

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Foot Locker Retail, Inc.  
Serial No. : 86/502,285 Examiner: Lyndsey Kuykendall, Esq.  
Filed : January 13, 2015 Law Office 102  
Mark : COLORADO

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT’S RESPONSE TO OFFICE ACTION DATED APRIL 13, 2015**

The Examining Attorney has refused registration of the above referenced trademark application (the “Application”) on the grounds that registration of the mark is likely to cause confusion because it is similar to a prior registered mark.

The Examining Attorney further refused registration alleging that the applied-for mark is geographically deceptive and primarily geographically deceptively misdescriptive of the origin of Applicant’s goods.


Applicant respectfully disagrees and requests that the Application be passed to publication for the reasons that follow.

**CLAIM OF PRIOR REGISTRATION**

Pursuant to TMEP §812.01, Applicant claims ownership of Reg. No. 1454322 for the mark COLORADO in class 25.

## REMARKS

### I. Likelihood Of Confusion

The Examining Attorney has refused registration of Applicant's mark COLORADO ("Applicant's Mark") on the ground that the mark when used in connection with Applicant's goods in class 25 "Capris; Fleece bottoms; Fleece shorts; Fleece tops; Jackets; Pants; Polo shirts; Shirts; Shorts; Sweatpants; Sweatshirts; T-shirts; Tank-tops; Tops" ("Applicant's Goods") so resembles the stylized mark  ("Cited Mark") (Registration No. 4,018,098) for "Clothing, namely, jerseys, shirts, bottoms, cloth bibs; headwear; footwear; all of the foregoing relating to a baseball team" in class 25 ("Cited Goods"), owned by Colorado Rockies Baseball Club, Ltd. ("Registrant"), that it is likely to cause confusion, or to cause mistake, or to deceive.

Applicant respectfully contends that an examination of the relevant factors under TMEP §1207 and *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973), warrants the conclusion that Applicant's Mark cannot be said to so resemble the Cited Mark that it is likely to cause confusion, or to cause mistake, or to deceive given careful consideration of the differences between: (i) the marks themselves; (ii) the parties' respective goods and (iii) the parties' respective channels of trade.

#### A. Similarity Of The Marks

The Examining Attorney noted that Applicant's Mark being in standard characters may be displayed in any lettering style, and since the Cited Mark is in stylized form, concluded that therefore the marks are confusingly similar because they could theoretically be presented in the same manner of display. However, this is not sufficient by itself to imply either confusing similarity or likelihood of confusion, without giving due consideration on all other factors that influence consumer's commercial impression of the mark in the real world. In fact, the Board has


repeatedly concluded that when viewed in their entireties, marks that share common terms, are not *per se* confusingly similar. More importantly, the Board has concluded that even marks that are identical are not likely to cause confusion mistake, or deception, when, as here, all the other relevant factors are considered. *See, e.g., Astra Pharmaceutical Prods. V. Beckman Instruments*, 220 USPQ 786, 790 (1<sup>st</sup> Cir. 1983); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (T.T.A.B. 1993).

A mere possibility of confusion is not sufficient for a finding of likelihood of confusion. Consumer confusion must be probable. *See, e.g., Bongrain International (American) Corporation v. Delice de France, Inc.*, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987). As the Federal Circuit Court has noted, in determining whether a likelihood of confusion exists, “[w]e are not concerned with the 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 deals.” *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). Moreover, it is well established that “a realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do” and that a side-by-side comparison is improper if that is not the way the consumers encounter the marks in the marketplace. *See, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition* §§24:51 and 23:58.

Here, the Cited Mark is particularly weak when viewed in connection with the Cited Goods, namely clothing, since it co-exists on the Register in a crowded field of third-party COLORADO formative marks registered for the same or related goods in class 25. It is established that “[w]here a party chooses a trademark which is inherently weak, he will not enjoy

the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.” *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158 (C.C.P.A. 1958). The weaker the mark, the less distinctive it is, making it unlikely for a junior user to create likelihood of confusion. As shown below, there are numerous third-party marks incorporating the term “COLORADO” for clothing and related goods in Class 25. Consumers are therefore not likely to be confused as to the source of goods that all bear a mark that incorporates the term “COLORADO” or variations thereof. *See, e.g., Puma-Sportschuhfabriken Rudolf Dassler K.G. v. Superga S.p.A.*, 210 USPQ 316 (TTAB 1980); *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, §11:26.

