

## **BODY OF RESPONSE TO LIKELIHOOD OF CONFUSION REFUSAL**

In a non-final Office Action issued June 17, 2019, the Examining Attorney initially refused registration of the subject application, Serial No. 88/380,314 (the “Application”) regarding the mark STYLELINE (“Applicant’s Mark”), under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Examining Attorney alleges that Applicant’s Mark is likely to cause confusion with the mark STYLE LINE, as shown in U.S. Registration No. 3,724,301 (the “Cited Mark” or “Cited Registration”). The Office Action also requires an amendment to the identification of goods and business entity type listed in the Application. In response, Applicant amends the identification of goods and the business entity type, traverses the § 2(d) refusal and hereby requests reconsideration.

### **I. BUSINESS ENTITY TYPE.**

The Application lists Applicant as a “corporation.” Applicant amends the business entity type to “limited liability corporation.”

### **II. IDENTIFICATION OF GOODS.**

The Application identifies the goods as “Laminate, engineered, hardwood and vinyl flooring” in Class 019. Applicant amends the goods to “Laminate, **engineered hardwood, hardwood**, and vinyl flooring.”

### **III. LIKELIHOOD OF CONFUSION.**

Initially, it is important to note that the Lanham Act is not concerned with a mere chance or possibility of confusion. *Estee Lauder, Inc. v. Gap, Inc.*, 42 USPQ2d 1228, 1233 (2d Cir. 1997) (“[I]t is not sufficient if confusion is merely ‘possible.’”) (citing 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition § 23:2, at 23-10,11 (1996)). The risk of confusion must be probable before a likelihood of confusion can exist. *See Electronic Design & Sales, Inc. v.*

*Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (“We are not concerned with mere theoretical possibilities of confusion....”). Some courts have even stated that the Lanham Act requires a “substantial likelihood” of confusion before the statute is violated. *See, e.g., Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 206 USPQ 961, 962 (1st Cir. 1980); *WSM, Inc. v. Hilton*, 221 USPQ 410, 417 (8th Cir. 1984). Accordingly, a rejection based only on a mere possibility of confusion is not appropriate. There must be a real, genuine, and probable likelihood of confusion for the rejection to be proper. Applicant respectfully submits that such is not the case here.

The Examining Attorney discusses the similarity of the marks and the similarity of the goods, two of the thirteen plus factors provided by the seminal case, *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). Applicant submits that the sophistication of the consumers, the purchasing conditions, and the strength of the marks are factors that also merit mention in the current analysis. Applicant submits that, after careful consideration of these factors, the balance of the factors weighs against a likelihood of confusion and Applicant respectfully requests reconsideration.

**a. Comparison of the Marks.**

Applicant does not dispute that Applicant’s Mark STYLELINE and the Cited Mark STYLE LINE bear certain similarities. However, without additional probative evidence, “the identity of the marks alone is insufficient to establish a likelihood of confusion.” *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1547 (TTAB 2015). The likelihood of confusion analysis must consider the trademark in connection with the goods and services offered. *See* 15 U.S.C. § 1052(d). The “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *In re W.W.*

*Henry Co., L.P.*, 82 USPQ2d 1213, 1214 (TTAB 2007) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ24, 29 (CCPA 1976)). Despite any potential similarities in the marks, the analysis must continue to consider the other relevant *du Pont* factors. In this instance, Applicant's Goods are sufficiently dissimilar from the goods listed in the Cited Registration such that consumer confusion is improbable and unlikely.

