

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: O&M Halyard, Inc.
Serial No: 88306593
Filed: February 19, 2019
Mark: ORANGE

RESPONSE TO OFFICE ACTION

On May 1, 2019, the Examining Attorney refused to register the above Applied-for mark because of a likelihood of confusion with ORANGE NITRILE (U.S. Reg. No. 4,020,863) used with “dental gloves; gloves for medical purposes; gloves for medical use; gloves for use in hospitals; medical examination gloves; medical gloves; nitrile gloves for medical use; protective gloves for medical use” and OUTRAGEOUS ORANGE (U.S. Reg. No. 4,377,108) used with “gloves for medical use; gloves for use in hospitals; latex medical gloves; surgical gloves.” Additionally, the Examining Attorney refused registration, concluding the Applied-for mark is merely descriptive.

I. No Likelihood of Confusion

The Lanham Act §2(d) prevents registration of a mark on the principal and supplemental register that is likely to be confused or mistaken or deceived, by potential consumers, as to the source of the goods of the applicant and the registrant. 15 U.S.C. §1052(d). Applicant argues that the Applied-for Mark, ORANGE, will not likely confuse consumers as to the origin of the goods in the application (surgical masks).

There is no likelihood a potential consumer will be confused, mistaken, or deceived between the Applicant’s mark and the cited marks as to the source of the goods offered in commerce. Federal courts and the Board have consistently held that likelihood of confusion exists between two marks only if a reasonably prudent purchaser is likely to be confused as to source or sponsorship of the services. *See In re E.I. du Pont de Nemours & Co*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Thirteen principal factors are to be considered in a likelihood of confusion analysis; 1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impressions, 2) the similarity or dissimilarity of and the nature of goods described in an

application or registration in connection with which a prior mark is in use, 3) the similarity or dissimilarity of established, likely-to-continue trade channels, 4) the conditions under which potential consumers purchase-impulse versus careful sophisticated purchasing, 5) the fame of the prior mark, 6) the number and nature of similar marks in use on similar goods, 7) the nature and extent of actual confusion, 8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, 9) the variety of goods on which a mark is or is not used, 10) the market interface between the applicant and the owner of the prior mark, 11) the extent to which applicant has a right to exclude others from use of its mark on its goods, 12) the extent of possible confusion-de minimus or substantial, and 13) any other established fact probative to the effect of use. Id.

Analysis of the applicable factors illustrates that there is no likelihood of confusion between Applicant's Applied-for Mark and the cited marks. The Examining Attorney rejected Applicant's mark based on the similarity of the marks and the relatedness of the services. In addition to the DuPont factors examined by the Examining Attorney, the sophistication of the consumer, fame of the cited marks, and the number and nature of similar marks in use on similar goods are also applicable in this case. The Applicant will demonstrate how the consumer will differentiate the current mark from each of the cited marks.

A. ORANGE NITRILE (Reg. No. 4,020,863)

i. Dissimilarity of the Marks

The marks are different in appearance, sound, and connotation because the applicant's word mark is ORANGE, not ORANGE NITRILE.

In considering sight, sound, and meaning, it is axiomatic that conflicting marks must be compared in their entireties. *See Opryland USA, Inc., v. The Great American Music Show, Inc.*, 23 U.S.P.Q. 2d 1471, 1473-74 (Fed. Cir. 1992). A mark should not be dissected into its component parts and each part then compared with corresponding parts of a conflicting mark to determine confusion – it is the impression the mark as a whole creates that is important. Id. As explained by the Court of Appeals for the Federal Circuit:

[M]arks must be considered in the way they are perceived by the relevant public. Although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. Thus it is not dispositive whether...descriptive words are included as parts of the marks; that is simply a factor to be considered when viewing the mark as a whole.

Id.

Additionally, in determining whether a mark will give rise to a likelihood of confusion, an examining entity should note that the fundamental issue is not whether a court, an examining attorney, or a lawyer finds confusion between two marks, but whether the relevant buyers would be confused. Daddys Junky Music v. Big Daddy Family Music, 109 F.3d 275, 42 U.S.P.Q. 1173 (6th Cir. 1997). As observed by the Eighth Circuit in Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc., 815 F. 2d 500, 504 (8th Cir. 1987):

[V]isual inspections by the court are permissible as an aid in determining likely confusion. However, caution should be exercised to avoid putting too much stock in subjective inspection done in-chambers that is devoid of market characteristics. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do.

