
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Toast (Mail Order) Limited

Application No.: 88421193

Filing Date: May 8, 2019

Mark: TOAST

Class: 25

Examining Attorney: Laura Gorman Kovalsky

Law Office: 110

APPLICANT’S RESPONSE TO OFFICE ACTION

Pursuant to 37 C.F.R. §2.62(a) and TMEP § 711, Applicant Toast (Mail Order) Limited (“Applicant”), by and through its attorneys, respectfully submits this Response to Office Action (the “Response”) regarding Application Serial No. 88421193 (the “Application”) for the mark (“Applicant’s Mark”). Applicant is responding to the Office Action dated July 23, 2019 (the “Office Action”). Applicant responds to each of the issues identified in the Office Action as follows:

I. **No Likelihood of Confusion Exists between Applicant’s Mark and the Cited Marks**

The Examining Attorney refused registration of Applicant’s Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), claiming that it could likely be confused with the following marks (the “Cited Marks”)

Mark	Registration/ Application No.	Owner
TOAST 2 COST	5361583	Thomas Clanton III and Gilbert Ryan (individuals)

TOAST INDUSTRIES	5052805	David Scott Schindehette
TOAST AND JAMMIES	4348900	Creative Apparel Concepts, Inc.
TOAST. CHILL. REPEAT.	87825075	CMG Partners, Inc.

Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register based on the arguments below.

The standard for determining whether two marks are likely to be confused is set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01. The *DuPont* case establishes several factors to be considered in the analysis of whether two marks are likely to be confused under Trademark Act Section 2(d). Each factor may play a more dominant or diminished role, depending on the facts of each case. *DuPont*, 177 USPQ at 567. No single factor is dispositive. *Id.* The Examining Attorney need not consider all factors but may consider those factors that are most relevant to the case at hand. *See In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985).

The most relevant *DuPont* factors in this case are (1) the dissimilarities of the appearance, sound, and commercial impression between Applicant's Mark and the Cited Marks and (2) the peaceful coexistence between the four Cited Marks, showing consumers are not confused by the coexistence between these marks.

Under the Trademark Act, a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods be likely, not just possible. As the Second Circuit has stated, "likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible.'" *Estee Lauder, Inc. v. Gap, Inc.*, 42 USPQ2d 1228, 1232 (2nd Cir. 1997) (internal quotations omitted) *quoting* 3 J. McCarthy, *Trademarks and Unfair Competition*, § 23:2 (1996) (now at 4 *McCarthy on Trademarks and Unfair Competition* § 23:3 (5th ed. 2017)). When the relevant *DuPont* factors are considered in relation to Applicant's Mark, each factor weighs in favor of allowing Applicant's Mark to register.


A. The Notable Differences in Appearance, Sound, Meaning and Commercial Impression of the Marks Precludes Likelihood of Confusion.

When Applicant's Mark and the Cited Marks are viewed in their entirety, as they must be, the differences are sufficient to avoid a likelihood of confusion. The similarity between the respective marks in their entirety as to appearance, sound, connotation and overall commercial

impression are primary factors to consider in a *DuPont* analysis. 177 USPQ at 567. It is well settled that in assessing likelihood of confusion, marks may not be dissected, nor any element of a mark ignored. TMEP 1207.01(b); *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Since marks tend to be perceived in their entirety, similarities between marks are based upon the overall impression of the marks. *Opryland USA, Inc. v. Great American Music Show Inc.*, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) (“When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared.”).

i. Applicant’s Mark and the Cited Marks Differ in Appearance.

Similarity in appearance is a factor in determining whether there is a likelihood of confusion between marks. TMEP § 1207.01(b)(ii). The mere fact that marks share certain elements does not compel a finding that confusion is likely. *Gen. Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442, 1445 (8th Cir. 1987) and cases cited; *see also Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc. et. al.*, 4 USPQ2d 1942 (6th Cir. 1987). In considering the marks for purposes of a likelihood of confusion analysis no feature of the mark is ignored, and all components thereof must be given appropriate weight. *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1241 (Fed. Cir. 1990) *citing Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272 (CCPA 1974); *Opryland*, 23 USPQ at 1474.

The appearance of Applicant’s Mark is distinct when compared to the Cited Marks. Each Cited Mark contains a unique element, differentiating it from Applicant’s Mark. Specifically, the Cited Marks contain the following terms which are absent from Applicant’s Mark: 2 COAST; INDUSTRIES; & JAMMIES; and CHILL. REPEAT. Moreover, none of the Cited Marks claim any stylization similar to that of Applicant’s Mark, . Thus, Applicant’s Mark and the Cited Marks differ in overall appearance, rendering confusion based unlikely.

ii. Applicant’s Mark and the Cited Marks Differ in Sound.

