

Response to Office Action

MARK: THE TRAVELER

SERIAL NO.: 88637952

APPLICANT: Barbara A. Brock

FILING DATE: October 1, 2019

INTERNATIONAL CLASS: 018

TO: Shaunia Carlyle
Examining Attorney
USPTO, Law Office 110

Applicant, Barbara A. Brock (“Applicant”) respectfully submits this Response to the Office Action issued on November 26, 2019 against Application Serial No. 88637952 for THE TRAVELER mark (for *Vanity bags and cases sold empty* in **Class 018**) (the “Applicant’s Mark”).

The Examiner has refused registration on the ground that Applicant’s Mark is likely to cause confusion with the trademark bearing Registration No. 5310111 (“E LETRAVELER” in Class 018) (the “Cited Mark”). Applicant maintains that, for the reasons set forth below, this confusion is unlikely, and therefore the Cited Mark should not pose a bar to registration.

The Examining Attorney has also refused registration on the ground that Applicant’s Mark is merely descriptive of Applicant’s goods, under 15 U.S.C. § 1052(e)(1). Applicant maintains that the mark is not merely descriptive because it is suggestive. Consequently, Applicant respectfully requests that this refusal be withdrawn.

As each issue in the Office Action letter of September 30 has been addressed, Applicant respectfully requests that the THE TRAVELER mark be granted registration.

I. Likelihood of Confusion Refusal

1. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “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.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969). As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording. Moreover, registrations for identical marks (which Applicant’s mark and Cited Mark are not) for closely related goods and services may coexist when the totality of the circumstances indicates there is no

likelihood of confusion.

2. Applicant's Mark Is Visually and Aurally Dissimilar from The Cited Mark and The Marks Create Distinct Commercial Impressions in Their Respective Contexts

Applicant's Mark is dissimilar from the Cited Mark in appearance and overall commercial impression.

In determining likelihood of confusion, marks being compared should be considered in their entirety. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

In determining the commercial impression created by a mark, the mark must be viewed in its entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although "Vargas" and "Varga" were similar, "the marks must be considered in the way they are used and perceived ... and all components thereof must be given appropriate weight." The court went on to say that "[b]y stressing the portion 'varga' and diminishing the portion 'girl', the Board inappropriately changed the mark." *In re Hearst Corp.* at 1239, *see also Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not likely to cause confusion with ALL, both for household cleaning products).

The Examining Attorney, in their letter of September 30, submits that Applicant's Mark, THE TRAVELER, in standard characters, is overly similar to the Cited Mark, E LETRAVELER, with logo design. For the reasons set forth below, Applicant respectfully disagrees.

First, it is axiomatic that consumers tend to focus on the first part of a trademark when allocating source-identifying significance. Here, Applicant's Mark begins with the word "THE," whereas the Cited Mark begins with the letter "E." In general, the letter "E," commonly denotes "electronic," as in "E-Book," "E-Cigarette," etc. Here, it is unclear whether the "E" in the Cited Mark means electronic, but it is highly likely that consumers will read the Cited Mark that way.

Second, Applicant's Mark is in plain English, whereas the Cited Mark is in French. This is an important distinction, not to be dismissed, as it creates an entirely different commercial impression from Applicant's Mark. By using French, rather than English, the Cited Mark sets itself apart from the American lexicon, and from the average American consumer who may not recognize the stylistic flair that the word "LE" conveys.

Lastly, the Cited Mark is incorporated into a very distinct design, consisting of the wording "E LETRAVELER" in stylized font. Applicant's Mark, on the other hand, is in standard characters and lacks any graphics or imagery; this difference contributes to the marks' visual dissimilarity.

In combination, respectfully these differences between the marks result in distinct commercial impressions, making confusion between them unlikely.

3. Applicant's Goods and the Cited Mark's Goods Are Sufficiently Unrelated to Render Consumer Confusion Unlikely

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207, 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). TMEP 1207.01(a).

The Cited Mark's goods are for *Alpenstocks; Attaché cases; Backpacks; Bags for climbers in the nature of all-purpose carrying bags; Beach bags; Briefcases; Business card cases; Canvas shopping bags; Handbags; Harness fittings; Haversacks; Leather laces; Mesh shopping bags; Name card cases; Pet clothing; Pocket wallets; Pouch baby carriers; Purses; School bags; Slings for carrying infants; Sports bags; Suitcases; Travelling bags; Travelling trunks; Trunks; Umbrellas; Valises; Vanity cases, not fitted; Waist bags* in Class 018.

Applicant's goods are for *Vanity bags and cases sold empty*, also in Class 018.

Although Applicant seeks registration in the same class as the Registration (Class 18), the goods themselves are very distinct. Specifically, Applicant's goods consist of a "pop-up organizer" for makeup and other toiletries. Applicant's goods are meant to be a traveling beauty counter, and are directly targeted to women on the go. Registrant's goods, on the other hand, are much broader and consist of general traveling totes and luggage. This is a much broader category of consumer goods that has a much wider targeted audience.

Further, given the significantly more meaningful distinctions between the two marks, described above, the Office must show a proportionally higher degree of relatedness to support a finding that the two marks would overall be confused in the marketplace.