Marks must be considered on a case-by-case basis. A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in market conditions would do.

Applicant believes that the Examining Attorney overemphasizes the compound portion ORANGE NITRILE. Even if consumers view ORANGE as the dominant portion of the Applied-for Mark, this does not necessarily lead to the inference that the marks are similar. When comparing marks, the common presence of a dominant term does not compel a conclusion that the marks are similar. See General Mills Inc. v. Kellogg Co., 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987) (no likelihood of confusion between APPLE RAISIN CRISP and OATMEAL RAISIN CRISP even though both marks identify ready-to-eat breakfast cereals that directly compete), citing Freedom Sav. & Loan Ass'n v. Way, 226 U.S.P.Q. 123, 127-28 (11th Cir.), cert. denied, 106 S. Ct. 134 (1985). See also

RICHARD L. KIRKPATRICK, LIKELIHOOD OF CONFUSION IN TRADEMARK LAW § 4.10, at 4-54 (“[T]he mere fact that the marks in issue share elements, *even dominant elements*, does not compel a conclusion of likely confusion.”) (emphasis added); Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc., 952 F. Supp. 1084, 1096-97 (D.N.J. 1997) (no likelihood of confusion between HARLEM WIZARDS to identify “show” basketball and WASHINGTON WIZARDS to identify NBA basketball team).

The additional term NITRILE in the cited mark changes the meaning, connotation, and commercial impression. Alone, ORANGE is a color. The additional element NITRILE is descriptive of goods that are nitrile rubber. This additional element changes the commercial impression of the cited mark vs the Applied-For Mark because a consumer would necessarily believe the goods associated with ORANGE NITRILE are orange nitrile rubber products. The same cannot be true for a consumer viewing the mark ORANGE, as without an additional element, the mark can only necessarily be suggestive of the color orange.

ORANGE is different than ORANGE NITRILE in appearance, sound, and connotation. This DuPont factor weighs towards finding no likelihood of confusion.

ii. Differences in the Goods or Services

The second DuPont factor cited by the Examining Attorney concerns the similarity or dissimilarity and nature of the goods or services. Applicant concedes that the goods are related in that they may be used in a medical setting. Applicant points out, however, that Applicant’s goods, masks, differ enough from goods used with the cited mark, gloves, that no confusion would exist. Surgical masks are typically worn on the face. Gloves are typically worn on the hands. Nevertheless, the following bullet-point list contains trademarks similar to this case where no likelihood of confusion existed even between the same or highly related goods:

- “LEAN CUISINE” and “LEAN LIVING” Stouffer Corp. v. Health Valley Natural Foods, 1 USPQ2d 1900 (TTAB 1987);
- “PECAN SHORTIES” and “PECAN SANDIES” Keebler Co. v. Murray Bakery Prods., 866 F.2d 1386 (Fed. Cir. 1989);

