

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Anhui Light Industries International Co., Ltd. Examining Attorney: K. Margaret Le

Application Ser. No.: 88242779

Law Office: 118

Mark: 

Office Action Date: March 25, 2019

Classes: 18, 20, and 25

RESPONSE TO OFFICE ACTION

On March 25, 2019, the Examining Attorney issued an Office Action refusing registration of Applicant Anhui Light Industries International Co., Ltd.'s (the "Applicant") Application Serial No. 88242779 (the "Application") to register the  mark (the "Mark") in Classes 18, 20, and 25.

In the Office Action, the Examining Attorney requested clarification on only the goods in Class 18 and stated that Applicant's Mark is likely to cause confusion with the U.S. trademark registration for the CAREFREE TEES mark, U.S. Registration No. 5658732, (the "Cited Registration") owned by Karen Wilfong d/b/a/ Carefree Tees (the "Cited Registrant").

Applicant hereby submits an amendment to the identification of goods in Class 18, and presents arguments and evidence to support that there is no likelihood of confusion between Applicant's Mark and the Cited Registration. As such, Applicant respectfully requests that the Examining Attorney reconsider her position and approve Applicant's Mark for publication.

I. Amendment to Identification of Goods

The Examining Attorney requested clarification of the goods in Class 18. Applicant hereby amends the identification of goods to read as follows:

[Class 18]: Saddle trees; leather leashes; leather leads; collars for animals; covers for animals; harness for animals; clothing for pets; umbrellas; **traveling trunks; trunks being luggage, and storage trunks;** backpacks; rucksacks; umbrella handles

II. No Likelihood of Confusion

The likelihood of confusion between two marks "is determined on a case-specific basis, applying the factors set out in *In re E.I DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ (BNA) 563, 567 (CCPA 1973) (enumerating factors that may be considered when relevant evidence is of record)." *Recot, Inc. v. Becton*, 214 F.3d 1322, 1326, 54 USPQ2d (BNA) 1894 (2000). These factors include:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- The relatedness of the goods or services as described in the application and registration(s);
- The similarity or dissimilarity of established, likely-to-continue trade channels;

- The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
- The number and nature of similar marks in use on similar goods;
- The existence of a valid consent agreement between the applicant and the owner of the previously registered mark.

Id. (citing *DuPont* 476 F.2d at 1361). Notwithstanding the above, “[t]here is no *mechanical test* for determining likelihood of confusion.”

Here, the dissimilarities of the marks in their entireties as well as the goods covered in each respective mark outweigh any other relevant factors and should be dispositive of the issue of likelihood of confusion.

i) Comparison of Goods

Confusion is not likely, even where two marks are identical, “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.” TMEP § 1207.01(a)(i). Furthermore, there is no *per se* rule that certain goods or services are related such that there must be a likelihood of confusion conclusion drawn from the use of similar marks in connection with such goods or services. TMEP § 1207.01(a)(iv).

Under TMEP § 1207.01(a)(vi), “[t]he examining attorney must provide evidence that the goods and services are related to support a finding of likelihood of confusion. Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods or services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods and services and the goods and services listed in the cited registration.”


Simply because marks are in the same broad Class 25, this is not determinative that likelihood of confusion exists. In fact, the goods covered in the Cited Registration and the goods applied for under Applicant’s Mark are dramatically different.

The Cited Registration covers “Baby bodysuits; Shirts for infants, babies, toddlers and children; Cloth bibs; Snap crotch shirts for infants and toddlers; T-shirts for babies, adults, children, women, men.” In contrast, Applicant’s Mark covers “Sports shoes; shoes; boots; slippers; caps being headwear; hats; gloves as clothing; ski gloves.”

Applicant’s goods are targeted specifically for outdoor use, requiring customers to go to a outerwear department in order to purchase these goods, unlike the departments in which they would purchase the goods covered by the Cited Registration. Further Applicant’s goods are not clothing for the body, but instead footwear and accessories, such as caps, hats and gloves, which are specifically not offered by the Cited Registrant. There simply is no overlap between the nature and/or sale of Applicant’s goods and the Cited Registrant’s goods.

