

Mark: **KENDALL**
Class 3
Serial No: 88413516

OFFICE ACTION RESPONSE

Applicant Kendall Jenner, Inc. (“Applicant”) hereby responds to the Office Action dated July 17, 2019 (“Office Action”) with respect to the above-referenced mark (“Applicant’s Mark” or “Mark”).

In the Office Action, the Examining Attorney refused registration of Applicant’s Mark in International Class 3 for “Fragrances; eau de parfum; eau de toilette; perfumes; hair care preparations; hair styling preparations; bath and shower gels; bubble bath; body powders; body lotions; body creams; face lotions; body milks; skin toners; skin cleansers; beauty masks; body scrubs; facial scrubs; body oils; deodorant for personal use; lip balm; lip gloss; cosmetics; cosmetic preparations; nail polish; nail polish remover; and nail care preparations” based on a perceived likelihood of confusion with sixteen registrations that include some form of the name “KENDALL” alone or in conjunction with other term(s) (the “Cited Marks”).

The Examining Attorney has also noted a prior-filed application that may present a bar to registration of Applicant’s Mark and has requested that Applicant provide an acceptable written consent to register Kendall Jenner’s first name, KENDALL, as a trademark with the United States Patent and Trademark Office. Applicant addresses each issue below.

For the reasons discussed below, Applicant respectfully requests that the Examiner withdraw the refusal and approve Applicant’s Mark for publication.

I. THERE IS NO LIKELIHOOD OF CONFUSION WITH THE CITED MARKS.

As noted above, the Examiner has cited sixteen prior registrations for “KENDALL” a variety of goods as a bar to registration of Applicant’s Mark. However, Applicant submits there is no likelihood of confusion between its Mark and any of the Cited Marks. In determining if a likelihood of confusion exists, “[t]he issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods [or services].” TMEP § 1207.01. Thus, even in instances where the goods or services at issue are similar or identical, a likelihood of confusion will only be found if the relevant purchasing public would mistakenly believe that the applicant’s goods or services originated from the same source as the registrant’s goods or services. *FBI v. Societe: “M. Bril & Co.”*, 172 USPQ 310 (TTAB 1971). For a likelihood of confusion to exist, consumer confusion as to the source of the applicable goods or services must be “probable” not simply “possible.” *Cohn v. Petsmart, Inc.*, 281 F.3d 837, 842 (9th Cir. 2002) (internal citations omitted); see also *Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998) (“Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion.”) (emphasis added).

The question of likelihood of confusion between marks is “not related to the nature of the mark but to its effect ‘when applied to the goods of the applicant.’ The only relevant application

is made in the marketplace. The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding the use of a mark.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (internal citations omitted). In determining whether there is a likelihood of confusion, courts look to many factors, e.g., the similarity of the marks in sight, sound, connotation and commercial impression, the relatedness of the goods or services, the channels of distribution of the goods and services, and the strength of the senior user's mark. *Id.* No single factor is dispositive and “each [factor] may from case to case play a dominant role.” *Id.* at 1357.

Here, application of the most relevant *du Pont* factors demonstrates that consumers are not likely to be confused as to the source of the goods offered in connection with each of these marks because (A) Applicant’s Mark, when used in connection with sufficiently dissimilar goods, differs in sight, sound and meaning, and creates a distinct overall commercial impression from each of the Cited Marks, (B) the goods offered under Applicant’s Mark are distinguishable from the goods offered under each of the Cited Marks, and (C) Applicant employs different marketing channels and targets a different consumer base from that of the Cited Marks.

A. There is no Likelihood of Confusion Because the Marks are Distinguishable in Sight, Sound and Meaning and Convey Dissimilar Commercial Impressions.

A general rule in considering the likelihood of consumer confusion between two marks is that “[e]ven marks which are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion.” TMEP §1207.01(b)(v) (citing *In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977)). In comparing the marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of a trademark. *See, e.g., In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009).

When comparing marks, the Examining Attorney must observe the “Anti-Dissection Rule,” which dictates that marks are not to be dissected, but rather are to be considered as a whole in a likelihood of confusion analysis. *See* TMEP § 1207.01 (citing *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985)); 4 McCarthy on Trademarks and Unfair Competition § 23:41 (4th ed.). “The basic principle in determining confusion between marks is that marks must be compared in their entirety and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (footnotes omitted) (citations omitted).

