

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of L'Oréal USA Creative, Inc.

Mark: MEMPHIS

Serial No.: 88/456,552

Dinisha Fernando Nitkin, Esq.
Examining Attorney
Law Office 110

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

OFFICE ACTION RESPONSE

Applicant responds to the Office Action, mailing date August 8, 2019, as follows:

I. Likelihood of Confusion

The Examining Attorney has preliminarily refused registration of Applicant's mark MEMPHIS, App. No. 88/456,552, for "hair care preparations sold to and through professional hair salons" in Class 3 ("Applicant's Mark") on the basis of a likelihood of confusion with the registered mark MEMPHIS *and design*, Reg. No. 5,610,023, for "body lotion" in Class 3 ("Cited Mark") owned by Oxford Onwuka ("Registrant"). For the reasons set forth in this Office Action response, Applicant respectfully submits that there is no likelihood of confusion between the Marks.

Under the Trademark Act, a refusal to register grounded in likelihood of confusion requires that such confusion as to the source of the goods or services not merely be possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). *In re Massey-Ferguson Inc.*, 222 USPQ 367, 368 (TTAB 1983) (quoting *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 164 USPQ 43, 44 (CCPA 1969)):

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which trademark laws deal.

Moreover, mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. *McGregor-Doniger, Inc. v. Drizzle Inc.*, 202 USPQ 81 (2d Cir. 1979). Thus, in holding the mark “DRIZZLE” for women’s overcoats was not likely to cause confusion with “DRIZZLER” for golf jackets, the Court of Appeals for the Second Circuit stated:

First, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. “Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.” (Citation omitted)

Id. at 89.

Sharing the same term is not dispositive of a likelihood of confusion. *See Edwards Lifesciences Corporation v. VigiLanz Corporation*, 94 USPQ2d at 1410 (“[A] finding that the goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both.”) (internal citation omitted). Thus, even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods such that there is no likelihood of confusion. *See, e.g., In re The Shoe Works, Inc.*, 6 USPQ2d 1890 (PALM BAY for women’s shoes not confusingly similar to PALM BAY for shorts and pants); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies’ sportswear, the Board finding that the term was suggestive of the construction of applicant’s bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being

suggestive of sportswear that “crosses over” the line between informal and more formal wear when applied to 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, the Board finding that the term PLAYERS implies a fit, style, color and durability adapted to 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., 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, the Board finding that the term connotes the drinking phrase “Drink Up” when applied to men’s suits, coats and trousers, but does not have this connotation when applied to ladies’ and children’s underwear).

Respectfully, the question centers on the likelihood of confusion of consumers in the market for a particular product at issue. “The proper examination is not whether some people viewing the products *might* be confused, but rather whether consumers in the market for the products *are likely* to be confused.” *Continental Plastic Containers v. Owens Brockway Plastic Prods.*, 141 F.3d 1081, 43 USPQ2d 1277 (Fed. Cir. 1998) (emphasis added).

Applicant’s goods are marketed to customers with a completely different purchase intention than those who purchase the goods offered by Registrant. As set forth in the identification of the goods in Applicant’s Mark, Applicant’s products are premium priced professional hair salon products sold to and through professional hair salons. Purchasers of Applicant’s products are hair salons, hair stylists in professional salons, and customers

within those salons. Registrant sells a body lotion to consumers seeking cost-effective skin care solutions.

An important consideration is “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful sophisticated purchasing.” *In re E. I. DuPont de Nemours & Co.*, 476 F. 2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In *Electronic Design & Sales v. Electronic Data Systems*, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), the Federal Circuit reversed the Trademark Trial and Appeal Board decision giving undue weight to purchaser sophistication, stating:

The Board also apparently failed to consider, and certainly failed to address, the sophistication of the buyers. ‘In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely.’ *In re E.I. Dupont DeNemours & Co.*, 476 F.2d 1357, 1362, 177 U.S.P.Q. 563, 568 (CCPA 1973) (emphasis in original). Even though the Board made explicit factual findings as to five of the thirteen factors set forth in *DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567, the Board gave too much weight to certain *DuPont* factors, such as the strength of opposer’s mark, and failed to give due weight to countervailing *DuPont* factors, such as the sophistication of purchasers.

