

## OFFICE ACTION RESPONSE

Applicant's mark is **PIX**, U.S. Trademark Application Serial No. 88/453,955, for use in connection with "Backpacks" in International Class 18 ("Applicant's Mark"). Registration of Applicant's Mark has been refused under Section 2(d) based on a finding of likelihood of confusion with Reg. No. 4,423,767 for the mark **P FOR PIX.**, depicted as follows:



for use in connection with "Camera bags; automatic valves made of leather" in International Class 9, and:

Purses; game bags, namely, hunters' game bags; school book bags; school satchels; business card cases and credit card cases; notecases, namely, wallets; hat boxes of leather; travelling trunks; sling bags for carrying infants; tool bags of leather sold empty; backpacks; handbag frames; pocket wallets; wheeled shopping bags; canvas shopping bags, leather shopping bags and reusable shopping bags; attache cases; bags for climbers in the nature of all-purpose carrying bags; bags for campers, namely, backpack; beach bags; handbags; travelling bags; bags of leather, for packaging; briefcases; leather travelling sets comprised of leather bags, suitcases and wallets; valises; suitcase handles; boxes of leather or leather board; chain mesh purses; cases of leather or leatherboard; trunks; luggage; unfitted vanity cases; haversacks; garment bags for travel; leather key cases; net bags for shopping, namely, mesh and string shopping bags; suitcases; bags for sports; slings for carrying infants; imitation leather cases; canvas carrying cases; cheque wallets made of leather; leather passport wallets; trimmings of leather for furniture, namely, leather for furniture; straps for soldiers' equipment, namely, backpack straps and shoulder straps; leather leads; shoulder straps for skates; leather thongs; leather straps; leather thread; leather twist, namely, twisted leather thread; chin straps, of leather; bands of leather; bandoliers

in International Class 18 (the "Cited Mark"). Registration of Applicant's Mark has also been refused under Section 2(e)(1) based on a finding that the mark is merely descriptive. Applicant

respectfully disagrees and submits this response to the Examining Attorney's refusals based on the following arguments.

### **I. THE MARKS ARE NOT SIMILAR**

In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). When comparing marks that share a literal element, the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. TMEP §1207.01(b)(iii); *see Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

In addition, consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee 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) ("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.').

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently the marks at issue are similar in only one element. Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). While it is often true that the word portion of a mark is more likely to be impressed upon a purchaser's memory, that is not the case in every situation. The Court of Appeals for the Federal Circuit has cautioned that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices). Further, the visual impact of the marks on the minds of the prospective purchasers who view them must be considered and the design portion of a mark can be the dominant part of a mark. *Finn v. Cooper's Inc.*, 130 U.S.P.Q. 269, 272 (CCPA 1961). Images create a lasting impression in the minds of consumers. *Id.* (“[We must consider the visual impact of the marks on the minds of the prospective purchasers who view them . . . . Symbolic marks speak a universal language; they lend themselves to effective display in advertising and sales promotional activity and can thus become the dominant part of the mark on labels, packages, and point of purchase displays. They can catch the eye of the customer and create a lasting general impression. Current mass advertising media utilize symbols which are visually projected into millions of homes of prospective purchasers by television and these symbols frequently are associated with pictures of the goods of a particular user”).

Applying these principles, in *In re Fairview Imp. Corp.*, 2013 TTAB LEXIS 447 (TTAB Aug. 16, 2013), the Board reversed a refusal to register the following combined word/design mark:



for, *inter alia*, “sunglasses” in International Class 9 (with the descriptive term “collection” disclaimed) was not likely to cause confusion with the mark HERITAGE 1981, for, *inter alia*, “eyewear, namely, sunglasses” in International Class 9 (with “1981” disclaimed).

