

RESPONSE TO OFFICE ACTION

The Examining Attorney has refused registration of Applicant's mark **ICON** asserting a likelihood of confusion with U.S. Registration Nos. 4,796,132 and 4,914,461 for **ICON** in Class 21 for "Bakeware; Cookware, namely pots and pans," and U.S. Registration No. 5,353,018 for **IKON** in Class 21 for "Pet brushes; Pet feeding and drinking bowls; Pet feeding dishes; Pet litter boxes; Pet treat jars; Automated pet appliances, namely, litter boxes; Brushes for pets; Household storage containers for pet food; Litter boxes for pets." Applicant's mark, as amended, is applied for in Class 16 for "Containers of paperboard for commercial packaging," and Class 21 for "Disposable cups, containers and lids made of paperboard." For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 2(d) refusal.

AMENDMENT OF GOODS DESCRIPTION

In accordance with the requirements of the Office Action, Applicant has amended the goods for Applicant's mark to the following:

Class 16: Containers of paperboard for commercial packaging

Class 21: Disposable cups, containers and lids made of paperboard

Applicant appreciates the Examining Attorney's acknowledgment that Applicant's mark as applied to Class 16 for "Containers of paperboard for commercial packaging" does not create a likelihood of confusion with the cited marks in the Office Action.

Applicant additionally submits that Applicant's amended goods description for Class 21 clearly and concisely defines the goods covered by Applicant's mark with the required degree of particularity.

LIKELIHOOD OF CONFUSION

No likelihood of confusion exists between Applicant's applied-for mark and the registered mark. In In re E.I. duPont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973), the court outlined several factors to be considered in testing for likelihood of confusion under Section 2(d) of the Trademark Act. The Examining Attorney indicates that the duPont factors justifying a 2(d) likelihood of confusion rejection in this case are (i) the similarity of the marks, and (ii) the relatedness of the goods. Applicant submits that no likelihood of confusion exists between Applicant's mark ICON and the cited marks ICON (Reg. Nos. 4,796,132 and 4,914,461) and IKON (Reg. No. 5,353,018) due to (a) the dissimilarity of the goods, and (b) the dissimilarity of the trade channels.

I. Dissimilarity of the Goods

Applicant submits that no likelihood of confusion exists between Applicant's mark and the cited marks because the nature of the goods offered under Applicant's mark, as amended, are distinctly different from the cited marks and adequately mitigate any concern that prospective customers are likely to assume that Applicant's goods, as amended, share a common source with the goods offered under the cited marks.

The fundamental inquiry in determining likelihood of confusion goes to the cumulative effect of the differences in the marks and the goods or services at issue. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1103 (C.C.P.A. 1976). No likelihood of confusion exists, even between marks which may appear quite similar, where the respective goods or services to which the marks are applied are such that prospective customers are not likely to assume that those goods or services share a common source. In re Sears, Roebuck and Co., 2 USPQ2d 1312 (TTAB 1987). Consumers must be likely to believe that the goods or services come from the same source

or are somehow connected with or sponsored by a common company. Commc'ns Satellite Corp. v. Comcet, Inc., 166 USPQ 353 (4th Cir. 1970), cert. denied, 167 USPQ 705 (1970). In other words, a likelihood of confusion requires that the goods or services of two respective marks share more than a general relation. See In re Sears, 2 USPQ2d 1312 (TTAB 1987). Indeed, the Board has previously rejected arguments of confusing similarity that were based solely on the fact that the goods or services share some overall general purpose. See Elec. Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992).

In the present case, the goods for Applicant's mark are specifically directed toward *disposable* cups, containers and lids made of paperboard (*see* Applicant's amended goods description). The goods for the cited marks are specifically directed toward household storage containers for pet food (with respect to Reg. No. 5,353,018) and bakeware and cookware, namely pots and pans (with respect to Reg. Nos. 4,914,461 and 4,796,132). The goods offered under Applicant's mark and the cited marks are distinctively different categories of goods.

With respect to Reg. No. 5,353,018, storage containers for pet food on one hand and disposable cups, containers, and lids made of paperboard on the other hand are two *distinctly different* categories of goods. Disposable cups, containers and lids made of paperboard are directed to single-use and temporary-use items for holding goods, such as food and beverages (e.g., coffee cups), and are intended to be disposed after such use. Conversely, storage containers for pet food are directed specifically to pet food items and intended to store pet food on a more long-term basis. Typically, pet food is purchased in disposable packaging material and consumers seek alternative non-disposable and more durable containers for long-term storage. These consumers do not seek to transfer pet food from one disposable container to another. Thus, Applicant's goods do not encompass the goods of the cited mark.

Additionally, storage containers for pet food are directed to consumers looking for pet accessories rather than disposable cups, containers, and lids made of paperboard (e.g., coffee cups). These distinct differences in categories is supported by the goods description of the cited mark: “*pet brushes; pet feeding and drinking bowls; pet feeding dishes; pet litter boxes; pet treat jars; automated pet appliances, namely, litter boxes; brushes for pets; household storage containers for pet food; litter boxes for pets.*” Each of the items listed in the cited mark description are accessories for pets and thus directed specifically to consumers with pets. Purchasers of pet food storage containers may also be searching for other pet accessories (such as pet treat jars, pet feeding and drinking bowls, etc.); however, such purchasers are not also searching for disposable cups, containers and lids made of paperboard (e.g., coffee cups) at the same time because these sets of goods are used for two different applications, the market for the goods are different, and the two categories of goods are directed to different consumers. Thus, consumers are not likely to associate Applicant’s goods with the goods of the cited mark due to their distinct differences, which prevents any likelihood of confusion between Applicant’s mark and the cited mark.