- “TEKTRONICS” and “DAKTRONICS INC.” Tektronicx, Inc. v. Daktronics, Inc., 534 F.2d 915 (CCPA 1976);
- “BED & BREAKFAST REGISTRY” and “BREAKFAST INTERNATIONAL” In re Bed & Breakfast Registry, 791 F.2d 157 (Fed. Cir. 1986);
- “SANDWICH CHEF” and “BURGER CHEF” Burger Chef Sys., Inc. v. Sandwich Chef, Inc., 608 F.2d 875 (CCPA 1979);
- “DUTCH APPLE” and “DUTCH MASTERS” Consolidate Cigar Corp. v. M. Landaw, Ltd., 474 F.2d 1402 (CCPA 1973);
- “K+” and “K+EFF” In re Electrolyte Labs, Inc., 929 F.2d 646 (Fed. Cir. 1990);
- “RED ZINGER” and “ZINGERS” Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926 (CCPA 1978);
- “RITE WAY” and “RITE AID” Rite Aid Corp. v. Rite-Way Discount Corp., 508 F.2d 828 (CCPA 1978);
- “SILK” and “SILK ‘N SATIN” Pacquin-Lester Co. v. Charmaceuticals, Inc., 484 F.2d 1384 (CCPA 1973);
- “STUDIO ONE” and “STUDIO GIRL” Studio Girl-Hollywood, Inc. v. H/P Consultants, Ltd., 453 F.2d 768 (CCPA 1972);
- “PARTY PARADE” and “PARTY PRIDE” Safeway Stores, Inc. v. Dunkirk Ice Cream Co., 455 F.2d 576 (CCPA 1972);
- “ROB SCOT” and “ROB ROY” Rob Roy Co. v. Thurman Mfg. Co., 455 F.2d 605 (CCPA 1972);
- “CHERRY JUBILEE” and “CHERRY JULEP” Jack Poust & Co. v. John Gross & Co., 460 F.2d 1076 (CCPA 1972);
- “DURAGOLD” and “EVERGOLD” Claremont Polychemical Corp. v. Atlantic Powdered Metals, Inc., 470 F.2d 636 (CCPA 1972);
- “ROMANBURGER” and “ROMAN MEAL” Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co., 781 F.2d 884 (Fed. Cir. 1986);
- “GREEN JADE” and “JADE EAST” Swank, Inc. v. Ravel Perfume Corp., 438 F.2d 622 (CCPA 1971);

- “MIGHTY MIKE” and “MIGHTY MO” Marrion-Hot Shoppes, Inc. v. McKee Baking Co., 442 F.2d 978 (CCPA 1971); and
- “CANADIAN BELLE” and “CUMBERLAND BELLE” Continental Distilling Corp. v. Norman Williams Co., 443 F.2d 392 (CCPA 1971).

Despite the highly related—if not identical—goods, authorities deemed the above listed marks could co-exist with no likelihood of confusion. ORANGE and ORANGE NITRILE are more dissimilar in appearance, sound, and connotation than the majority of the above marks.

iii. Consumer Sophistication

The consumers whom use Applicant’s and Registrant’s services are likely to be very sophisticated. “When goods are sold to consumers that exercise care there is less chance that confusion will occur.” PC Club v. Primex Technologies, Inc., 32 Fed. Appx. 576, 579 (Fed. Cir. 2002).

“[C]ircumstances suggesting care in purchasing may tend to minimize likelihood of confusion.” T.M.E.P. § 1207.01(d)(viii). *See also* In re Amsted Industries Inc., 972 F.2d 1326, 24 U.S.P.Q.2d 1067 (Fed. Cir. 1992) (considering particularly the sophistication of wire rope purchasers in overturning the TTAB refusal to register). The sophistication of purchasers “is important and often dispositive” Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992). *See, e.g.* Arrow Fastener Co. v. Stanley Works, 59 F.3d 384, 35 U.S.P.Q.2s 1449 (2nd Cir.1995); Astra Pharmaceutical, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983). There are also many instances where the TTAB has reversed an Examining Attorney’s finding of a likelihood of confusion between an applicant’s mark and the cited mark based, in part, on the sophistication of the consumer. In re Deceuninck N. Am. LLC, Serial No. 77465459 (TTAB May 27, 2009) unpublished; In re Boler Co., Serial No. 77059048 (TTAB. Feb. 17, 2009) unpublished; In re Trend Elecs. Int’l, Inc., Serial No. 77003068 (TTAB May 9, 2008) unpublished; In re Bridger Mgmt., LLC, Serial No. 78816349 (TTAB Dec. 28, 2007) unpublished; In re Invivo Corp., Serial No. 78670679 (TTAB Sept. 5, 2007) unpublished; In re Crosswalk, Inc., Serial No. 78424189 (TTAB Aug. 2, 2007) unpublished; In re Frank’s Int’l, Inc., Serial No. 76599870 (TTAB Mar. 22, 2007)

unpublished; In re Cyberchannel Inc., Serial Nos. 76567272 and 76567273 (TTAB Mar. 15 2007) unpublished.

