

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Mark:

Serial No.: 88/321,839

Filing Date: March 1, 2019

Applicant: CVS Pharmacy, Inc.

Examining Attorney: Christine Martin
Law Office 104

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Commissioner:

This communication responds to the Office Action issued April 25, 2019, concerning the above-referenced application.

DISCLAIMER

In response to the Examining Attorney's request, Applicant requests that the following statement be entered:

No claim is made to the exclusive right to use "PET" apart from the mark as shown.

RESPONSE

The Examining Attorney has initially refused registration, alleging that Applicant's PET



CENTRAL & design mark (, hereafter referred to as **Applicant's Mark**), as applied to Applicant's identified goods, is confusingly similar to: Reg. No. 4296516 for the mark PETCENTRAL, Reg. No. 2027880 for the mark PET CENTRAL, and Reg. No. 3519397 for the



following design mark: . The Examining Attorney also cited three prior pending applications as a potential bar to registration under Section 2(d) should they proceed to registration: Serial No. 87/828069 for the mark CENTRAL PET HOME ESSENTIALS, Serial No. 86/353399 for the mark PETS CENTRAL, and Serial No. 87/828097 for the following



design mark: .

As an initial matter, Applicant points out that Reg. No. 4296516 for the mark PETCENTRAL was cancelled on September 27, 2019 following the failure of the registrant to file a Section 8 declaration, and that Application Serial No. 87/828,069 was abandoned on June 7, 2019 pursuant to an inter partes decision by the Trademark Trial and Appeal Board. As these cancelled and abandoned marks can no longer form the basis of a refusal, Applicant respectfully requests that the Examining Attorney withdraw the objections based on Reg. No. 4296516 and Serial No. 87/828069 on that basis.

For the reasons discussed below, Applicant also respectfully requests that the Examining Attorney withdraw the refusals based on the marks covered by Reg. No. 2027880, Reg. No. 3519397 and Serial No. 87/828097, and that the subject application be suspended pending final disposition of Serial No. 86/353399. Applicant addresses each of the active cited registrations and applications in turn.

I. Alleged Likelihood of Confusion with CENTRAL PET HOME ESSENTIALS Design Mark.

The Examining Attorney has refused registration, alleging that Applicant’s Mark, as applied to the Applicant’s identified goods, is confusingly similar to the following design mark:



(the “**Central Garden Logo**”), assigned Serial No. 87/828097 and filed by Central Garden & Pet Company based on intent to use basis in Classes 12, 18, 20, 21, and 28 for “*fitted liners for the cargo area of vehicles; automotive seat covers; car seats for pets*”; “*animal*

leashes, collars for animals, dog jackets”; “beds for household pets; pet cushions; pet furniture; portable kennels; dog kennels; pet carrier; cat scratching pads; scratching posts; playhouses for pets; pet steps; pet accessibility ramps”; “perches for bird cages; pet feeding bowls; pet drinking bowls; racks and stands for elevated pet feeding bowls and dishes; pet waterers in the nature of portable water and fluid dispensers for pets”; and “pet toys”.

Applicant respectfully disagrees that a likelihood of confusion exists, and requests that the citation be withdrawn. Both marks were filed in logo form, and there are very clear differences between the logos that are sufficient to distinguish:



Central Garden Logo



Applicant's Mark

The Central Garden Logo prominently features a house design with a cat and dog inside the house, the word “CENTRAL” printed toward the top of the roof of the house, the words “PET HOME” in larger font below the house, and the word “ESSENTIALS” in smaller font on a separate line below “PET HOME.” In contrast, Applicant’s Mark consists of a large stylized heart design depicting a tag attached to a ring. Within the stylized heart tag is the wording “PET” in a large cursive font over the wording “CENTRAL” in a much smaller sans serif font with a small paw print after the word “CENTRAL.” Although the marks share some of the same words, the overall impression created by them is clearly very different. In support of its position, Applicant submits herewith (as **Exhibit A**) a signed agreement and consent to register from the owner of the cited application.

According to the TMEP, “[E]xamining attorneys should give *substantial weight* to a proper consent agreement. When an applicant and registrant have entered into a credible consent agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely.” TMEP 1207.01(d)(viii) (emphasis added).

As demonstrated by the attached consent agreement, the relevant parties have carefully considered the facts at hand and concluded that consumer confusion is not likely between Applicant's Mark and the Central Garden Logo, based on factors such as the appreciable differences between Applicant's Mark and the mark in the Central Garden Application, including the prominent design elements featured therein, and the differences between the parties' respective and distinct channels of trade.

