

OFFICE ACTION RESPONSE

This communication is in response to the Office Action dated January 14, 2021, issued against the above-referenced mark (“Applicant’s Mark” or “Mark”). In particular, the Examining Attorney refused registration of Applicant’s Mark based on a perceived likelihood of confusion with a prior registration for BE A MENTOR & Design (U.S. Reg. No. 4019908) owned by The Lynn and Foster Friess Family Foundation (the “Cited Mark”).

Applicant, Chad Taylor, hereby responds to the Office Action as set forth below and respectfully requests that the Examiner withdraw the Section 2(d) refusal and approve Applicant’s Mark for publication.

I. NO LIKELIHOOD OF CONFUSION WITH THE CITED MARK.

Applicant respectfully submits there is no likelihood of confusion between his Mark and the Cited Mark. In determining if a likelihood of confusion exists, “[t]he issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods.” TMEP § 1207.01. Thus, even in instances where the goods or services at issue are similar or identical, a likelihood of confusion will only be found if the relevant purchasing public would mistakenly believe that the applicant’s goods or services originated from the same source as the registrant’s goods or services. *FBI v. Societe: “M. Bril & Co.”*, 172 USPQ 310 (TTAB 1971). For a likelihood of confusion to exist, consumer confusion as to the source of the applicable goods or services must be “probable” not simply “possible.” *Cohn v. Petsmart, Inc.*, 281 F.3d 837, 842 (9th Cir. 2002) (internal citations omitted); *see also Elvis Presley Enterprises, Inc. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998) (“Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion.”) (emphasis added).

The question of likelihood of confusion between marks is “not related to the nature of the mark but to its effect ‘when applied to the goods of the applicant.’ The only relevant application is made in the marketplace. The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding the use of a mark.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (internal citations omitted). In determining whether there is a likelihood of confusion, courts look to many factors, e.g., the similarity of the marks in sight, sound, connotation and commercial impression, the relatedness of the goods or services, the channels of distribution of the goods and services, and the strength of the senior user's mark. *Id.* No single factor is dispositive and “each [factor] may from case to case play a dominant role.” *Id.* at 1357.

Here, application of the most relevant *DuPont* factors demonstrates that there is no likelihood of confusion between Applicant’s Mark and the Cited Mark because: (A) the marks are

distinguishable in sight, sound, meaning, and overall commercial impression, and (B) Applicant utilizes different marketing channels and targets a different customer base than the Cited Mark.

A. Applicant's Mark is Distinguishable from the Cited Marks in Appearance, Sound, Meaning, and Overall Commercial Impression.

The mere fact that two marks incorporate common overlapping words does not render the marks too similar. *See, e.g., Sun Banks of Fla., Inc. v. Sun Fed. S&L Ass'n*, 651 F.2d 311, 316 (5th Cir. 1981) ("Sun Federal and Savings Loan Association" not confusingly similar to "Sun Banks"); *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985) ("Freedom Savings and Loan" and "Freedom Realty" marks "lack ... confusing similarity"); *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888 (Fed.Cir.1986) ("Romanburger" and "Roman" marks for food products "are not similar in appearance"); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 260 (5th Cir. 1980) ("Domino's Pizza" not similar to "Domino sugar"); *Bell Labs., Inc. v. Colonial Prods.*, 644 F.Supp. 542, 547 (S.D.Fla.1986) ("Final flip" and "Flip" marks for same product are "ultimately different and different sounding"); *Little Caesar Enters. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) ("Pizza Caesar U.S.A." not similar to "Little Caesar's") ; *Conde Nast Publs., Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (C.C.P.A. 1975) ("Country Vogues" and "Vogue" publications "do not look or sound alike"); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (C.C.P.A. 1973) ("Silk 'n' Satin" beauty and bath lotion and oil not similar to "Silk" face cream); *Streetwise Maps v. VanDam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998) ("Streetwise" is not confusingly similar to "Street-Smart" for maps even though the names sound similar).

