

REMARKS

The Applicant requests that the Examining Attorney remove the subject application from suspension and resume prosecution as the Applicant's underlying Canada application which forms the filing basis of the subject application under Section 44 has matured to registration. Currently, the subject application includes dual filing bases, namely, Section 1(b) and Section 44(d). Applicant submits a copy of the certificate of registration for Canada registration number TMA1090334 to perfect the Section 44 basis. At this juncture, Applicant wishes to retain the Section 1(b) filing basis.

LIKELIHOOD OF CONFUSION

The Applicant further requests that the Examining Attorney withdraw the refusal to register the subject application based on U.S. Registration number 4,483,077 as the cited registration has been cancelled.

The sole remaining issue is the Examining Attorney's citation of the following prior pending application that has matured to registration. Based on the Examining Attorney's comments in the Suspension Notice regarding the cited prior pending application, Applicant submits the following arguments in support of registration.

Mark	Registration No.	Goods	Owner
ROK-IT	5,807,654	Outdoor furniture in IC 20	Denovo Brands, LLC

Applicant seeks to register the mark ROCKIT for use with "office furniture." The cited Registrant owns the mark ROK-IT for use with "outdoor furniture."

The strength of the mark sought to be protected is an important consideration in the likelihood of confusion analysis. It is well settled that "weaker" marks are not entitled to the wide latitude of protection afforded the owner of "strong" trademarks. McCarthy on Trademarks, Section 11:73; King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 U.S.P.Q. 108 (C.C.P.A. 1974). In the present case, it appears that the Examining Attorney has sought to provide broader protection to the cited mark than it is entitled to under the parameters of Section 2(d) of the Trademark Act.

Applicant submits the following registered marks owned by entities (unrelated to the cited mark owner) containing the prefix ROK (emphasis added) or the term ROCKET in International Class 20 for the Examining Attorney's review. Applicant submits the attached marks clearly evidence the weakness of the cited mark with the same or related goods to the cited owner's goods. As such, the cited owner should not be entitled to a broad scope of protection so as to preclude the Applicant's mark from registration.

Mark	U.S. Reg. No.	Owner	Class
ROKDUK	6,293,290	Zhou Guoqin, China	20

Mark	U.S. Reg. No.	Owner	Class
ROKEYE	6,163,976	Suqianben Niuye Technology Co., Ltd., China	20
ROKBOX and Design	5,854,503	Crateight Limited, United Kingdom	20
ROK-A-CHAIR	5,668,228	Alderman Acres Mfg., Inc. Coffeyville, Kansas	20
ROK	4,914,706	Rok, Inc., Irvine, California	6, 20
ROKUM	5,680,856	Rokum Ltda., Chile	20, 22
ROKOKO	2,580,839	A.me and Mitchell Alamag, Las Cruces, New Mexico	20
ROCKET RISERS	5,517,683	BrickFront Marketing, LLC, Weston, Massachusetts	20
ROCKIT and Design	5,598,079	Rocket Global Limited, New Zealand	16, 20, 31

Although third party registrations are not dispositive in any given case, the above registered marks present a convincing picture of the extent to which the prefix ROK and further the term ROCKET have become diluted when used in connection with goods in International Class 20. Clearly, the cited mark owner does not own an exclusive right to use the prefix ROK much less ROCKET/ROCKIT which present different commercial impressions.

Whether a mark is classified as strong or weak is a very important element in deciding likelihood of confusion. See, McCarthy on Trademarks (4th Ed.) Section 23:48. “Where a party uses a weak mark, his competitors may come closer to his mark than would be the case without violating his rights.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 USPQ2d 1453 (Fed. Cir. 1992). When selecting a mark which is a common name, or commonly used in the field, the owner assumes some degree of risk of uncertainty that competitors may come closer to his mark by adopting marks with the same or similar characteristics. *Milwaukee Nut Co. v. Brewster Food Service*, 125 USPQ 399 (CCPA 1960).

