

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : HORIZON LIGHT
Serial No. : 88496172
For : remarkable.legal
Examiner : CARYN GLASSER
Law Office : 105

RESPONSE TO OFFICE ACTION DATED 09/23/2019

This is responsive to Office Action dated 09/23/2019. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Abhay Wadhwa seeks registration of U.S. Serial No.88496172 for HORIZON LIGHT (and design) in relation to "Ceiling lights; Light bulbs; Light diffusers; Lighting apparatus, namely, lighting installations; Luminous tubes for lighting; LED (light emitting diode) lighting fixtures; LED mood lights" in International Class 11. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); see TMEP § § 1207.01 et seq.

•U.S. Registration No. 5492534 for HORIZON covering "Lighting apparatus, namely, laser light installations, namely, buttons, pan tilt motors, laser diodes, lenses, solar panels, and batteries; and lighting installations for buildings, vehicles, aircraft, helicopters, poles, and frames; laser flashlights; lights with lasers, namely, laser beam projectors; laser floodlights" in International Class 11.

•U.S. Serial No. 87394436 for HORIZON covering "Lighting apparatus, namely, high performance linear LED lighting fixtures for surface grazing and edge lighting applications specifically designed for high-end retail, commercial and residential settings" in International Class 11.

•U.S. Serial No. 87829015 for HORIZON covering "LED (light emitting diode) lighting fixtures; LED (light emitting diodes) lighting fixtures for use in display, commercial, industrial, residential, and architectural accent lighting applications; LED light assemblies for street lights, signs, commercial lighting, automobiles, buildings, and other architectural uses; LED light bulbs; LED light engines; LED light machines; LED lighting fixtures for indoor and outdoor lighting applications; LED lighting systems, namely, LED modules, power supplies, and wiring; LED and HID light fixtures; LED flood lights and LED work lights for construction settings; LED landscape lights; LED underwater lights; Luminaries, using light emitting diodes (LEDs) as a light source, for street or roadway lighting; Optical lens covers that improve light output and uniformity and protect the LED, sold as a feature of an LED lighting system" in International Class 11.

**APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF
CONFUSION**

Applicant respectfully disagrees with the Examining Attorney's 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 similarity or dissimilarity of the marks in their entireties as to appearance, sound,
connotation, and commercial impression;**

In comparing two trademarks for confusing similarity, the Examining Attorney must 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").

1. No Explicit Rule that Likelihood of Confusion Applies Where Junior User's Mark Contains the Whole of Another Mark.

There is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole of another mark. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to in-corporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused

registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion. Here, the marks share the term "HORIZON" in common but this common term is not enough to support a finding of likelihood of confusion, particularly where there are a number of differentiating factors.

2. Marks Differ in Sight, Sound, and Commercial Impression



a. Marks Differ in Sight

Where there is an addition of a distinctive element, as in a term or a design, or there is a significantly different display of the same terms, there is little likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). Likelihood of confusion is minimized where a design is used as part of a mark. *Harlem Wizards*, 952 F. Supp. at 1096 (citing *McCarthy* at §23:15[51]).

A visual examination of the literal elements of the conflicting marks supports a finding that they are different. Applicant's mark consists of the wording HORIZON LIGHT in white and outlined in orange within a rectangular background in gradient shading in the colors orange, yellow, white and blue from

the top down. In contrast, Registrant's and Prior Pending marks all consists of the word HORIZON. Given the significantly different literal elements discussed above, there is little likelihood of confusion.

b. Marks Differ in Sound

Here, the marks vary substantially in sound. Applicant's mark is pronounced with four syllables whereas Registrant's and Prior Pending marks are pronounced with three syllables, and non include the sound of the word LIGHT. As such, these marks sound little alike and have an entirely different phonetic profile.

However, even where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. See *National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed such as the term "duet" was a com-mon word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

c. Marks Differ in Commercial Impression

The marks in this case vary substantially in commercial impression. Applicant's HORIZON LIGHT (and design) in relation to Ceiling lights; Light bulbs; Light diffusers; Lighting apparatus, namely, lighting installations; Luminous tubes for lighting; LED (light emitting diode) lighting fixtures;

LED mood lights gives the idea of cutting edge lighting products that simulate the light a sunrise gives. Specifically, when we read the combination of HORIZON LIGHT, the word “light” emphasizes this idea of sunlight from the sunrise or sunset. HORIZON LIGHT will provide all your light needs for the day or night, with a whole spectrum of colors and with light weight design as portrayed by the thin letters on the logo and the distinct contrasting colors shown on the design.

In contrast, Registrant’s and Prior Pending trademarks HORIZON for lighting products gives the idea of devices made to light your HORIZON. We must remember the HORIZON is a perspective of where the surface and the sky appear to meet. It's a term that could imply limits, and without additional modifiers, only communicates the idea of lighting that will illuminate your HORIZON. This mark presents no commercial impression related to a sunset or sunrise light. Given the significant differences in commercial impressions, there is little likelihood of confusion between the marks.

CONCLUSION

For the reasons listed above, Applicant respectfully requests that the Examining Attorney should remove all refusals for the trademark HORIZON LIGHT (U.S. Serial No. 88496172) and approve the mark for publication.

Respectfully submitted:



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