The sophistication of potential purchasers can be “often dispositive because ‘[s]ophisticated purchasers may be expected to exercise greater care.’” Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), quoting Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 212 USPQ 246, 252 (1st Cir. 1981). Potential customers for surgical masks and medical gloves will not act on impulse but rather exercise a significant degree of care in purchasing specific goods. While Applicant concedes that even sophisticated consumers are not immune from source confusion, this factor weighs towards a lack of confusion between ORANGE and ORANGE NITRILE.

iv. Lack of Fame of ORANGE NITRILE Mark

The fame or strength of a mark is an important consideration in the likelihood of confusion analysis. In assessing the fame or strength of a mark, it is useful to evaluate two primary criteria: (1) the intrinsic strength or distinctiveness of a mark, and (2) the extent to which the mark has acquired strength through use and promotion in the marketplace. Here, the cited mark is not famous.

As noted earlier, ORANGE is suggestive of a color, and NITRILE is descriptive of nitrile rubber. Because of this, the ORANGE NITRILE Mark is inherently weak and non-distinctive. In fact, ORANGE NITRILE exists on the Supplemental Register.

The cited mark is very weak and therefore entitled to a very narrow range of protection. Therefore, this relevant DuPont factor strongly weighs towards a lack of confusion between the ORANGE and ORANGE NITRILE.

v. The Number and Nature of Similar Marks in Use on Similar Goods

Applicant would like to bring to the Examining Attorney’s attention that a Google search for “Orange surgical mask” shows mainly hits for the Applicant’s goods and press related to those services as the first-listed results. (see Exhibit A). This DuPont factor weighs in favor or is neutral towards a lack of confusion between the ORANGE and ORANGE NITRILE.

The analysis of the relevant DuPont factors reveals there is no likelihood of confusion between Applicant's ORANGE Mark and Registrant's ORANGE NITRILE Mark.

B. OUTRAGEOUS ORANGE (Reg. No. 4,377,108)

The DuPont factors and law for applying the DuPont factors for the remaining cited marks is identical to the analysis of the likelihood of confusion between ORANGE and OUTRAGEOUS ORANGE. For the sake of brevity, Applicant will not repeat the law from above but only apply that law to each separate cited mark.

i. Dissimilarity of the Marks

The marks are different in appearance, sound, and connotation because the registrant's word mark is OUTRAGEOUS ORANGE, not ORANGE. Applicant believes that the Examining Attorney overemphasizes the compound portion of the cited mark. Even if consumers view ORANGE as the dominant portion of the Applied-for Mark, this does not necessarily lead to the inference that the marks are similar.

The additional term OUTRAGEOUS in the cited mark changes the meaning, connotation, and commercial impression. Alone, ORANGE is a color. The additional element OUTRAGEOUS is arbitrary in relation to gloves. Accordingly, ORANGE is different than OUTRAGEOUS ORANGE in appearance, sound, and connotation. This DuPont factor weighs towards finding no likelihood of confusion.

ii. Differences in the Goods or Services

Applicant concedes that the goods are related in that they may be used in a medical setting. Applicant points out, however, that Applicant's goods, masks, differ enough from goods used with the cited mark, gloves, that no confusion would exist. Surgical masks are typically worn on the face. Gloves are typically worn on the hands. As shown in the list above at I.A.ii authorities deemed the listed marks could co-exist with no likelihood of confusion. Accordingly, ORANGE and OUTRAGEOUS ORANGE are more dissimilar in appearance, sound, and connotation than the majority of the above marks. This DuPont factor weighs against a finding of likelihood of confusion.

iii. Consumer Sophistication

The consumers whom use Applicant's and Registrant's services are likely to be very sophisticated. Potential customers for surgical masks and medical gloves will not act

on impulse but rather exercise a significant degree of care in purchasing specific good. While Applicant concedes that even sophisticated consumers are not immune from source confusion, this factor weighs towards a lack of confusion between ORANGE and OUTRAGEOUS ORANGE.

iv. Lack of Fame of OUTRAGEOUS ORANGE Mark

OUTRAGEOUS ORANGE was registered in 2013. At this time, Registrant has not filed the necessary declaration to show continued use, so Applicant is unable to ascertain whether OUTRAGEOUS ORANGE has acquired distinctiveness through extensive sales or advertising. This DuPont factor appears to weigh towards finding no likelihood of confusion.

v. The Number and Nature of Similar Marks in Use on Similar Goods

Applicant would like to bring to the Examining Attorney's attention that a Google search for "Orange surgical mask" shows mainly hits for the Applicant's goods and press related to those services in the first three pages. This DuPont factor weighs in favor or is neutral towards a lack of confusion between the ORANGE and OUTRAGEOUS ORANGE.

