

In the Office Action dated August 10, 2020, the Examining Attorney initially refused registration of



Applicant's mark based on 10 prior registrations:

1. U.S. Reg. No. 2951635 (SEVEN STARS) for Casino services featuring discounts and complementary services for frequent patrons through the use of an identification card in Class 41 and hotel and restaurant services featuring a frequent guest reward program with added features which allows participants to earn free or discounted lodging, meals and other travel-related benefit in Class 42
2. U.S. Reg. No. 3293190 (SEVEN STARS) for Customer loyalty services for casinos for promotional and/or advertising purposes, namely frequent customer reward program service which allows participants to earn discounts and free gifts in Class 35
3. U.S. Reg. No. 3632834 (SEVEN STARS SIGNATURE EVENT) for Customer loyalty services for casinos for promotional and/or advertising purposes, namely, frequent customer reward program service which allows participants to earn discounts and free gifts in Class 35.
4. U.S. Reg. No. 4360376 (SEVEN STARS) for Customer loyalty services for casinos for promotional and/or advertising purposes, namely, frequent customer reward program service which allows participants to earn discounts and free gifts
5. U.S. Reg. No. 4625406 (SEVEN STAR) for footwear
6. U.S. Reg. No. 4345760 (SEVENSTAR) for Arrangements for transportation of boats, pleasure yachts and aircraft by land, sea and air; Transport of vehicles in Class 35; boat transport; marine transport of pleasure yachts; transport of aircraft; freight transportation by ship of boats, pleasure yachts and aircraft via water in Class 39
7. U.S. Reg. No. 4906497 (SEVEN STARS AWARD) for Providing independent ratings and reviews of other businesses for commercial purposes
8. U.S. Reg. No. 5365040 (7 STAR DREAMS) for Business consulting, business management and providing information in the music business field
9. U.S. Reg. No. 3770489 (SEVENSTAR ACADEMY) for Education services, namely, providing live and on-line courses in the field of Christian education
10. U.S. Reg. No. 4193443 (SEVEN STAR) for Education services, namely, providing live and on-line courses in the field of Christian education.

The Examining Attorney also requested amendments to the services. Accordingly, Applicant has amended its services as suggested by the Examining Attorney and in accordance with the Acceptable Identification of Services Manual issued by the U.S. Patent and Trademark Office ("PTO"). Moreover, Applicant submit that these amendments (as well as the limitations Applicant has added to its services) not only resolve the indefiniteness problem but also resolve the likelihood of confusion objections as Applicant's amended and limited services are not likely to cause confusion with the cited marks.

Finally, the Examining Attorney requested that Applicant make of record a complete description of the mark. Accordingly, Applicant has made of record the description and color claim proposed by the Examining Attorney. In that regard, as acknowledged by the Examining Attorney in the proposed description and color claim, Applicant's mark is not SEVEN STARS. Instead, Applicant's mark contains highly stylized and integrated design and color elements, which further differentiate it from the cited marks.

In light of the differences in Applicant's amended services, the limitations and exclusionary language identified in Applicant's amended services, the difference in the marks, the coexistence of the cited marks with each other and many other marks and the comments set forth below, Applicant submits that the likelihood of confusion objections should be removed.

**THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE
TEN CITED MARKS AND APPLICANT'S MARK**

Likelihood of Confusion Standard

The PTO recognizes that a mark should not be refused registration in view of all similar registered marks, but only on the basis of those similar marks whose effect *in the marketplace* would be to create a likelihood of confusion or mistake on the part of the purchasing public. T.M.E.P. §1207.01.

The controlling standard for determining likelihood of confusion is whether the relevant purchasing public would mistakenly assume that the applicant's services originate with, are sponsored by, or are in some way associated with the services offered in connection with the cited registrations or referenced applications. FBI v. Societe: "M. Bril & Co.", 172 U.S.P.Q. 310 (T.T.A.B. 1971).

Further, Applicant notes that the Examining Attorney "bears the burden of making out a persuasive case for finding that confusion among consumers or users of products or services is not merely a theoretical possibility but is likely." In re Medical Central Online, Inc., Serial No. 76/138,824 (T.T.A.B. Oct. 22, 2003) (non-precedential). Argument and conclusive assertions do not suffice to establish a likelihood of confusion. In re Consulting Services International Inc., Serial No. 76/376,622 (T.T.A.B. Oct. 3, 2003).

