

RESPONSE TO OFFICE ACTION

TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS:

IN RESPONSE TO THE ABOVE-REFERENCED OFFICE ACTION, the Applicant hereby submits the following.

In the Office Action of Oct. 19, 2020, the Examining Attorney stated that the application for LING'S MOMENT (hereafter the "Application") may ultimately be refused registration under Trademark Act section 2(d) because of a likelihood of confusion with Registration Nos. 4905208 and 4908262. for LING'S MOMENT and LING'S MOMENT (hereafter "Registrations").

The Applicant respectfully disagrees, and hereby responds as follows.

Response to Section 2(d) Likelihood of Confusion and

Explanation of the *DuPont* Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely

The test for likelihood of confusion is whether a "reasonably prudent consumer" in the marketplace is likely to be confused as to the origin of the goods or services bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A 1973).

Consequently, the Federal Circuit Court of Appeals adopted multiple factors for the purpose of deciding likelihood of confusion on a case-by-case basis, known as the *DuPont* factors.

Application of the *DuPont* Factors

Applying the *DuPont* factors to the instant case, Applicant hereby submits the following arguments in support of its argument that there would be no likelihood of confusion between the Application and the Registration.

1) Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation, and Commercial Impression (The Sight, Sound, and Meaning Analysis)



In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their *appearance, sound, connotation, and commercial impression*. TMEP §§1207.01, 1207.01(b) (emphasis added). The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing).

a) Appearance

Even though marks may be similar in appearance when they share “similar terms or phrases,” the Trademark Trial and Appeal Board (the “Board”) has consistently held that confusion is not likely if the marks in their entireties convey significantly different commercial impressions, or the matter common to the marks is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive or diluted. *See, e.g. Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with “CATFISH” disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). The Board has stated that similarity as to one aspect of the sight, sound, and meaning trilogy will *not* automatically result in a finding of likelihood of confusion when the goods are identical or closely related. 4 McCarthy on Trademarks and Unfair Competition § 23:21 (4th ed.) (emphasis added).

Looking at the commercial impression of the respective marks, it is clear to the average consumer that the respective marks are from more than one source based upon their appearance. Specifically, both the Applicant and the Prior Owner present their respective marks using distinct

logos or fonts, each connoting a particular and distinct commercial impression.

Application	Registration No. 4905208	Registration No.4908262
	LING'S MOMENT	

Here, only the Applicant uses a logo that is stylized in its appearance and selection of font. The Applicant's mark prominently features a stylized clock inside an irregular hexagon. The Registration contains no design elements whatsoever. Furthermore, the word elements of the Application are very small in comparison to the mark's design elements, and therefore it can be said that the design portion of Applicant's mark is the dominant portion of the mark. Specifically, the wording in Applicant's mark is small and located at the bottom and top of the mark, and does not stand out nearly as much as the goat design. As such, the design elements are the dominant portion of Applicant's mark.

The Examining Attorney is mistaken that the word portion is necessary more likely to be impressed upon a purchaser's memory and to be used when requesting goods or services. *In re Dakin's Miniatures, Inc.*, 59 U.S.P.Q.2d 1593, 1596 (TTAB 1999). *See In Re Angel Computer Network Services, Inc.*, 77438719, 2013 WL 2364991, at *7 (TTAB January 25, 2013) (where the Board held a registrant's wing design to be the dominant portion of the registrant's mark, which was used for computer support and assistance).

Furthermore, splitting a mark into its various components and comparing only certain portions of one mark with another mark is improper. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (C.C.P.A. 1974); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) (holding that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely). Here it is highly inappropriate to compare Applicant's mark to the Registration merely upon the shared synonymous use of the word Ling's moment. The anti-dissection rule requires that Applicant's mark for Ling's moment, **along with its design components**, be considered in its entirety.

Pursuant to the anti-dissection rule, marks (including their design components) must be viewed in their entirety. The design elements of Applicant's mark should be considered the

dominant portion of the mark, **as the design elements are substantially larger than any word elements appearing in the mark.**

This creates a significant commercial impression upon the consumer in that from merely seeing either of the above marks, they know that they are viewing and purchasing services made by the respective owner.

b) Meaning and Overall Commercial Impression

“Similarity is not limited to the eye or ear. The mental impact of a similarity in meaning may be so pervasive as to outweigh any visual or phonetic differences. **That is, the ‘psychological imagery evoked by the respective marks’ may overpower the respective similarities or differences in appearance and sound.**” 4 McCarthy on Trademarks and Unfair Competition § 23:26 (4th ed.).

Any similarities as to appearance or sound between the respective marks, if any, are overpowered and obviated by the differences in the meaning between the respective marks, as well as the overall commercial impression and presentation of the marks in commerce.

The Applicant and the Prior Owner present, use, and advertise their respective marks in unique ways. Upon viewing Applicant’s goods, the difference in commercial impression is immediately apparent.

It is Applicant’s usage of a distinctive logo that makes the overall presentation and commercial impression of Applicant’s goods easily distinguishable.

2) Similarity as to Nature of the Goods or Services

Where the goods and services are directly competitive, the degree of similarity required to prove a likelihood of confusion is less than in the case of dissimilar products. 4 McCarthy on Trademarks and Unfair Competition § 23:20.50 (4th ed.); *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 77 U.S.P.Q.2d 1641 (1st Cir. 2006). Here, there is no evidence that the Prior Marks and the Applicant’s mark are competing or being confused with one another.