Accordingly for the reasons discussed below, Applicant respectfully asserts that its Mark is distinguishable in sight, sound, meaning, and overall commercial impression from each of the Cited Marks.

I. Applicant's Mark is Visually and Audibly Distinguishable from the Cited Marks.

Applicant's Mark differs in sight and sound from each of the Cited Marks. In particular, all but three of the Cited Marks include additional wording and, in several cases, design elements. Thus, when used in connection with different goods (as discussed in more detail below), consumers are not likely to be confused as to the source or origin of the parties' respective goods. Furthermore, if all of the Cited Marks can coexist on the registry with no likelihood of confusion, then Applicant's Mark, particularly when used in connection with different goods, should be able to join these other marks without creating confusion. In other words, Applicant submits that its mark is no more similar to these other marks than they are to each other.

Considering each of the marks in their entities, the obvious differences between the marks in sight and sound obviate any potential for confusion. This is particularly true when there are so many third-party marks (as evidenced by Examiner's citation to sixteen other registered marks) utilizing some variation of KENDAL/KENDALL for a wide array of merchandise. Indeed, evidence of widespread third-party use of marks containing a certain shared term demonstrates that purchasers have become conditioned to look to other elements of the marks as a means of distinguishing the source of the goods or services in the field. *See Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334 (Fed. Cir. 2015) (PEACE LOVE AND JUICE not likely to be confused with PEACE & LOVE and registrant's variants thereof); *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d at 1565-66 (no likelihood of confusion between BROADWAY CHICKEN and BROADWAY PIZZA); *Miss World (UK) Ltd. v. Mrs. American Pageants, Inc.*, 8 U.S.P.Q.2d 1237, 1241 (9th Cir. 1988) (citing *J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* §11:26, at 511 (2d ed. 1984)) (no likelihood of confusion between MISS WORLD and MRS. OF THE WORLD).

The visual and audible differences between the marks are highlighted below:

- a. KENDALL MAC (stylized) (Reg. No. 5694825) in Class 25 for clothing

Applicant's Mark is visually and phonetically different from this mark. Consumers encountering the marks in the marketplace will immediately see and pronounce the extra word "MAC" and notice the distinctive stylized font utilized in the mark KENDALL MAC, as shown here:

Kendall Mac

Though Applicant's Mark is a block letter mark, the stylization of the KENDALL MAC mark coupled with the additional term are sufficient to distinguish between the marks, particularly where consumers will encounter the two marks in the marketplace on different goods (clothing vs. perfume, body and hair care products). Therefore, there is no likelihood that consumers will believe the parties' respective products under their respective trademarks emanate from a single source.

- b. Cited Marks for KENDALL STREET COMPANY (and design) (Reg. No. 5593632) in Class 25 for t-shirts and L KENDALL (and design) (Reg. No. 5018352) in Class 14 for jewelry and watches

Where a mark consists of a design element and words, "the fundamental rule in this situation is that the marks must be considered in their entireties." See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015).

Here, the design mark KENDALL STREET COMPANY is used in conjunction with the additional words STREET COMPANY, as well as the distinct sailboat design, as shown here:



Consumers encountering the registrant's t-shirts featuring the design mark will perceive the entire mark and notice the visual and audible differences between the marks and are not likely to believe that the shirts sold under the KENDALL STREET COMPANY design mark emanate from the same source as the fragrances and body care products sold under Applicant's Mark.

Likewise, the mark L. KENDALL is used in combination with a star/nautical design element and arched stylized wording as shown here:



Consumers will immediately perceive the design component and arched wording along with the letter "L" in the first position and are not likely to confuse the source of the products sold under the mark KENDALL with the watches and jewelry sold under L. KENDALL (and design).

