

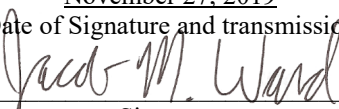
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I hereby certify that this correspondence is being electronically transmitted
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November 27, 2019

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By


Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 88/394,070
Filing Date: April 19, 2019
Applicant: A LITTLE FAITH MINISTRIES
Mark: FACTOR
Examining Attorney: Emma Sirignano
Attorney Docket: 70634-1

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

REPLY

Honorable Commissioner:

In response to the Office Action mailed July 1, 2019, for which the statutory period for reply is set to expire January 1, 2020, please reconsider the application in view of the remarks set forth below.

Remarks begin on page 2 of this paper.

REMARKS

1) Indefinite Identification of Services – Amendment Required

In the Office Action at page 4, the Examining Attorney requested that the identification of services be clarified. Applicant has hereby amended the goods and services description as suggested by the Examining Attorney. More specifically, the goods and services description has been amended to “[p]roviding emotional counseling and emotional support services for addicts, recovering addicts, families of addicts, and anyone affected by addiction.” Accordingly, it is respectfully submitted that the objection to the goods and services description should be withdrawn.

2) Section 2(d) Refusal – Likelihood of Confusion

In the Office Action mailed July 1, 2019, registration was refused for the applied-for mark, FACTOR (“applied-for mark”), under Trademark Act Section 2(d), 15 U.S.C. 1052(d) on the ground that the applied-for mark allegedly would create a likelihood of confusion with U.S. Registration No. 5044160 (CHIILL FACTOR SOCIAL CLUB) (“the ‘160 mark”) and U.S. Registration No. 4931555 (FACTOR-SIX ASSESSMENT SERIES) (“the ‘555 mark”) (collectively as “the cited marks”).

The cited ‘555 mark is used in connection with “[p]roviding emotional counseling and emotional support services for adult women and men with substance use disorders and co-occurring psychiatric disorders” in International Class 45.

The cited ‘160 mark is used in connection with “provide community outreach and networking services, through volunteering throughout the Greater Houston Area, namely, charitable services in the nature of providing emotional support services to children, adults and families by means of arranging and conducting family friendly activities that strengthen attachment with children and families” in International Class 45.

The application for the applied-for mark has been amended to cover “[p]roviding emotional counseling and emotional support services for addicts, recovering addicts, families of addicts, and anyone affected by addiction” in International Class 45.

As more fully set forth below, the application for the applied-for mark should proceed to registration because, based on the differences between the marks

themselves, the distinctions in the services sold under the marks, the targeted marketplaces, the channels of trade through which the services are sold, and the sophistication of the customers.

Likelihood of Confusion Factors

The question of likelihood of confusion between marks is “related not to the nature of the mark but to its effect ‘when applied to the services of the applicant.’ The only relevant application is made in the marketplace. The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (original emphasis). In determining whether there is a likelihood of confusion, courts look to many factors, including as particularly relevant here:

- The similarity or dissimilarity of the marks in their entirety;
- The similarity or dissimilarity and nature of the goods or services such that one party’s services will be mistaken for those of the other party;
- The channels of distribution of the goods or services;
- The conditions under which the goods or services are purchased (i.e. impulse buying versus purchases made after careful consideration);
- The sophistication of the purchasers of the goods or services; and
- The nature and extent of any actual confusion.

Id. at 1361.

In the Office Action at pages 2-3, the Examining Attorney noted that, in this case, the most relevant factors are the alleged similarity of the marks and the alleged similarity of the services. Applicant addresses each of these factors, along with the additional relevant factors listed above, in the following sections.

I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE APPLIED-FOR MARK (FACTOR) AND THE '160 MARK (CHIILL FACTOR SOCIAL CLUB)

A. The Applied-for Mark (FACTOR) and the '160 Mark (CHIILL FACTOR SOCIAL CLUB) Differ in Sight and Commercial Impression

In determining whether there is a likelihood of confusion between marks, the overall impression in commercial context made by each mark is determinative, not whether the marks share a component. See *Pacific Sunwear of California, Inc. v. AIT, Inc.*, 2004 TTAB LEXIS 76 (T.T.A.B. Feb. 18, 2004) (PAC SUN and PAC AIT are different in overall commercial impression and not confusing). Also, when assessing the likelihood of confusion between compound word marks, although each mark must be considered as a whole, it is appropriate to consider whether a portion of the mark is dominant in creating the mark's commercial impression (See TMEP 1207.01(b)(viii)).

