



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Platinum Investment Group Pty Ltd.
Serial No: 88464132
Filed: June 7, 2019
Mark: HIDEAWAY (Stylized)  (“Applicant’s Mark”)

TRADEMARK ACT 2(d) REFUSAL RESPONSE

On August 31, 2019, the Examining Attorney refused to register Applicant’s Mark because of a likelihood of confusion with HIDEAWAY (U.S. Reg. No. 3,696,267) used with “cosmetics, namely, concealer, liquid concealer, pencil concealer, cream concealer, powder concealer, blemish concealer” in Class 3 (the “Cited Mark”).

I. No Likelihood of Confusion

The Lanham Act §2(d) prevents registration of a mark on the principal and supplemental register that is likely to be confused or mistaken or deceived, by potential consumers, as to the source of the goods of the applicant and the registrant. 15 U.S.C. §1052(d). Applicant argues that its mark, HIDEAWAY (Stylized) , will not likely confuse consumers as to the origin of the goods in the application: “Antiperspirant soaps; Bar soaps; Bath soaps; Body soaps; Cakes of soap; Cakes of toilet soap; Cosmetic soaps; Deodorant soaps; Deodorising soaps; Facial soaps; Laundry soaps; Liquid soaps (non medicated); Non-medicated soap creams for use in washing; Non-medicated soap products; Non-medicated soap-based handwashes; Non-medicated soaps; Non-medicated toilet soaps; Perfumed soaps; Perfumed toilet soaps; Shaving soaps; Shower soaps; Soaps for foot perspiration; Soaps free washing emulsions for the body; Soaps for laundry use; Soapy detergents for household use; Sugar soaps; Toilet soaps; Body washes; Body creams; Body scrubs; Body oils; Bath oils; Massage oils; Scented oils” in Class 3.

There is no likelihood a potential consumer will be confused, mistaken, or deceived between Applicant’s Mark and the Cited Mark as to the source of the goods

offered in commerce. Federal courts and the Board have consistently held that likelihood of confusion exists between two marks only if a reasonably prudent purchaser is likely to be confused as to source or sponsorship of the services. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Thirteen principal factors are to be considered in a likelihood of confusion analysis; 1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impressions, 2) the similarity or dissimilarity of and the nature of goods described in an application or registration in connection with which a prior mark is in use, 3) the similarity or dissimilarity of established, likely-to-continue trade channels, 4) the conditions under which potential consumers purchase-impulse versus careful sophisticated purchasing, 5) the fame of the prior mark, 6) the number and nature of similar marks in use on similar goods, 7) the nature and extent of actual confusion, 8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, 9) the variety of goods on which a mark is or is not used, 10) the market interface between the applicant and the owner of the prior mark, 11) the extent to which applicant has a right to exclude others from use of its mark on its goods, 12) the extent of possible confusion-de minimus or substantial, and 13) any other established fact probative to the effect of use. *Id.*

Analysis of the applicable factors illustrates that there is no likelihood of confusion between Applicant's Mark and the Cited Mark. The Examining Attorney rejected Applicant's mark based on the similarity of the marks and the similarity of the goods. The Applicant will demonstrate how the consumer will differentiate Applicant's Mark from the Cited Mark.

A. Dissimilarity of the Marks

The marks are different in appearance, sound, and connotation because the word elements of Applicant's Mark are stylized. In considering sight, sound, and meaning, it is axiomatic that conflicting marks must be compared in their entireties. *See Opryland USA, Inc., v. The Great American Music Show, Inc.*, 23 U.S.P.Q. 2d 1471, 1473-74 (Fed. Cir. 1992). A mark should not be dissected into its component parts and each part then compared with corresponding parts of a conflicting mark to determine confusion – it

is the impression the mark as a whole creates that is important. *Id.* As explained by the Court of Appeals for the Federal Circuit:

[M]arks must be considered in the way they are perceived by the relevant public. Although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. Thus it is not dispositive whether...descriptive words are included as parts of the marks; that is simply a factor to be considered when viewing the mark as a whole.

Id.

Additionally, in determining whether a mark will give rise to a likelihood of confusion, an examining entity should note that the fundamental issue is not whether a court, an examining attorney, or a lawyer finds confusion between two marks, but whether the relevant buyers would be confused. Daddy's Junky Music v. Big Daddy Family Music, 109 F.3d 275, 42 U.S.P.Q. 1173 (6th Cir. 1997). As observed by the Eighth Circuit in Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc., 815 F. 2d 500, 504 (8th Cir. 1987):

[V]isual inspections by the court are permissible as an aid in determining likely confusion. However, caution should be exercised to avoid putting too much stock in subjective inspection done in-chambers that is devoid of market characteristics. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do.

Marks must be considered on a case-by-case basis. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do.

Applicant believes that the Examiner does not give adequate weight to the fact that Applicant's Mark is stylized. Even if consumers view HIDEAWAY as the dominant portion of the Cited Mark, this does not necessarily lead to the inference that the marks are similar. When comparing marks, the common presence of a dominant term does not compel a conclusion that the marks are similar. *See General Mills Inc. v. Kellogg Co.*, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987) (no likelihood of confusion between APPLE

RAISIN CRISPT and OATMEAL RAISIN CRISP even though both marks identify ready-to-eat breakfast cereals that directly compete), citing Freedom Sav. & Loan Ass'n v. Way, 226 U.S.P.Q. 123, 127-28 (11th Cir.), cert. denied, 106 S. Ct. 134 (1985). See also RICHARD L. KIRKPATRICK, LIKELIHOOD OF CONFUSION IN TRADEMARK LAW § 4.10, at 4-54 (“[T]he mere fact that the marks in issue share elements, *even dominant elements*, does not compel a conclusion of likely confusion.”) (emphasis added); Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc., 952 F. Supp. 1084, 1096-97 (D.N.J. 1997) (no likelihood of confusion between HARLEM WIZARDS to identify “show” basketball and WASHINGTON WIZARDS to identify NBA basketball team).

