

Applicant, Silverado Senior Living, Inc., is in receipt of a First Office Action received in connection with Applicant's U.S. Trademark Application Serial No. 88/281,503 for "LOFT". Applicant thanks the Examining Attorney for his prompt review and respectfully requests reconsideration of its application in light of the following facts and remarks:

REMARKS

Section 2(d) Refusal

The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because the Examining Attorney believes there exists a likelihood of confusion with the "THE LOFT REHABILITATION AND NURSING" mark under U.S. Registration No. 5,723,875 owned by The Loft Rehabilitation and Nursing, LLC. Reconsideration of that decision is respectfully requested.

The Lanham Act provides for rejecting registration of a mark that "so resembles a [registered] mark . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). The section continues that if "confusion, mistake, or deception is *not likely to result from continued use* . . . of similar marks . . ., concurrent registrations may be issued." *Id.* As the examining attorney points out, the likelihood of confusion determination is assisted by applying the *DuPont* factors outlined by the Court of Customs and Patent Appeals, predecessor to the Federal Circuit. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The thirteen *DuPont* factors are as follows: (1) the marks' similarity in appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity of the goods and services covered by the marks; (3) the similarity or dissimilarity of the channels of trade; (4) the sophistication of the typical consumer, i.e. "impulse" v. careful, sophisticated purchasing; (5) the fame of the registered mark; (6) the number of other,

similar marks used for similar goods or services; (7) any evidence of actual confusion; (8) the length of concurrent use without evidence of actual confusion; (9) the variety of goods or services covered by the marks; (10) any discussions or agreements between the marks' owners; (11) the marks' current exclusivity in the marketplace; (12) the substantiality of potential confusion; and (13) any other evidence probative of concurrent use's effects on consumers. *Id.* at 1361.

Because the likelihood of confusion determination is case specific, some factors may be more or less relevant in a given case. *Id.* at 1361-62; *see also Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355-57 (Fed. Cir. 2011). The examining attorney asserts that the following factors are most relevant in this case: (1) similarity of the marks and (2) similarity and nature of the goods and/or services. Applicant respectfully disagrees and requests reconsideration.

The determinative inquiry is whether the marks' concurrent use "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F. 2d 901, 902 (C.C.P.A. 1973).

Applicant respectfully acknowledges Examining Attorney's analysis with respect to the likelihood of confusion analysis. And, Applicant considers that at least the following *DuPont* factors could weigh in favor of registration:

- Dissimilarity of goods and services owing to: 1) the rehabilitative or recuperating nature of Registrant's services as compared to the ameliorative nature of Applicant's, and 2) Registrant's focus on physical health and strength compared to Applicant's on mental acuity.
- Dissimilarity of trade channels, omitting consideration of independent websites, the publications and third-party vendors utilized each for advertisement differ;

- Lack of distinctiveness of the cited mark given there are eighteen other LOFT-derivative marks registered or co-pending in International Class 044 (not considering Applicant's);

Applicant is still evaluating how best to proceed with this mark and thus files this Response to reserve the right to respond more substantively should another refusal issue.

Classification Requirement

Applicant consents to the amendment to classify the services in International Class 043.