

Applicant's Response to Office Action for SN 79299968

The following is Applicant's response to the non-final Office Action dated April 10, 2021.

Applicant has amended the identification of goods to address the alleged issues.

In addition, the Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground that the mark is likely to be confused with the THEODORE MAGNUS mark of Reg. No. 6158040, covering the following goods in Class 20: "Air mattresses for recreational use and not for medical purposes; armchairs; baby changing mats; beds; benches; plastic bins; wood bins; bookcases; plastic boxes; wood boxes; camping mattresses; chaise lounges; chests of drawers; non-metallic closures for containers; clothes hangers; non-metal hooks; console tables; non-metal and non-paper containers for storage or transport; deck chairs; furniture parts, namely, feet for furniture; flower-pot pedestals; flower-stands; footstools; furniture; furniture shelves; non-metal house numbers; inflatable furniture; lap desks; medicine cabinets; mirrors; nesting boxes for household pets; office furniture; picture frames; pillows; plate racks; screens being furniture; chairs; shelves for storage; residential shelving units and component parts thereof, namely, shelves and brackets sold as a unit; shoe dowels, not of metal; shower chairs; sideboards; sleeping pads; sleeping mats; sofas; stakes, not of metal, for plants and trees; step stools, not of metal; stools; stoppers for bottles, not of glass, metal or rubber; tables; mannequins; tent pegs, not of metal; plastic trays for foodstuff packaging; wardrobes; wind chimes."

Initially, Applicant notes that the proper evidentiary standard for evaluating whether a likelihood of confusion is created between ostensibly conflicting marks is set forth in the decision of *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973). This standard evaluates factors such as the similarity or dissimilarity of the marks, the relative strength or weakness of the registered mark, and the conditions under which purchases are made. The analysis must conclude that the likelihood of confusion between two marks must be "probable," that is, it is not sufficient if confusion is merely "possible." See e.g. *Estee Lauder, Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510, 42 U.S.P.Q.2d 1228, 1232-33 (2d Cir. 1997) ("Likelihood of confusion means a probability of confusion, which is more than a mere possibility of confusion."); *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 193, 46 U.S.P.Q.2d 1737, 1740 (5th Cir. 1998) ("Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion."). A mere theoretical possibility of confusion, deception or mistake is insufficient to show "probability." See *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.3d 713, 21 U.S.P.Q.2d 1338 (Fed. Cir. 1992) (citation omitted).

In refusing the applied-for mark in view of the mark of the cited registration, the Examining Attorney submits that marks at issue have similarities in appearance, sound, connotation, and commercial impression. Respectfully, Applicant emphasizes that the Examining Attorney's position does not analyze the marks at issue in their entireties, as the law indisputably requires. The term "magnus" means "great" in Latin, and thus is the commercial impression created by Applicant's mark. In stark and total contrast, the THEODORE MAGNUS mark has the look and feel of a person's name, which is completely lacking from Applicant's mark. Indeed, the name "Theodore Magnus" refers to "a character from the Captain Scarlet and the Mysterons episode Operation Time" (see attached print-out).

Moreover, the cited mark includes an entire eight letter prefix word that is completely missing from Applicant's mark. Indeed, the cited mark has 57% more letters than Applicant's mark. The prefix word also has three syllables completely absent from the Applicant's mark, which remarkably alters the pronunciation and spoken feel. The contention made in the Office Action that "applicant's mark is likely to appear to prospective purchasers as a shortened form of registrant's mark" is pure speculation that cannot support a proper refusal.

Having an element in common, while disregarding the remainder of the marks, is simply not the proper analysis. In contending otherwise, the Examining Attorney selects one aspect of the mark, the term "magnus," for analysis is derogation of the full composite mark. See Office Action, page 1 ("The marks create the same commercial impression because of the common element, MAGNUS..."). This type of dissection is improper under the authority of *Estate of P. D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538 (1920), wherein the U.S. Supreme Court held:

The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. **For this reason it should be considered in its entirety....**

Moreover, according to longstanding precedent, consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Applicant further notes that the existence of nearly fifty "MAGNUS marks" that peacefully coexist on the register for a variety of goods and services, and appends printouts of the same. This tends to suggest that various "magnus" marks can coexist without confusion being probable, and that no single user is entitled to a broad or exclusive right in the term.

In light of the foregoing, Applicant submits that confusion between the applied-for mark and the cited mark is unlikely given the differences in sound, connotation, and commercial impression. Passage of the mark to publication for opposition is respectfully requested.