The phonetic differences between Applicant’s and the Cited Marks preclude a likelihood of confusion. Similarities in sound and word structure are additional factors to consider in determining whether a likelihood of confusion exists. TMEP § 1207.01(b)(iv); *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 USPQ 848, 851 (TTAB 1983) (BABE v. BABOR; double as opposed to single sound); *HQ Network Sys. v. Executive Headquarters*, 755 F. Supp. 1110, 18 USPQ 2d 1897, 1902 (D. Mass. 1991) (different total number of syllables; use of one mark as a noun, the other as an adjective).

The Cited Marks consist of three and four syllable phrases compared to Applicant’s single syllable mark. Further, the unique terms contained in each Cited Mark, 2 COAST; INDUSTRIES; & JAMMIES; and CHILL. REPEAT., create a unique blend of consonants and vowels that contrast the sound of Applicant’s Mark. The Cited Marks TOAST 2 COAST; TOAST INDUSTRIES; TOAST & JAMMIES; and TOAST. CHILL. REPEAT. use rhyming, unique punctuation, or additional wording to formulate a unique sound and appearance relative to the Applicant’s Mark. Considering these factors, consumers are unlikely to be confused when encountering Applicant’s Mark or the Cited Marks.

iii. Applicant’s Mark and the Cited Marks Differ in Connotation and Commercial Impression.

The respective marks convey very distinct meanings and commercial impressions. The meaning or connotation conveyed by marks in relation to the specified goods or services is a further factor in determining whether a likelihood of confusion exists. TMEP § 1207.01(b)(v); *see In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not likely to be confused with BOTTOMS UP for men’s clothing; the Board found that the term connotes the phrase “Drink Up” when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear).

The Cited Marks convey distinct meanings and unique commercial impression in comparison to Applicant’s Mark. Applicant’s Mark elicits the edible definition of toast, the celebration definition of toast, or the temperature definition of toast. Meanwhile, TOAST 2 COAST connotes the coastline or the swift movement definition of “coast”; TOAST INDUSTRIES brings about an association with an industrial or business atmosphere; TOAST & JAMMIES brings about the feeling of breakfast toast in the morning in one’s pajamas; and TOAST. CHILL. REPEAT. is a phrase connoting relaxation.

Notably, “INDUSTRIES” in TOAST INDUSTRIES is disclaimed apart from the mark as a whole. A disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). The public is generally not aware of disclaimers in trademark applications and registrations that reside only in the USPTO’s records. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985)).

When the Cited Marks and Applicant’s Mark are considered in their entireties, the respective differences as to sight, sound, meaning, and commercial impression render consumer confusion unlikely.

i. Established Case Law Demonstrates that the Shared Elements in the Respective Marks Are Not Sufficient to Render Confusion Likely

The fact that the marks at issue share a similar word does not automatically compel a finding that confusion is likely. Even when marks with overlapping elements are applied to related goods or services, they can function to signify different sources. *See Gen. Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442, 1445 (8th Cir. 1987) (Kellogg, which used APPLE RAISIN CRISP for cereal, failed to show entitled to preliminary injunction against General Mills’ use of OATMEAL RAISIN CRISP for cereal); *Little Caesar Enterpriser Inc. v. Pizza Caesar Inc.*, 4 USPQ2d 1942, 1444-45 (6th Cir. 1987) (LITTLE CAESARS for pizza not infringed by PIZZA CAESAR USA for an Italian restaurant).

Many Trademark Trial and Appeal Board (“TTAB”) and Federal Circuit decisions reiterate this requirement to compare marks in their entireties in order to assess whether they create a distinct commercial impression. Additional examples of cases in which marks with overlapping wording were found unlikely to be confused include the following:

- HEALTHY LIFE versus HEALTH FOR LIFE (both for vitamins and dietary supplements)
- GULP and BIG GULP (for large soft drink) versus GULPY (water dish for pets)
- NUTRI/SYSTEM versus NUTRI-TRIM (both for weight loss services)
- SWATCH versus T-WATCH (both for watches)
- PECAN SANDIES versus PECAN SHORTIES (both for cookies)
- TACO TOWN versus TACO TIME (both for restaurant services)

Approved Pharmaceutical Corp. v. P. Leiner Nutritional Products Inc., 5 USPQ2d 1219 (TTAB 1987); *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715 (TTAB 2007); *Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 1 USPQ2d 1809 (9th Cir. 1987); *Swatch Watch, S.A. v. Taxor, Inc.*, 229 USPQ 391 (11th Cir. 1986); *Keebler Co. v. Murray Bakery Prods.*, 9 USPQ2d 1736 (Fed. Cir. 1989); *Taco Time Intl., Inc. v. Taco Town, Inc.*, 217 USPQ 268 (TTAB 1982).

