly graduated designers in the part of Copenhagen called Nørrebro. Today their office is situated in Vognmagergade in central Copenhagen, which is also the location of the Baum und Pferdgarten flagship store which opened in February 2010. The interior of the shop was created by the designers together with, amongst others “Femmes Regionales”^[1] and “all the way to paris”.^[2]

Currently Baum und Pferdgarten is available in more than 20 countries worldwide.

In 2009 the company experienced economical difficulties but survived due to the investment of Bruuns Bazaar A/S who became majority shareholder.^[3]

References

1. <http://www.femmesregionales.com/> Femmes Regionales
2. "Archived copy" (<https://web.archive.org/web/20101012101407/http://allthewaytoparis.com/2010/02/10/baum-und-pferdgarten/>). Archived from the original (<http://allthewaytoparis.com/2010/02/10/baum-und-pferdgarten/>) on 2010-10-12. Retrieved 2010-07-30.
3. "Archived copy" (<https://web.archive.org/web/20110401131804/http://www.business.dk/detail/bruuns-bazar-koeber-kriseramtmodehus>). Archived from the original (<http://www.business.dk/detail/bruuns-bazar-koeber-kriseramtmodehus>) on 2011-04-01. Retrieved 2010-07-30.

External links

- [Bruuns Bazaar \(http://bruunsbazaar.com/%20Bruuns%20Bazaar\)](http://bruunsbazaar.com/%20Bruuns%20Bazaar)
- [DANSK Fashion Awards \(http://danskfashionawards.com/%20DANSK%20Fashion%20Awards\)](http://danskfashionawards.com/%20DANSK%20Fashion%20Awards)
- [The Golden Fur Pin \(https://web.archive.org/web/20100814020641/http://www.kopenhagenfur.com/studio/catwalks/the%2Bgolden%2Bfur%2Bpin\)](https://web.archive.org/web/20100814020641/http://www.kopenhagenfur.com/studio/catwalks/the%2Bgolden%2Bfur%2Bpin)

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EXHIBIT B



Click Product to Zoom

Baum Und Pferdgarten

Lehana Camouflage Shoulder Bag

\$120

ADD TO BAG

Editor's Note

This **Baum Und Pferdgarten** Lehana Camouflage Shoulder Bag features shoulder straps and outside zip pockets.

Product Details

- Shoulder straps
- Outside zip pockets
- Unlined
- Composition: 63% polyester, 37% metallic fibers
- Color: pink gold army
- Imported

Product Code 601945

Size & Fit +

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Clothing > Dresses > Cocktail > BAUM UND PFERDGARTEN Clothing > BAUM UND PFERDGARTEN Dresses



BAUM UND PFERDGARTEN +

Accessia Dress

\$305.00

Color: Green Sulphur



Sizes

34	36	38	40	42	44
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Size & Fit Information

Sizes listed are **Italian sizes**.

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BAUM UND PFERDGARTEN



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Alberthine Shift Dress
\$285 (\$142.50 Deposit)

+ More Colors



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FILTER SIZES COLORS CLEAR SORT BY NEWEST

10 items
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Charissa Sweater
\$235.00



BAUM UND PFERDGARTEN...
Acessia Dress
\$305.00



BAUM UND PFERDGARTEN...
Natsuko Pants
\$235.00



BAUM UND PFERDGARTEN...
Abakana Dress
\$330.00



BAUM UND PFERDGARTEN...
Alia Dress
\$225.00



BAUM UND PFERDGARTEN...
Conale Sweater
\$275.00



BAUM UND PFERDGARTEN...
Catarina Sweater
\$225.00



BAUM UND PFERDGARTEN...
Drew Coat
~~\$422.00~~ \$253.20



BAUM UND PFERDGARTEN...
Amelia Dress
~~\$252.00~~ \$151.20



BAUM UND PFERDGARTEN...
Marjorie Top
~~\$169.00~~ \$100.80

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\$819.00



Baum Und Pferdgarten Claudine Stripe Sleeve Sweater
\$429.00



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Baum Und Pferdgarten Demetria Check Faux Fur Coat
\$529.00

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