

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : One Blue Dot LLC)
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 Serial No. : 88/414,145)
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 Filed : May 3, 2019)
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 Mark : BLUEDOT (stylized whale logo design))
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 Examining)
 Attorney : Oreoluwa Alao)
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 Law Office : 108)
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RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

Dear Oreoluwa Alao:

Applicant One Blue Dot LLC (“Applicant”) respectfully files this Response to Office Action in response to the Office Action mailed on July 23, 2019, with respect to U.S. Trademark Application Serial No. 88/414,145 (the “Application”) for the design mark BLUEDOT (“Applicant’s whale logo design mark”). Applicant has separately herewith amended the description of goods to better comport with suggested language offered by the Examining Attorney in the Office Action.

I. APPLICANT’S MARK WHEN USED IN CONNECTION WITH APPLICANT’S GOODS AND SERVICES IS NOT LIKELY TO BE CONFUSED WITH THE CITED MARKS

In the Office Action, the Examining Attorney refuses registration of Applicant’s mark in connection with Applicant’s Class 11 and 40 water filter goods and water filtration services, on the basis, *inter alia*, of a perceived likelihood of confusion under Trademark Act Section 2(d) (15 U.S.C. § 1052), in the belief that Applicant’s mark, when used in connection with Applicant’s goods and services, may be confused with U.S. Registration Nos. 4065822 and

4684543 for the Blue Dot. “globe” design mark owned by American Residential Services LLC (“Registrant’s globe marks”) for Class 37 “installation, maintenance and repair of air conditioning, heating, cooling and ventilation systems, equipment, and appliances, and the components and parts of such systems, equipment and appliances; plumbing services; and electrical contracting services” and related Class 42 services (“Energy auditing; Consulting services in the field of the design of energy-efficient heating cooling, and ventilation systems for others”).

Applicant respectfully contends that for the reasons presented and discussed below, Applicant’s whale logo mark, when used in connection with Applicant’s goods and services in actual commerce, is actually unlikely to cause confusion with the Registrant’s “globe” Blue Dot. marks in connection with their various air, heating, cooling home environment regulation-type services.

A. Legal Standard for Determining Likelihood of Confusion

The factors set forth in *In Re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973) are to be considered in determining whether there is a likelihood of confusion between marks. It is to be noted that likelihood of confusion requires that confusion be foreseeable and *probable*, not merely possible. *See, e.g., HMH Publishing Co. v. Brincat*, 183 U.S.P.Q. 141, 144 (9th Cir. 1974); *Fleishmann Distilling Corp. v. Maier Brewing Co.*, 136 U.S.P.Q. 508, 518 (9th Cir. 1963); *J.B. Williams Co. v. Le Conte Cosmetics, Inc.*, 186 U.S.P.Q. 317, 319 (9th Cir. 1975).

While it is true that some factors may play a dominant role depending upon the case, there is “no warrant, in the statute or elsewhere, for discarding *any* evidence bearing on the question of likelihood of confusion.” *See DuPont*, at 1362 (emphasis in original). As such, there is a duty for the Examining Attorney to carefully consider and weigh all the pertinent evidence. *Id.*

In this case, Applicant maintains that when all of the relevant *DuPont* factors are considered, the balance of the factors weighs in favor of a finding of no likelihood of confusion between Applicant’s mark and Registrant’s globe marks.

B. The Relevant *DuPont* Factors Weigh in Favor of Finding of No Likelihood of Confusion

1. The Nature of the Marks Is Not Identical nor Confusingly Similar

Applicant acknowledges that Applicant’s stylized whale logo “bluedot” mark and the Registrant’s globe “Blue D()t.” design marks are similar, at least in the literal elements thereof, even as the logo design elements of the two marks are quite distinct, in that Applicant’s mark primarily focuses on the graphic stylized whale logo design as the central component of the mark, while Registrant’s marks feature a stylized globe with meridian and parallel lines substituting for a proper letter “o”, such that the literal element is not as readily readable as “Dot” in Registrant’s marks. While the graphic aspects of these marks are already radically divergent from each other and what they might symbolize or allude to, note that courts have consistently held that *even identical marks* may not be confusingly similar, when used in connection with different goods or services, *even when the goods are related*. See, e.g., *Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc.*, 405 F. Supp. 2d 680, 689 (E.D. Va. 2005), *aff’d*, 227 F. App’x 239 (4th Cir. 2007) (where the court found that use of the mark, RENAISSANCE on gift bags was “not likely to cause confusion among consumers” of greeting cards using the mark RENAISSANCE GREETING CARDS); *WE Media, Inc. v. Cablevision Sys. Corp.*, 94 F. App’x 29, 33 (2d Cir. 2004) (finding no likelihood of confusion between television channel’s “WE: Women’s Entertainment” mark and media company’s “WE” mark); *In re Hair Masters Servs., Inc.*, 907 F.2d 157 (Fed. Cir. 1990) (reversing the TTAB’s refusal of registration of the mark, “Hair Masters,” as opposed to the senior mark, “Hairmaster”).

