



DOGWOOD PATENT AND TRADEMARK LAW

4801 GLENWOOD AVE., STE 200 RALEIGH, NC 27612

January 3, 2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: Unison

Serial No.: 88555979

Mark: TANDEM

Filed: July 31, 2019

International Class: 003

Examining Attorney: Kamal Preet

Law Office: 112

Attorney Docket No.: 121/2 TM

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

RESPONSE TO OFFICE ACTION

Applicant files this reply in response to the Office Action dated October 31, 2019, in connection with the above-referenced trademark application.

I. Response to the Section 2(d) Refusal

The Examiner has refused registration of Applicant's mark "TANDEM" for use in Class 003 with "deodorants for personal use, shampoo, soaps, and toothpaste." Specifically, the Examiner has based the rejection on an alleged likelihood of confusion with the following mark:

U.S. Reg. No. 5923711 for TANDEM + NANO

In response, Applicant respectfully submits that the registration cited by the Examiner will not cause confusion with the subject mark for the following reasons.

The Marks are Different

Initially, Applicant submits that likelihood of confusion between two marks at the USPTO is determined by a review of all of the relevant factors under the *du Pont* test. *In re du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, "there is no mechanical test for determining likelihood of confusion and 'each case must be decided on its own facts.'" TMEP §1207.01 (*citing du Pont*, 476 F. 2d at 1361, 177 USPQ at 567). Each of the *du Pont* factors may be considered in weighing likelihood of confusion, and any one may be dispositive. See, TMEP §1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common industry, because these factors are outweighed by other factors. *Id.*

The subject TANDEM mark and the cited registration both include the term "TANDEM". However, under the overall impression analysis, there is no rule that confusion is automatic merely because Applicant has a mark that contains in part or in whole another mark. See, for example, J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:41 (4th ed. 2002). Rather, the marks are to be compared in their entireties, including differences in appearance, pronunciation, connotation, and commercial impression.

Continuing, Applicant's mark is significantly different in visual appearance and pronunciation when compared to the mark cited by the Examiner. Specifically, the cited Registration includes the term "TANDEM" followed by a plus sign and the word "NANO." In comparison, Applicant's mark contains the single word "TANDEM." The plus sign (+) and the term "NANO" are completely lacking from Applicant's mark. Thus, the TANDEM mark includes a single word with a total of two syllables (TAN-dem). The cited registration, on the other hand, includes two words and a symbol that make up 5 syllables.

Applicant submits that marks that contain some similar terms, but are very different when viewed as a whole are unlikely to cause consumer confusion as to their source. *Keebler Co. v. Murray Bakery Prod.*, 866 F.2d 1386 (Fed. Cir. 1989). Any commonality created by the inclusion of these terms is expunged by the additional wording in Applicant's mark. Because the Trademark Act does not prevent registration of a mark on

the mere possibility of consumer confusion, but instead requires that the confusion be likely, registration of Applicant's mark is warranted under these circumstances. See, *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987); *In re The Ridge Tahoe*, 221 USPQ 839, 840 (TTAB 1983).

Given the visual and phonetic differences between Applicant's mark and the cited registration, Applicant respectfully submits that TANDEM is not visually or phonetically similar to TANDEM + NANO. The lack of similarity between the cited mark and Applicant's mark further strengthens the assertion that there would be no likelihood of confusion among consumers.

Applicant notes that the Examining Attorney has not introduced any evidence as to the likely commercial impression of the marks.

Continuing, the term "TANDEM" in Applicant's mark creates the commercial impression of personal care items that can be used together. For example, a consumer may apply deodorant, use shampoo to wash his hair, use soap to clean his body, and use toothpaste to clean his teeth – all as part of a normal daily morning routine. The term "TANDEM" thus gives the commercial impression that the personal care items may be used in succession. Applicant points to Exhibit A, a screenshot of the www.dictionary.com website definition of "tandem" – specifically, "one following or behind the other."

