

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark: )

)  
)  
)  
)

Serial No.: 88/248,783 )

Examining Attorney:

Filing Date: January 3, 2019 )

Megan Mischler

Our Docket No. 11605-289428 )

Law Office: 127

Applicant: Logistick, Inc. )

**RESPONSE TO OFFICE ACTION**

This responds to the Office Action dated March 21, 2019, for U.S. Serial No. 88/248,783 for the

SECURE & Design



("Applicant's Mark").

**I. Identification of Goods**

Applicant's mark has been refused in part due to an indefinite identification of goods. In response, Applicant, through the TEAS form, amends the applied-for goods as follows (as recommended by the Examining Attorney):


Class 20: Non-metal braces **specially adapted for use in holding** cargo shipping **containers**

**II. Section 2(d) Refusal – Likelihood of Confusion**

The Examining Attorney has also refused registration of Applicant's Mark based on three co-existing registrations for SECURE SLING & STRAP (Stylized), SECURE LOOPS, and SECURE-TITE (Stylized) owned by three unrelated companies. For the reasons detailed below, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the cited marks and requests that the Section 2(d) refusals be withdrawn.

**Background and Introduction**

The Examining Attorney refused registration of Applicant’s Mark based on the following registrations (collectively referred to as “Cited Marks”):

Reference	Mark	Owner	Reg. No.	Relevant Class & Goods
Cited Mark 1	 <p>SECURE SLING &amp; STRAP</p>	SMOLAK, ADAM PAUL	5367250	Class 22 - All-purpose nylon straps; All-purpose nylon straps featuring hook and loop fasteners; All-purpose straps comprised of synthetic textile materials; All-purpose tarpaulins of plastic; Anchoring ropes; Arrays of resilient plastic straps that may be arranged in prescribed angular orientations relative to each other to accommodate objects of different sizes, shapes and configurations in any one of a multiplicity of different arrangements; Belts, not of metal, for handling loads; Canvas tarpaulins; Car towing ropes; Cargo and carrier equipment for vehicles comprised of synthetic textile materials, excluding artificial leather, namely, tow ropes, tow straps, ratchet tie-down straps, quick release tie down straps, lashing straps, and tarp straps; Cargo slings of rope or fabric; Chemical fiber nettings; Cotton bags for industrial use; Disposable bulk container liners; Elastic bands for binding; Fabric and polyester mesh net used for storing toys and other household items; Heavy-duty bags for disposal of building materials and refuse; Heavy-duty bags for recycling and disposal of building materials; Heavy-duty bags for recycling and disposal of building materials, roofing shingles,

			<p>bricks; Horticultural bags and sacks made of woven synthetic or natural fibers or plastics materials, all for use in growing any type of plant, shrub or tree; Industrial packaging containers of textile; Mesh bags for storage; Mountaineering ropes; Natural fibers for use as reinforcements and fillers in composite materials used in the manufacture of a variety of industrial and consumer goods; Non-metal bands for wrapping or binding; Non-metal net wrapping for pallets; Non-metal rigging chains; Non-metal slings for loading; Non-woven polymeric fibers for conversion into a variety of industrial and consumer goods; Nylon fibers for textile use; Nylon strapping or tie downs; Nylon straps for handling loads; Nylon support straps for holding planted trees in an upward position; Nylon tie down straps; Nylon towing straps; Nylon weed trimmer line; Outdoor blinds of textile; Packaging bags of textile material; Packing rope; Polyester fibers; Polyester plastic netting for packaging goods; Polyethylene adhesive patches for repair of torn or damaged high-density polyethylene plastic bags for the storage of construction materials like rocks, bricks, roofing shingles; Polypropylene bags used for the storage of construction materials like bricks, roofing shingles; Polypropylene straps for securing bundles; Protective unfitted liners for the cargo area of vehicles; Ropes; Ropes and synthetic ropes; Ropes for</p>
--	--	--	---

