

Date: 10/13/2012

Re: Serial No.: 87035174
RESPONSE TO OFFICE ACTION DATED 09/12/2016

APPLICANT: Long Branch Footwear LLC

From: David Israel, Attorney for Applicant

To: Dominic J. Ferraiuolo, Examining Attorney

Likelihood of confusion with Reg. No. 2940225 is not established due to:

- Different Channels of Trade
- Sophistication and Discrimination of Relevant Purchasers of Band Uniforms
- Differences in Appearance, Connotation and Commercial Impression

I. Different Channels of Trade

The channels of trade for the applicant's goods and the Registrant's goods (Reg. No. 2940225) are completely different. The examiner is correct that applicant's goods are sold in shoe stores or department stores with shoe departments. However, the Registrant's goods are not sold in any shoe stores or department stores, with good reason. The market for band uniforms is easily identifiable – schools and organizations such as drum and bugle corps. As such, the providers of uniforms know exactly who their potential customers are and can solicit sales directly through traveling salespersons, mailings and by websites. See **Attachment 1¹**, which lists suppliers of band uniforms and indicates they have sales reps and design teams. There is remote probability of confusion when there is a "tenuous connection" between the channels of trade. [*Electronic Design and Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 717 (Fed. Cir. 1992), 21 USPQ2d 1388] The *Electronic Design* court found that even within the same hospital there can exist different "channels of trade" because the hospital staff

¹ <http://www.marching.com/resources/banduniforms/>

responsible for purchase of one product differs from the staff responsible for the purchase of another product. See, *Electronic Design*, 954 F.3d at 717:

The likelihood of confusion must be shown to exist not in a purchasing institution, but in "a customer or purchaser." *Id.*, at 1206, 220 USPQ at 790. As one of our predecessor courts, the Court of Customs and Patent Appeals, stated in *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967):

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.

II. Purchasers (Band Directors) Are Sophisticated and Discriminating

Second, the refusal fails to consider the sophistication of relevant purchasers. The purchasers of band uniforms are the directors of bands who are purchasing enough uniforms to meet the size of the school's band. They are not buying just one uniform. The directors have the sophistication to discern the sources of available products and do not purchase without careful consideration. See **Attachment 2²**, which describes the process for selecting band uniforms and indicates the purchase is one of the "larger single expenses for the booster organization or school administrative unit." It has been held to be error by the examiner in failing to consider the sophistication of relevant discriminating purchasers. See, *Electronic Design*, 954 F.3d at 718:

The Board also apparently failed to consider, and certainly failed to address, the sophistication of the buyers. "In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of all the evidence, whether or not confusion appears likely." *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (CCPA 1973) (emphasis in original). Even though the Board made explicit factual findings as to five of the thirteen factors set forth in

² <http://www.banddirector.com/article/pgmarchingbandmarchingapparel/buyersguideforpurchasingbanduniformspg?productguide=485>

DuPont, 476 F.2d at 1361, 177 USPQ at 567, the Board gave too much weight to certain DuPont factors, such as the strength of opposer's mark, and failed to give due weight to countervailing DuPont factors, such as the sophistication of purchasers. Even assuming, arguendo, that the Board was correct in finding sufficient relatedness of the goods and services, the **relevant persons--potential or actual purchasers--are nevertheless mostly different and in any event are sophisticated enough that the likelihood of confusion remains remote.**

In an analogous case, Dynamics Research Corp. v. Langenau Mfg. Co., 704 F.2d 1575, 217 USPQ 649 (Fed.Cir.1983), our court affirmed the Board's conclusion that "because the marks are used on goods that are 'quite different' and sold to different, discriminating customers, there is no likelihood of confusion" even though both parties used the identical mark "DRC."² Id. at 1576, 217 USPQ at 649 (emphasis added). Where the purchasers are the same, their sophistication is important and often dispositive because "[s]ophisticated consumers may be expected to exercise greater care." Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 489, 212 USPQ 246, 252 (1st Cir.1981). "[T]here is always less likelihood of confusion where goods are expensive and **purchased after careful consideration.**" Astra, 718 F.2d at 1206, 220 USPQ at 790.

Of great significance is that band directors, as discriminating customers of footwear for band members, buy footwear in bulk in various sizes for the band members. This is an expensive purchase requiring careful consideration. For footwear, they carefully consider the footwear available for its traction, weather resistance and comfort. See **Attachment 3**³, a webpage which lists footwear suppliers for marching bands and identifies qualities of the footwear. In contrast, many purchasers of women's dress shoes are spur-of-the-moment purchasers of a single pair of shoes who are attracted solely by the style.

III. Appearance, Connotation and Commercial Impression

Although a literal element of a mark may leave the strongest overall commercial impression, the mark of the applicant does not have a dominant literal

³ <http://bandshoesonline.com/marchingshoes.php>

element. It is underneath the design element and the stylized lettering is subdued. This is not a case where the design element is insignificant. See, In re Dixie Restaurants, 105 F.3d 1405, 1407 ["design is an ordinary geometric shape that serves as a background for the word"]

The design element of applicant's mark includes a high-heeled woman's shoe, which has a connotation to the consumer that the source of the product sells fashionable dress shoes. The high-heeled shoe does not connote to the average consumer that the applicant is a source of footwear suitable for a marching band.

Additionally, the word "INSIGNIA" has a dictionary definition. The consumer is less likely to associate the word with a source of footwear rather than with its dictionary definition of "official emblem". As such, the design portion of applicant's mark, which resembles an emblem, leaves a more lasting commercial impression than the literal element.

Finally, the Registrant's mark is considered as a "weak" mark because it is widely used. A TESS search of INSIGNIA [FM] & "LIVE" yields over 30 registrations for INSIGNIA. The purchasing public is more likely to distinguish such marks based on small distinctions among the marks. See, *A&H Sportswear v. Victoria's Secret Stores, Inc.*, 237 F. 3d 198 (3rd Cir. 2000) at 223-224:

For example, in *Sun Banks of Florida, Inc. v. Sun Federal Savings & Loan Association*, 651 F.2d 311, 316-17& n. 8 (5th Cir.1981), the court gave special weight to the fact that 25 competing financial institutions used the word "sun" in their titles, but also noted that over 4,400 Florida businesses used the term. The *Sun Banks* court thus clearly considered extensive use in other markets in its assessment of the weakness of the contested term. See also *Triumph Hosiery Mills, Inc. v. Triumph Int'l Corp.*, 308 F.2d 196, 199 n. 2 (2d Cir.1962) ("The mark `Triumph' is a so-called weak mark, i.e. it has been used many times to identify many types of products and services."). The relevance of such other uses of similar marks is apparent; if a consumer is aware that a particular mark, like

"Triumph" or "Ace," is often used to designate a variety of products made by a variety of manufacturers, that consumer will be less likely to assume that in a particular case, two individual products, both with the mark "Triumph," come from the same source. See *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 U.S.P.Q.2d 1477, 1479 (T.T.A.B.1987) ("[T]he numerous third-party uses [of Steve's] demonstrate that the purchasing public has become conditioned to recognize that many businesses ... use the term ... and ... is able to distinguish between these businesses based on small distinctions among the marks.")

Dated: October 13, 2016

/s/David Israel, Esq.
Attorney for Applicant