

The Examining Attorney has refused registration citing Reg. No. 6636014, and has also advised that registration may be refused under Section 2(d) of the Act if the following prior-pending Serial Nos. 88719148, 88719149, and 88724242 mature to registration. Applicant respectfully contends that the presumption of likelihood of confusion between its mark and the cited registration is unwarranted for the following reasons:

DIFFERENCE IN APPEARANCE, CONNOTATION AND COMMERCIAL IMPRESSION

The Examining Attorney must examine the marks for similarities in appearance, sound, connotation and commercial impression, *In re E.I. duPont*, 177 U.S.P.Q. 563. In accord with *duPont*, Professor McCarthy states:

Similarity as to one aspect of the sight, sound and meaning trilogy will not automatically result in a finding of confusion, even when the goods or services are identical or closely related. 3 McCarthy on Trademarks and Unfair Competition § 23:21 at 23-64 (4th ed. 1999). See also, *Gruner + Jahr U.S.A. Publishing v. Meredith Corp.*, 991 F.2d 1072, 1077-79 (2d Cir. 1993) (finding no likelihood of confusion between plaintiff's PARENT'S magazine and defendant's PARENT'S DIGEST magazine, both devoted to parenting issues); *duPont*, 177 U.S.P.Q. at 566, 567.

Applicant's mark when compared in its entirety is not confusingly similar to Registrant's mark. "The commercial impression of a trademark is derived from viewing it as a whole, not from its elements separated and considered in detail." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 40 S.Ct. 414, 417 (1920).

The CAFC confirmed this reasoning fifteen years later in *Packard Press, Inc. v. Hewlett-Packard Company*, reiterating that "[t]he ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety." 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000.) (HEWLETT-PACKARD and HEWLETT-PACKARD and Design v. PACKARD and Design.) The CAFC remanded the case because the Board erred in considering the "similar commercial impression of part of the marks -- the shared word PACKARD -- before concluding that the marks were similar." *Packard Press, Inc.* at 1357.)

In the instant application, it is initially noted that the marks are distinctly different. Applicant's mark is LA PRAIRIE SWITZERLAND (Stylized). The cited mark is CLINQUE LA PRAIRIE. The marks of the parties are different in sound and appearance. Indeed, the primary impact of the cited registrant's mark is the formative "CLINQUE," whereas the formative of the applicant's mark is "LA PRAIRIE." As the Examining Attorney is aware, the marks must be compared in their entireties and may not be dissected into their component parts. The marks, compared in their entireties, are distinctly different. Indeed, it is well settled that "[t]he marks must be considered as the public views them, that is, in their entireties." *In re National Data Corp.*, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985). The marked difference in appearance and commercial impression obviates the conclusion that the mere inclusion of very

commonly used terminology in the marks of the respective parties is enough to engender consumer confusion.

Neither is likelihood of confusion determined by the fact that one mark may bring another mark to mind. "The very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, the two marks." *In re Ferrero*, 178 U.S.P.Q. 167, 168 (C.C.P.A. 1973) (reversing the Board's decision to affirm an Examiner's refusal to register TIC TAC for candy because of a prior registration of TIC TAC TOE for ice cream and sherbet); **3 McCarthy on Trademarks and Unfair Competition** § 23:9 at 23-31.

In *Ferrero*, the C.C.P.A. determined that the TTAB's likelihood-of-confusion analysis should have included an assessment of the marks' importance and the relationship of the marks to the goods. *Ferrero, supra*, at 168. Hence, even if Applicant's mark "calls to mind" the cited mark, it does not inexorably follow that consumers would be confused as to source or sponsorship of the goods offered.

Here, while the marks each contain the terminology "LA PRAIRIE" the respective marks neither look similar, sound similar or create confusingly similar commercial impressions.

