

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICE ACTION

Applicant, Mitsui & Co., Ltd., hereby responds to the Office Action dated June 16, 2017, in which the U.S. Patent and Trademark Office (“PTO”) refused the Applied-For-Mark “SHIELD” on the Principal Register.

The Examining Attorney cited U.S. Registration No. 2481193 for the mark SHIELD GEAR; Registration No. 4762333 for SHIELD & Design, Registration No. 4808805 for SHIELD CLASSIC, and prior pending Application Serial No. 87172107 for the mark SHIELD WEAR, and refused registration under Section 2(d) likelihood of confusion.

Applicant hereby deletes Class 25 from the Applied-For Mark, in filing this Response. In light of the above, Applicant respectfully requests that the Examining Attorney reconsider his refusal to register Applicant’s Mark.

The Examining Attorney has refused registration of Applicant’s Mark noting that the above mentioned marks (the “Cited Marks”) present a bar to registration of Applicant’s Mark based on confusing similarity.

A review of the relevant likelihood of confusion factors demonstrates that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks.

(1) No Likelihood of Confusion

In determining whether a likelihood of confusion exists, the fundamental inquiry goes to the cumulative effect of the differences in the marks and the goods or services at issue. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). Under the Lanham Act, a refusal to register requires that such confusion as to the source of the goods and/or services is not merely possible, but **likely**. A mere possibility of confusion is an insufficient basis for rejections under Section 2(d). *In re Massey-Ferguson*, 222 U.S.P.Q. 367, 368 (T.T.AB. 1983). In the present case, the differences in the respective marks, in light of all the relevant factors, lead to a finding of no likelihood of confusion.


I. Different Commercial Impression

When examining the similarity or dissimilarity of marks, the marks must be compared “in their entirety as to appearance, sound, connotation and commercial impression.” In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); see also TMEP §1207.01(b).

In analyzing the similarity of the marks, it is inappropriate to dissect the marks of the parties and to discard or ignore all other non-similar elements, as the marks should be viewed in their entirety. Daddy’s Junky Music Stores Inc. v. Big Daddy’s Family Music Center, 109 F.3d 275, 283 (6th. Cir. 1997). To do so is contrary to the principles of trademark law. A trademark should not be split into its component parts and each part compared with parts of the conflicting mark to determine the likelihood of confusion. Little Caesar Enterprises Inc. v. Pizza Caesar Inc., 4. USPQ 2d 1942 (6th Cir, 1987).

When the marks of the parties are viewed in their entirety, Applicant's mark significantly differs from the cited marks in appearance and overall commercial impression.

In this case, the Applied-For Mark and the Cited Marks are visually distinct due to the presence of the terms “GEAR/CLASSIC” and the design which provide the whole marks with a different commercial impression from Applicant’s mark. Further, a visual contrast between the Applied-for-Mark and the cited Registrations infers that they do not look similar, reducing any possible risk of confusion as follows:

Applicant’s Mark	Cited Marks (1)	Cited Mark (2)	Cited Mark (3)
SHIELD	SHIELD GEAR Registration No. 2481193	 SHIELD Registration No. 4762333	SHIELD CLASSIC Registration No. 4808805

The additional terms "GEAR, CLASSIC" along with the special design of cited marks is sufficient to distinguish the marks and prevent any confusion. Applicant's position is supported by several analogous cases featuring similarly constructed marks. For example, in *Colgate-Palmolive C. v. CarterWallace, Inc.*, 167 USPQ 529 (C.C.P.A. 1970) the mark "PEAK PERIOD" for personal deodorants was found not to be confusingly similar to the mark "PEAK" for dentifrices.

See also *Bell Laboratories, inc. v. Colonial Products, Inc.*, 231 USPQ 569, 572 (S.D. Fla. 1986) (emphasizing the difference in sight and sound between "FINAL" and "FINAL FLIP," both for pesticides); *Gruner + Jahr USA Publishing v. Meredith Corp.*, 26 USPQ2d 1583, 1587 (2nd Cir. 1993) (holding that "PARENTS" and "PARENTS DIGEST" for the same type of magazines were not confusingly similar); *In re Ferrero*, 178 USPQ 167, 168 (C.C.P.A. 1973)(holding that "TIC TAC" for candy was not confusingly similar to "TIC TAC DOE" for ice cream); *In re Hearst Corp.*, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (holding that "VARGAS" and "VARGA GIRL," both for calendars, were sufficiently different so that there was no likelihood of confusion).

