

U.S. Serial No. 88/305,928

RESPONSE

1. Introduction. Applicant hereby submits the following in response to the Office Action sent on April 29, 2019 for “COASTER” (U.S. Serial No. 88/305,928). The deadline to respond is October 29, 2019.

2. Likelihood of Confusion. Examining Attorney stated that the applied-for mark for “COASTER” (U.S. Serial No. 88/305,928) should be refused registration based on the likelihood of confusion with the registered mark “COASTERS” (U.S. Registration No. 2,087,912). Applicant respectfully submits that an analysis of the marks supports a finding that there is no likelihood of confusion due to (1) the dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression; and (2) the dissimilarity and nature of goods described in the application and registration of the applied-for and registered marks and the dissimilar trade channels. In re E.I. DuPont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973).

Here, the two marks are very different in their appearance, meaning and overall commercial impression. The Registrant’s mark is the term “coasters” used in connection with shoes, while Applicant’s mark incorporates the term “coaster” with a large drawing of the silhouette of a man wearing a hat in connection with decals, hats and shirts. In Registrant’s use, the base term “coast” generally means to “move easily without using power,” such as one would move while wearing comfortable shoes. On the other hand, Applicant’s mark “coaster” in connection with a man wearing a large brimmed hat evokes the meaning of a person who approaches life with ease or effortlessly. The meaning of the mark must take into consideration the context in which the mark is used and the goods that it is used in connection with. Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (COACH for handbags is dissimilar to COACH for

educational software; “[e]ven where the marks at issue are identical...the Board has found that differences in connotation can outweigh visual and phonetic similarity”). Here, the Registrant’s term COASTERS is indicative of the shoes that it is used in connection with – and brings to the consumer’s mind moving easily in the shoes. Whereas, Applicant’s mark COASTER (singular) indicates to the consumer that the man in the image above the term is coasting through life. He *is* the “coaster” living life effortlessly in a laid-back manner. The differences in overall commercial impression of the trademarks in addition to the difference between the goods themselves weighs strongly against a finding of likelihood of confusion. Based on the design, meaning, appearance and overall commercial impression of the marks, the applied-for and registered marks are very different and not likely to cause confusion among consumers.

Comparison of the Marks

“The use of identical, even dominant, words in common does not automatically means that two marks are similar.” Gen. Mills v. Kellogg Co., 824 F.2d 622, 627 (8th Cir. 987) (citing Freedom Sav. & Loan Ass’n v. Way, 757 F.2d 1176, 1183 (11th Cir. 1985), *cert. denied*, 474 U.S. 845 (1985)). Applicant respectfully submits that the applied-for for “COASTER” and the registered mark for “COASTERS” are not so similar as to cause confusion, mistake, or deception. “When evaluating the similarity of marks, courts consider the overall impression created by a mark. Each mark must be compared against the other as a whole; juxtaposing fragments of each mark does not aid in deciding whether the compared marks are confusingly similar.” Brennan’s Inc. v. Brennan’s Restaurant, L.L.C., 360 F. 3d 125, 133 (C.A.2 (N.Y.), 2004) (citing Universal City Studios, Inc. v. Nintendo Co., 746 F. 2d 112, 117 (2d Cir. 1984)).

A side-by-side comparison of the marks is not the test to use to compare the marks, especially where the goods will not be found side-by-side in the marketplace, such as is the case here. Coach Servs., Inc., 668 F.3d at 1368. Instead, the marks connotation should be considered in relation to the way the mark is used, the differences in design and the goods the mark is used in connection with. Id.

Here, the Registrant uses a plural COASTERS in connection with shoes. Applicant uses COASTER, singular, with the depiction of a man in a hat above the mark in connection with t-shirts, hats and decals. As stated above, Registrant's use when applied to shoes is suggestive (or descriptive) of moving around without the need for power thereby creating the commercial impression of ease of mobility – specifically physical movement forward with ease. On the other hand, Applicant's mark, including the term COASTER, below a depiction of a silhouette of a man with a wide-brimmed hat looking to the distance, creates the commercial impression of a relaxed, laid-back individual. COASTER suggests to the consumer that the man *is* a “coaster” – an individual who takes life effortlessly and with ease. It does *not* bring to mind movement or travel. Though the marks have a similar base word, the marks as a whole, portray very different commercial impressions to the consumer.

Additionally, Applicant's applied-for mark and Registrant's mark differ significantly in their overall designs and appearance. Even where the marks include identical terms, contrasting design elements can create very different overall appearance and commercial impression. See Private Eyes Sunglass Co. v. Private Eye Vision Center of New Milford, P.C., 1992 WL 464228 *7 (D. Conn. 1992) (PRIVATE EYE v. PRIVATE EYES; the addition of the Sherlock Holmes caricature in connection with the defendant's mark creates a dissimilar appearance and general impression); Also see Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. V. Steinway & Sons, 523

F.2d 1331, 1339 (2d 1975) (STEINWAY v. STEINWEG; two different typefaces of the two marks created a different commercial impression). Applicant's applied-for mark features a design resembling a simple hand-drawn silhouette of a man wearing a hat looking into the distance. The word "COASTER" appears directly below the figure and resembles hand-written lettering, furthering the stylistic feature of a humanistic written and drawn design, as opposed to a computerized image. On the other hand, Registrant's mark is merely a word mark for "COASTERS." Consumers will take into consideration and remember the design of Applicant's mark along with the commercial impression provided by that depiction – namely that the man in the image is "Coaster" (or one who coasts through life).

Thus, the marks, when compared in their overall designs, meaning, appearances and overall commercial impressions, are not likely to cause confusion.

Comparison and Nature of the Goods and Trade Channels

Applicant further respectfully submits that the goods are not closely related. Applicant's mark for "COASTER" is for decals, hats and shirts, while Registrant's word mark "COASTERS" is for shoes. Shoes are separately branded goods and different from decals, hats and shirts. Shoes are sold in their own separate specific sections of stores or independent stores altogether. On the other hand, decals, hats and shirts are not typically sold next to shoes. The goods are different enough to create a different commercial impression when taking into consideration the dissimilarities of the two marks in appearance and meaning.

Taking into consideration the differences in the goods, trade channels and overall commercial impression of the mark as a whole, it is unlikely that a consumer would be confused as to the source of the goods between the two marks.

3. Disclaimer. Applicant respectfully disagrees that a disclaimer is required for the term “COASTER” as used in connection with decals, shirts and hats. Applicant’s mark is not used in connection with the sale of traditional paper/cardboard “coasters” found in class 016. “Decals” are not paper coasters – instead, they are designs for transfer onto other surfaces, such as glass or metal. Nor does the term “coaster” bring to mind the typical bar coasters. Instead, the term “coaster” takes on the meaning of the laid-back man shown in the design aspect of the mark and therefore, the Applicant respectfully submits that a disclaimer is unnecessary due to the meaning of the term when used in the context of the Applicant’s mark. This is similar to a term that has a double entendre – where the mark is not considered descriptive or generic because of the second meaning that the term holds. See TMEP 1213.05. Here, the word “coaster” is not used in Applicant’s mark in connection with “coasters.”

4. Conclusion. Applicant respectfully requests Examining Attorney to reconsider the rejections in view of the discussion above.