If all components of the respective marks are considered, as with the examples above, Applicant’s Mark and the Cited Marks are not likely to be confused. This contention is supported by the fact that seven registrations and applications currently coexist on the registry all featuring the TOAST component.

ii. USPTO Precedent Demonstrates that Applicant’s Mark and the Cited Marks Can Coexist.

The strength of the Cited Marks is a pivotal factor in a likelihood of confusion analysis. The determination of a mark’s strength is necessary to establish the scope of protection properly afforded to that mark. *Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc.*, 149 F.3d 727, 74 U.S.P.Q.2d 1587, 1590 (7th Cir. 1998). The common usage of a term or phrase in a particular industry is indicative of a weaker mark or element, such a mark is not entitled to a broad scope of protection and should not prevent registration of any other mark simply because the applied-for mark contains the common term. In this Office Action the Examining Attorney cited four trademarks owned by four different entities; the number of third-party marks containing the element “TOAST” significantly weakens the scope of protection properly afforded to each. *In re Red Carpet Corp. v. Johnson American Enterprises, Inc.*, 7 U.S.P.Q.2d 1404 (TTAB 1988). It cannot be ignored that where numerous third parties in the same field use the same or similar marks, each mark tends to be a weak indicator of a single source and is accordingly entitled to only a limited scope of protection. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1396, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005) (“Evidence of third party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection”); *Data Concepts, Inc.*

v. Digital Consulting, Inc., 150 F.3d 620, 47 U.S.P.Q.2d 1672, 1676 (6th Cir. 1998); *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 226 U.S.P.Q. 123, 127 (11th Cir. 1985); citing *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 211 U.S.P.Q. 844, 848-49 (5th Cir. 1981), and *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259, 205 U.S.P.Q. 969, 975 (5th Cir. 1980), quoting *Restatement of Torts* § 729 (1938) (“The greater the number of identical or more or less similar trademark already in use on different kinds of goods, the less the likelihood of confusion”). Based on the number of Cited Marks utilizing the TOAST component, it is improper to grant any single mark such a broad scope of protection as to cover the instant application.

A review of the records demonstrates that the Cited Marks have coexisted on the Principal Register without any apparent conflict or confusion for five years. Additionally, the USPTO did not cite any of the Cited Marks against each other in each of the marks' respective application processes. The fact that there are four registrations and applications all currently coexisting on the register and all featuring the term “TOAST” for clothing supports the conclusion that registration of Applicant's Mark will likewise not cause consumer confusion. As a result of the visual and aural differences and distinct commercial impressions between the respective marks, Applicant respectfully asserts that its Mark is no more similar to the Cited Marks than such marks are to each other. *See e.g. Amstar Corp. v. Domino's Pizza, Inc.*, 205 USPQ 969, 975-76 (5th Cir. 1980) (evidence of third party uses and registrations of identical or related marks reduces the risk of a likelihood of confusion); *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984) (Applicant's stylized KEY mark for banking services was “no more likely to cause confusion with the five cited registered [KEY-formative] marks [for banking related services] than the five cited marks [were] likely to cause confusion with [each other and] the fifteen other registered marks that contain the term ‘KEY’” for banking related services”).

The coexistence of the Cited Marks demonstrates that consumers are accustomed to differentiating between these marks. This coexistence suggests that consumers do not believe the goods and services identified by the Cited Marks emanate from a single source, thereby making it unlikely that consumers will be confused as to Applicant's Mark and the source of Applicant's Goods. Thus, Applicant's Mark will be able to peacefully coexist with the Cited Marks without any likelihood of confusion. The Examining Attorney is respectfully requested to act consistently with part USPTO decision in finding that more than “TOAST” component is needed to support a likelihood of confusion.

B. Summary

In view of the foregoing, Applicant respectfully submits that the refusal under Trademark Act Section 2(d) based on the Cited Marks is inappropriate because the threshold of a probability of confusion has not been met. The differences between the respective marks' appearance, sound, and commercial impression compel the conclusion that the risk of confusion is remote. Applicant therefore respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal.

C. Conclusion

Applicant submits that with the amendments, responses, and arguments above, all the issues raised by the Examining Attorney in the Office Action have been resolved. Applicant therefore respectfully requests that the Application be approved for publication.

The Examining Attorney is invited to contact the undersigned with any remaining questions or concerns.

Respectfully submitted,
/Benjamin M. Cantor/

Benjamin M. Cantor
Cantor Colburn LLP Attorneys for Applicant Toast (Mail Order) Limited

Our Ref: BSR0008TUS
Benjamin Cantor
Cantor Colburn LLP
20 Church Street
22nd Floor
Hartford, Connecticut 06103-3207 U.S.A.
Phone: 860-286-2929
Fax: 860-286-0115
Email: TM-CT@cantorcolburn.com