Here, professional hair salons and hair stylists are well informed and sophisticated in considering professional hair salon products, and they routinely recommend products to their customers based on hair texture, hair strength, and other factors. See *Graham Webb International v. Helen Curtis Inc.*, 48 USPQ2d 1730, 1740 (Dist. Minn. 1998) (holding purchasers of plaintiff’s products exercise sufficient care in their buying decisions to negate the probability that they would purchase defendants’ products inadvertently); *Aveda Corp. v. Aura, Inc.*, 19 USPQ2d 1864, 1867 (Dist. Minn. 1991) (holding consumers of A-Veda’s hair care products are well informed and careful buyers); *P.F. Cosmetique*,

S.A. v. Minnetonka, Inc., 605 F. Supp. 662 (SDNY 1985) (holding purchasers of premium priced beauty care products can and do differentiate among packages with a number of common elements). Such professionals and their customers are extremely conscious about which products should be applied to hair, as a wrong decision could lead to ruining a style he or she is attempting to achieve, or even worse, to hair damage. Given the extraordinary size of the hair care industry, the number and type of products available, and the competition for consumer loyalty among producers, consumers of hair care products are far less likely than others to be confused by unrelated products that share a name, particularly when the products are used in their hair salons and are recommended by their stylists.

In addition, as to Registrant's skin care products, consumers of beauty products are equally sophisticated and likely to examine with care the devices and products they apply to their skin and lips. *See, e.g., Juicy Couture v. L'Oreal USA, Inc.*, 2006 U.S. Dist. Lexis 20787 at *91 (SDNY 2006). Consumers of beauty products are looking for products that will make them feel and look their best. Accordingly, these purchases are extremely calculated and not done on a whim.

A close comparison of the respective marks and goods demonstrates that the differences are significant enough that consumers would not be confused as to the source of the goods. The Cited Mark consists of a distinctive design element, an orange diamond bifurcated by the word "MEMPHIS":



An integral part of the Cited Mark is a design element, which, respectfully, cannot be ignored in a likelihood of confusion analysis. See *In re Electrolyte Laboratories, Inc.*, 929 F. 2d 645, 647, 16 USPQ2d 1239 (Fed. Cir. 1990) (reversing the TTAB’s holding of a likelihood of confusion between the composite mark K+ and Design and the mark K+EFF, where both were used for a dietary potassium supplement, concluding that applicant’s mark was a composite and its design was a significant feature). Products bearing Applicant’s Mark will be marketed under Applicant’s well-known PULPRIOT brand of hair care preparations, accompanied by Applicant’s PULPRIOT mark (Reg. No. 5,280,918) and trade dress, thus further distinguishing Applicant’s Mark from the Cited Mark in form and appearance:



(See PULPRIOT registration Trademark Office records attached as Exhibit A.)

The word MEMPHIS is not dominant in either of the marks. The Examining Attorney must afford the proper weight to the first and dominant design component of the Cited Mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Again, the Cited Mark has a dominant design component in the unique shape of an orange diamond above and below the wording, while Applicant's Mark has no design component at all. Consumers will see Registrant's orange diamond design first when encountering the Cited Mark and will retain a strong commercial impression of that image. Consequently, such clear differences between the marks make them appear completely different, weighing heavily against a finding of a likelihood of confusion.

Furthermore, Applicant submits that the disclaimer of the term "MEMPHIS" in the Cited Mark demonstrates Registrant understands it does not have the exclusive right to use that term apart from the registered design element and stylization as a whole. See TMEP 1213. Thus, the Cited Mark is intended to protect a very specific stylization and design (distinctive logo) as opposed to the term "MEMPHIS" per se. Applicant's Mark MEMPHIS incorporates no similar design element or stylization.