Therefore, the differences between Applicant's mark and the Cited marks outweigh any similarities that the marks may share, and will prevent any confusion on the part of consumers.

II. The Parties' Goods are Distinguishable

First, there is no likelihood of confusion due to the differences in the parties' goods.

A review of the goods listed in the Applied-For Mark and the Cited Registrations reveals that the goods are not commercially related, as follows:

Goods Listed in the Applied-For Mark- As Amended	Goods/services Listed in the Cited Registration(s)
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Goods Listed in the Applied-For Mark-As Amended	Goods/services Listed in the Cited Registration(s)
<p>Class 24: Textile piece goods, namely, fabric for use in the manufacture of articles of clothing and sleeping bags.</p>	<p>Registration No.</p> <p>Class 25: men's, women's clothing, namely, fleece tops, T-shirts, sweatshirts, shorts, pants, jackets, wind resistant jackets</p>
	<p>Registration No. 4762333</p> <p>Class 9: Industrial safety articles in the nature of safety clothing, namely, clothing for protection against fire, flame retardant clothing, dust protective clothing and impact protective clothing; waterproof and/or water-resistant clothing, namely, water-resistant survival suits, coveralls, overalls, trousers, jackets, bomberjackets, parka's, bib overalls, shorts and salopettes; gloves, namely, fire resistant gloves, water-resistant gloves and impact protective gloves; safety shoes and safety boots, namely, protective industrial shoes and protective industrial boots; protective glasses; protective masks, namely, dust protective masks and protective face masks not for medical purposes; safety articles for personal use not included in other classes, namely, safety helmets and safety eyewear; all aforementioned goods not to be used for welding purposes or related to welding technology; and</p> <p>Class 25: Clothing, namely, coveralls,</p>

Goods Listed in the Applied-For Mark-As Amended	Goods/services Listed in the Cited Registration(s)
	<p>overalls, trousers, jackets, bomber jackets, parkas, bib overalls and salopettes; work clothing, not included in other classes, namely, coveralls, overalls, dust coats and work trousers; footwear, namely, shoes and boots; waterproof and water-resistant clothing and footwear, not included in other classes, namely, waterproof and water-resistant coveralls, trousers, jackets, bib overalls, salopettes, bomber jackets, parkas, overalls, dust coats, work trousers, as well as waterproof and water-resistant shoes and boots; all aforementioned goods not to be used for welding purposes or related to welding technology</p> <p>Registration No. 4808805</p> <p>Class 24: Textiles and textile goods, namely, fabrics, cotton fabrics, felt fabrics, faux suede fabrics, satin fabrics, silk fabrics, printed fabrics, woven fabrics; upholstery materials, namely, fabrics, cotton fabrics, felt fabrics, suede fabrics, satin fabrics, silk fabrics, printed fabrics, woven fabrics; materials for covering walls, namely, textile and fabric wall hangings; materials for soft furnishings, namely, textiles and fabrics for the further manufacture of soft furnishings; curtain materials of fabric and textile; fabrics for</p>

Goods Listed in the Applied-For Mark-As Amended	Goods/services Listed in the Cited Registration(s)
	<p>the manufacture of upholstered goods; flame retardant fabrics for the further manufacture of upholstered goods; waterproof fabrics for the further manufacture of upholstered goods; water resistant fabrics for the further manufacture of upholstered goods; laminated fabrics for the further manufacture of upholstered goods; vinyl cloth for use in the manufacture of upholstered goods; plastic substitutes for fabrics in the nature of vinyl fabric for use in the manufacture of upholstered items; upholstery fabrics; fabrics for the further manufacture of wall coverings; fabrics for furnishings; fabrics for soft furnishings; fabrics for seating areas, namely, for the further manufacture of furniture; curtain fabrics; soft furnishings, namely, curtains, cushion covers, bed sheets, duvet covers, pillow covers, bed blankets, blanket throws, lap blankets, travelling blankets, throws, coverlets; curtains; curtains of textile material; curtains made of plastics; shower curtains; door curtains in the nature of fabric curtains for separating rooms; fabric curtains for cubicles; fabric curtains for hospital cubicles; replacement parts for the aforesaid goods</p>