When a consumer is shopping, the first words of a mark usually renders it the most important and relied upon word in the mark. (See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

In this case, the applied-for mark is a single word, "FACTOR." Therefore, the entire mark is dominant. For the '160 mark, the first word and arguably the most dominant is "CHIILL." Even at a glance, a consumer will find the applied for mark distinct from the '160 mark because the dominant part of the applied-for mark is different from the dominant portion of the '160 mark. Accordingly, confusion is highly unlikely based on the dissimilarity of the applied-for mark and the '160 mark.

B. The Services under the Applied-for Mark (FACTOR) are not Similar to the Services Offered under the ‘160 Mark (CHILL FACTOR SOCIAL CLUB)

The services under the applied-for mark and the services under the ‘160 mark are different and offered to entirely disparate marketplaces.

In particular, the services under the applied-for mark are for addicts, recovering addicts, families of addicts, and anyone affected by addiction (See <https://www.factorrecovery.org/>, last accessed November 27, 2019).

By contrast the services under the ‘160 mark are completely different from the services offered under the applied-for mark. In particular the services offered under the ‘160 mark cover providing emotional support to children, adults, and families by means of arranging family friendly activities throughout the Greater Houston area. By contrast, the services offered under the applied-for mark specifically deals with specialized emotional counseling for addiction and anyone affected by addiction. In addition, the services offered under the applied-for mark does not include arrainging family friendly activities through the Greater Houston area.

Even where two marks are *identical*, which is not the case here, courts and the TTAB routinely hold that there is no likelihood of confusion “if the goods or services in question are not related in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.” TMEP § 1207.1(a)(i) (citing *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for drain opener not confusingly similar to LITTLE PLUMBER and Design for advertising services), see also *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1118 (6th Cir. 1996) (“Services are ‘related’ if the services are marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company.” (internal quotes omitted)).

Moreover, the Board has held that differences in the functions or purpose of products or series may prevent likelihood of confusion. *Aries Systems Corp. v. World Book, Inc.*, 26 U.S.P.Q.2d 1926, * 21 (T.T.A.B. 1993) (KNOWLEDGE FINDER and INFORMATION FINDER are not confusingly similar because, *inter alia*, “[s]uch products,

rather than being ...simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes.”).

Here, the marks are not identical, and the parties’ respective services are wholly distinct. Therefore, the realities of the marketplace here compel the conclusion that reasonably prudent purchasers would not believe Applicant’s specialized emotional counseling for addicts and for indirect victims of addiction would be in anyway associated with general emotional support counseling by means of arranging family activities. Accordingly, Applicant’s specialized counseling for addiction cannot be considered “related” to the services under the ‘160 mark for likelihood of consumer confusion purposes.

C. The Services under the Applied-for Mark (FACTOR) and the Services under the ‘160 Mark (CHILL FACTOR SOCIAL CLUB) are Marketed in Different Channels of Trade and are only Purchased by Distinct and Sophisticated Consumers after Careful Consideration

As the differences in the services under the applied-for mark and the ‘160 mark would suggest, the parties’ market these services to very different marketplaces in distinct channels of trade. As mentioned above, the ‘160 mark is marketed towards providing emotional support services by arranging and conducting family friendly activities throughout the Greater Houston area. The services under the applied-for mark are for providing specialized counseling for addiction. In addition, the services under the applied-for mark do not include arrainging and conducting family friendly activities through the Greater Houston area. Therefore, it is highly unlikely, that the applied-for mark and the ‘160 mark would be encountered by the same purchases under circumstances that could give rise to the mistaken belief that those services come from a common source.

In addition, it is well-settled that the likelihood of confusion is reduced where purchasers and potential purchasers of the products or services are sophisticated. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F. 2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, *inter alia*, both parties’ goods and services “are usually purchased after careful consideration by persons who

are highly knowledgeable about the goods or services and their source.”). See also TMEP § 1207.01(d)(vii) (care in purchasing tends to minimize the likelihood of confusion).

The likely purchasers of the ‘160 mark are consumers looking for emotional support through family friendly activities throughout the Greater Houston area. These consumers are looking for a very specific service, emotional support through family friendly activities, in a very specific area, the Greater Houston area. Since the service and the area where service is being offered is so specific, even consumers with a lower level of care would still be able to differentiate the services under the ‘160 mark and the services under the applied-for mark.

Moreover, the applied-for mark and the ‘160 mark are marketed towards mental healthcare. From a consumer standpoint, services relating to healthcare are unlikely to be an impulse purchase. For these reasons, this factor weights strongly in favor of a finding of no likelihood of confusion.