Despite the fact that the goods for both marks -- sunglasses -- were *identical*, and the marks shared the first term “Heritage” with the second terms “Collection” and “1981” disclaimed, the Board found that confusion was not likely because the “moose” design was “prominent” and contributed “greatly” to the visual impression of the applicant's mark:

[W]e note that applicant's mark Heritage Collection is similar to the mark HERITAGE 1981 in the cited registration solely to the extent that both contain the word HERITAGE as a prominent element thereof. However, the marks are dissimilar to a significant extent in that applicant's mark contains the prominently sized and arbitrary design of a moose. This design contributes greatly to the visual impression of applicant's mark. This is not a case in which the design portion of applicant's mark is an easily overlooked geometric carrier or an abstract pattern that is much smaller in size than the wording. We observe that in registrant's mark the term HERITAGE is the first and most prominent portion thereof. However, in applicant's mark, the term HERITAGE is located below the prominent moose design, which is equal in size to the wording HERITAGE COLLECTION and appears to be arbitrary as applied to the goods. Even if consumers did not recognize the design as a moose per se, they nonetheless would be likely to recognize it as the design of an animal with a large rack of antlers. Thus, when viewed as a whole, applicant's mark is notably dissimilar from that of registrant in appearance.

*In re Fairview*, TTAB LEXIS 447 at 9-12. The Board further explained that even though the marks shared the first term “Heritage”, which has similar connotations as applied to identical goods, the sole fact that the mark contained a highly distinctive “moose” design was sufficient to obviate a likelihood of confusion:

[T]he wording HERITAGE COLLECTION and HERITAGE 1981 are likely to have similar connotations as applied to identical or otherwise related goods. However, the arbitrary moose design does not appear to have any meaning or connotation as applied thereto, and thus creates an arbitrary and noticeable addition to the connotation engendered by applicant's mark. Taken as a whole, the marks thus are different in connotation and commercial impression.

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks favors applicant. Moreover, we find this factor is determinative and, despite the in-part identity of the goods, we conclude that the marks are sufficiently dissimilar that confusion is not likely between applicant's mark and the mark in the cited registration.

*Id.* at 11-12.

The Board more recently held *again* that **design elements may be dominant and must be considered**. In a precedential decision, the Board reversed a refusal of REDNECK RACEGIRL (& Design) for clothing in class 25, depicted as follows:



finding no likelihood of confusion with the mark RACEGIRL in standard characters for similar clothing in class 25. *In re Covalinski*, 113 USPQ 2d 1166 (TTAB 2014). The Board found “crucial differences” between the marks, including that the graphic elements of the applied-for mark “serve not only to draw attention to the RR letters apart from the wording, but also make the letters that for the 'a-c-e' of the word 'RACEGIRL' difficult to notice.” *Id.* at 5. The Board cited several prior decisions in which the design was deemed dominant.

Applying these principals in the present case, Applicant’s Mark and the Cited Mark must be considered in their **entireties**, including the distinctive “lightning bolt” design in the Cited Mark, as well as the additional wording in the Cited Mark. When the marks are properly considered in their entireties, the marks are very different in appearance, sound, meaning, and commercial impression.

Specifically, the marks are different in their appearance owing to the inclusion of the “lightning bolt” design in the Cited Mark, which does not appear in Applicant’s mark. Like the “moose” design in Fairview, **the “lightning bolt” design is a prominent design feature of the Cited Mark and thus “contributes greatly” to the overall visual impression of the mark.** *Fairview, supra, at 9.* Thus, the marks are completely different for at least the reason that the Cited Mark contains a “lightning bolt” design which is not present in Applicant’s Mark. Furthermore, the Cited Mark includes the first and dominant portion “P FOR”, which does not appear in Applicant’s Mark. As the first portion of the mark, “P FOR” should be afforded more weight in the likelihood of confusion analysis. Consumers encountering **P FOR** PIX will therefore distinguish the marks based on the first and dominant term **P FOR**, which is not present in Applicant’s Mark. Finally, the Cited Mark P FOR PIX displays the mark in a highly stylized script font, which does not appear in Applicant’s Mark. The inclusion of the prominent “lightning bolt” design, the first and dominant wording “P FOR”, and the stylization of the Cited Mark completely change the marks in appearance.