Goods Listed in the Applied-For Mark- As Amended	Goods/services Listed in the Cited Registration(s)
	Serial No. 87172107 Class 25: Clothing, namely, T-shirts, long sleeve shirts, hats, shorts, shirts, pants, headwear, tank tops, jackets, sweat shirts, women's bra; Athletic apparel, namely, shirts, pants, jackets, hats and caps, women's bra

It is clear that the nature, application, use and purpose of the parties' goods differ. Therefore, confusion regarding source or origin of the products is unlikely.

In the present case, Applicant's goods are clearly distinguishable from the goods listed in the Cited Registrations, and the prior pending Application. The Applied-For Mark will be used as a raw material, while the cited registrations are used to identify finished products such as clothing and/or fabric for industrial applications such as fabrics to covering walls, seats, and furnishing. Applicant also states that the goods and services are not competitive or complementary and are offered for wholly different purposes. Applicant respectfully submits that the differences in the parties' goods alone are sufficient to obviate any likelihood of confusion. See, e.g., In re Majestic Distilling Company, Inc., 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) ("Not all of the DuPont factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case.'").

Applicant states that Applicant's industry, market, and consumer differs from the Cited Registrations. It is clear that the nature, application, use, and the industry of the parties' goods differ. Therefore, confusion regarding source or origin of the products is unlikely.

II. Sophisticated Purchasers

Further minimizing any likelihood of confusion, the sophistication of the consumers is a key factor in this case too. It has been well established that confusion is less likely to arise when consumers deliberate over purchases. See *L.J. Mueller Furnace Co. v. United Conditioning Corp.*, 106 USPQ 112 (C.C.P.A. 1955); *Magnaflux Corp. v. Sonoflux Corp.*, 109 USPQ 313 (C.C.P.A. 1956); *Minnesota Mining and Manufacturing Company v. Electronic Memories, Inc.*, 173 USPQ 178 (C.C.P.A. 1972).

The degree of care exercised by consumers in purchasing goods, and the degree of sophistication of the relevant consumer group is a key factor that negates any likelihood of confusion in this case. TMEP § 1207.01(d)(vii); *Arrow Fastener Co. v. The Stanley Works*, 35 USPQ2d 1449, 1458 (2d Cir. 1995); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (T.T.A.B. 1986). If a purchasing decision is made after careful examination of the product, this is usually sufficient to negate a likelihood of confusion between the marks containing similarities. *Stoffer Corp. v. Health Valley Natural Foods, Inc.*, 1 USPQ 2d 1900 (T.T.A.B. 1986). See *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED).

In this case, customers of fabrics to manufacturer industrial items, and clothing in general are savvy and well informed of the products that they acquired. They look for the brand, price, quality, scientific techniques apply to manufacture raw material, new technology, and manufactures processes involved in the fabrication of the products. They are concern about new green trends, protection, quality, price, and safety. As such, the decision of acquiring a fabric of this nature is made after carefully examination of the materials, composition, innovation, and standards, among other factors. They would only seek out those goods that matched the purchaser's individual needs. Applicant submits an online article describing the consumer's behaviors in selecting clothing and fabric items. Please see Exhibit A.

The purchasers of Registrant's goods and Applicant's goods are sophisticated and knowledgeable. Purchases would not be made in a hasty manner. Great care

would be exercised during the purchasing process. It has been stated that where the nature of the goods demands this kind of deliberation, confusion is hardly even possible, much less likely. The Court of Customs and Patent Appeals has stated that other things being equal, confusion is less likely where goods are purchased after careful consideration than where they are purchased casually. See *Magna Flux v. Sonoflex Corp.*, 231 F.2d 669 (C.C.P.A. 1956).

This care in purchasing and the sophistication and knowledge of the purchasers, when coupled with the differences in the marks results in a situation where confusion is hardly possible, much less likely.

