

The Examining Attorney has refused registration of Applicant's mark STRUT ("Applicant's Mark") because the Examining Attorney believes there may be a likelihood of confusion between Applicant's Mark and the mark in Reg. No. 4,952,358 ("Cited Mark"), for STRUT, owned by the San Francisco AIDS Foundation ("Registrant").

The likelihood of consumer confusion analysis has been characterized as a factual question, and there is no litmus test that can be universally applied; every case must be determined on its specific facts. In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A., 1973) (citing Coca-Cola Co. v. Snow Crest Beverages, Inc., 162 F.2d 280, 73 U.S.P.Q. 518 (1st Cir. 1947)). "A mere possibility [of confusion] ... is not enough; there must be a substantial likelihood that the public will be confused as to the source of the goods." Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47 (2d Cir. 1978). As the PTO notes, in determining whether a likelihood of confusion exists between two marks, the PTO has adopted the test set forth by the Federal Circuit in DuPont, which considers various factors to evaluate the likelihood of confusion between marks. DuPont, 476 F.2d at 1361. The DuPont opinion also states that the factors are not balanced the same way in every situation, but that the weight attributed to different factors may vary from case to case. Id. at 1362.

No likelihood of confusion exists between the Applicant Mark and the Cited Mark for the following reasons: (A) Applicant's services and Registrant's services are different and unrelated, (B) the respective party's services are offered through mutually exclusive trade channels, (C) the conditions under which the services are purchased are different, and (D) both parties' consumers are sophisticated.

A. Applicant's Services and Registrant's Services are Different and Unrelated

The "proximity-of-the-products" inquiry concerns whether and to what extent two products or services compete with each other, an inquiry which leads to an examination of the nature of the products or services themselves and the structure of the relevant market. Cadbury Beverages v. Cott, 73 F.3d 474, 480 (2d Cir. 1996). When analyzing product similarity, the question is "whether the products are the kind the public attributes to a single source." McGraw-Edison Co. v. Walt Disney Prod's, 787 F.2d 1163, 1169 (7th Cir. 1986).

Applicant acknowledges the Examining Attorney's extrinsic evidence, submitted in connection with her April 5, 2019 Office Action; however, the present recitation in International Class 044 has been narrowed by amendment. Applicant submits that the revised recitation in Class 044 more accurately reflects the specific and targeted services offered by Applicant in this class, and also highlights the differences between Applicant's service offerings and those included in the Cited Registration, as well as the differences between the respective consumers and channels of trade within which the respective services would travel. Applicant submits that, even in light of the similarity of the marks, the public would not attribute the diverse services on which the respective marks are used to a single source.

Use of similar marks on different products or services in the same general field is not enough to engender a likelihood of confusion. In Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc., 952 F.Supp. 1084, 1095 (D.N.J. 1997), the court compared the marks HARLEM WIZARDS and WASHINGTON WIZARDS, both used for basketball teams. Even though the

owners of both of these marks operated within the basketball entertainment business, the court observed that:

“Numerous cases ... illustrate that even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion. Meaningful differences between the products and services are often cited as a factor tending to negate reverse confusion, even when the products are superficially within the same category.”

Id. Even when marks are identical, confusion is not likely 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).

The Harlem court relied on the differences of competition formats, league structure, athletic quality, and venues in finding a lack of similarity between similar marks each bearing the dominant term WIZARDS. Further, in Quartz Radiation Corp., the Board determined that confusion was not likely in when QR was used for a coaxial cable and QR was also used for various apparatus used in connection with photocopying, drafting, and blueprint machines because of differences between the respective goods, how those goods were promoted, and who the customers were. 1 USPQ2d 1668, 1669 (TTAB 1986). Additionally, in In re Thor Tech, Inc., the Board determined that the use of *identical* marks for towable trailers and trucks was 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. 113 USPQ2d 1546, 1551 (TTAB 2015); See also Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is *not* likely to cause confusion); Swanson v. Georgetown Collection, Inc., No. 94-CV-1283, 1995 WL 72717 (N.D.N.Y. Feb 14, 1995) (finding FARAWAY FRIENDS for porcelain dolls and FAR AWAY FRIENDS for cloth dolls not confusingly similar); Sunenblick v. Harrell, 895 F.Supp. 616 (S.D.N.Y. 1995) (finding UPTOWN RECORDS for jazz and UPTOWN RECORDS for hip hop not confusingly similar); TMEP § 1207.01(a)(i).

In the present situation, while the two marks in question are identical, the services they attach to are distinct, and therefore exist in different marketplaces and are promoted in different ways. Registrant’s services are directed to the San Francisco community and concentrate in community events, in-person counseling, and sexually-transmitted disease and infection (STD/STI) testing. This category of Registrant’s goods covers all of the individual recitations in the Cited Mark, including the relatively broad recitations of “medical clinics” and “health care services, namely, providing health and wellness programs”. As stated, each of these recitations describes services in the nature of in-person counseling and medical clinic services. See Exhibit 1, a printout from Registrant’s webpage.