When comparing marks, the Examining Attorney must observe the "Anti-Dissection Rule," which dictates that marks are not to be dissected, but rather are to be considered as a whole in a likelihood of confusion analysis. *See* TMEP § 1207.01 (citing *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985)); 4 *McCarthy on Trademarks and Unfair Competition* § 23:41 (4th ed.). Notwithstanding the "Anti-Dissection Rule," it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ at 751.

In comparing the marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of a trademark. *See, e.g., In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009).

Even in the circumstance where a junior user's mark incorporates another's mark in its entirety, "there is no rule that confusion is automatically likely[.]" J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:41 (4th ed. 2017) (emphasis added). In numerous cases, the TTAB has held that no likelihood of confusion existed between two marks for the same or related goods, despite the fact that one mark contained the whole of the other. *See,*

e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc., 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (CATFISH BOBBERS not confusingly similar to BOBBER); *In re Ferrero*, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). “It is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, which is important.” *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 4 U.S.P.Q.2d 1942, 1944-45 (6th Cir. 1987) (citing 4 J. Thomas McCarthy, Trademarks and Unfair Competition § 23:15 (2d ed. 1984)).

Accordingly, for the reasons discussed below, Applicant respectfully asserts that his Mark and the Cited Mark are distinguishable in sight, sound, and meaning, and convey distinct overall commercial impressions such that there is no likelihood of confusion.

i. The Marks Look and Sound Different.

In the present case, Applicant’s Mark and the Cited Mark are sufficiently distinguishable in visual appearance and sound to avoid consumer confusion. “When the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity.” See TMEP 1207.01(c) (citing *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990)). “In this situation, consideration must be given to the fact that the marks usually will not be viewed side-by-side in the marketplace and a purchaser’s recollection of design marks is often of a general, rather than specific, nature; thus the marks may be confusingly similar despite differences between them.” *Id.* Further, when a mark consists of both words and design elements, “the fundamental rule in this situation is that the marks must be considered in their entirety” and not dissected into their component parts. See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (C.C.P.A. 1974).

Furthermore, it is improper to simply ignore the design elements because such marks are “visualized.” *In Re Covalinski*, 113 U.S.P.Q.2d 1166 (T.T.A.B. 2014) (finding REDNECK RACEGIRL & Design not confusingly similar to word registration for RACEGIRL for goods of clothing); *In re Electrolyte Lab'ys, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990). Rather, where marks have common features, with similar goods and similar channels of trade, a comparison of the similarities ***and dissimilarities*** must be taken into consideration to determine the overall impression on whether the marks are confusingly similar. *In re Electrolyte*, 929 F.2d. 647 (emphasis added).

In re Electrolyte, the Board denied registration of K+ & Design on the grounds of prior registration for K+EFF & Design for similar goods, because the Board determined that the textual

elements of the marks were too similar. *Id.* The Federal Circuit determined that such finding was improper because the design elements of the marks are “viewed” rather than just spoken, and therefore the marks cannot be treated simply as word marks. *Id.* Rather, the Board should have taken into consideration not only the vocalizable elements of the marks, but also the visual indica. *Id.*

Like in *In Re Covalinski* and *In re Electrolyte*, the Examiner must consider all elements of the marks. Here, the Cited Mark is a design mark and the scope of protection afforded to this mark protects the mark as a whole, not just its individual component parts, which happen to include the word MENTOR. Not only are there clear differences in the spoken elements of the marks MENTOR vs. BE A MENTOR, the visual elements are vastly dissimilar. Specifically, the Cited Mark also includes the design of two birds, with the bigger bird on the right and a smaller bird on the left. Applicant’s Mark looks nothing like this mark and therefore, when the marks are compared in their entirety, it becomes clear that consumer confusion is not likely.

Notably, Applicant’s Mark appears to consumers in the following format:



In contrast, the Cited Mark appears as follows:



Applicant’s stylization looks very different from design element of two birds and font style used for the textual elements of the Cited Mark.

