

IN THE UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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| Applicant: | Anderson, Ronald W. | } | Trademark Law |
| Mark: | TRADE | } | Office: 120 |
| Serial No.: | 88/131,257 | } | Examining Attorney: |
| Filed: | 09/25/2018 | } | Jessica Hilliard |

RESPONSE

The Applicant thanks the Office for the consideration given the present application in the initial Office Action in this matter. The Applicant has endeavored to respond most properly to each of the issues raised by the Office. With this in mind, the Applicant respectfully requests that the Office reconsider and allow the present application.

Prior Filed Application

The Applicant acknowledges the Office's indication that the present application may be suspended pending final disposition of U.S. Application Serial No. 88/120,536 directed to the mark TRADES FOR GOOD. It is further understood that arguments regarding that pending application are not required at this time and that Applicant may address this issue without prejudice should a refusal under Section 2(d) later issue.

Refusal Based on Section 2(d) – Likelihood of Confusion

In the Action, the Office preliminarily refused registration under Section 2(d) of the

Trademark Act based on U.S. Registration No. 5,482,312 for the mark consisting of “capital block letters spelling out ‘TRADE’ in a stylized font framed by a larger contrasting irregular rectangle. The letters ‘T’ and ‘R’ are connected at the top. The letters ‘R’, ‘A’, and ‘D’ are connected at the bottom. The letter ‘E’ stands apart from the other letters.”

The goods and services of the cited registration are in Classes 009, 020, 025, and 041. More particularly, the stylized rendering of TRADE is registered by the ‘312 registration in relation to “sunglasses” in Class 009, “hand fans; hand-held folding fans” in Class 020, “tank-tops; athletic shorts; bathing suits for men; hats; short-sleeved or long-sleeved t-shirts; athletic shorts; baseball caps and hats; gym shorts; short-sleeved or long-sleeved T-shirts; sports shirts; T-shirts; underwear, namely, boy shorts” in Class 020, and “arranging and conducting nightclub entertainment events” in Class 041.

The Office found that Applicant's mark TRADE, when applied to Applicant’s listed goods in Classes 003, 008, and 021, so resembled the stylized mark of Registration No. 5,482,312 as that mark is applied to the listed goods and services in Classes 009, 020, 025, and 041 listed therein as to be likely to cause confusion, to cause mistake, or to deceive. In comparing the marks, the Office found that Applicant’s plain text mark could be adapted to have stylization and design elements similar to those in the registered mark, which would create a likelihood of confusion.

The classes of Applicant’s goods do not overlap with the classes of the goods and services of the cited registration and although Applicant’s listed goods are fully distinct from those of the cited registration. However, in comparing the goods and services, the Office referenced third party uses in support of the conclusion that both sets of goods could emanate from a single source under a single mark.

As set forth in Exhibit A, there are at least 20 trademark records (including that of the registrant and that of the Applicant) wherein the term TRADE comprises the entire mark. The cited registration issued on May 29, 2018 over plural previously registered marks formed by the term TRADE, including the following:

- U.S. Registration No. 5,366,107 for the mark TRADE in Class 035 for “retail store services featuring a wide variety of consumer goods of others” (which goods and services would necessarily overlap with those of the cited registration);
- U.S. Registration No. 5,117,712 for the mark TRADE in Class 043;
- U.S. Registration No. 4,175,110 for the stylized mark TRADE in Classes 037 and 040; and
- U.S. Registration No. 2,148,603 for the mark TRADE in Class 020 (notably one of the listed classes of Registration No. 5,482,312 now cited against the Applicant).

It is also apparent that thousands of registered and pending marks include the term TRADE as a portion thereof.

In view of the foregoing, it will be recognized that the Patent and Trademark Office has allowed plural, simultaneous registrations wherein the term TRADE forms the entire trademark—including registrations of the same term in the same International Class. Indeed, the registration now cited against the Applicant was permitted to proceed to registration while another mark directed to the term TRADE in plain text was already registered in the same International Class 020. The determination has thus been made that the term TRADE can be concomitantly used and registered by

plural different parties—even in the same International Class—without a likelihood of confusion therebetween. Meanwhile, neither the cited registration nor any of the other currently subsisting registrations for the term TRADE have any overlap of International Class or goods or services in relation to Applicant’s goods in International Classes 003, 008, and 021.

The consuming public is thus exposed to numerous uses of the term TRADE as a portion of a mark (or even as the entire mark) not only by the cited registrant but also by multiple third parties other than the registrant, including parties well senior in use to the registrant and selling goods in at least one of the classes in which the cited registration is disposed. It is also clear that Applicant’s currently listed goods and services are distinct from those of the cited registration.

While the precedent cited by the Office is recognized and appreciated with respect to comparing the textual portion of the cited mark with Applicant’s applied-for mark, it is not appropriate to presume that “the word portion [of Applicant’s mark] could be presented in the same manner of display” as the special form of the stylized mark.

