BOX RESPONSE NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Trademark Commissioner:

RESPONSE TO OFFICE ACTION

This responds to the Office Action dated January 3, 2017, for U.S. Serial No. 87177031 for the mark CONTOUR ("Applicant's Mark").

Identification of Goods and Services

Per the Office's request, Applicant hereby requests that the identification and classification of the listed goods and services be amended as follows:

> *Class 16: print publications, namely magazines regarding dental news, dental career and personal financial advice, relevant dental industry trends, and student rights and formative experience in the field of dental student education*;
>
> *Class 41: online non-downloadable electronic publications, namely, magazines regarding dental news, dental career and personal financial advice, relevant dental industry trends, and student rights and formative experience in the field of dental student education.*

Response to 2(d) Refusal: Likelihood of Confusion

The Trademark Office has cited pending U.S. Application Serial Nos. 87085788 and 86545541 ("Cited Marks") as potential bars to the registration of Applicant's Mark. Details about the Cited Marks are below:

Mark	Serial No	Relevant Goods/Services	Owner
CONTOR.COM	87085788	16: Printed publications, namely, books, brochures, booklets, magazines in the fields of art, music, entertainment, fashion and general human interest and film production	CONTOR INTERNATIONAL LIMITED
CONTOURE	86545541	9: Downloadable video recordings featuring information and instruction in	Inspired Studios, Inc.

		the fields of fitness and health; Pre-recorded video discs, video recording and video tapes featuring information and instruction in the fields of fitness and health; Video recordings featuring information and instruction in the fields of fitness and health	

As discussed in greater detail in this response, Applicant respectfully disagrees that a likelihood of confusion exists between Applicant's Mark and the Cited Marks because: (1) the respective goods and services are different and travel through distinct channels of trade to distinct consumers; and (2) the respective marks are distinct in appearance, sound, and commercial impression. As such, Applicant requests that the subject trademark application be approved for publication.

The Goods are Different and Will be Sold Through Distinct Channels of Trade

The cumulative effect of differences in the essential characteristics of the goods and services involved is a fundamental inquiry mandated by Section 2(d) of the Trademark Act. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151, 153 (C.C.P.A. 1978). Applicant has amended its identification of goods and services to make very clear that its goods and services are very distinct from those offered by owners of the Cited Marks.

Applicant, the American Student Dental Association is a national student-run organization that attempts to protect and advance the rights, interests, and welfare of students pursuing careers in dentistry.[1] Applicant uses the CONTOUR trademark in connection with a publication that provides information on relevant industry trends, champions student rights and represents important experiences to the wider dental community. Applicant's identification of goods and services clearly outlines the exact nature of the publication offered under the

[1] Exhibit A: https://www.asdanet.org/

CONTOUR mark.

Contor International Limited, on the other hand, claims a vast array of goods and services, but its identification specifically limits the publications to "*books, brochures, booklets, magazines in the fields of art, music, entertainment, fashion and general human interest and film production*." Clearly, Contor International Limited's use of CONTOR.COM for publications in the fields of art, music, entertainment, fashion, general human interest, and film production would not overlap with Applicant's use of CONTOUR in connection with publications for dental school students.

Inspired Studios, Inc., uses the CONTOURE trademark in connection with videos in the field of health and fitness.[2] As seen in Exhibit B and outlined in the CONTOURE application itself, Inspired Studios does not provide printed or electronic publications under the CONTOURE mark. Inspired Studios produces and distributes fitness and workout videos. There are absolutely no reasonable circumstances under which a potential consumer would see the trademark CONTOUR for a magazine in the field of dentistry and believe that it was in any way related to a fitness video marketed and sold under any entirely different mark, CONTOURE.

