

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Application Serial No. 88/500,200
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Attorney's Docket No. 23585-2
Mark: A-1 and design

RESPONSE TO OFFICE ACTION

In response to the Office Action dated September 28, 2019, Applicant respectfully submits the following remarks and arguments in support of allowing the Application to proceed to allowance and publication. This argument will focus on the Section 2(d) Refusal – Likelihood of Confusion issued by Office, while the remaining issue(s), if any, will be addressed in the electronic form submitted herewith. This Response relies upon and incorporates the facts provided in the attachments to the Office Action and also the Exhibit filed herewith. For the reasons indicated herein, favorable action with respect to this Response is respectfully requested.

REMARKS

In the Office Action, the Office refused the Application asserting that there is a likelihood of confusion between the applied-for mark and the mark of U.S. Registration No. 5004858 (“*stylized A1 design*”). The Office also suggests that there may be a likelihood of confusion between the applied-for mark and the mark of U.S. Application Serial No. 88414411 (“*stylized A1 GENERAL CONSTRUCTION INC. design*”) and U.S. Application Serial No. 88411459 (“A1 GENERAL CONSTRUCTION”). Although pending at the time of the Office Action, these two application have since registered as U.S. Registration Nos. 5936210 and 5936184, respectively.

The Office's analysis is incomplete and insufficient to establish a likelihood of confusion on the part of the ordinary consumer between the applied-for mark ("*stylized A-1 and man design*") and the cited registrations ("*stylized A1 design*"), ("*stylized A1 GENERAL CONSTRUCTION INC. design*"), and ("A1 GENERAL CONSTRUCTION"). A proper and complete analysis "requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" TMEP §1207.01(b). "All relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Id.* "The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon." TMEP §1207.01, citing *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901 (C.C.P.A. 1973). In other words, the question is not whether consumer confusion is *possible*, but rather whether confusion as to source is *likely*. The mere *possibility* of confusion among a very small subset of consumers is insufficient to establish a *likelihood* of confusion. In the Office Action, the Office improperly divides the marks into component elements and then gives too much weight to the literal A1 elements, but neglects to consider the other elements of the applied-for mark and the cited registrations. In other words, the Office has not adequately considered the marks in their entireties as to appearance, sound, connotation and commercial impression.

I. Appearance

“Similarity in appearance is one factor to consider when comparing the marks.” TMEP §1207.01(b)(ii). Given appropriate consideration, the appearance factor favors dissimilarity of the marks and no likelihood of confusion. The appearance of the applied-for mark (“*stylized A-1 and man design*”) is significantly different from that of the registered marks (“*stylized A1 design*”), (“*stylized A1 GENERAL CONSTRUCTION INC. design*”), and (“A1 GENERAL CONSTRUCTION”). The applied-for mark includes a sizeable clock element and walking man carrying a toolbox element, both of which are larger in size than the A-1 element. These elements are absent from the cited registrations and the cited registrations have no feature or element comparable or confusingly similar to these two elements. At a bare minimum, the clock and walking man elements distinguish the applied-for mark from the cited registrations.

In addition, colors are claimed features of the applied-for mark. The applied-for mark has three distinctively red elements – the dash in A-1, the walking man’s name tag, and the walking man’s toolbox. None of the cited references include the color red anywhere in the respective marks as a distinctive claimed element.

Furthermore, the stylized font of the A-1 element of the applied-for mark is distinctively different from that of the cited registrations.

Finally, even if an observer were to strip away and ignore all other design elements and limit the analysis to the wording only, which Applicant contends is wholly improper, the applied-for mark remains significantly different than the marks of the cited registrations. The applied-for mark includes three characters in the wording element – “A” “-” and “1.” The first cited registration includes only “A” and “1.” No dash. The first cited registration (“*stylized A1 design*”) is missing fully 1/3 of the characters in the wording element of the applied-for

mark. The remaining two cited registrations also lack the dash, but also include more additional distinguishing wording: “GENERAL CONSTRUCTION INC.” and “GENERAL CONSTRUCTION,” respectively. In any event, the stylized design elements of the applied-for mark and the cited registrations cannot be ignored.

The stylized design elements *distinguish* the applied-for mark from the cited registrations. The ordinary American consumer appreciates the visual differences between the applied-for mark and the cited registrations and, based solely on appearance, is unlikely to confuse the services associated with each to emanate from the same source.

II. Commercial Impression

Given appropriate consideration, the overall general commercial impression factor favors dissimilarity of the marks and no likelihood of confusion. The wording A1 and A-1 elements are found on many different marks. See Exhibit. The strength of that particular component element of the mark is relatively weak. Consumers see many different variations of A1 and A-1 associated with all kinds of different goods and services, sometimes even in the same or similar field. Taking in the overall general commercial impression, the dash alone is adequate for consumers to distinguish A-1 from A1. The additional wording included with the other cited registrations (“GENERAL CONSTRUCTION”) is also more than sufficient for consumers to differentiate given the common and frequent prevalence of A1 and A-1 elements. The other additional design elements ensure the applied-for mark makes a distinct overall general commercial impression different from that of the cited registrations. Given the difference in the general overall commercial impression of the applied-for mark compared to the cited registrations, the ordinary consumer is unlikely to confuse the services associated with each to emanate from the same source.

III. Conclusion

A proper and complete analysis of all relevant *du Pont* factors is insufficient to support the likelihood of confusion conclusion in this matter. The marks should not be divided into component elements. The A1 / A-1 element, alone and without accompanying stylized design element features, should not be given very much weight in the overall likelihood of confusion analysis. The applied-for mark and the cited registrations are dissimilar in appearance and overall general commercial impression. Taking all factors under consideration and giving them proper weight, the applied-for mark and the cited registrations are not likely to confuse people into believing that the services they respectively identify emanate from the same source.

In view of these arguments and the evidence on record, Applicant respectfully requests the Office to reconsider and withdraw the Section 2(d) Refusal previously asserted, thus allowing the Application to proceed to allowance and publication.