

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

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In Re Application of:		)
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Applicant:	Batty, Michael	)
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Serial No.:	88342821	)
		)
Mark:	AFTERMATH	)
		)
Filed:	March 16, 2019	)
		)
Int'l Classes:	025	)
		)
Our File No.	2019-00968	)

**RESPONSE TO OFFICE ACTION NO. 1**

Applicant Batty, Michael (“Applicant”) responds to the Office Action No. 1 mailed on June 4, 2019 as follows:

**I. REFUSAL TO REGISTER BASED ON LIKELIHOOD OF CONFUSION**

The Examining Attorney has refused registration of Applicant’s AFTERMATH mark (“Applicant’s Mark”) for “Graphic T-shirts; Hats; Shirts; Tops as clothing; all of the forgoing goods sold directly to club members” under International Class 025, Application Serial No. 88342821 (“Application”) under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the grounds that Applicant’s Mark is likely to be confused with U.S. Trademark Registration No. 2281697 for AFTERMATH, namely for “RETAIL CLOTHING AND GIFT STORE SERVICES” (“Cited Registration”)

For the reasons set below, Applicant respectfully traverses this objection and believes that its mark, and the goods and services thereunder, are distinguishable from the Cited Registration, and its goods, and that there is no likelihood of confusion between the marks of the parties.

Accordingly, Applicant respectfully submits that the Application should be allowed to proceed to publication.

## II. THERE IS NO LIKELIHOOD OF CONFUSION

There is no likelihood of confusion because of the distinct nature of the goods, channels of trade, and the number of similar marks in use when comparing the Applicant's Mark and the Cited Registration. In order for the Examining Attorney to find a likelihood of confusion, the respective goods and services covered by the marks, and not just the marks themselves must be considered. *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 U.S.P.Q. 639, 641 (TTAB 1977). The Examining Attorney must look at the covered goods and services to determine whether a relationship exists which would likely result in confusion about the origin. *In Re August Storck KG*, 218 U.S.P.Q. 823, 825 (TTAB 1983). In determining whether a likelihood of confusion is present the Examiner must consider the factors outlined under the ruling in *In re E.J. du Pont, de Nemours & Co.* 476 F.2d 1357, 1362 (C.C.P.A. 1973). These factors include, the similarity of the marks, the similarity of the nature of goods or services, the similarity of the trade channels in use, the sophistication of purchasers, the fame of the prior mark, the number and nature of similar marks, the nature and extend of actual confusion, the length of time of concurrent use without evidence of actual confusion, the variety of goods on which the mark is on, the market interface between the applicant and the prior mark, the extent of which applicant has a right to exclude other from use of its mark, and the extent of potential confusion. *Id.*

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). If assuming, arguendo, that the Cited Registration and the Applicant's mark contain similar components that fact alone is not

dispositive as to likelihood of confusion. Both the Applicant's mark and the Cited Registration have been in use concurrently for 19 years with no evidence of actual confusion. In analyzing the remaining factors, we find no likelihood of confusion.

APPLICANT'S PRODUCTS ARE DISTINCT WHEN COMPARED TO THE SERVICES OF  
THE CITED REGISTRATION

When comparing the Applicant's Mark and the Cited Registration the type of products are unique and wholly distinct. The court will look at whether the marks suggest that different goods and services may emanate from a single source. It has been found that where a product is so related to another as to form an integral relationship, the products cannot be considered distinct. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The mere fact that two products may be found in the same large store is not sufficient to establish that the products are related. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). **The Board has held products within the same international class can be held as distinct.** *In re Gelati Int'l, Inc.*, S.N. 75/179,289 (October 6, 2000). When comparing the Applicant's product to the services covered by the Cited Registration it is evident that there exists a difference between "Graphic T-shirts; Hats; Shirts; Tops as clothing; all of the forgoing goods sold directly to club members", and "RETAIL CLOTHING AND GIFT STORE SERVICES" the services covered by the Cited Registration.

With respect to both the number and nature of similar marks, it cannot be said that the Applicant's Mark is the only similar mark to the Cited Registration. For this additional reason, it would be inequitable for the Applicant's registration to be denied.

THE TRADE CHANNELS ARE DIFFERENT

The trade channels for the Applicant's Mark and the Cited Registration are different. In order to determine whether goods share common trade channels it is necessary to look at the suppliers and retailers of the goods. The court has previously held that the mere fact that two products may be found in the same large store is not sufficient to establish that the products are related. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24 (CCPA 1976). The Cited Registration is for "RETAIL CLOTHING AND GIFT STORE SERVICES". If, assuming arguendo, that the Applicant's goods and the goods covered by the Cited Registration were sold in the same store, the court has held that to be insufficient reason to hold the goods related. Applicant's products are only sold directly to club members.

ADDITIONAL MATTER IS SUFFICIENT TO REMOVE ANY LIKELIHOOD OF  
CONFUSION

It is established that in the event two marks are similar the inclusion of additional matter may be sufficient to avoid a likelihood of confusion where: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that

contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellent used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellent for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" is descriptive as applied to the relevant goods and thus has no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the

descriptive nature of "DESIGNERS/FABRIC" and "DESIGNER FABRICS," the addition of "DAN RIVER" is sufficient to avoid a likelihood of confusion). Here, Applicant's mark and the Cited Registration both offer completely distinct commercial impressions and therefore do not have a likelihood of confusion.

### THE CITED REGISTRATION IS NOT FAMOUS

The Cited Registration is not for a famous mark and is therefore not entitled to increased protections. In order for a mark to be considered famous, the mark must be well known so as to indicate the source of the covered goods. The Cited Registration does not appear to be well known. We find that the Cited Registration cannot be considered famous and therefore is not entitled to the protections afforded to famous marks.

### **III. EXTENT OF POTENTIAL CONFUSION IS DE MINIMIS**

Thus, assuming the marks may be similar, the goods and services offered are quite different in nature, are used for different purposes, are promoted differently and are purchased by different, and discriminating purchasers. Accordingly, the potential for confusion is de minimis.

### **IV. CONCLUSION**

Applicant believes that it has responded to all of the Examining Attorney's inquiries, and, specifically, has addressed the belief that there is a likelihood of confusion as between Applicant's Mark and the Cited Registration identified in the Office Action. As demonstrated above, the goods and services are distinct, likely to be sold in separate areas, and do not emanate from the same source as those provided under the Cited Registration. Accordingly, there is no likelihood of

confusion and Applicant respectfully requests that the Application be allowed to proceed to publication.