More importantly, it is well-recognized that "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, then, even if the marks are identical, confusion is not likely." T.M.E.P. § 1207.01(a) (i).

A number of factors set forth in In re DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) ("DuPont"), are considered relevant in making a determination of likelihood of confusion, including: (1) the differences in the marks; (2) the differences in functions and purposes of the services; (3) whether the goods/services at issue are engaged after careful consideration as to the source of the services; (4) whether intended consumers and consumers are sophisticated and knowledgeable and (5) the co-existence of third-party registrations and uses for similar marks for similar services. These factors are to be addressed with respect to "the known circumstances surrounding use of the mark." Id. at 567. Applying these factors to the case at hand, it is apparent that there is no likelihood of confusion between Applicant's mark and the 10 cited marks.

**APPLICANT'S SERVICES AS AMENDED ARE DISTINGUISHABLE FROM THE SERVICES IN THE
CITED REGISTRATIONS**

As noted above, the PTO recognizes that a registration should not be refused in view of all similar registered marks, but only on the basis of those similar marks **whose effect in the marketplace** would be to create a likelihood of confusion or mistake on the part of the purchasing public. Given the amendments and limitations to Applicant's services, Applicant submits that its **amended** services are clearly distinguishable from the services in the cited registrations. As such, it is apparent that Applicant's services and the services in the cited registrations are not "related in some manner" or sufficiently related that "the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the [services] come from a common source." Accordingly, the likelihood of confusion and potential likelihood of confusion objections should be removed. This is especially true as the cited marks (for similar services) already coexist with each other.

To support an objection based on a likelihood of confusion, Applicant's amended services must be so related to the services listed in the cited registrations, such that consumers would be confused about the source of origin. T.M.E.P. §1207.01(a) (i). Here, Applicant's amended services are not related or marketed in such a way that they would be encountered by the same people in situations that would create the incorrect assumption that they originate from the same source, then there is no likelihood of confusion, **even if the marks are identical**. See Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1371, 101 U.S.P.Q. 2d 1713 (Fed. Cir. 2012). Thus, there is no likelihood of confusion.

In fact, the only similarity between the services in the cited registrations and Applicant's application is their classification. It is well recognized that this is not a sufficient basis for finding a likelihood of confusion. In support of this position, Applicant directs the Examining Attorney's attention to Groveton Papers Co. v. The Anaconda Co., 197 U.S.P.Q. 576 (T.T.A.B. 1977), where the opposer maintained that its products were related to the applicant's because both products were within the same class. In dismissing the opposition, the Trademark Trial and Appeal Board (the "Board") indicated that:

[T]he Patent and Trademark Office classification of services was established for the Office's convenience rather than for the purpose of showing that the services falling within a single class are related, and thus Office classification of particular services is immaterial to the determination of any issue of likelihood of confusion concerning those services.

Id. at 579.

In the case at hand, it is apparent that Applicant's amended services are not "related in some manner" or sufficiently related to the services in the cited registrations so that "the conditions surrounding their marketing be such that they could be encountered under circumstances that could give rise to the mistaken belief that the services come from a common source." Accordingly, the likelihood of confusion objections should be removed. This is particularly true given the specific and highly distinguishable functions and purposes of the services identified in the cited registrations, as is discussed in more detail below. Instead, in light of the amendments and limitations, the differences in the marks, the differences in the amended services, the coexistence of cited marks with each other and many other marks much more similar to the cited marks as compared to Applicant's mark as well as the comments set forth below, the Section 2(d) refusals should be removed.

CONFUSION IS UNLIKELY BECAUSE THE PURPOSES AND FUNCTIONS OF THE SERVICES ARE DISTINGUISHABLE

A finding of no likelihood of confusion is mandated by the nature of each party's services and the differences in the functions and purposes of the respective services. In fact, the case at hand presents itself as one in which there will be no competitive proximity between the parties' respective services.

The realities of the marketplace mandate consumer orientation to the specific **utility or function** of the services necessary to fulfill the consumer's specific needs. While it may not be necessary for the services of the parties to be identical or directly competitive to find a likelihood of confusion, Applicant directs the Examining Attorney's attention to In re Unilever Ltd., 222 U.S.P.Q. 981 (T.T.A.B. 1984), in which the Board stated that: "where the services in question are not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all the services come from the same source . . . confusion is not likely." Id. at 982-83.

