

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Petco Animal Supplies Stores, Inc.
Serial Number: 88717542
Filing Date: December 6, 2019
Mark: YOULY

Examining Atty: Curtis W. French, Esq.
Law Office: 130

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

Applicant submits the following remarks in response to the Office Action dated February 24, 2020.

The Examining Attorney has refused registration of Applicant's YOULY mark covering pet products in Class 18 under Section 2(d) of the Trademark Act on the grounds that it is confusingly similar to the registered marks identified below:

1. Reg. No. 4354476 for the mark YOLIE covering various bags in Class 18, owned by *Yolanda Guerra* (the "Cited Registration").



2. Reg. No. 4354477 for the mark  covering various bags in Class 18, owned by *Yolanda Guerra* (the "Cancelled Registration").

The Examining Attorney has also issued an advisory 2(d) refusal based on prior pending Application No. 88126212 for the mark YULY covering goods in Class 18, owned by Beijing Yidengyipin Technology Co., Ltd (the “Cited Application”).¹

Since the Examining Attorney issued his refusal, Registration No. 4354477 has been cancelled due to failure to file an acceptable declaration of use pursuant to Section 8. *See* Exhibit A. Because the Cancelled Registration is no longer active on the Principal Register, it no longer bars registration of Applicant’s YOULY mark.

The Examining Attorney believes that confusion is likely due to the similarity of the marks, the goods, and the trade channels. Applicant respectfully disagrees that confusion is likely between Applicant’s YOULY mark and the Cited Registration and, for the reasons set forth below, requests withdrawal of the refusal.

A determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in evidence relevant to the thirteen factors set forth in *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). The Examining Attorney need not consider all factors, but instead may consider those factors that are most relevant to the case at hand. *See In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985). The relevant *du Pont* factors in this case include the differences in appearances and overall commercial impressions between the marks and the differences between the goods and services at issue. *See In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). It is clear that the cumulative differences

¹ Since the Examining Attorney issued his refusal, the owner of the Cited Application failed to timely respond to an office action. As such, Applicant is not submitting arguments against the Cited Application at this time and instead requests suspension of its application, if necessary, pending final disposition of the Cited Application.

between Applicant's mark and each of the cited marks are sufficient to avoid a likelihood of confusion. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (CCPA 1976).

1. The Parties' Marks Significantly Differ

The Examining Attorney narrowly focused on a presumed phonetic similarity between Applicant's YOULY mark and the cited YOLIE mark when concluding that the marks were similar. When viewed properly in their entireties, however, the overall differences between the marks are sufficient to make them distinct and distinguishable for likelihood of confusion purposes. *See China Healthways Institute Inc. v. Xiaming Wang*, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (marks must be compared in their entireties in assessing likelihood of confusion).

First, the Examining Attorney is mistaken that YOULY and YOLIE are "essentially phonetic equivalents." Those two words are, in fact, pronounced differently. YOULY is pronounced "YOO-lee." YOLIE—which is a common girl's shorthand nickname for Yolanda—is pronounced "YOW-lee." YOULY and YOLIE are pronounced differently and are not "phonetic equivalents" for one another. *See In re Reach Elecs., Inc.*, 175 USPQ 734, 735 (TTAB 1972) (finding no likelihood of confusion as between REAC and REACH, both for "power supplies," because the words did not sound alike when spoken).

Second, YOULY and YOLIE plainly look and are spelled different.

Finally, the parties' marks have different meanings. Registrant's YOLIE mark is a well-used girls nickname for "Yolanda," which unsurprisingly is the trademark owner's name, i.e., *Yolanda Guerra*. On the other hand, Applicant's mark is a fanciful term with but one purpose and meaning, i.e., to identify Applicant's pet products.

The parties' marks greatly differ in sight, sound, and meaning and, as such, are unlikely to create confusion. *See Goldring, Inc. v. Towncliffe, Inc.*, 110 USPQ 284 (CCPA 1956) (finding no likelihood of confusion as between TOWNCLIFFE and TOWNTREE because "they do not look alike, sound alike, or have the same meaning").

2. The Parties' Goods Significantly Differ

Goods are considered related if they are marketed and consumed in such a manner that buyers are likely to believe that they come from the same source. *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (Fed. Cir. 2007). The key issue in the likelihood of confusion analysis is whether both parties' marks will be encountered by the same persons under circumstances giving rise to the mistaken belief that the goods emanate from the same source. *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986). Here, the parties' goods are sufficiently distinct such that consumers will not encounter the respective marks under circumstances likely to lead to the mistaken impression that they share a common source.

Applicant's application covers the following Class 18 goods:

Leashes for animals; pet leashes; dog leads; pet collars; cat collars; pet harnesses; pet tote bags; pet travel bags; carry-on bags for pet owners; pet clothing; dog clothing; costumes for animals; pet hats; pet footwear; pet travel bags; pet accessories, namely, pouches for holding disposable bags to place pet waste in; tote bags; pet carriers in the nature of a bag and a sling.

The Cited Registration, on the other hand, covers the following goods in Class 18:

Purses; handbags; wallets; dolly bags; coin purses; clutches; all purpose sport bags; athletic bags; all purpose carrying bags; all purpose reusable carrying bags; baby carrying bags; backpacks; book bags; bum bags; bags for carrying babies' accessories; bags for umbrellas; beach bags; belt bags; canvas shopping bags; duffel bags; diaper bags; flight bags; garment bags for travel; hiking bags; knitted bags; leather bags; messenger bags; school bags; roll bags; suit bags; shoulder bags; wheeled and duffel bags.

Applicant offers *pet-related* goods, namely, pet leashes/collars, pet clothing, pet harnesses, pet costumes, and, as it relates to the issue at hand, *pet* bags. Applicant's application covers none of the bags covered by the Cited Registration, nor does the Cited Registration cover any goods related to pets. Given the very discrete field to which Applicant's goods are targeted (i.e. pets), there is no overlap between such goods and the goods covered under the Cited Registration.

Further still, the specimens of use submitted with the Cited Registration show that the YOLIE mark is used with coin purses—a product far afield from the pet products covered under Applicant's application. This simply underscores the disparate nature of the parties' goods. The specimen of use submitted with the Cited Registration on April 23, 2013 and January 2, 2019 are attached as Exhibit B and C, respectively.

Finally, the goods covered in the Cited Registration and the pet products covered in Applicant's application are sold to different consumers through disparate trade channels, i.e. those shopping for pet products versus those shopping for a personal bag.

Conclusion

The cumulative differences between the marks, goods, and trade channels are such that an appreciable number of reasonably prudent consumers are unlikely to be confused, mistaken, or deceived into believing that Applicant's YOULY mark for pet products originates from the same source as, or is associated with, the goods identified in the Cited Registration. *See Botteger Beneta v. Volumer Shoe*, 226 USPQ 964, 967 (TTAB 1985), *citing McGregor-Doniger v. Drizzle*, 202 USPQ 81, 86 (2d Cir. 1979).

Applicant respectfully asks that refusal under Section 2(d) be withdrawn. Applicant further respectfully requests that its application be suspended pending final disposition of the Cited Application.