- c. Cited Marks for KENDALL CONRAD (Reg. No. 4929216) in Class 25 for footwear, (Reg. No. 4567076) in Class 14 for jewelry, and (Reg. No. 4412170) in Class 18 for bags and wallets, KENDALL &

JAMES (Reg. No. 5009646) in Class 14 for jewelry and (Reg. No. 5246722) in Class 25 for clothing, KENDAL & HYDE (Reg. No. 5104354) in Class 18 for bags and wallets, KENDALL MILES (Reg. No. 5257054) in Class 25 for footwear, KENDALL-JACKSON (Reg. No. 4603318) in Class 3 for soap, KENDAL BOOTGLOW (Reg. No. 3446761) in Class 25 for clothing, and KENDALL HARTCRAFT (Reg. No. 2532004) in Class 20 for picture frames

Each of the above Cited Marks contains an additional term that makes it visually different from Applicant's Mark. Consumers must see and pronounce each of these additional words to fully perceive each of the marks. Applicant's Mark contains no additional term. Further, Applicant submits that the dominant and distinguishing portions of each of these marks is not KENDALL, but is rather the additional terms, i.e., CONRAD, & JAMES, & HYDE, MILES, - JACKSON, BOOTGLOW, and HARTCRAFT. Indeed, the name is a fairly popular first name and consumers have become accustomed to seeing the name so often that they are not likely to believe that all trademarks that share the term "Kendall" are related. See Printout from www.ourbabynamer.com.

Furthermore, given that each of these cited marks coexist without confusion and all begin with the word "KENDALL/KENDAL," it is clear that that the differences in sight and sound, coupled with the different goods sold under the marks, are sufficient to avoid confusion. The only Cited Mark above that even overlaps in Class 3 is the KENDALL-JACKSON mark for soap. However, KENDALL-JACKSON is a well-known wine maker that arguably always uses its mark in its entirety, including the "hyphen" between the terms "KENDALL" and "JACKSON." Thus, consumers encountering the perfume, cosmetics, hair and body care products sold by Applicant under the mark KENDALL are not likely to mistakenly believe that they originate from the well-known wine maker Kendall-Jackson.

Therefore, Applicant submits that confusion between its Mark and these Cited Marks is unlikely.

- d. Cited Marks for KENDAL (Reg. No. 5593994) in Class 10 for microdermabrasion apparatus and foot massagers, (Reg. No. 5219431) in Class 20 for massage chairs and related furniture items, and (Reg. No. 5041395) in Class 14 for jewelry

The remaining registrations for KENDAL are the only three out of sixteen cited marks that do not include an additional term or design element. However, Applicant's Mark is also visually distinguishable from this mark because it includes a second "L." Again, consumers are so accustomed to seeing the name Kendall/Kendal/Kendyll in the marketplace, that a different spelling is an immediate signal that the source of the goods sold under marks featuring various spellings is also different. Thus, Applicant contends that the visual difference between KENDALL and KENDAL, particularly when used on very different goods (i.e., foot massagers, microdermabrasion tools and furniture vs. cosmetics, perfume and body/hair care products), is enough to conclude that there is no likelihood of confusion. Lastly, if the registrations for

KENDAL can coexist with the other cited registrations noted above, then Applicant's Mark too should be able to join these marks without creating a likelihood of confusion.

Accordingly, given the differences between Applicant's Mark and each of the Cited Marks in sight and sound, Applicant submits that the marks are not likely to be confused.

2. *The Marks Convey Distinct and Different Commercial Impressions; Applicant's Mark Refers to a Famous Person.*

"The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." TMEP 1207.01(b)(v) (citing *e.g.*, *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "'implies something else, primarily indoors in nature'" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

Furthermore, "[i]f two conflicting marks each have an aura of suggestion, but each suggests something different to the buyer [as is the case here] this tends to indicate a lack of likelihood of confusion . . . Thus, in some instances identical or closely similar marks will not in fact give rise to a likelihood of confusion because the meaning they convey in each context will point in distinctly different directions." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:28 at 23-102.19 (4th ed. 2004) (emphasis added).