D. There is No Evidence of Actual Confusion between the Applied-for Mark (FACTOR) and the ‘160 Mark (CHILL FACTOR SOCIAL CLUB).

Significantly, Applicant has been advertising its services under the applied-for mark and has operated an Internet website having the applied-for mark (<https://www.factorrecovery.org>, last accessed November 27, 2019) and is unaware of any instance of actual confusion with the services sold under the ‘160 mark.

For at least these reasons, Applicant respectfully requests that the Section 2(d) refusal for likelihood of confusion relative to the ‘160 be withdrawn.

II. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE APPLIED-FOR MARK (FACTOR) AND THE ‘555 MARK (FACTOR-SIX ASSESSMENT SERIES)

A. The Applied-for Mark (FACTOR) and the ‘555 Mark (FACTOR-SIX ASSESSMENT SERIES) Differ in Sight and Commercial Impression

In determining whether there is a likelihood of confusion between marks, the overall impression in commercial context made by each mark is determinative, not

whether the marks share a component. See *Pacific Sunwear of California, Inc. v. AIT, Inc.*, 2004 TTAB LEXIS 76 (T.T.A.B. Feb. 18, 2004) (PAC SUN and PAC AIT are different in overall commercial impression and not confusing). Also, when assessing the likelihood of confusion between compound word marks, although each mark must be considered as a whole, it is appropriate to consider whether a portion of the mark is dominant in creating the mark's commercial impression (See TMEP 1207.01(b)(viii)).

When a consumer is shopping, the first words of a mark usually renders it the most important and relied upon word in the mark. (See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In this case, the applied-for mark is a single word, “FACTOR.” Therefore, the entire mark is dominant. For the ‘555 mark, the first word and arguably the most dominant is the compound noun “FACTOR-SIX.” A compound noun is made up of two or more words to form a new noun. Clearly, FACTOR-SIX, by being a compound noun, conveys a different expression than the word FACTOR alone. Therefore, a consumer will find the applied-for mark distinct from the ‘555 mark because the dominant part of the applied-for mark is different and has a different expression than the dominant part of the ‘555 mark.

Accordingly, confusion is highly unlikely based on the dissimilarity of the applied-for mark and the ‘555 mark.

B. The Services under the Applied-for Mark (FACTOR) are not Similar to the Services Offered under the ‘555 Mark (FACTOR-SIX ASSESSMENT SERIES)

The services under the applied-for mark and the services under the ‘555 mark are different and offered to entirely disparate marketplaces.

In particular, the services under the applied-for mark are for addicts, recovering addicts, families of addicts, and anyone affected by addiction (See <https://www.factorrecovery.org/>, last accessed November 27, 2019).

By contrast the services under the '555 mark cover adult women and men with substance use disorders and co-occurring psychiatric disorders. Also, and in contrast to the '555 mark, the services under the applied-for mark treat indirect victims of addiction, such as the families of addicts and anyone else affected by addiction.

Notwithstanding the dissimilarities between services under the '555 mark and the services under the applied-for mark, Applicant was unable to find any reference to the '555 mark on its owner's website (see <https://www.simplerecovery.com/>, last accessed November 27, 2019, the home page). Thus, Applicant believes the '555 mark is not being actively used in commerce

Even where two marks are *identical*, which is not the case here, courts and the TTAB routinely hold that there is no likelihood of confusion "if the goods or services in question are not related in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." TMEP § 1207.1(a)(i) (citing *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for drain opener not confusingly similar to LITTLE PLUMBER and Design for advertising services), see also *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1118 (6th Cir. 1996) ("Services are 'related' if the services are marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company." (internal quotes omitted)).

Moreover, the Board has held that differences in the functions or purpose of products or series may prevent likelihood of confusion. *Aries Systems Corp. v. World Book, Inc.*, 26 U.S.P.Q.2d 1926, * 21 (T.T.A.B. 1993) (KNOWLEDGE FINDER and INFORMATION FINDER are not confusingly similar because, *inter alia*, "[s]uch products, rather than being ...simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes.").

Here, the marks are not identical, and the parties' respective services are wholly distinct. For example, the services under the '555 mark cover adult woman and men who

have substance abuse or other psychiatric disorders. The services under the applied-for mark cover specialized emotional counseling for direct and indirect victims of addiction.