Where the common portion of the marks at issue are weak, even minor differences in the remaining portion of the marks could make for marks which overall, are not confusingly similar because “consumers distinguish between these usages.” *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Glamorene Prods. v. Earl Grissmer*, 203 USPQ 1090 (TTAB 1979)(No confusion found between SPRAY' N VAC v. RISENVAC, both for vacuum rug cleaners); *Mead Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977) (No confusion found between METRECAL for dietary products and MINICAL for dietary food products); *Basic Vegetable Prods. Inc. v. General Foods Corp.*, 165 USPQ 781 (TTAB 1970) (MAGIC v SOUR MAGIC) (The Board noted that frequent adoption and registration of the term MAGIC is sufficient to distinguish MAGIC and SOUR MAGIC. “The theory behind this rests on the obvious character of the term . . . purchasers have been exposed in a particular trade to such a plethora of trade designations containing this notation that they have become accustomed to distinguishing between them.”) In the present case, the differences in the respective marks create marks with different sounds, appearances, meanings and overall commercial impressions such that consumers would not find the respective marks confusingly similar.

In making the determination as to whether there is a likelihood of confusion or not, important factors to be considered are the similarity or dissimilarity of the respective marks as to appearance, sound, commercial impression and connotation. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Moreover, trademarks should be considered in their entirety, the way consumers encounter them. Their individual components should not be dissected and analyzed piecemeal. *In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir. 1986). The commercial impression of a trademark is derived from it as a whole, not from elements separated and considered in detail. *Estate of P.D. Beckwith Inc. v. Commissioner of Patents*, 252 US 528 (1920).

Applicant submits that the mark ROCKIT conveys a distinguishable commercial impression to the cited mark ROK-IT such that consumers would not be confused by the contemporaneous use of the respective marks as to source, affiliation or sponsorship similarly to all of the registered marks noted above. Clearly, the mere incorporation of terms within one mark which exist also in a registered mark does not, ipso facto, create a likelihood of confusion between the marks. See, *Electronic Data System Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, (TTAB 1992) at page 1463 (finding confusion not likely between EDSA for computer programs for electrical distribution system analyses and design and EDS for computer data processing programming services).

The Applicant respectfully submits that the marks are visually dissimilar. The similarity of appearance of marks has been described as nothing more than a subjective "eyeball" test. *General Foods Corp. v. Ito Yokado Co.*, 219 USPQ 822 (TTAB 1983), *McCarthy on Trademarks and Unfair Competition*, Section 23:25, 4th Ed. Here, the mere fact that the respective marks just like the representative registered marks noted above share some common letters is not dispositive of confusion. The Second Circuit addressed this issue in *Lang v. Retirement Living Publishing*, 21 USPQ 1041, 1045 (2nd Cir. 1991) wherein the court found no similarity of appearance between NEW CHOICES PRESS for publishing services and NEW CHOICES FOR THE BEST YEARS for magazines. *Lang v. Retirement Living Publishing* is especially noteworthy due to the similarities found in the *Lang* case and the present situation. More specifically, the cited mark owner offers outdoor furniture and the Applicant offers office furniture. While the respective goods may both include the term furniture, the marketplace and practical realities cause the respective goods to be much less similar than the goods and services in the *Lang* case in which the Court found no confusion likely.

Here, the mark ROCKIT is visually distinctive of the cited mark ROK-IT. Unlike the Applicant's mark, the cited mark consists of two terms that is used with outdoor furniture, specifically, outdoor portable rocking chairs. Please see the attached screenshot from the cited owner's website at www.kijaro.com/product-page/rok-it-chair and the description found therein for the cited owner's "ROK-IT" chair.

"The Rok-it blends unparalleled comfort and style, making it the ultimate adventure companion. With the Rok-it by your side, you can sit back and enjoy the journey wherever you go. This portable rocker folds down and can easily fit into the carry bag making it easy to store with your other camping gear. This portable rocking camping

chair also has padded armrests and a flip out cupholder. This collapsible rocking chair will keep you cool with the mesh back, and the custom rear chair feet help you rock smoothly all day long.”