More importantly, there is no likelihood of confusion between marks that have a shared term where one mark designates a particular person. *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 1339 (Fed. Cir. 1984) (finding no likelihood of confusion between HUNGRY HOBO and HOBO JOE'S despite the significant similarity between both marks). In *Colony Foods, Inc.*, the Federal Circuit upheld the Board's decision and rejected a finding of likelihood of confusion between the registrant's mark HUNGRY HOBO and the petitioner's mark HOBO JOE'S. *Id.* at 1340. Despite the similarity between the marks and the goods and services, the Court held that the petitioner's mark was not confusingly similar to the registrant's mark because petitioner's mark "designate[d] a particular person"—Joe—whereas registrant's mark "[gave] the impression of an anonymous person." *Id.* at 1339. Customers would leave petitioner's restaurant with an image of a particular individual hobo named Joe as opposed to the impression of an anonymous, hungry hobo when leaving the registrant's restaurant. *Id.* Accordingly, the Court held there was no

likelihood of confusion between the marks because the marks had different meanings. *Id.* at 1340.

Here, there is no likelihood of confusion between Applicant's Mark and the Cited Marks because they have significantly different meanings, particularly when applied to the parties' respective goods. Indeed, when Applicant offers its fragrances and personal care products to the public under the mark KENDALL, it will do so in close association with the world famous model and reality television star and member of the well-known Kardashian/Jenner family, Kendall Jenner. *See* Printout from Kendall Jenner's Wikipedia page. Indeed, Ms. Jenner's fame is evident when one considers that a simple Google search returns more than 50,000,000 hits for her name. *See* Printout of Google Search results for "Kendall Jenner." E! News online returns more than 1000 articles featuring Kendall Jenner and People returns nearly 5,000 articles. *See* Printouts from www.eonline.com and www.people.com. Applicant's fame is so widespread that when consumers encounter the trademark KENDALL on Applicant's products, particularly when marketed in connection with Kendall Jenner, consumers will immediately associate the name KENDALL with the famous model, her family and their vast array of clothing, accessories, and beauty products. Just like perfume sold under the name TAYLOR immediately calls to mind the famous pop star, Taylor Swift, so too does perfume sold under the name KENDALL call to mind the famous model, Kendall Jenner. Therefore, Applicant contends that the overall commercial impression conveyed by its Mark is one of high fashion, youthfulness and beauty, and it is very different than the commercial impressions conveyed by the Cited Marks.

In addition, specific differences in the commercial impressions as they pertain to certain of the Cited Marks are noted below:

- a. KENDALL MAC (stylized) (Reg. No. 5694825) in Class 25 for clothing

Kendall Mac

The registration for the stylized mark KENDALL MAC, when applied to the registrant's clothing goods, implies that the clothes come from a particular individual by the same name. Indeed, the mark is used on the goods in a stylized fashion that appears to be a person's signature – which further supports the notion that the goods emanate from a clothing designer named Kendall Mac. Given the differing meanings and commercial impressions conveyed by the marks, Applicant respectfully submits that fragrances, cosmetics and personal care products sold under the KENDALL mark, when marketed and sold in connection with Kendall Jenner, are not likely to be confused with the clothing sold under this brand.

- b. KENDALL STREET COMPANY (and design) (Reg. No. 5593632) in Class 25 for t-shirts



KENDALL STREET COMPANY (and design) identifies a band that uses the mark on t-shirts and is still together and actively touring. See Printout of Tour Dates from the band's website at www.kendallstreetcompany.com/tour. The use of the sailboat design shown above conveys a commercial impression of ease and relaxation, which is very different than the commercial impression of high fashion, youthfulness and beauty conveyed by Ms. Jenner's mark KENDALL. Combined with the additional wording "Street Company" for t-shirts, it is unlikely that the products sold under Applicant's Mark will be confused with this registrant's shirts.

- c. L KENDALL (and design) (Reg. No. 5018352) in Class 14 for jewelry and watches



The name L. Kendall identifies an expert watchmaker from the 18th century. See Printout from www.kendallwatches.com. Therefore, when used in connection with jewelry and watches, the mark L. KENDALL (with a nautical design) calls to mind luxury, hand-crafted water-resistant watches and fine jewelry. Thus, the commercial impression conveyed by this mark is very different from Applicant's Mark, particularly when applied to the parties' respective goods, which alleviates any likelihood of confusion.

