

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

Applicant:	Microtech Knives, Inc.	Examining Attorney:	Leslie Ann Thomas-Riggs
Serial Number:	88373758	Deposit Account:	602160
Filed:	4/5/2019	Customer Number:	153554
Mark:	ICONIC	Docket Number:	MTK-49-TM

**RESPONSE TO OFFICE ACTION**

Commissioner for Trademarks  
P. O. Box 1451  
Alexandria, VA 22313-1450

Dear Sir:

Please accept the following in response to the office action dated June 6, 2019, for the above-captioned Trademark Application.

**I. Section 2(d) Refusal**

The applied-for trademark ICONIC for fixed blade knives and folding knives stands rejected as being likely to be confused with U.S. Registration 5,596,675 for the stylized trademark TRUE ICONIC for various goods including shears. Applicant respectfully requests reconsideration of the rejection that ICONIC is confusingly similar to the stylized trademark TRUE ICONIC.

Applicant agrees that the *du Pont* factors provide the generally accepted framework for evaluating a likelihood of confusion between two marks. *In re E.I. du Pont De Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). When balancing the *du Pont* factors, no single factor should be treated as dispositive; nor should the inquiry be mechanical by which the party with the greatest number of factors

wins. *Nabisco II: Nabisco Inc Nabisco Brands Company v. Warner--Lambert Company*, 220 F.3d 43, 46 (2nd Cir. 2000). Instead, the focus should be on the ultimate question of whether consumers are likely to be confused. *Paddington Corp. v. Attiki Imps & Distribs., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993).

The two key considerations are the similarity of the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”), *see du Pont*, 177 U.S.P.Q. at 567. In analyzing all relevant factors, Applicant respectfully asserts that the marks are not confusingly similar.

**A. Differences in the Sight, Sound, Meaning, and Commercial Impression of the Marks**

Under *du Pont*, the marks are compared in terms of sight, sound, meaning, and commercial impression. *du Pont*, 177 U.S.P.Q. at 567. When one mark contains additional features that distinguish its overall appearance from another mark, confusion is less likely, even when the two marks also contain similar features. *See, e.g., Miller Brewing Co. v. Premier Beverages, Inc.*, 210 U.S.P.Q. 43, 48-49 (T.T.A.B. 1981) (concluding no likelihood of confusion between MILLER and OL’ BOB MILLER’S for beverages). Even slight differences can distinguish two marks. *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (K+ and design for dietary supplement was held not likely to be confused with K+EFF (stylized) for dietary potassium supplements).

It is well settled that trademarks must be compared in their entireties. For example, the Federal Circuit has found no confusion between VARGA GIRL for calendars and the registered trademark VARGAS for calendars when evaluating all relevant factors. *In re Hearst Corp.*, 982

F.2d 493, 494 (Fed. Cir. 1992). In that case, the Federal Circuit held that the TTAB erred by giving too much weight to the similarities between VARGA and VARGAS, and not giving appropriate weight to the descriptive element GIRL. The Federal Circuit further stated that the TTAB “inappropriately changed the mark” by stressing the VARGA portion and ignoring the GIRL portion. *Id.* The Federal Circuit concluded, “When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.” *Id.* As a result, the court held that the marks VARGA GIRL and VARGAS were sufficiently different in sound, appearance, connotation, and commercial impression to negate likelihood of confusion. *Id.*

The present Office Action similarly improperly stresses the ICONIC portion of each mark while discounting many significant other features of the cited registered mark. Specifically, the cited registered mark is a stylized trademark that consists of the words “TRUE” and “ICONIC” in uppercase lettering, with the word “TRUE” directly above the first occurrence of the “IC.” In addition, a stylized poodle dog silhouette is facing to the left inside the letter “O.” The cited registered mark is thus fairly distinctive, particularly considering that at least the trademark office’s online database indicates that more than 425 other applications or registrations include the common word ICONIC. Therefore, Applicant respectfully asserts that its mark ICONIC is substantially different in appearance, sound, meaning, and commercial impression when compared to the Registrant’s stylized mark TRUE ICONIC as a whole.

#### **B. Difference in the Goods**

A likelihood of confusion analysis must also consider the goods used with the marks. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective goods so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies’ sportswear, the

Board finding that the term was suggestive of the construction of applicant's bras); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing).

In the present case, Applicant's description of goods is fixed blade knives and folding knives, and the Registrant's stylized mark is used with a number of products associated with grooming animals, including shears. While knives and shears both fall within international class 008, the products are otherwise not related, and consumers are unlikely to associate fixed blade knives and folding knives under the mark ICONIC with shears under the stylized mark TRUE ICONIC.

### **C. Conclusion**

As discussed above, the readily observable differences between the marks as a whole and the goods used with the marks negates a likelihood of confusion between Applicant's mark ICONIC and the cited stylized mark TRUE ICONIC. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the Section 2(d) rejection and allowance of Applicant's mark for publication.

## **II. Advisory Section 2(d) Refusal**

Applicant's mark ICONIC also potentially stands rejected under Section 2(d) as being likely to be confused with U.S. Application 79254134 for the stylized mark EMOJI THE ICONIC BAND. Applicant respectfully notes that the cited application appears to have been abandoned, and Applicant will respond to any rejection to the extent necessary.