As explained in more detail below, Applicant's amended services have very specific functions, purposes and fields of use. Likewise, the services in the cited registrations also have very specific functions, purposes and fields of use (such as casinos, customer loyalty, independent ratings, music and Christian education) that are unrelated to Applicant's amended services. Thus, the services at issue are not identical or competitive. Moreover, a consumer interested in the services being provided by the owners of the cited registrations would be unable to use Applicant's amended services to perform the same functions and purposes. As all the services have mutually-exclusive purposes, a finding of likelihood of confusion is even more tenuous.

In Chase Brass & Copper Co., Inc. v. Special Springs, Inc., 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978), the Board found no likelihood of confusion between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because "while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same persons in an environment where a likelihood of confusion could occur."

Moreover, in reversing the Board's decision sustaining a Section 2(d) opposition with respect to the marks "E.D.S." versus "EDS," the Federal Circuit explained that "[w]here both applicant's goods and

opposer's services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because applicant sells some of its goods in some of the same fields in which opposer provides its services." Elec. Design & Sales, *supra*, 21 U.S.P.Q.2d 139. The Federal Circuit further emphasized that "[w]e are not concerned with 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 deal." *Id.* (quoting Witco Chem. Co. v. Whitfield Chem. Co., 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969)). See also Cooper Indus., Inc. v. Repcoparts USA, Inc., 218 U.S.P.Q. 81, 84 (T.T.A.B. 1983) ("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'").


Indeed, noting that a likelihood-of-confusion analysis may focus on "dispositive factors," the Federal Circuit reversed another Board decision sustaining a Section 2(d) opposition where the marks were identical and the services superficially related. Shen Mfg. Co. v. Ritz Hotel Ltd., 73 U.S.P.Q.2d 1350, 1353 (Fed. Cir. 2004). This opposition involved RITZ applied to cooking classes versus the identical mark RITZ applied to various kitchen textiles. The Federal Circuit disapproved of the Board's rationale that "the services of applicant clearly require the use of certain of opposer's goods," and clarified that simply because "two goods are used together . . . does not, in itself, justify a finding of relatedness," *Id.* at 1355, and that "aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from the same source," *Id.* at 1356.

Furthermore, in Reynolds & Reynolds Company v. I.E. Systems, Inc. ("Reynolds"), 5 U.S.P.Q.2d 1749 (T.T.A.B. 1987), both the applicant and registrant marketed computer software. Nonetheless, the Board concluded that there was no likelihood of confusion because the applicant marketed its products to an entirely different set of consumers than the opposer. *Id.* at 1752. After analyzing the channels of trade through which applicant's and opposer's goods flowed, as well as the customers who purchased those goods, the Board concluded that the "goods sold under applicant's mark are sufficiently different from those services for which opposer uses its . . . mark." *Id.* at 1757.

Likewise, the source of Applicant's services is not likely to be confused with the source of the services in the cited registrations, just as the source of the applicant's computer software in Reynolds was not likely to be confused with the source of the opposer's computer software.

APPLICANT'S MARK IS DIFFERENT FROM THE MARKS IN THE CITED REGISTRATIONS IN CONNOTATION AND MEANING



As noted above, Applicant's mark is not SEVEN STARS but . Given the difference in connotation and meaning of the marks, the Section 2(d) refusals should be removed.

Thus, it could be seen as SEST and ENRS or SEEN STRS. This alone mandates a finding of no likelihood of confusion.

In Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha, 228 U.S.P.Q. 672, 674 (T.T.A.B. 1985) ("Fuji"), the Trademark Trial and Appeal Board (the "Board") held there was no likelihood of confusion between the marks SUPRA and SUBARU. The Board noted that while both marks start with the same letter and contain several letters, the marks were otherwise clearly different in appearance. In fact, the Board noted that the fact that several of the letters were almost the same was immaterial and that while "trademark owners cannot control with certainty how purchasers . . . will vocalize their trademarks (cite omitted), it strains credulity that either SUBARU or SUPRA could conceivable be so badly pronounced as to be mistaken in verbal marketplace communications."

