

88/598,529 for RICHARDSON (Stylized)

Attorney Docket No. 057989-0506288

REMARKS

Section 2(d) Refusal - Likelihood of Confusion

The Examining Attorney has rejected classes 25 and 41 based on Section 2(d) likelihood of confusion with Reg. No. 3,365,829 for RICHARDSONS' for class 16 "Books, booklets, and pamphlets pertaining to navigation; printed nautical charts, namely, printed waterproof nautical charts; nautical charts bound into booklet form; nautical-chart booklets with plastic waterproof pages; chartbooks incorporating facility listing and cruising information" and Reg. No. 4,506,910 for RICHARDSON & Design for class 25 "Athletic uniforms; Beanies; Caps; Gloves; Hats; Jackets; Pants; Scarves; Shirts; Shorts; Sweat pants; Sweatshirts; Warm up outfits; Warm up suits." The Applicant believes the rejection should more properly relate to classes **16** and 25 and has addressed the rejections as such. The Applicant respectfully disagrees with the rejections for the following reasons.

Under Section 2(d) of the Lanham Act, the United States Patent and Trademark Office may refuse to register a mark if it "so resembles" a previously registered mark "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). Likelihood of confusion depends on whether the purchasing public would mistakenly assume that the Applicant's goods or services originate from the same source as, or are associated with, the goods or services identified in a previous registration. Paula Payne Prods. Co. v. Johnson Publ'g Co., 177 U.S.P.Q. 76, 77 (CCPA 1973).

With this in mind, likelihood of confusion determinations must be made on a case-by-case basis (On-Line Careline Inc. v. Am. Online Inc., 56 U.S.P.Q.2d 1471, 1474 (Fed. Cir. 2000)), taking into consideration the thirteen nonexclusive factors set forth in In re E.I. duPont de Nemours & Co., 177 U.S.P.Q. 563, 567 (CCPA 1973) by the Court of Customs and Patent Appeals, the predecessor court of the Court of Appeals for the Federal Circuit. Not all of the DuPont factors may be relevant or of equal weight in a particular case, and "any one of the factors may control a particular case." In re Dixie Restaurants, Inc., 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997).

A. Confusion Must Be Probable, Not Possible

As an initial matter, for confusion to be likely, the confusion must be probable; it is irrelevant that confusion is merely possible. Electronic Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1465 (TTAB 1992) (standard is likelihood of confusion, "not some theoretical possibility built on a series of imagined horrors"); Rodeo Collection, Ltd. v. West Seventh, U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("probable, not simply a possibility"). 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., 21 U.S.P.Q.2d 1388 (Fed Cir. 1992), quoting Witco Chem. Co. v. Whitfield Chem. Co., 164 U.S.P.Q. 43, 44-45 (CCPA 1969), aff'g, 153 U.S.P.Q. 412 (TTAB 1967).

B. There Is No Likelihood of Confusion Because Applicant's Mark Is Distinct from the Cited Marks in Appearance, Sound, Meaning & Overall Commercial Impression

Applicant's Mark RICHARDSON is sufficiently distinct from the cited marks due to additional presence of other elements and additional design in the case of Reg. No. 4,506,910 and the additional presence of a possessive form in the case of Reg. No. 3,365,829 that significantly changes the overall appearance, sound, meaning and commercial impression. Upon viewing the mark in its entirety, the viewer's eyes see all of the terms in combination that immediately differentiates from the cited applications. Applicant respectfully reminds the Examining Attorney that the marks must be considered as wholes, as they are encountered in the marketplace, rather than dissected for purposes of analysis. See Richard L. Kirkpatrick, Likelihood of Confusion in Trademark Law, § 4.7 (8th Ed. 2002); See also Security Ctr., Ltd. v. First Nat'l Security Ctr., 225 USPQ 373, 378 (5th Cir. 1985); Opryland USA, Inc. v. Great American Music Show, Inc., USPQ2d 1471, 1473 (Fed. Cir. 1992); In re Hearst Corp., 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (stating that because "marks tend to be perceived in their entireties . . . all components thereof must be given appropriate weight").

The "anti-dissection" rule requires that marks be compared by examining them as wholes, rather than breaking them up into their component parts for comparison. See In re National Data Corp., 224 USPQ 749, 751 (Fed. Cir. 1985) ("likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark") citing Franklin Mint Corp. v. Master Mfg. Co., 212 USPQ 233, 234 (CCPA 1981) ("[i]t is axiomatic that a mark should be not dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion").

The Examining Attorney must consider Applicant's overall mark and cited overall marks rather than just considering the various letters and letter groupings in isolation. The overall differences in appearance and sound allow consumers to distinguish the marks and avoid confusion. This is true even in instances where marks have a similar sequence and number of letters. See Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha, 228 USPQ 672, 674 (T.T.A.B. 1985) (stating that "although both marks start with the same letters, they are otherwise clearly different in appearance" and that "purchasers do not count letters when reacting to trademarks in the marketplace."); Am. B.D. Co. v. N.P. Beverages, Inc., 213 U.S.P.Q. 387, 388 (T.T.A.B. 1981) ("[I]n determining whether there is a likelihood of confusion, we must consider the marks in their entireties. Purchasers are not expected to, and do not, count the number of letters which marks have in common")." Thus, the Examining Attorney must consider Applicant's entire mark versus the entirety of the cited marks.

