

Response to OA  
U.S. Trademark Application No. 88443128  
VIVID SPACE FURNITURE  
Cozen Ref: 390001.206

**Remarks:**

In response to the Office Action dated August 13, 2019, Applicant has amended the identification of goods and added a disclaimer of FURNITURE to address the issues raised by the Examiner.

In response to the refusal regarding the likelihood of confusion with U.S. Registration No. 4469874 for SPACE FURNITURE (disclaimer to FURNITURE) (the "Cited Mark"), Applicant respectfully submits that there is no likelihood of confusion between the respective marks given the differences between the respective marks as well as the differences between the respective goods and services.

An otherwise viable trademark application should not be refused under Section 2(d) unless a potential consumer is likely to be confused or mistaken about whether the applicant's goods or services and those of a senior registrant emanate from the same source. See 15 U.S.C. § 1052(d); *Paula Payne Prods. Co. v. Johnson's Pub'g Co.*, 473 F.2d 901, 902, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source."). The Trademark Trial and Appeal Board (the "TTAB") examines multiple factors when determining if a likelihood of confusion exists between two marks, including, (1) the similarity or dissimilarity of the marks, and (2) the relatedness of the goods or services. See TMEP § 1207.01; *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (listing additional factors). Here, these factors weigh against a finding of likelihood of confusion, as discussed in detail below.

In considering the question of likelihood of confusion under Section 2(d), the marks at issue must be considered in their entireties. See 4 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition*, § 23:41 (4<sup>th</sup> Ed. Rel. 79 Sept. 2016) (hereinafter "McCarthy"). "[I]n analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features." *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (holding that OATMEAL RAISIN CRISP for breakfast cereal was not confusingly similar to APPLE RAISIN CRISP for breakfast cereal).

When properly compared in their entireties, the distinctions between Applicant's Mark and the Cited Mark become apparent. Specifically, Applicant's Mark consists of three terms, beginning with the distinctive term "VIVID," which creates a different sound when pronounced as well as a different visual impression from the Cited Mark, which consists of the two words "SPACE" and "FURNITURE." In addition, the meanings and overall commercial impressions of the respective marks are quite different given the use of the distinctive term "VIVID" in Applicant's Mark. The term "VIVID" is defined as "of a color : very strong : very high in chroma," "having the appearance of vigorous life or freshness" or "producing a strong or clear impression on the senses." See Exhibit A for true and correct copies of printouts of the definition of "vivid" from *Merriam-Webster Online*. The use of the term "VIVID" in Applicant's Mark suggests that Applicant's goods are colorful or lively or associated with colorful or lively "spaces" or leave a strong impression on the senses. As such, Applicant's Mark has a connotation and creates a commercial impression that is entirely distinct from the Cited Mark.

Furthermore, although it is improper to dissect the respective marks, one feature of a mark may be more significant, and it is proper to give greater weight and effect to that dominant feature. See *McCarthy, supra*, § 23:42; see also *In re National Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark"). Here, the differences in the dominant portions of the respective marks suggests that there is no likelihood of confusion between Applicant's Mark and the Cited Mark. Specifically, the first and dominant portion of Applicant's Mark is the distinctive term "VIVID," whereas the dominant term in the Cited Mark is "SPACE."

The term "VIVID" (or the phrase "VIVID SPACE") is most likely to be impressed upon the minds of consumers as the distinctive portion of Applicant's Mark, whereas the dominant portion of the Cited Mark is the suggestive term "SPACE" on its own, which does not create a similar meaning or connotation. Thus, the differences in the dominant portions of the respective marks strongly suggests that there is no likelihood of confusion between the respective marks.

Another factor in the likelihood of confusion analysis is the relatedness of the goods and/or services associated with each mark. See TMEP § 1207.01; *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361. In multiple cases, the TTAB has held that there cannot be a rule that certain goods or services are per se related. See, e.g., *Information Resources Inc. v. X\*Press Information Services*, 6 U.S.P.Q.2d 1034, 1038 (TTAB 1998); *Hi Country Foods Corp. v. Hi Country Beef Jerky*, 4 U.S.P.Q.2d 1169, 1171 (TTAB 1987); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 1998 U.S.P.Q. 151, 152-53 (C.C.P.A. 1978) (holding that there is no "per se" rule that all food products are deemed related goods by nature or by virtue of being sold in the same food markets). Instead, the specific attributes of the goods and services should be compared. See *McGregor Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1132, 202 U.S.P.Q. 81 (2d Cir. 1979). If the goods or services associated with two marks "are not related or marketed in such a way that they would be encountered by the same person in situations that would create the incorrect assumption that they originate from the same source, then even if the marks are identical, confusion is not likely." TMEP § 1207.01(a)(i).