			<p>marine use; Ropes, not of metal; Rubber cable ties and straps for fastening and securing objects such as bundles of wire together; Sacks or bags for the transportation or storage of materials in bulk; Sheets of polypropylene netting used for decorating floral and gift arrangements and craft purposes; Synthetic fibers; Synthetic fibers and filaments for use in the manufacture of fabrics, textiles, yarns, and carpets; Synthetic fibres for textile use; Synthetic rope and webbing; Tarpaulins; Tarpaulins; Tarpaulins; Tarpaulins; Tarpaulins made from plastics coated materials; Tents; Tents; Tents comprised primarily of tensile fabric membrane; Tents for mountaineering or camping; Textile bags for merchandise packaging; Textile fibers; Textile fibres; Textile filaments; Tow; Tow ropes for automobiles; True hemp fiber; Twine; Twine for nets; Twine made of paper; Twines; Unfitted covers for boats and marine vehicles; Unfitted liners for the cargo area of vehicles; Unfitted vehicle covers; Vehicle covers, not fitted; Vehicle rescue apparatus, rope cables used to affix between vehicles to pull a jammed or stuck door of one of the vehicles; Wrapping or binding bands, not of metal; Yarn fibers; Slings, not of metal, for handling loads; Cables, not of metal; Glass fiber netting; Hemp; Hemp fibers; Hemp fibres; Hemp nettings; High-density polyethylene plastic bags for the storage of household items; Horticultural</p>
--	--	--	--




				bags and sacks, bags and sacks made of woven synthetic or natural fibers or plastics materials, all for use in growing any type of plant, shrub or tree; Jute bags for industrial use; Jute fiber; Shock cords not of metal; Tow ropes for automobiles; True hemp fiber; Twine; Twine for nets; Twine made of paper; Twines
Cited Mark 2	SECURE LOOPS	VALEDA COMPANY, LLC	3416436	Class 22 - Tie down straps
Cited Mark 3	<b>SECURE-TITE</b> (stylized)	HAMPTON PRODUCTS INTERNATIONAL CORPORATION	3080216	Class 22 - All-purpose straps for cargo; non-metal strapping or tie downs for cargo; straps for handling and securing loads; tie down straps for cargo; towing straps for cargo; straps for securing bundles

As discussed in greater detail below, Applicant respectfully disagrees that there is any potential likelihood of confusion between Applicant’s SECURE & Design mark and the Cited Marks because: (1) The Relevant Public Is Exposed To Several Third-Party SECURE Marks; (2) The Respective Marks Are Dissimilar When Considered In Their Entireties; and (3) The Burden Of Proof To Find A Likelihood Of Confusion Has Not Been Met. As such, Applicant respectfully requests that the subject trademark application be approved for publication.

**1. The Relevant Public Is Exposed To Several Third-Party SECURE Marks**

The common term of the Cited Marks and Applicant’s mark—SECURE—is significantly diluted. “If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” TMEP § 1207.01(d)(iii), *quoting, Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). Here, the term “SECURE” is so commonly used and registered in connection with goods in International Classes 20 and 22 for braces and straps for cargo and related goods that no one trademark owner can claim broad rights to this highly diluted term.

Applicant has identified over one hundred federal trademark registrations and allowed applications utilizing the term SECURE for the same or related goods, including the following:

