

The Applicant applied for registration of the mark “WILLCO” in IC 021 and IC 025. The Examining Attorney refused registration of the applied for mark because she found a likelihood of confusion with the mark in U.S. Registration No. 3347204 [WILCO] in IC 025. Applicant believes it would help the Examining Attorney to have a better understanding of the origin of the two marks and the ways in which consumers are likely to encounter and interact with them.

The owner of the registered mark is Decibels Per Minute, Inc. This company is also the owner of two identical marks registered in IC 041 and IC 009 before they were registered in IC 025. For the mark registered in IC 041, the Goods and Services are described as “Entertainment services in the nature of a live musical band, namely, live music concerts; personal appearances by a musician, musical group or musical band.” The description of the Goods and Services for the mark registered in IC 009 is “Musical sound recordings; audio-visual recordings, namely, compact discs, [tape cassettes, audio cassettes, audio tapes,] audio discs, records, [CD-ROMs, video tapes, video cassettes,] video discs, DVDs, [DATs, and laser discs,] all featuring music.” Only later did Decibels Per Minute, Inc. register the mark in IC 025 and describe its goods and services as “Headwear; Infant and toddler one-piece clothing; Jackets; T-shirts; Tops; Wristbands.” In short, the origin of this mark is the name of a musical band.

The Applicant, however, is seeking registration of a coined term that is derived from the name of the County in which he lives, i.e. Williamson County, Tennessee. Applicant describes the goods and services he intends to provide as “Coffee mugs; Travel mugs” in IC 021 and “Hats; Sweatshirts; T-shirts” in IC 025.

This distinction is important because the prior mark with which the Examining Attorney found the likelihood of confusion is the actual name of the thing the goods are intended to promote. Therefore, consumers will always use the mark as registered to denote the band whether orally or in writing. The applied-for mark, however, is meant to evoke another name, i.e. the actual full name of the County. Consumers are not likely to refer to Williamson County as “WILLCO” orally or in writing. Instead, they will simply write or say, “Williamson County”.

Furthermore, because of the differing origins of the marks, consumers are not likely to encounter the marks or goods displaying the marks in the same places. Consumers of the Decibels Per Minute’s goods are likely to find them at the band’s concerts or on its website or other websites selling rock music T-shirts and souvenirs. Consumers of the goods displaying the applicant’s mark are, however, likely to find them in souvenir shops or street festivals in a particular location, i.e. Williamson County, Tennessee. Fans of the band are not likely to assume that goods displaying the applicant’s mark found in a souvenir shop or street festival in Williamson County, Tennessee have anything to do with a rock band.

Differences in connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used. *Revlon, Inc. v. Jerrell, Inc.*, 713 F. Supp. 93, 11 U.S.P.Q. 2d 1612, 1616 (S.D.N.Y. 1989); citing *Clarks of England, Inc. v. Glen Shoe Company*, 465 F. Supp.

375, 379, 209 USPQ 852, 854-55, (S.D.N.Y. 1960). In this case the words are not identical, and the context in which the marks are used and their respective connotations make it unlikely that consumers would view Applicant's mark as a variation on Registrant's mark.

In addition, there is a significant difference in the ways the two marks were displayed in Decibels Per Minute's registrations and the applicant's application. Decibels Per Minute displayed its mark as "WILCO" in all its registrations. The applicant displayed his mark as "WillCo". The capital "C" in the middle of the mark is an important feature, because it emphasizes the intended impression on consumers that it stands for two words, "Williamson County". Therefore, it will be critical that the mark always be used in this way.

The applicant searched the internet for T-shirts and other products displaying Decibels Per Minute's mark. The applicant found that the prior registrant displays its marks in all capital letters or with only the first letter capitalized. In no instance was the mark found displayed with the "C" or any other letter in the middle of the word emphasized by capitalization.

This distinction is worth emphasizing, because the Examining Attorney based her finding of likelihood of confusion in large part on the "phonetic equivalence" of the marks. Because consumers are not likely to hear or say the applied-for mark, but rather only see it in written form, phonetic equivalence should not be given much weight in this case, but rather the visual impression. The visual impression created by the marks with the addition of a letter "l" and, in the applicant's case, the capitalization of the letter "C", is sufficiently different to minimize the likelihood of confusion.

For the foregoing reasons, the applicant submits that there is not a likelihood of confusion between the registered mark and the applicant's mark, and that, the Examining Attorney should withdraw her refusal based on likelihood of confusion. The mere *possibility* that relevant purchasers might relate the two different marks does not meet the statutorily established test of *likelihood* of confusion. *E.g., In re Hughes Aircraft Company*, 222 U.S.P.Q. 263, 264 (TTAB 1984) ("the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source or origin, only where such confusion is *likely*") (emphasis added).