IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Identity Pet Nutrition, LLC
Serial No.	:	88412014
Filing Date	:	May 1, 2019
Mark	:	IMAGINE
Examining Attorney	:	Udeme U. Attang
Law Office	:	115

RESPONSE TO OFFICE ACTION

Commissioner For Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

Dear Commissioner,

Identity Pet Nutrition, LLC ("Applicant") seeks registration on the Principal Register of the mark IMAGINE for "Cat food; Dog food; Pet food; Edible cat treats; Edible dog treats," in International Class 031.

In the Notice of Suspension dated July 13, 2019, the Trademark Examining Attorney mentioned that if pending U.S. Application Serial No. 87883988 has an earlier filing date or effective filing date than applicant's application and if the mark in that cited application registers, the USPTO may refuse registration of applicant's mark under Section 2(d) because of a likelihood of confusion with the registered mark. That cited mark is LITTER REIMAGINED for "Cat litter and litter for small animals" in International Class 031. Applicant respectfully disagrees with this determination and offers the following arguments in support of registration.

I. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Examining Attorney is respectfully reminded that the determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567(CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

Considering the first du Pont factor, whether IMAGINE and LITTER REIMAGINED are similar or dissimilar "in their entireties as to appearance, sound,

connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting du Pont, 177 USPQ at 567). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs.*, 101 USPQ2d at 1721 (*quoting Leading Jewelers Guild, Inc. v. LJOW Holdings*, LLC, 82 USPQ2d 1901, 1905 (TTAB 2007)).

While the marks are somewhat similar in sound and appearance since they share variations of the word "IMAGINE," they are dissimilar in sound and appearance due to the additional term "RE" and the generic term "Litter." As to connotation and commercial impression, the marks must be considered in their entireties, and when so compared, LITTER REIMAGINED and IMAGINE take on different meanings and commercial impressions. As the following definition of the prefix "re-' indicates, in association with cat litter and litter for small animals, LITTER REIMAGINED suggests that the cat litter has been "re-invented" or re-engineered to imbue the litter with special desirable quality.

re-

1 a prefix, occurring originally in loanwords from Latin, used with the meaning "again" or "again and again" to indicate repetition, or with the meaning "back" or "backward" to indicate withdrawal or backward motion:
regenerate; refurbish; retype; retrace; revert.

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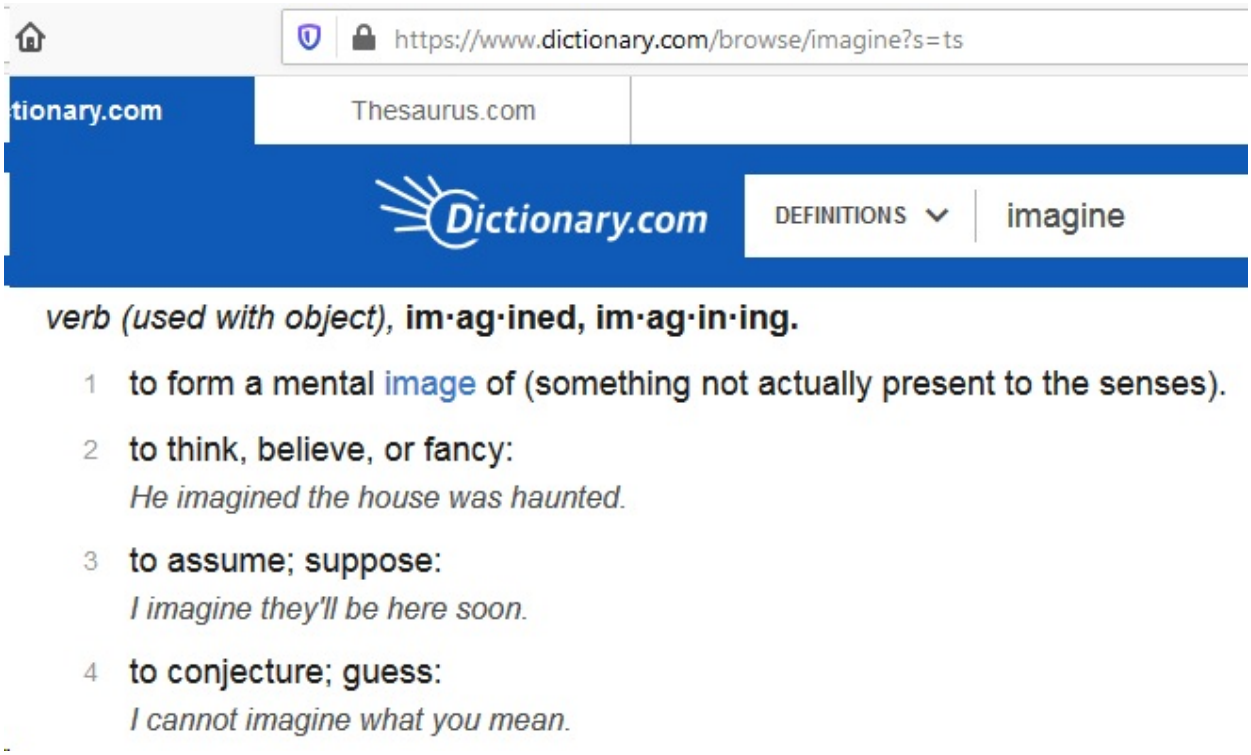
Cf. Philip Morris, Inc. v. Reemtsma Cigarettenfabriken GmbH, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE represents a certain "upscale, affluent" imagery and style; mark is used to suggest a sophisticated aura linked to that street associated with fashionable living in Manhattan). On the other hand, as the following online definition suggests, IMAGINE is a lofty nebulous term that points to nothing in particular.



Moreover, there is nothing in the record to support a finding that IMAGINE would be perceived as a variant of Registrant's LITTER REIMAGINED mark. The marks in their entireties convey overall different commercial impressions and that consumers will be able to differentiate the marks. The differences in connotation and commercial impression outweigh any similarities in sound and appearance. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL for champagne held not confusingly similar to CRYSTAL CREEK for wine); *In re Hearst Corp*., 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) (VARGA GIRL for calendars held not confusingly similar to VARGAS for calendars). This du Pont factor weighs in Applicant's favor.

Even if the goods were legally identical and had overlapping channels of trade and potential purchasers, the marks are too dissimilar to warrant a determination of likely confusion. The first du Pont factor is dispositive in this case. *See Champagne Louis Roederer*, 47 USPQ2d at 1460 (holding that Board did not err in deciding likelihood of confusion based solely on dissimilarity of marks regardless of other du Pont factors, that favored a likelihood of confusion, noting that "we have previously upheld Board determinations that one DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks"); *Kellogg Co. v. Pack'em Ents*., 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (upholding Board decision that "a single duPont factor – the dissimilarity of the marks – was dispositive of the likelihood of confusion issue," observing "we know of no reason why, in a particular case, a single duPont factor may not be dispositive").

II. CONCLUSION

The differences between the marks, as discussed above, clearly outweighs any of the other similarities and leads to a conclusion that confusion between the marks is not apt to occur. In view of the foregoing, Applicant respectfully requests that the present application now be removed from suspension and approved for publication. Applicant reserves the right to argue any and all of the other du Pont factors in case the Examining Attorney maintains the 2(d) refusal. Applicant again expresses thanks for the attention provided to this application and looks forward to receiving the Notice of Publication for this application.

DATED: February 2, 2020

Respectfully submitted,
TDFoster – Intellectual Property Law

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