When viewed in their entireties, Applicant's Mark and the cited marks are different in sound, appearance, meaning and commercial impression. See Land O Nod Co. v. Paulison, 220 USPQ 61 (TTAB 1983) (holding that CHIRO MATIC and CHIROPRACTIC are not confusingly similar as applied to identical goods); In re General Electric Co., 134 USPQ 190, 191 (CCPA 1962) (holding VULKENE and VULKAN not confusingly similar for the "same

goods”). First, though the marks can be argued to share some similarities, they are not identical. While it can be argued that the marks all share the phrase RICHARDSON, the additional elements present in the cited marks are apparent upon viewing by a consumer, who would easily distinguish between the marks based on the difference in terms and their meanings. The additional elements and design in the cited marks, which are lacking in the Applicant’s Mark, are transformative and significant. Thus, the marks are different in sight.

Further, Applicant’s Mark also differs in sound from the cited marks. The differences in the cited marks require the user to pronounce those marks differently than the Applicant’s Mark and further highlights the differences from the cited marks and brings the consumer’s attention to those differences. For example, the different syllables in the pronunciation of the marks would be readily noticed by consumers such that the consumer would readily distinguish between the marks and avoid any confusion.

Moreover, the marks are not similar in meaning. Reg. No. 3,365,829 is a possessive form that conveys a different meaning and commercial impression than the Applicant’s Mark. Reg. No. 4,506,910 has additional element “R” and overall design and font that likewise conveys a different meaning and commercial impression than Applicant’s Mark.

Aside from rendering the marks dissimilar in appearance and sound, the differences between Applicant’s Mark and the cited marks result in the creation of different commercial impressions that consumers are unlikely to confuse. In today’s commercial landscape, because consumers are exposed to numerous brands and marketing and have come to expect as such, consumers are able to identify and distinguish marks based on any combination of differences in those marks.

Lastly, the unique stylized font incorporated into Applicant’s Mark further distinguishes from the appearance and overall commercial impression from the cited marks. The difference in design created by the prominent font that RICHARDSON is presented in is evident immediately upon viewing Applicant’s Mark.

Accordingly, the differences between the respective marks in the present case are enough to avoid confusion.

C. There Is No Likelihood of Confusion Because Applicant’s Goods and the Goods Listed in the Cited Registrations Are Distinct

No likelihood of confusion exists because Applicant’s goods are distinct from the cited goods. For class 16, Applicant’s goods are directed to “Magazines featuring art, fashion, apparel and sexuality.” The goods do not include and have nothing to do with navigation or nautical charts or maps. Applicant’s goods are directed to a very specific type of printed matter that pertains to popular culture and provocative topics. These are drastic differences both in terms of the types of goods and the purpose of those goods that no consumer would consider similar or confuse in any way. While the Examining Attorney argues that there is evidence that a source providing maps can also provide books, this fails to look at the relevant topics of those printed matters. Applicant has not found, and the Examining Attorney has not provided, any evidence that would show a publisher of maps and nautical charts would be expected to publish magazines

on art, fashion, apparel and sexuality. For avoidance of any doubt, Applicant has amended its class 16 goods to make clear that its recited goods do not cover maps or nautical charts.

For class 25, Applicant's goods consist of specific type of clothing known as streetwear, which have a very particular type of style and purpose which the cited class 25 goods simply do not have. See e.g., <https://www.latimes.com/fashion/la-ig-richardson-los-angeles-20161020-snap-story.html> Reg. No. 4,506,910 is clearly directed to athletic wear for use with sports. It's website clearly demonstrates the same. See e.g., <https://richardsonsports.com/> The different types of clothing and what a consumer would seek those types for avoids any potential confusion. Manufacturers of athletic wear would not be expected to also produce edgy streetwear or vice versa. Again, for avoidance of any doubt, Applicant has amended its class 25 goods to limit its clothing to streetwear.

Even if the goods at issue can be categorized in the same broad "field" does not, of itself, provide a basis for regarding the products as "related." See In re Digirad Corp., 45 U.S.P.Q.2d 1841 (ComrPats 1998) (holding that despite some industry "overlap," DIGIRAY and DIGIRAD not confusingly similar for high-tech medical diagnostic used to different ends); Cooper Industries, Inc. v. Repcoparts USA, Inc., 218 U.S.P.Q. 81, 84 (TTAB 1983) ("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'"). As stated above, confusion must be probable and not merely possible. Thus, even where the marks are identical and the products can be marketed to the same customers, sufficient differences between the products/services negate a likelihood of confusion. Local Trademarks Inc. v. The Handy Boys Inc., 16 U.S.P.Q.2d 1156 (TTAB 1990) (holding no confusion between LITTLE PLUMBER for liquid drain opener and identical mark LITTLE PLUMBER for advertising services though both products were marketed to plumbing contractors).

