

TRADEMARK LAW OFFICE 115
SERIAL NUMBER: 88644022

MARK: HUNTER

RESPONSE TO OFFICE ACTION

TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS:

IN RESPONSE TO THE ABOVE-REFERENCED OFFICE ACTION, the Applicant hereby submits the following.

In the Office Action of November 19, 2019, the Examining Attorney stated that the application for HUNTER (hereafter the “Application”) may ultimately be refused registration under Trademark Act 2(d) because of a likelihood of confusion with Registration No. 5603086 for RAFFLE HUNTER (hereafter “Registration” or “Prior Mark”).

The Applicant respectfully disagrees, and hereby responds as follows.

Response to Potential Section 2(d) Likelihood of Confusion:

Explanation of the *DuPont* Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely

The test for likelihood of confusion is whether a “reasonably prudent consumer” in the marketplace is likely to be confused as to the origin of the goods or services bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). This includes factors such as the similarity or dissimilarity of the marks in their entirety for appearance, sound, connotation and commercial impression, similarity or dissimilarity and nature of the goods or services, and the number and nature of similar marks in use on similar goods. *Id.* Whether a likelihood of confusion exists between an applied-for mark and a previously registered mark is

determined on a case-by-case basis, aided by application of the *DuPont* factors. *On-Line Careline v. Am. Online*, 229 F.3d 1080, 1085 (Fed. Cir. 2000).

Application of the *DuPont* Factors

Applying the *DuPont* factors to the instant case, Applicant hereby submits the following arguments in support of its argument that there would be no likelihood of confusion between the Application and the Prior Mark.

1) Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation, and Commercial Impression (The Sight, Sound, and Meaning Analysis)

a. Appearance

In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their *appearance, sound connotation, and commercial impression*. TMEP §§1207.01, 1207.01(b) (emphasis added). Marks must be viewed in their entireties, including words and designs. *In re Viterra, Inc.* 671 F.3d 1358, 1362 (Fed. Cir. 2012) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993)). More weight may be placed on a dominant portion of a mark if another feature of the mark is, for example, descriptive or generic standing alone. The mark must be considered in total. *In re Viterra, Inc.* 671 F.3d at 1362 (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1457 (Fed. Cir. 2000)).

The meaning or connotation of a mark must also be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck, & Co.*, 2 USPQ 2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's

underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co. Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing).

Even though marks may be similar in appearance when they share "similar terms or phrases," the Trademark Trial and Appeal Board (the "Board") has consistently held that confusion is not likely if the marks in their entireties convey significantly different commercial impressions, or 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., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). The Board has stated that similarity as to one aspect of the sight, sound and meaning trilogy will *not* automatically result in a finding of likelihood of confusion when the goods are identical or closely related. 4 McCarthy on Trademarks and Unfair Competition §23:21 (4th ed.) (emphasis added).

Here, the marks were improperly dissected. The Application and the Prior Mark both contain the term "Hunter." However, the Prior Mark contains the word "Raffle" in front of "Hunter." "RAFFLE HUNTER" and merely "HUNTER" as a whole is distinguishable. Furthermore, the Prior Mark deals with completely different services than the Application. The Application merely is used to create a public environment used to index and locate email addresses for people, whereas the Prior Mark is used to create a Search Engine for raffles, sales promotion, customizable on-line web pages, and communication streams via social media. These differences are enough to not only **completely distinguish** themselves from each other based on the mark

itself, but also the goods/services provided are also **completely distinguishable** by usages and therefore there will be no confusion from consumers.

b. Sound

It is well established that merely because two marks contain a similar term, that there is no likelihood of confusion. In fact, there is no rule that confusion automatically exists between marks containing the same term. *See Application of Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) (no confusion between TIC TAC and TIC TAC TOE both for impulse foods); *see also White Rock Distilleries, Inc. v. Franciscan Vineyards, Inc.*, 2009 WL 498673 (N.D. Cal. 2009) (unpublished) (Board reversed Examining Attorney and found no likelihood of confusion between VOLTA for vodka and TERZA VOLTA for wine).

In *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970), the Court of Customs and Patent Appeals affirmed the Board's decision that there was no likelihood of confusion between PEAK and PEAK PERIOD for personal care products. Likewise, in *IN RE JOHNSON & JOHNSON*, 2002 WL 649081 (T.T.A.B. 2002), the Board reversed the Examining Attorney's refusal to register the mark EPIC MICROVISION for a medical device, despite the existence of a prior registration for the mark EPIC also for a medical device. Here, consumers will discern the differences between the Prior Application and Applicant's mark because of the Applicant's use of an additional word, as well as the Prior Mark's prominent design elements. The Application is also distinguishable from the Prior Application in terms of sound. The Prior Mark's main sound is the first word of "Raffle" whereas this Application is merely "Hunter."

II) Similarity as to the Nature of the Goods or services

The meaning or connotation of a mark must also be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create

sufficiently different commercial impressions when applied when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck, & Co.*, 2 USPQ 2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co. Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing).