Moreover, it is well founded that in deciding likelihood of confusion, marks must be compared in their entireties and should not be dissected, and their parts compared separately. See Estate of P.D. Beckwith, Inc. v. Comm. of Patents, 252 U.S. 538 (1920) (the commercial impression of a composite mark is derived

from the mark, not its separate elements). In fact, it has been held that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely. Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). In other words, splitting a mark into its various components and comparing only certain portions of one mark with another mark is not proper. Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). Thus, a proper comparison of Applicant's mark to the cited marks shows that the marks are quite dissimilar in sound, meaning, connotation, overall appearance and commercial impression. See also In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) ("no element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone"); and Spice Islands, Inc. v. Frank Tea & Spice Co., 505 F.2d 1293, 184 U.S.P.Q. 35 (C.C.P.A. 1974) (improper to ignore portion of composite mark).

In fact, "no element of a mark is ignored simply because it is less dominant or would not have trademark significance if used alone." In re Electrolytes Laboratories, Inc., 913 F.2d. 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990), corrected 929 F.2d 645 (Fed. Cir. 1990) ("Electrolytes") (holding no likelihood of confusion between the marks K+ (Stylized) and K+EFF (Stylized) both for a dietary potassium supplement).

Applicant respectfully submits that when the marks are properly considered in their entireties, they are dissimilar in overall appearance. See Little Caesar Enters., Inc. v. Pizza Caesar, Inc., 834 F.2d 568, 571 (6th Cir. 1987) (holding that, despite a prominent component shared by PIZZA CAESAR USA and LITTLE CAESARS, that differences in sound and appearance made them dissimilar).

In Oakville Hills Cellar, Inc. dba Dalla Valle Vineyards v. Vina Casa Tamaya S.A., Opposition No. 91189443 (April 15, 2013), the Board held that dissimilarity of the marks TAMAYA and MAYA and the difference in commercial impressions resulting in no likelihood of confusion between the marks despite the fact that both marks were for wine.

Further, in ConAgra Inc. v. Saavedra, 4 U.S.P.Q.2d 1245 (T.T.A.B. 1987), the Board found that the mark "PATIO" for Mexican food has a different connotation than the mark "TAPATIO" for Mexican food and in Taj Mahal Enterprises Ltd. v. Trump, 745 F.Supp. 240, 16 U.S.P.Q.2d 1577 (D.N.J. 1990), the court found that the mark "TAJ MAHAL" for Indian restaurant has different connotation than the mark "TAJ MAHAL" for Atlantic City hotel/casino.

Similarly, in Fleetwood Co. v. Mende, 132 U.S.P.Q. 458 (C.C.P.A. 1962), the Court of Customs and Patent Appeals ("CCPA") affirmed the Board's dismissal of a Petition for Cancellation of the mark "TINT 'N SET" for hair care preparations brought by the owner of the registration for the mark "TINTZ," also for hair care preparations. *Id.* at 459. In reaching its conclusion, the CCPA reasoned that merely because both marks contained the term "TINT" and were used on virtually identical goods, there was no likelihood of confusion. *Id.*

In the case, Giorgio Beverly Hills Inc. v. Revlon Consumer Products Corp., 33 U.S.P.Q.2d 1465 (S.D.N.Y. 1994), the court found that there was no likelihood of confusion between "RED" and "CHARLIE RED," both for perfume. *Id.* at 1467. Likewise, in Bell Laboratories, Inc. v. Colonial Products, Inc., 231 U.S.P.Q. 569 (S.D. Fla. 1986), the court found no confusion between "FINAL" and "FINAL FLIP," both for rodenticides. *Id.* at 571-572.

In fact, the Federal Circuit has made it clear that "one DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." Champagne Louis Roederer S.A. v. Delicato Vineyards, 47 U.S.P.Q.2d 1459, 1460 (Fed. Cir. 1998). In that case, the Federal Circuit affirmed the Board's finding of no likelihood of confusion between the marks CRISTAL and CRYSTAL CREEK, both for alcoholic beverages, based upon the marks' different commercial impressions. Specifically, the Federal Circuit agreed with the Board's conclusion that while CRISTAL evoked the clarity of the wine within the bottle or the glass of which the bottle itself was made, the mark CRYSTAL CREEK suggested "a very clear (and hence probably remote from civilization) creek or stream." *Id.* Notwithstanding the similarity between the words CRISTAL and CRYSTAL, the court also agreed with the Board's finding that the overall appearance and sound of the marks were both dissimilar. *Id.*

Further, in the case In re Variety Supply Co., 143 U.S.P.Q. 367, 368 (T.T.A.B. 1964), the Board found no likelihood of confusion between the marks "GAY CHARM" and "CHARM," both for the identical types of women's undergarments.

