

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Mark:

US Serial Number: 88258852

Filing Date: January 11, 2019

Register: Principal

REMARKS IN RESPONSE TO OFFICE ACTION

This paper is submitted in response to the office action issued on March 26, 2019 (hereinafter, the “Office Action”) in the above listed application serial number.

**Required Amendment of Identification of Goods**

The Office Action states that the current identification of goods—“Clothing”—is unacceptable because it contains indefinite wording under 37 C.F.R. §2.32(a)(6) and TMEP §1402.01, and must be clarified. Applicant hereby adopts the following amended identification of goods:

International Class 025: “Exercise apparel, namely, T-shirts, long sleeve shirts, tank tops, sweatshirts, hats, sweatbands, shorts, pants, sweat pants, and stretch pants.”

**Required Mark Description Amendment**

The Office Action states that the current mark description is incomplete and does not describe all the significant aspects of the mark under 37 C.F.R. §2.37 and TMEP §§808 *et seq.* The Office Action then suggests the description “The mark consists of the stylized wording ‘FAITH’, with the letter ‘I’ represented as a cross.

The Applicant asserts that the current mark description already includes the elements of the suggested amendment, in that the current mark description includes the following:

“Color is not claimed as a feature of the mark. The mark consists of the word *faith in bold, block letter, faux-typeset font*, with a *Christian cross in the place of the ‘T’*, where the cross is about twice as tall as the lettering” (emphasis added). If this description is found to be insufficient, Applicant accepts the amended description suggested in the Office Action.

## **Specimen Refusal under Section 2(d)**

### *There Is No Likelihood Of Confusion Between The Applied-For Mark And The Registered Marks*

The applicant has applied for registration of the single-word mark FAITH (+ design), the mark having the description: “the word faith in bold, block letter, faux-typeset font, with a Christian cross in the place of the ‘T’, where the cross is about twice as tall as the lettering.” The description of the goods and services has been amended to the following: “Exercise apparel, namely, T-shirts, long sleeve shirts, tank tops, sweatshirts, hats, sweatbands, shorts, pants, sweat pants, and stretch pants.”

The Examining Attorney has refused registration based on Registration No. 4336642 for the mark FAITH for use with “Footwear, boots, shoes and sandals.”

The Examining Attorney refers to *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), where the court listed several factors, that when relevant, and must be considered in the likelihood of confusion analysis. The Examining Attorney considers that the similarities of the marks, the similarity and nature of the goods, and the similarity of the established, likely-to-continue trade channels of the goods to be the most relevant. The applicant also points to the classes and sophistication of buyers and the fame of the prior mark as relevant factors.

#### A. The Marks are Not Confusingly Similar

This factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *In re E.I. du Pont de Nemours & Co.*, 746 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

The Court of Appeals for the Federal Circuit has provided the following guidance for evaluating the marks:

“The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”

*In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (footnotes omitted) (citations omitted). TMEP § 1207.01(b). As set forth in TMEP § 1207.01(b)(i),

“Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related”. According to the above precedents, the marks must be considered in their entirety (not dissected), and similarity as to any single element is not dispositive. As set forth below, a comparison of these elements of the marks shows that they are distinctively different.

Here, the Office has not followed these rules. Instead the Examining Attorney has essentially ignored the significant differences in appearance, connotation, and commercial impression. The U.S. Supreme Court observed: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety ...”). The Federal Circuit has made similar statements: “It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.” *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007), cert. denied, 128 S. Ct. 661 (2007) (reversing the Board's finding of no likely confusion between CHI and design and CHI PLUS for competing electric massagers because the Trademark Board downplayed the importance of the Chinese word “chi”). Thus, it is improper to simply ignore an important part of the applied-for mark (the stylized font of the design, and the Christian cross replacing the letter T) in considering the sight, connotation, and commercial impression of the marks.

1. Appearance (Sight).

The Examining Attorney asserts that the wording of the marks is identical in appearance and meaning and have the potential to be used in exactly the same manner. Respectfully, these assertions are inaccurate. The appearance of the applied-for mark (FAITH + design) is distinctly different from that of the registered mark (FAITH) because the design aspects of the applied for mark gives it an entirely different visual appearance that is easily distinguished from that of the registered mark. The applied-for mark is a design mark having bolded, weathered type-face block letters in upper-case, and the T has been replaced with a Christian cross which is the clear focal point of the mark, being twice the height of the other letters in the mark and not having the same distinctive type-face font. In contrast, as seen in the images below, the registered mark is presented as a curving, crowded, lower-case script in which the letter “t” is in no way emphasized, but rather is difficult to tell apart from the letters around it. The bold, weathered type-face font and salient Christian cross of the applied-for mark creates a very different visual than that of the slim, lower case, flowing script and indistinct letter “t” of the registered mark. The marks are certainly are not identical in appearance, and at first glance do not even look like the same word.



