

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of: Guangzhou Chixiang)	Mark Type: Trademark
Car Accessories Co., Ltd.)	
)	Examiner: Mildred Black
U.S. Application Serial No: 88485374)	
)	Register: Principal
Application Filing Date: Jun. 24, 2019)	
)	Docket No.: 60-1107-TUS
MARK: BEE		

Response to Office action for Trademark Application

Honorable Sir:

This is a response to the Notice of office action query mailed for this application on **September 23, 2019**.

REMARKS

In response to the non-final Office action for Trademark Application UNDER Trademark Act Sections 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03. Applicant is addressing the following ISSUES:

- Section 2(d) Refusal – Likelihood Of Confusion
- Amendment to the Identification of Goods
- U.S. Counsel Required

Refusal - Section 2(d) – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5780574 & 4601343. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to registered mark that it is likely that consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d).

With reference to the examining attorney's contention that the cited application resembles the applied for trademark having U.S. Application Serial No. 88485374 (hereinafter "Applied for Mark"), the applicant respectfully submits that the cited U.S. registered trademark Nos. 5780574 & 4601343 (hereinafter "Cited Marks") are both visually, structurally and phonetically different from the applied for mark. A brief comparison of visual aspects has been presented in the following table:

U.S. Applied Application No. 88485374 BEE	U.S. Cited Registration No. 5780574 TECHBEE
	U.S. Cited Registration No. 4601343 BEELITE

It is submitted that the Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*,

476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We have to consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). It is submitted that the marks should be compared in its entirety and "dissection" of the marks must be avoided in reaching our ultimate conclusion. However, there is nothing improper in giving more or less weight to a particular feature of a mark, for rational reasons. In re *National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When compared phonetically, the cited marks and applied mark are similar in that each includes the syllable 'BEE' in different formation with other words. However, Applicant's mark differs from the registered marks in appearance and sound when compared in its entirety. Applicant emphasizes that the position of 'BEE' as a single word gives it additional weight and distinctiveness when compared with the cited mark. It is most unlikely that consumer will get confused due to existence of syllable 'BEE'.

In the present case there is hardly any likelihood of confusion as the marks contain different set of letters and combination of words, even though there is some overlap on the Goods/Services. Moreover, the courts have consistently found that the mere presence of an identical term within two marks does not necessarily create a likelihood of confusion. For example, the marks **ROMAN** and **ROMANBURGER** were found not to be confusingly similar when each used on food products, even though both marks contained an identical term, and even though the entirety of the mark ROMAN is found within the mark ROMANBURGER. *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 782 F.2d 884 (Fed. Cir. 1986).

Anti-Dissection Rule

It is submitted that the doctrine of anti-dissection rule prescribes that “a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:27 (4th ed. 2003); *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000) (“[I]t is the mark in its entirety that must be considered—not simply individual elements of that mark.”). Hence, the cited mark cannot be considered as conflicting mark upon comparing the visual, phonetic and structural aspects of the applied mark with the cited marks, the proposed mark when compared as a whole is very distinct. Thus, there is not an iota of confusion or any similarity in the marks cited in the office action. In view of above, it is respectfully submitted that though initial word of both the marks are similar however, when compared both the marks as a whole both the marks have acquired distinctiveness on consideration of structural, visual and phonetic aspects of the marks.

Furthermore, the marks IVY LEAGUE and IVY HALL were held not to be confusingly similar when used for clothing and neckties, respectively. *House of Worsted-Tex, Inc. v. Superba Cravats, Inc.*, 284 F.2d 528 (C.C.P.A. 1960). The marks LAWN-BOY and LAWN PUP were held not to be confusingly similar when each were used for lawnmowers. *Toro Co. v. GrassMasters Inc.*, 66 U.S.P.Q.2d 1032 (T.T.A.B. 2003). In each of the above-cited cases, the marks in question contained identical portions, and/or the entirety of one mark was found within the second mark. In above-cited case, the mark was found not to be confusingly similar, even for use on identical or overlapping goods. Nonetheless, Applicant's applied for mark "BEE" is not even closely identical to the cited Registrations for the mark simply because marks contains different set of characters in different sets of words.

Applicant's applied for mark has a visual appearance and pronunciation that is significantly different than the cited marks. Potential customers seeing, reading, hearing or saying aloud the both the marks would immediately perceive significant differences in the marks. Accordingly, the marks are not likely to be confused simply because each contains some common letters.

Accordingly, absent an additional showing, the marks are not likely to be confused due to the differences in the recited goods, the visual and phonetic differences between the marks, and the differences in the commercial impression that Applied for Mark and Cited registrations clearly convey.

Applicant submits that the marks applied for mark and cited registrations are not confusingly similar under Section 2(d) of the Trademark Act.

