

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK LAW OFFICE 112
SERIAL NUMBER 88412530

MARK:



BARON

RESPONSE TO OFFICE ACTION

TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS:

IN RESPONSE TO THE ABOVE-REFERENCED OFFICE ACTION, the Applicant hereby submits the following.

In the Office Action of July 30, 2019, the Examining Attorney stated that the application for BARON (hereafter the "Application") may ultimately be refused registration under Trademark Act section 2(d) because of a likelihood of confusion with Registration No. 0864313 for BARON (hereafter "Prior Mark").

The Applicant respectfully disagrees, and hereby responds as follows.

Response to Section 2(d) Likelihood of Confusion:

Explanation of the *DuPont* Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely

The test for likelihood of confusion is whether a “reasonably prudent consumer” in the marketplace is likely to be confused as to the origin of the goods or services bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A 1973). Consequently, the Federal Circuit Court of Appeals adopted multiple factors for the purpose of deciding likelihood of confusion on a case-by-case basis, known as the *DuPont* factors.

Application of the *DuPont* Factors



Applying the *DuPont* factors to the instant case, Applicant hereby submits the following arguments in support of its argument that there would be no likelihood of confusion between the Application and the Prior Mark.

1) Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation, and Commercial Impression (The Sight, Sound, and Meaning Analysis)

In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their *appearance, sound, connotation, and commercial impression*. TMEP §§1207.01, 1207.01(b) (emphasis added). The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies’ sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 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 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not likely to be confused with BOTTOMS UP for men’s clothing).

Even though marks may be similar in appearance when they share “similar terms or phrases,” the Trademark Trial and Appeal Board (the “Board”) has consistently held that confusion is not likely if the marks in their entireties convey significantly different commercial impressions, or the matter common to the marks is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive or diluted. *See, e.g. Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with “CATFISH” disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). The Board has stated that similarity as to one aspect of the sight, sound, and meaning trilogy will **not** automatically result in a finding of likelihood of confusion when the goods are identical or closely related. 4 McCarthy on Trademarks and Unfair Competition § 23:21 (4th ed.) (emphasis added).

Looking at the commercial impression of the respective marks, it is clear to the average consumer that the respective marks are from more than one source based upon their appearance. Specifically, both the Applicant and the Prior Owner present their respective marks using distinct logos or fonts, each connoting a particular and distinct commercial impression.

Application	Prior Mark
	

Here, both marks use highly distinctive logo designs. Applicant’s mark prominently features the design of a head of a man with a white face and black facial features including a black moustache. He is wearing a bow tie that is black and red. He has gold hair that is outlined in red. Beneath the design, the stylized wording “BARON” appears in red. The Prior Mark prominently features a crown design. Furthermore, the design elements stand out more in the respective marks. Specifically, the word elements are significantly smaller than the design elements in the respective marks and appear at the bottom of the marks.

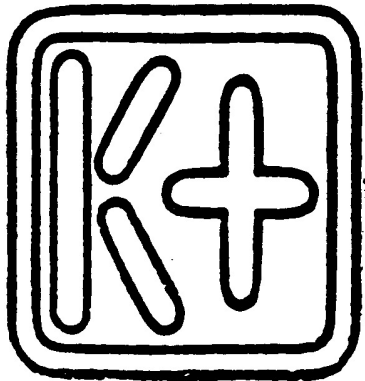
The word portion of a mark is not necessarily the more dominant and more significant feature of a mark. The Anti-Dissection rule requires that marks be evaluated in their entireties,

including their design portions. *See, e.g., Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 U.S.P.Q. 406 (CCPA 1960); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 51 U.S.P.Q.2d 1349 (10th Cir. 1999) (Because marks are to be compared in their entireties, even if the “dominant” parts of the conflicting word-design marks are the identical words, the marks as a whole are not confusingly similar).

Similarity is usually controlled by determining whether the word **or** the design dominates. *See Omaha Nat’l Bank v. Citibank (South Dakota), N.A.*, 633 F.Supp. 231, 229 U.S.P.Q. 51 (D. Neb. 1986) (where the Court held that a composite design was not infringed by the defendant’s use of the words BANK IN A WALLET alone, and that defendant’s designations are mere words while the plaintiff’s composite mark is a combination of words and design, specifically the words BANK IN A BILLFOLD and a border design resembling that on paper currency).

Moreover, the Federal Circuit has cautioned that: “**There is no general rule as to whether letters or design will dominate in composite marks.** ... No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Laboratories, Inc.*, 913 F.2d 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990, corrected, 929 F.2d 645 (Fed. Cir. 1990 (emphasis added)).

In re Electrolyte Laboratories, Inc. involved the below two marks, one of which was a composite mark with design elements, and the other a standard character mark. *Id.* at 646-47.