Applicant also states that the relevant consumers do distinguish the marks SHIELD and the SHIELD-formative marks even when the marks are used for fabrics and/or related goods such as clothing, as in this case. Currently, there are registered and granted several SHIELD marks in connection with identical or closed related goods to those cited by the Examining Attorney, including one in the name of Applicant, Mitsui & Co., Ltd., for the same goods listed in the Applied for-Mark as follows:

Marks	Class/Goods	Applicant/Owner
PERTEX SHIELD	Class 24: Textile fabrics for making waterproof, showerproof, or windproof articles, namely, clothing, sleeping bags, and tents; and Class 25: Outerclotthing, namely, waterproof, showerproof, or windproof jackets, pants, or coats; coats; jackets; trousers; anoraks; hoods; hooded robes	Mitsui & Co., Ltd.
HYDRA SHIELD	Class 24: Textile fabrics for use in the manufacture of garments, bags, jackets, gloves, and apparel; Waterproof fabric for manufacturing clothing, furniture and automobile upholstery, and luggage; Non-woven textile fabrics; Textile fabrics for use in the manufacture of garments, bags, jackets, gloves, and apparel; waterproof breathable polyurethane	NTA Enterprise, Inc.

Marks	Class/Goods	Applicant/Owner
	fabric for use as a textile in the manufacture of a lining or insert for clothing	
MULTISHIELD	Class 24: Curtains; fabric window coverings and treatments, namely, window liners in the nature of draperies; window treatments in the nature of window panels of polyester, cotton and wool; fabric window coverings, namely, curtains and draperies	Ellery Holdings LLC
SOLSHIELD	Class 24: Curtains; fabric window coverings and treatments, namely, window liners in the nature of draperies; window treatments in the nature of window panels of polyester, cotton and wool; fabric window coverings, namely, curtains and draperies	Ellery Holdings LLC
BLOCKSHIELD	Class 24: Curtains; fabric window coverings and treatments, namely, window liners in the nature of draperies; window treatments in the nature of window panels of polyester, cotton and wool; fabric window coverings, namely, curtains and draperies	Ellery Holdings LLC
INTERSHIELD	Class 24: Curtains; fabric window coverings and treatments, namely, window liners in the nature of draperies; window treatments in the	Ellery Holdings LLC

Marks	Class/Goods	Applicant/Owner
	nature of window panels of polyester, cotton and wool; fabric window coverings, namely, curtains and draperies	
PROTECTO CAMO SHIELD CAMO PATCH	Class 24: Self-adhesive fabrics having camouflage patterns	Protecto Wrap Company
SHIELDX	<p>Class 24: Bed blankets; Bed pads; Bed sheets; Bed spreads; Pillow cases; Sheet sets; Towel sets; Towels; Bath towels; Beach towels; Cotton towels; Hand towels; Kitchen towels;</p> <p>Class 25: Ankle socks; Baselayer bottoms; Baselayer tops; Bras; Briefs; Camouflage shirts; Clothing, namely, base layers; Fishing shirts; Hunting shirts; Ladies' underwear; Long underwear; Men's socks; Men's underwear; Shirts; Shirts and short-sleeved shirts; Socks; Socks and stockings; Sports bra; Sports bras; Tee-shirts; Thermal socks; Thermal underwear; Underwear; Women's underwear; Woollen socks; Boxer briefs; Moisture-wicking sports bras; Panties, shorts and briefs</p>	Unifire Corporation
SOFTSHIELD	Class 24: Sheets, pillow cases, comforters, duvets, bedspreads, bed blankets, shams, bed ruffles, bath	Welspun Global Brands Limited

Marks	Class/Goods	Applicant/Owner
	towels, beach towels and washcloths	
PEE PEE SHIELD	Class 24: Diaper changing cloths for babies; Diaper changing pads not of paper	Slepkow, Joshua
DURASHIELD	Class 24: Polyurethane barrier covers specially adapted for mattress pads	Standard Fiber, LLC
BATTLESIELD X	Class 24: Textile fabrics for the manufacture of clothing, namely, jackets, parkas, vests, pants, shirts, pullovers, crew necks, mock turtlenecks, overalls, bib overalls, headwear, and gloves	Samtech, LLC
MICROSHIELD	Class 24: Antimicrobial fabric finish or surface treatment composition sold as a component of finished treated or coated fabrics for window fashions	Hunter Douglas Inc
SOFA SHIELD	Class 24: Unfitted fabric furniture covers	Hills Point Industries
CAMO SHIELD	Class 24: Self-adhesive fabrics having camouflage patterns	Protecto Wrap Company
LIFESHIELD	Class 24: Bath linen; Bath towels; Beach towels; Bed linen; Golf towels; Hand towels; Towel sets; Towels; Towels for use in salons and barber shops	Immortal Gear Llc Limited Liability Company
P-SHIELD	Class 24: fabric for shielding electronic components from electromagnetic waves	Polymer Science, Inc.
THERMAL SHIELD	Class 24: window curtains	Maytex Mills, Inc