- d. KENDALL CONRAD (Reg. No. 4929216) in Class 25 for footwear, (Reg. No. 4567076) in Class 14 for jewelry, and (Reg. No. 4412170) in Class 18 for bags and wallets

The Cited Marks for KENDALL CONRAD, identify a line of accessories created by designer Kendall Conrad. The "About" page of Ms. Conrad's website identifies her as the creator and source of the products. Therefore, the commercial impression conveyed by this mark is one that associates the products with a particular living individual and gives the impression that the goods emanate from that designer. See Printout from the Kendall Conrad Design website's "About" page at www.kendallconraddesign.com/pages/about.

- e. KENDALL & JAMES (Reg. No. 5009646) in Class 14 for jewelry and (Reg. No. 5246722) in Class 25 for clothing

KENDALL & JAMES for jewelry and clothing conveys an image of two individuals coming together to collaborate on a jewelry and clothing line and that these individuals are the designers of the goods. Arguably, this impression is different than the impression conveyed by beauty care products sold by Kendall Jenner under the mark KENDALL. These different commercial impressions when applied to the parties' respective goods are sufficient to avoid confusion.

- f. KENDAL & HYDE (Reg. No. 5104354) in Class 18 for bags and

wallets

KENDAL & HYDE for bags and wallets again conveys the impression that two designers collaborated to create the bags and small leather goods, just like designers Peter Dooney and Frederic Bourke created the well-known handbag collection under the mark DOONEY & BOURKE. Thus, the commercial impression of two individual designers is different than that conveyed by beauty care products sold by Kendall Jenner under the mark KENDALL and is sufficient to avoid confusion.

g. KENDALL MILES (Reg. No. 5257054) in Class 25 for footwear

Similarly, KENDALL MILES identifies a luxury shoe designer named Kendall Reynolds. Consumers encountering this mark are likely to believe that Kendall Miles is the name of the designer of the shoes and they will not likely confuse the hair and body care products sold by Kendall Jenner.

h. KENDALL-JACKSON (Reg. No. 4603318) in Class 3 for soap

As noted above, KENDALL-JACKSON is owned by the famous wine-maker of the same name. Thus, the commercial impression conveyed by this mark will be one associated with a winery and not a fashion model and world famous celebrity.

i. KENDAL BOOTGLOW (Reg. No. 3446761) in Class 25 for clothing

KENDALL BOOTGLOW is a fictional character in the children's show "The Fo-Fo Figgly Show." Thus, clothing sold under this mark is likely to be viewed as a secondary source for the show and is not likely to be perceived as being associated with the goods sold under Ms. Jenner's KENDALL mark.

j. KENDALL HARTCRAFT (Reg. No. 2532004) in Class 20 for picture frames

The term "Hartcraft" as used in the mark KENDALL HARTCRAFT gives the impression that the creator of the goods is a person by this name. In addition, the incorporation of the word "CRAFT" into this mark conveys the mental impression of crafty items. When used for picture frames, the mental impression conveyed by this mark is very different from the one conveyed by the mark KENDALL for body and hair care products.

k. KENDAL (Reg. No. 5593994) in Class 10 for microdermabrasion apparatus and foot massagers, (Reg. No. 5219431) in Class 20 for massage chairs and related furniture items, and (Reg. No. 5041395) in Class 14 for jewelry

Although Applicant's Mark is most similar to these registrations in sight and sound, the use of identical terms in common does not mean two marks are similar. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987). As established above, if the marks convey significantly different meanings and as a result evoke a different commercial impression, despite

the marks being identical, there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ.2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes.); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing.).

Here, the marks are significantly different, KENDALL is a household name for the world famous model and member of the Kardashian/Jenner family, Kendall Jenner. On the other hand, the word “KENDAL,” as used in this mark, makes no reference to a specific individual and even less so when applied to the registrant’s foot massagers and other electronic goods. Therefore, there is no likelihood of confusion between Applicant’s Mark and these registrations and the Examiner should allow the Applicant’s Mark to proceed to publication.

In short, the commercial impression conveyed by Applicant’s Mark is different from that conveyed by each of the Cited Marks. Furthermore, when considering the way in which the goods provided under Applicant’s Mark will be marketed to relevant purchasers will create an immediate association with Kendall Jenner, which will immediately eliminate any potential for confusion. Accordingly, Applicant respectively submits that the distinct overall commercial impression conveyed by Applicant’s Mark is distinguishable from each of the Cited Marks such that there is no likelihood of confusion.