**b. Comparison of the Goods.**

**i. The Goods are Dissimilar for Likelihood of Confusion Purposes.**

For goods to be considered similar for likelihood of confusion purposes, there must be a relationship between the goods "that gives rise to the mistaken belief that the goods and/or services emanate from a common source." *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). For likelihood of confusion to occur, even when two marks are identical, the goods/services and channels of trade must be sufficiently related so that the use of similar marks thereon would be likely to generate confusion, mistake, or deception. *See, e.g., In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983) (no confusion likely where identical FESCO mark used on distributorship services in the field of farm equipment and machinery, and in the field of fertilizer processing equipment and machinery); *In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987) (no confusion likely where identical mark of PURITAN used on laundry and dry cleaning services and on commercial dry cleaning machine filters); *Chase Brass and Copper Co., Inc. v. Special Springs, Inc.*, 199 USPQ 243 (TTAB 1987) (no confusion likely where identical BLUE DOT mark used on springs for engine distributors and on brass rods used on auto manufacturing).

Initially, it is improper to state that the goods/services are sufficiently related and that a likelihood of confusion is probable merely because they could exist in a common broad industry,

namely, in this case, the home repair, building materials, or construction industry. “The board ... has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.” *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 USPQ 222, 224 (TTAB 1983). The simple fact that both Applicant’s and Registrant’s Goods *can* be classified in this broad category does not render the goods *per se* related.

Applicant’s and Registrant’s goods are not so related such that it would be likely to generate confusion, mistake, or deception. Applicant’s goods are “laminated, engineered hardwood, hardwood, and vinyl flooring” (“Applicant’s Goods”). Registrant’s goods are “vinyl patio doors; vinyl windows” (“Registrant’s Goods”). Initially, Applicant notes that defining the material as “vinyl” in both instances does not render the goods – floors, doors, and windows – related. Floors, doors, and windows can be made of any number of materials, and the similarity or difference in material is immaterial to the likelihood of confusion analysis. The crux of the analysis here depends on whether “flooring,” as such, is related to “doors” and “windows” for likelihood of confusion purposes. Applicant submits that they are not.

The parties’ goods are dissimilar in function and appearance. Different consumers purchase these goods for different reasons. To the extent that these goods are sold in the same physical or online retail locations, such as a big box retailer, specialty retail outlets, or online retail stores, they will be sold in completely separate departments. The goods are marketed to dissimilar groups of consumers, as the consumer looking for “doors” or “windows” will differ from the consumer looking for “flooring.” Further, consumers are not conditioned to assume

that the manufacturer of flooring will also sell windows and doors. Thus, the goods are unlikely to generate confusion, mistake or deception, and are therefore unrelated for likelihood of confusion purposes.

**ii. The Examining Attorney's Evidence Does Not Establish Relatedness.**

The Examining Attorney's evidence does not establish the relatedness of the dissimilar goods at issue here. The mere fact that Applicant's Goods and the goods in the Cited Registration can be sold on the same internet website or big box retailer does not, by itself, establish the relatedness of the goods. *See In re Thor Tech, Inc.*, 113 USPQ2d at 1547 (finding no likelihood of confusion between identical TERRAIN marks for "trucks" and "recreational vehicles, namely, towable trailers" despite being sold in the same internet locations); *see also In re Princeton Tectonics*, 95 USPQ2d 1509, 1511 (TTAB 2010) (finding no likelihood of confusion between personal headlamps and electric lighting fixtures both using the mark EPIC, despite evidence provided by the Examining Attorney that some retailers would carry both items in-store or online). Furthermore, the scant evidence of registrations containing both parties' respective goods submitted by the Examining Attorney actually demonstrates that it is exceedingly rare that these unrelated goods are sold or registered using the same mark.

The Examining Attorney submitted evidence from big box retailers and online retailers that sell flooring, windows, and doors to show that these goods are "sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use." This evidence is unavailing. It is not uncommon for a retailer or online retailer to offer a wide variety of goods produced by any number of different companies. Nor is it uncommon for online retailers to sell every conceivable accessory or appliance for a particular type of good, regardless of whether those goods originate from the same manufacturer. Here, the Examining Attorney

has only offered evidence from four retailers: Lowe's, Home Depot, Doors, Floors and More, and Chadwell. Two of these retailers, Lowe's and Home Depot, sell an incredibly wide range of items. The other two, Doors, Floors, and More and Chadwells are specialty retailers that sell a wide variety of goods within a particular field, namely, building and construction materials.