Trademark	App./Reg. No.	Goods/Services
SECUREHOOKS	SN: 88008026	Class 20: Household safety devices, namely, anti-tip-kits for furniture and televisions comprised of non-metal general use wall and ceiling mounts, brackets, straps and hooks; and non-metal screw-less mounting fixtures and fasteners, namely, general use wall and ceiling mounts for furniture and televisions.
SECURE IT QUICK	SN: 88263979	Class 20: Non-metal hooks.  Class 22: All-purpose nylon straps; All-purpose nylon straps featuring hook and loop fasteners; Bungee cords; Synthetic rope and webbing.
SECURE YOUR PASSION	SN: 87311423	Class 22: Cargo management products comprised of synthetic textile materials, excluding artificial leather, namely, ratchet tie downs, cambuckle tie downs, over-center tie downs, bungee cords, tarp straps, cable ties, tow straps, retractable tie downs and retractable tow straps.
SECURE A STRAP 	RN: 5145726	Class 22: Elastic and bungee ratchet strap and tie-down organizers.
SECURE YOUR FUTURE	RN: 4379619	Class 22: Polyethylene strapping and tie downs; plastic strapping and tie downs.
SL SECURELINE BY LEHIGH 	RN: 4191449	Class 6: metal hardware, namely, non-electric cables, chains, trigger snaps, anchor shackles, s-hooks, bolt snaps, quick snaps, snap links, rope clips, hitch rings, cable thimbles, quick links, rope cleats, o-rings, ferrules, rope clamps, pulleys, clevis hooks, chain attachments in the nature of repair links, grab hooks, load binders, metal cable winches, and screw-in wall and ceiling hangers for hanging tools.  Class 8: manually operated pipe and tube working tools in the nature of swaging tools.  Class 20: plastic hardware, namely, chains, pulleys, and stakes, namely, tent stakes and ground stakes for gardening.  Class 22: ropes made of natural and synthetic fibers.
SECURE-TITE 	RN: 4298252	Class 12: Fitted liners for cargo area of vehicles in the nature of cargo nets; fitted tonneau covers for truck beds.

		Class 22: Storage bags for tie-down webbing; bungee cords; unfitted liners for the cargo area of vehicles in the nature of cargo nets; rope tie-down straps; unfitted covers for truck beds in the nature of a tarp.
SECURIBOX	RN: 4966974	Class 20: Non-metal and non-paper containers and closures for containers, in particular such with a tamper-evident seal.  Class 21: Containers of glass, in particular for household and kitchen, and in particular with closures for tamper-evident protection of the content.
SECURE LOOPS	RN: 3416436	Class 22: Tie down straps.
SAFE 'N SECURE	RN: 2741304	Class 6: Securement system for securing items during storage and shipping, namely metal, rail-mounted or formed slots provided in interior walls of the cargo area of a vehicle that are attachable to straps, cords, slings and cargo securement bars to secure goods or objects during transportation; cargo control restraint bars made of metal.  Class 22: Cargo control devices, namely, tow and lashing straps and cargo nets.
SECURE SYSTEMS	RN: 2129536	Class 22: cargo tie down straps.

(TSDR reports for the above references are attached as Exhibit A.).

The above evidence demonstrates the USPTO has determined that marks including the term SECURE for the relevant goods herein can co-exist. "[T]hird-party registrations may be relevant to show that a mark or a portion of a mark is ... so commonly used that the public will look to other elements to distinguish the source of the goods or services." TMEP § 1207.01(d)(iii). *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40 (Fed. Cir. 2015).

In this case, as shown by the evidence above, it is common in selling braces and straps for cargo to use the word SECURE and its variations, and for those marks to co-exist with other marks containing similar or identical variations. Indeed, the peaceful co-existence of the registrations for the Cited Marks indicates confusion is unlikely to occur. *In re Itec Mfg., Ltd.*, 2008 TTAB LEXIS at \*25 (TTAB 2008) (finding that the coexistence of the cited registrations is "probative in showing the confusion is unlikely to occur among the relevant medical professionals and other medical entities purchasing the involved goods."). As such, consumers are accustomed to distinguishing among many types of SECURE-formative marks in the marketplace.

**2. The Respective Marks Are Dissimilar When Considered In Their Entireties**

The appropriate test for determining a likelihood of confusion is to account for “the similarity or dissimilarity of the marks ***in their entirety*** 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 (CCPA 1973))(emphasis added). See also *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (overruling the Trademark Trial and Appeal Board and finding the VARGA GIRL and VARGAS are sufficiently different in sound, appearance, connotation, and commercial impression and therefore finding no likelihood of confusion). In comparing word marks:


[t]he points of comparison .... are appearance, sound, meaning and commercial impression. Similarity of the marks in one respect -- sight, sound, or meaning -- will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related.

See *In re Thor Tech, Inc.*, 90 U.S.P.Q. 2d 1634, 1635 (TTAB 2009).