B. There is no Likelihood of Confusion Because the Marks are Used in Connection with Dissimilar Goods.

In a likelihood of confusion analysis, the goods and services identified by the marks must be compared to determine if they are related or if the marketing activities associated with each are such that consumers are likely to be confused as to their origin. *In re August Storck KG*, 218 U.S.P.Q. 823 (TTAB 1983); *In re Int’l Telephone and Telegraph Corp.*, 197 U.S.P.Q. 910 (TTAB 1978); *Guardian products Co. v. Scott Paper Co.*, 200 U.S.P.Q. 738 (TTAB 1978). Moreover, if the marks at issue are similar, the commercial relationship between the goods or services of the respective parties must be considered to fully determine whether or not there is a likelihood of consumer confusion. *In re Concordia Int’l Forwarding Corp.*, 222 U.S.P.Q. 355 (TTAB 1983). Courts have held that even when two types of goods and/or services fall within the same general field it does not mean they are sufficiently similar to create a likelihood of confusion. *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997). In *Harlem Wizards*, the court considered two very similar marks, each used in conjunction with a basketball team, and held that confusion between the two marks was unlikely. *Id.* In coming to this conclusion, the court reasoned that the plaintiff’s theatrical brand of “show basketball” was markedly different from the competitive basketball played by the defendant in the NBA and “when every aspect of the two teams is compared, there is a glaring dissimilarity. Any similarity between the teams is superficial and the result of creating over-inclusive categories that are irrelevant to the likelihood of confusion.” *Id.* (emphasis added).

Furthermore, with regard to likelihood of confusion there is no per se rule that certain goods and/or services are related. TMEP § 1207(a)(iv) (citing *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854, 855-56 (TTAB 1984)). Instead, the facts of each case must be considered in light of the

varying circumstances and the commercial impressions conveyed by each mark. *See British Bulldog*, 224 U.S.P.Q. at 856. “The issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.” *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (TTAB 1992); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029, 1034 (S.D.N.Y. 1990) (“while [both parties] furnish products related to the broad field of finance, [they] are completely unrelated as night and day.”).

Here, the goods at issue are not confusingly similar, particularly when the Examiner considers the differences between the marks in sight, sound and meaning. Furthermore, all but one of the Cited Marks are registered in connection with goods that are very different from those provided under Applicant’s Mark. The categories are largely clothing and apparel items in Class 25 (Reg. Nos. 5246722, 4929216, 5694825, 5593632, 5257054, 3446761), jewelry and watches in Class 14 (Reg. Nos. 5041395, 5009646, 4567076, 5018352), handbags and wallets in Class 18 (Reg. Nos. 4412170, 5104354), picture frames and furniture in Class 20 (Reg. Nos. 5219431, 2532004) and foot massagers and microdermabrasion apparatus in Class 10 (Reg. No. 5593994). Indeed, the only Cited Mark registered in Class 3 is KENDALL-JACKSON for soap (Reg. No. 4603318). However, as noted above, soap sold by the well-known winemaker is not likely to be confused with the personal care products sold under the mark KENDALL and marketed in connection with Kendall Jenner.

In support of the Examiner’s position that Applicant’s goods are related to the goods sold under the Cited Marks, the Examiner attached printouts from various retailers showing that single retailers sell fragrances, cosmetics and body care products and the merchandise sold under the Cited Marks (i.e., clothing, handbags, accessories, picture frames, etc.). However, Applicant argues that this evidence should only hold minimal weight. Stores like Target and Walmart sell every type of product imaginable and those stores sell many similar unrelated brands in each of the relevant categories. Therefore, Applicant submits that consumers have become accustomed to encountering all kinds of products sold under similar name brands in one retail location and are able to distinguish between them.

Accordingly, Applicant respectfully submits that the differences between Applicant’s goods and the goods offered under the Cited Marks are sufficient to avoid consumer confusion.

C. Applicant Employs Different Methods of Marketing and Targets a Different Customer Base from Certain of the Cited Marks.