Furthermore, the records of the Patent and Trademark Office demonstrate that many entities have used 'BEE' in combination of other words, making it

unlikely that consumers would give significant weight to this term in ascertaining the source of such goods. As reflected in the Trademark Electronic Search System, the Trademark Office has routinely registered marks containing "BEE" as one of the terms. Examples of this practice are set forth in the following table:

S. No.	Registration	Application No.	Trademark
1	88590811	6013493	SNUGGLE BEE
2	88578777	6012945	BAILEYBEE
3	88552760	6012532	DANCING BEES
4	88516260	6012219	FATTY BEE
5	88424290	6011745	BEE KIWI
6	88309712	6011160	BELLA-BEE
7	88299476	6014891	BEENICE
8	88466254	6005764	BEEGREENY
9	88370919	6005480	VIKIBEE
10	88346217	6009417	BEES FOR HOPE
11	88298580	6009310	JOYBEES
12	88663266	6008051	BEE BEE QUE
13	88595576	6007925	SWADDLE BEE
14	88572239	6002145	BEE!
15	88565844	6001611	CHAINBEE
16	88562914	6001422	PROBEE
17	88553817	6001018	KEEP THE BEES
18	88430281	6004115	LUCKYBEEBO
19	88565854	5997001	CHAINBEE
20	88558139	5996213	KEYBEE
21	88477948	5998879	MAY B. MORELIGHT
22	88560630	5991155	BEENUT
23	88558330	5991009	BEENUT
24	88556584	5990904	SHINEBEE
25	88556559	5990895	BEE NESTING
26	88554652	5990717	BEAUTYBEEZ
27	88551207	5990285	BEELEAF
28	88549248	5990141	BEEGIFT
29	88547901	5989911	DODOBEE
30	88546314	5989790	LONG LIVE THE BEE
31	88537710	5989224	BEEBIRTH

As can be seen from the illustrative registrations above, use of the word "BEE" in conjunction with other words is quite common. As a result of being exposed to numerous marks containing BEE, relevant consumers are likely to consider the entire mark in ascertaining the source of the goods, and to differentiate goods and services using the entire mark.

Strength of the Cited Marks

In comparing Applicant's mark with previously registered marks or pending applications, one factor that must be considered is the impact of prior registrations on the strength of the registered marks. TMEP § 1207.01 ("In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: . . .6. The number and nature of similar marks in use on similar goods.")

In light of the foregoing evidence that many entities have used 'BEE' based marks in connection with multiple goods, it would be disingenuous to claim that the cited registration are strong marks. Indeed, the mere fact that the Examining Attorney was able to cite a registered mark which is a clear indication of the lack of strength of the mark. "[I]n a 'crowded' field of similar marks, each member of the crowd, is relatively 'weak' in its ability to prevent use by others in the crowd." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 11:85 at 11-163 (4th Ed. 2001). Accordingly, the cited mark in combination of word "BEE" registrations should be given a narrow scope of protection, in light of their coexistence, barring registration of only virtually identical marks.

Visual Impression

Applicant's mark is drastically different in its visual appearance from the marks cited by the Examining Attorney. Because the marks must be considered in their entirety, the term BEE creates a markedly different visual appearance from cited marks. Cited marks are not similar sounding due to different formations with other words and in different sets of words. This makes consumer confusion highly unlikely.

Aural Impression

Spoken aloud, 'BEE' does not sound similar to cited marks. Due to the lack of aural similarity between the cited marks and Applicant's mark, there is no likelihood of confusion among consumers who hear the cited mark and Applicant's marks.

AMENDMENT IN DESCRIPTION OF GOODS

It is respectfully submitted that the applicant request to delete the below mentioned words from the description of goods. Accordingly, strike out words may kindly be deleted from the application:

"Automotive lighting headlights for vehicles; Floor lamps; Headlights for automobile; Headlights for vehicles; LED flashlights; LED lamps; LED light bulbs; LED light strips for decorative purposes; LED safety lamps; LED and HID light fixtures; Light bars for vehicles, namely, ~~HONDA, FORD, BUICK, Volkswagen, Toyota~~; Spot lights; Spot lights for use on vehicles; Strip lighting for indoor use; Tail lights for vehicles; Vehicle brake lights; Vehicle dynamo lamps; Vehicle turn-signal light bulbs" in International Class 11.

Accordingly, the revised and amended description of goods should be:

“Automotive lighting headlights for vehicles; Floor lamps; Headlights for automobile; Headlights for vehicles; LED flashlights; LED lamps; LED light bulbs; LED light strips for decorative purposes; LED safety lamps; LED and HID light fixtures; Light bars for vehicles, namely, automatic guided vehicles; Spot lights; Spot lights for use on vehicles; Strip lighting for indoor use; Tail lights for vehicles; Vehicle brake lights; Vehicle dynamo lamps; Vehicle turn-signal light bulbs” in International Class 11.

Requirement – U.S. Counsel Necessary

To this requirement, the undersigned hereby confirms to represent the applicant.

Regarding Payment for This Response

It is not believed that additional fees are required. However, in the event that additional fees are necessary to allow consideration of this paper, the applicant requests to kindly intimate the applicant regarding the same.

Favorable reconsideration and allowance of the present application is hereby courteously requested. Should there be any questions with regard to this response, please contact the undersigned at the email provided below.

Respectfully submitted,

/Wayne V. Harper/

Wayne V. Harper

Attorney of record, Florida Bar member

E: tm@kafiling.com

Date: 03/20/2020