

Re: U.S. Trademark Application No. 88328603
Mark: ESPADA
In the name of BBE Sound Inc.

RESPONSE TO OFFICE ACTION

Dear Madam:

This communication is in response to the Office Action issued on May 16, 2019, whereby the Trademark Examining Attorney has set forth the following:

1. Registration on the principal Register is refused on the grounds that a likelihood of confusion exists with U.S. Registration No. 5471923;
2. Prior-Filed Pending Application No. 88285640; and
3. Translation Required

REMARKS

Applicant submits that the English translation of "ESPADA" in the mark is "SWORD".

Additionally, Applicant elects not to submit arguments at this time to address prior pending application for ESPADA (Serial No. 88285640), filed by Elysian Pickups, LLC on February 1, 2019, and reserves its right to address this issue later if a refusal under Section 2(d) issues.

ARGUMENTS

The Examining Attorney has refused registration of Applicant's mark for ESPADA on the ground that there is a likelihood of confusion with U.S. Registration No. 5471923 for SPADA, owned by the Roland Corporation ("Cited Mark"). Based upon the arguments outlined below, Applicant respectfully disagrees with the Examining Attorney's position and submits that consideration of the relevant factors supports the conclusion that there is no likelihood of confusion between the respective marks. For the reasons set forth below, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register on this ground.

A multi-factor test is used by the Patent and Trademark Office to assess whether there exists a likelihood of confusion between marks. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (determining likelihood of confusion by thirteen factors: similarity of the marks, similarity and nature of the goods or services, similarity of established trade channels, whether purchases are impulse or sophisticated, fame of the prior mark, amount and nature of similar marks on similar goods, actual confusion, length of time of concurrent use without evidence of actual confusion, variety of goods on which mark is used, market interface between applicant and owner of prior mark, extent that Applicant has a right to exclude others from use of its mark, extent of potential confusion, and any other probative fact). Some of the factors may not be relevant in a particular case. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003). Additionally, there is no reason why a single *DuPont* factor should not outweigh all the rest. *Kellogg Co. v. Pack 'Em Enters., Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991).

A. *The Marks Are Different.*

The first *DuPont* factor looks at the similarity of the marks in their "entireties as to appearance, sounds, connotation, and commercial impression." *DuPont*, 476 F.2d at 1361. "[T]he likelihood of confusion is reduced if the two trademarks, taken as a whole, are visually distinct." *Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 554 (10th Cir. 1998).

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In this case, Applicant's Mark "ESPADA" is visually, aurally, and connotatively distinct from the Cited Mark. First, the "E" in "ESPADA" distinguishes Applicant's from the Cited Mark both visually and aurally. The fact that the "E" in Applicant's Mark is the first letter of the mark is important because consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. In this case, when consumers view Applicant's Mark in commerce, they will read the mark from left to right, and will read "ESPADA" rather than "SPADA." Therefore, Applicant's Mark and the Cited Mark are both visually different and pronounced/sound different, and the distinctive portion of Applicant's Mark is the portion of the mark that consumers are more likely to focus on and remember.

Additionally, Applicant's Mark and the Cited Mark have different connotations and commercial impressions. Specifically, Applicant's Mark is derived from the Spanish language, whereas the Cited Mark is derived from the Italian language. Though both marks translate to "sword" in English language, the different language from which the respective marks are derived create distinct commercial impressions in the minds of consumers.

B. The Covered Goods Are Different.

The second *DuPont* factor looks strictly at "[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *DuPont*, 476 F.2d at 1361.

Applicant's Mark covers, "Musical instruments, namely, guitars and basses" in class 15 ("Applicant's Goods"). In contrast, the Cited Mark covers:

"Electronic musical instruments, namely, music sequencing machines; music synthesizers; drums; percussion instruments; electronic drums; keyboards for musical instrument; drum machines; musical instruments, namely, rhythm machines; computerized musical instruments; cases for musical instruments; stands for musical instruments" in class 15; and