The stylization of Applicant’s Mark changes the meaning, connotation, and commercial impression. Applicant has deliberately chosen the stylization of HIDEAWAY for the exact purpose of creating a strong and distinct commercial impression. In word form only, HIDEAWAY *simpliciter* may connote its own commercial impression, however, it is certainly devoid of the same commercial impression as Applicant’s Mark. This DuPont factor weighs towards finding no likelihood of confusion.

B. Differences in the Goods or Services

The second DuPont factor cited by the Examiner concerns the similarity or dissimilarity and nature of the goods or services. The goods are similar only to the extent that they are products used for personal care. The goods used with Applicant’s Mark are soaps, whereas the goods used with the Cited Mark are cosmetics. Nevertheless, the following bullet-point list contains trademarks similar to this case where no likelihood of confusion existed even between the same or highly related goods:

- “LEAN CUISINE” and “LEAN LIVING” Stouffer Corp. v. Health Valley Natural Foods, 1 USPQ2d 1900 (TTAB 1987);
- “PECAN SHORTIES” and “PECAN SANDIES” Keebler Co. v. Murray Bakery Prods., 866 F.2d 1386 (Fed. Cir. 1989);
- “TEKTRONICS” and “DAKTRONICS INC.” Tektronicx, Inc. v. Daktronics, Inc., 534 F.2d 915 (CCPA 1976);

- “BED & BREAKFAST REGISTRY” and “BREAKFAST INTERNATIONAL” In re Bed & Breakfast Registry, 791 F.2d 157 (Fed. Cir. 1986);
- “SANDWICH CHEF” and “BURGER CHEF” Burger Chef Sys., Inc. v. Sandwich Chef, Inc., 608 F.2d 875 (CCPA 1979);
- “DUTCH APPLE” and “DUTCH MASTERS” Consolidate Cigar Corp. v. M. Landaw, Ltd., 474 F.2d 1402 (CCPA 1973);
- “K+” and “K+EFF” In re Electrolyte Labs, Inc., 929 F.2d 646 (Fed. Cir. 1990);
- “THE UNCOLA” and “COCA-COLA” Coca-Cola Co. v. Seven-Up Co., 497 F.2d 1351 (CCPA 1974);
- “RED ZINGER” and “ZINGERS” Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926 (CCPA 1978);
- “RITE WAY” and “RITE AID” Rite Aid Corp. v. Rite-Way Discount Corp., 508 F.2d 828 (CCPA 1978);
- “SILK” and “SILK ‘N SATIN” Pacquin-Lester Co. v. Charmaceuticals, Inc., 484 F.2d 1384 (CCPA 1973);
- “STUDIO ONE” and “STUDIO GIRL” Studio Girl-Hollywood, Inc. v. H/P Consultants, Ltd., 453 F.2d 768 (CCPA 1972);
- “PARTY PARADE” and “PARTY PRIDE” Safeway Stores, Inc. v. Dunkirk Ice Cream Co., 455 F.2d 576 (CCPA 1972);
- “ROB SCOT” and “ROB ROY” Rob Roy Co. v. Thurman Mfg. Co., 455 F.2d 605 (CCPA 1972);
- “CHERRY JUBILEE” and “CHERRY JULEP” Jack Poust & Co. v. John Gross & Co., 460 F.2d 1076 (CCPA 1972);
- “DURAGOLD” and “EVERGOLD” Claremont Polychemical Corp. v. Atlantic Powdered Metals, Inc., 470 F.2d 636 (CCPA 1972);
- “ROMANBURGER” and “ROMAN MEAL” Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co., 781 F.2d 884 (Fed. Cir. 1986);
- “GREEN JADE” and “JADE EAST” Swank, Inc. v. Ravel Perfume Corp., 438 F.2d 622 (CCPA 1971);

- “MIGHTY MIKE” and “MIGHTY MO” Marrion-Hot Shoppes, Inc. v. McKee Baking Co., 442 F.2d 978 (CCPA 1971); and
- “CANADIAN BELLE” and “CUMBERLAND BELLE” Continental Distilling Corp. v. Norman Williams Co., 443 F.2d 392 (CCPA 1971).

Despite the highly related—if not identical—goods, authorities deemed the above listed marks could co-exist with no likelihood of confusion. The goods at issue here—cosmetics versus soaps, are less similar than the goods above. In addition, Applicant’s Mark and the Cited Mark are more dissimilar in appearance, sound, and connotation than the majority of the above marks. This DuPont factor weighs towards finding no likelihood of confusion.

CONCLUSION

Applicant believes it has responded to the Examiner’s rejection based on a likelihood of confusion. It is clear from a closer analysis of the DuPont factors, that there is no likelihood consumers will be confused between Applicant’s Mark and the Cited Mark.

“In every case turning on the likelihood of confusion, it is the duty of the examiner ... to find, upon consideration of all the evidence, whether or not confusion appears likely.” In re E.L. DuPont, 476 F.2d at 1362 (emphasis in original). Here, the strongest consideration should be given to the differences in the marks and the differences in the goods. In view of the foregoing, the Applicant respectfully requests that the Examining Attorney retract the refusal to register Applicant’s Mark and approve Application No. 88464132 for publication.