

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICANT'S RESPONSE TO OFFICE ACTION**

In re Application of :
APPLICANT : Destini J. Chesley
MARK : FIBONACCI
SER. NO. : 88267745
FILING DATE : January 18, 2019

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attention: Regina C. Hines, Esq.
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Responding to Office Action dated July 2, 2019:

RESPONSE TO LIKELIHOOD OF CONFUSION REFUSAL

In the above-identified Office Action, the Examining Attorney states, “[r]egistration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 85606161. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*”¹ The Examining Attorney continues, “Trademark Act Section 2(d) bars

¹ Applicant notes that ‘85606161’ refers to a Serial Number rather than a Registration Number. Applicant assumes that this is merely a clerical error and that the referenced mark is, in fact, identified by Registration No. 4389056. Accordingly, this Applicant’s Response to Office Action addresses the mark identified in Reg. No. 4389056.

registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). Finally, the Examining Attorney notes, “Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services.” Importantly, the Examining Attorney addresses only two of the complete set of *du Pont* factors.

SIMILARITIES BETWEEN THE MARKS

With respect to comparing the Applicant’s mark, FIBONACCI, and the Registrant’s mark, FIBONACCI and design, the Examining Attorney states, “[w]hen evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services,” and “although marks must be compared in their entirety, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed.” The Examining Attorney seems to conclude that since both marks incorporate the word FIBONACCI, this factor weighs in favor of a finding of likelihood of confusion between the marks.

Applicant respectfully disagrees with the Examining Attorney’s conclusion because the Fibonacci Spiral design element of the mark identified in Registration No. 4389056 should be given significantly more weight than the word FIBONACCI for three distinct reasons. First, the

location of the Fibonacci Spiral design element is centered, is located above, and is distinctly separate from the FIBONACCI word element. This draws the attention of the viewer away from the word portion of the mark. As a result, the Fibonacci Spiral design element has more prominence in the Registrant's mark. Second, the Fibonacci Spiral design element has a dark circle in the center which resembles the pupil of an eye and therefore makes the Fibonacci Spiral design element, as a whole, appear as an eye. Since humans are naturally drawn to the presence of eyes looking or staring at them, the similarity of the Fibonacci Spiral design element to an eye, draws the viewer's attention away from the word portion of the mark. Again, this gives the Fibonacci Spiral more prominence in the Registrant's mark. Third, since the Fibonacci Spiral design element is indeed an approximation of the mathematical Fibonacci Spiral itself, the addition of the word FIBONACCI serves merely as a descriptive notation to the more prominent Fibonacci Spiral design element. This means that the word portion of the Registrant's mark is not adding its own distinct contribution to the overall commercial impression of the mark. As a result, this gives the Fibonacci Spiral, rather than the word FIBONACCI, more prominence in the Registrant's mark. For these reasons, the design element is the dominant feature of the Registrant's mark. Consequently, a comparison of the most prominent features of the respective marks would show that they are not similar. Likely consumers would not be confused, nor mistaken, nor deceived as to the commercial source of the goods and/or services of the parties.

Therefore, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) Likelihood of Confusion Refusal and allow the Applicant's trademark application to proceed.

RELATEDNESS OF THE COMPARED GOODS AND/OR SERVICES

With respect to comparing the Applicant's goods and the Registrant's goods, the Examining Attorney states, "[t]he goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i). If the marks of the respective parties are identical or highly similar, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). TMEP §1207.01(a). Furthermore, the Examining Attorney argues that, "[b]oth parties' goods are similar in kind and closely related because they are for clothing items and related accessories. The attached internet evidence shows that clothing/apparel and fashion accessories are offered under the same brand in the commercial marketplace.² Thus, there is a strong likelihood of confusion that the purchasing public may believe the goods of the applicant and registrant emanate from the same source."