Marks	Class/Goods	Applicant/Owner
SHIELD DESIGNER	Class 24: Textiles and textile goods, namely, fabrics, cotton fabrics, felt fabrics, faux suede fabrics, satin fabrics, silk fabrics, printed fabrics, woven fabrics; upholstery materials, namely, fabrics, cotton fabrics, felt fabrics, suede fabrics, satin fabrics, silk fabrics, printed fabrics, woven fabrics; materials for covering walls, namely, textile and fabric wall hangings; materials for soft furnishings, namely, textiles and fabrics for the further manufacture of soft furnishings; curtain materials of fabric and textile; fabrics for the manufacture of upholstered goods; flame retardant fabrics for the further manufacture of upholstered goods; waterproof fabrics for the further manufacture of upholstered goods; water resistant fabrics for the further manufacture of upholstered goods; laminated fabrics for the further manufacture of upholstered goods; vinyl cloth for use in the manufacture of upholstered goods; plastic substitutes for fabrics in the nature of vinyl fabric for use in the manufacture of upholstered items; upholstery fabrics; fabrics for the further	Panaz Limited

Marks	Class/Goods	Applicant/Owner
	<p>manufacture of wall coverings; fabrics for furnishings; fabrics for soft furnishings; fabrics for seating areas, namely, for the further manufacture of furniture; curtain fabrics; soft furnishings, namely, curtains, cushion covers, bed sheets, duvet covers, pillow covers, bed blankets, blanket throws, lap blankets, travelling blankets, throws, coverlets; curtains; curtains of textile material; curtains made of plastics; shower curtains; door curtains in the nature of fabric curtains for separating rooms; fabric curtains for cubicles; fabric curtains for hospital cubicles; replacement parts for the aforesaid goods</p>	
ECOSHIELD	Class 24: Fabrics for textile use	Victor Innovatex Inc.
FORMASHIELD	Class 24: Resin-saturated fiberglass fabric for use in structural reinforcement, structural repairs, and structural protection	Pipe Wrap LLC
ULTRA-SHIELD	Class 24: Ballistic resistant fabrics for use in the production of ballistic resistant, bulletproof, and blast proof clothing, garments, shoes, shields, and personal body armor	Top-Line Armor Systems, LLC
FPG THERMASHIELD	Class 24: Blanket throws; Blankets for outdoor use; Fabrics for the manufacture of modular panels, heat	ForceProtector Gear, LLC

Marks	Class/Goods	Applicant/Owner
	reflection, insulation, camouflage, shelter; Mixed fiber fabrics; Narrow woven fabrics	
FLEXSHIELD	Class 24: woven fabrics and textile goods, namely, textile fabrics for use in making clothing; cotton fabrics; woolen fabrics; lining materials, namely, textile used as lining for clothing; fleece fabrics; textile substitute materials made from synthetic material; bath linen; textile towels; blankets, namely, travelling blankets, woolen blankets, fleece blankets	Jack Wolfskin Ausrüstung für Draussen GmbH & Co

Current TSDR records for the marks cited above are attached hereto as Exhibit B.

As such, as no confusion was considered likely between the related previously registered and granted marks, Applicant submits that there is no likelihood of confusion between the Applicant's mark and the Cited Marks, and respectfully request the Examining Attorney use the same reasoning here.

IV. Conclusion

An analysis of the facts in the present case supports a conclusion that consumers will not be confused. Applicant submits that, given the differences in the parties respective marks, as well as the care and sophistication with which a purchase of Cited Registration's products would be made, there is no likelihood of confusion between Applicant's mark, and the Cited Mark. In view of the foregoing, Applicant respectfully

requests the Examining Attorney withdraw the refusal and approve Applicant's Mark for publication in the Official Gazette.