IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: DreamonX
Serial No.: 88560799
Examiner: Laila Sabagh, Examining Attorney
Law Office: 127

RESPONSE TO OFFICE ACTION DATED 11/04/2019

This is response to Office Action dated 11/04/2019. The applicant, Zheng Han, respectfully requests that the application be reconsidered.

Here below is the information about the **Likelihood of Confusion** required.

BACKGROUND

Applicant Zheng Han seeks registration of **DreamonX** for "Athletic footwear; Baby layettes for clothing; Business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses and footwear; Costumes for use in children's dress up play; Down jackets; Flip flops; Gloves as clothing; Head wear; Jackets; Jumpers; Outer jackets; Scarves; Shirts; Singlets; Socks; Sweaters; Tee shirts; Tops as clothing; Trousers; Vests" in International Class 25. The trademark-examining attorney has refused registration of the mark **DreamonX** under Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP§§1207.01 et seq. alleging the applied for mark is likely to be confused with registration number No. 3520710 **DREAM ON** brand for "Hats; T-shirts" in International Class 25.

APPLICANT'S ARGUMENT IN SUPPORT OF REGISTRATION

Applicant respectfully and legitimately disagrees with the Examining Attorney's provisional decision for the reasons discussed below.

The Standard for Determining Likelihood of Confusion

A determination of likelihood of confusion between two marks is determined on a case by case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable thirteen factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *DuPont* factors as they relate to likelihood of confusion in this case are reviewed below.

The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;

In comparing several trademarks for confusing similarity, the Examining Attorney could compare the marks for resemblances in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity in one respect – sight, sound, or meaning – does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545–46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). *See Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. V. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual

features").

Here, the trademark **DreamonX** and the trademark **DREAM ON** do have a little similarities, but the trademark **DreamonX** is still significantly different. The letter X is significantly different from **DREAM ON** in the composition and pronunciation of the phrase. At the same time, there is no space between the phrases **Dreamon**, and it is also different from **DREAM ON** in the composition and pronunciation. The trademark **DreamonX** does not confuse people with the trademark **DREAM ON** visually or acoustically.

The dissimilarity and nature of the goods or services as described in an application or registration;

If the marks of the respective parties are very similar or virtually identical, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC,* 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009). The obviously differences of the goods and services as described in the application and registration can be an important factor which is a key consideration in any likelihood of confusion determination.

It is well known that goods and services can fall into three categories: (1) competitive, (2) non-competitive but related, and (3) non-competitive and non-related. *Homeowners Group, Inc. v. Home Mktg. Specialists Inc.*, 931 F.2d 1100, 18 USPQ2d 1587,1593 (6th Cir. 1991). Goods and services in the last category are unlikely to be confused. *Murray v. Cable National Broadcasting Co.*, 86 F.3d 858,861 39 USPQ2d 1214 (9th Cir. 1996).

Here, we note that the goods of the trademark **DREAM ON** only involve two : Hats and T-shirts. These two goods obviously cannot cover all goods of clothing products. It is obviously unfair and unreasonable to prevent all other clothing goods from

applying for the entire class 25 with these two separate goods alone.
Therefore, the applicant of the trademark **DreamonX** decided to delete the goods with the same meaning as " Hats; T-shirts "in the trademark **DreamonX** application, that is, delete" Head wear; Tee shirts ", so that the remaining clothing goods and trademark **DreamonX** are covered no relevance with trademark **DREAM ON**.

CONCLUSION

For the reasons listed above, Applicant respectfully submits that the trademark examining attorney should remove the Section 2(d), 15 U.S.C. §1052(d) refusal for the trademark **DreamonX** (Serial no. 88560799) for "Athletic footwear; Baby layettes for clothing; Business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses and footwear; Costumes for use in children's dress up play; Down jackets; Flip flops; Gloves as clothing; Jackets; Jumpers; Outer jackets; Scarves; Shirts; Singlets; Socks; Sweaters; Tops as clothing; Trousers; Vests" in International Class 25.

Dated: Jersey City, New Jersey
December 27, 2019

/s/ Zheng Han
Zheng Han, *Applicant*