The Examining Attorney asserts that the registered mark can be displayed in any color, font, size, and stylization, including that of the applied-for mark. However, in reality the registered mark represents a well-known, fashionable women's shoe brand named after its founder Samuel Faith, and is currently owned by a well-established and consistently marketed British department store. (See Exhibit A, attached).



The "faith" brand has for decades presented its mark to consumers in the same manner, and the good will built up in the particular look of the mark is highly valuable to the Registrant. Thus, the registered mark is, and likely will continue to be, presented to the consumer in a very different fashion than that of the applied-for mark, particularly in regard to the lack of a Christian cross replacing the letter "t".

## 2. Meaning / Connotation.

The word faith has several meanings, including "confidence or trust in a person or thing", "belief that is not based on proof", and "belief in God or in the doctrines or teachings of religion", among other similar definitions. See [www.dictionary.com](http://www.dictionary.com). However, Faith is also a common first

name for women, and a somewhat less common family name. The meaning which a consumer would assign to the applied-for mark is clearly one which has to do with Christian faith, based on the Christian cross included in the mark.

On the other hand, the registered mark is presented without a cross, without a capital “F” (which may connote faith in God), and without any other apparent aspect which may be interpreted by a consumer as being related to Christian faith. Rather, the “faith” shoe brand is well known to be founded by a man named Samuel Faith, and later taken over by Samuel’s son, Johnathan Faith. Also, because the brand used with shoes targeted toward fashionable women, a consumer unaware of the founder of the brand may reasonably expect the mark to connote a woman’s first name. Based on the brand history and the way in which the mark is presented to consumers, the average consumer is far more likely to assume that the registered mark connotes a person’s name than to assume the mark connotes some relation to the Christian faith.

### 3. Commercial Impression.

Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. See, e.g., *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies’ sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant’s bras, whereas “CROSSOVER,” as applied to registrant’s goods, was “likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which “crosses over” the line between informal and more formal wear . . . or the line between two seasons”); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men’s underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant’s argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature” when applied to men’s underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies’ and children’s underwear and BOTTOMS UP for men’s clothing not likely to cause confusion, noting that the wording connotes the drinking phrase “Drink Up” when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear). TMEP § 1207.01(b)(v).

Here, as noted above, the applied for mark is a design mark which includes bold, uppercase, weathered typeface font for every letter except the “T”, which is replaced with a Christian cross twice as tall as the other letters. Thus, the cross—denoting Christian faith—is presented as the most salient and important aspect of the mark, while the remaining letters, whose styling brings to mind strength—especially in connection with exercise apparel—and extensive, weathered use, come together to form the impression of a faith which has been tested yet remains strong. In contrast, the light, lowercase, flowing font of the registered mark—in association with fashionable but affordable women’s shoes—gives the impression of femininity, and “High Street fashion” (see Exhibit A).

Overall, the applied-for mark and the registered mark are not similar in appearance or meaning, and give very different commercial impressions, particularly when considered in association with the goods sold under each. Therefore, the marks should not be considered confusingly similar to the average consumer.

#### B. Neither the Goods Nor the Trade Channels are Related

In the present case, the Applicant's goods have been amended to "Exercise apparel, namely, T-shirts, long sleeve shirts, tank tops, sweatshirts, hats, sweatbands, shorts, pants, sweat pants, and stretch pants", while Registrant's goods include "Footwear, boots, shoes and sandals." There is no question that the goods are different from each other, and that they are not competitive (i.e., they are not substitutes for each other). This is particularly apparent in that Applicant's goods specifically do not recite any type of footwear, exercise related or otherwise. Since the goods are not competitive, the question becomes whether they are related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they come from a common source. TMEP § 1207.01(a)(i).

The Office Action asserts that the goods sold under the respective marks are similar due in part to a lack of limitations regarding trade and thus it is assumed that the goods are sold everywhere that is normal for such items. However, as evidenced by Exhibit A, the goods sold under the registered mark are fashionable women's shoes which are sold primarily at Debenhams department store concessions, meaning that the goods are primarily sold divided areas which sell *only* "faith" brand shoes, and do so under a large sign comprising the "faith" mark in its flowing lower-case script, as shown in the images provided above. The Registrant's goods are also sold as overstocked items by third party websites, but those websites also arrange their goods by categories, including women's shoes.