Furthermore, for the purposes of determining a likelihood of confusion, a trademark must be considered in its entirety and not dissected into component parts. *Estate of P.D. Beckwith Inc. v. Comm’n of Patents*, 252 U.S. 538, 546 (1920); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986). "It has been held to be a violation of the anti-dissection rule to focus upon the 'prominent' feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark." McCarthy, *McCarthy on Trademarks and Unfair Competition*, *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992) (VARGA GIRL and VARGAS not confusingly similar when used on same or similar goods); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F. 2d 1005, 212 U.S.P.Q. 233, 234 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.").

In this case, it is improper to dissect the respective marks, focusing *solely* on the “SECURE” portion of each mark and completely ignoring the other differences. Indeed, Applicant’s Mark and the Cited Marks all include unique additional terms, stylization, and/or design elements



For example, Applicant’s  mark consists of the single term SECURE and a unique design element created by placing the term on a slant between two thick bars. The overall look





of the mark is similar to that of the familiar “confidential” stamp, evoking feelings of being locked and safe or protected.

These distinctive visual stylization and design elements distinguish the mark from Cited Mark 1,



, which not only contains its own distinctive stylization and design elements, but also the additional phrase “SLING & STRAP.” These distinct features make the respective marks appear differently when viewed by consumers and also sound differently when referred to by consumers. Indeed, “SECURE SLING & STRAP” sounds very different from simply “SECURE,” and the



unique block-like lettering with the elongated “R” used in evokes the thought of a strap used to tie something in place, which is very different from the stamp-like feel of Applicant’s mark.

Applicant’s mark is also readily distinguishable in appearance and sound from Cited Mark 2, SECURE LOOPS, and Cited Mark 3, SECURE-TITE (stylized), which also contain their own distinctive elements, particularly the additional terms “LOOPS” and “TITE.” These added terms create different appearances and sounds from Applicant’s unitary mark consisting of only the term SECURE. This is important because as the Court explained in *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) “[m]arks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.”

When properly considering the respective marks in their entirety, as required, Applicant’s



mark is readily distinguishable from the Registrants’ , SECURE LOOPS, and SECURE-TITE marks in sound and appearance. Given the aural, contextual, and visual differences, the respective marks are sufficiently different.

**3. The Burden of Proof to Find a Likelihood of Confusion Has Not Been Met**

The Trademark Office must meet its burden of proving that Applicant's mark, when used in connection with the Applicant's goods, so resembles the Registered marks when used with Registrants' goods, as to be likely to cause confusion, to cause mistake, or to deceive the relevant purchasing public. *See In re Giovanni Food Co.*, 97 U.S.P.Q.2d 1990, 1991 (T.T.A.B. 2011) (“[W]e determine that the Office has not met its burden of proving likelihood of confusion”); *see also* 15 U.S.C. §1052(d). A refusal should be based on comparison of the *entire* marks, an *understanding of the relevant industries*, an *analysis of the marketplace*, and the likely reaction of prospective purchasers. Substantial evidence is now before the Trademark Office to show that confusion is not likely.

Therefore, Applicant respectfully requests that the Examining Attorney allow the subject application to proceed toward registration.

**III. Conclusion**

For each of the above reasons, and certainly for their combined effect, Applicant respectfully submits that all issues have been addressed and requests that the Examining Attorney allow Application Ser. No. 88/248,783 for publication.

Dated: June 23, 2019

Respectfully submitted,  
LOGISTICK, INC.

By: Monica J. Stover  
Monica J. Stover  
Genevieve E. Charlton  
Thomas J. Donovan  
**Barnes & Thornburg LLP**  
Attorneys for Applicant  
One North Wacker Drive, Suite 4400  
Chicago, Illinois 60606  
312.357.1313  
[tdonovan@btlaw.com](mailto:tdonovan@btlaw.com); [mstover@btlaw.com](mailto:mstover@btlaw.com);  
[gcharlton@btlaw.com](mailto:gcharlton@btlaw.com)