

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Date: April 27, 2023

To: Karen K. Bush

Trademark Examining Attorney

Law Office 108

United States Patent and Trademark Office

RE: Serial No.: 97353263

Mark: ELEMENTS

Applicant: Viva Novitas LLC

APPLICANT'S RESPONSE TO OFFICE ACTION

Applicant Viva Novitas LLC, by and through its undersigned counsel, submits the following response to the Office Action issued against its Section 1(a) application, U.S. Trademark Application Serial No. 97353263, filed April 8, 2022, for the standard character mark ELEMENTS in International Class 10 for the following goods:

“Adult sexual stimulation aids, namely, original handmade artificial penises in Phallic, Non Phallic, Science Fiction and Fantasy Inspired, and Abstract shaped.”

Applicant seeks registration on the Principal Register.

2(d) REFUSAL

The Examining Attorney identified “ELEMENT MS,” “ELEMENT CR,” and “ELEMENT PM”, which were registered with the USPTO and given, respectively, U.S. Application Serial Nos. 5266895, 5266896, and 5266897 (the “Cited Marks”), as the basis for refusal of Applicant’s standard character mark, ELEMENTS (the “Applicant’s Mark”), under Trademark Act Section 2(d) because of a likelihood of confusion between the Applicant’s Mark and the Cited Marks. For the following reasons, Applicant respectfully disagrees and requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant’s Mark.

Likelihood of confusion between two marks is determined by analyzing all of the relevant factors under the *DuPont* test. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Any one of the thirteen DuPont factors may be the dispositive factor in the determination that there is no likelihood of confusion. See TMEP § 1207.01. Even when the marks share certain terms or the goods and/or services are related to a common industry, those concerns may be offset by other factors, such as other similar marks in the marketplace in connection with similar goods and/or services, the trade channels of the goods/services, sophistication of consumers, and other factors, which, upon evaluation, will lead to the determination that there is no likelihood of confusion. *Id.*

The Applicant seeks registration of the standard character mark “ELEMENT” in connection with “Adult sexual stimulation aids, namely, original handmade artificial penises in Phallic, Non Phallic, Science Fiction and Fantasy Inspired, and Abstract shaped” in International Class 10. The Examining Attorney alleged a conflict between Applicant’s Mark and the Cited Marks, all for “Massage apparatus; Massaging apparatus for personal use” in International Class 10. There is no likelihood that consumers will be confused as to the source of the services in connection with each of these two marks because Applicant's Mark is different in appearance, sound, and commercial impression. Further, the goods offered in connection with Applicant's Mark and the Cited Mark are different, noncompetitive, and marketed towards different consumers. Therefore, Applicant respectfully requests the Examining Attorney withdraw the refusal and allow Applicant's Mark to be published on the Principal Register.

The Marks are Different in Appearance, Sound, Meaning, and Commercial Impression

Under *DuPont*, marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, connotation, and commercial impression. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). When comparing marks that share a literal element, the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. TMEP §1207.01(b)(iii); *see Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re SD. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Applicant's Mark and the Cited Marks, while somewhat similar, are different in appearance, sound, and commercial impression. Applicant's Mark is plural and consists of only one word, whereas the Cited Marks are all singular and each contains additional letters set apart from the first word (to wit, CR, MS, and PM). As such, they differ in appearance and sound.

As for meaning and commercial impression, the marks are quite different, especially when analyzed in light of their respective goods. *See, e.g., In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color and durability adapted to outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase "Drink Up" when applied to men's suits, coats, and trousers, but does not have this connotation when applied to ladies' and children's underwear). The word "ELEMENTS" brings to mind the elements of nature (earth, wind, fire, and water), whereas the word "ELEMENT" is commonly understood to mean "a component or constituent of a whole¹." Therefore, the commercial impression created by Applicant's Mark is that of nature and natural forces, while the public would understand the Cited Marks to be a part of something larger, which is further described by the following letters CR, MS, and PM. Differences in connotation alone are sufficient to avoid finding marks confusingly similar. The Trademark Trial and Appeals Board has noted that ". . . in other close cases of this nature, where [the marks have different connotations]... such factor has played an important role in this Board's conclusion of no likelihood of confusion." *In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (TTAB 1987). Thus, distinct connotations tend to outweigh similarity of spelling or sound. As a result, the Applicant's Mark and the Cited Marks convey significantly different commercial impressions, which weighs against a finding of a likelihood of confusion.

