

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: JK Trading, Inc.
MARK: SPECTRA
SERIAL NO: **90/162290**
FILING DATE: September 6, 2020
TRADEMARK EXAMINING ATTORNEY: Justin Miller
Law Office 130

RESPONSE TO NONFINAL OFFICE ACTION

Commissioner for Trademarks
Post Office Box 1451
Alexandria, Virginia 22313-1451

Dear Sir/Ma'am:

The Examining Attorney issued a Nonfinal Office Action on January 21, 2021 regarding the above-referenced application and has carefully considered its contents. Applicant submits this response in furtherance of its application to register SPECTRA ("Applicant's Mark") in International Class 026 for "Hair extensions; Synthetic braiding hair; Wigs, hairpieces, and add-in and add-on hair accessories constructed primarily of synthetic and/or human hair."

ARGUMENT FOR REGISTRATION

I. PROCEDURAL BACKGROUND

The Nonfinal Office Action was issued on January 21, 2021 and identified two registrations as bases to refuse registration of Applicant's Mark: U.S. Registration No. 4,758,108 (Spectralift) and U.S. Registration No. 6,003,707 (Spectra Salon Suites).

II. APPLICANT'S MARK IS NOT CONFUSINGLY SIMILAR TO THE CITED MARKS

The Court of Customs and Patent Appeals in *In re Du Pont de Nemours & Co.*, 476 F.2d 1357, 1362 (C.C.P.A. 1973), listed thirteen factors to be considered in determining if there is a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) (2006). Importantly, the facts of the *Du Pont* case was ultimately a finding that the mark RALLY for polishing and cleaning agent was *not likely to be confused* with the mark RALLY for all-purpose detergent.

According to the Court, the following must be considered when testing for likelihood of confusion:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to continue trade channels;
- (4) The conditions under which, and buyers to whom, sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) The market interface between applicant and the owner of a prior mark;
- (11) The extent to which the applicant has a right to exclude others from use of its mark on its goods;

- (12) The extent of potential confusion, i.e., whether de minimis or substantial; and
- (13) Any other established fact probative of the effect of use.

Du Pont, 476 F.2d at 1361.

The analysis for likelihood of confusion turns “not [on] the nature of the mark alone, but rather [on] the mark’s effect when applied to the goods of the applicant.” 476 F.2d at 1360. “The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark” in the marketplace. 476 F.2d at 1360-61.

The totality of the factors indicate that consumers will be able to distinguish between the origin of the services offered under Applicant’s Mark and the origin of the goods offered under the Cited Marks, especially as the Board has already determined that consumers can differentiate between the cited mark and numerous other SPECTRA variants without confusion as to the sources of goods or services.

A. Applicant’s Mark and the Cited Marks Are Distinguishable in Appearance, Connotation, and Overall Commercial Impression

The overall appearance and commercial impression created by Applicant’s Mark differs significantly from the Cited Marks. In evaluating a likelihood of confusion, marks must be taken as a whole and compared with regard to their overall commercial impression, including resemblances in sound, appearance, and meaning or connotations. *Du Pont*, 476 F.2d at 1361; *In re Ecopetrol S.A.*, 2015 WL 2170146, *3 (TTAB April 23, 2015). Assessing only one element – resemblance in appearance, sound, or meaning – does not inevitably lead to a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i). See, also, *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007)(it is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669,

673 (Fed. Cir. 1984) ("Of paramount interest is not the descriptive nature of SPICE, but the overall commercial impression derived by viewing the marks in their entirety Arguments to the effect that one portion of a mark possesses no trademark significance leading to a direct comparison between only what remains is an erroneous approach.").

In the present case, while the first portion of Applicant's Mark and the Cited Marks are the same, Applicant's Mark creates a distinct commercial impression when viewing the marks in their entirety.

When viewing the overall commercial impression, the cited mark SPECTRALIFT is not sufficiently similar to Applicant's Mark. The cited mark is a single word, and one aspect of the word should not be given less importance. Spectra, the plural form of the word spectrum, has a commonly understood meaning of "a band of colors...produced by separation of the components of light..." Therefore, the overall impression of the cited mark is the "increasing"(i.e. "lifting") of the spectrum of colors. When viewed in conjunction with the products offered, i.e. hair care preparations...hair coloring preparations, the cited mark implies that the products are used to increase the spectrum of one's hair color. This overall commercial impression is distinct from Applicant's Mark. A review of internet searches for SPECTRALIFT discloses no references to SPECTRALIFT products as of June 14, 2021.

Similarly, when viewing the overall commercial impression, the cited mark SPECTRA SALON SUITES is not sufficiently similar to Applicant's Mark. The cited mark, in its overall commercial impression, is designed to identify the Mark as being associated with a grouping of rooms (suites) to be used by beauticians (salon). Salons are not only associated with hairdressers, but also with the whole beauty process, including facials, manicures, pedicures, makeup services, massages, etc. See, e.g., TRICOCI SALON SPA (Reg. No. 6,297,270 for,

among other services, skin care...massage therapies...nail manicuring services, foot treatments...hand and foot treatments...waxing...aromatherapy, body wraps...skin tanning...); SALON APPEARANCES (Reg. No. 6,181,592 for "beauty spa services, namely, providing facial and body treatment services and massages"); DOUGLAS J SALON (Reg. No. 6,001,525 for, among other things, "providing massage, facial and body treatment services..., nail care, manicures, pedicures...make-up application services"). Thus, the Cited Mark implies that the Registrant is offering a spectrum (variety) of salon services, not limited to hair dressing or hair styling. This is confirmed when viewing the website for the Cited Mark – the registrant is offering a location for stylists to provide services. No products are offered. See Exhibit A.