The present case is clearly analogous to these cases. Specifically, when the marks are compared in their entireties, they are distinguishable in meaning and commercial impression. As a result, consumer confusion is unlikely.

It is also well established that merely because two marks contain a similar or identical term, this does not establish that there is a likelihood of confusion. In fact, time and time again, the Board and the courts have found that even where the marks at issue are identical or nearly identical; there is no likelihood of confusion.



This is especially true with regard to Applicant's mark. Specifically, the existence of the integrated design element in Applicant's mark and the highly stylized letters along with Applicant's amendments and limitations to its description of services all support the conclusion that there is no likelihood of confusion. Given the large and dominant design element and stylized letters in Applicant's



mark, Applicant's mark and the cited marks are quite dissimilar in sound, meaning, connotation, overall appearance and commercial impression.

In support of this position, Applicant directs the Board's attention to Omaha National Bank v. Citibank (South Dakota), N.A., 633 F. Supp. 231 (D.C. Neb. 1986). In Omaha, the court determined that because the



plaintiff's composite mark consisted of words and a design element, it was not infringed by the defendant's use of the mark "BANK IN A WALLET." Id. at 233-34.


Further, Applicant directs the Examining Attorney's attention to Electrolytes, supra, where the Federal Circuit determined that due to the existence of the design portion of the K+ and Design mark, there was no likelihood of confusion between the marks "K+ and Design" and "K+EFF (stylized)" both for a dietary potassium supplement. In reaching this conclusion, the Federal Circuit stated, "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue."

In addition, in In re TSI Brands, Inc., the Board reversed the Examining Attorney's refusal to register



the mark in Application Serial No. 75/615,925 (the "'925 Application") for "pants,



jeans, shorts and shirts” in light of prior registrations for the mark  for “sweaters, jerseys, shirts, tops, undershirts, pants, hosiery, jackets, ski pants, ski jackets, ski suits, tops.” The Board determined that the marks proffered distinguishable commercial impressions. Applicant notes that the '925 Application proceeded to registration and was assigned Trademark Registration No. 2,802,613.

Applicant further directs attention to In re Merchandising Motivation, Inc., 184 U.S.P.Q. 364 (T.T.A.B. 1974), where the Board determined that the mark “MEN’S WEAR and MMI (STYLIZED)” for men’s fashion consulting services did not resemble the mark “MEN’S WEAR” for a men’s fashion magazine. See also Diamond Alkai Co. v. Dundee Cement Co., 145 U.S.P.Q. 211, 212 (C.C.P.A. 1965). See also Tektronics, Inc. v. Daktronics, Inc., 189 USPQ 693 (C.C.P.A. 1976) (the prominent letter “D” must be given weight);; Menzies v. International Playtex, Inc., 204 USPQ 297 (T.T.A.B 1979) (no confusion between the marks “SUPER LOOK” and “SUPER LOOK +”) and Medical Modalities Associates Inc. v. ARA Corporation, 203 USPQ 295 1979) (no confusion between the marks “MG-PLUS” and “MG+C”).

Indeed, “differences in designs may outweigh similarity of words.” Richard L. Kirkpatrick, Likelihood of Confusion In Trademark Law, § 4:9.2 (2006).

In fact, different designs, lettering, or typeface play a significant role in distinguishing two marks and may even prevent confusion between identical words. See, e.g., Packman v. Chicago Tribune Co., 60 U.S.P.Q.2d 1245, 1255 (7th Cir. 2001) (“Packman”) (“Although the words . . . are the same, the words’ appearances do not resemble each other and are not likely to cause confusion”).