Composite Mark	Standard Character Mark
	<p style="text-align: center;">K+EFF</p>

The two composite marks shown above were held to not be confusingly similar when both were used for a dietary potassium supplement. *Id.* at 647-48. The letter “K” in both composites is the chemical symbol for potassium and “K+” is the symbol of the potassium ion. *Id.* at 647. “EFF” is an abbreviation of “effervescent.” *Id.* The Federal Circuit felt that the difference in the

associated **design** and the letters “EFF” were sufficient to overcome any similarity. *Id* (emphasis added).

Furthermore, any rule that words are always presumed to be dominant is merely a guideline. This “rule” of word-dominance is clearly a generality as has been shown by cases finding that a design element is dominant if more conspicuous than accompanying words. *See, e.g., Association of Co-op. Members, Inc. v. Farmland Industries, Inc.*, 684 F.2d 1134, 1141, 216 U.S.P.Q. 361 (5th Cir. 1982) (“[V]isual prominence alone does not make an element dominant. ... [W]hen a composite includes both words and a design, **the design element is likely to dominate if it is more conspicuous** or well known to the purchasing public.”); *Envirotech Corporation v. National Service Industries, Inc.*, 197 U.S.P.Q. 292, 1977 WL 22642 (TTAB 1977) (addition of word mark to a sun design similar to that of senior user was not sufficient to avoid confusingly similarity of the designs); *In Re Sloppy Joe's International Inc.*, 43 U.S.P.Q.2d 1350, 1997 WL 424966 (TTAB 1997) (composite of words “Sloppy Joe's” and large portrait of the famous writer Ernest Hemingway: the guideline that words are normally dominant was not operative because of the fame of the person pictured); *In re Covalinski*, 113 U.S.P.Q.2d 1166, 2014 WL 7496055 (TTAB 2014) (The overall commercial impression of applicant's mark was **dominated by its design features**, with the words in small lettering as part of the design. This distinguished applicant's mark from the cited word mark.).

Splitting a mark into its various components and comparing only certain portions of one mark with another mark is improper. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (C.C.P.A. 1974); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) (holding that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely). Here it is highly inappropriate to compare Applicant's mark to the Prior Mark merely upon the shared synonymous use of the wording BARON. The anti-dissection rule requires that the respective marks be considered in their entirety.

Pursuant to the anti-dissection rule, marks (including their design components) must be viewed in their entirety. The design elements of Applicant's mark should be considered the dominant portion of the mark, as the design elements are substantially larger than any word elements appearing in the mark. *See In Re Angel Computer Network Services, Inc.*, 77438719, 2013 WL 2364991, at *7 (TTAB January 25, 2013) (where the Board held a registrant's wing design to be the dominant portion of the registrant's mark, which was used for computer support

and assistance).

This creates a significant commercial impression upon the consumer in that from merely seeing either of the above marks, they know that they are viewing and purchasing services made by the respective owner.

It is well established that merely because two marks contain a similar term that there is not a likelihood of confusion. In fact, there is no rule that confusion automatically exists between marks containing the same term. *See Application of Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) (no confusion between TIC TAC and TIC TAC TOE both for impulse foods); *see also White Rock Distilleries, Inc. v. Franciscan Vineyards, Inc.*, 2009 WL 498673 (N.D. Cal. 2009) (unpublished) (Board reversed Examining Attorney and found no likelihood of confusion between VOLTA for vodka and TERZA VOLTA for wine).

In *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970), the Court of Customs and Patent Appeals affirmed the Board's decision that there was no likelihood of confusion between PEAK and PEAK PERIOD for personal care products. Likewise, in *IN RE JOHNSON & JOHNSON*, 2002 WL 649081 (T.T.A.B. 2002), the Board reversed the Examining Attorney's refusal to register the mark EPIC MICROVISION for a medical device, despite the existence of a prior registration for the mark EPIC also for a medical device. The present case is analogous. Here, the design elements of the respective marks are such that consumer confusion in commerce is highly unlikely.

“Similarity is not limited to the eye or ear. The mental impact of a similarity in meaning may be so pervasive as to outweigh any visual or phonetic differences. That is, the ‘psychological imagery evoked by the respective marks’ may overpower the respective similarities or differences in appearance and sound.” 4 McCarthy on Trademarks and Unfair Competition § 23:26 (4th ed.).

Any similarities as to appearance or sound between the respective marks, if any, are overpowered and obviated by the differences in the meaning between the respective marks, as well as the overall commercial impression and presentation of the marks in commerce.

The Applicant and the Prior Owner present, use, and advertise their respective marks in unique ways. Upon viewing Applicant’s goods, the difference in commercial impression is immediately apparent.

2) Conditions Under Which and Buyers to Whom Sales are Made

Here, the buyers of the respective goods and services will be a sophisticated. In other words, consumers making purchases of services from either the Applicant or the Prior Owner are well educated, and not likely to make such purchases on impulse.

As such, the services offered by the Applicant and Prior Owner are aimed at discriminating purchasers. “Where the relevant buyer class is composed of professional or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers...they (the professional purchasers) are usually knowledgeable enough to be less likely to be confused by trademarks that are similar. For example, the First Circuit found no infringement in the case of ASTRA local anesthetic preparation versus ASTRA computerized blood analyzer machine. The ‘most critical factor’ was said to be the sophistication of the buyers of the products.” 4 McCarthy on Trademarks and Unfair Competition § 23:101 (4th ed.); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786 (1st Cir. 1983).