While the Applicant's Mark and the Cited Marks share the word SPECTRA in common, the overall commercial impressions of the marks are sufficiently distinct from the Applicant's Mark so that this factor should not weight so heavily against registration. The fact that SPECTRA SALON SUITES and SPECTRALIFT were both approved for registration indicates that there is significance to the marks as a whole, and that consumers consider the other portions of the mark to be just as important, and just as critical, as the first portion of the marks.

B. Applicant's Goods Are Distinguishable from the Goods/Services Offered Under the Cited Marks, and Such Goods Travel in Different Channels of Trade

Applicant recognizes that there exists some overlap between the goods to be sold with the Applicant's Mark, the goods sold under the SPECTRALIFT Mark, and the services provided under the SPECTRA SALON SUITES Mark. Although the Cited Marks and Applicant's Mark are in the general area of hair care, there still exists some distinction between the goods of Applicant's Mark and the services of the Cited Marks.

As to the SPECTRA SALON SUITES Mark, the goods/services offered under the Marks are distinguishable. As demonstrated by the website advertising SPECTRA SALON SUITES (www.spectrasalonsuites.com), the Cited Mark is primarily, if not exclusively, a mark denoting a new concept in salon suites with currently one location with a second location to be opened. The Cited Mark is being promoted as a franchise concept. There is no indication that the Cited Mark is being used with any goods to be sold, although the Examiner's cited evidence tends to show that salons may sell privately labeled products within their salon. Consumers that see a similar mark, such as Applicant's Mark, outside of the SPECTRA SALON SUITES would not be confused into thinking that the private label products offered in-house by a salon would be available elsewhere.

As to SPECTRALIFT, Applicant continues to find that the goods are related but not similar, but agrees to modify its description of goods/services to specifically "exclude" the types of hair care products offered under the Cited Mark.

C. Applicant's and Registrants' Buyers/Users are Sophisticated and are Unlikely to be Confused by the Marks

This factor is really made up of two separate but interrelated queries discussed below: (1) how much care would an ordinary consumer use in purchasing the goods or services at issue, or *what type of product* is she purchasing? (2) How knowledgeable is the purchaser about the goods or services at issue, or *what type of purchaser* is she?

Courts hold that even seemingly low-priced items require consumer brand awareness and sophistication. *Star Indus. v. Bacardi & Co.*, 412 F.3d 373, 390, 75 U.S.P.Q.2d 1098 (2d Cir. 2005) (“Unhurried consumers in the relaxed environment of the liquor store, making decisions about \$12 to \$24 purchases, may be expected to exhibit sufficient sophistication to distinguish between [plaintiff's and defendant's] products, which are differently labeled.”). See

also *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 4 U.S.P.Q.2d 1216 (10th Cir. 1987) (treatise cited) (designer jeans costing \$15–60); *Black & Decker, Inc. v. North American Philips Corp.*, 632 F. Supp. 185, 228 U.S.P.Q. 659 (D. Conn. 1986) (\$20–\$40 portable vacuum cleaners); *Sunbeam Corp. v. Equity Ind. Corp.*, 635 F. Supp. 625, 229 U.S.P.Q. 865 (E.D. Va. 1986) (\$59 compact food processors),

Consumers with some expertise or sophistication regarding the products at issue are less likely to be confused by similar products. *E.g.*, *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 102, 57 U.S.P.Q.2d 1969 (2d Cir. 2001) (“The more sophisticated the consumers, the less likely they are to be misled by similarity in marks.”); *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 718, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (holding that purchaser sophistication “is important and often dispositive because sophisticated consumers may be expected to exercise greater care”) (citation omitted); *In re Phoenix Intangibles Holding Co.*, 2002 TTAB LEXIS 131 (T.T.A.B. 2002) (owners and purchasing agents of supermarkets and restaurants are “sophisticated and knowledgeable” about food and would “easily distinguish between applicant’s mark RIVER CITY CHICKEN COMPANY and registrant’s mark RIVER CITY”).

Professionals purchasing goods for their business are typically considered to be more sophisticated buyers. *E.g.*, *Virgin Enterprises, Inc. v. Nawab*, 335 F.3d 141, 151, 67 U.S.P.Q.2d 1420 (2d Cir. 2003) (“Where the purchasers of a products are highly trained professionals, they know the market and are less likely than untrained consumers to be misled or confused by the similarity of different marks.”); *Oreck Corp v. U.S. Floor Systems, Inc.*, 803 F.2d 166, 231 U.S.P.Q. 634 (5th Cir. 1986) (holding that “persons are buying for professional and institutional purposes at a cost in the thousands of dollars ... are virtually certain to be informed, deliberative

buyers”); *Savin Corp. v. Savin Group*, 391 F.3d 439, 461, 73 U.S.P.Q.2d 1273 (2d Cir. 2004) (upholding finding of district court that purchases of large business equipment or professional engineering services are “often the result of careful deliberation by more than one individual in the purchasing organization” and the likelihood of confusion is “remote”) (citation omitted).

