

## ARGUMENT

The Examining Attorney has refused registration of the applicant's trademark application for SUNNYSIDE\* (U.S. Serial No. 88/500,271), under Section 2(d) of the Trademark Act of 1946, citing a likelihood of confusion with the registration in U.S. Reg. No. 4,749,007. The applicant respectfully disagrees for the following reasons.

**(I) The applicant's SUNNYSIDE\* mark has a unique connotation and commercial impression.**

When comparing the applicant's SUNNYSIDE\* mark for promotional t-shirts, hoodies and hats to the registrant's SUNNYSIDE UP THREADS mark for clothing, namely, t-shirts, shirts, blouses, sweaters, sweatshirts, tops, bottoms, pants, shorts, jeans, skirts, dresses, jackets, blazers, coats, loungewear, footwear, socks, undergarments, headwear, scarves, and gloves sold in department stores, 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 the 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) (Internal citation omitted). The similarity or dissimilarity of the marks is determined based on the marks in their entirety, and the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re. Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 223, 224 (CCPA 1981) (It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion).

Although the cited mark SUNNYSIDE UP THREADS and the present application for SUNNYSIDE\* include one of the same word elements, the overall appearance, pronunciation, and meanings of the two marks are different. Where “sunnyside” is a **noun** generally referring to the side exposed to the sun’s rays, or the favorable optimistic aspect, “sunnyside up” is an **adjective** describing an egg, fried on one side only (see attached Merriam-Webster dictionary excerpt). The difference between the noun and adjective meanings of the marks create unique connotations and commercial impressions, and consumers are not likely to confuse the source of one such mark for the other.

**(II) The channels of trade for the respective parties’ goods are different and would never overlap.**

Here, although the cited registrant is a clothing company that may have sold goods through department stores (see attached description), no active listings were found for SUNNYSIDE UP THREADS goods at any brick and mortar department store. Instead, SUNNYSIDE UP THREADS merchandise appears to be The applicant, on the other hand, seeks to protect its mark on promotional merchandise to be sold together with its other products, at its own online or brick and mortar stores. The applicant would never sell its main line of products in a department or general goods store, and therefore would also never sell its ancillary promotional clothing products in any department or general goods store. The parties’ respective goods and services travel in completely different channels of trade, and the likelihood that those channels of trade would overlap in the future is virtually nonexistent. As such, the cited SUNNYSIDE UP THREADS registration should not serve as a bar to the present application and the applicant respectfully requests that the refusal based on this cited registration be withdrawn.

## **Conclusion**

In conclusion, the burden is on the Examining Attorney to establish the cited grounds for refusal. *In re Nantucket, Inc.* 213 USPQ 889 (C.C.P.A. 1982), *In re Standard Elektrik Lorenz Aktiengesellschaft*, 152 USPQ 563 (C.C.P.A. 1967). For the reasons set forth above, the applicant respectfully submits that the Examining Attorney's burden has not been met. The applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal and approve the present application for publication in its entirety.