Applicant respectfully submits that the methods of marketing and channels of distribution employed by Applicant differ from those utilized by certain of the Cited Marks, thus tending to eliminate customer confusion. Methods of marketing and channels of distribution are factors to be considered in determining likelihood of confusion. *See du Pont*, 177 U.S.P.Q. 563. “[I]f the goods of one party are sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is less than if both parties sold their goods through the same channels of distribution.” *See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* sec. 24:51 (2013). Additionally, courts have frequently found no likelihood of confusion when one mark user sells exclusively at retail and the other sells exclusively to commercial buyers. *See*

id. (citing *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959); *David Crystal, Inc. v. Soo Valley Co.*, 471 F.2d 1245 (C.C.P.A 1973); *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440 (9th Cir. 1980)).

Furthermore, even when related goods or services are distributed in differing marketing channels, the courts have often found no likelihood of confusion. *See Paul Sachs Originals v. Sachs*, 325 F.2d 212 (9th Cir. 1963) (finding no likelihood of customer confusion when girl's dresses and women's dresses sold to different customers in different stores); *Field Enterprises Educ. Corp. v. Cove Industries, Inc.*, 297 F. Supp. 989 (E.D.N.Y. 1969) (finding different channels of encyclopedia distribution door to door sales versus department store sales). In *Este Lauder Inc. v. Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997), the court distinguished marketing channels by the characteristics of the customers and the location of the sales. Plaintiff sold its personal care products only through prestigious retail stores while the defendant sold to a younger group of buyers through its own "Gap Old Navy" stores. The court found that while the customers could overlap, the differences in locations and the target markets were sufficient to prevent the likelihood of confusion. *See id.* Additionally, in determining the dissimilarity of trade channels, the Sixth Circuit considers "how and to whom the respective goods or services of the parties are sold. Where the parties have different customers and market their goods or services in different ways, the likelihood of confusion decreases." *Therma-Scan, Inc. v. Thermoscan, Inc.*, 63 U.S.P.Q.2d 1659, 1666 (6th Cir. 2002) (internal citation omitted). In that decision, the court held that the focus should be on the targeted consumers and marketing methods employed rather than rely solely on the fact that both THERMA-SCAN and THERMOSCAN enjoyed an Internet presence.

In this case, contemporaneous use of Applicant's Mark is not likely to cause confusion with the Cited Marks discussed below based on the differences between the marketing channels and target customer base for each mark. In particular, Applicant respectfully submits that the goods provided under Applicant's Mark will target fans of Kendall Jenner who are interested in fashion and cosmetics and beauty products sold by the Kardashian/Jenner family. Further, Applicant intends to sell the fragrances and hair and body care products under the mark KENDALL on Applicant's website and in connection with Kendall Jenner.

In contrast, several of the Cited Marks have different marketing channels and target a different class of purchaser which tends to eliminate confusion.

- a. Cited Marks for KENDAL (Reg. No. 5593994) in Class 10 for microdermabrasion apparatus and foot massagers, (Reg. No. 5219431) in Class 20 for massage chairs and related furniture items, and (Reg. No. 5041395) in Class 14 for jewelry

These marks are owned by New Shining Image, LLC in New York. The company website, located at www.newshiningimage.com, indicates that the company sells a large array of mechanical beauty products, including the foot massagers, microdermabrasion apparatus and furniture related to massage. Therefore, the marketing channels utilized by this company are likely to be specialty catalogues and websites and the target purchaser is likely to be a massage parlor or individual masseuse needing specialty equipment.

On the other hand, the target purchaser of Applicant's goods are fans of Kendall Jenner that follow the model's fashion and beauty tips and trends. To illustrate, Kendall Jenner has over 100 million followers on her Instagram page alone and this is likely to be the primary source of marketing for Ms. Jenner's beauty and personal care products. *See* Printout of Ms. Jenner's Instagram page. Therefore, although it is possible that there could be some overlap in the target customer base, the relevant purchaser of Applicant's products branded under the KENDALL mark are likely to know the goods are associated with Kendall Jenner and not a massage supply company in New York.

