

REMARKS

On November 6, 2019, the United States Patent and Trademark Office (the “Office”) issued an Office Action refusing registration of Applicant’s TORIN mark for “footwear” in Class 25 (U.S. Ser. No. 88291397) (the “Application”) under Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d). This refusal was based on a likelihood of confusion between Applicant’s TORIN mark and the previously registered trademark TORAIN (stylized), owned by Toray International, Inc. (the “Registrant”), for “clothing, namely, jackets, pants, sports jackets, sports pants, waterproof jackets and pants, wind resistant jackets and pants” in Class 25 (Reg. No. 5830954) (the “Registration”). Applicant hereby respectfully submits that consumer confusion is unlikely given the distinct connotations of Registrant’s trademark and the lack of overlap in identified goods.

Section 2(d) Refusal

A determination of likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1502(d), is made on a case-by-case basis using the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A.). *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085 (Fed. Cir. 2000)). Marks are compared in their entireties in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321 (Fed. Cir. 2014) (quoting *Palm bay Imps., Inc. v. Vueve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005)); TMEP § 1207.01(b)-(b)(v).

Connotation is particularly relevant in this case. Even where there are visual and aural similarities between marks, those marks may still be differentiated by their respective connotations in relation to the relevant goods and services. TMEP § 1207.01(b)(v); *see, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987). When determining the connotation of trademarks, “the focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of the trademarks.” TMEP § 1207.01(b)(v); *see also In re Bay State Brewing Co.* 117 USPQ2d 1958, 1960 (TTAB 2016).

Further, additional matter in a likelihood of confusion analysis “may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii); *see also Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011) (finding no likelihood of confusion between CAPITAL CITY BANK and CITIBANK based partially on the fact that “CITY BANK” is commonly used in the banking industry and the CAPITAL element of the applicant’s mark gave the mark a distinct geographic connotation); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (finding no likelihood of confusion between CATFISH BOBBERS (“CATFISH” disclaimed) for fish and BOBBER for restaurant services due to different connotations in relation to the respective goods and services).

The Marks’ Respective Connotations Create Distinct Commercial Impressions

The Examining Attorney concluded that there is a likelihood of confusion between Applicant’s TORIN mark and the previously-registered TORAIN (stylized) mark because the two marks “are nearly identical in spelling, but for the deletion of the letter ‘P’ from the registrant’s mark” and because Applicant’s mark, as a standard character mark, could be presented in any form including in the same manner as Registrant’s TORAIN (stylized) mark.

The alleged aural similarity of the literal elements of both marks and the mere potential for visual similarity, however, are not necessarily enough to show a likelihood of confusion if the marks—in their entireties and as applied to the relevant goods—create distinct commercial impressions. In this case, the connotation of Registrant’s TORAIN (stylized) mark is so evident as to create a commercial impression entirely distinct from Applicant’s TORIN mark.

Applicant's and Registrant's marks must be evaluated *as a whole* for the purposes of a likelihood of confusion analysis, which means that the connotation, or lack thereof, of both marks must be considered in order to adequately compare them. If an average consumer would retain a general impression of the TORIN mark that is distinct from that same consumer's general impression of the TORAIN (stylized) mark, then there can be no likelihood of confusion. TMEP § 1207.01(b)(v); *see also In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987); *In re Bay State Brewing Co.* 117 USPQ2d 1958, 1960 (TTAB 2016).

In this case, consumers are likely to associate Registrant's TORAIN (stylized) mark with a specific connotation, especially when considering the stylization of the mark and the particular goods identified in the Registration. It is unlikely, however, that consumers would perceive Applicant's TORIN mark as having the same connotation as Registrant's TORAIN (stylized) mark, if they would assign any specific connotation to the TORIN mark at all.

To begin, Registrant's TORAIN (stylized) mark presents the literal element of the mark in a simple, sans serif font, but the "O" of this literal element is replaced by the recognized symbol for a hurricane. This presentation does two things. First, the symbol immediately calls consumers to think of hurricanes and connections to storms, wind, and rain. Second, the symbol creates a visual barrier in the mark and accentuates the more obvious literal element: "RAIN." Consumers encountering Registrant's mark are thus likely to mentally separate the mark into distinct parts and perceive it as "TO RAIN" rather than "TORAIN," which strengthens its association with hurricanes, rain, or water generally. This association is further reinforced by the fact that the registration specifically identifies, among various apparel products, "waterproof jackets and pants" and "wind resistant jackets and pants," again calling consumers' attention to the storm, hurricane, or rain connotation of Registrant's mark.

Applicant's TORIN mark, on the other hand, does not have any clear connotation onto which consumers can immediately grasp. The word TORIN is completely arbitrary in connection with footwear, meaning that consumers are unlikely to attach any specific meaning to the mark at all, other than as a source identifier for Applicant's goods. Further, even if consumers attach some connotation to TORIN in connection with footwear, it is highly unlikely that they would perceive Applicant's TORIN mark as having the same water or rain connotation that is so readily apparent in Registrant's TORAIN (stylized) mark.

Besides the distinct connotations of both marks, the Application and Registration identify discrete goods. There is no direct overlap between the "footwear" identified in the Application and the "clothing, namely, jackets, pants, sports jackets, sports pants, waterproof jackets and pants, wind resistant jackets and pants" identified in the Registration. While the Examining Attorney may consider these goods to be related, this is not necessarily dispositive of a likelihood of confusion. Even if the goods are related, consumers would still likely perceive the lack of direct overlap of goods, when coupled with the distinct connotation of Registrant's mark discussed above, as a further distinguishing characteristic between the marks.

When considering the relevant marks in their entireties, consumers will likely distinguish between TORIN and TORAIN (stylized) based both on the highly distinctive connotation presented by Registrant's TORAIN (stylized) mark that is not shared by Applicant's TORIN mark and on the lack of direct overlap between the goods identified in the Application and the Registration. The overall commercial impressions created by each mark, therefore, are likely distinctive enough to overcome any alleged aural or visual similarities between the literal elements of the marks.

CONCLUSION

As demonstrated by the foregoing arguments, the differences between the parties' marks obviates any likelihood of confusion. Applicant therefore respectfully requests that the Office withdraw the refusal and allow the Application to proceed to publication.