THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	:	
	:	Trademark Attorney
App. Ser. No. 88/290991	:	Grace Duffin
	:	Law Office 120
Applicant: Advance Magazine Publishers Inc.	:	
	:	
Mark: WWT WOMEN WHO TRAVEL	:	

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I. REMARKS

In the Office Action dated April 23, 2019 ("Office Action"), the Examining Attorney refused registration of the Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on the conclusion that Applicant's mark "WWT WOMEN WHO TRAVEL" is likely to be confused with the marks shown in U.S. registration numbers 5223161 and 5025988.

Applicant respectfully disagrees with the Examining Attorney's opinion that the Applicant's Mark is likely to be confused with the registered marks. In addition to the arguments, Applicant hereby submits the requested disclaimer and amendments.

For the reasons provided herein, Applicant respectfully requests that the Examining Attorney approve the Application for registration.

II. LIKELIHOOD OF CONFUSION

The principal factors to be considered in determining whether there is a likelihood of confusion are laid out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), and include (1) the similarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression, (2) the similarity and nature of the goods as described in the Application, and (3) the similarity of the channels of trade of the goods (collectively, the

"*DuPont* Factors"). The Examining Attorney maintains that Applicant's Mark so resemble the Cited Mark that a potential consumer would be confused or mistaken or deceived as to the source of services in question.

It is well established that there is no rule that confusion is automatically likely simply because marks share common elements. See *Colgate-Palmolive Company v. Carter Wallace Inc.*, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (PEAK PERIOD for personal deodorants is not confusingly similar to PEAK for dentifrice); and *Lever Brothers Company v. The Barcolene Company*, 174 U.S.P.Q. 392 (CCPA 1972 (ALL CLEAR for household cleaner not likely to cause confusion with ALL for the same goods). Instead, an analysis under Section 2(d) must be based on the similarity or dissimilarity of the general overall commercial impressions engendered by the involved marks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106 (T.T.A.B. 1975). When the marks at issue are properly evaluated in their entireties and in context of the marketplace, Applicant respectfully claims that Applicant's Mark and the Cited Marks are not likely to be confused because of the material differences between the marks at issue as explained in detail below.

REGISTRATION NO. 5223161

a. No Likelihood of Confusion between Marks Taken in their Entirety

Marks are compared along the axes of their "appearance, sound, connotation and commercial impression." *In re E.I. du Pont de Nemours & Co.* at 1361. "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545–46 (1920).

The cited mark THE BOY WHO LIVED & GIRL WHO TRAVELS contains only one word in common with Applicant's mark. This word is "TRAVEL" and it is the last and the least dominant word in both marks. The mere fact that cited Registrant's mark contains the common word cannot be a basis for refusing registration to all other marks that incorporate the word "TRAVEL". Applicant has found 4330 active federal trademark registrations and applications that contain the same word. See Exhibit A. The mere fact that two marks may share a word or words in common is not dispositive of likelihood of confusion. Clairol, Inc. v. Cosmair, Inc., 224 U.S.P.Q. 229, 232 (S.D.N.Y. 1984) (SUMMER BLOND and SUMMER SUN for directly competitive hair lighteners sold through the same channels of distribution are different enough in terms of name, packaging and impression to avoid likelihood of confusion by average customer). Even where common words may appear to be "dominant", courts have held that confusion is not likely, after considering marks in their entireties. In re Cooper Tire and Rubber Co., 22 U.S.P.Q. 2d 1079, 1080 (Fed. Cir. 1991) (THE INDY TUBE for rubber inner tubes is not likely to cause confusion with INDY 500 for tread rubber used on automobile tires. The court stated "even though we agree that in parsing the marks THE INDY TUBE and INDY 500, similarities can be found, we do not agree that the marks are, in their entireties, similar as to appearance, sound and commercial impression").

In addition, Applicant's mark contains a distinctive logo that contains the letters WWT surrounded by a square design and separated by diagonal lines. This design part of the mark further distinguishes it from the cited mark.

In sum, the commercial impressions and differences of these marks in sound, meaning, connotation and appearance in their entireties makes these marks very different and Applicant's

mark will not cause any confusion with the Cited Mark. Therefore, the Applicant's Application should be approved.

b. No Likelihood of Confusion of Mark Based on Trade Channels and Sophistication of Consumers

Applicant's services are part of larger and famous media brand CONDE NAST TRAVELER, and they are only used on the CONDE NAST TRAVELER's website and channels. Moreover, Applicant's services are focused on women, while cited mark's services are focused on boys and girls. Therefore, any confusion as to the source of the services is unlikely.