Applicant is aware that the cited mark solely includes the wording “outdoor furniture” but submits the above noted information to provide the Examining Attorney with context about the character of the cited owner’s product marketed under the ROK-IT mark. Clearly, the cited mark describes the function of the goods, namely, that the chair rocks, i.e., a “portable rocking camping chair.” As such, the cited owner should not be granted broad rights when its alleged mark merely describes a characteristic of its goods. Obviously, the cited mark does nothing more than convey to the consumer that the chair rocks. All of which leads to the inescapable conclusion that the marks convey distinctly different meanings.

The different commercial impressions created by the respective marks not only render the marks distinguishable to the ear and to the eye, but the differences in the marks also serve to give the marks different meanings as discussed above. As noted by the Tenth Circuit Court of Appeals, “it is not necessary for similarity to go only to the eye or the ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning.” If two conflicting marks each have an aura of suggestion, but each suggests something different to the buyer, this tends to indicate a lack of likelihood of confusion. See, McCarthy on Trademarks and Unfair Competition (4th Ed.), Section 23:28. Similarly, marks may be phonetically similar, but confusion is prevented by different suggestive connotations of the marks. See, Republic Steel Corp. v MPH Mfg. Corp., 136 USPQ 447 (CCPA 1963) (Different connotation of TRUSS-SKIN v. TRUSCON for metal building parts); Morrison Milling Co. v. General Mills, Inc., 168 USPQ 591 (CCPA 1971) (different connotations of CORN-KITS and CORN KIX); General Mills, Inc. v. Frito Lay, Inc., 176 USPQ 148 (TTAB 1972) (no likely confusion between FUNYUMS and ONYUMS; different suggestive connotation).

Here, the Applicant submits that the overall suggestion, image and commercial impression conveyed by the Applicant's mark is distinguishable from the cited mark so as to obviate consumer confusion. See, Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373 (Fed. Cir. 1998) (CRISTAL for champagne and CRYSTAL CREEK for wines held not confusingly similar. The marks “evoked very different images in the minds of relevant consumers”: while CRISTAL suggests the clarity of the wine in the bottle or the glass, CRYSTAL CREEK suggests a clear, remote stream.); Hard Rock Cafe Licensing Corp. v. Elsea, 48 USPQ2d 1400 (TTAB 1998) (COUNTRY ROCK CAFE v. HARD ROCK CAFE for restaurant services not held confusingly similar. “[W]e believe there is no question that “country rock” and “hard rock” evoke quite different images for consumers.”) The ROK-IT mark conjures up a very different image in the mind of the consumer as compared to the ROCKIT mark. Applicant’s mark may be considered by younger generations to play on the slang expression “ROCK IT” meaning “to do what you do in an outrageous and [marvelous](#) way.” Please see the attached screenshot from the Urban Dictionary - www.urbandictionary.com/define.php?term=Rock%20it. It may be helpful to know that the Applicant’s goods used in connection with the applied for mark are height adjustable workstations which typically resonate with younger generations of office workers. Please see the

attached “Inscape_RockIt_Lookbook_2018” marketing material and the attached screenshot of the relevant portion of the applicant’s website detailing the ROCKIT height adjustable workstations. To further distinguish the Applicant’s goods from the goods in the cited application and to avoid even the possibility that the goods may be considered sufficiently related in which to refuse registration of the subject application, Applicant has amended the goods in the subject application to “office furniture, namely, fixed height and adjustable height work stations and benches, office desks.”

Applicant relies on the following cases in support of the proposition that there is no rule that confusion is automatically likely if the junior user has a mark that contains in part the whole of another's mark. See *Colgate Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) (PEAK PERIOD for deodorant not confusingly similar to PEAK for denitrifies); *Lever Bros. Co. v. Barcolene Co.*, 174 USPQ 392 (CCPA 1972) (ALL CLEAR for household cleaners not confusingly similar to ALL for household cleaners); *In re Ferrero* 178 USPQ 167 (CCPA 1973) (TIC TAC for candy not confusingly similar to TIC TAC TOE for ice cream). Similarly, the Applicant’s mark conveys a distinguishable commercial impression separate and apart from the cited owner’s mark such that consumers would not find the respective marks confusingly similar.