The Marks are Used in Connection with Different Goods and Target Different Consumers

Applicant is seeking to register its ELEMENTS mark in connection with "Adult sexual stimulation aids, namely, original handmade artificial penises in Phallic, Non Phallic, Science Fiction and Fantasy Inspired, and Abstract shaped." The Cited Marks are used in connection with "Massage apparatus; Massaging apparatus for personal use." The Applicant's Mark and the Cited Marks, while in the same class, are used in connection with different goods which target different consumers. As a threshold issue, the goods sold in connection with the Cited Marks are all electronics which must be charged and are sold in

¹ Definition found at <https://www.dictionary.com/browse/element> (Accessed April 26, 2023)

a single color (black), whereas the Applicant's goods are not electronic and consist of platinum silicone in a variety of colorways. Applicant's goods are vibrant, artistic works capable of incorporating custom design features and appeal to consumers who are seeking goods which are not plain or dull. Further, Applicant's goods are not massagers, whereas the Cited Marks are used in connection with goods which are exactly that. As such, the goods are non-competitive. The courts have frequently held that similar or even identical marks used by members of the same industry do not, by virtue of such similarity, create a likelihood of confusion when the use is in different markets. *See Sunenblick v. Harrell*, 895 F. Supp. 616, 629 (S.D.N.Y. 1995) (marks at issue were UPTOWN RECORDS and UPTOWN RECORDS and were used in connection with record labels); *Strange Music, Inc. v. Strange Music, Inc.*, 326 F. Supp. 2d 481, 487 (S.D.N.Y. 2004) (finding no likelihood of confusion by virtue of two record labels using identical marks).

The fact that the marks occupy the same or closely related industries is not the end of the inquiry, but analysis must be made of whether competitive proximity would lead to consumer confusion, by comparing "all aspects of the products, including price, style, intended uses, target clientele, typical distribution channels, and others." *Brockmeyer v. Hearst Corp.*, 248 F. Supp. 2d 281 (S.D.N.Y. 2003) (Holding that "O The Oprah Magazine" does not infringe on the registered trademark "O" for use in connection with "magazines, books and catalogs in the fields of fashion, adult entertainment, adult novelties and videotapes; [and] posters and calendars"). Regarding price, Applicant's goods are far more high-end and expensive than those sold in connection with the Cited Marks (for example, ELEMENT MS retails on Amazon for \$50², whereas Applicant's Fifth Element, in its ELEMENTS line of products, retails for \$95³), especially in light of the fact that the Applicant's goods do not contain any electronics. Moreover, the target consumers are quite distinct. They are each acutely aware of the differences in electronic massagers and silicone phalli suitable for use with a harness and are not likely to be misled or confused.

Applicant's and Registrant's goods are not competitive, overlapping, or related, but instead, Applicant's goods are clearly very distinct from those offered by Registrant, are offered to different consumers, are sold at very different price points, and are not similar enough to create a likelihood of confusion in the minds of consumers.

CONCLUSION

The differences between the appearance, sound, meaning, and commercial impression of Applicant's Mark and the Cited Marks are sufficient to prevent any likelihood of confusion. In addition, Applicant's goods are not only quite distinct

² While it appears that the product is no longer available, the price is disclosed in the reviews: https://www.amazon.com/Sir-Richards-Element-Vibrating-Masturbation/dp/B01MCR55EG/ref=cm_cr_ar_p_d_product_top?ie=UTF8 (Accessed April 36, 2023)

³ See product available at: <https://www.uberrime.com/listing/1351931834/the-fifth-element-abstract-dildo-non> (Accessed April 36, 2023)

from Registrant's, but serve a different market. Accordingly, Applicant respectfully requests that the examining attorney permit U.S. Trademark Application Serial No. 97353263 to proceed to publication.

Dated: April 27, 2023

Respectfully Submitted,

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