

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
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Applicant:	Zhong, Jing)
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Serial No.:	88487015)
)
Mark:	AUDACE)
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)
Filed:	June 24, 2019)
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Int'l Classes:	003)
)
Our File No.	2019-01005)

RESPONSE TO OFFICE ACTION NO. 1

Applicant Zhong, Jing (“Applicant”) responds to the Office Action No. 1 mailed on October 17, 2019 as follows:

I. REFUSAL TO REGISTER BASED ON LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration of Applicant’s AUDACE mark (“Applicant’s Mark”) for “Cosmetics, Facial beauty masks, Face creams for cosmetic use, Facial lotion, Facial washes, Skin softeners, Wrinkle removing skin care preparations, Make-up, Cologne, Facial concealer, Shampoo-conditioners, Perfume oils, SPF sun block sprays, Cosmetic preparations, Cosmetic preparations for slimming purposes, Eye-shadow, Spot remover, Facial cleansing milk; False eyelashes, Massage oil, Nutritional oils for cosmetic purposes, Skin masks, Cosmetic oils, Cosmetic creams for skin care, Skin whitening preparations, Cosmetic preparations for skin care, Non-medicated skin care creams and lotions, Skin care preparation, namely, body polish” under International Class 003, Application Serial No. 88487015 (“Application”) under Section 2(d) of

the Trademark Act, 15 U.S.C. §1052(d), on the grounds that Applicant's Mark is likely to be confused with U.S. Trademark Registration Nos. 5842732 and 4933307 for AUDACE and AUDACIOUS, respectively ("Cited Registrations").

For the reasons set below, Applicant respectfully traverses this objection and believes that its mark, and the goods and services thereunder, are distinguishable from the Cited Registration, and its goods, and that there is no likelihood of confusion between the marks of the parties. Accordingly, Applicant respectfully submits that the Application should be allowed to proceed to publication.

II. THERE IS NO LIKELIHOOD OF CONFUSION

There is no likelihood of confusion because of the distinct nature of the goods, channels of trade, the number of similar marks in use, the sophistication of potential purchasers, and the dissimilarity of the marks when comparing the Applicant's Mark and the Cited Registrations. In order for the Examining Attorney to find a likelihood of confusion, the respective goods and services covered by the marks, and not just the marks themselves, must be considered. *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 U.S.P.Q. 639, 641 (TTAB 1977). The Examining Attorney must look at the covered goods and services to determine whether a relationship exists which would likely result in confusion about the origin. *In re August Storck KG*, 218 U.S.P.Q. 823, 825 (TTAB 1983). In determining whether a likelihood of confusion is present the Examiner must consider the factors outlined under the ruling in *In re E.J. du Pont, de Nemours & Co.* 476 F.2d 1357, 1362 (C.C.P.A. 1973). These factors include the similarity of the marks, the similarity of the nature of goods or services, the similarity of the trade channels in use, the sophistication of purchasers, the fame of the prior mark, the number and nature of similar marks, the nature and extent of actual confusion, the length of time of concurrent use without evidence of

actual confusion, the variety of goods on which the mark is on, the market interface between the applicant and the prior mark, the extent of which applicant has a right to exclude other from use of its mark, and the extent of potential confusion. *Id.*

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Assuming, arguendo, that the Cited Registrations and the Applicant's mark contain similar components, that fact alone is not dispositive as to likelihood of confusion. Applicant's Mark has been in use concurrently with Registration No. 5842732 for 1.5 years and with Registration No. 4933307 for 3 years with no evidence of actual confusion. In analyzing the remaining factors, we find no likelihood of confusion.

APPLICANT'S PRODUCTS ARE DISTINCT WHEN COMPARED TO THE PRODUCTS OF
THE CITED REGISTRATIONS

The types of products covered by the Application and the Cited Registrations are appreciably distinct. The court will look at whether the marks suggest that different goods and services may emanate from a single source. It has been found that where a product is so related to another as to form an integral relationship, the products cannot be considered distinct. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The mere fact that two products may be found in the same large store is not sufficient to establish that the products are related. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). The Board has held products within the same international class can be held as distinct. *In re Gelati Int'l, Inc.*, S.N. 75/179,289 (October 6, 2000).

