

U.S. PATENT AND TRADEMARK OFFICE
 RESPONSE TO OFFICE ACTION
 FOR ELECTRONIC SUBMISSION

Mark: REBOOT
 Ser. No. 88567924
 Our Ref: MUFE 1808743

RESPONSE TO OFFICE ACTION

ARGUMENTS

In the Office Action mailed October 8, 2019 (the "Office Action"), registration of REBOOT ("Applicant's Mark") was refused under Section 2(d) on the basis of U.S. Registration No. 4308282 (the "Cited Mark"):

TM/AN/RN	Details	Goods/Services	Owner Information
REBOOT ANTIOXIDANT BUFF Disclaims: "ANTIOXIDANT BUFF" Reg: 4308282 Serial: 85671183	Registered Affidavits: 8 Reg: 03/26/2013 Pub: 01/08/2013 Filed: 07/08/2012 First Use: 08/08/2011 Current Basis: 1a Section 8 - Accepted	003 non-medicated stimulating lotions for the skin; skin care preparation, namely, body polish, skin care preparations, namely, fruit acid peels for skin; skin texturizers; wrinkle removing skin care preparations; wrinkle-minimizing cosmetic preparations for topical facial use; astringents for cosmetic purposes; cosmetic preparations for bath and shower; cosmetic preparations for body care; cosmetic preparations for skin care; cosmetic preparations for skin renewal; cosmetic preparations, namely, firming lotions; cosmetic skin fresheners; exfoliants for skin; fragranced body care preparations, namely, body scrub, shower	Beck, Linda Litzinger DBA Make My Day Beautiful! 603 S. State Hwy. 49 #237 Jackson CA Specimen filed with Section 8 in 2019:

TM/AN/RN	Details	Goods/Services	Owner Information
		gel.; fragranced face care preparations, namely, facial cleanser; fragranced skin care preparations, namely, skin cleanser; non-medicated cleansers for personal use, namely, skin cleanser, facial cleanser; non-medicated herbal body care products, namely, skin exfoliant, cleanser and skin conditioner; seawater-based skin care preparations for skin renewal; skin abrasive preparations; skin clarifiers; skin cleansers; skin cleansing lotion;	

For the reasons set forth below, Applicant respectfully submits that there is no likelihood of confusion.

a. The Marks are Sufficiently Different

It is well established that in conducting a likelihood of confusion analysis, the Examining Attorney must compare the marks for similarities in appearance, sound and connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). “Similarity of the marks in one respect—sight, sound, or meaning—will not automatically result in a determination that confusion is likely even if the goods are identical or closely related.” TMEP §1207.01(b)(i).

The Applicant’s mark REBOOT is sufficiently different from the Cited Mark to avoid consumer confusion. The refusal is based on the Examining Attorney’s determination that the overall commercial impression of Applicant’s Mark and the Cited Mark is highly similar because each mark contains the term “REBOOT.” However, the mark REBOOT ANTIOXIDANT BUFF contains the term “ANTIOXIDANT BUFF” which does not appear in the Applicant’s Mark. In addition, the Applicant’s Mark is only one word, two syllables and six letters whereas REBOOT ANTIOXIDANT BUFF is three words, eight syllables and twenty-one letters. Moreover, the

words ANTIOXIDANT BUFF have a meaning in connection with the Registrant's goods, which are skin care preparations such as body polish, fruit acid peels, skin texturizers, firming lotions, exfoliants, skin abrasive preparations, skin clarifiers, and skin cleansers. This meaning is completely absent in Applicant's mark, which is REBOOT alone.

Taking the above into account, the Applicant's Mark and the Cited Marks cannot be considered confusingly similar as the different wording and meaning of Applicant's Mark and the Cited Marks are readily apparent and distinguishable by consumers. A factor in evaluating likelihood of confusion is whether two marks contain different words and syllables as a factor in determining similarity of appearance. *See Soft Solutions S.A.*, 2007 WL 1676770, at *4 (TTAB May 21, 2007) (non-precedential) (noting "recognizable differences in sound and appearance" between marks, including that the marks "do not have the same number of words or syllables"). The Office action failed to give the proper weight to the additional wording in the Cited Mark. The Court of Appeals for the Federal Circuit has repeatedly instructed that (a) trademarks should be viewed in their entireties as they are perceived by consumers, and (b) trademarks should not be dissected into fragments, with entire elements disregarded. For example in *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), the Federal Circuit held that there was no likelihood of confusion between VARGA GIRL and VARGAS, both for calendars. In reversing the Trademark Trial and Appeal Board, the Federal Circuit stated:

The Board erred in its analytic approach. Although undoubtedly "varga" and "vargas" are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.