With respect to Reg. No. 4,914,461 and 4,796,132, bakeware and cookware on one hand and disposable cups, containers and lids made of paperboard on the other hand are two *distinctly different* categories of goods. Disposable cups, containers and lids made of paperboard are directed to single-use and temporary-use items for holding goods, such as food and beverages (e.g., coffee cups), and are intended to be disposed after such use. Conversely, bakeware and cookware, namely pots and pans, are directed to items specifically for baking and cooking food. Generally, bakeware and cookware, especially pots and pans, are not disposable and not made of paperboard. They are generally made of more durable materials (such as metal, rather than paperboard) to withstand cooking and baking processes and are not intended to be disposed after use. Thus, Applicant’s

goods and the goods of the cited mark have different applications and are distinct. Additionally, purchasers of disposable cups, containers and lids made of paperboard (e.g., coffee cups) are not also searching for bakeware and cookware at the same time because there is no overlapping use or application for these two different types of goods. As a result, the market for each of these two categories of goods is different and directed to different consumers. Thus, consumers are not likely to associate Applicant's goods with the goods of the cited mark due to their distinct differences, which prevents any likelihood of confusion between Applicant's mark and the cited mark.

Further, the Examining Attorney relies on evidence of third-party registrations located on the USPTO's X-Search database to support the conclusion that the goods of Applicant's applied for mark and the goods of the cited mark "are of a kind that may emanate from a single source under a single mark." The fact that the general nature of goods under Applicant's mark (i.e., disposable cups, containers and lids made of paperboard) and the cited marks (i.e., bakeware and cookware, namely pots and pans) may occasionally be offered by single sources that offer a wide range of different goods does not establish that the goods share more than a general relation. There can be no rule that certain goods or services are per se related; instead, there must be some likelihood of confusion arising from the use of similar marks in relation to such goods or services. See M2 Software, Inc. v. M2 Commc'ns, Inc., 450 F.3d 1378, 1383 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate). A similar situation occurred in In re Coors Brewing Co., 343 F.3d 1340 (Fed. Cir. 2003), where, in a case involving identically appearing BLUE MOON marks, one applied to beer and one applied to restaurant services, the court held beer and restaurant services were not sufficiently related in order to justify a likelihood of confusion rejection merely because some

restaurants brew their own beer. Another similar situation occurred in Michael Caruso & Co. v. Estafan Ent., Inc., 944 F. Supp. 1454 (S.D. Fla. 1998), where the court held that “the mere fact that defendants sell some clothing items and plaintiff specializes in retail apparel does not establish proximity of goods for purposes of likelihood of confusion.” In fact, the Board has also previously rejected arguments of confusing similarity based solely on the fact that the goods or services share an overall general purpose. In Elec. Data Sys. Corp., 23 USPQ2d 1460, 1463 (TTAB 1992), the Board held that “the issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.”

The present case is similar. While the goods under Applicant’s mark and the cited mark may share a broad, general relation, the distinctly different nature of the goods under Applicant’s mark (i.e., disposable cups, containers and lids made of paperboard) as compared to the goods under the cited marks (i.e., bakeware and cookware, namely pots and pans) prevents a likelihood of confusion among consumers. Consumers are not likely to seek out disposable cups, containers and lids made of paperboard at the same time or in the same commercial setting as bakeware and cookware as included under the cited marks. Thus, the fact that Applicant’s mark is directed specifically toward disposable cups, containers and lids made of paperboard, as opposed to bakeware and cookware as in the cited marks, prevents any likelihood of confusion between Applicant’s mark and the cited marks even if the goods share some general relation.

II. Dissimilarity of Trade Channels

The goods of Applicant’s applied-for mark and the goods of the cited marks are marketed to different classes of consumers in different marketing contexts and channels. Even marks in complementary markets can cover goods that are distinctive enough that confusion would be

unlikely where there are differences in the channels of trade. See In re Thor Tech, Inc., 113 USPQ2d at 1551 (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); TMEP § 1201.01(a)(i).

The “disposable cups, containers and lids made of paperboard” of Applicant’s applied-for-mark are marketed to consumers seeking disposable, single-use and temporary-use items for holding goods such as foods and beverages. With respect to Reg. No. 5,353,018, the “household storage containers for pet food” of the cited mark are specifically directed towards consumers seeking pet accessories. The markets for disposable containers and pet accessories are separate and distinct. With respect to Reg. No. 4,914,461 and 4,796,132, the “bakeware and cookware, namely pots and pans” of the cited marks are specifically directed towards consumers seeking products suitable for baking and cooking. The markets for disposable containers made of paper and products suitable for baking and cooking are separate and distinct. Further, consumers are not going to encounter the Applicant’s goods and the goods of the cited marks in the same location within a store if the store happens to carry goods from both the Applicant and the cited marks. Accordingly, Applicant respectfully submits that the goods of the applied-for mark are not confusingly similar to the goods of the cited marks for the reasons provided herein.

III. Conclusion

Due to the distinction between the goods, and the differences in the channels of trade, Applicant contends that there is no likelihood of confusion between its applied-for mark and the registered marks. Accordingly, Applicant respectfully submits that the application is now in condition for publication and courteously solicits the same.