- b. KENDALL & JAMES (Reg. No. 5009646) in Class 14 for jewelry and (Reg. No. 5246722) in Class 25 for clothing

The owner of these two registrations is World Tour Enterprises, Ltd. An online search indicates that the only avenue for purchasing the KENDALL & JAMES products appears to be through Poshmark. *See* <https://poshmark.com/brand/kendall%20&%20James>. Poshmark is an online shopping platform generally known for second hand goods. Most often, sellers list used clothing, shoes, and accessories. While you could buy fragrances and lotions on Poshmark, customers generally do not visit poshmark.com looking for second hand fragrances and personal care products. Therefore, the different marketing channels and class of purchaser, coupled with the differences in the marks and the differences in the goods, obviates any potential confusion between Applicant's Mark and the cited marks for KENDALL & JAMES.

- c. KENDALL CONRAD (Reg. No. 4929216) in Class 25 for footwear, (Reg. No. 4567076) in Class 14 for jewelry, and (Reg. No. 4412170) in Class 18 for bags and wallets; KENDALL MILES (Reg. No. 5257054) in Class 25 for footwear

As noted above, KENDALL CONRAD is an accessories brand owned by designer, Kendall Conrad. The goods sold under the mark are available for purchase on Ms. Conrad's website, www.kendallconraddesign.com. Therefore, consumers are likely to visit this website intentionally looking to purchase KENDALL CONRAD-branded items and are not likely to be confused as to the source of the products sold under the mark KENDALL, by Kendall Jenner.

- d. L KENDALL (and design) (Reg. No. 5018352) in Class 14 for jewelry and watches

The watches sold under the mark L. KENDALL (and design) are made in small quantities and are only available for purchase in the United States in a small brick and mortar jeweler called Genon's of Newport in Newport, Rhode Island. *See* Printout from A Blog to Watch. Thus, consumers looking to purchase an L. KENDALL watch are likely to seek out the retail store where they can buy this particular brand of watch and are unlikely to mistakenly believe that perfume and body care products sold under the KENDALL mark are sold by the same seller of the L. KENDALL watches.

- e. KENDALL-JACKSON (Reg. No. 4603318) in Class 3 for soap

As mentioned above, Kendall-Jackson owns and operates a winery in Sonoma County, California. *See* Printout from "Visit Us" page of registrant's website at www.kj.com/visit. Though

the website lists several wines for sale and includes a gift shopping page, there is no listing to purchase KENDALL-JACKSON-branded soap on the website. Presumably, small items like soap are only available for purchase in the brick and mortar gift shop at the winery. Therefore, customers encountering the products sold under the KENDALL-JACKSON mark are most likely physically present at the winery and know the source of the goods they are buying. Since Kendall-Jackson's soaps are likely only available at the winery itself, and Applicant's fragrances and body care products will likely be sold on the internet and in specialty cosmetics retail stores, Applicant contends that confusion between the marks is not likely.

Applicant respectfully submits that one considers the visual and phonetic differences in the marks, the different classes of goods and differing commercial impressions conveyed by each mark, and the divergent channels of distribution and target customers as to certain marks, consumer confusion between Applicant's Mark and the Cited Marks is unlikely. Accordingly, Applicant respectfully requests that the Examiner withdraw the Section 2(d) refusal and approve Applicant's Mark for publication.

II. THE PRIOR PENDING APPLICATION NOTED BY THE EXAMINER HAS BEEN ABANDONED.

In the Office Action, the Examiner also raised a potential issue with a prior-filed application for the mark KENDALL THE MASTER STYLIST (U.S. Ser. No. 99309211) in International Class 3. However, a review of the USPTO database confirms that this application was abandoned on November 4, 2019. Therefore, Applicant submits that this application no longer presents any issue as to registration of Applicant's Mark.

III. REQUIREMENT TO SUBMIT ACCEPTABLE WRITTEN CONSENT.

The Examiner has also required Applicant to submit an acceptable written consent signed by named individual, Kendall Jenner, in the following format: "I, Kendall Jenner, consent to the use and registration of my name, Kendall, as a trademark and/or service mark with the USPTO." Per the Examiner's request, Applicant submits the attached written consent signed by Kendall Jenner.

IV. CONCLUSION.

Based on the foregoing, Applicant believes the objections and issues raised by the Examiner have been resolved. More specifically, Applicant submits that when considering the most relevant DuPont factors, the differences between Applicant's Mark and each of the Cited marks are sufficient to avoid confusion. Therefore, Applicant respectfully requests that the refusal be withdrawn and that the Examiner approve Applicant's Mark for publication.