"Power adapters; power adapters for USB; electrical connectors, wires, cables, and adapters; electronic controllers for sound reproduction apparatus; headphones; earphones; ear buds; in-ear headphones; audio frequency devices and apparatus, namely, audio-frequency transformers, audio frequency meters, audio frequency converters; loudspeakers; loudspeakers with built in amplifiers; amplifiers; record turntables; digital sound processors; audio recorders; digital audio recorders; digital audio players; analog and digital music and video recorders; equipment for processing analog and digital music, namely, digital sound processors; apparatus for recording, transmission, reception, processing and reproduction of sound and data, namely, CD players, DVD players, audio speakers, microphone; apparatus for storing sound and data, namely, external computer hard drives; apparatus for recording, transmission, processing and reproduction of sound, images and data for use with computer; apparatus for recording, transmission, processing or reproduction of sound, images and data; apparatus for reception of sound, images, and data, namely, audio, video, and data cable receptacles; video frequency devices and apparatus, namely, video-frequency mixers, video frequency switchers, video frequency converters, electronic switchers for audio and video signals; sound mixers; audio mixers; AV mixers, namely, audio mixers; audio and video mixing desks, namely, electronic audio mixing apparatus; software to control and improve audio equipment sound quality; computer software for controlling the operation of audio and video devices; phonograph records featuring music; downloadable music files; sound effects processors; effecters for electric or electronic musical instruments, namely, electronic effects pedals for use with musical instruments; machines for processing acoustic echo and acoustic echo effects, namely, echo sounding devices; electric and electronic effects units for musical instruments; graphic equalizers;

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downloadable music files and sound files containing music; downloadable image files and video recordings containing music and musical performances; blank magnetic recording disks for music and video; blank optical recording disks for music and music video; portable flash memory devices, namely, portable blank flash memory cards; memory expansion modules; pre-recorded electronic circuits and electronic memory devices recorded with automatic performance programs for electronic musical instruments; electronic publications, namely, book, magazine, manual featuring music and musical performances, recorded on computer media” in class 9.

(collectively, “Cited Goods”).

In comparing both marks in relation to class 15, Applicant’s Goods are limited to “musical instruments, namely guitars and basses.” In contrast, the Cited Mark is registered for use with “electronic musical instruments, namely, music sequencing machines; music synthesizers; drums; percussion instruments; electronic drums; keyboards for musical instrument; drum machines; musical instruments, namely, rhythm machines; computerized musical instruments; cases for musical instruments; stands for musical instruments.” Therefore, the Cited Goods do not overlap with Applicant’s Goods, and as a result, Applicant’s Mark and the Cited Mark will not appear on the same musical instruments. Accordingly, a consumer looking to purchase the Applicant’s Goods (i.e., a guitar or bass) will not be confused seeing the Applicant’s Mark on the product, since the Cited Mark should not appear on guitars or basses.

Indeed, the prior-filed pending application identified in the Office Action (No. 88285640) was filed on February 1, 2019—after registration of the Cited Mark—and seeks registration for the mark “ESPADA” for use with “guitars; electric and electronic musical instruments; string instruments” in class 15. Notably, no Section 2(d) refusal was issued in connection with this application based on the Cited Mark. Furthermore, Registrant did not oppose the prior-filed pending application after it was published on May 29, 2019. This indicates that Registrant does not believe there is a likelihood of confusion between the Cited Mark and the mark ESPADA. Both of these facts are strong evidence that the mark ESPADA is not confusingly similar to the mark SPADA when the musical instruments with which the respective marks are used do not overlap, as Applicant has argued above.

Furthermore, the Cited Mark is not a famous mark and therefore not entitled to a broader degree of protection.

C. *Any Confusion Between The Marks Is Merely Theoretical.*

In *Witco Chem Co. v. Whitfield Chem Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (CCAP 1967), *aff’d*, 153 U.S.P.Q. 412 (TTAB 1967) the court stated:

We are not concerned with the mere theoretical possibilities of confusion, deception or mistake or with *de minimis* situations, but with the practicalities of the commercial world, with which the trademark laws deal.

Here, it is important to note that the Cited Mark was registered under Section 66(a) and there is no evidence that it has been used in commerce. Indeed, the Cited Mark cannot be found on any products listed for sale on the Registrant’s website (<https://www.roland.com/global/>). Accordingly, the possibility of any confusion as to the source of Applicant’s Goods and the Cited Goods is merely theoretical. Moreover, the present-day practices of the commercial world are such that Applicant’s Goods are purchased and used by knowledgeable purchasers who take time to consider, understand, and closely interact with them. A theoretical or *de minimis* possibility of confusion between Applicant’s Mark the Cited Mark is not a sufficient basis for refusal to register Applicant’s Mark.

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CONCLUSION

Applicant has demonstrated that its goods and the Cited Goods share virtually no characteristics and that its customers differ from those of the Cited Goods. Further, Applicant's proposed mark is visually, phonetically, and connotatively distinct from the Cited Mark. Consequently, Applicant respectfully requests the refusal to register under Section 2(d) of the Trademark Act be withdrawn.

Respectfully submitted,

Dated: November 18, 2019

By: /s/ Susan Acquista
Susan N. Acquista, Esq.

Attorney of Record
c/o Trademark Department
DLA Piper US LLP
401 B Street, Suite 1700
San Diego, CA 92101-4297
Tel. 619-699-2723
susan.acquista@dlapiper.com,
sdtrademark@dlapiper.com