

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of                      Dream Crew Management  
Serial Nos.                                      88/291,958  
Trademarks:                                  BY THE BOY  
Filing Date:                                  February 06, 2019

RESPONSE TO OFFICE ACTION

COMES NOW, the Applicant Dream Crew Management (hereinafter “Applicant”) and respectfully requests the Examining Attorney to reconsider its refusal of the instant application on the grounds of Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*, stating as follows:

ARGUMENT IN SUPPORT OF REGISTRATION

The Examining Attorney refused registration of the mark on the basis that, if registered, the Applicant’s mark would create a likelihood of confusion with the registered trademark THE BOYS, more fully set forth in U.S. Registration No. 2,929,162 (the “Registered Mark”).<sup>1</sup>

*The Standard for a Determination of a Likelihood of Confusion*

A determination of likelihood of confusion between marks is made on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The Examining Attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;

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<sup>1</sup> The Examiner also lists an advisory potential confusion with U.S. Application Serial Nos. 88/143,186 and 88/143,156. The arguments listed herein applies to both applications as the trademark of the registered trademark and the prior-pending trademark applications have the same name, THE BOYS. In regards to Serial No. 88/143,156, that application has been abandoned as of September 03, 2019.

- (4) The conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing; and
- (5) The number and nature of similar marks in use on similar services.

*Id.*

The Examining Attorney is tasked with evaluating the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the Examining Attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10<sup>th</sup> Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole) (citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10<sup>th</sup> Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are confusingly similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8<sup>th</sup> Cir. 1987), the court held that "Oatmeal Raisin Crisp" and "Apple Raisin Crisp" are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10<sup>th</sup> Cir. 1996), marks for "FirstBank" and for "First Bank Kansas" were found not to be confusingly similar. Further, in *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark "Lean Cuisine" was not confusingly similar to "Michelina's Lean 'N Tasty" even though both marks use the word "Lean" and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party's goods must be determined on the basis of the goods recited in the application or registration. See, e.g., *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990);

*Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). See generally TMEP § 1207.01(a)(iii).

Even if the marks are similar, confusion is not likely to occur if the goods 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 an incorrect assumption that they originate from the same source. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field). See generally TMEP § 1207.01(a)(i).

Applying the legal standards as enumerated above, it is clear that confusion is not likely as between Applicant's trademark and the Registered Mark and, accordingly, the refusal to register BY THE BOY should be withdrawn.

#### *The Trademarks Are Dissimilar*

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973)). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related. Rather, considering all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar, but a similarity of one factor is not dispositive of the entire analysis. See *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In*

*re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Moreover, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. In *re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009), citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Additions or deletions to marks are often sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. While “the similarity or dissimilarity of the marks is determined based on the marks in their entireties ... there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties.” In *re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When comparing Applicants BY THE BOY mark to Registrant’s THE BOYS trademark, Applicant contends the dominant portion is not “THE BOY” but instead, the dominant portion of Applicant’s mark is “BY.” Usually, the first word in the mark, which is frequently the most dominant portion of a mark since it is the most likely to be impressed upon the mind of the purchaser and to later be remembered. See *Palm Bay Imports*, 73 USPQ2d at 1692 (“*Veuve*” is the most prominent part of the mark VEUVE CLICQUOT because “*veuve*” is the first word in the mark and the first word to appear on the label); *Century 21 v. Century Life* 23 USPQ2d at 1700 (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Therefore, the dominant portions of the marks are completely different as it will give consumers an instant idea who the goods and services are offered by, The Boy. Consumers who view the trademark will notice “BY” before they notice “THE BOY.” Although Examiner argues BY “...merely indicates who the applied-for goods and services are connected with,” consumers

will instantly know the applied-for goods and services are connected with a specific person, namely Aubrey Graham (Drake). Simply put, the average purchaser would not believe the marks BY THE BOY and THE BOYS are associated.