Likewise, in Private Eyes Sunlass Corp. v. Private Eye Vision Center of New Milford, 25 U.S.P.Q.2d 1709, 1715 (D. Conn. 1992), the court found no likelihood of confusion notwithstanding the near identical marks PRIVATE EYE and PRIVATE EYES because “the print design and the logotype reduce the potential for confusion that would otherwise be inherent given the similar wordings.”

For instance, in Hard Rock Cafe Licensing Corp. v. Elsea, 48 U.S.P.Q.2d 1400 (T.T.A.B. 1998), the Board dismissed a Section 2(d) opposition because it found no likelihood of confusion between the marks COUNTRY ROCK CAFE SALOON DANCE HALL & Design and HARD ROCK CAFE & Design for identical services, e.g., clothing and restaurant services. With regard to the applicant’s mark, the Board found that the design element was “a significant factor in the overall commercial impression of the mark” because all of the wording in the applicant’s mark was either highly suggestive or merely descriptive as applied to its services. Id. at 1409. Concluding, the Board found that the two marks engendered different commercial impressions, “particularly in view of the highly suggestive nature of both parties’ marks in connection with their respective services.” Id. at 1410.

Likewise, in Ass’n of Coop. Members, Inc. v. Farmland Indus., Inc., 216 U.S.P.Q. 361, 367 (5th Cir. 1982), the Court of Appeals for the Fifth Circuit explained that “when a composite [mark] includes both words and a design, the design element is likely to dominate if it is more conspicuous” and “[a] word that may be subject to lessened trademark protection because of its popularity and lack of distinctiveness is not likely, when included in a composite, to be the element that attracts the public’s attention.”

In fact, the Board and the courts have held that different designs, lettering, or typeface play a significant role in distinguishing two marks and often prevent confusion between identical words. For example, in Packman, supra, the court stated, “Although the words . . . are the same, the words’ appearances do not resemble each other and are not likely to cause confusion.” Further, in D & H Distributing Co. v. Designhouse International, Inc., 211 U.S.P.Q. 662 (T.T.A.B. 1981), the Board determined that a likelihood of confusion determination involving a mark with a design element must be primarily based on the mark’s overall visual appearance. Likewise, in this matter, the cited marks proffer different connotations and meanings and distinguishable commercial impressions from Applicant’s mark. Thus, consumers will recognize the differences in sight, sound and meaning between the marks, which negates any likelihood of confusion.

THE WEAK NATURE OF THE CITED MARKS AND THE CO-EXISTENCE OF THE CITED MARKS AND THIRD-PARTY MARKS AND USES SUPPORTS A FINDING OF NO LIKELIHOOD OF CONSUMER CONFUSION

It is well established that merely because marks contain a similar term, this does not establish that there is a likelihood of confusion. In fact, time and time again, the Board and the courts have found that even where the marks at issue are identical or nearly identical, there is no likelihood of confusion. This is even more so here, where the cited marks are weak and the numerous third-party registrations for similar marks (also discussed below).

Further, Applicant notes that Section 1207.01(d) (iii) of the T.M.E.P. explains that “[t]hird-party registrations may be relevant to show that the mark or a portion of the mark is . . . so commonly used that the public will look to other elements to distinguish the source of the goods or services.” In a similar vein, T.M.E.P. § 1207.01(d)(x) provides that “[i]f the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.” In the case at hand the fact that multiple parties own and use SEVEN STARS marks supports the position that the mark is diluted and the 2(d) refusals should be removed.

Applicant notes that the terms SEVEN and STAR/STARS are common English terms and widely used and registered for numerous goods and services, including identical or nearly identical goods and services as those listed in the cited registrations. In fact, in addition to the 10 marks cited by the Examining Attorney, a quick search of the PTO’s records revealed almost 100 live applications or registrations containing or consisting of the term SEVEN and STARS. A printout from the PTO listing these marks is attached hereto as **Exhibit A**.

Applicant notes that Reg. No. 62608870 for the mark 7STARS for retail store services featuring convenience store items was filed after Applicant’s application and includes retail store services that include alcoholic beverages. Thus, using the Examining Attorney’s logic, this registration should have been refused due to Applicant’s mark as well as several of the marks cited against Applicant’s mark. A printout of the specifics of this registration are attached as **Exhibit B**.