So, too, in this case, it is important to "see" what the consumers see, and not simply match up elements of the marks in an artificial way.

The Office Action argued that confusion is likely because REBOOT is the dominant portion of REBOOT ANTIOXIDANT BUFF, and this dominant portion is identical to the Applicant's Mark. However, it is well established that "the use of identical, even dominant, words in common does not automatically mean that two marks are similar." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 687 (8th Cir. 1987) (holding defendant's OATMEAL RAISIN CRISP did not infringe plaintiff's APPLE RAISIN CRISP trademark); *see also Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (holding that the marks COUNTRY VOGUES for dresses and VOGUE for a fashion magazine were not confusingly similar); *Knight Textile Corp. v. Jones Inv. Co.*, 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005) (holding that the marks NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS were not confusingly similar). Similarly, given the differences in appearance and sound, the Applicant's Mark and the Cited Marks are sufficiently different to avoid confusion despite having the term "REBOOT" in common.


Finally, the Examining Attorney erred in discounting the effect of ANTIOXIDANT BUFF in REBOOT ANTIOXIDANT BUFF since the words are disclaimed. "[Disclaimed matter] cannot be ignored in determining likelihood of confusion. Such disclaimers are not helpful in preventing likelihood of confusion in the mind of the consumer, because he is unaware of their existence. Therefore, the disclaimed portions of the mark must be considered in determining the likelihood of confusion." *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570,


218 USPQ 390, 395 (Fed. Cir. 1983) (citations omitted). Thus, it is not proper to analyze the mark as if ANTIOXIDANT BUFF is not a part of it.


Taking into account the differences in appearance, sound, and commercial impression for the recited goods, there is no likelihood of confusion between the Applicant’s Mark and the Cited Mark.

b. The Cited Mark Is Weak And Is Entitled to a Narrow Scope of Protection

The Cited Mark is weak as there are already other marks containing the term “REBOOT” coexisting on the Register in Class 3 and in the marketplace; the wording is hardly unique.


Trademark Registration No. Application No. Disclaimer	Status Key Dates	Full Goods/Services	Owner
WRAP. REMOVE. REBOOT RN: 5309124 SN: 87042056 Disclaimer: "WRAP"	Registered October 17, 2017 Int'l Class: 03 First Use: January 3, 2016 Filed: May 18, 2016	(Int'l Class: 03) cosmetic body wrap system, sold as a unit, comprised of cosmetic body wraps in the nature of non-woven cloths infused with cosmetic lotions containing botanical ingredients for tightening, toning, and firming purposes, not for athletic uses, and dietary and nutritional supplements	It Works Marketing, Inc. (Michigan Corp.)
<p>Specimen filed with application in 2016:</p>  <p>IT WORKS! SYSTEM™</p> <p><i>WRAP. REMOVE. REBOOT.™</i></p> <p><i>\$37 Savings</i></p> <p><i>Includes:</i></p> <ul style="list-style-type: none"> • 1 box Ultimate Body Applicator™ (4 Applications) • 1 box It Works! Cleanse™ 4 Bottles (4 fl oz) • 1 jar Greens™ Berry (4.5 oz) • 1 bottle Ultimate ThermoFit™ (60 tablets) • 1 It Works! Blender Bottle (22 oz) 			
ROOT REBOOT RN: 5429470 SN:	Registered Int'l Class: 03 First Use: April 6, 2017 Filed: Jan 10, 2017	(Int'l Class: 03) Hair color; hair dyes; hair colourants; hair colouring; hair	Madison Reed, Inc.