In *In re E. I. du Pont de Nemours & Co.*, the Court of Customs and Patent Appeals stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

476 F.2d 1357, 1363, 177 U.S.P.Q. 563, 568. The USPTO should not substitute its own judgment concerning likelihood of confusion for the judgment of the real parties in interest who have concluded that confusion is not likely. *See In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 U.S.P.Q. 2d 1071 (Fed. Cir. 1993).

In this case, the Applicant has submitted a consent agreement stating the reasons why confusion is unlikely. Accordingly, Applicant submits that confusion is not likely between Applicant's Mark and the Central Garden Logo, and respectfully requests that the Examining Attorney withdraw the citation.

II. Alleged Likelihood of Confusion with WHOLE PET CENTRAL WHERE HEALTHY FOOD COMES NATURALLY & Design.

The Examining Attorney has also refused registration of Applicant's Mark on the ground that it is likely to cause confusion with Reg. No. 3519397 for the following design mark:



(the "Whole Pet Logo"), owned by Whole Pet Central, LLC in Class 35 for

"retail store services featuring pet food, pet supplements and pet products". As explained below, Applicant respectfully disagrees that a likelihood of confusion exists, and requests that

the citation be withdrawn. Once again, both marks were filed in logo form, and the overall commercial impressions created by the respective marks are different and sufficient to distinguish between them.

a. *Applicable Law*

The PTO bears “the burden of proving that a trademark falls within a prohibition of § 1052.” *In re Standard Elektrik Lorenz Aktiengesellschaft*, 152 U.S.P.Q. 563 (C.C.P.A. 1967). Confusion should not be concerned with “de minimis” situations, but rather with the practicalities of the real world in which trademarks exist. *See MTD Prods. Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56 (TTAB. 1976). A refusal to register based upon confusing similarity should be made only when a “likelihood” (meaning “probability”) of confusion has been established; a mere “possibility” of confusion between uses of the marks in question is insufficient to justify a refusal to register a mark. *See* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:3 (5th ed.); *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 167 U.S.P.Q. 713 (9th Cir. 1970). A newcomer to the market is not required to so mark his goods so that they are “foolproof” from the possibility of buyer confusion. *Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429, 56 USPQ 400 (7th Cir. 1943).

Marks must be compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re E.I. DuPont Co.*, 476 F.2d at 1361. In evaluating confusion, the marks are not to be dissected but rather are to be compared in their entireties. *See In re National Data Corp.*, 224 U.S.P.Q. 749, 750 (Fed. Cir. 1985); *Opryland USA Inc. v. Great American Music Show, Inc.*, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992). Similarity of the marks in one respect—sight, sound, or meaning—will not automatically result in a determination that confusion is likely. TMEP § 1207.01(b)(i).

When viewed in their entireties, the Applicant’s Mark is appreciably different visually, literally, and in terms of meaning and overall commercial impression from the Whole Pet Logo, such that confusion is not likely or probable.

b. *Applicant’s Mark is Distinguishable in Terms of Appearance*

Ample precedent dictates that the design elements in marks must be given serious weight in differentiating the marks. A design is viewed not spoken and a stylized letter design cannot be

treated simply as a word mark. *In re Burndy Corp.*, 300 F.2d 938, 940 (C.C.P.A. 1962). Here, the visual elements and design characteristics found in the cited Whole Pet Logo clearly render it distinguishable from Applicant’s Mark, leading to a finding of no likelihood of confusion. *See Private Eyes Sunglass Corp. v. Private Eye Vision Ctr. of New England*, 25 U.S.P.Q.2d 1709 (D. Conn. 1992) (finding that although mark for women’s sunglasses and mark for prescription eyewear both contained PRIVATE EYE, different typesets and addition of cartoon caricature supported a finding of dissimilarity).

Applicant’s Mark consists of a large stylized heart design depicting a tag attached to a ring. Within the stylized heart tag is the wording “PET” in a large cursive font over the wording “CENTRAL” in a much smaller sans serif font with a small paw print after the word “CENTRAL.” The overall impression is of a heart-shaped tag for the collar of a dog, cat, or other pet featuring the prominent term “Pet.”



Whole Pet Logo



Applicant’s Mark

In stark contrast, the Whole Pet Logo is dominated by the wording “WHOLE PET,” in which the “O” of “WHOLE” is replaced by a paw print design. The wording “CENTRAL” appears in a much smaller font underneath, followed by the slogan “where healthy food comes naturally.”

