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VIA TEAS

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**Re: U.S. Trademark Application Serial No. 88412986
S.W.I.F.T. STEADFAST WARRIORS INCORPORATING FAITH TOGETHER
Word-and-Design Mark**

Dear USPTO:

Our office represents Christopher M. Williams ("Applicant"), who has applied to register this trademark for certain goods in Classes 18, 25, and 28:



On July 19, 2019, the Office issued an initial refusal to register Applicant's mark based on a likelihood of confusion under § 2(d) of the Lanham Act. *See* TMEP § 1207; 15 U.S.C. §1052(d). Applicant presents this letter in response to that initial refusal.

Courts and trademark examiners apply the factors from *Application of E. I. DuPont DeNemours & Co.* to assess whether a likelihood of confusion exists between two marks. 476 F.2d 1357, 1361 (CCPA 1973); TMEP § 1207.01. This analysis "may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods." *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017).

The Office followed this approach. Citing a single standard-character registration for **S.W.I.F.T. STRONG WOMEN IN FITNESS TOGETHER** (No. 4695569), it relied exclusively on two of the thirteen *DuPont* factors and concluded that the mark pictured above and the registered mark were "substantially similar." Applicant strongly disagrees with that conclusion and respectfully submits that there is no potential for confusion sufficient to bar registration under § 2(d).

1. Applicant’s Goods are Entirely Distinct from Registrant’s Services

Registrant provides running-specific retail and association services in Class 35. Applicant seeks to register his mark for various goods in Classes 18, 25, and 28, none of which are specifically related to running:

Applicant’s Goods (Classes 18, 25, and 28)	Registrant’s Services (Class 35)
<p><u>Class 18</u>: Backpacks; Luggage; Suitcases; Wallets; Drawstring bags; Dry bags; Duffel bags; Overnight bags; Shoulder bags; Tote bags; Travelling bags; Weekend bags</p> <p><u>Class 25</u>: A-shirts; Button down shirts; Collared shirts; Dress shirts; Gloves; Golf shirts; Golf pants, shirts and skirts; Headbands for clothing; Hooded sweatshirts; Hoods; Jackets; Polo shirts; Shirts; Tee shirts; Ties as clothing; Tops as clothing</p> <p><u>Class 28</u>: Balls for sports; Boxing gloves; Boxing bags; Punching bags; Sports equipment for boxing and martial arts, namely, boxing gloves, boxing bags, punching mitts, belly protectors, groin protectors and shin guards; Sports equipment for boxing and martial arts, namely, boxing gloves, mixed martial arts gloves, punching mitts, and shin guards</p>	<p><u>Class 35</u>: Association services, namely, promoting the interests of women’s fitness and running; On-line retail store services featuring apparel and running accessories.</p>

Registrant’s services are specifically limited to running apparel, accessories, and association services. Applicant does not seek to register his mark for any goods specific to running—or any services whatsoever—so the potential for consumer confusion here is very low. The Office’s conclusion that Applicant’s goods and Registrant’s services are “closely related” relies on caselaw about the relationship between products and “retail-store services featur[ing] the same type of products[.]” *E.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018). But that caselaw is inapplicable here because Applicant has made no claim to the type of running-based goods that Registrant sells.

2. Applicant’s Mark Is Distinct from the Registered Mark

Second, Applicant’s mark and the registered mark are dissimilar in “appearance, sound, connotation[,] and commercial impression[.]” TMEP § 1207.01(b); *see, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012). The inquiry may properly end there, as “a single *DuPont* factor may be dispositive in a likelihood of confusion

analysis, especially when that single factor is the dissimilarity of the marks.” *E.g., Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 1381-82 (Fed. Cir. 2016).

A. Appearance

“Similarity of appearance between marks is really nothing more than a subjective ‘eyeball test.’” 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:25 (5th ed.) (citing *General Foods Corp. v. Ito Yokado Co.*, 219 USPQ 822 (TTAB 1983)); see TMEP § 1207.01(b)(ii).

