

## **APPLICANT'S RESPONSE TO THE OFFICE ACTION DATED NOVEMBER 25, 2019**

The Examining Attorney has refused registration of the above-referenced trademark application (the "Application") for the mark MINT (the "Trademark") in Classes 18, 21, and 25 (collectively, "Applicant's Goods") on the grounds that registration of the mark is likely to cause confusion because it is similar to prior registered marks. The Applicant respectfully disagrees and requests that the Application be passed to publication for the reasons that follow.

The Examining Attorney is also requiring amendment of the description of goods in the Application. The Applicant's response is set forth below.

### **I. IDENTIFICATION OF GOODS**

The Applicant is hereby amending the description of goods in Classes 18, 21, and 25 as follows:

Class 18: ~~beach bags, tote bags,~~ cross body bags, ~~backpacks;~~

Class 21: cups and mugs, water bottles *sold empty*, water glasses;

Class 25: headwear, namely, baseball caps, toques, beanies, cap visors, caps, hats; clothing, namely, T-shirts, Tank Tops, Hoodies, Sweatshirts, Pullover shirts, Polo Shirts, Sports Jerseys, Sweaters, Vests, Dresses, Skirts, Leggings, Pants; Footwear, namely, running shoes, slip-on shoes, flip flops, sandals; Socks, hosiery; scarves; mittens, gloves.

In view of the amendments to the listing of goods, Applicant submits that there are goods in three classes and no additional fees are required.

### **II. THE TRADEMARK IS NOT CONFUSINGLY SIMILAR TO THE CITED MARKS**

The Examining Attorney has refused registration of the Trademark on the grounds that the Trademark, when used in association with the Applicant's Goods in Classes 18, 21, and 25, so resembles the following four previously registered trademarks that it is likely to cause confusion, mistake, or to deceive:

1. MINT (U.S. Registration No. 3710848) (in standard character form) for goods including "Duffel bags; Luggage; Backpacks; Tote bags; Overnight bags; Carry-on bags; Garment bags for travel; Shoe bags for travel; Cosmetic bags sold empty; Diaper bags; Beach bags; and specifically excluding women's handbags and purses" in International Class 18 ("Cited Registration No. 1");
2. MINT (U.S. Registration No. 3726948) (in standard character form) for "women's handbags, namely, purses, clutch bags, handbags, and coin purses" in International Class 18 ("Cited Registration No. 2");
3. MINT (U.S. Registration No. 3849218) (in standard character form) for "Retail clothing boutiques; Retail clothing stores; On-line retail store services featuring women's clothing and accessories, namely, dresses, skirts, tops, shirts, pants, belts, shoes, undergarments, and perfume" in International Class 35 ("Cited Registration No. 3"); and
4. MINT TABLEWARE (U.S. Registration No. 5901813) (in special form) with "TABLEWARE" disclaimed for "dinnerware" in International Class 21 ("Cited Registration No. 4");

(Collectively, hereinafter, the "Cited Marks").

The Applicant respectfully submits that having regard to the relevant factors under TMEP § 1207 and set forth in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973), the Trademark cannot be said to so resemble any one of the Cited Marks that it is likely to cause confusion, mistake, or to deceive for the reasons set out below.

**A. Likelihood of Confusion with Cited Registration No. 1 and Cited Registration No. 2**

The concurrent use and registration of the Trademark with Cited Registration No. 1 and Cited Registration No. 2 is not likely to cause confusion because of the fact that the PTO has previously deemed registrable, and has permitted to co-exist without risk of confusion, Cited Registration No. 1 and Cited Registration No. 2, both of which are registrations for the trademark MINT for different types of bags in class 18 (i.e. the bags covered by each registration do not directly overlap)

As the Trademark Trial and Appeal Board stated in *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983), it is well recognized that third party registrations are of value to the extent they indicate that a particular word, feature or design has been adopted and registered by others in a particular field. Such registrations indicate that the word, feature or design is more suggestive than arbitrary in a particular field, and, therefore, such a registration for goods or services in the same or related field should be given a more restricted scope of protection.

In the present case, the peaceful co-existence of Cited Registration No. 1 and Cited Registration No. 2 with one another, where each mark is used with, is evidence that the registration of other such similar trademarks in association with bags not covered by Cited Registration No. 1 or Cited Registration No. 2 is unlikely to cause confusion in the marketplace.

As such, given that bags listed in the Application, as amended, covers only “cross-body bags”, and given that this type of bag is not covered by either Cited Registration No. 1 or Cited Registration No. 2, the Applicant submits that there is room for the Trademark to co-exist with both Cited Registration No. 1 and Cited Registration No. 2 with little risk of confusion.