In contrast, Applicant does not sell women's shoes, and even if "faith" brand shoes were not sold in exclusive settings (both in Debenham's concessions and online), Applicant's goods are not generally found in the same area of a department store or a department store website as fashionable women's shoes. Because of the disparate nature of the goods and the distinct trade channels in which they are sold, there is no danger that the Registrant will suffer adverse commercial impact from the Applicant as a newcomer using an allegedly similar mark. Overall, the Applicant's and Registrant's goods should not be considered related for likelihood of confusion purposes.

#### C. Classes of Buyers

As noted above, the applied-for mark includes a Christian cross in place of the letter T which is twice the height of the other letters in the mark. It is reasonable to expect the average consumer to understand that the large cross in the registered mark indicates Christian faith, and to understand that wearing apparel which includes a Christian cross in the designs on that apparel

will signal to other people that the wearer is a member of the Christian faith. A person's faith, or lack thereof, is often a very important aspect of that person's life. Thus, the average consumer should be expected to be very aware of the religious aspects of the applied-for mark, and those aspects should be expected to play a large part in the consumer's decision on whether to purchase exercise apparel which is sold under and displays such religious faith. Because the religious aspects of the applied-for mark also represent the primary differences between the applied-for mark and the registered mark, the classes of buyers interested in each mark should be considered both distinct and sophisticated as to the therein.

Additionally, the care that the average consumer of fashionable women's shoes puts into making purchases thereof is significant and should not be underestimated. Thus, overall, the care and sophistication of the classes of buyers of goods under the applied-for mark and the registered mark weighs heavily against the likelihood of confusion.

#### D. Fame of the Prior Mark

The registered mark has been a well-known brand of fashionable women's shoes since the 1960s, the company being sold for £65 million in December, 2004 (see Exhibit A). The brand is now owned and marketed by one of the largest department stores in England. Such fame weighs against any confusion between the "faith" shoe brand and the applied-for mark for use with exercise apparel.

For all of the above reasons, the applicant's FAITH (+ design) mark should be registered.

#### **Prior Filed Applications**

Applicant elects not to submit arguments at this time regarding the prior filed applications cited in the Office Action. Applicant reserves the right to present such arguments in response to a future issued refusal under Section 2(d), if any.

Dated: September 26, 2019.

Respectfully Submitted,

By           /William K. Nelson/            
William K. Nelson  
Sierra IP Law, PC  
P.O. Box 5637  
Fresno, California 93755-5637  
(559) 436-3800

# EXHIBIT A



## CASE STUDY



## Background

Faith Shoes was a premium retailer of footwear and accessories in the UK and Ireland. The business operated from **78 standalone stores, 126 department store concessions and a transactional website**, turning over £72 million at its peak.

The business suffered from challenging trading conditions during the 2008 economic downturn and entered administration. Despite being acquired by a new management team who sought to negotiate reduced rental costs, revitalise the brand and refurbish flagship stores, the business continued to lose money and was under threat of receiving a winding up petition from its creditors.

## Hilco Capital's role

- Acquired the bank's security
- Appointed by the company's Administrators to manage retail operations while a buyer was sought
- Worked with Faith's management to quickly understand the profitability of each store and concession
- Following this exercise, it became apparent that many of the stores had become substantially loss making
- Launched a store closing sale in the absence of credible offers for the business as a going concern
- Worked with the Administrators to negotiate the onward sale of the concession business, residual stock and the Faith brand

## Results

- £3 million trading profit achieved for the company's creditors through the store closing sale
- Going concern sale of the concession business to Debenhams achieved, preserving 600 jobs
- Brand sold for a seven figure sum to the benefit of the Faith's creditors
- Hilco Property negotiated a lease premium for assigning the former flagship Oxford Street store

## Key facts

**1964**  
founded by  
Samuel Faith

**£72m**  
turnover

**78**  
stores & 126  
concessions

**£3m**  
trading profit

**600**  
jobs preserved

11 PRODUCTS

FAITH

Sort By Most Popular

New In (3)

In Stock (11)

CATEGORY

Boots (6)

Sandals (4)

Shoes (1)

COLOUR

PRICE

Brit high-street favourites Faith channel a love of fast fashion across their trend-led collections of shoes and accessories. Chic Parisian ballet pumps and studded flat sandals team up with Western ankle boots, skyscraper heels and platform court shoes. Hot on the heels of Faith's footwear comes an edit of wear-with-everything bags, from oversized slouchy hobo bags to cute clutches and across body bags.