Conversely, Applicant’s services are the exact opposite of in-person, clinical health services – they take place entirely online, as reflected in Applicant’s updated recitation of services, which states specifically “online health care services, namely,...”. See Exhibit 2, a printout from the “How It Works” sub-page of Applicant’s website.

The similarity of the marks and the relatedness of the services are not the only two DuPont factors to be considered in the likelihood of confusion analysis, and the weight attributed to each DuPont factor may vary from case to case, with no one factor or set of factors controlling in every case. DuPont, 476 F.2d at 1362. As set forth in greater detail below, several other DuPont factors point decidedly *away* from a likelihood of confusion between the two marks in question.

B. The Respective Party’s Services Are Offered Through Mutually Exclusive Trade Channels

As noted above, and evidenced by Exhibits 1 and 2 hereto, “Strut” is the name of Registrant’s health and wellness center in San Francisco, CA. Although Registrant, the San Francisco AIDS Foundation, offers additional services and online resources, their mark STRUT is used exclusively to identify their physical facility in the Castro district of San Francisco, and to advertise the services offered by Registrant at that physical location. Stated differently, Registrant’s services under the STRUT mark are offered exclusively in-person. Therefore, the consumers of Registrant’s services are also in a limited geographic area.

By contrast, Applicant does not have a physical location from which services are provided – Applicant’s services are provided exclusively online, remotely, by e-mail, web fillable forms, and snail mail. These virtual communications are the polar opposite of Registrant’s exclusively in-person services. The channels of trade under which the services offered under the respective marks travel, therefore, are not only different but mutually exclusive.

As seen in In re Thor Tech, identical marks are not likely to cause confusion when the channels of trade are different. Registrant’s services are advertised and provided to individuals who need access to mental health assistance and inclusive events, whereas Applicant’s website (its sole advertising venue) and products focus on individuals who are looking for a discreet way to purchase personal care medications. The distinction is even more stark considering Applicant’s services in class 044 are explicitly limited to treatments for hair loss, erectile dysfunction, cold sores, scars, acne, nails, and melasma; all personal care and health issues. On the other hand Registrant San Francisco AIDS’ services are targeted to people with afflictions that benefit greatly from in-person support, therapy and group inclusivity, and therefore are best treated in the in-person environment which Registrant has set up specifically and exclusively for this purpose.

C. The Conditions Under Which the Services Are Purchased Are Different

Regardless of any advertising employed by either Applicant or Registrant, as described above, Registrant’s services *under the STRUT mark* are purchased or obtained exclusively in an in-person environment: the STRUT-branded wellness center in San Francisco, CA. Applicant’s services are provided exclusively by remote means – online and through the mail. It goes without saying that the purchasing conditions as between these two forums are markedly different. This is yet another factor pointing away from a likelihood of confusion as between the marks at issue.

D. Both Parties’ Consumers are Sophisticated

Consumers to whom the services are sold are relevant to the structure of the market. Cadbury Beverages Inc., 73 F.3d at 480. Both In re Thor Tech and Quartz Radiation Corp. discuss the

importance of the consumers and their level of sophistication and what they are seeking to purchase. 113 USPQ2d 1546, 1551; 1 USPQ2d 1668, 1669. Additionally, TBED 1207.01(d)(vii) states that "circumstances suggesting care in purchasing" can lessen the likelihood of confusion.

Here, we see two distinct classes of consumer. Registrant's consumers are in a very limited geographic area. They are looking for educational resources, events, and mental health and sexual counseling, treatment, and testing. Conversely, Applicant's consumers are individuals looking to purchase personal care medication. However, both Applicant's consumers and Registrant's consumers are seeking highly personal and potentially expensive treatments, products and/or services: in the case of Applicant's consumers, treatment for highly personal albeit non-life-threatening conditions; in the case of Registrant's consumers, counseling related to HIV/AIDS and related/resultant diagnoses. In both cases, consumers are likely to research, and take seriously, the decisions they're making regarding these very personal purchasing choices. See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily").

III. LIKELIHOOD OF CONFUSION – INTERNATIONAL CLASS 041

For the sake of completeness, and for the reasons set forth above, Applicant disagrees with the Examining Attorney's conclusion that the Cited Mark is likely to cause confusion with Applicant's services in International Class 041.

IV. CONCLUSION

Applicant respectfully requests that upon the entry of this response, which meets the points raised by the Examiner, the Application be passed to publication.

Please contact the undersigned if you have any questions.

Respectfully submitted,

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