**B. Likelihood of Confusion with Cited Registration No. 3**

It is routinely held that even where two marks are identical, there is no likelihood of confusion “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source...” TMEP § 1207.01(a)(i). Moreover, in determining whether the parties’ goods and services and channels of trade are so related that a likelihood of confusion will result from registration of Trademark, the Examining Attorney should be guided by the practicalities of the commercial world. See *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (“We are not concerned with the 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 laws deals.”).

Taking into consideration the practicalities of the commercial world in which the Trademark and each of Cited Registration No. 3 are encountered by the respective customers, confusion is not likely because Applicant’s Goods are sufficiently different and/or travel in sufficiently different channels of trade than the goods and services covered by Cited Registration No. 3.

Specifically, the services covered by Cited Registration No. 3 are “Retail clothing boutiques; Retail clothing stores; On-line retail store services featuring women’s clothing and accessories, namely, dresses, skirts, tops, shirts, pants, belts, shoes, undergarments, and perfume” in class 35. Attached hereto as **Exhibit A** are true and correct copies of screenshots from the website of the owner of Cited Registration No. 3, located at [www.shopmint.com](http://www.shopmint.com), providing information about the services covered by Cited Registration No. 3. Upon information and belief, the retail clothing store services covered by Cited Registration No. 3 are specifically focused on the sale of luxury fashion products for women. That is, the retail services covered by Cited Registration No. 3 relate to the sale of fashion products produced and

manufactured by unrelated third-party luxury brands, and all of the goods sold in the related retail stores are products branded with the trademarks of these other third-party luxury fashion brands. See **Exhibit A**.

In contrast, the Applicant's Goods relate only to clothing products intended to be marketed and sold in association with the trademark MINT. Moreover, the Applicant's field of business is the sporting goods industry, and not luxury fashion, as is the case for the owner of Cited Registration No. 3. See, attached here **Exhibit B** which contains true and correct copies of screenshots from the Applicant's website located at <https://mintgreen.com/>.

Therefore, it is unlikely that the Applicant's Goods would ever be sold at the MINT-branded retail stores covered by Cited Registration No. 3 and the consumer is unlikely to believe that clothing products produced by the Applicant, which operates in the sporting goods industry, would have any relationship with a retail store which focuses on the sale of goods made and manufactured by third party luxury fashion brands for women.

Thus, the Applicant's Goods have a distinct function and purpose and are intended for a distinguishable category of consumers than those of the services covered by Cited Registration No. 3. Accordingly, no consumers would mistakenly believe that the Applicant's Goods originate from a common source as the services of Cited Registration No. 3. As a result, the Applicant's Goods and the services covered by Cited Registration No. 3 differ in nature and with respect to the normal channels of trade, such that consumer confusion is not likely to result from registration of the Trademark.

#### **C. Likelihood of Confusion with Cited Registration No. 4**

The Examining Attorney is of the view that Trademark is confusingly similar to Cited Registration No. 4 because each mark contains the term MINT, and therefore the marks create the same commercial impression.

In determining the similarity or dissimilarity of two marks, the marks must be compared in their entireties and a likelihood of confusion "cannot be predicated on dissection of a mark, that is, on only part of the mark." *In re Natl Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). Rather, in analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features. See, e.g., *Shen Manuf. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir. 2004) (reversing the Board's finding of a likelihood of confusion between THE RITZ KIDS and RITZ because the Board improperly dissected the mark THE RITZ KIDS and failed to acknowledge to source-identifying function of the terms "THE" and "KIDS").

The fact that both the Trademark and Cited Registration No. 4 include the term "MINT" is an insufficient basis for refusing the Trademark given that, as a whole, the Trademark and Cited Registration No. 4 present very different overall impressions.

First, the marks sound different. The mark MINT TABLEWARE consists of four syllables combining the words "MINT" and "TABLEWARE". In contrast, the Trademark consists solely of the one-syllabic term "MINT".

Second, the marks look different. Cited Registration No. 4 is a design trademark comprised of the words "MINT TABLEWARE" shown in the image of mint leaf, whereas the Trademark is comprised of a single, succinct mark.

Finally, not only do the marks look and sound different, but Cited Registration No. 4 has a distinct and specific meaning, conveying to consumers the idea of the mint herb plant. The mint plant is typically associated the idea of "fresh" (i.e. minty fresh) and, as such, the idea suggests is that the associated tableware products are "fresh". In contrast, such a meaning is devoid from the Trademark.

The differences in the overall impressions of the Trademark and Cited Registration No. 4 is made more significant when one considers the differences between the Applicant's Goods and the goods listed in Cited Registration No. 4. Specifically, the Applicant's Goods cover, in relevant part, only various types of drinking vessels. These drinking vessels, i.e. cups, mugs, water bottles, and drinking glasses, are the types of goods typically sold for promotional purposes, and are not, typically, sold for the purpose of serving as a consumer's everyday tableware (i.e. we all have cupboards full of such drinking vessels branded by different businesses in the promotion of their business activities). In contrast, the goods covered by Cited Registration No. 4 are described as "tableware", which has a very specific connotation: the goods are the type of goods sold by stores specializing in home décor (and typically sold as a complete, matching set (i.e. a full set of six glasses, or a full set of four complete dish settings)).

