

Response to Office Action

MARK: CLEO

SERIAL NO.: 88560750

APPLICANT: Ran Deng

FILING DATE: August 1, 2019

INTERNATIONAL CLASS: 024

TO: Meghan Reinhart
Examining Attorney
USPTO, Law Office 108

Applicant, Ran Deng (“Applicant”) respectfully submits this Response to the Office Action issued on October 29, 2019 against Application Serial No. 88560750 for the “CLEO” mark (for *Bath towels; Bed linen and table linen; Bed sheets, fitted bed sheet covers, bed flat sheets, and pillow cases used in the bedding, health care, home-health care and nursing home industries made of biodegradable film created from renewable bio-polymer resources; Bedspreads; Children's bed sheets, pillow cases, and blankets; Cloths for removing make-up; Curtains; Dish towels for drying; Door curtains; Fitted toilet seat covers of textile; Flannel; Mosquito nets; Natural and synthetic fabrics and textiles, namely, cotton, silk, polyester and nylon fabrics; Pet blankets; Pet overnight sets composed primarily of a pet blanket and also including pet pajamas sold as a unit in a bag; Pillowcases; Sleeping bag liners; Sleeping bags; Wall hangings of textile; Baby bedding, namely, bundle bags, swaddling blankets, crib bumpers, fitted crib sheets, crib skirts, crib blankets, and diaper changing pad covers not of paper* in Class 024) (the “Applicant’s Mark”).

The Examiner has refused registration on the ground that Applicant’s Mark is likely to cause confusion with the trademark bearing Registration No. 4619701 (MADE BY CLEO in Class 018) (the “Cited Mark”). Applicant maintains that, for the reasons set forth below, this confusion is unlikely, and therefore the Cited Mark should not pose a bar to registration.

For the reasons set forth herein, Applicant respectfully requests that the CLEO mark be granted registration on the Principal Register.

I. Likelihood of Confusion Refusal

1. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont De Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “not concerned with 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.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969). As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording. Moreover, registrations for identical marks (which Applicant’s mark and Cited Mark are not) for

closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion.

2. Applicant's Mark Is Visually and Aurally Dissimilar from The Cited Mark and The Marks Create Distinct Commercial Impressions in Their Respective Contexts

Applicant's Mark is dissimilar from the Cited Mark in appearance and overall commercial impression.

In determining likelihood of confusion, marks being compared should be considered in their entirety. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

In determining the commercial impression created by a mark, the mark must be viewed in its entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although “Vargas” and “Varga” were similar, “the marks must be considered in the way they are used and perceived ... and all components thereof must be given appropriate weight.” The court went on to say that “[b]y stressing the portion ‘varga’ and diminishing the portion ‘girl’, the Board inappropriately changed the mark.” *In re Hearst Corp.* at 1239, *see also Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not likely to cause confusion with ALL, both for household cleaning products).

The Examining Attorney, in its October 29 Office Action letter, asserts that Applicant’s Mark, CLEO, in standard characters, is confusingly similar to the Cited Mark, MADE BY CLEO, also in standard characters, “because they both contain or consist entirely of the term “CLEO.” For the reasons set forth below, Applicant respectfully disagrees.

First, consumers are generally more inclined to focus on the first part of a trademark when attributing it to a source. The Cited Mark begins with the words “MADE BY” whereas Applicant’s Mark does not. By referencing who Registrant’s goods are “made by,” the Cited Mark specifically identifies the originator, which acts as a strong-source identifier, and obviates any confusion between Applicant’s Mark and the Cited Mark. When consumers encounter the Applicant’s and Registrants’ marks in commerce, they will prioritize the beginning of the marks, and understand that each mark serves as a unique source identifier. Applicant’s Mark, on the other hand, is a one-word Mark that lacks the same stylistic flair as the Cited Mark. In that same vein, Applicant argues that the different lengths of the compared Marks also alters the immediate commercial impression conveyed by each. As stated, Applicant’s Mark is one-word, while the Cited Mark is three words. This contributes to the Marks’ aural distinctions.

Furthermore, while the Cited Mark incorporates the word “CLEO,” presumably this is meant to reference or denote the brand owner. Applicant’s use of the word “CLEO,” on the other hand, lacks any significance or meaning, and consists of a random selection of letters. This is important because it reflects the decreasing importance of brand names when it comes to Amazon shoppers and retailers, like Applicant. As 53.4% of shoppers are more willing to buy a brand they’re not familiar with on Amazon than they would

be on any other store,¹ the focus for Applicant and companies like Applicant who trade solely on Amazon, is not so much on brand recognition but on the *products*. To be clear, Applicant is not suggesting that its Mark does not function as a source-identifier, as it certainly does; however, in making their purchases, Amazon shoppers are more likely to focus on price and ratings, rather than brand names. Thus, while brand names are still important for trademark purposes, as well as marketing and promotion, the shift in focus towards price and ratings and away from brand recognition on Amazon largely eliminates likelihood of confusion issues.