Trademark Registration No. Application No. Disclaimer	Status Key Dates	Full Goods/Services	Owner
		colouring preparations; hair colouring and dyes; hair lighteners; hair care kits comprising non-medicated hair coloring preparations, namely, shampoo, conditioner, hair colouring preparations, hair colouring and dyes, and plastic gloves	
<p>Specimen filed with application in 2017:</p> 			
SUPER REBOOT SN: 88398983	Pending - Non-Final Action Mailed July 3, 2019 Int'l Class: 03 First Use: July 31, 2018 Filed: April 23, 2019	(Int'l Class: 03) Cosmetics; Make-up; Non-medicated skin care preparations	Peach and Lily, Inc. (Delaware Corp.)
Specimen filed with application in 2019:			

Trademark Registration No. Application No. Disclaimer	Status Key Dates	Full Goods/Services	Owner
			

The TESS record for SUPER REBOOT is in the record as it is cited as a prior pending application in this case. The TESS records for WRAP. REMOVE. REBOOT and ROOT REBOOT are attached as Exhibit A.

In addition, the following marks are in use in commerce:

<p data-bbox="203 1283 602 1314">Beauty Reboot Set by Shiseido</p> <p data-bbox="203 1356 337 1388">Exhibit B</p> <p data-bbox="203 1394 704 1497"> https://www.ulta.com/awaken-energy-beauty-reboot-set?productId=pimprod2004913 </p>	
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REBOOT for glitter eyeshadow

Exhibit C

https://www.litcosmetics.com/products/copy-of-reboot-electric-glitter?_pos=1&_sid=ebeaab2fb&_ss=r.



The existence of such use-based applications and registrations coexisting on the Register and in the marketplace is strong evidence that each is entitled to only a narrow scope of protection. As set forth in TMEP Sec. 1207.01(d)(iii):

[A]ctive third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

Clearly, the existence of these coexisting marks demonstrates that the Applicant's Mark REBOOT can likewise coexist with the Cited Mark without consumer confusion. In a crowded field, it is unlikely that consumers would be confused.

Conclusion

In sum, Applicant requests that the above arguments be taken into consideration against the Cited Mark, the refusal to register be withdrawn, and the application suspended pending disposition of the prior pending applications.

EXHIBIT A



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Wrap. Remove. Reboot

Word Mark WRAP. REMOVE. REBOOT

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Cosmetic body wrap system, sold as a unit, comprised of cosmetic body wraps in the nature of non-woven cloths infused with cosmetic lotions containing botanical ingredients for tightening, toning, and firming purposes, not for athletic uses, and dietary and nutritional supplements. FIRST USE: 20160103. FIRST USE IN COMMERCE: 20160103

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number **87042056**

Filing Date May 18, 2016

Current Basis 1A

Original Filing Basis 1A

Published for Opposition August 1, 2017

Registration Number 5309124

Registration Date October 17, 2017

Owner (REGISTRANT) It Works Marketing, Inc. CORPORATION MICHIGAN 908 Riverside Drive Palmetto FLORIDA 34221

Attorney of Record Steven A. Richards

Disclaimer Type of NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "WRAP" APART FROM THE MARK AS SHOWN
TRADEMARK

Mark

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ROOT REBOOT

Word Mark ROOT REBOOT

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Hair color; hair dyes; hair colourants; hair colouring; hair colouring preparations; hair colouring and dyes; hair lighteners; hair care kits comprising non-medicated hair coloring preparations, namely, shampoo, conditioner, hair colouring preparations, hair colouring and dyes, and plastic gloves. FIRST USE: 20170406. FIRST USE IN COMMERCE: 20170406

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 87296085

Filing Date January 10, 2017

Current Basis 1A

Original Filing Basis 1B

Published for Opposition November 28, 2017

Registration Number 5429470

Registration Date March 20, 2018

Owner (REGISTRANT) Madison Reed, Inc. CORPORATION DELAWARE 430 Shotwell Street San Francisco CALIFORNIA 94110

Attorney of Record Connie L. Ellerbach, Esq., Deborah Kang, Esq.

Disclaimer Type of NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ROOT" APART FROM THE MARK AS SHOWN TRADEMARK

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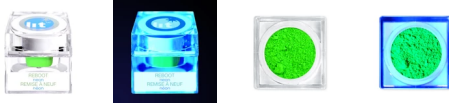
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