The following are only some examples of third party registrations and allowed applications in Class 25 that co-exist on the Principal Register, including the prior registration for the identical mark owned by the Applicant in class 25 (as shown on the first line below):

Mark/Reg. or App. No.	Status	Goods/Services	Owner
COLORADO RN: 1454322 SN: 73412908	Registered: August 25, 1987 Last Renewal: August 25, 2007	(Int'l Class: 25) footwear	Foot Locker Retail, Inc. (New York Corp.) 112 West 34th Street New York New York 10120
COLORADO CUT and Design  RN: 1676851 SN: 74094824	Registered: February 25, 1992 Last Renewal: February 25, 2002	(Int'l Class: 25) t-shirts, pants, skirts, sweat shirts and jackets	Colorado Contract Cut and Sew Inc. (Colorado Corp.) 1157 South Cherokee St. Denver Colorado 80223

Mark/Reg. or App. No.	Status	Goods/Services	Owner
<p>COLORADO EIGHTY-FIVE</p> <p>COLORADO EIGHTY-FIVE</p> <p>RN: 3862679 SN: 77803352</p>	<p>Registered October 19, 2010</p>	<p>(Int'l Class: 25) footwear</p>	<p>Asics Corporation (Japan Corp.) 1-1, Minatojima-Nakamachi 7-Chome Chuo-Ku, Kobe 650-8555 Japan</p>
<p>COLORADO STATE</p> <p>RN: 2039973 SN: 74731923</p>	<p>Registered: February 25, 1997 Last Renewal: February 25, 2007</p>	<p>(Int'l Class: 25) clothing, namely, hats, jackets, shirts, sweaters and pants</p>	<p>The Board of Governors of the Colorado State University System, by and Through Colorado State University (Colorado State University) 410 17th Street, Suite 2440 Denver Colorado 80202</p>
<p>COLORADOKISSES</p> <p>coloradokisses</p> <p>SN: 86546241</p>	<p>Filed: February 25, 2015 Application Published: July 7, 2015</p>	<p>(Int'l Class: 16) greeting cards; pictures (Int'l Class: 25) t-shirts</p>	<p>Maestas, Andrew (United States Citizen) P.O. Box 489 Lyons Colorado 80540</p>
<p>EL CHAPULIN COLORADO</p> <p>EL CHAPULIN COLORADO</p> <p>SN: 85749507</p>	<p>Filed: October 9, 2012 Application Published: April 23, 2013</p>	<p>(Int'l Class: 25) aprons; bonnets; caps; cardigans; cloth bibs; coats; fleece tops; jackets; overalls; pajamas; pants; sleepwear; sweat pants; sweat shirts; swimwear; t-shirts (Int'l Class: 30) candy; sweets</p>	<p>Araceli Lopez Del Valle (Mexico Citizen) 2239 Leron Ave Rowland Heights California 91748</p>
<p>SOMEONE IN COLORADO LOVES ME!!</p> <p>Someone in Colorado Loves Me!!</p> <p>SN: 86389887</p>	<p>Filed: September 9, 2014 Application Published: August 11, 2015</p>	<p>(Int'l Class: 25) baby bodysuits; hats; hooded sweat shirts; jackets; pants; rompers; short- sleeved or long-sleeved t-shirts; shorts; socks; sweat shirts; t-shirts; tank tops; underwear</p>	<p>Bigboymusic, Inc (Florida Corp.) 21282 Braxfield Loop Estero Florida 33928</p>

Mark/Reg. or App. No.	Status	Goods/Services	Owner
YOCOLORADO  YoColorado  RN: 4764513 SN: 86452341	Registered June 30, 2015	(Int'l Class: 25) beanies; gloves; hats; jackets; scarves; socks; sweatshirts; t-shirts; tank tops	Dirtyragz Inc. (Colorado Corp.) 1009 Tucker Gulch Way Golden Colorado 80403

The fact that so many “COLORADO” marks already co-exist on the Register is evidence that consumers are able to distinguish between the source of different goods and services all bearing some variation of this term, with or without additional elements.