As a final point about commercial impression, a quick glance at the websites for the relevant products demonstrates that the products are represented in entirely different ways. More specifically, Applicant sells its products on Amazon, and Applicant's Amazon store features Applicant's products in a utilitarian, no-frills way that simply displays the product without bright colors or catchy displays. (See, https://www.amazon.com/Cleo-Standard-Pillowcases-Cotton-Pillow/dp/B07VWQJ51P?ref=ast_bbp_dp). On the other hand, Registrant represent its products in ways that are wholly unique from Applicant. Registrant uses bright colors, catchy displays, and tons of imagery to display its goods. (See, <https://www.madebycleo.com/>). Thus, through their branding and promotional content, Applicant and Registrant provide differing commercial impressions, which further minimizes the likelihood of confusion between the Marks.

Ultimately, the Examining Attorney is correct in that the similarity of the marks should be considered; however, it is just one of many relevant factors to be considered. Though Applicant acknowledges that it's Mark and the Cited Mark are similar in appearance and sound, equally significant is the dissimilarity of the nature of the goods, the dissimilarity of the trade channels used to target the respective customers, and the degree of care used by the relevant consumer market. Applicant respectfully submits that a proper comparison of the *DuPont* factors confirms that consumer confusion is unlikely and that the similarity of the marks, alone, should not prohibit registration as other factors, such as the diverse nature of the goods, the conditions under which sales are made, and the distinct commercial impression created by Applicant's Mark, render the two marks distinguishable.

In combination, respectfully these differences between the marks result in distinct commercial impressions, making confusion between them unlikely.

3. Applicant's Goods and the Cited Mark's Goods Are Sufficiently Unrelated to Render Consumer Confusion Unlikely

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) . If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207, 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). TMEP 1207.01(a).

The Cited Mark's goods are *Collars for pets; Pet collar accessories, namely, bells, silencers, safety lights and blinkers, pendants and charms* in Class 018.

¹ See Exhibit 1, the 2018 Amazon Shopper Behavior Study, P. 7.

Applicant's goods are *Bath towels; Bed linen and table linen; Bed sheets, fitted bed sheet covers, bed flat sheets, and pillow cases used in the bedding, health care, home-health care and nursing home industries made of biodegradable film created from renewable bio-polymer resources; Bedspreads; Children's bed sheets, pillow cases, and blankets; Cloths for removing make-up; Curtains; Dish towels for drying; Door curtains; Fitted toilet seat covers of textile; Flannel; Mosquito nets; Natural and synthetic fabrics and textiles, namely, cotton, silk, polyester and nylon fabrics; Pet blankets; Pet overnight sets composed primarily of a pet blanket and also including pet pajamas sold as a unit in a bag; Pillowcases; Sleeping bag liners; Sleeping bags; Wall hangings of textile; Baby bedding, namely, bundle bags, swaddling blankets, crib bumpers, fitted crib sheets, crib skirts, crib blankets, and diaper changing pad covers not of paper* in Class 024.

Applicant's goods are not related to the Cited Mark's goods. Specifically, Registrant's goods consist solely of pet collars and pet accessories, which are available in a variety of prints, textiles, and materials. Registrant's products are for pets only and Registrant markets itself as a stylish pet accessories company. (See, <https://www.madebycleo.com/>). Applicant's goods, on the other hand, are various textiles and linens for the bath and the bedroom. Applicant's products are simple and for every-day use.

Further, given the significantly more meaningful distinctions between the two marks, described above, the Office must show a proportionally higher degree of relatedness to support a finding that the two marks would overall be confused in the marketplace.

Applicant respectfully maintains that in light of the forgoing arguments these goods are not sufficiently related to warrant the finding of 2(d) confusion.

4. The Channels of Trade and Conditions Under Which Sales Are Made Render Consumer Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. See also *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); See also, *In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public). Additionally, where goods or services move in different channels of trade, confusion as to source is unlikely. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between opposer's mark E.D.S. for computer services and applicant's mark EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets).

Applicant's Mark and the Cited Mark are unlikely to be confused for the reasons set forth above, and because the associated goods travel in vastly different trade channels. Applicant's goods are sold direct to consumers on the Amazon website only. Conversely, the Cited Mark's goods are available on Registrant's website, as well as on Etsy, a site devoted to individual craftsmanship and more artisanal goods, as opposed to the utilitarian retailers on Amazon. (See, <https://www.madebycleo.com/> and <https://www.etsy.com/shop/MadeByCleo>).

Therefore, the channels of trade and the conditions under which the respective products are sold are distinct, and the 2(d) refusal should be withdrawn.

II. Conclusion

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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