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January 18, 2020

VIA ELECTRONICALLY (TEAS)

Commissioner For Trademarks
U.S. Patent and Trademark Office
Examining Attorney Faith Beaudry-Torres
Law Office 126

RE: Response to Office Action Filing Date: July 18, 2019
Serial No. 88413746
Mark: *FAITHWORKS*
Applicant: CBC Group, Inc.

Dear Ms. Beaudry-Torres:

This letter is in response to your Office Action Letter (“Action Letter”) with a mailing date of July 18, 2019.

Pursuant to this letter, and as requested by your Action Letter, the Applicant hereby responds as follows:

1. Likelihood of Confusion:

a. Registered Marks. Applicant respectfully disagrees with the conclusion of the Examining Attorney that the proposed Mark is likely to cause confusion with the marks in U.S. Registration No. 3042658 (FAITHWORKS DESIGNS) and U.S. Registration No. 5187535 (FAITHWORKS APPAREL). The test for likelihood of confusion is probable confusion and not just the mere possibility of confusion. See American Steel Foundries v. Robertson, 269 U.S. 372, 46 S.Ct. 160, 70 L.Ed. 317 (1926).

As Examining Attorney is aware, *In re E.I. duPont v. Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) set forth thirteen non-exclusive factors relevant to a determination of likelihood of confusion. The DuPont factors include: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;

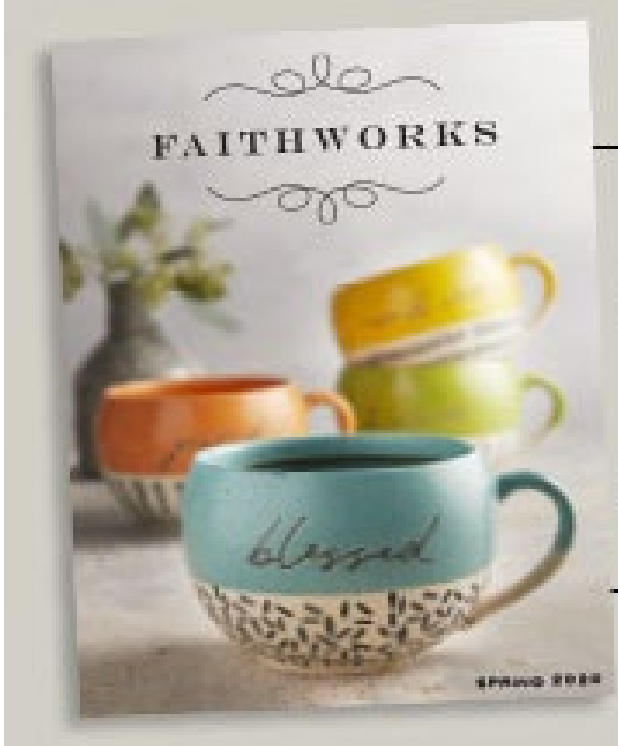
(9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether de minimis or substantial; and (13) any other established fact probative of the effect of use. *DuPont*, 476 F.2d at 1361.

“Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed.Cir.2010). The proper test is not a side-by-side comparison of the marks, but instead "whether the marks are sufficiently similar in terms of their commercial impression" such that persons who encounter the marks would be likely to assume a connection between the parties. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (citing *Leading Jewelers Guild*, 82 U.S.P.Q.2d at 1905.) In this fact-specific inquiry, if the parties' goods are closely related, a lesser degree of similarity between the marks may be sufficient to give rise to a likelihood of confusion. *Id.* citing *In re Inca Textiles, LLC*, 344 Fed. Appx. 603, 606 (Fed. Cir. 2009). Even where the marks at issue are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity. *Id.* citing *Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1820-21 (T.T.A.B. 2005) (finding that BLUE MAN GROUP "has the connotation of the appearance of the performers" and that applicant's BLUEMAN mark "has no such connotation for cigarettes or tobacco. Thus, the marks differ in their connotations and commercial impressions"). A comparison of the marks in view of the relevant *duPont* factors and applicable caselaw shows that neither confusion nor mistake is likely.

Looking at the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, the overall appearance of the mark. Applicant's mark is “FAITHWORK” and while the 2 registered marks, Registration No. 3042658 (FAITHWORKS DESIGNS) and Registration No. 5187535 (FAITHWORKS APPAREL) contain “FAITHWORKS” it is clear from the peaceful coexistence of current registered marks that the additional wording, despite the disclaimer of the word **apart from the mark as shown**, is important for the consumers overall impression of the marks.

More importantly, however, looking at the nature of the goods or services between the marks, the trade channels and the purchasers involved, Applicant's mark will not be confusingly similar to the marks in Registration No. 3042658 (FAITHWORKS DESIGNS) and Registration No. 5187535 (FAITHWORKS APPAREL). While Examining Attorney provides internet evidence of various large retailers that sell similar items to show the goods are marketed to the same consumers and channels, Applicant's goods are not marketed to the same class of purchasers or through the same marketing channels. Applicant's goods are typically marketed through independent sellers and at trade shows. Orders are then submitted on Applicant's website by the independent sellers, telephone or facsimile. The general public cannot simply order from Applicant's website like the retail websites submitted as evidence by Examining Attorney. The goods sold under Registration No. 5187535 (FAITHWORKS APPAREL) are men's and women's t-shirts, sweatshirts and hoodies containing religious messages or images. The t-shirts, sweatshirts and hoodies can be ordered by the consumer directly from the faithworks apparel website (www.faithworksapparel.com) website.

Applicant's Mark



Registration No. 5187535
FAITHWORKS APPAREL



FaithWorks
Apparel

Registration No. 3042658
FAITHWORKS DESIGNS



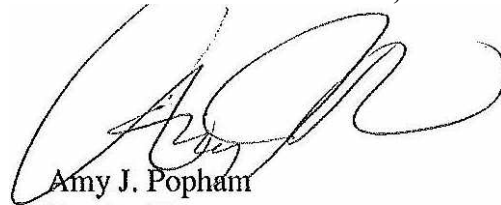
Lastly, Applicant first started using the mark "FAITHWORKS" in commerce in January 2005, ten years prior to the use of the registered mark FAITHWORKS APPAREL at Registration No. 5187535 and months prior to the use of the registered mark FAITHWORKS DESIGNS at Registration No. 3042658. The applied for mark and the current registered marks have existed peacefully for several years with no evidence of actual confusion.

The differences in the marks in appearance, product, marketing channels and targeted purchasers are substantial as to create completely different overall impressions, thus leading to the conclusion that confusion is not likely. "The similarities and dissimilarities between the two marks must be considered, for likelihood of confusion depends on the overall impression of the marks." *In re Electrolyte Laboratories, Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). The overall impression of the marks are so different from one another as to avoid a likelihood of confusion. The differences along with the Prior Registration are evidence that the registered mark and the applied for mark are not confusingly similar.

If, after reviewing this response to your Action Letter, you have additional questions or comments, please contact the undersigned at (623) 444-9791.

Sincerely,

POPHAM LAW GROUP, P.L.C.

A handwritten signature in black ink, appearing to read 'AJP', is written over the typed name of Amy J. Popham.

Amy J. Popham
For the Firm

AJP