The standard under Section 2(d) is likelihood of confusion, not mere possibility of confusion. As noted by the Trademark Trial and Appeal Board in determining likelihood of confusion, “we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Witco Chemical Co., Inc. v. Whitfield Chemical Co., Inc.* 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969).

In addition to the differences in the marks, there are also significant differences between the goods with which the marks are used, such that no likelihood of confusion exists. In order for there to be confusion as to source, connection, or sponsorship of the goods of the Applicant and the cited mark owner, the goods would have to be of such a nature that they would come to the attention of the same kinds of purchasers. *In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987); *In re Fresco Inc.*, 219 USPQ 437, 438 (TTAB 1983). It has long been held that even where the marks are identical in every respect (here they are not), confusion would not be likely if the goods are not related, or if the goods are not marketed in such a way that would create the incorrect assumption that they originate from the same source. See, e.g., *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ 1156 (TTAB 1990). The prime limitation is that trademark rights extend only as far as necessary to avoid consumer confusion. *WCVB-TV v Boston Athletic Ass'n.*, 17 USPQ2d 1688, 1690 (1st Cir. 1991) (“The trademark statute does not give [any] property right in the mark except the right to prevent confusion.”) There is no monopoly, or “right in gross” in a mark. *University of Notre Dame v J.C. Gourmet Food Imports Co.*, 217 USPQ 505, 507 (Fed. Cir. 1983)(A right in gross is contrary to the principle of trademark law.)

Further, past decisions of the federal courts and the Trademark Trial and Appeal Board (hereinafter the “TTAB”) applying “per se” rules that goods and services in the same general field and bearing the same mark are so similar or related that confusion as to origin is likely have been criticized as being too inflexible. Such decisions are seen as being contrary to a basic tenet

of trademark law, namely that each likelihood of confusion case must be decided based on its own facts and circumstances. See, *Interstate Brands v. Celestial Seasonings*, 576 F.2d 926, 928 (CCPA. 1978) (no “per se” rule for foods); *In re The Shoe Works, Inc.*, 6 USPQ2d 1890, 1891 (TTAB 1988) (no “per se” rule that the use of the same mark on different items of wearing apparel likely to cause confusion.)

Applicant's office desks and workstations and cited mark owner's portable outdoor rocking chairs are not marketed in such a way that would create the incorrect assumption that they originate from the same source. The Applicant respectfully submits that notwithstanding the argument that the respective goods may be broadly generalized as furniture, this argument does not render them sufficiently related to support the Examining Attorney's refusal when the practical realities of the differences in the goods and the marketing thereof are factored into the likelihood of confusion analysis. Moreover, the goods as amended in the application eliminate even the argument that the Applicant's goods and the goods in the cited application may be considered sufficiently related to support a likelihood of confusion refusal. These facts coupled with the existence of so many registered marks using the prefix ROK in International Class 20 owned by different entities leads to the inescapable conclusion that no likelihood of confusion is present.

It is respectfully submitted that the Applicant's goods must be suited to the office space where such goods will be used and tailored to each individual therein. Obviously, the effort typically expended in choosing height adjustable workstations for an office far exceeds the care typically expended in purchasing a portable outdoor rocking chair. The Applicant's products would not be purchased on impulse, but only after deliberate, careful consideration, knowing exactly with whom the consumer is dealing. Given the differences between the cited owner's goods and the Applicant's goods and the differences between the respective marks, Applicant submits that a likelihood of confusion as defined by Trademark Act Section 2(d) does not exist. The Applicant therefore respectfully requests that the potential Section 2(d) refusal should be withdrawn.

CONCLUSION

It is respectfully submitted that the Examining Attorney withdraw the potential 2(d) refusal given the fact the consumers will not confuse the Applicant's mark and the cited mark as to source, affiliation or sponsorship. As all the outstanding requirements have been complied with, it is hereby respectfully submitted that the subject mark be allowed to proceed to publication at the Examining Attorney's earliest convenience.

If the Examining Attorney has any questions, it is requested he contact the undersigned attorney.