


Serial No. 88/477,537

Mark: 

I. LIKELIHOOD OF CONFUSION REFUSAL

The Examining Attorney has refused registration of Applicant's Mark under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with the Registration No.

4781038 for the Mark  (the "038 Mark"). The Examining Attorney has also cited as a potential bar Application No. 88240286 for the Mark Hutch, which has now registered under Registration No. 5922582 (the "582 Mark") (collectively the "Cited Marks"). For the reasons set forth below, Applicant submits that confusion is not likely to arise between Applicant's Mark and either of the Cited Marks and requests that the Examining Attorney withdraw both the refusal to register and the citation to the '582 Mark, and approve the subject application for publication.

A. The Marks Differ in Overall Commercial Impression

Applicant's Mark differs from the each of the Cited Marks in sight, sound and meaning. It is well established that marks must be considered in their entirety when determining whether there is a likelihood of confusion. Even if the Examining Attorney concludes that the marks are similar in any one respect of the appearance, sound or meaning trilogy, this does not automatically result in a determination of likelihood of confusion even if the goods or services are closely related. Rather, the rule to be applied when considering the similarity of marks requires that all relevant facts of the particular case be taken in to account. *See In re Lamson Oil*

Co., 6 U.S.P.Q. 2d 1041, 1042 n.4 (T.T.A.B. 1987). Moreover, a mark should not be split into its component parts and each part then compared with the parts of the conflicting mark. *Colgate-Palmolive Co. v. Carter-Wallace Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970). Applicant respectfully submits that any conclusion that Applicant's Mark is likely to be confused with the distinguishable Cited Mark is in violation of this anti-dissection rule.

Applicants' Mark is:



The Cited Marks, on the other hand, are



Hutch

Applicant's Mark consists of the large, angled, and distinctive double "H" design above the disjointed letters HuTcH; with the horizontal line of the "T" stretching across other letters for a striking visual effect. The '038 Mark makes an entirely different visual impression, with its transparent letters, cursive font and diagonal orientation.

The marks also sound different when spoken, considering that Applicant's Mark HH HUTCH, with the distinctive double "H" sound forming the first two syllables of Applicant's three-syllable Mark, as compared to the one-syllable Cited Marks.

These differences in sight and sound result in each mark making different commercial impression such that no likelihood of confusion will arise from coexistence of Applicant's Mark

with the Cited Marks. This is particularly the case because the distinctive double “HH” pattern of Applicant’s Mark is in the dominant higher position. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 U.S.P.Q. 2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 U.S.P.Q. 2d 1372, 1374-75 (T.T.A.B. 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q. 2d 1895, 1897 (T.T.A.B. 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In addition, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although “Vargas” and “Varga” were similar, “the marks must be considered in the way they are used and perceived...and all components thereof must be given appropriate weight.” The court went on to say that “[b]y stressing the portion ‘varga’ and diminishing the portion ‘girl’, the Board inappropriately changed the mark.” *Id.* at 1239.

Where Applicant’s Mark differs in overall commercial impression by virtue of its distinguishing design features and unusual font, then no likelihood of confusion will result and the refusal to register Applicant’s Mark and the potential bar citation should be withdrawn.

B. The Respective Goods are Different.

Applicant’s goods, as amended herein, are “shoes; sandals; sports shoes; leisure shoes; spiked running shoes” in class 25. The ‘038 Mark, on the other hand, covers:

“Backpacks, book bags, sports bags, bum bags, wallets and handbags; Change purses; Clutch purses; Coin purses; Coin purses not made of precious metal; Evening handbags; Fashion handbags; Fitted protective covers for handbags, briefcases, valises, suitcases, and briefcase-like portfolios; Gentlemen's handbags; Handbag frames; Handbags; Handbags for ladies; Handbags for men; Handbags, purses and wallets; Interchangeable decorative covers for accessorization purposes that are specially adapted to handbags; Leather handbags; Leather purses; Multi-purpose purses; Multistranded, beaded clip that attaches to the outside of a women's purse as a decorative accessory; Pochettes; Purses; Purses and wallets; Purses and wallets of precious metal; Straps for handbags” in class 18.

These goods are different and are sold either in different stores or in different areas of large stores. Thus consumers will not assume that these goods emanate from the same source, particularly in view of the differences in commercial impression between the marks.

The goods covered under the ‘038 Mark are “Dresses, skirts, pants, shorts, blouses, jackets, blazers, vests, coats, scarves, clothing tops, camisoles, wedding dresses, bridesmaid dresses, sweaters”. These goods are also sold in different areas of large stores and consumers will distinguish the marks based on overall impression. *See In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (PLAYERS for men’s underwear able to coexist with identical mark PLAYERS for shoes considering that they would be sold in different sections of the same stores and taking into account difference in commercial impression of the marks). The differences in the respective goods, considered alongside the differences in overall commercial impression of the marks, warrants a finding of no likelihood of confusion.

C. The Cited Marks are Coexisting.

It is significant to note that the Cited Marks have been found by the USPTO to be able to coexist *with each other*; the ‘582 Mark was examined and approved for publication without even an initial refusal to register based on the ‘038 Mark. Considering that the ‘038 Mark does not even have a separate distinguishing design element, it is difficult to understand how the

Examining Attorney could reach the conclusion that Applicant's distinguishable mark for goods that are different from either of the Cited Marks, causes a likelihood of confusion with either of the Cited Marks. Rather, the coexistence of the Cited Marks shows that these marks are entitled to only a narrow range of protection, and that Applicant's mark may coexist as well. *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984); *In re Dayco Products-Eagle Motive Inc.*, 9 U.S.P.Q. 2d 1910 (T.T.A.B. 1988). In view of the coexistence of multiple marks, there is no more likelihood of confusion as to source resulting from Applicant's mark than between the Cited Marks. When there are multiple marks containing similar terms for related goods or services, consumers have learned to distinguish different marks based on small additions or changes. *See Miss World UK Ltd. v. Mrs. America Pageants Inc.*, 8 U.S.P.Q. 2d 1237, 1241 (9th Cir. 1988). Thus the refusal to register Applicant's Mark and the potential bar citation should be withdrawn.

II. CONCLUSION

Confusion is ultimately to be decided on the basis of whether there is confusion as to source of origin of the goods. *See Globe-Union Inc. v. Raben Laboratories Inc.*, 180 U.S.P.Q. 469 (T.T.A.B. 1973). Confusion should not be concerned with "de minimis" situations, but rather with the practicalities of the real world in which trademarks exist. *See MTD Prods. Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56 (T.T.A.B. 1976). It is not sufficient that there exists a "possibility" that the subject mark will engender confusion with the cited registration for a holding of likelihood of confusion. *See Carter-Wallace, Inc. v. Procter & Gamble Co.*, 167 U.S.P.Q. 713 (9th Cir. 1970). A refusal to register based upon confusing similarity should be made when a "likelihood", meaning "probability", of confusion has been established and not

merely a "possibility" of confusion between use of the marks in question in conjunction with the goods. *See 4 McCarthy on Trademarks and Unfair Competition*, Section 23:3 (4th ed. 2010). Here, Applicant has established that the differences in overall commercial impression between its Mark, differences in the respective goods, and the coexistence of the two Cited Marks warrant a finding of no likelihood of confusion.

REMARKS

For the above reasons, and having resolved all informalities raised by the Examining Attorney, Applicant respectfully requests withdrawal of the refusal to register based on the '038 Mark, the citation to the '582 Mark, and early approval for publication.

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