Consumers encountering these marks in the marketplace must see and pronounce the entirety of each mark to fully perceive the marks and will notice the obvious visual and phonetic differences between them, including the distinctly different design elements and will not be confused. Therefore, Applicant respectfully submits that once consumers see the marks and process the visual differences between them, confusion is highly unlikely.

ii. The Marks Have Different Meanings and Convey Different Overall Commercial Impressions.

Applicant respectfully submits that the meanings and commercial impressions created by the parties’ marks is distinguishable. Specifically, Applicant uses the mark “MENTOR” in

connection with promoting and encouraging people to give their time and knowledge to others in the form of mentoring. The products sold under Applicant's Mark are marketed and sold to those who have joined the mentoring community and/or those who would like to recognize someone that gives their time to be a mentor. See Printouts from Applicant's website at <https://www.mentorempire.com>, attached hereto as **Exhibit 1**. The applied-for Mark is used along with the mentoring services provided by The Taylor Foundation. Chad Taylor started The Taylor Foundation after finding out that the Intensive Confinement Center ("ICC") based out of California was closing from lack of funds. The ICC was a his life saving experience for Chad Taylor, who after completing it vowed to change his life for good and became a successful business entrepreneur. Learning that the opportunity that was so meaningful to Mr. Taylor would no longer be a viable option for a second chance of a successful life for youths in the criminal system, Mr. Taylor felt compelled to create a non-profit organization in hopes of being able to fill the huge void the closure if the ICC would create. As part of those services, Mr. Taylor created Mentor Empire in hopes of encouraging others with a similar past to mentor youths, particularly those newly into the system for a first time offense, in hopes to lead them down a successful life such as Mr. Taylor's. See video regarding The Taylor Organization, <https://mentorempire.com/pages/about-us>.

Unlike the Applicant's Mark, the Cited Mark conveys a message of persuasion, simply telling others that they should become a mentor. The commercial impression and purpose of the organizations are also vastly different. The Lynn and Foster Friess Family Foundation ("Registrant") is a Christian based foundation. Mr. Foster Friess, a born again Christian and billionaire from his bank investment business, and his wife, Lynn, created the foundation as their philanthropic organization. The Registrant does not currently provide programs, including mentorship programs. Rather, Registrant gives grants/financial donations "primarily to faith-based entrepreneurial inner-city programs, especially one-on-one mentoring." with a geographic focus in Arizona, Delaware, Georgia and Wyoming. See Printouts from City Vision University Grant Directory, Here-4-You Consulting, and Foundation Directory Online, attached hereto as **Exhibits 2, 3 & 4**. Indeed, after a successful 2020 year in stocks, Registrant gave over \$40 million dollars in donations to other non-profit organization throughout the United States. See Printout of Article "Friess Friends Help Them Give Away \$40 Million" attached hereto as **Exhibit 5**. The Friess Foundation does not currently have an active website and access to it is denied (<https://www.lifeenrichmentfoundation.org/>), and there is no ability to purchase or view the goods of clothing. In addition, to the best of Applicant's knowledge, there is no ability to purchase such goods from a third-party outlet. While Applicant recognizes that this is not the appropriate forum to challenge a cited registration, Applicant believes it is important to note that the Cited Mark may no longer be in use and may not be renewed by the upcoming renewal deadline (as discussed below).

Given the differences in the meanings and overall commercial impressions conveyed by Applicant's Mark, on the one hand, and the Cited Mark, on the other hand, combined with the differences between the marks in sight and sound, Applicant respectfully submits that consumers are unlikely to be confused as to the source of the parties' respective goods.

