

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leslie Stevenson Reilly

Docket No.: 93620



Mark:

TIARA

Examining Attorney: Kathleen Lorenzo

Serial No.:

86355722

Law Office: 109

Filed:

September 15, 2014

**Response to Possible Refusal of Registration  
Under Trademark Act Section 2(d), 15 U.S.C. §1052(d)**

In the Office Action of June 5, 2015, the Examining Attorney issued a Suspension of Applicant's application, citing a possible likelihood of confusion with the marks in U.S. Serial Nos. 85901058 and 86343692. Applicant disagrees with this conclusion, and in further support of its original application, hereby submits this Response and requests that the Examining Attorney reconsider that Applicant's application remain suspended.

As an initial note, Applicant wishes to establish that Serial 86343692 has been abandoned and thus should no longer serve as a reason for Applicant's application to remain suspended.

In addition, Applicant submits as part of this response a signed consent and co-existence agreement from the owner of the cited application Serial 85901058, serving to further indicate that there is not a likelihood of consumer confusion between the marks. Applicant submits that it has obtained the consent of the owner's of the cited application, and attaches said consent agreement hereto as part of Applicant's response. [*See* Ex. 1].

Applicant is seeking protection for a word mark consisting of the elements TIARA. Applicant is seeking protection in connection with "Fashion jewelry made of base metals, not including jewelry worn on the top of the head." Applicant's products are classified in Class 014.

The Cited Mark is a word mark consisting of the elements TIARA. The Cited Mark is seeking protection for "Children's jewelry in any metal and specialty jewelry made of precious metals, not including jewelry worn in the hair or tiaras." The Cited Marks products are in Class 014.

Applicant respectfully asserts that, based on the differences of the marks themselves, there is no likelihood of confusion between the marks.

**I. Applicant has Obtained Consent from The Owner of the Cited Mark.**

Applicant and the owner of the cited mark do not feel that there is a likelihood of confusion between the two marks. Both marks have existed in the marketplace for a significant period of time, and there has not been any reports or instances of confusion between the marks.

To this effect, Applicant has obtained the consent of the owner of the cited mark to use, promote, and obtain federal trademark protection for this mark. This consent is attached at Exhibit 1. Applicant respectfully asserts that any doubts that remain as to whether the two marks are in fact confusingly similar to each other not resolved by the above arguments should be fully resolved through the existence of this consent and co-existence agreement.

When a consent agreement is present, it should be “given great weight.” See *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1363, 177 USPQ at 568; TMEP § 1207.01(d)(viii). The Trademark Office “should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion. See *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); see also *du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568.

Thus, given the differences between the marks as explained below and the consent agreement between the parties, the Applicant respectfully asserts that the likelihood of confusion refusal should be lifted.

## **II. Application of the *DuPont* Factors to the Pending Application Establishes a Lack of a Likelihood of Confusion Between the Marks.**

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). 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.*, 177 U.S.P.Q. 563 (C.C.P.A 1973). The examining attorney is to apply each of the applicable factors set out in *In re DuPont*, otherwise known as the *DuPont* factors, which are, as relevant to the present case:

- (1) the similarity or dissimilarity as to appearance, sound, connotation, and commercial impression;
- (2) the similarity or dissimilarity as to the services provided under the marks;
- (3) the degree of care/sophistication likely to exercised by consumers; and
- (4) the fame of the registered mark.

*See id.*

Applying the relevant DuPont factors to the instant case, Applicant hereby submits the arguments below in response to Examiner's potential refusal to register Serial No. 86355722.

### **A. Applicant’s Products and Trade Channels are Sufficiently Different from Those of the Cited Marks.**

The goods and services need only be sufficiently related that consumers would be likely to assume, upon encountering the goods and services under similar marks, that the goods and services originate from, are sponsored or authorized by, or are otherwise connected to the same source. See *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir.1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). One must consider channels of trade and classes of

consumers based on the identifications in the involved applications and registrations. *The Sports Authority Michigan, Inc. v. The PC Authority, Inc.*, Opposition No. 113,785, (TTAB 2001).

Furthermore, 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., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field); see also *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978), cert denied, 439 US 1116 (1979).

In this case, Applicant's products are sold in high-end fashion stores. Applicant's clientele are adults. In contrast, the Cited Marks products are marketed and sold for children, and are not sold in high-end fashion stores.

**B. Purchasers of the Goods/Services Associated with Both Marks are Likely to be Sophisticated and Knowledgeable.**

As analyzed in *DuPont*, supra: to the extent that a customer is likely to exercise a high degree of care and/or sophistication when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks. See also *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 102 (2d Cir.2001) ("The more sophisticated the consumers, the less likely they are to be misled by similarity in marks."); *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 480 (2d Cir.1996) ("The sophistication factor recognizes that the likelihood of confusion between the products at issue depends in part on the sophistication of the relevant purchasers."). Furthermore, the degree of care factor plays a significant role in minimizing potential confusion where the subject goods fail to constitute "impulse" goods. See, e.g., *Astra Pharm. Prods. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) (finding that blood analyzers that cost between \$35,000 to \$60,000 require careful consideration likely to result in added consumer scrutiny and examination).

Circumstances that suggest consumers exercise care in purchasing minimize the likelihood of confusion. See *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000 (Fed.Cir. 1985). Goods that are sold to consumers that have a sophisticated knowledge of a given activity are less likely to be confused with goods that are sold to a different class of sophisticated buyers. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ 2d 1388, 1392 (Fed. Cir. 1992).