In this case, Applicant’s Class 11 goods and Class 40 services relate particularly to drinking water filters and filtration services. In contrast, the cited Registrant’s services relate substantially to air, heating and cooling “home environment regulation” type Class 37 and Class 42 services.

Applicant submits that, when combined with consideration of the other factors to be discussed below in this Response, Applicant’s whale logo bluedot mark and Applicant’s water filter and filtration goods and services, and the cited Registrant’s home environment regulation services, as identified by Registrant’s Blue Dot. “globe” marks, are not marks nor the types of services that one would be particularly likely to encounter together, nor are they identical, nor compellingly similar enough as to lead to a reasonable probability of a likelihood of consumer confusion in actual practice.

2. Sophistication of the Consumers

The condition of purchase and the sophistication of the purchasers is a *DuPont* factor that is highly material in this case. The Federal Circuit has made clear that purchaser “sophistication is important and often dispositive because ‘[s]ophisticated consumers may be expected to exercise greater care.’” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489, 212 USPQ 246, 252 (1st Cir. 1981)).

Even, *assuming arguendo*, that one might consider drinking water filtration and home regulation services (*e.g.*, plumbing – which actually deals more with waste removal, rather than drinking water purification), one should still examine whether the actual target consumers would likely consider these services, with these marks, to be emanating from the same source. In this case, Applicant’s goods and services are targeted primarily to individuals and families seeking purified drinking water for consumption, while Registrant’s services are targeted primarily to homeowners trying to ensure that their home environment is regulating properly. These target groups consumers are thus seeking different sources to pursue divergent objectives; as such, it is readily evident that the different groups of consumers will likely expect these diverging needs to be taken care of by different sources/service providers, even if the literal elements of their trademarks are similar (*e.g.*, Cisco, Sysco and Crisco may all relate to the home or business, but one would imagine it hard to confuse these sources and their respective goods and services, even without considering further the added factor of radically different graphic elements incorporated into such marks).

While Applicant recognizes that discerning consumers are not and cannot be wholly immune from source confusion, nevertheless, when this factor is taken into account along with the other *DuPont* factors that are discussed herein, Applicant maintains that these target groups of consumers, especially in as distinct and separate as the groups targeted by Applicant’s and by Registrant’s marks are, respectively, they *would not* associate Applicant’s water filters and filtration services under Applicant’s whale logo mark as being affiliated in any likely way with the Registrant’s home environment regulation services as identified by Registrant’s Blue Dot. “globe” graphic logo marks, nor would there be any confusion as to the source of either party’s services.

Even if Applicant’s whale logo bluedot goods and services, and the Registrant’s Blue Dot. “globe” services, were somehow to be offered simultaneously within the same commercial

environment (for example, at a trade show), each party's marks would be readily recognized by even casual observers or consumers as being different when compared side-by-side to each other and, again, because of the small but saliently different nature of the marks, assumed to be unaffiliated with each other. In truth, consumers who might happen to encounter each party's marks and services in the same environment would be more likely to express curiosity as to why the services might be situated or presented together, rather than to experience any confusion as to whether the services themselves originated from different sources.

Accordingly, Applicant's mark and services and the Registrant's marks and services, by the very nature of the marks and services themselves, the sources and the purposes for which such services are employed, and the clients/customers to whom such services are marketed, flow through dissimilar marketing efforts and outlets. Any overlap between the parties' marks and services, if any, in fact, is likely, is likely to be *de minimis*. Moreover, when combined with the other factors discussed in this Response, Applicant maintains that there would be no appreciable likelihood of confusion between the services of the respective marks.

3. The Market Interface between Applicant's Mark and the Registrant's Marks

This is another *DuPont* factor relevant to the Examining Attorney's overall analysis of likelihood of confusion. As touched upon previously, the Registrant's business involves specialty sales involving home environment regulation (air, heating, cooling) services and design to homeowners. In contrast, Applicant's business involves selling water purification filters and filtration services essentially to any consumer clientele interested in improved water quality and are available through more general commercial outlets. As such, Applicant and Registrant do not typically or substantially directly compete or intersect with each other, and, as described above, the customers which seek out Applicant and those who seek out the Registrant are likely doing so under different conditions in pursuit of different objectives. As such, there is likely to be little (if any is at all is indeed possible) significant market interface between Applicant's and the Registrant's groups with respect to their respective marks. This factor, along with the other factors discussed in this Response, supports a conclusion that there is no likelihood of confusion between the Applicant's mark and the cited Registrant's marks.