Consumers encountering Applicant’s Mark will focus first on the large stylized heart tag, followed by the term “PET.” They are not at all likely to confuse this stylized heart mark with the mark shown in the Whole Pet Registration, which has the words “WHOLE PET” as its largest and most eye-catching element and does not include a heart element at all. The two marks are different in terms of font, stylization, wording, and design elements such that no consumer viewing the marks as used on the Applicant and registrant’s respective goods and services would be likely to confuse the two.

c. Applicant’s Mark is Distinguishable in Terms of Meaning

The Whole Pet Logo, particularly when considered in connection with the registrant’s identified “retail store services featuring pet food, pet supplements and pet products,” also gives

rise to a different meaning in the minds of consumers than does Applicant's Mark. The cited mark consists in large part of its literal element—most prominently the phrase “WHOLE PET” followed by “CENTRAL” in smaller print along with “where healthy food comes naturally.” The only words that overlap in the marks are “PET” and “CENTRAL,” and Applicant's Mark does not contain the word “WHOLE” nor any wording similar to “where healthy food comes naturally.” The “WHOLE” element in the cited mark also cannot be divorced from the term “PET” in that mark—these two terms are displayed as a unitary phrase and must be read together as such. “WHOLE PET” gives rise to a different meaning and connotation than just the term “PET” in isolation, particularly when read in context of the wording and stylization of the marks on the whole. “WHOLE PET CENTRAL WHERE HEALTHY FOOD COMES NATURALLY” suggests taking care of the “whole pet” via “natural” and “healthy food,” whereas Applicant's prominent heart design for its PET CENTRAL logo suggests love or caring. The differences in meaning and connotation of the marks weighs against a finding of likely confusion and in favor of peaceful coexistence.

d. Applicant's Mark is Distinguishable in Terms of Sound

In addition to the significant visual and connotative differences in the marks, they also sound very different when spoken. The literal element of Applicant's Mark consists only of the two-word, three-syllable phrase “PET CENTRAL.” In contrast, the literal portion of the Whole Pet Logo consists of the eight-word, thirteen-syllable phrase “WHOLE PET CENTRAL WHERE HEALTHY FOOD COMES NATURALLY.” Moreover, the cited registration begins in “WHOLE” and ends in “NATURALLY” whereas Applicant's Mark begins in “PET” and ends in “CENTRAL.” Consumers are likely to focus on the beginning sound, end sound, and overall length of a mark as a whole rather than discrete elements within the mark. Given the significant differences between Applicant's Mark and the cited mark in terms of overall sound, confusion is unlikely.

e. Applicant's Mark and the Whole Pet Logo Possess Different Overall Commercial Impressions

Marks must be compared in terms of their entireties. *In re E.I. DuPont Co.*, 476 F.2d at 1361. When taken as a whole, and as illustrated in the above sections II.b-d., Applicant's Mark

and the Whole Pet Logo have different overall commercial impressions such that consumers encountering these marks in connection with the Applicant's and registrant's respective goods and services are not likely to confuse the marks. The marks look different, sound different, and give rise to different meanings in the minds of consumers.

For at least the above reasons, Applicant respectfully requests that the Examining Attorney withdraw the citation of the Whole Pet Logo.

III. Alleged Likelihood of Confusion with Pets Central Media Registration

The Examining Attorney has also refused registration of Applicant's Mark based on an alleged likelihood of confusion with the mark PET CENTRAL covered by Reg. No. 2027880 for "*providing on line information relative to pets and pet care products*" in Class 42. This registration was purportedly assigned to Pets Central Media, Inc. from Invisible Fence, Inc. in January 2016, after Pets Central Media filed a petition to cancel said registration on abandonment grounds. However, and consistent with Pets Central Media's own position in the cancellation action it filed, Applicant believes that any rights Invisible Fence may have once held in the PET CENTRAL mark covered by Reg. No. 2027880 had long since been abandoned at the time of the assignment, such that there were no rights left in the subject registration to be assigned. Thus, Pets Central Media did not acquire any valid rights in Reg. No. 2027880, which should be cancelled on that basis. In view of this, Applicant respectfully requests that the Examining Attorney withdraw the refusal based on this mark.

IV. Alleged Likelihood of Confusion with Pending Application for PETS CENTRAL mark.

The Examining Attorney has also cited prior pending application Serial No. 86/353399 for the mark PETS CENTRAL as a potential bar to registration under Section 2(d). The Applicant elects not to submit arguments concerning the potential citation at this time, and requests that action on the subject application be suspended pending final disposition of the prior pending mark pursuant to TMEP 1208.02(c).

V. Conclusion

In light of the above, Applicant respectfully requests that the Examining Attorney withdraw the citations of the following: Reg. No. 4296516, Reg. No. 2027880, Reg. No. 3519397, Serial No. 87/828069, and Serial No. 87/828097. Applicant also requests that action on its application be suspended pending final disposition of the pending Pets Central Media Application, No. 86/353399.

Applicant believes that it has responded to all issues raised in the Office Action. However, should any questions arise with respect to the application or the issues addressed herein, please contact the undersigned.