As the likely potential buyers of both of the applicant's and the registered mark's goods are sophisticated and knowledgeable about their respective interests, the likelihood of confusion between the marks is greatly limited.

Here, consumers are sophisticated and will use great care in choosing the different products provided under the Applicant and the Cited mark. Both marks are used to identify jewelry products,

which individuals wear to express themselves and convey emotion to the world. The goods sold under the mark also are commonly inspected and care is taken to ensure that they are of high quality.

### **C. Nature Of Similar Marks Used On Similar Goods.**

A vital consideration must be made in determining “strong” or “weak” marks in order to determine the scope of protection to be accorded. Strong marks are widely protected, as contrasted to weak marks. *Amstar Corp. v. Domino’s Pizza Inc.*, 615 F.2d 252, 259 (C.A.Ga. 1980). If the registered mark is not a coined word, or is not purely fanciful, it is not to be accorded the same degree of protection given to such coined and fanciful terms as “Kodak” or “Xerox.” *Id.* at 260. A weak mark is a mark that is a meaningful word in common usage or is merely a suggestive or descriptive trademark. A strong mark is entitled to a greater degree of protection than is a weak one, because of its unique usage. *Alpha Indus., Inc. v. Alpha Tube & Shapes, Inc.*, 616 F.2d 440, 445-46 (9th Cir.1980).

Moreover, extensive third-party use is relevant in showing pre-existing dilution of the mark because “[t]hird-party uses of a mark on similar goods are relevant for the purposes of showing a ‘crowded field’ and that the mark is therefore weak.” *Lexington Management Corp. v. Lexington Capital Partners*, 10 F.Supp.2d 271, 281 (S.D.N.Y. 1998). In *Michael Caruso and Co., Inc. v. Estefan Enterprises, Inc.*, 994 F.Supp. 1454, 1458 (S.D. Fla.1998), the court held that a clothing manufacturer’s “Bongo” mark was weakened by extensive third party use of the term. The primary indicator of trademark strength measures logical correlation between name and product; if seller of product or service would naturally use a particular name, it is weakly protected. *Caruso*, *supra* at 1458.

Where the primary term is considered a weak mark, minor alterations could effectively negate any confusingly similarity between the two. *Freedom Sav. & Loan Ass’n*, 757 F.2d 1176, 1183 (C.A.11 Fla.1985). The mere fact that two marks incorporate a form of a common identifying word does not render the marks too similar. See, e.g., *Freedom Sav. & Loan Ass’n*, 757 F.2d at 1183 (“Freedom Savings and Loan” and “Freedom Realty” marks “lack ... confusing similarity”); *Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass’n*, 651 F.2d 311, 316 (“Sun Federal and Savings Loan Association” not confusingly similar to “Sun Banks”); *Amstar*, 615 F.2d at 260 (“Domino’s Pizza” not similar to “Domino sugar”); *Bell Laboratories, Inc. v. Colonial Prods., Inc.*, 644 F.Supp. 542, 547 (S.D.Fla.1986) (“Final Flip” and “Flip” marks for same product are “ultimately different and different sounding”); *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed.Cir.1992) (“Varga girl” and “Vargas” are “sufficiently different in sound, appearance, connotation, and commercial impression, to negate likelihood of confusion”); *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”); *Little Caesar Enterprises*, 834 F.2d 568, 571 (“Pizza Caesar U.S.A.” not similar to “Little Caesar’s”); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) (“Country Vogues” and “Vogue” publications “do not look or sound alike”); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (CCPA 1973) (“Silk ‘n’ Satin” beauty and bath lotion and oil not similar to “Silk” face cream). Ultimately whether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. *Bell Laboratories*, *supra*, at 548.

Applicant respectfully submits that marks formed using the word “TIARA,” for products related to jewelry is common, resulting in weak protection. In furtherance of the argument that the Cited Mark is weak for the referenced or related products, Applicant has attached registrations for jewelry related products and services all using the word “TIARA” in the mark. All of these coexist without conflict. Thus, Applicant respectfully submits that the relative weakness of these marks should allow Applicant to register its own TIARA mark.

#### **D. Concurrent Use Without Actual Confusion.**

Where, there has been considerable activity by the parties under their respective marks over a long period of time without any reported instances of confusion, one may infer that simultaneous use of the marks is not likely to cause confusion. *See Haveg Industries, Incorporated v. Shell Oil Company*, 199 USPQ 618, 626 (TTAB 1978). “The absence of evidence of actual confusion . . . by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence . . . that there has been a significant opportunity for actual confusion to have occurred.” *See In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

Here there has been sufficient concurrent use to infer that there is no likelihood of confusion. Applicant has been using its mark in the marketplace at least as early as September 1996. The cited mark has been using its mark at least as early as 2009. Applicant and the Cited Mark have remained in the marketplace together for at least 6 years. Applicant has never had a customer experience confusion given the distinct trade channels between the two Parties. As such, it is unlikely that any future consumer confusion will occur in the marketplace.

#### **III. Conclusion**

In the Office Action, the Examiner contends that likelihood of confusion exists where Applicant's mark shares similarities in appearance, sound, and relatedness of the goods and channels of trade. However, Applicant asserts that an examination of the *DuPont* factors shows clear differentiation when comparing Applicant's mark to the cited mark. Additionally, Applicant has obtained the consent of the owner of the cited mark to use and register the applied for mark. Thus, for all of the reasons set forth above, Applicant submits that there is no likelihood of confusion, mistake, or deception in the marketplace. The Examiner may hence approve the mark for publication in the Official Gazette.