Applicant respectfully maintains that in light of the forgoing arguments these goods are not sufficiently related to warrant the finding of 2(d) confusion.

4. The Channels of Trade and Conditions Under Which Sales Are Made Render Consumer Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. See also *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); See also, *In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public). Additionally, where goods or services move in different channels of trade, confusion as to source is unlikely. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between opposer's mark E.D.S. for computer services and applicant's mark EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets).

Applicant's Mark and the Cited Mark are unlikely to be confused for the reasons set forth above, and because the associated goods are marketed to consumers in completely different markets. Applicant's goods are targeted to women on the go, seeking travel solutions for their personal hygiene products. The Cited Mark's goods, on the other hand, are not directly marketed to consumers at all (at least in the US). Indeed, Applicant searched for the Cited Mark's goods on the internet but was unable to find any web presence demonstrating its channels of trade or consumers to which it markets. This indicates that consumers in the US have no real access to the Cited Mark's goods. While this factor, in itself, is not dispositive, it indicates that consumers will not be confused by Applicant's Mark and the Cited Mark, as the two entities do not cross channels.

Based on the foregoing, the channels of trade and the conditions under which the respective products are sold are distinct, and the 2(d) refusal should be withdrawn.

II. **Descriptiveness Refusal**

1. Descriptiveness Standard

A trademark is not merely descriptive if it does not immediately tell an average potential purchaser what the goods or services are. *In re Energy Resources Corporation*, 173 USPQ 510 (TTAB 1972) (holding ENERGY RESOURCES not merely descriptive of the services of exploration for and production of oil and gas for others). If a trademark does not without interpretation and imagination describe the goods or services, then the trademark is not merely descriptive. *In re The Gracious Lady Service, Inc.*, 174 USPQ 340 (TTAB 1972). If the mental leap between the mark and the applicant's goods and services is not almost instantaneous, this strongly indicates suggestiveness, not mere descriptiveness. See *McCarthy On Trademarks* (4th ed.), § 11.67 at 118. Further, a trademark is not merely descriptive if it is not needed by others to describe the goods or services. See *McCarthy On Trademarks* (4th ed.), § 11.68.

2. Applicant's Mark is Not Merely Descriptive Because it is Suggestive

Applicant's goods are *Vanity bags and cases sold empty*, in Class 018.

Applicant's Mark is TRAVELER. The Examining Attorney reasons that this is merely descriptive because "TRAVELER is defined as a person who travels...TRAVELLER is also used to refer to a classification of bags...Here, the wording describes the nature of the goods and the intended user of the

goods.” Applicant respectfully disagrees and submits that the mark is suggestive because it does not merely convey to the potential purchaser of Applicant’s goods what they are but creates an overall commercial impression that combines the Mark’s components in a stylized manner that has greater significance than the sum of its parts.

As the Examining Attorney correctly states, the word “TRAVELER” is defined as “a person or thing that travels.” When the average consumer hears the word “TRAVELER” they associate it with an individual, and not with an item. Indeed, most people would argue that “travelers” are people. Applicant respectfully submits that the word TRAVELER could have several other connotations or implications apart from the goods identified in the application. Further, the notion that the word “TRAVELER” has any inherent relationship with cosmetics, or a makeup case is tenuous at best. As such, the phrase in its entirety is vague and unclear as to what exactly it is referring to, making Applicant’s Mark inherently suggestive.

Further, Applicant clarifies that by its design, structure, and visual “look”, Applicant’s products are very much compact cosmetics cases, as opposed to luggage or other travel baggage in the traditional sense referenced by the Examining Attorney.

In short, Applicant’s Mark does not describe its goods. In order to reach a conclusion as to the nature of Applicant’s goods, a consumer would perceive the Mark, use rudimentary context clues to suspect the goods have something to do with travel, and only then reach a conclusion that the goods involve makeup cases. In other words, there is a multi-step process for potential consumers to reach the conclusion as to the meaning of Applicant’s mark. This is the sort of multi-stage reasoning that Professor McCarthy writes strongly indicates suggestiveness. *Id.* Therefore, Applicant must conclude that its Mark is not merely descriptive, but is suggestive.

3. Doubts as to Registrability are Resolved in Favor of Applicant and Publication

Applicant respectfully notes that the Office bears the burden of demonstrating mere descriptiveness by a preponderance of evidence. At a minimum, Applicant has raised a doubt about the propriety nature of the classification of Applicant's Mark as merely descriptive. Any doubts concerning the descriptive significance of a mark are to be resolved in favor of Applicant and of passing the mark to publication. *See In re Grand Forest Holdings Inc.*, 78 U.S.P.Q.2d 1152, 2006 WL 337549 (T.T.A.B. 2006).

As the Federal Circuit stated in the case *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987), “It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.” *See also In re the Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380, 382, 1972 WL 17804 (T.T.A.B. 1972) (“It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes ...”).

Therefore, respectfully, the Mark is not merely descriptive of the applied-for goods because it is suggestive. Applicant asks that the 2(e)(1) be withdrawn.

III. Conclusion

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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