

Dear Madam:

This is in response to the Examining Attorney's Office Action e-mailed May 23, 2019 in the above captioned case.

## **RESPONSE**

### **1. Introduction; Test for Likelihood of Confusion**

In the subject Office Action, the Examining Attorney refused registration of Applicant's trademark THE HYPE COLLECTION on the Principal Register under Section 2(d) of the Trademark Act on the ground that the mark, when used in conjunction with the identified goods, is likely to be confused with the previously registered trademarks Registration of the applied-for mark is refused because of a likelihood of confusion with the following marks:

1. HYPE in standard character form for use in connection with "Cartomizers, namely, combination electronic cigarette refill cartridges sold empty and atomizers, sold as a component of electronic cigarettes; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarette refill cartridges sold empty; Electronic cigarettes; Matches; Tobacco" in Class 34 (U.S. Registration No. 4587435) and
2. HYPE ENERGY in stylized form with a design for use in connection with "Cartomizers, namely, combination electronic cigarette refill cartridges sold empty and atomizers, sold as a component of electronic cigarettes; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarette refill cartridges sold empty; Electronic cigarettes; Matches; Tobacco" also in Class 34 (U.S. Registration No. 4587541).

The fundamental objective of the Lanham Act is "making registration more liberal, dispensing with mere technical prohibitions and arbitrary provisions and modernizing the trademark statutes so that they will conform to legitimate present-day business practice." *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 566 (C.C.P.A. 1973). The underlying goal of enactment, as stated by the C.C.P.A., was "the protection of trademarks, securing to the owner the goodwill of his business and protecting the public against spurious and falsely marked goods." *Id.* The Lanham Act is intended to provide protection from confusion on

the consumer level and is intended to be measured in the actual marketplace, not in the abstract. Moreover, the default being registration, it is clear the Act should be interpreted so as to facilitate rather than inhibit registration. *See 15 U.S.C. § 1052(d)* (Lanham Act § 2(d)) (providing "No trademark . . . shall be refused registration . . . unless it . . . so resembles a [prior mark] as to be likely . . . to cause confusion...." (emphasis added).

Because the Act seeks to make registration more liberal and mandates registration as the default, the test for refusing registration to a mark is correspondingly strict. In determining whether a mark should be refused registration, the Act speaks not of a possibility of confusion, but requires that confusion be likely to occur. Further, the test looks beyond incidental occurrences of confusion and requires "an appreciable number of ordinarily prudent purchasers" be likely to confuse the source of the newcomer's products or services with the source of another existing prior mark. *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 199 U.S.P.Q. 65 (2d Cir. 1978), cert. denied, 439 U.S. 1116, 200 U.S.P.Q. 832 (1979).

The ultimate question of likelihood of confusion is one of fact and numerous factors are relevant in making such a determination. Such factors include, inter alia, a comparison of the sight, sound, appearance, and commercial impression of the relevant marks, and a comparison of the relevant goods, channels of trade for the goods and the nature of the consumers for said goods. *See E.I. DuPont*, 476 F.2d at 566-67; see also TMEP § 1207.01. Applicant respectfully submits and discusses further below that all relevant factors weigh in favor of Applicant and against finding a likelihood of confusion.

## **2. The Marks Are Not Confusingly Similar.**

### **a. Confusion Is Unlikely Because The Goods Exist in a Broad Field and The Purposes And Functions Of The Goods Are Distinguishable**

Applicant contends that a finding of no likelihood of confusion is mandated by the highly specialized nature of each party's goods. In fact, the case at hand presents itself as one in which there will be effectively no competitive proximity between the parties' respective goods, such goods being marketed differently to different customers.

Applicant's goods are "Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges; Liquid nicotine solutions for

use in electronic cigarettes.” The cited marks are used in conjunction with, “[c]artomizers, namely, combination electronic cigarette refill cartridges sold empty and atomizers, sold as a component of electronic cigarettes; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarette refill cartridges sold empty; Electronic cigarettes; Matches; Tobacco.”

The realities of the marketplace mandate consumer orientation to the specific utility or function of the environment in which these products will be sold to the consumer. A consumer looking for specific cigarette, component of an e-cigarette, or cartomizer will be very clearly not be looking for a “frozen blue raspberry” flavored e-liquid bottle with which to fill its personal vaporizer. (See Exhibit A for a screenshot of Applicant’s products) The e-cigarette and vaporizer industry is a crowded, and highly specialized industry with all sorts of very specific products from e-liquids to the actual devices in which the liquids may be used. Such consumers are forced to be very specific and sophisticated about the products they purchase due to it being such a crowded industry.

Noting that a likelihood-of-confusion analysis may focus on "dispositive factors," the Federal Circuit reversed a Board decision sustaining a Section 2(d) opposition where the marks were identical and the goods and services superficially related. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350, 1353 (Fed. Cir. 2004). This opposition involved RITZ applied to cooking classes versus the identical mark RITZ applied to various kitchen textiles. The Federal Circuit disapproved of the Board's rationale that "the services of applicant clearly require the use of certain of opposer's goods," and clarified that simply because "two goods are used together . . . does not, in itself, justify a finding of relatedness," *Id.* at 1355, and that "aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from the same source," *Id.* at 1356.