Here, Applicant's goods, as amended, consist of "Office furniture; computer furniture; tables; chairs; office chairs; organization and storage furniture, namely, desk drawer organizers, shelves for storage, storage racks, desks, bookcases, mobile file cabinet, lateral file cabinet, filing cabinet, storage cabinet, printer stand, coffee station in the nature of a buffet table, conference tables, office tables, room divider panel, reception desk, room divider reception panel, room divider modesty panel, room divider privacy panel, office room dividers for forming a cubicle, wardrobe cabinet" in Class 20 ("Applicant's Goods"). The Cited Mark is registered in connection with "On-line retail store services featuring furniture and home furniture accessories; Retail store services featuring furniture and home furniture accessories" in Class 35 ("Registrant's Services"). Applicant respectfully submits that Applicant's Goods and Registrant's Services should not be viewed as overlapping merely because they are related to furniture. Registrant's Services appear to be related to the retail sale of space-saving furniture, specifically murphy beds, as evidenced by the specimen filed in conjunction with the underlying application. See Exhibit B for true and correct copies of the original filed in connection with the trademark application corresponding to the Cited Mark. Registrant's retail services focus on a very specific and narrow classification of furniture, that is different from the office furniture, organization and storage furniture, desks, etc. encompassed within Applicant's Goods.

Furthermore, Applicant respectfully submits that the term "SPACE" is weak due to numerous third-party uses of the term in connection with the retail of furniture and related goods and services, as demonstrated by the registrations noted in the table below.

Mark	Registration Number	Owner	Relevant Goods/Services
EQUIP YOUR SPACE	2483650	Liberty Procurement Co. Inc.	IC 35: Retail store services, mail order services and computerized on-line retail services in the fields of linen products, home furnishings, housewares, house plants, toys, books, furniture and food.

LIVING SPACES	3101463	Living Spaces Furniture, LLC	IC 35: Retail furniture stores
ENRICHING SPACES	3138372	Interior Services Incorporated	IC 35: Retail and wholesale stores featuring furniture, carpet, fabrics, wall coverings, interior décor accessories, and lighting;
URBANSPEACE	4459626	Urbanspace Interiors, LLC	IC 35: Retail store services featuring furniture, lighting, art, gifts and interior décor items in the nature of rugs, pillows, mirrors, tiles, wallpaper, textile fabrics for home interiors, and bedding
SPACE. REINVENTED.	4167907	Resource Furniture, LLC	IC 35: Wholesale and retail stores in the field of furniture

The registrations noted above demonstrate that the term "SPACE" is widely used in connection with wholesale retail services. In situations such as this one, there is no likelihood of confusion, because consumers have learned to carefully pick out one mark from another based on small distinctions among the crowded field of marks. See, e.g., *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 U.S.P.Q.2d 1447, 1479 (TTAB 1987) (stating that numerous third-party registrations and uses of "STEVE'S" in the related industries of restaurants and food stores showed that the purchasing public is able to distinguish the marks based on small differences and holding that STEVE'S & Design for restaurant services was not confusingly similar for STEVE'S for ice cream for consumption on and off the premises). Here, these marks all share the term "SPACE," indicating that consumers will look to other portions of the mark to distinguish them amongst this crowded field. Furthermore, each of the registrations noted above covers services that directly overlap with the services noted in connection with the Cited Mark; the coexistence of these registrations with the Cited Mark suggests that Applicant's Mark should also be permitted to coexist with the Cited Mark, particularly when taking into consideration the incorporating of the distinctive term "VIVID" and the differences in the respective goods and services.

Accordingly, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark given the differences in the respective marks and the differences in the respective goods and services.

Applicant believes that all issues have been addressed. If questions remain, the Examining Attorney is invited to contact Applicant's counsel, Lorraine Linford, via email at [LLinford@cozen.com](mailto:LLinford@cozen.com) or by telephone at (206) 340-1000.