IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Law Office	:	116
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Applicant	:	Mobile Defenders, LLC
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For	:	SELECT

RESPONSE

In the September 16, 2019 Office Action, the Examining Attorney refused registration of Applicant's Mark based on (i) a prior pending mark, Applicant Serial No. 88,338,635 SELECT ("Prior Pending Mark") by Cura Partners, Inc., an Oregon corporation ("Prior Applicant"), (ii) likelihood of confusion grounds with U.S. Registration No. 5,164,455 – SELECT BRAND ("Registrant Mark") owned by L&R Distributors, Inc., a New York corporation ("Registrant") and (iii) the descriptiveness of Applicant's Mark.

I. Likelihood of Confusion with Prior Pending Mark.

The Prior Pending Mark is in connection with various types of apparel and novelty items, namely:

Class 025: headwear, namely, hats, caps, beanies, stocking caps, baseball hats, and visors; clothing, namely, shirts, t-shirts, polo shirts, shorts, hooded sweatshirts, long-sleeve shirts, sweatshirts, tank tops, jackets, pants, tights, leggings, and socks; footwear, namely, shoes and sandals; swimwear, namely, men's and women's bathing suits, bikinis, trunks, and shorts;

Class 021: cups; mugs; bottles sold empty; sports bottles sold empty; water bottles sold empty;

Class 018: Backpacks; tote bags; duffel bags; and

Class 009: Eyewear, namely, eyeglasses and sunglasses; eyewear cases; batteries; cell phone cases; carrying cases for cell phones; cell phone battery chargers; phone accessories, namely, smart phone mounts.

Upon a search of Prior Applicant's business, it is obvious that Prior Applicant is in the cannabis oil industry, which is completely separate and distinct from Applicant's business, and it can be inferred that Prior Applicant's goods in connection therewith are merely promotional for Prior Applicant's actual marketed goods (see below):

The optical similarities of Prior Applicant's goods as suggested in its application for the Prior Pending Mark, namely, cell phone battery chargers and phone accessories, with Applicant's goods do not reflect the reality of industry similarities nor do they serve a similar customer base. Instead, any customer purchasing Prior Applicant's promotional goods would be doing so to represent its support of Prior Applicant and Prior Applicant's business and products, which seems to be strictly in the cannabis industry. Applicant is a wholesale replacement parts center for electronics, offering aftermarket batteries, screens and other replacement parts for laptops and handheld mobile devices. In determining whether the likelihood of confusion exists,

the Examining Attorney should consider the factors listed in *E.I. Du Pont de Nemouris & Co., Inc.,* 476 F.2d 1357, 171 U.S.P.Q. 563 C.C.P.A. 1973. The most relevant factors from *DuPont* are (i) similarity of the marks; and (ii) relatedness of the goods or services. While the Prior Pending Mark and the Applicant's Marks are essentially identical, the "DuPont factors" as set forth in the *Du Pont* case cited above, are taken together as a whole and are not equally weighted, but of paramount significance is the similarity of the marks in terms of their appearance, sound, connotation, and commercial impression as well as the relatedness of the goods and services associated with the marks. Here, the goods associated with Prior Applicant's Mark are not the apparel and novelty items as suggested in Prior Applicant's application, but instead, used as promotional items for goods in an entirely different industry. Therefore, Applicant respectfully submits that the second factor demonstrates that there is **no** likelihood of confusion between Prior Applicant's Mark and Applicant's Mark.

II. Likelihood of Confusion with Registrant Mark.

The Examining Attorney cited a likelihood of confusion with the Registrant Mark. Registrant uses this mark in connection with an array of goods identified as follows:

Class 034: Lighters for smokers;

Class 032: Distilled drinking water;

Class 030: Candy; Gummy candies;

Class 029: Roasted nuts, namely, mixed nuts;

Class 025: Insoles for footwear;

Class 021: Brooms; Dental care kit comprising toothbrushes and floss; Dental floss; Gloves for household purposes; Hair brushes; Hair combs; Mops; Manual toothbrushes;

Class 016: Clipboards; Envelopes for stationery use; File folders; Glue sticks for stationery or household use; Paper coffee filters; Adhesive tapes for stationery or household purposes;

