

App. No. 88521477


Mark ROFFIE

Section 2d Partial Refusal

The Examining Attorney has initially partial refused registration in light of U.S. Registration Nos. 5483283 (ROPHIE and Design) and 5719691 (RF ROFI and Design). For the following reasons, the position of the Examining Attorney is respectfully traversed.

Applicant's initial argument is that the cited Registrations are owned by different entities. If the cited marks are able to coexist, Applicant's mark is also entitled to coexist without any likelihood of confusion in the marketplace. Just as RF ROFI and Design was allowed to register over ROPHIE and Design for more closely related goods than those of Applicant, so to ROFFIE should be allowed to register over the two cited Registrations.

As the Examining Attorney is aware, merely altering, adding, or eliminating even a single letter can create a different commercial impression for prospective customers. See, e.g., *Nestle Co. v. Nash-Finch Co.*, 4 U.S.P.Q.2d 1085 (T.T.A.B. 1987) (DELIQUICK creates a different commercial impression from NESTLE QUICK and QUICK); *Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F. Supp. 1244, 216 U.S.P.Q. 770 (D.N.J. 1982) (CREAM OF WHEAT was found not to be confusingly similar to CREAMY WHEAT even though both marks are used for breakfast cereals); and *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 U.S.P.Q. 641 (C.C.A.P. 1982) (BOSTON SEA PARTY was found not to be confusingly similar to BOSTON TEA PARTY). In the present case, Applicant's mark is ROFFIE in standard

characters. The mark of Registration No. 5483283 is  and the



mark of Registration No. 5719691 is . The mere fact that the pertinent marks are pronounced the same way does not make the marks confusingly similar. Registrants' marks overall commercial impressions and appearances are highly distinctive. Specifically, Registrants'

Rophie

marks consist of a the word "ROPHIE" with an eyeball in the hollowed capital letter "R" and a horizontal line under the whole word starting from the bottom



right of the letter "R;" and the mark consist of letters "RF" stylized with the "F" formed by shape of the negative space within the outline of the "R", and the term "ROFI" in stylized font against a shaded background, respectively, both combined in such a manner as to create unitary impressions. The designs of these marks are so distinctive that they are equally dominant to the wording. This greatly diminishes the potential for confusion in the marketplace. Hence, each of the pertinent marks has unique and unitary expressions which differ significantly from each other in this matter, making confusion improbable.

As noted in TMEP §1207.01(c)(ii), "The Court of Appeals for the Federal Circuit has cautioned, however, 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 Labs. Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

As stated in *Juice Generation, Inc. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015), a mark should not be dissected and considered piecemeal. It must be considered as a whole in determining likelihood of confusion. That does not preclude consideration of components of a mark. It merely requires heeding the common-sense fact that the message of a whole phrase may well not be adequately captured by a dissection and recombination. *Supra*, at p. 11. (TTAB's finding of a likelihood of confusion between PEACE LOVE AND JUICE & Design and PEACE & LOVE reversed and remanded for failure to consider the marks as a whole).

The applicable standard for determining whether there is a likelihood of confusion between trademarks is whether an appreciable number of reasonable buyers are likely to be confused as to source or sponsorship of the goods of the respective parties. The mere possibility that relevant consumers might relate the two marks does not meet the standard. *In re Hughes Aircraft Company*, 222 USPQ 263, 264 (TTAB 1984) ("the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source or origin, only where such confusion is likely," that is, probable).

When the pertinent marks are compared in their entireties, Registrants' marks are clearly different than Applicant's mark. When comparing marks, the Court of Appeals for the Federal Circuit has stated, "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). The Office Action does not give enough weight to the mark as a whole and it is clear that the overall commercial impressions of the marks are completely different.

Although the Federal Circuit has held that a single *du Pont* factor may be dispositive in any particular case. *Kellogg Co., v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). This is an instance in which the dissimilarities in the respective marks should be dominant and controlling.

The Office Action states that "one feature of a mark may be more significant or dominant in creating a commercial impression." The similarity or dissimilarity of the pertinent marks

should be considered in their entirety, not only by focusing only on a few components of the marks, *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 USPQ2d 1351, 1353 (Fed. Cir. 2000). (court held that the board erred in analyzing the similarity or dissimilarity of the marks by focusing only on the “Packard” component of the marks, without considering both marks in their entirety). Here, the overall commercial impression and appearance of the pertinent marks are quite different.