The Examiner also contends that the marks “share similar meanings which leave consumers with the similar commercial impression.” Applicant disagrees with this determination. There have been instances where the Board has found that confusion is not likely even when an applicant has incorporated the entirety or a portion of a cited mark as part of its own mark. See e.g., *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (Applicant’s mark



not confusing similar with cited RACEGIRL mark in standard characters); *In re White Rock Distillers, Inc.*, 92 USPQ2d 1282 (TTAB 2009) (Applicant’s standard character VOLTA mark not confusingly similar with the cited mark



The way the term is used, “boy” is making a reference to a particular person. In the Registrant’s Mark, the mark THE BOYS refers to a specific group of boys. Attached is a picture from the Registrant’s Facebook page showing a group of boys with the caption “#ThrowBackThursday to 1989!! Mike, Richie, Joey, Frank, and John!! ☺ #TheBoysFarmersMarket #Family.” In regards to Registrant’s Mark, THE BOYS is probably referring to a specific group of boys as shown in the picture. In the same sense that THE BOYS mark refers to a collective group of specific individuals, Applicant’s BY THE BOY refers to a specific person. As shown by the attached 2(c) Declaration of Consent, The Boy refers to the pseudonym of Aubrey Graham (Drake). So, the full mark, BY THE BOY, refers to goods and services offered by a specific person, Aubrey Graham (Drake). While the dictionary term “boy” does refer to the adolescents of males, the specific reference of the mark, BY THE BOY, refers to Aubrey Graham (Drake).

Accordingly, as the trademarks at issue have different sight, sound, and meaning, it is

respectfully submitted that this favors a finding of an absence of a likelihood of confusion as it relates to this *du Pont* factor.

#### *Different Commercial Impressions*

If the respective trademarks create separate and distinct commercial impressions source confusion is not likely. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression).

In the instant case, Applicant's trademark, BY THE BOY, creates a commercial impression of goods or services from The Boy, Aubrey Graham (Drake). In the alternative, the Registered Mark creates a commercial impression of services that come from a specific group of boys (as shown on the attached image). Given these separate and distinct commercial impressions, it is submitted that this fact favors a finding of an absence of a likelihood of confusion under this *du Pont* Factor.

#### *The Trademarks Create Distinct Connotations*

Similarity in meaning or connotation is another factor in determining whether the marks are confusingly similar. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973); *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645-46 (TTAB 2009). The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks.

Moreover, the meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies'

sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear...or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks). Applying the above to the application at hand, Applicant applied to register the trademark IN ASSOCIATION WITH THE BOY in connection with Class 043 - Bar services; Coffee and tea bars; Hotels; Restaurant and café service. In this context, Applicant's trademark creates a connotation of services offered by The Boy, Aubrey Graham (Drake). This gives consumers the

feeling they are getting goods and services directly from The Boy, Aubrey Graham (Drake).

In contrast, the registered trademark, THE BOYS is used in connection with Class 043 - restaurants; and restaurant services, namely, a server of food and beverages. In this context, the mark, THE BOYS, creates a connotation of services offered by a specific group of individuals. In this sense, consumers view the Registrants Mark as referring to a group, not just one person or an individual. As such, consumers seeing the trademarks BY THE BOY and THE BOYS will notice the singular and plural use of "boy" and, more importantly, notice the reference of "THE BOY" and "THE BOYS" as it relates to a specific person or a specific group.

Accordingly, as the trademarks at issue create distinct connotations in relation to their respective goods or services, it is respectfully submitted that this also favors a finding of an absence of a likelihood of confusion as it relates to this *du Pont* factor.

#### *Overlapping Terms*

Moreover, if the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB's holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women's shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with "ASO" disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion). *See also Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellent used to repel deer, other



ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellant for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" is descriptive as applied to the relevant goods and thus has no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of "DESIGNERS/FABRIC" and "DESIGNER FABRICS," the addition of "DAN RIVER" is sufficient to avoid a likelihood of confusion).