The big box retailers each provide anything from car batteries to lumber to lawn fertilizer. It is unlikely that a consumer would view a cordless drill and a table lamp inherently related just because they have seen them both sold at Lowe's or Home Depot; yet, by the Examining Attorney's logic, such would be the case, as any item sold at such a big box retailer or online marketplace would be inherently related in the eyes of a consumer. This is clearly an overly broad interpretation of the relevant case law and examination procedures. Moreover, the Trademark Trial and Appeal Board explicitly held that evidence of two items appearing in a retail store (even a specialized retail store) or online retail store that carries a wide variety of goods is insufficient, by itself, to establish the relatedness of the goods. *Princeton Tectonics*, 95 USPQ2d at 1511.

In the case at hand, Applicant's Goods are not sufficiently related to Registrant's Goods such that use of the respective marks would be likely to generate confusion, mistake, or deception. The Examining Attorney's argument and evidence does not establish otherwise.

**c. Conditions of Purchase/Sophistication of the Consumer.**

It is axiomatic that "the level of purchaser sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Systems*, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992); *Pignons S.A. v. Polaroid Corp.*, 212 USPQ 246, 252 (1st Cir. 1981). Likewise, "there is always

less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Electronic Design & Sales*, 21 USPQ2d at 1392.

By their very nature, neither Applicant’s nor Registrant’s Goods are purchased on a whim. Regardless of the consumer demographic, “flooring,” “doors,” and “windows” are only purchased after deliberation and investigation and at a non-inconsequential cost. No individual home or condominium owner simply purchases flooring, doors, or windows without first considering (1) price; (2) quality; (3) style/preference; and (4) the consumers individual needs before purchasing any of these items. If the consumer is a building professional or contractor, they will make similar considerations prior to purchasing what could be a large amount of building materials. Consequently, neither Registrant’s nor Applicant’s goods are purchased haphazardly. Rather, the purchase only occurs after significant planning and consideration regarding whether the goods will be to the consumer’s specification and satisfaction. As a result, consumers and potential consumers of Applicant’s Goods are sophisticated and careful and will readily discern between “flooring” on one hand, and “doors and windows” on the other hand. Thus, the sophistication of the consumers weighs against a likelihood that consumers would be confused.

**d. Strength of the Marks.**

At the time of this writing, there are currently 10 live registrations and two pending applications for STYLE LINE (or phonetically equivalent variations) marks. Attached as Exhibit A are current status sheets taken from the Trademark Document Retrieval System on November 14, 2019. The existence of a number of third party registrations indicates that consumers are conditioned by exposure to a number of similar marks “to distinguish between different marks on the basis of minute distinctions.” *Juice Generation, Inc. v. GS Enters. LLC*,

115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (quoting *Std. Brand v. RJR Foods, Inc.*, 192 USPQ 383, 386 (TTAB 1976)). Furthermore, the existence of numerous STYLE LINE registrations indicates that Applicant may “come closer” to Registrants’ mark without “causing a likelihood of confusion and thereby invading what amounts to a comparatively narrower range of protection.” *Juice Generation*, 115 USPQ2d at 1675. Where the marks are not inherently strong, the scope accorded to their respective protections should be narrowed accordingly. Thus, here, the existence of several third-party registrations on identical or highly similar marks weighs against a finding of confusion.

#### **IV. CONCLUSION**

For all the foregoing reasons, Applicant submits that that Applicant’s mark is not likely to cause confusion, mistake or deception with the Cited Mark when used in connection with Applicant’s Goods. Applicant further submits that the remaining issues identified in the Office Action have been addressed, and that the Application is now in condition for formal allowance and passage to publication. Such action is respectfully requested. If any issues arise which the Examining Attorney believes may be best resolved over the telephone, the Examining Attorney is invited to contact Applicant’s undersigned attorney at (800) 821-7962 or via email at [cgntmdocket@shb.com](mailto:cgntmdocket@shb.com).