While Applicant acknowledges that the Trademark Office is not bound by its prior decisions, Applicant is entitled to a certain degree of reliance on treatment of similar marks. In fact, the Court of Appeals for the Federal Circuit encourages the use of a uniform standard in assessing marks. *See, e.g., In re Nett Designs*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

B. Relatedness Of The Goods

The Examining Attorney argues that Applicant’s Goods are directly related to the goods covered by the Cited Mark. While the parties’ respective goods are both marketed to consumers seeking some kind of clothing, likelihood of confusion should not automatically be inferred. Indeed, the coexistence of many third party registrations for marks that include the term “COLORADO”, covering various kinds of apparel, is evidence in and of itself that consumer confusion is unlikely and that consumers are able to distinguish between different sources and do not believe that the term “COLORADO” necessarily denotes a single origin. Similarly, the fact that the Cited Mark is allowed to co-exist on the Register with many other unrelated third party “COLORADO” composite marks for identical or closely related goods and services, indicates

that consumers are not likely to be confused as to the origin of the goods and services merely because the marks include the term “COLORADO.”

Further, Applicant’s Goods and the Cited Goods are sufficiently distinct such that consumer confusion is unlikely. The identification of the Cited Goods is specifically limited by the wording “*all of the foregoing relating to a baseball team*” to baseball clothing and headwear (such as “jerseys” or “bibs”) that is typically used while playing baseball or is reminiscent of baseball team attire, and is directly associated with the Registrant, which is a baseball team (i.e., Colorado Rockies Baseball Club, Ltd.). This express limitation sets the Cited Goods even further apart from the goods of the many third-party “COLORADO” composite marks on the Register, and particularly it distinguishes the Cited Goods from Applicant’s Goods, which are leisure and fitness/activewear clothing (such as, e.g., capris and tank-tops) -- rather than team-inspired baseball gear available from the Registrant’s club store. Under the circumstances, Applicant’s Goods and the Cited Goods are different enough that consumer confusion is not likely and refusal to register Applicant’s Mark would be unjustified.

C. Channels Of Trade

In determining whether the parties’ goods are so related that a likelihood of confusion will result from registration of Applicant’s Mark, the practicalities of the commercial world should be guiding. Given the commercial reality, it is not just unlikely, but almost inconceivable that the respective relevant consumers would mistakenly believe that the parties’ goods originate from the same source or that a connection or sponsorship exists.

Applicant’s Goods are intended for a private label line, which will only be available in any of the Foot Locker divisions’ brand stores, and will not be sold in third-party retail outlets along with other types of clothing. In order to encounter goods bearing Applicant’s Mark, a consumer would have to actively to go to Applicant’s own outlets, where the source of

Applicant's Goods is clear to consumers. On the other hand, upon information and belief, the Cited Goods are sold through Registrant's club website <http://colorado.rockies.mlb.com/>, and the target consumers of the Cited Goods are fans seeking to buy this specific club-sponsored merchandise. Therefore, Applicant's Goods will not travel in the same channels of trade as the Cited Goods. As a result, consumer confusion is not likely to result from the registration of Applicant's Mark. The fact that the Cited Mark already co-exists with so many other unrelated third party marks which include a variation of "COLORADO" is clear evidence that consumer confusion is highly unlikely.

For all the foregoing reasons, Applicant respectfully requests that the Examining Attorney find that Applicant's Mark, when used in connection with Applicant's Goods, is not likely to cause consumer confusion with the Cited Mark, and pass the Application to publication.

II. Applicant's Mark Is Not Geographically Deceptive And Primarily Geographically Deceptively Misdescriptive

Applicant respectfully disagrees with the Examining Attorney's contention that Applicant's Mark is allegedly geographically deceptive and primarily geographically deceptively misdescriptive of the origin of Applicant's Goods.

(1). Applicant's Mark Does Not Primarily Create An Association With The State of Colorado As A Geographic Location

By incorporating the term COLORADO, Applicant's mark does not primarily create an association with the State of Colorado as a geographic location. "Colorado" conveys other connotations, for example for average consumers it is at least as equally understood to evoke a prominent association with the Colorado river, which in terms of identifying a geographic location does not pin-point particularly one state since the river runs south-west through the states of Utah, Arizona into the Gulf of California, and also is famously associated with tourist destinations not located in Colorado, such as e.g. the Grand Canyon in Arizona. Attached hereto



as Exhibit A is a printout from the online Merriam-Webster Dictionary; and Exhibit B hereto is a printout from Wikipedia, concerning the significance and multistate span of the Colorado river. Rather than any specific geographic location, the term COLORADO as used in connection with leisure and fitness/activewear clothing such as Applicant's Goods, is more likely to merely suggest the freedom and lifestyle of the great American outdoors in the mind of consumers, which is not exclusive of a particular geographic location, and certainly does not only or primarily evoke the State of Colorado. Consumers are therefore not likely to believe that Applicant's Goods, simply because they are sold under a mark incorporating the term "COLORADO," originate from the State of Colorado.