Further, the Office Action states that “the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers.” Yet here the visual element, i.e. the commercial impression and appearance of the marks are different with differing commercial impressions. Further the mere possibility of confusion is not enough. The Federal Circuit has stated that more than a mere possibility of confusion must be shown; instead it must be demonstrated that there is a probability of likelihood of confusion. *See Witco Chemical Co. v. Whitfield Chemical Co.*, 164 USPQ 43, 44-45 (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 the trademark law deals.”); *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). In this case, Applicant’s mark is not likely to be confused with Registrants’ mark due the differences in the marks when viewed in their entirety.

The marks must be considered in the way they are used and perceived. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed.Cir.1985). Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Here, the marks are so distinctive that each design is equally dominant to the wordings, making likelihood of confusion improbable.

As is evident from the substitute specimen submitted herewith, Applicant’s Class 9 and Class 21 goods pertain to remote pet care when the owner is away. None of the goods of the prior Registrants is for a similar purpose. Thus, the respective goods are non-competitive, unrelated and incompatible. . The non-competitive nature of goods and service is a relevant factor in all cases. *Curtis-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 189 USPQ 138 (CCPA 1976). It is highly unlikely that they would be encountered by the same purchasers in the

marketplace. Thus, there is no probability that confusion, mistake or deception as to source would arise.

The Examining Attorney's attention is directed to the following third party Registrations for similar goods in International Class 9:

Mark	Reg. No./Reg. Date	Goods/Services	Owner(s)
ROFIN & Design	3728547 Dec. 22, 2009	laser beam sources and laser systems, not for medical use, comprised of a laser head, a power supply, beam guiding optics and scanner optics, optical beam shaping and focusing optics, and a work-piece holder for materials processing with a laser beam; lasers, not for medical use, namely, CO2 gas lasers, solid-state lasers, and diode lasers; laser beam sources and laser systems, not for medical use, comprised of a laser head, a power supply, beam guiding optics, optical beam shaping and focusing optics, and workpiece holder for processing materials with a laser beam; laser beam sources and laser systems, not for medical use, comprised of a laser head, a power supply, beam guiding optics and scanner optics, optical beam shaping and focusing optics, and a work-piece holder for microprocessing materials and for structuring materials; laser beam welding devices for	Rofin-Sinar Laser GmbH

		material welding; laser beam cutting	
ROFIN	2857282 Jun. 29, 2004	Lasers not for medical use; CO2 gas lasers; solid state lasers; diode lasers; laser beam sources and laser systems comprised of a laser beam source, a power supply, an optical beam delivery system, an optical beam shaping and focusing unit, and a work-piece holding/manipulation unit for machining materials with a laser beam; laser beam sources and laser beam systems comprised of a laser beam source, a power supply, an optical beam delivery system, an optical beam shaping and focusing unit, and a work-piece holding/manipulation unit for surface treatment with a laser beam; laser beam sources and laser systems comprised of a laser beam source, a power supply, an optical beam delivery system, an optical beam shaping and focusing unit, and a work-piece holding/manipulation unit for curing surfaces; laser beam perforating units; laser writing and marking systems comprised of a laser beam source, a power supply, an optical beam delivery system, and an optical beam shaping and focusing unit; and parts for lasers	Rofin-Sinar Laser GmbH
ROSI	4598990 Sep. 02, 2014	Computer application software for desktop computers, mobile phones	ADVANSIX RESINS & CHEMICALS LLC

		and handheld computers, namely, software for assisting in improving agricultural crop yield	
ROVI	5460681 May 01, 2018	Vehicle safety equipment, namely, an on-board vehicular surveillance system comprised of cameras and monitors for exposing and eliminating blind spots on the sides of the vehicle	Pilot Inc.

The TSDR datasheet for these records are attached in the evidence section of the Response.

Certainly if the cited marks may also coexist with the noted marks for related goods in International Class 9, then Applicant's mark is likewise entitled to coexist without any likelihood of confusion. Under these circumstances, the potential for confusion in the marketplace is highly improbable.

For all of the foregoing reasons, Applicant respectfully requests that the citations be withdrawn and that the application be approved for publication.