Here, that “eyeball test” shows two marks made up of very different words:



S.W.I.F.T. Strong Women in
Fitness Together

Indeed, the two marks share nothing in common other than their acronym and the final word “together.” As the Office has acknowledged, it is obligated to consider Applicant’s composite mark in its entirety and “not from its elements separated and considered in detail[.]” *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). Looking at Applicant’s mark as a whole, the large capital letters S.W.I.F.T. are the most dominant visual element because of the amount of space they take up. The same is not true in Registrant’s mark, where S.W.I.F.T. is simply the first of many words and is likely to be glossed over in favor of more information about the mark’s actual meaning.

Consumers do not necessarily have the luxury of making the same side-by-side “eyeball test” that judges, trademark examiners, and attorneys do. *See, e.g., Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). But they would not naturally view these two marks as visually similar either. Because of the periods, consumers will immediately discern that each mark is an acronym and redirect their attention to the component words accordingly. Four of those five component words are completely different: “steadfast” v. “strong”; “warriors” v. “women”; “incorporating” v. “in”; and “faith” v. “fitness”. This is more than enough to make a distinct visual impression.

B. Sound

“Trademarks, like small children, are not only seen but heard.” *Grotrian et al. v. Steinway & Sons*, 523 F.2d 1331, 1340 (2d Cir. 1975). To evaluate phonetic similarity, an examiner may consider the number of syllables of articulable elements of a mark. TMEP § 1207.01(b)(iv); *e.g., G.D. Searle & Co. v. Charles Pfizer & Co.*, 265 F.2d 385, 387 (7th Cir. 1959). Here, Applicant’s mark is roughly nineteen syllables, while Registrant’s is only fourteen. The individual components—*e.g., “incorporating”* (five syllables) v. “in” (one)—have very

different syllable patterns as well. These phonetic distinctions further reduce any potential for confusion between the two marks.

C. Connotation

Both marks include the letter pattern "S.W.I.F.T." This is not a problem: the periods in each mark make it readily apparent that "S.W.I.F.T." is an acronym in each case, and the remainders of each mark promptly explain exactly what those acronyms mean. *Cf., In re Max Capital Grp. Ltd.*, 93 USPQ.2d 1243 (TTAB 2010) (mark perceived as a word "because it [wa]s not depicted with periods or anything that would indicate" it was an acronym).

A case involving two competing "CBN" television networks, *The Christian Broadcasting Network, Inc. v. ABS-CBN International*, provides helpful guidance. 84 USPQ.2d 1560 (TTAB 2007). There, one network argued that there was no likelihood of confusion "because the [two] marks [we]re acronyms or initialisms which mean different things: Christian Broadcasting Network in the case of petitioner's CBN mark; and Alto Broadcasting Network and Chronicle Broadcasting Networking in the case of respondent's ABS-CBN mark." *Id.* The TTAB rejected this argument, citing the potential for confusion "because the corporate names [we]re not part of either party's registrations" and because there was no evidence that consumers knew what either acronym stood for. *Id.*

Here, consumers have perfect information. Even the most casual observer will automatically know what each "S.W.I.F.T." stands for because the full name of each company is in each mark. As a result, there is no ambiguity or confusion about the source of goods or services sold under these two marks.



2. Many Registered Marks for Apparel Begin with "SWIFT"

Even with many fewer distinguishing words, Applicant's mark would still be registrable. This is because the word SWIFT, suggestive as it is of speed and agility, is "so commonly used" for apparel that "that the public will look to other elements to distinguish the source of the goods or services." TMEP § 1207.01(d)(iii).