Therefore, the realities of the marketplace here compel the conclusion that reasonably prudent purchasers would not believe Applicant's specialized emotional counseling for addicts and indirect victims would be in anyway associated with counselling for diagnosable psychiatric disorders. Accordingly, Applicant's specialized counseling for addiction cannot be considered "related" to the services of the '555 mark for likelihood of consumer confusion purposes.

C. The Services under the Applied-for Mark (FACTOR) and the Services under the '555 Mark (FACTOR-SIX ASSESSMENT SERIES) are Marketed in Different Channels of Trade and are only Purchased by Distinct and Sophisticated Consumers after Careful Consideration

As the differences in the respective products would suggest, the parties' market these services to very different marketplaces in distinct channels of trade. As noted above, the owner of the '555 mark does not appear to be using the '555 mark. Thus, it does not appear that the '555 mark is marketed towards the applied-for mark's consumers.

Alternatively, if we consider the original specimen of the '555 mark, the '555 mark was used in association with a specific counseling regimen (the relevant portion of the specimen reproduced below). The regimen consisted of an exploration process for achieving academic and vocational goals. The regimen was used by existing clients of the '555 mark who were not ready to reenter into the workforce or the classroom.

addiction. Although clients in Foundation are not ready for reentry into the workforce or the classroom, during this phase clients still have an opportunity to begin the process of restoring their lives. Within the first 30 days of treatment, clients complete our **Factor-Six Assessment Series™** with a Simple Life advisor to begin the exploration process for achieving academic and vocational goals. From there, the advisors of Simple Life work with the clinical team to build an implementation plan that incorporates clinical and recovery goals with concrete life skills training.



A Portion of the Specimen Submitted for ‘555 registration on June 23, 2015

In contrast, the services associated with the applied-for mark are marketed towards addicts and indirect victims of addiction, not specifically to persons who are not ready to reenter the workforce or classroom. Given these differences, it is highly unlikely that the applied-for mark and the ‘555 mark would be encountered by the same purchases under circumstances that could give rise to the mistaken belief that those services come from a common source, even if the ‘555 mark is in fact still being used.

In addition, it is well-settled that the likelihood of confusion is reduced where purchasers and potential purchasers of the products or services are sophisticated. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F. 2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, *inter alia*, both parties’ goods and services “are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source.”). See also TMEP § 1207.01(d)(vii) (care in purchasing tends to minimize the likelihood of confusion).

The likely purchasers of the ‘555 mark are preexisting clients of the owner of the ‘555 mark who suffer from diagnosable psychiatric disorders and are unable to reenter into the workforce or classroom. These consumers are exercising a high level of care for

their mental healthcare. Therefore, it is highly unlikely that the consumers of the '555 mark would confuse the treatment services they are already receiving with the applied-for mark.

Moreover, the applied-for mark and the '555 mark are marketed towards mental healthcare. From a consumer standpoint, services relating to healthcare are unlikely to be an impulse purchase. For these reasons, this factor weights strongly in favor of a finding of no likelihood of confusion.

D. There is No Evidence of Actual Confusion between the Applied-for Mark (FACTOR) and the '555 mark (FACTOR-SIX ASSESSMENT SERIES).

Significantly, Applicant has been advertising its services under the applied-for mark and has operated an Internet website having the applied-for mark (<https://www.factorrecovery.org>, last accessed November 27, 2019) and is unaware of any instance of actual confusion with the services sold under the '555 mark.

For at least these reasons, Applicant respectfully requests that the Section 2(d) refusal for likelihood of confusion relative to the '555 mark be withdrawn.

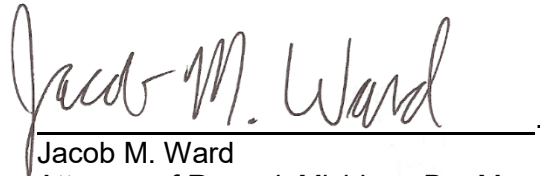
E. Request for Suspension

As stated above, Applicant does not believe the '555 mark is actively being used. In particular, Applicant was unable to find any reference to the '555 mark on its owner's website (see <https://www.simplerecovery.com/>, last accessed November 27, 2019, the home page). Accordingly, and if the Examining Attorney is not persuaded by the arguments against the '555 mark, Applicant respectfully requests a suspension of the application for the applied-for mark until April 5, 2021.

CONCLUSION:

Accordingly, Applicant believes that the application is now in condition to be approved for publication. If the Examining Attorney believes that personal communication will expedite prosecution of this application, the Examining Attorney is invited to telephone the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script that reads "Jacob M. Ward". The signature is written in black ink and is positioned above a horizontal line.

Jacob M. Ward
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