It is respectfully submitted that the Federal Circuit Court of Appeals in In re Viterra Inc., 671 F.3d 1358 (Fed. Cir. 2012) expressly found that it was *not* a reasonable variation of the standard character mark to take on the special form of the registrant’s mark in its entirety (“The Board was careful to state that, ‘we do not mean to suggest that the specific special form of registrant’s mark in its entirety constitutes a ‘reasonable’ variation of applicant’s standard character mark.’” In re Viterra Inc. at 1365. In other words, finding confusingly similarity by presuming that it would be a reasonable variation of Applicant’s mark to adopt the specific form of a registered mark is *not* permissible in a likelihood of confusion analysis during examination.

Squirtco v. Tomy Corp., 697 F.2d 1038 (Fed. Cir. 1983), also cited in the Action, is

inapposite. In Squirtco, the Court of Appeals reversed the District Court’s dismissal of SquirtCo’s opposition, finding that “By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.” Id.

Here, Applicant is not asserting a difference based on its own stylization but instead asserts that (in accord with In re Viterra) a likelihood of confusion determination should not rely on a finding that it would be a reasonable variation of Applicant’s mark to adopt the special form of the registrant’s mark in its entirety.

It is respectfully submitted that comparing comparison of the textual portions of the cited mark and the applied-for mark may well be appropriate, but it is further submitted that finding similarity based on the concept that Applicant might wrongly adopt the special form of the cited registration is not proper. While decisions such as Squirtco and In re Viterra permit comparison of textual portions of stylized and plain text marks, they do not permit a likelihood of confusion analysis to be bolstered by a presumption that an applicant could in theory wrongfully copy particular aspects of a registered mark.

Applicant’s applied-for mark for TRADE is no more similar to the mark of the cited registration than the mark of the cited registration is similar to the marks consisting of the term TRADE that were already registered when the application of the cited registration was allowed. Indeed, Applicant’s mark as applied to Applicant’s listed goods is *less similar* since, although the cited registration overlaps in class with at least one other live registration, Applicant’s mark has no overlap in class and no overlap in goods or services in relation to the cited registration.

Furthermore, as TMEP 1207.01(d)(iii) provides, “[i]f 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.’ *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).” It has been held that third-party registrations may be relevant to show that the mark or a portion of a mark may be 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) (citing *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983)). Of particular relevance to the case at hand, the TMEP further instructs that, “[i]f the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.” 1207.01(d)(x).

Here, plural active registrations exist that employ the term TRADE as the full mark, and thousands of registrations exist that incorporate the term TRADE as a portion of the mark. Accordingly, the protection to be afforded to the cited registration’s stylized rendering including the term TRADE should be quite narrow. Because the consuming public is exposed to many marks that include the term TRADE (the portion common to the cited registration and Applicant’s mark), consumers would be likely to differentiate between the marks, particularly where they are applied to different goods in different classes.

Even though one may compare the word portions of the marks at issue, it remains notable that the mark of the cited registration is limited to a highly-stylized logo that merely includes the term TRADE as a portion thereof. The consuming public would be exposed to the mark of the cited registration in that stylize format, even if the word portion is given emphasis. The stylization of the mark of the cited registration—including “capital block letters spelling out ‘TRADE’ in a stylized

font” that is “framed by a larger contrasting irregular rectangle” where the “letters ‘T’ and ‘R’ are connected at the top,” the “letters ‘R’, ‘A’, and ‘D’ are connected at the bottom,” and “[t]he letter ‘E’ stands apart from the other letters”—further narrows the protection to which it should properly be afforded and further operates to distinguish Applicant’s mark visually and conceptually.

The Applicant respectfully submits that the factors set out by the Court of Customs and Patent Appeals in *In re E.I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) as approximating the totality of the circumstances necessary to making a likelihood of confusion determination do not support barring registration under Section 2(d) of the Trademark Act. While multiple registrants use the same term, TRADE, Applicant’s goods are distinct and are disposed in entirely different classes from the goods and services recited in Registration No. 5,482,312 (while the goods in that registration actually overlap in class with the goods of one or more previous registrations for the term TRADE).

Further mandating against a finding of a likelihood of confusion is the fact that there is no evidence that the cited mark enjoys any great fame. It is thus still more apparent that the scope of protection that the mark of the cited registration should be afforded is exceedingly narrow, and the likelihood of confusion between the marks is still lower.

A plurality of factors to be included in a proper likelihood of confusion determination thus weigh against a finding of a likelihood of confusion between Applicant’s mark and that of the cited registration. In view of the totality of the circumstances, it is respectfully submitted that Applicant’s mark does not so resemble the stylized mark of the cited registration as to be likely, when applied to the goods of the Applicant, to cause confusion, to cause mistake, or to deceive. Accordingly, it is submitted that registration is not prevented by Section 2(d). The Office’s reconsideration and

allowance of the application are requested.

Conclusion

The Applicant respectfully submits that all outstanding issues raised in the Office Action have been addressed. If, after consideration of the above, there remain any open issues in this application that possibly can be resolved by a telephone interview, then Applicant's undersigned attorney most respectfully requests that he be called to discuss and attempt to resolve those issues.

Respectfully submitted,

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