

DOLLY’S BABY BLUES – 88175361

Summary of Issues:

- Continued and Maintained: Section 2(d) Refusal – Likelihood of Confusion
- Continued and Maintained: Name of Individual Consent – *have that for uploading*
- Applicant’s Address Required – *added domiciled address*

I. REFUSAL OF REGISTRATION – LIKELIHOOD OF CONFUSION

The Examining Attorney has continued her refusal of registration of the mark DOLLY’S BABY BLUES (“Applicant’s Mark”) on the grounds that it is confusingly similar to Registration



No. 4165139 for VENICE BABY BLUES BBQ with Design, owned by Baby Blues BBQ IP, LLC (the “Cited Registration”) within the meaning of Section 2(d) of the Federal Trademark Act, as amended. The Examining Attorney contends that because the respective marks are “similar” and because the services are related, regardless of the distinctive differences between the marks, confusion is likely. However, for the reasons discussed below, Applicant again respectfully requests that the Examining Attorney withdraw the refusal to register and allow the subject application to proceed to registration.

Applicant’s Mark and the Cited Registration Are Dissimilar

As noted above, one of the factors in evaluating a likelihood of confusion is the similarity or dissimilarity of the respective marks. Applicant’s mark is different than the Cited Registration. This conclusion is obvious given the overall distinctiveness of the respective marks, as discussed below.

In determining whether a likelihood of confusion exists, “the marks...must be viewed in their entireties.” *Textronics v. Daktronics*, 534 F.2d 915 (CCPA 1976). It is inappropriate to disregard one element of a mark, thereby de-emphasizing other components of the marks. *In re the Hearst Corp.*, 982 F.2d 493, 494, 25 USPQ 1238 (Fed. Cir. 1992). That is, “the marks must be considered in the way they are used and perceived.” *Id.* at 1239, citing *In re National Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985). As the *Hearst* court stated, “marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight,” citing *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847 (Fed. Cir. 1992). *Id.*

In the present case, the Examining Attorney has stressed only the shared component of the marks and not the differences, and has erroneously concluded that because the marks contain the terms “baby” and “blues” the marks are confusingly similar. Indeed, each portion of both Applicant’s and Registrant’s respective marks must be given appropriate weight in determining

the overall appearance, sound, connotation and commercial impression elicited from the mark. When viewed as a whole, the marks are not likely to be confused.

1. The Visual Differences Between the Marks Renders Any Likelihood of Confusion Remote

i. The Marks Contain Different Visual Elements and Are Distinguishable

Applicant's Mark DOLLY'S BABY BLUES is substantially different from the cited



stylized design

registration.

While the Examining Attorney has stated that “baby” and “blues” are featured in both of the marks, and argues that because the marks contain the same dominant elements, that the marks are confusingly similar. Applicant respectfully disagrees. As seen above, the Registrant's Mark has a distinctive color and design.

Moreover, most consumers viewing the marks can easily distinguish between the respective marks through the differences, including the additional text. In fact, most consumers viewing the respective marks will not assume that the marks are related given their marked differences. Moreover, the marks have very different visual impressions elements, and therefore are not similar.

2. The Terms “baby” and “blues” Appear in Other Co-Existing Registrations for Goods Similar to The One Identified in the Cited Registration

Applicant submits the co-existing applications and registrations previously cited in its earlier response and Registrations to show the coexistence of the mark and includes copies of such applications and registrations to be included in the record.

This co-existence of the Cited Marks and others on the Federal Register evidences that the U.S. Patent and Trademark Office believes that consumers can and do distinguish between the sources of the services sold under the respective marks. In this regard, Applicant includes below an illustrative chart of various marks featuring the terms “baby” and “blues” for similar goods/services:

| MARK | REGISTRATION NO. |
|-----------------------|------------------|
| BABB BROS BBQ & BLUES | 4393992 |
| THE BLUES BBQ CO. | 4939963 |

| | |
|----------------------------|---------|
| SWEET BABY RAY'S | 5008119 |
| GEORGIA BLUE | 5175430 |
| DOTTIE'S TRUE BLUE CAFÉ | 5211874 |
| BLUE J BAR & LOUNGE | 5295980 |
| BLUE'S | 5474212 |
| BIG BABY Q | 5606915 |
| PITTSBURGH BLUE STEAKHOUSE | 5806834 |
| IOU BBQ | 5839004 |
| BABY'S BURGERS | 5936744 |
| BLUES BOULEVARD JAZZ | 5980872 |
| BLUE BEAR | 5993815 |
| BLUE COLLAR | 5995114 |

Attached as exhibits are the TESS printouts from the above mentioned trademark registrations.

3. Consumers that Purchase These Services Would Not Be Confused

Diners are sophisticated and will know the difference between DOLLY'S BABY BLUES



vs. the stylized

Even where two products or services are used by the same type of consumers in the same general area, the channels of trade can be sufficiently dissimilar. See *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 715 (Fed. Cir. 1992) (E.D.S. and EDS not confusingly similar where used with computer programming services and design of power supplies, respectively, even where both parties sold their goods or services to many of the same customers in the automotive, communications, and merchandising industries). Further, in *Hewlett-Packard Co. V. Human Performance Measurement, Inc.*, 23 U.S.P.Q.2d 1390, 1395, the T.T.A.B. held that the fact that both the parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely. Therefore, even if the services may be encountered by the same consumers, that does not, by itself, establish similarity of trade channel or market overlap resulting in a likelihood of confusion.

4. Allegations of Potential Confusion are Theoretical and Not Grounds for Refusal to Register

The possibility, either theoretical or *de minimis* that confusion may occur is not a sufficient basis for refusal to register Applicant's Mark. *Whitco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969) ("*Whitco*"). Rather, a *likelihood* of

confusion must exist. *Id.* While Applicant realizes that actual confusion is not necessary, Applicant notes that more than a mere theoretical possibility of confusion must be present. In *Whitco*, the Court stated:

We are not concerned with the mere theoretical possibilities of confusion, deception or mistake or with the *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.

In the present case, the possibility of confusion as to the source of the respective parties' services is merely theoretical or at most, *de minimis*. There is no proof that consumers will view Applicant's Mark as being similar to the Cited Registration, and there is no proof that consumers will be actually confused by the respective uses of the marks.

II. CONCLUSION

In light of the foregoing comments and information, and having complied with all of the outstanding requirements of the Examining Attorney's Office Action, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal and promptly pass the subject application to publication.