

The Present Application

The Applicant, Resolute Lacrosse LLC, has filed U.S. Appl. Ser. No. 88/348,806 to register the following mark:

**R=solut=s**

in International Class 025 as associated with “Bottoms as clothing for men and women; Headwear for men and women; Hooded sweatshirts for men and women; Knitwear, namely, shirts, shorts, and caps; Shorts for men and women; Sweatshirts for men and women; Tops as clothing; Tops as clothing for men and women; Wearable garments and clothing, namely, shirts.” In conjunction with the filing of this Response, the applicant has amended the listing of goods to clarify that none of them are made from denim. The Applicant has been using its mark in commerce on the foregoing goods since at least as early as August 20, 2009.

The Office Action

The Examining Attorney has rejected the present application under Trademark Act Section 2(d) based on an alleged likelihood of confusion over the following marks:

U.S. Reg. No.	Mark	Recited Goods/Services
4,290,793	RESOLUTE	Denim pants
4,770,368	RESOLUTE RACING	Athletic pants; Athletic shorts; Athletic tops and bottoms for rowing; Bandanas; Bathing suits; Bathrobes; Belts; Bow ties; Capri pants; Capris; Caps; Cardigans; Dress shirts; Flip flops; Gloves; Hats; Jackets; Long-sleeved shirts; Neckties; Pajamas; Pants; Polo shirts; Rain jackets; Rash guards; Rash vests; Rugby shirts; Scarves; Shoes; Shorts; Ski jackets; Sneakers; Socks; Sports bras; Sweaters; Sweatpants; Sweatshirts; T-shirts; Tank tops; Underwear; Unitards; Vests

The Applicant respectfully disagrees with the Examining Attorney’s conclusion under Section 2(d) for the following reasons:

Law and Argument

Determinations under Section 2(d) must be based on an analysis of all the probative evidence which bears on a likelihood of confusion. *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). In any

likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods or services. *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”).

The *du Pont* likelihood of confusion factor which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression requires considering each of these characteristics of the marks when appropriate. *Palm Bay Imports Inc. v. Veuve Clicquot Posardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005). While “the similarity of the marks in regard to one of these factors can be critical to a finding of similarity ... the law does not counsel that similarity in one factor alone automatically results in a finding that the marks are similar.” *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1609 (TTAB 2010). The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur. *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 760 (CCPA 1980). “A design is viewed not spoken, and a stylized letter design cannot be treated simply as a word mark.” *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) citing *In re Burndy Corp.*, 49 C.C.P.A. 967 (1962).

With respect to U.S. Reg. No. 4,290,793 for RESOLUTE as associated with Denim pants, the applicant respectfully submits that it has amended the goods recited by its own application to clarify that none of the goods are made from denim. While the applicant’s recited goods include shorts and other articles of clothing, no pants are recited. Respectfully, the facts support withdrawing the objection based on the ’793 registration. Specifically, not only are the registrant’s products for a very particular clothing article, denim pants that differ from those of the applicant, but the applicant is applying to register a stylized mark: this must be considered in analyzing the dissimilarity of the marks. *See In re Electrolyte Laboratories, Inc.*, 929 F.2d at 647. The fact that the mark of the ’397 Registration has been capable of coexisting with the mark of U.S. Reg. 4,770,368 for RESOLUTE RACING supports that the Applicant’s mark is also capable of coexisting. Moreover, the facts show that the Applicant has been selling its goods in commerce for over ten years. There has been no confusion in the marketplace despite the longtime coexistence of the denim pants allegedly being sold under the ’793 Registration and the Applicant’s clothing being sold under its stylized mark. *See Declaration of Anthony Kelly* which is hereby being filed with this Response as Exhibit A. This strongly rebuts the Examining Attorney’s allegations regarding a likelihood of confusion and supports permitting the mark of the present application to proceed to registration.

With respect to U.S. Reg. No. 4,770,368 for the RESOLUTE RACING mark, the Applicant notes that its use of its mark on the goods recited in the pending application actually predates the claimed use of the RESOLUTE RACING mark of the ’368 Application. While the Applicant appreciates that cancellation proceedings are available to remove the RESOLUTE RACING mark from the registrar, the Applicant is hopeful that such proceedings are not necessary. Specifically, the ’368 Registration claims that the

RESOLUTE RACING mark has been used on clothing since Oct. 1, 2014. As discussed above, the Applicant has been using its stylized mark on clothing since at least as early as 2009. Yet, the Applicant is not aware of any confusion that has occurred in the marketplace despite the coexistence of these marks. See Ex. A. This strongly rebuts the argument that there is a likelihood of confusion and suggests that the Applicant's mark should be permitted to register. The fact that the '368 Registration is capable of coexisting with the '793 Registration similarly supports that the Applicant's mark is also capable of coexistence.

## EXHIBIT A

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

Applicant : Resolute Lacrosse LLC  
 App. Ser. No. : 88/348,806  
 Filed : Mar. 20, 2019  
 Mark : **R=solut=**  
 Docket : RES3325-005  
 Examining Attorney : Anna J. Oakes  
 Law Office : Law Office 103

**DECLARATION**

I, Anthony Kelly, am owner of the applicant Resolute Lacrosse LLC (“Resolute Lacrosse”). I have personal knowledge of the information within this declaration, which is being provided to the United States Trademark Office in conjunction with the Applicant’s response to the Office Action that issued on May 29, 2019 in Application Ser. No. 88/348,806 (“the ’806 Application”). The ’806 Application seeks to register the following mark:

**R=solut=**

hereinafter “the Mark,” in conjunction with certain articles of clothing. Resolute Lacrosse has been selling “Bottoms as clothing for men and women; Headwear for men and women; Hooded sweatshirts for men and women; Knitwear, namely, shirts, shorts, and caps; Shorts for men and women; Sweatshirts for men and women; Tops as clothing; Tops as clothing for men and women; Wearable garments and clothing, namely, shirts” displaying the Mark since at least as early as August 20, 2009. I have been informed that the ’806 Application has been rejected based on an alleged likelihood of confusion over the following trademarks:

U.S. Reg. No.	Mark	Recited Goods/Services
4,290,793	RESOLUTE	Denim pants
4,770,368	RESOLUTE RACING	Athletic pants; Athletic shorts; Athletic tops and bottoms for rowing; Bandanas; Bathing suits; Bathrobes; Belts; Bow ties; Capri pants; Capris; Caps; Cardigans; Dress shirts; Flip flops; Gloves; Hats; Jackets; Long-sleeved shirts; Neckties;

		Pajamas; Pants; Polo shirts; Rain jackets; Rash guards; Rash vests; Rugby shirts; Scarves; Shoes; Shorts; Ski jackets; Sneakers; Socks; Sports bras; Sweaters; Sweatpants; Sweatshirts; T-shirts; Tank tops; Underwear; Unitards; Vests
--	--	---

Collectively "the Cited Marks." I further understand that the registrations for the cited marks each allege that use of the respective marks has been going on for a number of years. I am very familiar with the use that is being made of the Mark and the goods being sold thereunder. I am not aware of any confusion in the marketplace that has occurred despite the seemingly long-term coexistence of the Mark and the Cited Marks.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on November 20, 2019.

Signature: 

Printed Name: Anthony Kelly

Title: Owner of Applicant

Date: November 20, 2019