Applicant's products are purchased, primarily, by hair dressers that are professionals that are working to add hair extensions for a customer. The consideration of the type and kind of hair extensions to be placed into a customer's hair is not an impulse purchase, but is one that is done with care and deliberation.

D. The Co-Existence of Many SPECTRA Marks Weighs Against a Finding of Likelihood of Confusion.

Federal courts and the Board have long recognized that the coexistence of third-parties' use and/or registration of similar marks is evidence of the scope of protection to be accorded to the prior mark. *See, e.g., Nat'l Motor Bearing Co. v. James-Pond-Clark*, 266 F.2d 799, 803, 121 U.S.P.Q. 515 (C.C.P.A. 1959) (finding CIRCLE SEAL and Sea Lion Design for valves not confusingly similar to Sea Lion Design for O-rings); *Shoe Corp. of Am. v. Juvenile Shoe Corp.*, 266 F.2d 793, 796, 121 U.S.P.Q. 510 (C.C.P.A. 1959) (finding LAZY PALS and LAZY BONES, both for shoes, not confusingly similar); *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559, 1565-66, 1996 WL 253841, *3-5 (TTAB March 26, 1996) (finding BROADWAY PIZZA and BROADWAY CHICKEN, both for restaurant services, not confusingly similar).

More recently, the Federal Circuit found the Trademark Trial and Appeal Board (the "Board") gave inadequate consideration to the strength or weakness of the marks by discounting "evidence of a fair number of third-party uses of marks containing 'peace' and 'love' followed by a third, product-identifying term" based on the ground there were no "specifics regarding the

extent of sales or promotional efforts surrounding the third-party marks and, thus, what impact, if any, these uses have made in the minds of the purchasing public." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339-40 (Fed. Cir. 2015). In that case, the Federal Circuit held the Board should have considered "whether and to what degree the extensive evidence of third-party use *and registrations* indicates that the phrase PEACE & LOVE carries a suggestive or descriptive connotation in the food service industry, and is weak for that reason," which was required for "a proper likelihood-of-confusion inquiry." *Id.*

Among other uses of a version of SPECTRA include:

1. BIO SPECTRA ATTITUDE, Reg. No. 4,369,387, for goods in International Class 003 including, but not limited to, "baby shampoo, shampoo and hair conditioner for adults...."
2. BIO SPECTRA ATTITUDE, Reg. No. 4,989,519, for goods in International Class 003 including, but not limited to, "shampoo, conditioners for hair,...3 in 1 shampoo/body wash/conditioners,...hair detangler,...hair oil, hair colour, hairspray, hair gel, hair wax, hair mousse...."
3. BIO SPECTRA ATTITUDE NATURAL CARE, Reg. Nos. 5,933,216 and 5,993,217, for goods in International Class 003, for similar goods as marks listed above.
4. SPECTRA REFRACTOLOGY, Serial Number 88/393,506, for "hair care preparations; hair coloring preparations; hair styling preparations" which mark was allowed but subsequently abandoned for failure to file statement of use.

In light of the marks that currently co-exist, SPECTRA-based marks are relatively diluted with regard to such goods and services, and consumers do not associate those terms with a single

source. The co-existence of these marks also suggests that consumers are accustomed to paying attention to the non-common variations among SPECTRA marks. *See In re Broadway Chicken*, 1996 WL 253841 at *3.

E. Applicant Adopted the Onyx Ocean Mark in Good Faith

“[C]ourts regularly include intent as one of the factors to be considered in evaluating the likelihood of confusion.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 22, Reporter’s Note to cmt. b, at 248 (1995); *see* 4 MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 23:110 (“It is well established that an intent of the alleged infringer to gain through confusing customers or others is relevant to the issue of likelihood of confusion....”). Applicant adopted its Mark without any predatory intent. In choosing this mark, Applicant did not adopt it to trade on anyone’s reputation, including that of the owner of the Cited Mark.

F. Under an Application of All the Relevant Factors, Confusion Is Highly Unlikely

“A showing of mere possibility of confusion is not enough; a *substantial likelihood* that the public will be confused must be shown.” *Omaha Nat’l Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231, 234, U.S.P.Q. 51 (D. Neb. 1986) (emphasis added). Applicant submits that all relevant factors set forth in *DuPont* clearly support Applicant. Under these circumstances, and absent “*substantial doubt*,” Applicant’s application should pass to publication. *In re Mars, Inc.*, 741 F.2d 395, 396, 222 U.S.P.Q. 938 (Fed. Cir. 1984) (emphasis supplied) (finding CANYON for candy bar not likely to be confused with CANYON for fruit).

III. CONCLUSION