Similarly, Reg. No. 4694796 for the mark SEVEN STARS BAKERY for bakery products and retail bakery shops was allowed despite the existing of Reg. No. 2951635 and include retail store services and food items that could be served at hotels and restaurants identified in Reg. No. 2951635. A printout of the specifics of this registration are attached as **Exhibit C**.

By allowing this third party subsequent mark (and all of the other marks listed above and the 10 cited marks), it is evident that the PTO has determined that this third party subsequent mark, the 10 cited marks and all of these other marks can coexist as long as there is even a slight difference in the mark or the services. In fact, the multiple registrations and uses establish that the term dope has become diluted. Moreover, the very existence of a multiplicity of similar marks decreases the likelihood of confusion between Applicant’s mark and the cited marks. See Loctite Corp. v. Tubbs Cordage Co., 175 U.S.P.Q. 663 (T.T.A.B. 1972); In re Shoe Corp. of American v. The Juvenile Shoe Corp. of America, 121 U.S.P.Q. 510, 512-13.

In light of the previous stance of the PTO, it seems difficult to reconcile the Examining Attorney’s position in this matter. As the Board has stated that the PTO should avoid inconsistent practices, Applicant submits that it should not be singled out and subjected to inconsistent treatment in this case. See, e.g., In re Women’s Publishing Co., Inc., 23 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1992). Accordingly, the Section 2(d) refusal should be removed.

In support of this, Applicant directs the Examining Attorney to In re Broadway Chicken, Inc., 38 USPQ2d 1559, 1565-1566 (TTAB 1996), in which the Board stated:

Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.

In light of this, the Board determined there was no confusion between BROADWAY CHICKEN and BROADWAY PIZZA and BROADWAY BAR & PIZZA). The Board reached this conclusion based on the common meaning of the term BROADWAY and the number of third-party BROADWAY marks.

Further, in In re Hartz Hotel Services, Inc., 102 U.S.P.Q.2d 1150 (T.T.A.B. 2012) (“Hartz Hotel”). In Hartz Hotel, the Board reversed the Examining Attorney’s refusal to register the mark GRAND HOTELS NYC (with a disclaimer of HOTELS NYC) for hotel services based on a prior registration for the mark GRAND HOTEL (with HOTEL disclaimed) for hotel and restaurant services.

In reaching its decision that there was no likelihood of confusion, the Board noted that there were several other registrations for GRAND marks for hotel services that coexisted with the cited mark. Further, the Board also noted that there were several parties using the term GRAND for hotels. Thus, the Board stated:

It is clear from the third-party registrations that the addition of a geographic location to the word GRAND HOTEL has been sufficient for the Patent and Trademark Office to view these marks as being sufficiently different from the cited registrant’s mark, and from each other, such as not to cause confusion.

In further support of Applicant’s position, Applicant directs the Examining Attorney to Sure-Fit Products Company v. Saltzson Drapery Company, 254 F.2d 158, 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958), where the court stated:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

In the case at hand, the fact that the Examining Attorney cited 10 marks owned by multiple entities demonstrates that the terms SEVEN and STARS are commonly used and registered. In support of this, Applicant directs the Examining Attorney to in In re Hamilton Bank, 222 U.S.P.Q 174, 177 (T.T.A.B. 1984), where the Board reversed the refusal to register under Section 2(d) based on the fact that the federal register showed numerous registrations for banking services incorporating the word “key.” In reversing the refusal, the Board held that “the applicant’s mark is no more likely to cause confusion with the cited mark than cited mark was likely to cause confusion with the other registered marks which contain the term ‘KEY.’” Id.

In In Plus Products v. Natural Organics, Inc., 204 U.S.P.Q. 773 (T.T.A.B. 1979), the Board found no likelihood of confusion between the marks NATURE’S PLUS and PLUS both for vitamins. In reaching this conclusion, the Board noted that the PTO has “historically registered PLUS marks for vitamins to different parties so long as there has been some difference, not necessarily create by a distinctive word, between the marks as a whole.

In Jerrold Electronics Corp. v. The Magnavox Company, 1999 U.S.P.Q.2d 751, 758 (T.T.A.B. 1978), the Board concluded that third-party registrations reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can co-exist.

In re Sien Equipment Co., 189 U.S.P.Q. 586, 588 (T.T.A.B. 1975), the Board stated that the suggestive meaning of the word “BRUTE” explains the numerous third-party registrations incorporating the word with other wordings or material no matter how little additional significance this may add to the word “BRUTE” per se.