Class 011: Light bulbs; Electric night lights;

Class 010: Therapeutic hot and cold therapy packs; Thermometers for medical purposes;

Class 009: Batteries; Disposable cameras;

Class 008: Manicure implements, namely, Nail nippers and cuticle pushers; Manicure implements, namely, nail Clippers; Pedicure implements, namely, Clippers; Razor blades; Razors; Razors and razor blades; Razors, electric or non-electric; Scissors; Tweezers; Disposable razors;

Class 005: Acetaminophen; Adhesive bandages; Allergy relief medication; Antacids; Anti-itch ointment; Anti-motion sickness agents; Antibacterial alcohol skin sanitizer gel; Antibiotic creams; Antiseptics; Baby diapers; Caffeine preparations for stimulative use; Contact lens cleaning preparations; Contact lens cleaning solutions; Contact lens cleaning preparations; Contact lens cleaning solutions; Contact lens wetting solutions; Cough treatment preparations; Cough drops; Cough syrups; Decongestant nasal sprays; Diarrhea medication; Dietary supplements; Ear drops; Eye drops; Hemorrhoid treatment preparations; Laxatives; Medicated shampoo; Menstrual symptom treatment preparations; Natural sleep aid preparations; Pain relief medication; Personal lubricants; Pregnancy test kits for home use; Stool softeners; Vitamin preparations; Anti-cough drops; Mixed vitamin preparations;

Class 003: After-shave; After-sun lotions; Baby powder; Baby oil; Baby powder; Baby wipes; Body powder; Body wash; Breath freshening confectionery, namely, dissolvable breath strips, breath mints, candy and gum; Cosmetic body scrubs for the entire body; Cosmetic

creams for skin care; Cosmetic preparations for the care of mouth and teeth; Cosmetics and make-up; Denture cleaners; Deodorants and antiperspirants; Facial cleansers; General purpose mentholated ointment not for medical use; Hair conditioners; Lip balm; Liquid soap; Liquid soaps for hands, face and body; Lotions for Skin; Nail-polish removers; Skin cleansing cream; Skin cleansing lotion; Sunscreen creams; Toothpaste and mouthwashes; Waterproof sunscreen; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; and

Class 001: Unexposed camera film.

Registrant is a distribution center of health and beauty and general merchandise goods to supermarkets, drugstores and other retail-like stores providing an array of products, as identified by the above-referenced goods descriptions, across several consumer markets. As stated previously, Applicant is a wholesale replacement parts center for electronics, offering aftermarket batteries, screens and other replacement parts for laptops and handheld mobile devices. As such, Applicant respectfully submits that confusion is unlikely between the Registrant Mark and Applicant's mark as the marks and their channels of trade are dissimilar, and as Applicant's mark and the Registrant Mark represent completely different industries and customer bases. Using the *Du Pont* factors identified above, Applicant submits that (A) the identified goods are different and unrelated and (B) the identified goods travel in entirely different channels of trade. Applicant therefore respectfully submits that the second factor demonstrates that there is **no** likelihood of confusion between the Registrant Mark and Applicant's Mark.

A. The Identified Goods or Services Are Different and Unrelated

Under the Trademark Act, a refusal to register on the grounds of likelihood of confusion requires that such confusion as to the source of goods or services be not merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). *In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367. 368 (TTAB 1983) (quoting *Witco Chemical Co. v Whitfield Chemical Co., Inc.*, 164 U.S.P.Q. 43, 44 (CCPA 1969)) ("we are not concerned with the mere theoretical possibilities of confusion, deception, or mistake, or de minimis situations but with the practicalities of the commercial world with which trademark laws deal"). Here, confusion is unlikely.

The identified goods of Applicant's mark are distinct from those of the Registrant Mark. Registrant's goods fall under an array of International Classes and only somewhat overlap with Applicant's goods with regard to "batteries" listed under International Class 009. Here, it is clear that the actual types of batteries provided by Applicant and Registrant are completely different. Registrant provides household-type batteries for retail sale whereas Applicant provides industry and product-specific batteries to its customers which are the end users. If a customer is looking for a replacement battery for a handheld mobile device, it is common knowledge that such customer would not seek to purchase such product at a drugstore, let alone would such customer be contacting a wholesale distributor of health and beauty and general merchandise goods. As such, since the nature and breadth of these classes of goods are sufficiently unrelated and distinct, a customer of either Registrant or Applicant is extremely unlikely to get the two parties and their goods or services confused.