Boots

Sandals

Bags



Faith Sequin Barely There Sandals \$71



Faith Ankle Boots \$56



Faith Buckle Ankle Boots With Buckle ... \$71



Faith Glitter Court Shoes \$36



Faith Ankle Strap Two Part Courts \$56



Faith Ankle Strap Two Part Courts \$56

NEW in

# The Guardian

This article is more than **9 years old**

## Faith shoe chain goes into administration

**More than 1,700 jobs at risk after fashion footwear retailer is brought down by its debts**

**Julia Finch**, *City editor*

Thu 22 Apr 2010 15.20 EDT

More than 1,700 jobs are at risk after the Faith shoe chain collapsed into administration today.

The retailer, which operates 78 shops and 120 concessions, mainly in Debenhams stores, had been searching for a buyer in recent weeks. Accountants from Mazars, appointed as administrators, said that the business collapsed "once it became apparent that achieving a solvent sale was not possible".

The accountants said they intended to continue running the business while further efforts were made to find a buyer.

Faith, which specialises in fashion footwear and accessories, was founded in 1964 and was a family business until it was sold to private equity investors in 2004. It employs 362 full-time staff and 1,382 part-timers.

It is not the first time Faith has faced financial difficulties. In 2008 it was seized by Barclays bank, and the chain was then sold to John Kinnaird, a business associate of the retail entrepreneur Sir Tom Hunter. Kinnaird previously owned the Dolcis chain, which collapsed in 2007.

Mazars said that Faith had been crippled by the scale of its debts: "Despite extensive restructuring, the business remained significantly over-leveraged and as a result steps were taken recently to market the business for sale."

This week there were reports that suppliers to Faith, who were worried that they might not be paid, had sent lorries to Debenhams stores and to Faith's head office in west London to demand the return of their stock.

Heath Sinclair, one of the Mazars administrators, said: "We are currently liaising with interested parties in an attempt to facilitate a going concern sale. We will be working closely with the businesses' stakeholders in an effort to preserve a well-known retail brand."

Potential buyers could include Debenhams, which bought the Principles fashion brand out of administration last year after failing to agree a price for the business before its collapse. Principles is now a Debenhams own-brand.

### Since you're here...

... we have a small favour to ask. As the climate crisis escalates, The Guardian is standing alongside those taking part in this week's global climate strike. The climate emergency is the

defining issue of our times, and we are committed to being truthful, resolute and undeterred in pursuing our journalism.

More people are reading and supporting The Guardian's independent, investigative journalism than ever before. And unlike many news organisations, we have chosen an approach that allows us to keep our reporting accessible to all, regardless of where they live or what they can afford. But we need your ongoing support to keep working as we do.

The Guardian will engage with the most critical issues of our time - from the escalating climate catastrophe to widespread inequality to the influence of big tech on our lives. At a time when factual information is a necessity, we believe that each of us, around the world, deserves access to accurate reporting with integrity at its heart.

Our editorial independence means we set our own agenda and voice our own opinions. Guardian journalism is free from commercial and political bias and not influenced by billionaire owners or shareholders. This means we can give a voice to those less heard, explore where others turn away, and rigorously challenge those in power.

We need your support to keep delivering quality journalism that's open and independent. Every reader contribution, big or small, is so valuable.

Support The Guardian



Topics

- Debenhams
- Job losses
- Retail industry
- Recession
- news

WIKIPEDIA

# Faith (shoe retailer)

---

**Faith** was a British shoe retailer founded in 1964 by London accountant Samuel Faith and his wife. In the following years new stores were gradually added, primarily in the South of England. After Samuel's retirement, his son Jonathan acquired the family business which he subsequently sold to Bridgepoint Capital in December 2004 for £65 million.

The company entered administration in 2010, and Debenhams purchased the brand and 115 Faith concessions operating within its stores.

## History

---

In the 1980s the brand launched its prosperous 'faith solo' brand, taking styles and ideas straight from the catwalk and selling them to a mainstream audience. The company also began a programme of opening concessions within selected Dorothy Perkins and Topshop stores.

In 1996 a contract was agreed with Topshop for Faith to open a concession in every Topshop store in the UK and Ireland. In the late 1990s Debenhams also approached Faith with a long-term view to becoming the main concession partner for young fashion ladies footwear. This form of expansion therefore became the only means of growth for the business for several years until 2001.

