

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<i>In re Application of Popup Design, S. De R.L. de C.V.</i> Serial No.: 88/259,214 Filed: January 11, 2019 Mark: GAIA	 Examining Attorney Breanna Freeman Law Office 114
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RESPONSE TO NON-FINAL OFFICE ACTION

This responds to the Office Action issued on March 27, 2019, (“Office Action”), in which the Examining Attorney refused the applied-for trademark, GAIA (US App. No. 88/259,214)(“Application”), owned by Popup Design, S. de R.L. de C.V. (“Applicant”), *in Class 20 only*, under Trademark Act Section 2(d). The Examining Attorney has also required that Applicant (1) clarify its entity type; and (2) amend the identification of goods and services.

AMENDMENT TO THE IDENTIFICATION OF GOODS AND SERVICES

The Examining Attorney states that the identification of goods and services is indefinite and must be clarified. Applicant requests the following amendments to the identification of goods and services (in *bold and italics*):

- Class 20: *Furniture*, mirrors, picture frames; goods made *of wood or of plastic* not included in other classes, *namely, statues of wood or plastic, figurines of wood or plastic, statuettes of wood or plastic, flower-pot pedestals of plastic, and coat hangers and clothes hangers of wood or plastic; all of the foregoing not including baskets of wicker.*
- Class 035: Commercial services of furniture, *namely, retail store and online retail store services featuring furniture.*

Now that the request for further clarification has been satisfied, Applicant respectfully requests that the requirement to amend its identification of goods and services be withdrawn.

CLARIFICATION OF ENTITY TYPE

The trademark application lists the owner as Pop Design, S. De R.L. De C.V., a corporation. However, the Examining Attorney states that the “S. de R. L.” business designation is generally considered the equivalent to a “limited liability company.” The Applicant requests the following amendment to the entity type (in bold and italics): Pop Design, S. De R.L. De C.V., ***a Limited Liability Company***. Accordingly, Applicant respectfully requests that the clarification of entity type requirement be withdrawn.

SECTION 2(D) – LIKELIHOOD OF CONFUSION REFUSAL

There is no per se rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. *See Cooper Industries, Inc. v. Repcoparts USA, Inc., 218 USPQ 81, 84 (TTAB 1983)*. Where consumers are faced with various types of household goods and services, it is reasonable that consumers can easily distinguish among them. The issue of whether two products or services are related does not revolve around the question of whether both can be classified under the same general category. *Elec. Data Sys. Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1463 (TTAB 1992)*. Instead, the issue is whether the goods or services of the applicant and the registrant are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. America Online Inc., 56 USPQ2d 1471, 1475 (Fed. Cir. 2000)*; TMEP Section 1207.01(a)(i). Here, Applicant’s goods and services are neither identical nor overlapping with the goods provided under Registrant’s Mark, especially where Applicant’s

description of goods explicitly excludes Registrant's narrowly-described goods. Furthermore, there is no evidence that Registrant's Mark is of sufficient fame to "cast a long shadow which competitors must avoid." *Kenmar Parker Toys, Inc.*, 22 USPQ2d at 1456.

When the relatedness of the goods and services is not evident, and the cited mark is not well known, "something more" than the mere fact that the goods and services are used or marketed together must be shown. *In re St. Helena Hosp.*, 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness). Therefore, when comparing furniture with wicker baskets, "something more" must be shown to indicate that consumers would understand such services and goods emanate from the same source.

In the present case, Applicant's goods and services and Registrant's goods are not interchangeable. A customer who is seeking Applicant's goods and services would not see Registrant's wicker baskets as interchangeable with or related to the goods and services provided by Applicant, particularly where Applicant explicitly excludes wicker baskets from its description of goods. Applicant's goods and services and Registrant's goods are simply too different in nature and sold at a different and much lower price point, and a purchaser would not normally expect the product and service offerings from these entities to emanate from the same source or be marketed to and sold to the same types of consumers. Thus, these cumulative differences obviate a likelihood of confusion between the respective marks.