As such, likelihood of confusion is unlikely given that the goods in question are not related, nor are they 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.

ii) Comparison of Marks


Applicant's Mark, , is not confusingly similar to the Cited Mark, CAREFREE TEES, when the marks are properly considered in their entireties. *See DuPont*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973) (to determine the similarity or dissimilarity between two marks, one must compare the marks in their entireties as to appearance, sound, connotation and commercial impression). An analysis concerning a likelihood of confusion cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the *entire* marks, not just part of the marks. *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 125 USPQ 406 (CCPA 1960); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 51 USPQ2d 1349 (10th Cir. 1999). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 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").

Likelihood of confusion between Applicant's Mark and the Cited Mark cannot be assumed simply because the marks contain terms in common. Even when such marks are used on similar goods or services, the mere presence of such shared elements within the marks does not on its own make confusion likely. *Freedom Savs. & Loan Ass'n*, 757 F.2d at 1183 ("[T]he use of an identical word, even a dominant word, does not automatically mean that two marks are similar."); *see also Time Inc. v. Peterson Publ'g Co.*, 173 F.3d 113, 119, 50 U.S.P.Q.2d 1474, 1478 (2d Cir. 1999) (no likelihood of confusion between TEEN and TEEN PEOPLE, both for magazines); *First Savs. Bank*, 101 F.3d at 653 (no likelihood of confusion between FIRST BANK and FIRST BANK SYSTEM marks); *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1080, 26 U.S.P.Q.2d 1583, 1588 (2d Cir. 1993) (no likelihood of confusion between PARENTS and PARENT'S DIGEST, both for magazines); *In re Ferrero*, 479 F.2d 1395, 1398 (C.C.P.A. 1973) (no likelihood of confusion between TIC TAC for candy and TIC TAC TOE for ice cream); *Servo Corp. of Am. v. Servo-Tek Prod. Co.*, 289 F.2d 955, 981, 129 U.S.P.Q. 352, 353 (C.C.P.A. 1961) (no likelihood of confusion between SERVOSPEED for electronic motor speed control system and SERVO for electrical connectors and control equipment); *UStrust v. U.S. Trust Co.*, 210 F. Supp. 2d 9, 27-28 (D. Mass. 2002) (no likelihood of confusion between UNITED STATES TRUST COMPANY and UNITED STATES TRUST COMPANY OF BOSTON, both for financial services); *In re Lancer Orthodontics, Inc.*, 1998 WL 377664, *2 (T.T.A.B. 1998) (no likelihood of confusion between IN ADVANCE and ADVANCE, both for dental products).

Furthermore, when comparing composite marks with standard character marks, often the design elements may be considered more dominant, particularly if its larger or above the word elements. *See e.g., Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 20017) (prominently displayed design considered to be dominant element of the mark because it catches the eye and engages the viewer before the viewer looks at the word "BODYMAN"); *see also, Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB) (no likelihood of confusion between STEVE'S and Design mark for restaurant services and STEVE'S for ice cream; "Even with the word 'STEVE'S' appearing above the hot dog figures, applicant's mark is distinguishable from the registered mark of oppose, which is simply the word 'STEVE'S' in block letter form.").

Here, the Examining Attorney appears to have dismissed the additional term of “TEES” in the Cited Registration. Simply because Applicant’s Mark and Cited Registration both contain the term “CAREFREE,” this should not be determinative that the marks are confusingly similar. Instead, when the marks are compared in their entireties, there are significant differences between the marks in overall appearance, sound, and connotation, which serve to render confusion unlikely.

First, the appearance and sound of the two marks are fundamentally different. Applicant’s Mark is a unitary mark which consists of only one word, CAREFREE, and is two syllables. In contrast, the Cited Registration is composed of two distinct words, “CAREFREE” and “TEES.” Therefore, when consumers ask for the Cited Registrant’s products, they will pronounce one additional syllable to state, “CAREFREE TEES.”

Further, Applicant’s Mark, , is in a stylized font and incorporates a fanciful design. There is a distinctive design of two triangles with forked sides above the word “CAREFREE.” Additionally, the word “CAREFREE” is in a stylized font with rounded letters, which incorporate both lowercase and uppercase letters. Therefore, when consumers encounter Applicant’s Mark, it is likely that they will be naturally drawn to the distinctive design elements, thus further distinguishing Applicant’s Mark from the Cited Registration.