B. Applicant Employs Different Marketing Channels and Targets a Different Customer Base Than the Cited Mark.

Applicant submits that any risk of confusion becomes virtually nonexistent when one considers how consumers will actually encounter the respective marks out in the marketplace. Methods of marketing and channels of distribution are factors to be considered in determining likelihood of confusion. *See du Pont*, 177 U.S.P.Q. 563. “[I]f the goods of one party are sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is less than if both parties sold their goods through the same channels of distribution.” *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION sec. 24:51 (2013). Additionally, courts have frequently found no likelihood of confusion when one mark user sells exclusively at retail and the other sells exclusively to commercial buyers. *See id.* (citing *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959); *David Crystal, Inc. v. Soo Valley Co.*, 471 F.2d 1245 (C.C.P.A. 1973); *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440 (9th Cir. 1980)).

Furthermore, even when related goods or services are distributed in differing marketing channels, the courts have often found no likelihood of confusion. *See Paul Sachs Originals v. Sachs*, 325 F.2d 212 (9th Cir. 1963) (finding no likelihood of customer confusion when girl’s dresses and women’s dresses sold to different customers in different stores); *Field Enterprises Educ. Corp. v. Cove Industries, Inc.*, 297 F. Supp. 989 (E.D.N.Y. 1969) (finding different channels of encyclopedia distribution door to door sales versus department store sales). In *Esté Lauder Inc. v. Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997), the court distinguished marketing channels by the characteristics of the customers and the location of the sales. Plaintiff sold its personal care products only through prestigious retail stores while the defendant sold to a younger group of buyers through its own “Gap Old Navy” stores. The court found that while the customers could overlap, the differences in locations and the target markets were sufficient to prevent the likelihood of confusion. *See id.* Additionally, in determining the dissimilarity of trade channels, the Sixth Circuit considers “how and to whom the respective goods or services of the parties are sold. Where the parties have different customers and market their goods or services in different ways, the likelihood of confusion decreases.” *Therma-Scan, Inc. v. Thermoscan, Inc.*, 63 U.S.P.Q.2d 1659, 1666 (6th Cir. 2002) (internal citation omitted). In that decision, the court held that the focus should be on the targeted consumers and marketing methods employed rather than rely solely on the fact that both THERMA-SCAN and THERMOSCAN enjoyed an Internet presence.

In this case, Applicant’s and Registrant’s products are marketed to different groups of consumers in different channels of trade. In particular, Applicant’s products are sold only through Applicant’s website. *See* Exhibit 1. Further, MENTOR products are sold and marketed specifically to mentors or to those customers looking to buy a gift for a mentor. In contrast, Registrant’s BE A MENTOR-branded goods cannot be found and do not appear to be sold by third party retailers. Therefore, the target purchaser of Registrant’s products is someone connected to the Friess Foundation in some way, whereas, Applicant’s target customer is a specific subset of the general public that either provides or receives mentoring.

Given the divergent channels of marketing and target customers of Applicant and Registrant, as well as the other differences between the parties' marks as noted above, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

II. ALTERNATIVE REQUEST FOR SUSPENSION.

In the alternative, if the Examining Attorney is unpersuaded by the arguments set forth above and is inclined to issue a final refusal under §2(d) of the Trademark Act, Applicant respectfully requests that the Examiner suspend Applicant's application. Specifically, the Cited Mark must file its Section 8 and 9 Declaration by August 30, 2021, with the grace period expiring on February 28, 2022. If the Registrant fails to timely file the § 8 & 9 renewal application and the Cited Mark is cancelled, it will no longer be a bar to registration of Applicant's Mark. As such, Applicant believes that he has good cause to request to suspend action on his application pending the outcome of the renewal or cancellation of the Cited Mark.

III. CONCLUSION.

Based on the foregoing, Applicant believes that all outstanding objections and issues have been resolved and therefore, respectfully requests that the Examiner withdraw the likelihood of confusion refusal and approve Applicant's Mark for publication. In the alternative, if the Examining Attorney is not persuaded by the arguments presented, Applicant believes that suspension of his application is warranted, and therefore, respectfully requests that his application be suspended pending the renewal or cancellation of the Cited Mark.