Simply because the goods and services provided by Applicant and Registrant are both found in homes or otherwise in the same field does not make them related per se. See *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d at 1410 ("[A] finding that the goods are similar is not based on whether a general term or overarching relationship can be found to

encompass them both.”) (internal citation omitted); *In re White Rock Distillers Inc.*, 92 USPQ2d 1182, 1285 (TTAB 2009) (finding the Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). A general or shared industry does not necessarily equate to an identical target market or related goods. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir 2006) (findings that the goods in question were not related because the channels of trade and purchasers were different.).

The Examining Attorney has made of record pages from the websites of well-known “big box” retailers, such as, Wayfair, Pottery Barn, and World Market. The fact that two different items can be found in department or mass merchandiser stores is not a sufficient basis to support a finding that the goods are related. *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“the law is that products should not be deemed related simply because they are sold in the same kind of establishments”); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion from the use of similar marks on any goods so displayed”); *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517, 526 (TTAB 1980) (“This contention [to equate different or unrelated goods by urging that they are all sold in supermarkets, department stores, and similar establishments] has been rejected...”).

Applicant provides a variety of household furnishings, including, in particular, high-priced couches and chairs. Registrant is providing only the very narrowly-described and easily distinguishable “baskets of wicker”, which Applicant has explicitly excluded from its description of goods. Generally, wicker baskets are relatively inexpensive, averaging in price between \$5 and \$50, depending on size, and these types of baskets typically can be found for sale in large discount stores. *See Exhibit A*, including screenshots from <https://www.uglyducklinghouse.com/get-cheap-pretty-storage-baskets/>. In contrast, Applicant provides exclusively-designed furniture, with couches costing \$10,000 and chairs costing upwards of \$1,000. *See Exhibit B*, including screenshots from <https://www.gaiadesign.com.mx/sale.html>. Applicant and Registrant target different consumers at different price points, thus, it is unlikely that a consumer would incorrectly assume that the respective goods originate from the same source.

Moreover, Courts and the Board have found a lack of confusion for identical marks even where the goods and services offered were more closely related than in the case at hand. *See, e.g., Vitarroz Corp. v. Borden, Inc.*, 644 F. 2d 960 (2d Cir. 1981) (no confusion for BRAVO’S for crackers and BRAVOS for tortilla chips); *Harlem Wizards Entm’t Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1094-95 (D.N.J. 1997) (holding that concurrent use of WIZARDS mark by two non-competitive basketball teams did not create a likelihood of confusion); *Sunenlick v. Harrell*, 895 F. Supp. 616 (S.N.D.Y. 1995) (no confusion between UPTOWN RECORDS for jazz music and same mark for rap and R&B), *aff’d*, 101 F. 3d 684 (2d Cir. 1996); *United Foods, Inc. v. United Airlines, Inc.*, 41 USPQ2d 1653 (TTAB 1995) (no confusion between UNITED EXPRESS for transportation of goods by truck and identical mark for transportation of goods by air); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987)

(finding CROSS-OVER for bras not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (finding PLAYERS for men's underwear not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (finding BOTTOMS UP for ladies' and children's underwear not likely to be confused with BOTTOMS UP for men's clothing). Certainly, if the identical and almost identical marks in the cases cited above can peacefully coexist for their respective goods and/or services, then so too can GAIA for Applicant's goods and services and GAIA CONTEMPORARY HOME for Registrant's goods, which are not closely related and do not commonly originate from a single source. Applicant respectfully submits that for these reasons confusion is not likely to occur in this case.

CONCLUSION

Through the foregoing Response, Applicant believes that it has addressed the issues raised by the Examining Attorney in the Office Action issued on March 27, 2019, including the requirements related to the identification of goods and services and the inquiry with respect to the Applicant's entity type. In light of the arguments and evidence presented by Applicant, Applicant does not believe that a likelihood of confusion exists between Applicant's Mark and Registrant's Mark and respectfully requests that the Examining Attorney reconsider and withdraw the refusal under Trademark Act Section 2(d)

Respectfully submitted,

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