In view of the specialized and distinguishable nature of the goods and the purposes to which the products are directed, Applicant's goods and the goods in the cited registration are not so "related" that there is any dispositive likelihood of confusion as to the source, connection, or sponsorship of the goods in the minds of the consumers.

**b. The Nature of the Goods and the Conditions of Purchase**

The nature of the goods at issue and the degree of care likely to be exercised by purchasers of those goods must be considered in a likelihood of confusion analysis. *Accuride Int'l Inv. v. Acuride Corp.*, 10 U.S.P.Q. 1589, 1595 (9 Cir., 1989).

As alluded to above, a consumer would not purchase Applicant's products or the products identified in the cited registration impulsively but would contemplate such a purchase due to the costs involved, the high number of "imitators" involved in the industry, the broad variety of products, and the fact that the product must fit the purpose the consumer desires. And since any of the goods would come in direct contact with the consumer's body, greater care must be taken in choosing what product is placed on something so personal to the consumer. Thus, consumers and potential consumers would be inclined to a great deal more circumspection before selecting and purchasing the goods. Thus, the nature of the goods and the conditions of purchase support the conclusion that there is no likelihood of confusion between the marks.

c. **Confusion is Not Probable**

In performing any likelihood-of-confusion analysis, it is essential to remember that likelihood of confusion "is synonymous with 'probable' confusion – it is not sufficient if confusion is merely 'possible.'" J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4<sup>th</sup> ed. 2006). Or, as the Court of Appeals for the Federal Circuit has put it, "[w]e are 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." *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969)). See also *Phoenix Closures Inc. Yen Shaing Corp. Ltd.*, 9 U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this Board will not base a finding of likelihood of confusion upon such theoretical possibilities."); *Restatement (Third) of Unfair Competition* § 20 cmt. g (1995) ("[A] few particularly undiscerning persons may make purchasing decisions under a wide range of misconceptions. An actor is subject to liability for infringement only if the actor's use of another's designation is likely to confuse a significant number of prospective purchasers"). In other words, it is well-settled that there is no likelihood of confusion, as opposed to a *possibility* of confusion, even between identical marks where any confusion would arise only

through accident or chance confrontation. For example, in *Fesco, supra*, the applicant's mark FESCO and Design for use in connection with "distributorship services in the field of farm equipment and machinery" was refused registration in view of the registered mark FESCO for, *inter alia*, "fertilizer" and "fertilizer coolers and dryers." Although the Board deemed the marks "virtually identical" and observed that the cited mark FESCO was arbitrary and therefore a "relatively strong designation," the Board nonetheless found no likelihood of confusion:

[E]ven identical marks would have little opportunity, in our view, other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regard, the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties.

*Fesco*, 219 U.S.P.Q. at 438 (emphasis added). See also Borg-Warner, supra, 225 U.S.P.Q. at 224 (no likelihood of confusion found between identical marks BLENDEX applied to "stabilizing chemical composition for fertilizers and pesticides" and "synthetic resinous compositions for use in the industrial arts," Board finding that "there would be little opportunity other than through accidental or chance confrontation, for these marks to create confusion among customers or potential customers of applicant or opposer and while confusion as to source may be possible, it is not likely").

**d. Overall Impression Created by the Marks is Not Confusingly Similar**

One of the important factors in determining whether a likelihood of confusion exists is the overall impression created by the marks in question. The commercial impression of the marks as with the sight, sound, and meaning, is not derived from the elements separated and considered apart from each other, but from the marks as a whole, since that is the manner in which they are used and the manner in which they are encountered by those exposed to them. See *In re American Physical Fitness Institute, Inc.*, 181 USPQ 127 (TTAB 1974).

In *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 644 F.Supp. 542, 231 USPQ 569 (S.D. Fla. 1986), the court found the mark FINAL FLIP was not confusingly similar to the registered mark FLIP, both for use with a pesticide. Even though they shared the term “final,” the marks were “ultimately different.” In part, because it found the mark FINAL to be weak, the Court held that the addition of the word FLIP, a distinctive word, effectively negated any confusing similarity. *See also Fruit of the Loom, Inc. v. Fruit of the Earth, Inc.*, 3 USPQ2d 1531 (TTAB 1987).

Like the marks cited in the cases above, Applicant’s mark and Registrant’s mark do not consist of identical symbols, letters, and characters in their stylized logos, as discussed above; rather, the marks have distinctly different commercial impressions to the consumer. The consumer will see Applicant’s meticulously crafted packaging with unique cursive script, the shaded coloring, and know it is very different from the cited mark’s block bubble like text, which is also nearly impossible to find anywhere online.

### 3. **Conclusion**

From the foregoing, it is clear that not only are the marks of Applicant and Registrant different, but the products sold are distinguishable to the consumer as suggested by the difference in the respective marks and the sophistication of the consumer in a broad and crowded field. Accordingly, Applicant believes that the case is in condition for allowance and publication.

If the Examiner believes that any further revisions or amendments are necessary for allowance, it is requested that she contact the undersigned attorney at (657)204-6844 or via email at [yasmine@kalawpartners.com](mailto:yasmine@kalawpartners.com).

Attorney thanks Examiner for her consideration.

(Evidence in the nature of Exhibits A has been attached.)