The Registered TANDEM + NANO mark, on the other hand, creates the commercial impression of an item that is dispensed serially as a single use, such as no touch hand soap or paper towels. Particularly, the symbol "+" is well known to refer to the word "AND" – therefore, TANDEM + NANO can be reasonably viewed as referring to "Tandem and Nano." The term "NANO" refers to a very small amount, as illustrated in the screenshot of Exhibit B of the Merriam-Webster dictionary definition. Thus, the commercial impression is of serial administration of small amounts or single use items, such as hand soaps and paper towels. Applicant further points to Exhibit C, illustrating one example of a TANDEM + NANO automatic paper towel dispenser available for sale on the Office Depot website.

Such differences in connotation and meaning are key factors in determining a likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used. *Revlon, Inc. v. Jerrell, Inc.*, 713 F. Supp. 93, 11 U.S.P.Q. 2d 1612, 1616 (S.D.N.Y. 1989) (No likelihood of confusion because the meaning and connotation of the marks THE NINES and INTO THE NINETIES are not related. THE NINES suggests the number nine, or nine of something in a group. INTO THE NINETIES is a reference to the decade of the 1990's, and more generally the future; Plaintiff's motion for preliminary injunction is denied.); citing *Clarks of England, Inc. v. Glen Shoe Company*, 465 F. Supp. 375, 379, 209 USPQ 852, 854-55, (S.D.N.Y. 1960) (TREK and STAR TREK for shoes; TREK connotes hiking across the Himalayas; STAR TREK connotes space travel.)

Taken together with the visual and phonetic differences between the cited registrations and Applicant's mark, it is clear that the marks are not likely to be confused in the marketplace. The cited TANDEM + NANO mark is different from Applicant's TANDEM mark visually, when spoken, in meaning, and in overall commercial impression. As a result, the cited differences render confusion unlikely.

Consumers are Sophisticated

Factors such as the sophistication of purchasers can reduce the likelihood of confusion and result in registration of what otherwise might be similar marks. *In re Digirad Corp.*, 45 USPQ2d 1841 (T.T.A.B. 1998). Applicant's and Registrant's target customers are consumers purchasing personal care items in Class 003. As such, the target customers are sophisticated and would be expected to be discerning, brand-conscious, and loyal when buying such items.

Thus, the sophisticated target consumers of both the Applicants and Registrant's products would be able to clearly distinguish the significant overall differences in the marks and associated products of the parties sufficient to avoid consumer confusion.

Prior Registrations in Class 025

Applicant further submits that there is an additional mark in Class 003 that includes the term "TANDEM" as set forth below.

| <u>Reg./Ser. No.</u> | <u>Mark</u> | <u>Goods in Class 003</u> |
|----------------------|-------------------|--|
| 3699504 | TEXTURE TANDEM | Hair care preparations; Hair styling preparations. |

A copy of the cited trademark is included in Exhibit D.

The Trademark Office has therefore routinely registered marks that include the term "TANDEM" in connection with goods in Class 003. The cited TEXTURE TANDEM mark is currently coexisting peacefully on the trademark register with the cited TANDEM + NANO mark. The fact that these marks are peacefully coexisting without confusion on the register lends weight to the assertion that Applicant's mark will likewise not cause confusion.

Applicant also points to the two cited TANDEM + NANO and TEXTURE TANDEM registrations, both used with goods in Class 003. Applicant submits that because both of the marks are currently registered for overlapping goods in Class 003, this provides **strong evidence** that Applicant's TANDEM mark would not present a likelihood of confusion, especially based upon the differences in spelling, pronunciation, and commercial impression as discussed above. Applicant therefore respectfully requests that the Trademark Office follow its established precedent of allowing marks that include the term "TANDEM" in Class 003 to peacefully coexist.

Conclusion

Applicant therefore submits that there is no likelihood of confusion between Applicant's mark and the cited registration. Applicant respectfully requests that the Likelihood of Confusion refusal be withdrawn at this time, and the subject application be allowed to proceed to publication.

With best regards,

A handwritten signature in blue ink, appearing to read 'Ashley D. Johnson', with a stylized flourish at the end.

Ashley D. Johnson
Dogwood Patent and Trademark Law, PLLC