

Refusal – Likelihood of Confusion

Registration of the instant application has been refused with respect to Class 35 only “because of a likelihood of confusion with the mark in U.S. Registration No. 1227678” (the “Cited Mark”). The Cited Mark, which is owned by MAIYCHER, s.r.o. (“Registrant”), is depicted as follows:



Applicant respectfully submits that this refusal is misplaced as its mark is readily distinguishable from the Cited Mark, and as such, consumers are unlikely to confuse Applicant’s mark with the Cited Mark.

A. Legal Standard

To determine whether likelihood of confusion exists, the Examining Attorney must consider *all* of the *DuPont* factors that are relevant to a particular case. *See In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); *see also Recot, Inc. v. Becton*, 214 F.3d 1322, 1326 (Fed. Cir. 2000) (whether likelihood of confusion exists is determined “on a case-specific basis” using the *DuPont* factors). An analysis of these factors demonstrates that there is little likelihood of confusion between Applicant’s mark and the Cited Mark.

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) (“*McCarthy*”) § 19:75 at 19-230. To refuse registration under Section 2(d), the Examining Attorney “must present sufficient evidence and argument that the mark is barred from registration.” *Id.* § 19:128 at 19-383. Here, respectfully, the Examining Attorney has not met her burden.

B. There is No Likelihood of Confusion Between Applicant's Mark and the Cited Mark

When determining likelihood of confusion under § 2(d), marks are compared based on their appearance, sound, meaning, and commercial impression. *See Du Pont*, 177 U.S.P.Q. at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Importantly, the likelihood of confusion analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 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.”). Courts also have cautioned that there is no general rule that the letter portion of a mark will form the dominant portion of the mark. *See In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed.Cir.1990).

As a reminder, the Cited Mark appears as follows:



Here, the Examining Attorney claims the parties' marks are confusingly similar simply because both “contain the phonetically equivalent wording ATTEST and ATEST.” Respectfully, there are numerous flaws with this argument.

First, by focusing solely on the alleged phonetic similarities between the terms “ATEST” and “ATTEST” and ignoring all of the other elements in the Cited Mark, the Examining Attorney has failed to consider the marks as a whole. *See Franklin Mint*, 212 USPQ 233 at 234 (CCPA 1981); *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its

elements separated and considered in detail.”). When viewed in their entirety, as they must be, it is clear that the parties’ marks look and sound different, and convey different commercial impressions.

Second, to the extent the Examining Attorney is entitled to elevate any component over another, that element must be the prominent blue and grey concentric circles that dominate the Cited Mark. Not only is this the first element to catch a consumer’s eye when naturally viewing the Cited Mark from left to right, it completely dwarfs the accompanying text. The Board has routinely found such prominent use of a design element to be a strong indicator of no likelihood of confusion. *See In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods); *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966) (confusion was unlikely



between applicant’s mark and several marks owned by opposer consisting of or containing FERRO, due to the dominance of the design elements of applicant’s mark and the relatively small typeface in which FERRO appeared); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (prominently displayed design considered to be dominant element



of the mark **BODYMAN** because it catches the eye and engages the viewer before the viewer looks at the word “Bodyman”); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477,



1478-79 (TTAB 1987) (no likelihood of confusion between for restaurant services and STEVE’S for ice cream; “Even with the word ‘STEVE’S’ appearing above the hot dog figures, applicant’s mark is distinguishable from the registered mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”).

Third, even if consumers were somehow able to exclude the large design element that dominates the Cited Mark and focus solely on the smaller literal elements, there is no evidence that they would disregard the “CODE” element in the Cited Mark and view it only as “ATEST.” Both the “TEST” element in the “ATEST” term and the word “CODE” are depicted in the same grey color. Moreover, they are also approximately the same size. Because of this, it is likely that consumers, at best, would view the literal element in the Cited Mark as being “ATEST CODE,” not just “ATEST.”

Fourth, even if one were to assume that the sole dominant feature in the Cited Mark is the term “ATEST,” there is no evidence that consumers would view this term as unitary. In its description of its mark, Registrant concedes that “the ‘A’ in ‘ATEST’ appears stylized in blue and ‘TEST’ in gray.” This indicates that consumers who encounter this term would likely view it as the separable words “A TEST” instead of as a unitary term, especially considering that Registrant includes “testing of materials” in its services description in Class 42. Indeed, considering that the “A” in the cited mark is depicted as a different colored caret, it is even likely that consumers would disregard this letter altogether and simply view this term as “TEST.”

Fifth, even if one were to assume that the term “ATEST” in the Cited Mark was a unitary term, there still is no evidence that consumers would pronounce this term the same way they would pronounce Applicant’s ATTEST mark. Generally speaking, the emphasis in the word “ATTEST” in Applicant’s mark is on the second syllable. In contrast, because of the way the term “ATEST” is depicted, consumers are likely, at best, to pronounce this term with an emphasis on the first syllable – i.e., as “A TEST.” Indeed, for this same reason, it is logical that consumers who encounter the Cited Mark would even view it as “A TEST CODE” when read in its entirety.

In sum, when the parties’ marks are compared in their entireties, as they must be, it is unlikely consumers will confuse Applicant’s ATTEST word mark with the Cited Mark. Nor, respectfully, has the Examining Attorney met her burden of compelling a different result.

C. Conclusion

Based on the foregoing, Applicant respectfully requests that the Examining Attorney withdraw her refusal to register Applicant’s mark because there is no likelihood of confusion between Applicant’s mark and the Cited Mark.