Applicant is seeking to register the design trademark LING'S MOMENT. It is Applicant's contention that there is such an overwhelming dissimilarity between the marks in

terms of appearance and commercial impression that the goods on which they are respectively used are not likely to result in confusion.

Here, Applicant's goods within International Class 018, the source of the alleged confusion according to the Examining Attorney, cover "Backpacks; Briefcases; Leather bags, suitcases and wallets AND so on" The Registration covers Linen; Table linen; Unfitted seat covers of textile in International Class 024 as well as Fabric table runners; Polyester fabric; Table cloth of textile in International Class 024. Specifically, the Board has held such goods as **not being inherently similar**.

Here, the Applicant's leather goods in International Class 018 are highly unlikely to be confused with the Prior Owner's goods in International Class 24. *See Orange 21 North America Inc., formerly Spy Optic, Inc. v. Beryll Brand Division Est. and Sigmar Berg*, 91181440, 92051640, (TTAB Feb. 21, 2012) (where the Board held that **bags goods** were not inherently similar to **Linen; Table linen; Unfitted seat covers of textile**. and **Fabric table runners; Polyester fabric; Table cloth of textile** as sold under Applicant's and Registrant's respective marks).

As such, Applicant's leather bag goods in Class 018 are highly unlikely to cause confusion with the Registration's respective goods in Class 024.

3) Conditions Under Which and Buyers to Whom Sales are Made

Here, the buyers of the respective goods and services will be a sophisticated. In other words, consumers making purchases of services from either the Applicant or the Prior Owner are well educated, and not likely to make such purchases on impulse.

As such, the services offered by the Applicant and Prior Owner are aimed at discriminating purchasers. "Where the relevant buyer class is composed of professional or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers...they (the professional purchasers) are usually knowledgeable enough to be less likely to be confused by trademarks that are similar. For example, the First Circuit found no infringement in the case of ASTRA local anesthetic preparation versus ASTRA computerized blood analyzer machine. The 'most critical factor' was said to be the sophistication of the buyers

of the products.” 4 McCarthy on Trademarks and Unfair Competition § 23:101 (4th ed.); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786 (1st Cir. 1983).

4) The Fame of the Prior Mark

All trademarks are not equal. Some are strong, some are weak and most are somewhere in between. “Strong” marks are given “strong” protection—protection over a wide range of related products and services and variations on visual and aural format. 'The stronger the mark, the more likely it is that encroachment on it will produce confusion.' Conversely, relatively weak marks are given a relatively narrow range of protection both as to products and format variations. 2 McCarthy on Trademarks and Unfair Competition § 11:73 (4th ed.). Likewise, here, there is no evidence that the cited Prior Marks re famous or have acquired secondary meaning within the marketplace or that consumers associate the term LING'S MOMENT with the Prior Owner.

5) The Nature and Extent of Any Actual Confusion

There has been no documented evidence that shows that any consumers have confused the respective marks in commerce. There have been no demonstrated events of confusion by consumers between the respective marks.

A review of the Office’s records reveals the following coexisting registrations with same words ling marks for the different goods:

Mark Name	class	Owner	Serial/reg. No	Status
LING	44	LING SKINCARE, LTD	4037361	registered
LING	25	Huynh, Phat	4964340	registered
LING	28	Beijing Ling Technology	5618151	registered
LING	41	Beijing Ling Technology	5618151	registered
LING	42	Beijing Ling Technology	5618151	registered
LING	09	DATA PHYSICS	5700785	registered
LING	37	DATA PHYSICS	5700785	registered

Courts have long held that concurrent use of such marks without instances of actual confusion is evidence of no confusion. 4 McCarthy on Trademarks and Unfair Competition § 23:18 (4th ed.); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490,

212 U.S.P.Q. 246 (1st Cir. 1981) (“[W]hen the marks have been in the same market, side by side, for a substantial period of time, there is a strong presumption that there is little likelihood of confusion.”); *Greentree Laboratories, Inc. v. G.G. Bean, Inc.*, 718 F. Supp. 998, 13 U.S.P.Q.2d 1161 (D. Me. 1989) (concurrent use for five years without confusion where plaintiff's mark is weak creates a presumption that confusion is unlikely; judgment of no infringement); *Aktiebolaget Electrolux v. Armatron Intern., Inc.*, 999 F.2d 1, 4, 27 U.S.P.Q.2d 1460 (1st Cir. 1993) (“[A]n absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that little likelihood of confusion exists.”).

Conclusion

Consequently, taking the respective marks in their totality pursuant to the Anti-Dissection Rule, consumers would likely be able to differentiate between the respective marks because of the differences in goods and services, difference in appearance, as well as their overall commercial impression. Additionally, consumers of the owners' respective products are sophisticated and likely to exercise great care in purchasing their respective goods and services, and there has been no evidence of any actual confusion.

Therefore, the Applicant respectfully requests that the Examining Attorney allow Applicant's application for the mark LING'S MOMENT to proceed to publication. If for some reason the Examiner continues to believe that the present application is not in condition for publication, the Examiner is respectfully requested to email Applicant's attorney at us-trademark@outlook.com to discuss any possible amendments of the like which places the case in condition for publication, or arrange an Examiner's amendment to put the case in condition for publication.

Thank you for your consideration.

Respectfully submitted,
By /Jeffrey S. Firestone/
us-trademark@outlook.com