

Refusal under Section 2(d)

The Examining Attorney has cited as a bar to registration of Applicant's mark CARING HANDS covering "hand-sanitizing preparations" in Class 5, Registration Nos. 2948115 for CARING covering "gauze" in International Class 5 and 2990675 for CARING covering "adhesive bandages and tape" in Class 5, both by the same registrant. For the reasons set forth herein, there is no likelihood of confusion between the respective marks.

A. The Marks are Different in Appearance, Sound, Connotation, and Commercial Impression

It is well established that the basic principle in determining the issue of the likelihood of confusion is that the marks must be compared in their entireties and must be considered in connection with the goods and services for which they are used. *In re National Data Corp.*, 224 U.S.P.Q. 749, 750 (Fed. Cir 1985); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689 (Fed. Cir. 2005). When considering the respective marks themselves, it is readily apparent that there are differences between them. The cited marks are for the word CARING. Applicant's mark is CARING HANDS. The cited marks and Applicant's mark are different in appearance, sound, and overall commercial impression as to avoid any likelihood of confusion between the respective marks.

The Examiner's position that there is a likelihood of confusion between the respective marks is not supported by precedent established by the Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals. In the Federal Circuit's decision in *In re The Hearst Corporation*, 25 USPQ2d 1238 (Fed. Cir. 1992), the TTAB refused registration of Hearst's application for VARGA GIRL for calendars in view of a prior registered trademark for VARGAS also for calendars and similar goods. *Id.* at 1238. Specifically, the TTAB held that "VARGA" was the dominant element of the mark and "GIRL" was merely descriptive and therefore could not be given substantial weight in a comparison between VARGA GIRL and VARGAS. *Id.* at 1239. On appeal, the Federal Circuit reversed the TTAB's decision, holding that "the Board erred in its analytic approach." *Id.* The Federal Circuit held that "the marks must be considered in the way they are used and perceived...The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl". By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark. Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word "girl". When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely." *Id.* Furthermore, in the case *Colgate-Palmolive Company v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) in which the Court held that the trademarks PEAK for a dentifrice and PEAK PERIOD for personal deodorants were not confusingly similar, in part, due to the difference in sound and appearance between the respective marks. The Court found that "the mere presence of the word "peak" in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion or deception. That determination must arise from a consideration of the respective marks in their entireties. The difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike" *Id.* at 530. See also *The Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 USPQ 422 (CCPA 1975) ("COUNTRY VOGUES and VOGUE do not look or sound alike. The only similarity between them is that VOGUE is part of the mark COUNTRY VOGUES, and the dissimilarities between the marks, viewed in their entireties, outweigh this similarity sufficiently to leave no doubt." *Id.* at 425). In view of *In re The Hearst Corporation* and *Colgate-Palmolive Company*, Applicant respectfully asserts that the Examiner erred in finding a likelihood of confusion on the basis that "CARING" is the alleged dominant element of Applicant's mark and that the addition of the word

“HANDS” does not obviate any likelihood of confusion. As in *In re The Hearst Corporation*, by stressing the “CARING” element of the mark and diminishing the “HANDS” element of the mark, the Examiner inappropriately changed the mark. When the term “HANDS” is given fair weight, along with “CARING”, there is no likelihood of confusion with the cited CARING marks. Also, as in *Colgate-Palmolive Company*, a comparison between Applicant’s CARING HANDS mark and the cited CARING marks *in their entirety* demonstrates obvious differences between the respective marks in appearance and sound that rule out a likelihood of confusion.

In addition, under TMEP 1207.01(b)(iii) the addition of a term (“HANDS”) to identical terms (“CARING”) would be sufficient to avoid a likelihood of confusion if “the marks in their entirety convey significantly different commercial impressions.” TMEP 1207.01(b)(iii). For example, in *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986), the TTAB held that the mark CATFISH BOBBERS (with “CATFISH” disclaimed) for fish was not likely to be confused with BOBBER for restaurant services. Specifically, the TTAB held that “the word “BOBBER”, as it appears in applicant’s mark “CATFISH BOBBER,” clearly suggests the dictionary meaning of the word “bobber,” as a fishing bob or float, while “the word “BOBBER” comprising the registrant’s mark “is not likely to conjure up this dictionary meaning” and “appears to be wholly arbitrary” as applied to restaurant services. *Id.* at 495-6. As such, contrary to the Examiner’s rationale, the TTAB found the marks to be clearly distinct in commercial impression despite the fact that the word CATFISH in the applicant’s mark was merely descriptive (and disclaimed) and the fact that the CATFISH BOBBERS mark “merely narrows” the type of BOBBER. Similarly, in the present case, it is precisely because Applicant’s mark includes the term “HANDS” that the CARING HANDS and CARING marks have significantly different commercial impressions. Applicant’s mark CARING HANDS clearly focuses on the “hands” with the term “caring” just used as an adjective, while the term CARING comprising the cited marks does not conjure up such a narrow and specific meaning and is wholly arbitrary in relation to the goods covered by the cited marks.

Applicant’s CARING HANDS mark and the cited marks for CARING are also significantly different in sound due to the presence of the additional word “HANDS” in Applicant’s mark.

The USPTO also clearly recognizes that different marks by different parties containing the term “CARING” in conjunction with other terms for the same or highly related goods have different commercial impressions with no likelihood of confusion. Specifically, the following registrations included in **Exhibit A** currently coexist on the Principal Register:

- Registration No. 5881028 for **CARING MILL** by FSA Store Inc. covering “sanitizing wipes; adhesive tapes for medical purposes” in Class 5;
- Registration No. 4529633 for **CARING IS PREPARING** by Johnson & Johnson covering “first aid kits” in Class 5;
- Registration No. 4425862 for **CARING FOR YOU. CARING FOR THE EARTH.** by DLC Laboratories, Inc. covering “Health aids, namely, topical pain relievers, topical anti-acne preparations, and medicated camphorated salves” in Class 5;
- Registration No. 5041353 for **CARING FOR YOUR LITTLE ONE FROM TIP TO TOE** by Topco Holdings, Inc. covering “Baby food; baby formula; medicated ointment for the treatment and prevention of diaper rash and skin irritations; disposable diapers for babies and children” in Class 5.

In view of the above, Applicant's CARING HANDS mark and the cited CARING marks are clearly distinct in appearance, sound, meaning, and commercial impression so that there would be no likelihood of confusion between the respective marks.

B. The Goods Are Different

Applicant's goods are "hand-sanitizing preparations" in Class 5.

The goods covered by the cited registrations are "gauze" and "adhesive bandages and tape" in Class 5.

Applicant submits that the differences between the respective marks, combined with the fact that Applicant's goods and the goods covered by the cited registrations are different, further demonstrates that there would be no likelihood of confusion between the respective marks. It is highly unlikely that Applicant's mark CARING HANDS used in connection with a *hand*-sanitizing preparation would be confused with the mark CARING used in connection with gauze, adhesive bandages, or tape used for wound treatment and that have nothing to do with cleaning one's hands. Given the complete context in which the respective marks are used in connection with different goods and the distinct commercial impressions conveyed by the respective marks, consumer confusion is highly unlikely, even assuming that some companies may provide both Applicant's goods and the goods covered by the cited registrations.

Accordingly, Applicant respectfully requests that the Examiner withdraw the refusal to register under Section 2(d) of the Trademark Act.