It is evident that there exists a difference between Applicant's products and those covered by the Cited Registrations. Applicant's products include "Cosmetics, Facial beauty masks, Face creams for cosmetic use, Facial lotion, Facial washes, Skin softeners, Wrinkle removing skin care preparations, Make-up, Cologne, Facial concealer, Shampoo-conditioners, Perfume oils, SPF sun block sprays, Cosmetic preparations, Cosmetic preparations for slimming purposes, Eye-shadow, Spot remover, Facial cleansing milk; False eyelashes, Massage oil, Nutritional oils for cosmetic purposes, Skin masks, Cosmetic oils, Cosmetic creams for skin care, Skin whitening preparations, Cosmetic preparations for skin care, Non-medicated skin care creams and lotions, Skin care preparation, namely, body polish" The Cited Registrations cover the following products:

1. Registration No. 5842732 (AUDACE) ("Cited Registration 1"): "Crimping irons; Curling tongs; Electric hair clippers; Electric hair curling irons; Electric irons for styling hair; Electric shavers; Eyelash curlers; Fingernail clippers; Flatware, namely, forks, knives, and spoons; Gardening shears and scissors; Gardening trowels; Hand tools, namely, pincers; Manicure sets, electric" in International Class 008.
2. Registration No. 4933307 (AUDACIOUS) ("Cited Registration 2"): "COSMETICS, NAMELY, LIPSTICK, LIPSTAIN, LIP GLOSS, LIP BALM, LIP LINERS AND MASCARA" in International Class 003.

While it may be true, as the Examining Attorney states, that certain large companies purvey both Applicant's goods and the goods covered by Cited Registration 1, these companies are effectively "modern supermarket[s]," where a "wide variety of products...have been brought together...for the convenience of the customer." *Federated Foods*, 544 F.2d at 1103. The existence of two products at such large stores does not inherently mean that the products are related, and "should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks

on any goods so displayed.” *Id.* Applicant’s goods are plainly distinct from the goods purveyed under Cited Registration 1, given that the latter purveys various tools, electronics, and flatware, while Applicant provides various cosmetic-related products. Thus, the mere fact that these products may appear at the same large store is insufficient to hold the two related.

Applicant’s goods are also distinct from those covered under Cited Registration 2. It should be noted that while both the Application and Cited Registration 2 cover products that can be included in the broad category of cosmetics, the two do not cover the exact same products. Because Applicant’s identification of goods consists of a lengthy enumeration of various products in the cosmetics sphere, it can be reasonably inferred that the word “cosmetics” at the start of the identification of goods serves simply to categorize the succeeding enumerations, and those enumerations serve to limit the cosmetics products covered by the Application. Thus, while it is true that “where the goods in an application or registration are broadly described, they are deemed to encompass ‘all the goods of the nature and type described therein,’” *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (quoting *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)), here the Applicant’s goods are not broadly described. The successive enumerations following the word “Cosmetics” limits the identified goods to those enumerated cosmetics.

Thus, Applicant’s goods are distinct from those supplied under Cited Registration 2. It is true that goods do not need to be precisely the same to be related, but only need to be sufficiently related that consumers may mistakenly believe that the goods “emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Here, however, the broadness of the cosmetics realm, and the distinction between Applicant’s goods and those covered under Cited

Registration 2, prevent consumers from cognizing such a mistaken belief. Thus, Applicant's goods are sufficiently distinct from those covered by Cited Registration 2 that no likelihood of confusion arises therefrom.

NUMEROUS REGISTERED MARKS ARE SIMILAR TO THE CITED REGISTRATION

With respect to both the number and nature of similar marks, it cannot be said that the Applicant's Mark is the only similar mark to the Cited Registrations. For example, the marks in U.S. Registration Nos. 4546362 and 3059376 are highly similar to Cited Registration 1, and the marks in U.S. Registration Nos. 5921481 and 5632492 are highly similar to Cited Registration 2. This similarity between the Cited Registrations and numerous other registered marks is "relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). Further, given that purchasers of services of the Cited Registrations may be accustomed to seeing similar marks, it is likely that such purchasers will look to other aspects of the product to distinguish it, thereby reducing the likelihood of confusion. *See, e.g., In Re Hartz Hotel Servs. Inc.*, 102 U.S.P.Q.2d 1150 (T.T.A.B. 2012). For this additional reason, it would be inequitable for the Applicant's registration to be denied.

EVEN IF THE TRADE CHANNELS ARE THE SAME, THIS IS AN INSUFFICIENT
REASON TO HOLD THE PRODUCTS AND SERVICES RELATED

To the extent that similar or the same trade channels are used to purvey Applicant's goods and services as well as those covered by the Cited Registration, this is insufficient to hold them related. In order to determine whether goods share common trade channels it is necessary to look at the suppliers and retailers of the goods. The court has previously held that the mere fact that two

products may be found in the same large store is not sufficient to establish that the products are related. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24 (CCPA 1976). Assuming, arguendo, that the Applicant's goods and the goods covered by the Cited Registrations were sold in the same store, the court has held that to be insufficient reason to hold the goods related.