4. The Fame of the Registrant's "Blue Dot. Globe" Logo Design Mark

Applicant is unaware of any contemporary evidence to suggest that the Registrant's Blue Dot. "globe" marks are currently "famous" or particularly well-known within the United States generally, or in the home environment regulation services market particularly. As the cited marks

are not especially salient, trendy, or famous, this finding conveys the sense that a current consumer, of any appreciable level of sophistication in the relevant market, would be unlikely to confuse Applicant's whale logo mark with the Registrant's Blue Dot. "globe" marks.

5. The Variety of Goods for which the Registrant's Mark Is or Is Not Used

This is another *DuPont* factor that is relevant to the Examining Attorney's overall analysis of likelihood of confusion. To Applicant's knowledge, the Blue Dot. "globe" logo design marks registered in connection with the Registrant's services are *not* a "house mark" or one of a "family" of marks. Therefore, the Registrant's marks draw no strength from being a member of a "family" of marks. This factor, along with the other factors discussed in this Response, further supports the proper conclusion that there is no likelihood of confusion between Applicant's mark and the Registrant's marks.

6. Any Other Established Fact Probative of the Effect of Use

Another *DuPont* factor relevant to the Examining Attorney's overall analysis of likelihood of confusion is the consideration of any other established fact probative of the effect of use.

In this case, Applicant further wishes to point out that the cited Registrant's marks have been existing in the marketplace for a period of time now, and now coexist with Applicant's mark, and yet Applicant is completely unaware of any instances whatsoever of actual consumer confusion (or even consumer comparison) between the two marks or sources.

While certainly not dispositive, nor even necessarily persuasive taken alone, this factor, when considered along with the multiple other factors discussed in this Response, supports the conclusion that there is no likelihood of confusion between the Applicant's whale logo mark and the cited Blue Dot. "globe" logo marks of Registrant.

7. The Extent of Potential Confusion is *De Minimis*

The extent of potential confusion is one of the key *DuPont* factors and therefore deserves to be given due consideration and weight. Given the broad array of evidence provided thus far showing little likelihood or risk of confusion: the distinguishable marks at issue; the different specialty markets for purchase by sophisticated and diverging consumer groups; the overall lack of substantial market interface between Applicant's and the Registrant's groups with respect to their respective services; the fame (or absence thereof) on the part of Registrant's marks; and, additionally, the fact that the respective marks now appear to coexist in the marketplace without evidence of consumer confusion (or even comparison), Applicant maintains that there is no

likely probability of real confusion between the services and the sources thereof between the parties, and that the extent of potential confusion is, at most, *de minimis*.

C. On Balance, the Relevant *DuPont* Factors Favor a Finding of No Likelihood of Confusion

In sum, the consideration of all relevant *DuPont* factors weighs strongly in favor of a finding that Applicant's mark is not likely to be confused with the Registrant's marks by the relevant public, if encountered in the marketplace by the proper target demographic clients and consumers. While Applicant's mark and the Registrant's marks certainly *do* share an overt resemblance, at least with regard to the literal elements of the respective marks, yet, when properly considering and weighing the following factors: the salient distinction between the marks at issue (that would be readily appreciable by the target consumer groups); the distinct specialized markets for consumption and purchase by the relevant consumers, coupled with the apparent lack of any substantial market interface or overlap between Applicant's and the Registrant's groups with regard to their respective services; the fame (or lack thereof) on the part of the cited Registrant marks; the lack of any evidence that the cited mark is used on a large and especially wide variety of services; and the fact that the respective marks already coexist in the marketplace, yet there is no evidence of instances of consumer confusion (or even explicit consumer comparison between them); one will reach the ready conclusion that there is no likelihood that ordinary consumers of the respective services will believe or are likely to believe that Applicant's service offerings marked by Applicant's mark emanate from the same source as Registrant's service offerings marketed and provided under the cited Registrant's marks.

II. CONCLUSION

In view of the above arguments and observations, Applicant respectfully submits that there is no potential likelihood of confusion between Applicant's mark and the Registrant's marks. As Applicant believes that this issue has been adequately addressed, explored, and obviated, Applicant now respectfully asks the Examining Attorney to reconsider and withdraw the present refusal to register and grant a prompt allowance of the applied-for stylized whale bluedot logo design mark.

Should the Examining Attorney have any remaining concerns about this mark and this application, Applicant asks that the Examining Attorney contact Applicant at the Examining Attorney's earliest convenience, so to work together to allay the Examining Attorney's concerns and (hopefully) successfully bring this mark to registration.