Where the goods and services are directly competitive, the degree of similarity required to prove a likelihood of confusion is less than the case of dissimilar products. 4 McCarthy on Trademark and Unfair Competition § 23:20.50 (4th ed.); *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 77 U.S.P.Q.2d 1641 (1st Cir. 2006). However, in this case there is a substantial dissimilarity between the nature of the goods and services of the two marks, and there is no evidence of the two marks actually competing or being confused with one another.

As discussed above, CROSSOVER for brassieres and CROSSOVER for ladies' sportswear were dissimilar because “[a]s a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance.” *In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d at 1314.

See also, A&H Sportswear, Inc. v. Victoria's Secret Stores Inc., 237 F.3d 198 (3rd Cir. 2000). A&H used its mark “MIRACLESUIT” to market and advertise its new brand of swimwear, while Victoria's Secret used the mark “THE MIRACLE BRA” for a new collection of lingerie. *Id.* The court in that case found the two marks to be distinctively dissimilar and were not confusingly similar. *Id.* at 217

Similarly, F.L.I.P. and flippis are two distinctively different goods and services. First, as the examining attorney described, the Applicant's mark is used for "providing free internet service provider services to a community," in International Class 038. Whereas the Registrant's mark, flippis, is registered in International Class 38 as "Audio and video broadcasting services over the Internet; Broadcasting services and provision of telecommunication access to video and audio content provided via a video-on-demand service via the Internet." There is a distinct difference amongst an internet service provider ("ISP") and audio and video broadcasting on the internet.

Here, the Prior Mark deals with completely different services than the Application. The Application merely is used to create a public environment used to index and locate email addresses for people, whereas the Prior Mark is used to create a Search Engine for raffles, sales promotion, customizable on-line web pages, and communication streams via social media. These differences are enough to not only **completely distinguish** themselves from each other based on the mark itself, but also the goods/services provided are also **completely distinguishable** by usages and therefore there will be no confusion from consumers.

III) The Fame of the Prior Mark

All trademarks are not equal. Some are strong, some are weak and most are somewhere in between. "Strong" marks are given "strong" protection—protection over a wide range of related products and services and variations on visual and aural format. The stronger the mark the more likely it is that encroachment on it will produce confusion. Conversely, relatively weak marks are given a relatively narrow range of protection both as to products and format variations. 2 McCarthy on Trademarks and Unfair Competition § 11:73 (4th ed.). A famous mark has "extensive public recognition and renown." *Bose Corp. v. QSC Audio Prod's Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002). The fame of a prior mark can play a dominant role in the likelihood

of confusion analysis. Famous marks have a broad scope of protection or exclusivity of use. *Citigroup, Inc.*, 637 F.3d at 1355. Famous marks are given more protection because they are easily remembered and associated in a purchaser's mind than a weak mark. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000).

Likewise, here, there is no evidence that the cited Prior Mark is famous or has acquired secondary meaning within the marketplace or that consumers associated the terms HUNTER or RAFFLE HUNTER.

IV) The Nature and Extent of Any Actual Confusion

There has been no documented evidence that shows that any consumers have confused the respective marks in commerce. There have been no demonstrated events of confusion by consumers between the respective marks.

Courts have long held that concurrent use of such marks without instances of actual confusion is evidence of no confusion. 4 McCarthy on Trademarks and Unfair Competition § 23:18 (4th ed.); *Pignons S.A. de Macanique de Precision v. Polaroid Corp.*, 657 F. 2d 482, 490, 212 USPQ 246 (1st Cir. 1981) (“[W]hen the marks have been in the same market, side by side, for a substantial period of time, there is a strong presumption that there is little likelihood of confusion.”); *Greentree Laboratories, Inc. v. G.G. Bean, Inc.*, 718 F. Supp. 998, 13 USPQ 2d 1161 (D. Me. 1989) (concurrent use for five years without confusion where Plaintiff's mark is weak, creates a presumption that confusion is unlikely; judgment of no infringement); *Aktiebolaget Electrolux v. Armatron Intern., Inc.*, 999 F.2d 1, 4, 27 USPQ 2d 1460 (1st Cir. 1993) [“[A]n absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that little likelihood of confusion exists.”).

Conclusion

Consequently, taking the respective marks in their totality pursuant to the Anti-Dissection Rule, consumers would likely be able to differentiate between the respective marks because of the differences in goods and services, difference in appearance/sound, as well as their overall commercial impression. and there has been no evidence of any actual confusion.

Therefore, the Applicant respectfully requests that the Examining Attorney allow Applicant's application for the mark HUNTER to proceed to publication. If for some reason the Examiner continues to believe that the present application is not in condition for publication, the Examiner is respectfully requested to call Applicant's attorney at (806) 570-3049 to discuss any possible amendments of the like which places the case in condition for publication, or arrange an Examiner's amendment to put the case in condition for publication.

Thank you for your consideration.

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