Additionally, the fact that Applicant's goods relate to professional hair care products and Registrant's goods relate to skin care in and of itself is not dispositive of whether the marks are likely to be confused. *Electronic Data Systems Corporation v. EDSA Micro Corporation*, 23 USPQ 2d 1460, 1463 (TTAB 1992) ("Moreover, 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.”). The Trademark Trial and Appeal Board has held that BEL ARIA for sauces and spreads is not likely to be confused with BEL-AIR for frozen foods and juices because the goods are sufficiently unrelated. *Safeway Stores, Incorporated v. Bel Canto Fancy Foods Ltd.*, 5 USPQ2d 1980 (TTAB 1987). *See also, In re August Storck KG*, 218 USPQ 823 (TTAB 1983) (JUICY 2 for candy and JUICY BLEND II for a ground beef and textured vegetable protein mix found unrelated); *Level Brothers Company v. American Bakeries Company, Inc.*, 215 USPQ 647 (E.D. N.Y. 1982) (AUTUMN GRAIN for bread not confusingly similar to AUTUMN for margarine); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 USPQ 969 (2d Cir. 1981) (BRAVOS for tortilla chips held not confusingly similar to BRAVO’S for crackers); *CPC International v. Rico Banana Co., Inc.*, 212 USPQ 308, 310 (TTAB 1981) (KARO for syrups and CARRO for, *inter alia*, canned vegetables, condiments, soups and food coloring found to “fall within the general category of food items. Nevertheless, they are specifically different items of merchandise.” No likelihood of confusion found); *Interstate Brands Corp. v. Celestial Seasoning, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978) (no likelihood of confusion between opposer’s ZINGER’S for cakes and RED ZINGERS for herbal tea).

Here, Applicant’s goods are specifically delineated in the goods description as hair care preparations that are available “*to and through professional salons,*” and the products are sold at a price point commensurate with a professional hair care brand. Registrant’s fairly inexpensive goods, however, appear to be available to the general

public through Registrant's website (see <https://www.memphiscocoabutter.com/product-page/memphis-cocoa-butter>, attached as Exhibit B), where any consumer can purchase the products without having to visit a licensed retailer or hair salon. Given the high price point of Applicant's MEMPHIS products, the difference in trade channels for the respective goods, and, as noted above, the care and consideration professional hair stylists apply to the purchase of premium priced hair care products, it is unlikely that these sophisticated purchasers would be confused as to the source of Applicant's Mark and the Cited Mark.

Finally, Applicant believes that its mark should be approved for publication since it is the policy of the Trademark Office to resolve any doubt in favor of the applicant. *In re Women's Publishing Co., Inc.*, 23 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1992) (“[I]n accordance with precedent, we must resolve any reasonable doubt in favor of applicant in these kinds of cases.”); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (Any doubt in determining registrability is resolved in favor of applicant “on the theory that any person who believes that he would be damaged by the registration will have an opportunity ... to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.”).

Considering all the foregoing, Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register and pass the application on to publication.

II. Information Required

The Examining Attorney has requested a “statement explaining whether Applicant's goods will be manufactured, packaged, shipped from, sold in or will have

any other connection with the geographic location named in the mark.” (See Office Action, p.3.) Applicant confirms that Applicant’s goods will not be manufactured, packaged, or shipped from Memphis. Applicant’s MEMPHIS goods are sold to professional hair salons that may be located in Memphis, in the same manner they are sold to professional hair salons in cities across the U.S. and in the same manner that Registrant’s goods can be purchased by consumers from Memphis. Applicant’s Mark is one of several that Applicant owns that are suggestive of a liberal, cosmopolitan, creative culture, one that speaks to the inclusivity and passion of the hair artist community around the world. (See TORONTO, Reg. No. 5,893,179; ZURICH, Reg. No. 5,893,178; BUDAPEST, Reg. No. 5,893,177; and LIVERPOOL, Reg. No. 5,893,176.)

III. Attorney Bar Information and Attestation

The attorney bar information and statement have been updated by using the TEAS form Revocation of Attorney and/or Appointment of Attorney/Domestic Representative.

Conclusion

Based on the foregoing, Applicant respectfully submits that it has satisfied the Examining Attorney’s inquiries and respectfully requests that the application be approved for publication.