In the instant case, the trademarks at issue share the same, weak, overlapping term(s), namely "BOY." As the case law sets forth above, if the primary similarity as between the Applicant's Trademark and that of the registrant are descriptive in nature, this consideration

must also lend to a conclusion of an absence of a likelihood of confusion under *du Pont*.

Applicant has attached screen shots showing the use of the term "boy" in registered trademarks. According to [tess.uspto.gov](http://tess.uspto.gov), there are over 1,900 trademarks that are registered that include the term "boy." In IC 043, there are 89 trademarks that are registered that include the term "boy." This decisively shows that the term "boy" can be used to reference different goods and services by different sources without any consumer confusion. Additionally, there seven registrations with the terms "BY" and "BOY" and zero registrations with the terms "BY" and "BOY" in IC 043.

#### CONCLUSION

Based upon the foregoing, it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's Trademark.

WHEREFORE it is respectfully requested that the Examining Attorney reconsider the refusal of the instant proceedings, remove as an impediment the cited trademark, and approve the instant Application for publication.

Respectfully submitted this 14<sup>th</sup> day of October, 2019,

s/robert kleinman/  
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ID of Goods

Applicant agrees to the following change for Class 009:

“Audio and video recordings featuring music and artistic performances; Digital sound processors; Downloadable musical sound recordings; Downloadable software in the nature of a mobile application for entertainment purposes, namely, software that enables users to stream, edit, upload, and download music; Downloadable software in the nature of a mobile application for music and video production; Media players.”

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK APPLICATION, PRINCIPAL REGISTER

In regards to Serial No(s).      88/291,974 and 88/291,958

Trademark(s):                    IN ASSOCIATION WITH THE BOY; and  
BY THE BOY, respectively.

Filing Date:                      February 6, 2019 (for both Serial Nos.)

SECTION 2(c) DECLARATION OF CONSENT

Commissioner for Trademarks  
PO Box 1451  
Alexandria, VA 22313 – 1451

Dear Commissioner,

Applicant, Dream Crew Management, intends to use and register the marks IN ASSOCIATION WITH THE BOY and BY THE BOY for the goods listed on Exhibit A. The name in the mark identifies a pseudonym of a living individual whose consent to register is made of record. I hereby give consent to the use and registration by Dream Crew Management of my pseudonym as a trademark and/or service mark with the USPTO.

Date: \_\_\_\_\_

\_\_\_\_\_  
Aubrey Graham (Drake)

EXHIBIT A  
List of Goods

IC 004 – Candles.

IC 009 - Audio and video recordings featuring music and artistic performances; Digital sound processors; Downloadable musical sound recordings; Downloadable software in the nature of a mobile application for entertainment purposes; Downloadable software in the nature of a mobile application for music and video production; Media players.

IC 016 - Publications, namely, books and magazines in the fields of music, art and entertainment; Sticker books.

IC 025 - Dresses; Hats; Hoodies; Jackets; Lingerie; Outerwear, namely, hats, coats, scarves and gloves; Pants; Shirts; Shoes; Shorts; Skirts; Socks; Suits; Sweatshirts; Track suits; Undergarments; Waist belts.

IC 033 – Spirits; Wine.

IC 035 - Arranging personal appearances by persons working in the field of film, music, television, entertainment or sport; Business consulting, business management and providing information in the music business field; Personal management services for musical performers.

IC 041 - Arranging and conducting nightclub parties; Entertainment services in the nature of arranging social entertainment events; Entertainment services in the nature of creation, development, and production of television programming; Entertainment services in the nature of hosting social entertainment events; Entertainment services in the nature of an ongoing reality based television program; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Music production services; Music publishing services; Music video production; Production of music; Production of sound and music video recordings.

IC 043 - Bar services; Coffee and tea bars; Hotels; Restaurant and café services.