The fact that the Applicant's goods and the cited goods can be characterized to be generally related to printed matter or clothing is not an adequate basis to find the required "relatedness." Applicant's goods simply do not relate to the same industry as those of the cited goods and there can be no likelihood of confusion. Furthermore, the differences in the purpose of the goods and the consumers that seek those goods further negates a likelihood of confusion. As stated above, even where the marks are identical and the products can be marketed to the same customers, sufficient differences between the goods/services negate a likelihood of confusion. Here, the goods are sufficiently distinct as to avoid any confusion between the cited marks and Applicant's Mark.

D. There Is No Likelihood Of Confusion Because the Goods Are Directed to Different Target Markets

Applicant's founder is a former fashion stylist known for creating a brand of provocation and edginess which is evident in the goods offered by the Applicant. Both the class 16 and class 25 goods are clearly directed to a mix of art, music, fashion and culture that has no relatedness to or overlap with the cited goods. As such, the same consumers are not likely to encounter Applicant's goods and the goods of the cited marks because the purpose of those goods are completely different and do not overlap.

Even in cases of identical marks used in the same industry, to support a claim of confusion, there must be a reasonable basis for finding that the marks would be encountered by the same persons other than by chance. See Borg-Warner Chem., Inc. v. Helena Chem. Co., 225 U.S.P.Q. 222, 224 (TTAB 1983); In re Fresco Foods, Inc., 219 U.S.P.Q. 437, 438 (TTAB 1983) (“the recited goods are not so related that they would come to the attention of the same kinds of purchaser and, therefore, we agree with applicant that any likelihood of confusion is remote...This being the case, even identical marks would have little opportunity...other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regards, 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 for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties”); In re Unilever, Ltd., 222 U.S.P.Q. 981, 982-83 (TTAB 1984); Murray v. Cable National Broadcasting Co., 39 U.S.P.Q.2d 1214, 1216 (9th Cir. 1996); Cooper Industries, Inc. v. Repcoparts USA, Inc., 218 U.S.P.Q. 81, 84 (TTAB 1983) (“although goods utilizing a common . . . mark [were] sold through automotive product dealers . . ., there was no evidence to show that persons who purchased, worked with or in any way came in contact with the goods would be the same (and the character of the goods made this highly unlikely). Moreover, mere movement through the same or overlapping channels of trade . . . would not be sufficient if the goods were not likely to reach the same users”). Thus, even if, for argument’s sake, there is some overlap between the industries of the parties, this does not mean there is automatically a likelihood of confusion. In the present case, consumers would not encounter the same marks other than by chance and, even in such a situation, because the types and purpose of the goods are so disparate, consumers would not expect them to come from the same source.

E. Coexistence

The Applicant is not a newcomer as suggested but rather has been using the Applicant’s Mark for many years. The Applicant is not aware of any instances of confusion between the Applicant’s Mark and the cited marks. For this reason and all the reasons presented above, there is no reasons to expect any future confusion given the coexistence between the marks for the past several years. *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012) (in finding confusion unlikely, the Board noted that applicant’s registration and the cited registration had coexisted for over five years).

F. Conclusion

In sum, likelihood of confusion is not probable and the differences between the respective marks in this case are more than enough to avoid confusion as to either source of origin or sponsorship. Further, the respective goods are wholly distinct, the marks and respective goods are directed to different target markets, and the targeted consumers are would not confuse the source of the goods. Consequently, these key distinctions are more than enough to avoid confusion. Therefore, Applicant respectfully requests that the 2(d) refusal be withdrawn.

Section 2(e)(4) - Surname Refusal

The Examining Attorney has rejected the Applicant's Mark for being primarily a surname. As noted by the Examining Attorney, the Applicant has been using its mark for many years. A refusal under Section 2(e)(4) can be overcome by submitting a claim of acquired distinctiveness under 15 USC 1052(f). TMEP 714.05(a)(i). Accordingly, the Applicant submits herewith a verified statement that the mark has become distinctive of the goods and services (as amended) per TMEP 1212 and requests to amend the application to Section 2(f):

The mark has become distinctive of the goods and/or services through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

The Applicant respectfully requests that the Section 2(e)(4) refusal be withdrawn. The Applicant reserves the right to submit further arguments against the surname rejection should the refusal not be withdrawn.

Specimen Refusal; Refusal – Failure to Function -- Activity Not a Service

The Applicant has deleted the objected to class 41 goods and respectfully submits that these rejections are moot.

Amendment to Goods

Applicant thanks the Examiner for suggested amendments and has amended the goods as follows:

Class 9: "Electronic publication, namely, **downloadable** e-zines featuring art, fashion, apparel and sexuality; Electronic publication, namely, e-zines featuring art, fashion, apparel and sexuality, **recorded on computer media**"

Class 16: "Magazines featuring art, fashion, apparel and sexuality **and excluding maps or nautical charts**"

Class 25: "**Streetwear** clothing, namely, T-shirts, hoodies, jumpers, sweatshirts, shirts, pants, skirts, blouses, dresses, jackets, sweaters; underwear; caps being headwear; hats; socks"

Class 41: "~~Publishing of magazines and books; publishing of web magazines~~ **Providing on-line non-downloadable e-zines in the fields of art, fashion, apparel and sexuality**"