See also Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 U.S.P.Q. 529. (C.C.P.A. 1970), where the CCPA affirmed the Board’s decision that there was no likelihood of confusion between “PEAK” and “PEAK PERIOD” for personal care products because PEAK was suggestive) Knapp-Monarch Company v. Polorano Products, Inc., 134 U.S.P.Q. 412 (T.T.A.B. 1962) (THERM is highly suggestive of heat insulated products). Similarly, the owners of the cited marks did not invent the term dope.

CONFUSION IS NOT PROBABLE

In performing any likelihood-of-confusion analysis, it is essential to remember that likelihood of confusion "is synonymous with 'probable' confusion - it is not sufficient if confusion is merely 'possible.'" 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:3 (4th ed. 2006). Or, as the Court of Appeals for the Federal Circuit has put it, "[w]e are not concerned with 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 deal." Elec. Design & Sales Inc. v. Elec. Data Sys. Corp., 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (quoting Witco Chem. Co. v. Whitfield Chem. Co., 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969)). See also Phoenix Closures Inc. Yen Shaing Corp. Ltd., 9 U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this TTAB will not base a finding of likelihood of confusion upon such theoretical possibilities."); Restatement (Third) of Unfair Competition § 20 cmt. g (1995) ("[A] few particularly undiscerning persons may make purchasing decisions under a wide range of misconceptions. An actor is subject to liability for infringement only if the actor's use of another's designation is likely to confuse a significant number of prospective purchasers").

In other words, it is well-settled that there is no likelihood of confusion, as opposed to a possibility of confusion, even between identical marks where any confusion would arise only through accident or chance confrontation. For example, in In re Fesco Inc., 219 U.S.P.Q. 437, 438 (T.T.A.B. 1983), the Board did not hesitate to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry.

Specifically, the applicant's mark FESCO and Design for use in connection with "distributorship services in the field of farm equipment and machinery" was refused registration in view of the registered mark FESCO for, inter alia, "fertilizer" and "fertilizer coolers and dryers." Although the Board deemed the marks "virtually identical" and observed that the cited mark FESCO was arbitrary and therefore a "relatively strong designation," the Board nonetheless found no likelihood of confusion:

[E]ven identical marks would have little opportunity, in our view, other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regard, the TTAB has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties.

Fesco, 219 U.S.P.Q. at 438 (emphasis added). See also Borg-Warner, *supra*. 225 U.S.P.Q. at 224 (no likelihood of confusion found between identical marks BLENDEX applied to "stabilizing chemical composition for fertilizers and pesticides" and "synthetic resinous compositions for use in the industrial arts," Board finding that "there would be little opportunity other than through accidental or chance confrontation, for these marks to create confusion among customers or potential customers of applicant or opposer and while confusion as to source may be possible, it is not likely").

CONCLUSION

In performing any likelihood-of-confusion analysis, it is essential to remember that likelihood of confusion "is synonymous with 'probable' confusion - it is not sufficient if confusion is merely 'possible.'" 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:3 (4th ed. 2006). Or, as the Court of Appeals for the Federal Circuit has put it, "[w]e are not concerned with 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 deal." Elec. Design & Sales, *supra*. See also Phoenix Closures Inc. Yen Shaing Corp. Ltd., 9 U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this Board will not base a finding of likelihood of confusion upon such theoretical possibilities."); Restatement (Third) of Unfair Competition § 20 cmt. g (1995) ("[A] few particularly undiscerning persons may make purchasing decisions under a

wide range of misconceptions. An actor is subject to liability for infringement only if the actor's use of another's designation is likely to confuse a significant number of prospective purchasers").

Given the fact that Applicant's services are vastly different in purpose and function from the services in the cited registrations, the nature of all of the services at issue, it cannot be said that confusion with respect to a significant number of prospective purchasers is probable, as opposed to a theoretical possibility with respect to some de minimis number of undiscerning purchasers. Accordingly, Applicant respectfully requests the Examining Attorney withdraw the Section 2(d) refusals.

Applicant submits it has responded to all outstanding issues raised in the Office Action. The Examining Attorney is encouraged to contact the undersigned if the Examining Attorney has any questions or requires any additional information.