(2). Consumers Are Not Likely To Believe Applicant's Goods Originate In Colorado

The Examining Attorney argues that due to the inclusion of "COLORADO" in Applicant's mark, consumers are likely to believe Applicant's Goods originate from Colorado alleging that many clothing manufacturing companies are located in Colorado. However, Colorado is not so known or noted for the manufacture of clothing that Applicant's use of the term "COLORADO" will deceive consumers simply because (like in many other states in the United States) companies manufacture clothing within its borders. The evidence submitted by the Examining Attorney does not support this contention. The list of online results submitted by the Examining Attorney mentions only a random list of companies of unspecified significance that allegedly make clothing, not unlike similar lists that may be retrieved in other states. This is far from sufficient to prove that Colorado is well known for clothing manufacturing such that Applicant's mark will deceive consumers. The only thing which can be gleaned from the information submitted by the Examining Attorney is that ten different companies of unknown size, reach and prominence located in Colorado deal with clothing. For example, in *In re Venice Maid Co., Inc.*, 222 USPQ 618, 619 (TTAB 1984), the Board refused to sustain an examiner's

refusal to register VENICE MAID simply on the basis that Venice is a large Italian city that could, conceivably, be the source of a wide range of goods.

(3). Use Of The Term COLORADO In Applicant's Mark Will Not Be Material To Consumers' Purchasing Decisions

In any event, the fact that companies in Colorado may manufacture clothing is not enough to sustain a Section 2(a) or 2(e)(3) refusal. Such a refusal also requires the Examining Attorney to prove that consumers would be likely to associate the goods with the geographical location and that the belief the goods originated in Colorado would be a material factor in a significant portion of consumers' decision to purchase the goods. *See* TMEP § 1203.02(c). Here, the Examining Attorney has not met her burden of proof. In fact, the Examining Attorney has submitted no proof to support her assertion that whether the goods originate from Colorado would be a material factor in a consumer's decision to purchase the goods. *See In re Robert Simmons, Inc.*, 192 USPQ 331 (TTAB 1976) (holding that WHITE SABLE is not deceptive on artist's paint brushes). Unlike its well-established ski resort tourist industry and renowned mountaineering tradition, Colorado is not particularly known to the public for the manufacture of clothing. It is therefore highly unlikely that consumers would believe that Applicant's Goods sold under the mark COLORADO actually originate from Colorado. The inclusion of the term "COLORADO" in Applicant's mark would therefore not constitute a material factor in their decision to buy the goods.

The fact that many COLORADO formative marks owned by various companies located in other states or countries already co-exist on the Register for products which do not originate in Colorado indicates that consumers are not deceived into believing that products sold under marks incorporating the term COLORADO actually originate from Colorado. By way of example only, some of the registrations and applications listed in the table at pages 4-6 above are owned by

companies located in other states or countries, such as in New York, Japan, Florida and California. *See, In re Amerise*, 160 USPQ 687 (TTAB 1969) (consumers would not assume that products sold under the mark ITALIAN MAIDE are of Italian origin as it is not unusual to find products normally associated with Italy manufactured and sold by American companies).

Applicant contends that its mark can no more be said to be geographically deceptive or geographically deceptively misdescriptive than any of the already registered marks noted in the table above. Although the prior allowance of third-party registrations may not be binding on the Trademark Office, a uniform standard in the treatment of similar marks is favored. *See, e.g., In re Nett Designs*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Therefore, Applicant respectfully requests that the refusal based on geographic deceptiveness or primarily geographic deceptive misdescriptiveness be withdrawn since Applicant's Mark is inherently distinctive.

### III. CONCLUSION

Based on the foregoing remarks, Applicant respectfully requests that the Examining Attorney allow this Application to proceed to publication. If any unresolved issues still remain, the Examining Attorney is respectfully requested to telephone the undersigned in order to resolve said issues.

Respectfully submitted,

KELLEY DRYE & WARREN LLP  
Attorneys for Applicant

Dated: September 2, 2015

By: Ilaria Maggioni  
Andrea L. Calvaruso  
Amy Gaven  
Ilaria Maggioni  
101 Park Avenue  
New York, NY 10178  
Tel: 212-808-7800