Second, the marks are completely different in sound. Specifically, the Cited Mark includes the first and dominant wording “P FOR,” which will naturally be pronounced by consumers when calling for the mark aloud. The additional wording in the Cited Mark results in three (3) syllables when the mark is called for aloud. In contrast, Applicant’s Mark consists solely of the term PIX, which results in only one (1) syllable when called for aloud. The marks are therefore significantly different in sound.

Furthermore, the meaning and commercial impression of the marks are completely different. Specifically, the Cited Mark gives the commercial impression that the registrant’s goods are meant for photographers. This is especially so given the wording “FOR PIX” in the Cited Mark as well as the “camera bags” listed in the goods identifiers in Class 9. In contrast, Applicant’s Mark impresses upon consumers that Applicant’s backpacks may be used to display pixelated images. Accordingly, the marks are not similar in appearance, sound, meaning, or overall commercial impression, thus weighing heavily against a finding of likelihood of confusion.

## **II. APPLICANT’S MARK IS NOT MERELY DESCRIPTIVE**

The Examining Attorney found that “‘PIX’ means ‘pictures,’” and that “this wording immediately describes that the applicant’s goods will feature pictures or images”. Thus, the

Examining Attorney argues, PIX "merely describes the applicant's goods." Applicant respectfully disagrees.

### **1. PIX Does Not Mean "Pictures"**

PIX does not merely describe Applicant's goods because "PIX" does not mean "pictures" to the relevant consumers.

The Trademark Trial and Appeal Board has held that the test for descriptiveness is "whether a term 'immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.'" *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003); *see also In re Grand Forest Holdings Inc.*, 78 U.S.P.Q.2d 1152 (T.T.A.B. 2006). Moreover, if the Examining Attorney refuses registration on descriptiveness grounds, he or she should support the refusal with appropriate evidence. TMEP 1209.02.

The Examining Attorney submitted evidence taken from the Macmillan Dictionary showing that one possible definition of "PIX" is "pictures". However, the abbreviated term PIX can have a variety of meanings, including Cisco's "Private Internet Exchange," "Product Information Exchange," "Parcel International Express," and as an abbreviation for "pixels." *See* Exhibit A. These alternative and well-known definitions for "PIX" clearly show that consumers do not immediately think of "pictures" when they see or hear the term "PIX". *See In re MBNA Am. Bank*, 340 F.3d at 1332. In addition, Applicant respectfully reminds the Examining Attorney that all doubts as to descriptiveness should be resolved in favor of the applicant. *In re Grand Forest*, 78 U.S.P.Q.2d 1152. Accordingly, PIX does not merely mean "pictures", and thus does not merely describe Applicant's goods.

### **2. Applicant's Mark is Suggestive and Not Merely Descriptive**

Applicant submits that PIX is not a descriptive mark. Rather, it is a suggestive mark as it relates to Applicant's goods.

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about

the goods or services. *See In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

Here, PIX does not immediately convey any information about the nature of Applicant's goods because Applicant's goods are "backpacks", not "pix" or "pictures". Nor does the term "PIX" *immediately* tell consumers which product they are purchasing. Instead, consumers must imagine that "PIX" refers to a pixels or pictures; and that Applicant's goods may be used to display pixelated images because Applicant's goods have a display screen. Consumers must make this "mental leap" to understand the nature of Applicant's goods. Thus, PIX is a suggestive mark when used in connection with "backpacks".

Finally, Applicant respectfully reminds the Examining Attorney that any reasonable doubt in determining whether an applied-for mark should be classified as descriptive or suggestive is to be resolved "in favor of the Applicant, in accordance with practice and precedent." *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

### **III. CONCLUSION**

Based on the foregoing, Applicant respectfully submits that there is no likelihood of confusion among Applicant's Mark and the Cited Mark. Furthermore, Applicant respectfully submits that Applicant's Mark is not merely descriptive. Thus, Applicant respectfully requests that the Section 2(d) and Section 2(e)(1) refusals be withdrawn and that Applicant's Mark be published for opposition.