With the above information it mind, it becomes clear that there is no overlap in the respective goods or services. Applicant's publications are marketed, purchased, and used by dental students or other professionals in the dental field. While Applicant's goods and services and the goods of the Cited Mark owners could all be said to fall under the incredibly broad umbrella of "publications or media" that is too tenuous a connection upon which to base a finding that they are sufficiently related for the purposes of likelihood of confusion. To demonstrate that the involved goods or services are related, it is not sufficient that a particular term may be found which may broadly describe the goods/services. *See In re W.W. Henry Co.*,

[2] Exhibit B: http://www.inspired-studios.com/contoure/

82 U.S.P.Q.2d 1213, 1215 (TTAB 2007). Further, courts have held that the mere fact that "two products or services fall within the same general field . . . does not mean that the two products or services are sufficiently similar to create a likelihood of confusion." *Matrix Motor Co. v. Toyota Jidosha Kabushiki Kaisha*, 290 F. Supp. 2d 1083, 1092 (2003), *aff'd* 120 Fed. Appx. 30 (9th Cir. Cal. 2005) (*citing Harlem Wizards Entm't Basketball, Inc. v. NBA Props*., 952 F. Supp. 1084, 1095 (D.N.J. 1997)).

In *Harlem Wizards Entm't Basketball, Inc.*, the NBA sued a theatrical basketball organization that performed "show basketball" over its use of the term WIZARDS. In finding that no confusion way likely, the court focused extensively on the slight distinction between the services, noting:

> Plaintiff would have this Court simply lump the services of plaintiff and defendants under the heading of basketball or entertainment and, on that basis alone, find that the parties engage in confusingly similar services. Numerous cases, however, illustrate that even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion.

Id. at 1095. The court went on to list a number of cases similar to the case at issue, where the services could be lumped under the same broad category, but no likelihood of confusion was found. For example, in *Sunenblick*, the court found no reverse confusion between jazz records and hip-hop records sold under the identical mark UPTOWN RECORDS because although the recordings were both musical products, they were marketed to different consumers and sold in separate sections of record stores. *Sunenblick v. Harrell*, 895 F. Supp. 616 (S.D.N.Y. 1995).

In this instance, Applicant's goods and services and the goods of the Cited Mark owners would clearly be marketed to different consumers and sold through distinct channels of trade. As such, no confusion is likely.

The Marks Are Different

Applicant's mark is CONTOUR. The prior applicants' marks are CONTOR.COM and CONTOURE. Despite the Trademark Office's contention, these marks are not identical. The appropriate test for determining a likelihood of confusion takes into account "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." TMEP § 1207.01, *citing In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). *See also Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions). It is well established that even identical marks can create sufficiently different commercial impressions when applied to the respective parties' goods or services so as not to cause confusion or mistake. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Systems*, 954 F.2d 713, 716 (Fed. Cir. 1992) (reversing TTAB finding of likelihood of confusion between EDS for computer hardware components and E.D.S. for data processing services); *NEC Electronics, Inc. v. New England Circuit Sales*, 13 U.S.P.Q.2d 1059 (D. Mass. 1989) (no likelihood of confusion between the marks NEC and NECS, where both companies sold computer chips to sophisticated purchasers with specific technical needs).

In the context of CONTOR.COM, "contor" means "a measuring instrument in the nature of a meter".[3] Applicant's mark CONTOUR has no similar meaning. CONTOUR is a commonly understood English word with a readily identified meaning, unlike CONTOR.COM.[4] Further, the addition of ".COM" further distinguishes the marks in appearance, sound, and meaning. With respect to the CONTOURE mark in connection with videos in the field of health and wellness, this clearly implies to contouring or shaping of one's physical body. Applicant's Mark has no

[3] Exhibit C
[4] Exhibit D: http://www.dictionary.com/browse/contour

similar meaning when applied to publications in the field of dentistry. When used in connection with Applicant's publications, the CONTOUR mark is entirely arbitrary and will be viewed by the relevant consuming public as such.

The Burden of Proof

The burden of proof is on the Examining Attorney to establish the likelihood of confusion. A refusal should be based on an understanding of the relevant industries, an analysis of the marketplace, and the likely reaction of prospective purchasers. Substantial evidence is now before the Examining Attorney to show that no likelihood of confusion is possible. To maintain this refusal in view of these submissions, significant contrary evidence would be necessary.

Conclusion

Applicant has responded to all matters in the Office Action and should the Examining Attorney have any questions with regard to this Response or to any matter relating to this Application in general, a telephone call to Applicant's undersigned representative at the telephone number listed below would be greatly appreciated.

Respectfully submitted,

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