Applicant respectfully disagrees with the Examining Attorney's conclusion that "both parties' goods are similar in kind and closely related because they are for clothing items and related accessories." In fact, Registrant's goods are more aptly described as leather goods rather

² The evidence provided by the Examining Attorney in Attachment - 4 through Attachment - 29 does not accurately represent a marketplace where one would encounter similar trademarks for similar goods. The evidence provided was selected by pre-selecting specific brands (i.e. Calvin Klein, Michael Kors, and Tory Burch) and then reviewing the goods offered by those specific brands. No other brands are displayed in those attachments. Therefore, they do not show how a consumer would encounter different brands for similar goods, which would be a necessary threshold requirement to show a likelihood of confusion.

than “clothing items and related accessories.” There are at least three reasons to draw this conclusion. First, the Registrant’s business name is Ming Hsing Leather Co., Ltd. It is reasonable to believe that such a company does indeed produce leather or leather goods. Second, four of the Registrant’s goods specifically reference ‘leather’ or ‘imitation leather’ without reference to any other material or fabric. In addition, each of the Registrant’s other goods, or certain parts of those goods, are all routinely manufactured of leather or imitation leather. It is reasonable to believe that the company’s brands apply to leather or leather goods. Finally, in one of the few online references to Ming Hsing Leather Co., Ltd., the company states that it “comes with 30 years of experience in producing sports handles and straps. We successfully produce leather products for various kinds of sports activities” (See Exhibit A). By the Registrant’s own admission, it produces leather products and therefore its goods should be described as leather goods rather than “clothing items and related accessories.” This important distinction between the Registrant’s leather goods and the Applicant’s “clothing items” means that the goods of the respective parties’ are indeed different. As a result, there is not a strong likelihood of confusion that the purchasing public may believe the goods of the Applicant and Registrant emanate from the same source.

Therefore, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) Likelihood of Confusion Refusal and allow the Applicant’s trademark application to proceed.

**SIMILARITY OR DISSIMILARITY OF ESTABLISHED,
LIKELY-TO-CONTINUE TRADE CHANNELS**

The similarity or dissimilarity or established, likely-to-continue trade channels may also be relevant in an ex parte likelihood-of-confusion determination and must be considered if there

is pertinent evidence in the record (*see* TMEP §1207.01). Here, the Registrant does not appear to be selling any goods in the United States using the mark identified in Registration No. 4389056. The Registrant has no known web site; there do not appear to be any goods identified using a Google search with the key word ‘fibonacci’ and any of the Registrant’s cited goods; there appears to be no evidence of the Registrant using the mark identified in Registration No. 4389056 with any goods on the www.amazon.com site; and, there appears to be no evidence of the Registrant using the mark identified in Registration No. 4389056 with any goods on the www.ebay.com site. Therefore, it is reasonable to conclude that the Registrant has no established or likely-to-continue channels of trade in the United States using the mark identified in Registration No. 4389056 with any goods cited in Registration No. 4389056.

In view of the Registrant’s apparent lack of use of the mark identified in Registration No. 4389056, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) Likelihood of Confusion Refusal and allow the Applicant’s trademark application to proceed.

CONCLUSION

Accordingly, in view of the arguments and evidence provided above, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) Likelihood of Confusion Refusal and allow the Applicant’s trademark application to proceed.

Respectfully Submitted,

/Destini J. Chesley/

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Dated: January 2, 2020

EXHIBIT A

Search our Products **Ming Hsing Leather Co Ltd - Taiwan**

- [Company Home](#)
- [Company Profile](#)
- [Products / Services](#)
- All (3)

Company Information

Contact Person:
Ms. Lydia

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[Contact Supplier](#)

Ming Hsing Leather Co., Ltd. comes with 30 years of experience in producing sports handles and straps. We successfully produce leather products for various kinds of sports activities, which make us a well-known manufacturer in sports equipment. Our products feature excellent functions and quality, which gained great popularity. With a brilliant product development team and great management, our factory takes a leading role in the industry and is trusted by clients from Europe, Japan and the US.

Product/Service Highlights

		
Men's Bike Gloves	Bike Gloves	Bike Grips
Contact Supplier	Contact Supplier	Contact Supplier

Company Profile

Nature of Business:	Manufacturer
Industry:	Sports Goods
Product/Service Range:	Sports leather goods, handles and straps



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