Accordingly, having regard to the distinctions in the overall impressions of the Trademark and Cited Registration No. 4, as well as the distinctions in the specific nature of the class 21 goods covered by the Trademark and Cited Registration No. 4, no confusion is likely to result from the registration of the Trademark.

### **III. FOREIGN REGISTRATION**

The foreign registration is not yet available. The foreign application is still pending. Applicant requests that the U.S. application be suspended until a copy of the foreign registration is available.

### **IV. CONCLUSION**

For all the foregoing reasons, the Applicant respectfully requests that the Examining Attorney remove the rejections/objections of record.

# EXHIBIT A

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[\(/collections/beach-wear\)](/collections/beach-wear)



**FACE MASKS**

[\(/collections/face-masks\)](/collections/face-masks)



[\(/collections/new-arrivals\)](/collections/new-arrivals)

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 Six Fifty



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 Rewards



# EXHIBIT B



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# OUR BRANDS

We are proud to represent leading golf, court,

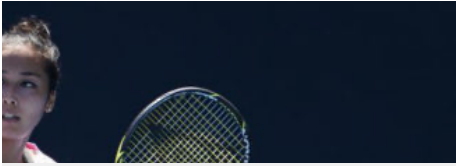
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# MINT GREEN GROU

Founded in 1974 by Ted Fletcher, The Mint Green Gr  
penchant for sales. This love lead to a lifelong ca  
pioneer and one of Canada's foremost business

Today, we are proud to represent leading brands ac  
align with who we are. As we continue to build on o  
adding new brands to our family and offering them  
building and Canadian marketplace

## THE MINT GREEN A

## **We Are Brand Stewards.**

Brand DNA is at our core. Our expertise is in taking a brand's global strategy and activating it cohesively and creatively in Canada, across every touchpoint.

## **We Make Deep Consumer Connections.**

Everything we do starts and ends with the consumer – how and where they see the brand and how they engage with it. Our job is to understand the consumers' needs deeply so we can earn their loyalty through meaningful content and an emotional connection.

## **Long-Term Relationships Across All Channels.**

With over 45 years of proven success in wholesale, mono-brand retail and DTC, we have what it takes to get it right. We understand the retail landscape in Canada and how to differentiate across channels, drive sell-thru and leave the consumer with a lasting impression.

# OUR VALUES

The values we live by and

## RESPECT

We want everyone to feel valued and have a voice. We're open, honest and we each take accountability for our words and actions.

## COMMITMENT

We are all committed to a common outcome, regardless of our individual titles. We do whatever it takes to WOW our customers, we're loyal to our partners and we always aim to do what's right for the business.

## CREATIVITY

Creativity drives us. We make the mundane memorable and encourage new ideas and ways of thinking that make everyone's business better.

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# OUR TE

We're a crew of service-obsessors, solution-finders, number-crunchers, data-lovers and optimistic, life enthusiasts. Me



## TED FLETCHER

FOUNDER

Ted is one of Canada's most recognized business leaders in the Golf, Sports and Lifestyle industries. With decades of experience leading the Canadian growth of many iconic brands, Ted has built a reputation as a trusted partner, a savvy entrepreneur, a dedicated philanthropist and a highly accomplished business leader.

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CEO

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## BOB COTE

### PRESIDENT

Bob is a 25-year veteran in the golf and sports licensing business, having worked with leading brands such as Cobra, Acushnet, Greg Norman, '47 Brand and others. His long-standing relationships throughout the industry and his experienced sales leadership continue to be a key driver of Mint Green's growth and success.



## ADAM COX

### EXECUTIVE VP & GM


Adam Cox has 25 years of corporate experience, having worked for the and Puma, leading Cobra Puma Golf Canada. An entrepreneur at heart, background in sales with his financial brands forward and fuel their growth is in building a solid organizational to deliver long-term, sustainable s





# CONTACT US


We look forward to speaking with you.

## GET IN TOUCH


 **Phone:** (514) 738-3486

 For brands looking to expand into Canada:  
[info@mgg.ca](mailto:info@mgg.ca)

 For retailers looking to carry our brands: [info@mgg.ca](mailto:info@mgg.ca)

 For passionate people looking to join our company:  
[hr@mgg.ca](mailto:hr@mgg.ca)

## VISIT OUR OFFICE

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## WRITE US

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Your Email (required)

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**Building Brands in Canada.**

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