SOPHISTICATION OF THE CONSUMER

In addition to the fact that the marks of the respective parties are different in commercial impression, because of the highly-personal nature of the goods and services of the respective parties, consumers will know precisely with whom they are dealing and are unlikely to be confused as to source origin. Indeed, consumers will be careful and discriminating, not ordinary consumers. *See, e.g., St. Helena Hosp.*, 774 F.3d at 755 (reversing refusal to register because consumers of health care services exercise a high degree of care in their purchasing decisions); *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718-19 (Fed. Cir. 1992) (finding confusion unlikely where opposer's services are expensive and purchased only by experienced corporate officials after significant study and contractual negotiation); *Edwards Lifesciences*, 2010 WL 1514315, at *16 (dismissing opposition because purchasers of parties' patient-care products would exercise a high degree of care when making purchasing decisions); *Stiefel Labs., Inc. v. VetGen, LLC*, Cancellation No. 27,360, 2000 WL 158731, at *5 (T.T.A.B. Feb. 11, 2000) (finding veterinarians to be sophisticated consumers of the animal health products at issue and noting that "only knowledgeable people would make purchases from a veterinary products distributor").

Applicant notes for sake of good order, however, that even if it were the case that the goods and services were both provided through the same merchandising channels, there nevertheless is no potential for consumer confusion. Both courts and the Trademark Trial and Appeal Board have made it clear that the use of the same or a similar mark in the same industry, or even in the same market, is, in and of itself,

insufficient ground upon which to substantiate a likelihood of confusion refusal. **Worthington Foods Inc. v. Kellogg Co.**, 732 F.Supp. 1417 (SD Ohio 1990) (there is no per se rule that goods sold “under the same roof with similar marks will engender confusion as to source, connection or sponsorship”).

Applicant also notes, with importance, that consumers are familiar with the instant applicant, who is the owner of the attached 16 active U.S. registrations for marks comprising the LA PRAIRIE designation. Applicant notes, in particular, that the literal element forming the marks in the following registrations is essentially identical that that in the instant application: 1334997, 1268605, 3643174, 3643181, 4680955. Given the family of “LA PRAIRIE-formative” marks owned by the applicant, consumers will naturally assume that the LA PRAIRIE SWITZERLAND mark is associated with applicant; not the cited registrant.

The Examining Attorney has noted that there is a Coexistence Agreement of record in the cited Registration, No. 6636014. Indeed, it is because of the Coexistence Agreement that the cited registration progressed to registration in the first instance. The Examining Attorney has noted that the referenced Coexistence does not specifically reference the instant application. This, of course, stands to reason inasmuch as the instant application did not exist at the time the Coexistence Agreement was executed between the parties and could not, therefore, be included by reference in the subject Coexistence Agreement. That said, applicant submits herewith the attached Coexistence and Consent. In view of the submission of the Coexistence and Consent executed between the parties, applicant respectfully submits that the potential refusal under Section 2(d) of the Act should be considered moot.

In this regard, the Examining Attorney's attention is directed to **Bongrain International (America) Corp. v. Delice de France Inc.**, 1 USPQ2d 1775 (Fed. Cir. 1987). In **Bongrain**, the Court held that the parties whose marks are at issue are in a much better position to know the real life situation in the marketplace than bureaucrats or judges and therefore, consent agreements between the parties carry great weight.

The Examining Attorney's attention is also directed to **In re Fieldcrest Cannon Inc.**, 5 USPQ2d 1142 (TTAB 1987), wherein the Board reversed the Examining Attorney's refusal under Section 2(d) of the Trademark Act. In determining that the likelihood of confusion refusal could not stand, the Board found that a great deal of weight must be given to the parties' assessment as to whether or not confusion in the marketplace is likely to occur. Likewise, in **In re Leonard S.A.**, 2 USPQ2d 1800 (TTAB 1987), the Board also reversed a likelihood of confusion refusal, indicating that consent agreements represent the views of the parties in the marketplace and are in a better position to know the real life situation relating to the likelihood of confusion.

All remaining informalities having been resolved, it is respectfully submitted that the instant application should be allowed to proceed on to publication, and publication of the mark for opposition is earnestly solicited.

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