

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:		)
		)
Applicant:	Sharp, Kimberly N	)
		)
Serial No.:	88328588	)
		)
Mark:	KW	)
		)
Filed:	March 6, 2019	)
		)
Int'l Classes:	016,021,026	)
		)
Our File No.	2020-01201	)

**RESPONSE TO OFFICE ACTION NO. 2**

Applicant Sharp, Kimberly N (“Applicant”) responds to the Office Action No. 2 mailed on November 21, 2019 as follows:

**I. REFUSAL TO REGISTER BASED ON LIKELIHOOD OF CONFUSION**

The Examining Attorney has refused registration of Applicant’s KW mark (“Applicant’s Mark”) for “Stickers, bumper stickers, decorative stickers for cars, decals, magnetic decals, vinyl decals, stationery, postcards, posters, wrapping paper, gift bags, Insulating sleeve holder for beverage cups and cans, cups, mugs, shot glasses, wine glasses, beer mugs, coffee mugs, plastic cups, bottle openers, Patches for clothing made of rubber, plastic, and vinyl, embroidered patches for clothing, ornamental cloth patches, hat trimmings, armbands, embroidery” under International Class 016,021,026, Application Serial No. 88328588 (“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 No. 5411082 for KW, namely for “T-shirts; Hats; Pants; Shirts; Snapback hats; Trucker hats; Tank tops; Visors being headwear; Shorts; Jackets; Hoodies;

Underwear; Sweatshirts; Swim wear; Bathing suits; Fishing shirts; Rash guards; Sandals” (“Cited Registration”)

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 A CONSENT AGREEMENT AGREEING THAT NO  
LIKELIHOOD OF CONFUSION EXISTS BETWEEN THE CITED  
REGISTRATION AND THE APPLICANT’S MARK**

The Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason. *See In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); *see also du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568; *cf. In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) There is a consent agreement between Applicant and the owner of the Cited Registration which in addition to giving consent of the owner of the registered mark to register the Applicant’s mark contains the agreement of the parties that there is no likelihood of confusion between the Cited Registration and the present Application. The consent agreement is attached hereto.

**III. THERE IS NO LIKELIHOOD OF CONFUSION**

There is no likelihood of confusion because of the distinct nature of the goods and channels of trade when comparing the Applicant's Mark and the Cited Registration. 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 extend 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). If assuming, arguendo, that the Cited Registration and the Applicant's mark contain similar components that fact alone is not dispositive as to likelihood of confusion. Both the Applicant's mark and the Cited Registration have been in use concurrently 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 REGISTRATION

When comparing the Applicant's Mark and the Cited Registration the type of products are unique and wholly 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). When comparing the Applicant's products to the products covered by the Cited Registration it is evident that there exists a difference between "Stickers, bumper stickers, decorative stickers for cars, decals, magnetic decals, vinyl decals, stationery, postcards, posters, wrapping paper, gift bags, Insulating sleeve holder for beverage cups and cans, cups, mugs, shot glasses, wine glasses, beer mugs, coffee mugs, plastic cups, bottle openers, Patches for clothing made of rubber, plastic, and vinyl, embroidered patches for clothing, ornamental cloth patches, hat trimmings, armbands, embroidery", and "T-shirts; Hats; Pants; Shirts; Snapback hats; Trucker hats; Tank tops; Visors being headwear; Shorts; Jackets; Hoodies; Underwear; Sweatshirts; Swim wear; Bathing suits; Fishing shirts; Rash guards; Sandals" the products covered by the Cited Registration.

THE TRADE CHANNELS ARE DIFFERENT

The trade channels for the Applicant's Mark and the Cited Registration are different. 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). The Cited Registration is for “T-shirts; Hats; Pants; Shirts; Snapback hats; Trucker hats; Tank tops; Visors being headwear; Shorts; Jackets; Hoodies; Underwear; Sweatshirts; Swim wear; Bathing suits; Fishing shirts; Rash guards; Sandals”. If, assuming arguendo, that the Applicant’s goods and the goods covered by the Cited Registration were sold in the same store, the court has held that to be insufficient reason to hold the goods related.

#### THE CITED REGISTRATION IS NOT FAMOUS

The Cited Registration is 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 Registration does 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

#### **IV. EXTENT OF POTENTIAL CONFUSION IS DE MINIMIS**

Thus, assuming 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.

#### **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 Registration identified in the Office Action. As demonstrated above, the goods and services are distinct, purchasers are highly sophisticated, likely to be sold in separate areas, and do not emanate from the same source as those provided under the Cited Registration. Accordingly, there is no likelihood of confusion and Applicant respectfully requests that the Application be allowed to proceed to publication.