Applicant may present existing third party registrations for the "limited" purpose of showing this common use—or, in the words of the sixth *DuPont* factor, the "number and nature of similar marks in use on similar goods." *Application of E. I. DuPont DeNemours & Co.*, 563, 567 (CCPA 1973). Any such evidence of third-party use of similar marks on similar goods "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005). Here, all of the following marks are registered and active for apparel-related goods:

Mark	Reg. No.	Goods (Quoted; Class 25)
SWIFTMOVEMENT	5913673	Boots; Boots for sport; Cheongsams (Chinese gowns); Coats; Down jackets; Dresses; Footwear; Fur coats; Insoles; Lace boots; Men's and women's

		jackets, coats, trousers, vests; Overcoats; Pants; Sandals; Shirts; Shoes; Slippers; Sports shoes; Sweaters; T-shirts; Tops as clothing; Trousers; Wearable garments and clothing, namely, shirts; Women's clothing, namely, shirts, dresses, skirts, blouses
SWIFTLITE	5715489	Fabric sold as an integral component of finished clothing items, namely, pants and shorts
SWIFT PIGEON APPAREL	5100036	Clothing, namely, shirts, t-shirts, tank tops, sweatshirts, hooded sweatshirts, jerseys, pullovers, jackets, hats, underwear
SWIFT DIAMOND	5717101	Clothing, namely, athletic sleeves; Dresses; Leg shapers; Leg warmers; Leg-warmers; Leggings; Pullovers; Shirts; Skirts; Socks; Tank-tops; Evening dresses; Fleece pullovers; Head wraps; Hooded pullovers; Hoodies; Hoods; Jackets; Jerseys; Long sleeve pullovers; Polo shirts; Sports shirts; Sweat shirts; T-shirts; Tee shirts; Turtleneck pullovers; Yoga shirts
SWIFTWATER	5585903	Footwear
SWIFTWICK	5364438	Hats; Headbands; Socks; Sports pants; Sports shirts; Sweat bands; T-shirts; Wrist bands as clothing
SWIFTLY	5413086	Clothing, namely, t-shirts, shirts, tank tops, sweatshirts, sweaters; clothing accessories, namely, arm warmers and scarves; headwear, namely, headbands
SWIFT ENOUGH TO ENDURE	4953847	Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Children's and infants' apparel treated with fire and heat retardants, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments
SWIFTBELTS	4694060	Belts for children
SWIFT RIVER	3014135	Apparel for men, women, and children, namely, pants, shirts, and jackets

SWIFT	3941729	Infant carriers worn on the body
	3998502	Socks; Hats; Headbands; Sports pants; Sports shirts; Sweat bands; T-shirts; Wrist bands
SWIFT-DRY	4242161	Footwear, Hosiery, and Socks
SWIFT CREEK	2508080	Footwear
	1167379	Shoes

Copies of these registrations are included with this response as **Exhibits 1-15**. The peaceful coexistence of all of these SWIFT-based marks for apparel indicates that Applicant's mark may be safely registered for apparel-related goods as well.

3. Applicant Accepts the Office's Proposed Description Amendment

As a final matter, the Office proposed the following amended mark description:

The mark consists of the stylized wording "S.W.I.F.T.". The stylized wording "STEADFAST WARRIORS INCORPORATING FAITH TOGETHER" appears below "S.W.I.F.T.". All the wording appears shaded on top of a darker shaded background.

Applicant accepts this proposed amendment and requests that the Office issue an Examiner's Amendment reflecting the change.

Conclusion

The Office has initially refused registration for Applicant's mark based on a registered mark for S.W.I.F.T. STRONG WOMEN IN FITNESS TOGETHER. But Applicant's mark differs substantially from that mark in appearance, sound, and connotation, which leaves consumers with substantially different commercial impressions of the two marks. Moreover, the initial element shared by the marks—the word SWIFT—is widely used for apparel and is accordingly entitled to only a minimal level of trademark protection.

Applicant therefore submits that its mark poses no § 2(d) likelihood of confusion and is entitled to prompt publication. If the Office disagrees, Applicant respectfully requests that it issue a second non-final action to which Applicant can further respond.

Applicant thanks the Office in advance for its continued attention to this application.

Sincerely,

/William Chan/

William Chan