Further, the Examining Attorney cites that the Applicant's Mark "SELECT" and the Registrant Mark "SELECT BRAND", both using the word SELECT "creates a dominant commercial impression because the word "brand" is descriptive and has been disclaimed. Thus, the dominant portion of the registrant's mark is identical to the applicant's mark." Again, using

the "*Du Pont* factors" identified above, coupled with the above-referenced distinction between Registrant and Applicant's businesses, the commercial impression and relatedness of the goods and services associated with the marks is so drastically different, justifying the dissociation of the Registrant Mark and Applicant's Mark necessary to prove that absolutely none of the goods or services provided by Registrant and Applicant overlap or could be considered similar.

B. The Identified Services Travel in Entirely Different Channels of Trade

The trade channels of the Applicant's goods are also entirely different from those of the Registrant's goods, as Registrant is a wholesale distributor of a variety of unlike products and Applicant is a retail store, servicing end customers with needs in a specific industry.

The primary focus in any likelihood of confusion analysis should be the way the goods are encountered in the marketplace. TMEP § 1207.01(a). If the goods or goods in question are not marketed in such a way that they would be encountered by the same persons, under the same conditions, then even if they are identical, confusion is not likely. *Shen Mfg. Co., Inc. v. Ritz Hotel Ltd.*, 393 F.3d 1283 (Fed. Cir. 204); *Local Trademarks v The Handy Boys, Inc.*, 16 U.S.P.Q. 2d1156, TTAB 1990). It is unlikely that people seeking replacement cellular device parts would encounter products such as household batteries in a drugstore and be confused as to whether that product would suffice. Further, and more importantly, as a distributor of wholesale products, a consumer would never come into contact with Registrant for such products.

It is generally recognized that where a product or service is targeted and promoted to a specific consumer, (such as a consumer with specific electronic parts replacement needs), the consumer will have a sufficient sophistication or discrimination regarding the goods so as not to be confused by similar marks used in connection with dissimilar goods. The mere fact that Registrant is a distributor of batteries to retail stores does not mean, and is in fact unlikely, that the batteries are marked with Registrant's "SELECT" brand. Even the most sophisticated

consumer of general merchandise is not aware of who distributed the products they purchase at their local CVS Store. In this case, Applicant's goods are so specific that the sophisticated consumer seeking Applicant's products is aware that such replacement parts cannot be purchased at a general merchandise store.

Simply put, the trade channels and the consumers of Applicant and Registrant are sufficiently distinct as to avoid any likelihood of confusion.

III. Merely Descriptive.

A trademark is considered "merely descriptive" if the mark itself describes a quality or characteristic of the mark's goods or services. According to the prevailing tests of descriptiveness, a descriptive term must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2d Cir. 1961). If, however, the information about the product or service associated with the mark is indirect or vague, requires imagination, thought, and perception as to the nature of the goods, then the mark is suggestive. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976). The word "SELECT" when read by a customer, even with the most liberal use of his or her imagination, would not give such customer any idea with regard to the product itself or its characteristics. The Examining Attorney stated that "[m]arks that are merely laudatory and descriptive of the alleged merit of a product [or service] are…regarded as being descriptive." When considering whether a mark is descriptive or merely suggestive, such mark should be considered on a continuum or spectrum of descriptiveness. For example, "creamy cheese" could be considered descriptive as it would describe an actual characteristic of the product as creamy. In this case, "select" when used in connection with repair or replacement electronic parts, is only merely suggestive of the quality of Applicant's

goods. In sum, Applicant's Mark alone is not merely descriptive of the goods connected with Applicant's Mark.

In view of the foregoing, the application is in condition for allowance. Applicant respectfully requests that the refusal be withdrawn, and the mark be approved for publication.

Respectfully submitted,

Mobile Defenders, LLC

By *_/s/ Brittany R. Harden_*

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