PURCHASERS ARE HIGHLY SKILLED AND SPECIALIZED SOPHISTICATED
CONSUMERS AND THEREFORE NO LIKELIHOOD OF CONFUSION EXISTS

It has been established that where the purchasers of a product are sophisticated there can be no likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

The consumers of both the Applicant's products and the Cited Registrations' products are likely to be highly specialized individuals. Many purchasers of beauty products, particularly the relatively specialized ones that Applicant provides, are likely to be practical experts in that domain, given the frequency with which such products are often purchased, and the time and money invested in them. The same is true of many of the implements sold under Cited Registration 2, such as crimping and curling irons, which are typically used either by certified experts in hair styling or by private individuals with significant experience in that area; or gardening implements, typically used by those with substantial experience tending to gardens and the like. Moreover, Applicant's products are technically distinct from those purveyed under the Cited Registrations. As such, the sophisticated purchasers of these products would "unquestionably know the source of the goods," *In re N.A.D., Inc.*, 754 F.2d at 1000, and therefore no likelihood of confusion exists.

ADDITIONAL MATTER IS SUFFICIENT TO REMOVE ANY LIKELIHOOD OF
CONFUSION

It is established that in the event two marks are similar the inclusion of additional matter may be sufficient to avoid a likelihood of confusion where: (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. See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellent used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellent for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" is descriptive as applied to the relevant goods and thus has no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation 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); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of "DESIGNERS/FABRIC" and "DESIGNER FABRICS," the addition of "DAN RIVER" is sufficient to avoid a likelihood of confusion).

Here, Applicant's Mark and the Cited Registrations offer completely distinct commercial impressions. Cited Registration 1 contains a design element that distinguishes it entirely from Applicant's Mark. While true that greater weight is often accorded the words in a mark containing both words and design elements, *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)), the design element in Cited Registration 1 is taller than the text, and appears before the text. Just as the first word of a mark is, practically of necessity, a "prominent feature" of the mark, *Palm*

Bay Imps., 396 F.3d at 1372, when a design element is the first feature of a mark, it too must weigh heavily on the consumer's perception of that mark. As such, the design element of Cited Registration 1 is plainly the dominant feature of the mark, which must weigh heaviest in determining the similarity of marks. *See, e.g., In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 2012)). Thus, the additional matter in Cited Registration 1 creates an entirely different commercial impression from the one created by Applicant's Mark.

Cited Registration 2 is, in standard character form, the word "AUDACIOUS." In conjunction with the goods offered under Cited Registration 2, this "clearly suggests the dictionary meaning of the word," *In re Farm Fresh Catfish Co.*, 231 USPQ at 495, which is "intrepidly daring," or "marked by originality and verve." *See* <https://www.merriam-webster.com/dictionary/audacious>. Applicant's Mark, on the other hand, is the word "AUDACE," in standard character form, which, while meaning "bold" or "spirited," is merely "used as a direction in music." *See* <https://www.merriam-webster.com/dictionary/audace>. Even to the small minority of Americans who have the requisite musical knowledge to understand this term, it is unlikely to have the same connotation as "audacious." The differing connotations between Applicant's Mark and Cited Registration 2 gives rise to distinct commercial impressions. Therefore, given that the commercial impression created by Applicant's Mark differs from those created by the Cited Registrations, no likelihood of confusion exists between them.

THE CITED REGISTRATIONS ARE NOT FAMOUS

The Cited Registrations are not for a famous mark and is therefore not entitled to increased protections. In order for a mark to be considered famous, the mark must be well known so as to indicate the source of the covered goods. The Cited Registrations do not appear to be well known.

We find that the Cited Registration cannot be considered famous and therefore is not entitled to the protections afforded to famous marks. This factor should be given neutral weight.

III. EXTENT OF POTENTIAL CONFUSION IS DE MINIMIS

Assuming, arguendo, that the marks may be similar, the goods and services offered are quite different in nature; are used for different purposes; are promoted differently; and are purchased by different, and discriminating, purchasers. Accordingly, the potential for confusion is de minimis.

IV. PRIOR PENDING APPLICATION

With respect to the prior-filed pending application potential rejection, U.S. Serial No. 87626707 (“Prior Pending Application”), the arguments above apply equally to the prior-filed pending application as well as to the Cited Registrations, particularly those addressing Cited Registration 2, given this mark’s similarity to the Prior Pending Application. The marks are sufficiently distinct in the goods purveyed under them and in the commercial impression that they impart; and their likely purchasers are highly sophisticated in the relevant domain. Accordingly, no likelihood of confusion exists between Applicant’s Mark and the Prior Pending Application. Applicant reserves the right to supplement this response in the event that a likelihood of confusion rejection under Section 2(d) is brought forth.

V. CONCLUSION

Applicant believes that it has responded to all of the Examining Attorney’s inquiries, and, specifically, has addressed the belief that there is a likelihood of confusion as between Applicant’s Mark and the Cited Registrations. As demonstrated above, the goods are distinct, their purchasers are highly sophisticated, and, to the extent that they are sold in the same trade channels, this is insufficient to hold them related. Moreover, the marks themselves are dissimilar and create entirely

different commercial impressions. Accordingly, there is no likelihood of confusion and Applicant respectfully requests that the Application be allowed to proceed to publication.