Lastly, Applicant’s Mark and the Cited Registration convey entirely different meanings and commercial impressions that consumers are unlikely to be confused when they encounter the marks. Applicant’s Mark is for “CAREFREE,” which Merriam-Webster’s dictionary defines as “having no worries or troubles” or “irresponsible.” Applicant’s use of the term, “CAREFREE” is intended to invoke the idea of being carefree and relaxed in the outdoor environment. This is further supported by the goods offered under Applicant’s Mark. Specially, Applicant’s Mark is for “Sports shoes; shoes; boots; slippers; caps being headwear; hats; gloves as clothing; ski gloves,” which are products consumers will use when exploring the natural outdoors.

In contrast, the Cited Registration is for “CAREFREE TEES.” “Tees” is defined by the Merriam-Webster as an informal reference to “t-shirts.” Merriam-Webster’s complete definition of ‘tees’ is attached as Exhibit A. Therefore, the Cited Registrant’s use of the term “TEES” automatically informs their consumers that apparel, such as t-shirts, are offered by the Cited Registrant. Therefore, the overall meaning and commercial impressions conveyed by each mark are entirely different and consumers are unlikely to be confused by the coexistence of the two marks.


III. The term “CAREFREE” Should be Afforded a Narrow Scope of Protection

There are several other U.S. trademark registrations in Class 25, which include the term “CAREFREE” such as U.S. Registration No. 4818147 for the CAREFREE NUDIST CAMP mark for “hats and shirts” in Class 25 and U.S. Registration No. 5487499 for the CAREFREEBLACKGIRL mark for “t-shirts” in Class 25. Accordingly, the CAREFREE mark should only be afforded a narrow scope of protection. In a crowd of similar marks, customers will not likely confuse one mark for the other given that there are so many that co-exist. *See Standard Brands Incorporated v. RJR Foods, Inc.*, 192 USPQ 383, 385, 1976 WL 21135 (TTAB 1976); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1996 WL 253841 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.”). Further, “in a ‘crowded’ field, each member of the crowd, is relatively “weak” in its ability

to prevent use by others in the crowd.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:85 at 11-163 (4th Ed. 2001). Similarly, in this case, consumers will recognize that not all of the goods offered under the “CAREFREE” marks originate from the same source.

Therefore, since the Cited Registrant is not the only trademark owner who has been granted the right to use the term “CAREFREE” in connection with goods in Class 25, Applicant should also be granted registration and be allowed to co-exist on the Register along with these registrations.

IV. Conclusion

In view of the foregoing arguments set forth above and the evidence submitted herewith, Applicant contends that Applicant’s Mark is not likely to cause confusion with the Cited Registration. Therefore, Applicant respectfully requests that the Examining Attorney reconsider her position and approve Application Serial No. 88242779 for the  mark for publication in the *Official Gazette*.

Should anything further be required, a telephone call to the undersigned at (949) 732 – 6810 is respectfully solicited.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Date: September 23, 2019

By: /Susan L. Heller/
Susan L. Heller
3161 Michelson Dr., Suite 1000
Irvine, CA 92612
Phone: (949) 732-6810
Fax: (949) 266-9468

Attorney for Applicant
Anhui Light Industries
International Co., Ltd.

EXHIBIT A



SINCE 1828



tee



DICTIONARY

THESAURUS

tee noun (1)

\ 'tē \

Definition of *tee* (Entry 1 of 3)

- 1 : the letter *t*
- 2 : something shaped like a capital *T*
- 3 *informal* : T-SHIRT
// wearing a cotton *tee*
- 4 : a mark aimed at in various games (such as curling)

to a tee

: EXACTLY, PRECISELY

// the description fit her *to a tee*

tee noun (2)

Definition of *tee* (Entry 2 of 3)

- 1 **a** : a small mound or a peg on which a golf ball is placed before being struck at the beginning of play on a hole
- b** : a device for holding a football in position for kicking
- c** : an adjustable post on which a ball is placed for batting (as in T-ball)
- 2 : the area from which a golf ball is struck at the beginning of play on a hole

See how Alzheimer's disease affects the brain. Take our Brain Tour.



alz.org/brain

alzheimer's association

WORD OF THE DAY

suffuse

to spread over or through

Get Word of the Day daily email!

Your email address

SUBSCRIBE

TEST YOUR VOCABULARY

The Exceptions Quiz III



Which of these words does *not* mean "nonsense"?

LEARN MORE FROM M-W >



Meet Puku, Our New Kids' App!