
In Re Application of:)
Applicant:	Rockwood)
Serial No.:	88595513)
Mark:	CHAMPION)
Filed:	Aug. 28, 2019)
Int'l Classes:	027)
Our File No.	2020-01199)

RESPONSE TO OFFICE ACTION NO. 1

Applicant Rockwood (“Applicant”) responds to the Office Action No. 1 mailed on December 16, 2019 as follows:

I. REFUSAL TO REGISTER BASED ON LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration of Applicant’s CHAMPION mark (“Applicant’s Mark”) for “Carpet underlays, namely, rug grippers” under International Class 027, Application Serial No. 88595513 (“Application”) under Section 2(d) of the Trademark Act, 15 U.S.C. §1062(b), on the grounds that Applicant’s Mark is likely to be confused with U.S. Trademark Registration No. 5251493 for CHAMPION (With Design), namely for “Blankets [and] Throws” (“Cited Registration 1”); U.S. Trademark Registration No. 3946020 for CHAMPION (With Design), namely for “fuel filters, oil filters, [and] air filters for vehicle motors and engines” (“Cited Registration 2”); and U.S. Trademark Registration No. 4415020 for CHAMPION (With Design), namely for “air filters for use in vehicle heating, ventilation, and air conditioning systems” (“Cited Registration 3”).

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 Registrations, and their 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, the different channels of trade, the sophistication of potential purchasers, and the number of similar marks in use, when comparing the Applicant's Mark and the Cited Registrations. 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). To determine 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. The Applicant's mark and the Cited Registrations' marks have been concurrently in use for three years, with no evidence of confusion. In an analysis of the remaining factors, we similarly find no likelihood of confusion.

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

When comparing the Applicant's products to the Cited Registrations' products, the goods are unique and wholly distinct. To determine whether the products are distinguishable, the court will compare the applicant's goods to the previous registrants' goods as they are identified in the application and the cited registration. *In re Hughes Furniture Indus., Inc.*, 114 U.S.P.Q.2d 1134, 1137 (TTAB 2015). *See also Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 942, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990) ("The question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.").

Here, the identified goods in the Application and in the Cited Registrations are not legally identical. In the Application, the Applicant's products are listed as area rugs and mats, particularly "rug grippers." Conversely, the products listed in Cited Registration 1 are indoor and outdoor blankets, and the products listed in Cited Registration 2 and Cited Registration 3 are vehicle filters used for vehicle fluids and vehicle ventilation systems, respectively. These products differ

sufficiently in their classification and uses; therefore, Applicant's registration should be allowed to proceed to publication.

THE TRADE CHANNELS ARE DIFFERENT

The trade channels for the Applicant's Mark and the Cited Registrations are different. The court has previously held that where the goods in the cited registration and/or application are broadly identified as to their nature and type, it is presumed that in scope the identification of the goods encompasses all the goods of the nature and type described therein, and all channels of trade which would be normal therefore. *In re Elbaum*, 211 U.S.P.Q. 639, 640 (TTAB 1981). The Application's identification of goods is not broad; in fact, the Application specifies the types of mats and rugs the Applicant sells and specifies where consumers should use them. Because the goods are not broadly identified, the channels of trade are presumed to be different.

Additionally, 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 Registrations are for "blankets" and "vehicle filters." Assuming, arguendo, that the Applicant's goods and the Cited Registrations' goods 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

The court has previously held that purchaser sophistication is often dispositive as to the likelihood of confusion because sophisticated consumers may be expected to exercise greater care. *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q.2d 1388, 1392 (Fed.

Cir. 1992). Accordingly, 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 highly specialized individuals. The Applicant's products are completely distinct from the Cited Registrations' products in terms of their functions and common uses. Therefore, the potential purchasers of both the Applicant's products and the Cited Registrations' products are highly skilled consumers, eliminating any likelihood of confusion.

ADDITIONAL MATTER IS SUFFICIENT TO REMOVE ANY LIKELIHOOD OF
CONFUSION

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 and therefore do not have a likelihood of confusion.

THE CITED REGISTRATION IS NOT FAMOUS

Cited Registration 1, Cited Registration 2, and Cited Registration 3 are not famous marks and therefore are not entitled to increased protections. 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; in fact, Cited Registration 2 and Cited Registration 3 have concurrently sold similar products in the same trade channels for approximately seven years with no evidence of confusion, thereby demonstrating the marks' lack of fame. We find that the Cited Registrations cannot be considered famous and therefore are not entitled to the protections afforded to famous marks. This factor should be given neutral weight.

III. EXTENT OF POTENTIAL CONFUSION IS DE MINIMIS

Thus, assuming 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. 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 Cited Registration 1, Cited Registration 2, and Cited Registration 3 identified in the

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