By 2001, concessions accounted for 75% of sales mainly through the Arcadia stores of Topshop, Dorothy Perkins and Miss Selfridge. In the autumn of 2001, Arcadia served notice that they intended to terminate the contract. Faced with this loss of revenue, the company embarked on a substantial programme of opening own-brand stores.

Topshop asked Faith to leave its stores in the summer of 2003 as they found there would be a higher profit in producing its own brand of footwear. This led to a huge expansion of both Faith branches and profits. Latterly there was only one Faith concession within Topshop (at Oxford Circus).

In 2004 there were approximately 1700 employees in the UK and Ireland, with further concessions operating under licence in the Middle East. There was also a division servicing the main UK mail order catalogues, such as Freemans and Littlewoods.

The brand celebrated its 40th anniversary in 2004. In December 2004, Faith Shoes was bought for £65 million by private equity group Bridgepoint Capital, and some years later entered into a pre-pack administration agreement in 2008, when John Kinnaird bought the business.

In April 2010, all stores were closed as part of a new administration procedure. Prior to administration it had 72 stand alone branches, as well as concessions in Allders, Debenhams, Sunwin House, and Beatties. Debenhams purchased the 115 Faith concessions trading within its stores in July 2010.<sup>[1]</sup>

## "Hope" store

---

In April 2010, after Faith Footwear Ltd went into administration, 70 stores were closed, and more than 1700 staff lost their jobs.<sup>[2]</sup> Inspired by the former Dorchester Woolworth's Store Manager Claire Robertson's success in reopening her store as 'Wellworths', the Chelmsford branch of Faith got together and reopened their store on 3 July 2010<sup>[3]</sup> as 'Hope'.

In the official press release Store Manager Justina Pay stated: "We were inspired by Claire Robertson and her success in turning her old Dorchester Woolworths store into Wellworths, a great example of someone who has had a massive success from a very sad redundancy. Customers were genuine in their sadness that our stores were closing and were concerned as to where they could buy quality shoes from, we knew we had to 'do a Wellworths' and try and bring it back!"<sup>[4]</sup>

## References

---

1. Rosie Baker (2 July 2010). "[Debenhams has faith in shoe chain](http://www.marketingweek.co.uk/debenhams-has-faith-in-shoe-chain/3015382.article)" (<http://www.marketingweek.co.uk/debenhams-has-faith-in-shoe-chain/3015382.article>). *Marketing Week*. Retrieved 5 October 2012.
2. Finch, Julia (2010-04-22). "[Faith shoe chain goes into administration](https://www.theguardian.com/business/2010/apr/22/faith-shoe-chain-administration)" (<https://www.theguardian.com/business/2010/apr/22/faith-shoe-chain-administration>). London: Guardian. Retrieved 2010-11-07.
3. "[YouTube video of 'Hope' Chelmsford Opening](https://www.youtube.com/watch?v=H5pW7T8Xy84)" (<https://www.youtube.com/watch?v=H5pW7T8Xy84>). YouTube. 2010-03-07. Retrieved 2010-03-07.
4. "[Faith Girls Fight Back! Hope is Coming!](https://web.archive.org/web/20101107182506/http://store.hopefootwear.co.uk/hope_pressrelease.html)" ([https://web.archive.org/web/20101107182506/http://store.hopefootwear.co.uk/hope\\_pressrelease.html](https://web.archive.org/web/20101107182506/http://store.hopefootwear.co.uk/hope_pressrelease.html)). Hope Footwear. 2010-06-30. Archived from [the original](http://store.hopefootwear.co.uk/hope_pressrelease.html) ([http://store.hopefootwear.co.uk/hope\\_pressrelease.html](http://store.hopefootwear.co.uk/hope_pressrelease.html)) on 2010-11-07. Retrieved 2010-11-07.

---

Retrieved from "[https://en.wikipedia.org/w/index.php?title=Faith\\_\(shoe\\_retailer\)&oldid=916585477](https://en.wikipedia.org/w/index.php?title=Faith_(shoe_retailer)&oldid=916585477)"

---

**This page was last edited on 19 September 2019, at 16:32 (UTC).**

Text is available under the [Creative Commons Attribution-ShareAlike License](#); additional terms may apply. By using this site, you agree to the [Terms of Use](#) and [Privacy Policy](#). Wikipedia® is a registered trademark of the [Wikimedia Foundation, Inc.](#), a non-profit organization.