Sophistication of consumers is important and often dispositive because sophisticated consumers may be expected to exercise greater care. *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir.1992). As stated above, Applicant's services will be instantly associated with Applicant's famous media brand, CONDE NAST TRAVELER, with millions of viewers and followers each month. The majority of Applicant's consumers are mostly experienced readers and fans who have been following and are subscribed to Applicant's services for years and who are very well familiar with Applicant's nature of services. These consumers would never confuse the Registrant's services with Applicant's. Also, no ordinary person without knowledge of these industries is likely to confuse these different marks.

With the foregoing in mind, any overlap between the trade channels at hand is *de minimis*.

REGISTRATION NO. 5025988

a. No Likelihood of Confusion between Marks Taken in their Entirety

Marks are compared along the axes of their "appearance, sound, connotation and commercial impression." *In re E.I. du Pont de Nemours & Co.* at 1361. "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545–46 (1920).

The cited mark GIRLS WHO TRAVEL contains only one word in common with Applicant's mark. This word is "TRAVEL" and it is the last and the least dominant word in both marks. The mere fact that cited Registrant's mark contains the common word cannot be a basis for refusing registration to all other marks that incorporate the word "TRAVEL". Applicant has found 4330 active federal trademark registrations and applications that contain the same word. See Exhibit A. The mere fact that two marks may share a word or words in common is not dispositive of likelihood of confusion. Clairol, Inc. v. Cosmair, Inc., 224 U.S.P.Q. 229, 232 (S.D.N.Y. 1984) (SUMMER BLOND and SUMMER SUN for directly competitive hair lighteners sold through the same channels of distribution are different enough in terms of name, packaging and impression to avoid likelihood of confusion by average customer). Even where common words may appear to be "dominant", courts have held that confusion is not likely, after considering marks in their entireties. In re Cooper Tire and Rubber Co., 22 U.S.P.Q. 2d 1079, 1080 (Fed. Cir. 1991) (THE INDY TUBE for rubber inner tubes is not likely to cause confusion with INDY 500 for tread rubber used on automobile tires. The court stated "even though we agree that in parsing the marks THE INDY TUBE and INDY 500, similarities can be found, we do not agree that the marks are, in their entireties, similar as to appearance, sound and commercial impression").

In addition, Applicant's mark contains a distinctive logo that contains the letters WWT surrounded by a square design and separated by diagonal lines. This design part of the mark further distinguishes it from the cited mark.

In sum, the commercial impressions and differences of these marks in sound, meaning, connotation and appearance in their entireties makes these marks very different and Applicant's mark will not cause any confusion with the Cited Mark. Therefore, the Applicant's Application should be approved.

b. No Likelihood of Confusion of Mark Based on Trade Channels and Sophistication of Consumers

Applicant's services are part of larger and famous media brand CONDE NAST TRAVELER, and they are only used on the CONDE NAST TRAVELER's website and channels. Moreover, Applicant's services are focused on adult women, while cited mark's services are focused on girls. Therefore, any confusion as to the source of the services is unlikely.

Sophistication of consumers is important and often dispositive because sophisticated consumers may be expected to exercise greater care. *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir.1992). As stated above, Applicant's services will be instantly associated with Applicant's famous media brand, CONDE NAST TRAVELER, with millions of viewers and followers. The majority of Applicant's consumers are mostly experienced readers and fans who have been following and are subscribed to Applicant's services for years and who are very well familiar with Applicant's nature of services. These consumers would never confuse the Registrant's services with Applicant's.

Also, no ordinary person without knowledge of these industries is likely to confuse these different marks.

With the foregoing in mind, any overlap between the trade channels at hand is *de minimis*.

III. CONCLUSION

In light of the foregoing, Applicant respectfully requests that its Application Serial No. 88/290991 be cleared for publication. If the Examining Attorney has any further questions regarding this application, Applicant respectfully notes that the Examining Attorney may contact the undersigned at the telephone number provided below.

Respectfully,

ADVANCE
One World Trade Center
New York, New York 10007
(Attorneys for Applicant)

By: /s/Natasa Colovic_____
Natasa Colovic

Dated: October 22, 2019
Telephone: (212) 286-8310