The Prior Owner and Applicant deal in respective goods and services that can be extremely expensive. If the goods or services are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation. 4 McCarthy on Trademarks and Unfair Competition § 23:95 (4th ed.); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 U.S.P.Q. 81, 92 (2d Cir. 1979).

3) The Fame of the Prior Mark

All trademarks are not equal. Some are strong, some are weak and most are somewhere in between. “Strong” marks are given “strong” protection—protection over a wide range of related products and services and variations on visual and aural format. 'The stronger the mark, the more likely it is that encroachment on it will produce confusion.' Conversely, relatively weak marks are given a relatively narrow range of protection both as to products and format variations. 2 McCarthy on Trademarks and Unfair Competition § 11:73 (4th ed.). Likewise, here, there is no evidence that the cited Prior Mark is famous or has acquired secondary meaning within the marketplace or that consumers associate the term BARON with the Prior Owner. To the contrary, and as explained below, there are many marks containing the word BARON for use

within International Classes 030 for various food goods, and the Prior Owner represents a minuscule percentage of such trademarks.

4) The Nature and Extent of Any Actual Confusion

There has been no documented evidence that shows that any consumers have confused the respective marks in commerce. There have been no demonstrated events of confusion by consumers between the respective marks.

Courts have long held that concurrent use of such marks without instances of actual confusion is evidence of no confusion. 4 McCarthy on Trademarks and Unfair Competition § 23:18 (4th ed.); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490, 212 U.S.P.Q. 246 (1st Cir. 1981) (“[W]hen the marks have been in the same market, side by side, for a substantial period of time, there is a strong presumption that there is little likelihood of confusion.”); *Greentree Laboratories, Inc. v. G.G. Bean, Inc.*, 718 F. Supp. 998, 13 U.S.P.Q.2d 1161 (D. Me. 1989) (concurrent use for five years without confusion where plaintiff’s mark is weak creates a presumption that confusion is unlikely; judgment of no infringement); *Aktiebolaget Electrolux v. Armatron Intern., Inc.*, 999 F.2d 1, 4, 27 U.S.P.Q.2d 1460 (1st Cir. 1993) (“[A]n absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that little likelihood of confusion exists.”).

5) The Number and Nature of Similar Marks in Use on Similar Goods

Other marks besides those belonging to the Applicant and Prior Owner have used the word BARON for class 030 food-related goods. As a result of such registrations continued co-existence, it cannot be said that Applicant’s mark will create a likelihood of confusion. Please see Exhibit A that contains a list of numerous such marks.

Trademark	Registration	International Class
BARON’S	5558586	030
BIENEN BÄRON (translates to BEE BARON)	5438982	030

PRETZEL BARON (PRETZEL disclaimed)	4633998	030
SINCE 1889 PRETZEL BARON THREE GENERATIONS OF PRETZEL BAKING MASTERS (SINCE 1889 PRETZEL disclaimed)	4633997	030
BARONE (translates to BARON)	5658691	030
VON BARON FARMS (VON BARON translates to BARON)	4994713	030
BILL BARON'S SAVOURY SECRETS SPICE IS THE VARIETY OF LIFE (SPICE disclaimed)	4295472	030
BILL BARON'S SAVOURY SECRETS (SAVOURY disclaimed)	4295471	030
BILL BARON'S ALL NATURAL HOME & GRILL (ALL NATURAL and GRILL disclaimed)	4295470	030
BARON'S	4022775	030
THE BAKERY BARON (BAKERY disclaimed)	3332108	030
RED BARON PREMIUM QUALITY (PREMIUM QUALITY disclaimed)	2749741	030
RED BARON	1190169	030

If these marks as well as the Prior Mark are able to co-exist with so many other similar trademarks for analogously similar services, then it can also be said that there is room for Applicant's mark for BARON. Applicant submits that such extensive use of said words in this manner by third parties for similar goods or services entitles Applicant to a reduced scope of trademark protection, which weighs against a finding of likelihood of confusion.

Conclusion

Consequently, taking the respective marks in their totality pursuant to the Anti-Dissection Rule, consumers would likely be able to differentiate between the respective marks because of the differences in goods and services, difference in appearance, as well as their overall

commercial impression. Additionally, consumers of the owners' respective products are sophisticated and likely to exercise great care in purchasing their respective goods and services, and there has been no evidence of any actual confusion.

Therefore, the Applicant respectfully requests that the Examining Attorney allow Applicant's application for the mark BARON to proceed to publication. If for some reason the Examiner continues to believe that the present application is not in condition for publication, the Examiner is respectfully requested to call Applicant's attorney at (561) 295-7325 to discuss any possible amendments of the like which places the case in condition for publication, or arrange an Examiner's amendment to put the case in condition for publication.

Thank you for your consideration.

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