

Response to Office Action  
Serial No. 90172464 – Filed on – August 13, 2020  
Date of Issuance of Office Action – January 21, 2021

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In re Application of: LONZO BALL  
Serial No.: 90172464  
Filed: September 9, 2020  
Mark: LONZO BALL

### **RESPONSE TO OFFICE ACTION**

Dear Mr. Ronald L. Fairbanks, Esq.:

Applicant, Born to Ball, Inc., a corporation, by and through his counsel, responds as follows to the Office Action dated January 21, 2021, entered in the above captioned application for the mark, LONZO BALL (Serial No. 90172464) (hereinafter, the “**Mark**”) in contention to LONZO (Reg. No. 5774073) (hereinafter, the “**Registered Mark**”).

#### **I. THE MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED REGISTERED MARK**

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 good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The Federal Circuit Court of Appeals articulated thirteen factors for the purpose of deciding a likelihood of confusion on a case-by-case basis, commonly known as the *DuPont* factors. The first factor examines the “similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Id.* The second factor examines the “similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.” *Id.*

##### *A. No Similarity in Sight, Sound, Connotation or Commercial Impression*

The Examining Attorney argues on the basis of the first *DuPont* factor simply that, “[i]n the present case, the marks are identical in part”, without further reasoning. *Office Action*, p. 1.

Per the Supreme Court’s Anti-Dissection Rule, a mark must be considered in its entirety in determining a likelihood of confusion. *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920) (“[t]he 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"); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974) ("[i]t 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"); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) ("[l]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark."); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000). Thus, it is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important.

Here, Applicant respectfully disagrees with the Examining Attorney. In accordance with the Supreme Court's Anti-Dissection rule, an examination of the appearance of the Mark and Registered Mark reveal clear differentiation. Specifically, the Registered Mark is an obvious unitary expression without additional elements. Albeit the Registered Mark is somewhat unique, when the Registered Mark is seen, it undeniably is viewed as a solitary word and nothing more. Conversely, the Mark is comprised of two distinct names to create the identification of a well-known public figure. In this respect, "Lonzo" and "Ball" cannot be separated because it is the full name that reasonably prudent consumers are accustomed to encountering. Thus, the Mark must be read together as the Mark is well understood to be recognized.

Moreover, it is obvious that the Mark as "LONZO BALL" is more complex and lengthened than simply the solitary expression of the Registered Mark. Upon observation of the Mark, it is clear that its multiple elements are material in comparing the marks. Thus, the Mark must not be dissected to be analyzed piece-meal because the Mark does not have a dominant portion when taken as a whole.

Accordingly, the Mark's composition of a distinguished first and surname, unequivocally distinguishes its sight and sound from the Registered Mark. It is in error to simply focus on the first element of the Mark, because both characters of the Mark specifically identify a famous professional athlete, whereas, the Registered Mark alone has no meaning. Moreover, the multiple names in the Mark also create a distinguished commercial impression that would not lead to a likelihood of confusion in the average reasonably prudent buyer (see, *infra*).

Furthermore, under the overall commercial impression analysis, there is no rule that a mark will be automatically deemed confusingly similar if a junior user's mark contains in part the whole of another's mark; "determination must arise from a consideration of the respective marks in their entireties." *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (finding PEAK PERIOD not confusingly similar to PEAK); *Application of Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); see also *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L.

Ed. 705 (1920) (holding the commercial impression of a mark is derived from it as a whole, not from its elements separated and considered in detail).

Here, the Registered Mark is represented as a solitary word without association. After a comprehensive search to ascertain the character of the Registrant's brand, it appears that it does not exist. In this regard, it is inconclusive as to what the Registered Mark is supposed to symbolize, or what exactly is the commercial impression it connotes. Conversely, the Mark, when taken as a whole, is used to connote an identifiable professional athlete who the average consumer is familiar with. In this respect, it is undeniable that the Mark represents a public figure who has expanded his business venture into apparel and clothing design.

Accordingly, it is undetermined what the Registered Mark connotes as it is simply a unitary word without meaning that is associated with presumably a nonexistent company. Whereas, the Mark when observed in its totality as the full name of a prominent athlete, undeniably creates a commercial impression for a brand associated with a public figure who has expanded his commercial endeavors into the apparel industry.

Therefore, the Mark's use of "Lonzo" itself should not elicit a likelihood of confusion in the average reasonably prudent buyer. Moreover, the Mark must be viewed in its entirety because "LONZO BALL" is clearly an identifiable celebrity.

*B. Commercially Related However Not Likely to Be Encountered Together in The Marketplace by Consumers*

The Examining Attorney argues the respective mark's goods are commercially related on the basis of the second *DuPont* factors by presenting both marks' goods under IC 025:

"The applicant provides: Coats; Dresses; Hats; Lingerie; Pants; Shirts; Shorts; Skirts; Underwear; Hoodies; Jackets; Pajamas; Scarves; Vests; Visors being headwear; Skull caps.

The registrant provides: Athletic uniforms; Baselayer tops; Bathing caps; Bathing suits; Beachwear; Bicycle gloves; Bikinis; Blouses; Bras; Brassieres; Caps with visors; Cardigans; Corselets; Down jackets; Dresses; Ear muffs; Hats; Hosiery; Knit shirts; Knitted gloves; Knitted underwear; Knot caps; Leotards; Mittens; Nightgowns; Overcoats; Riding gloves; Scarfs; Scarves; Shawls; Shirts; Shoes; Short-sleeved shirts; Shorts; Ski gloves; Skirts; Small hats; Stockings; Suits; Sweaters; Sweatshirts; Swimwear; T-shirts; Tank-tops; Tights; Trousers; Underpants; Underwear; Wind-jackets; Wind suits; Women's underwear; Women's clothing, namely, shirts, dresses, skirts, blouses; Women's hats and hoods; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses and footwear; Sweatpants." *Office Action*, p.1.

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (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); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

Here, Applicant respectfully disagrees with the Examining Attorney. First, the Registered Mark is associated with a nonexistent brand that has not engaged in any marketing activity whatsoever. In this respect, it is reasonable to assume that consumers, even those seeking products bearing the Applicant's name, would not encounter the Registered Mark in the marketplace. To be clearer, consumers would not confront both marks in the marketplace because the Registered Mark is not offered or available on the relevant goods.

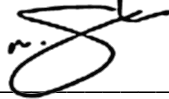
Conversely, the Mark is actually marketed for and offered on the relevant goods. Moreover, the Mark is already well known and recognizable without comprehensive advertising. In this respect, the Mark is already distinguishable when reasonable average consumers encounter the Mark on the relevant goods. Thus, consumers will only encounter the Mark in the marketplace because unlike the Registered Mark, consumer can actually purchase goods under IC 025 bearing the Mark.

Therefore, it is impossible for a likelihood of confusion between the marks, because the Registered Mark is not actually available in the market, whereas, the Mark is marketed for or offered on the relevant goods.

## II. CONCLUSION

Ultimately, given that the Mark in relation to the Registered Mark is not a sufficiently similar in terms of their sight, sound, overall commercial impression, and marketing, it is unlikely that confusion will result from Applicant's use and registration of the Mark. As such, Applicant respectfully requests that the objections of the Examiner be withdrawn, and the subject application be allowed to proceed.

Respectfully submitted,



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Attorney for Applicant

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Date: July 13, 2021