II. Applicant's mark is suggestive and should be registered on the Principal Register

The Examining Attorney refused registration because the Applied-for Mark "merely describes a feature of applicant's goods." The Examining Attorney noted further that a representative sample of search results showed that because some surgical masks were orange, that the Applied-for Mark would be necessarily incapable of maturing to registration. Lastly, the Examining Attorney asserts the Applied-for Mark is generic.

As a threshold issue, the Applied-for Mark is not generic and is capable of source identification. The Applied-for Mark, ORANGE, refers primarily to a color, and the mark is to be used with "surgical masks." That the Examining Attorney conducted an image search and found surgical masks that were orange in color does not mean that the mark is incapable of acting as a source-identifier. As pointed out earlier, many of the first-listed results in the Examining Attorney's search belong to Applicant. Therefore the same

evidence the Examining Attorney uses to conclude the mark is generic actually points toward the conclusion that the Applied-for Mark is fully capable of source identification.

Next, the Examining Attorney asserts the mark is merely descriptive, because “surgical masks are often the color orange.” The USPTO has granted numerous registrations for trademarks where the wordmark consists of a color that describes items that might appear in that color:

- RED (U.S. Reg. No. 4,311,408) used with “clothing for athletic use, namely, padded shorts for snowboarding” in Class 25;
- BLUE (Stylized) (U.S. reg. No. 5,777,389) used with “Crew necks; Footwear; Hats; Leggings; Pants; Shorts; Socks; Sweatshirts; T-shirts” in Class 25;
- CLASSIC YELLOW (U.S. Reg. No. 3,189,006) used with “sports and fitness clothing, namely, t-shirts” in Class 25;
- GREEN (U.S. Reg. No. 1,151,799) used with “footwear” in Class 25;
- BROWN (U.S. Reg. No. 3,668,335) used with “Headgear, namely, baseball hats and caps, and visors; Shirts; all used in connection with promoting or providing transportation and delivery services” in Class 25;
- GOLD (U.S. Reg. No. 3,746,753) used with “gloves as clothing, hoods, jackets, t-shirts” in Class 25; and
- TIFFANY BLUE (U.S. Reg. No. 4,804,204) used with “Jewelry; jewelry featuring the color blue as an integral component of the jewelry” in Class 14.

The above list is a small sample of wordmarks consisting of a word that is a color, applied to a broad class of goods. That these marks were granted registration runs counter to the Examining Attorney’s conclusion that because goods often appear in the color that matches an applied-for mark, that such a mark is merely descriptive. In fact, following the Examining Attorney’s logic to conclusion would dictate that the above marks, and any other mark named after a color are unregistrable because some goods might appear in that color.

CONCLUSION

Applicant believes it has responded to the Examining Attorney rejection based on a likelihood of confusion. It is clear from a closer analysis of the DuPont factors, incorporating the evidence provided, that there is no likelihood consumers will be confused between Applicant's mark and the cited marks. "In every case turning on the likelihood of confusion, it is the duty of the examiner ... to find, upon consideration of all the evidence, whether or not confusion appears likely." In re E.I. DuPont, 476 F.2d at 1362 (emphasis in original). Here, the strongest consideration should be given to the differences in the marks, the differences in the goods, the sophistication of the purchaser, and the lack of fame of the prior mark.

Applicant has also addressed the Examining Attorney's rejections based on the Applied-for Mark being merely descriptive or generic.

In view of the foregoing, the Applicant respectfully requests that the Examining Attorney retract the refusal to register Applicant's Mark and approve Application No. 88306593 for publication.

