

## ARGUMENT AND EVIDENCE (See Attachments 1 and 2 Annexed Hereto)

This responds to the PTO's refusal of registration of the applied-for mark under Section 2(d) of the Trademark Act because of a likelihood of confusion with the marks in U.S. Registration Nos. 2060828 (the "828 Registration") and 4430116 (the "116 Registration"), both owned by Walgreen Co. ("Walgreens" or "Registrant"). This response is being submitted by the attorney for the assignee of the applied-for mark pursuant to an assignment from the Applicant that was recorded with the PTO on November 14, 2019. First, as to the 828 Registration.

### **I. The 828 Registration**

The 828 Registration was registered by Walgreens on May 13, 1997 for goods identified as unexposed photographic film in class 1 and photographic cameras in class 9. Although the TSDR record indicates that a Section 8&15 affidavit of continued use was timely filed in 2002 and that a first Section 8&9 renewal was timely filed in 2007, no subsequent renewals are indicated of record. The deadline for filing the second renewal would have been May 13, 2017, plus the six-month grace period allowed for late filing, which would extend the deadline for the second renewal to November 13, 2017. Since it is now more than two years after the extended renewal deadline and there is no indication that the second renewal has been filed, it appears that the 828 Registration has lapsed and should therefore be removed by the PTO from "live" status. This would obviate the need for Applicant to respond to the PTO's objections concerning the 828 Registration. On the other hand, should it turn out that the 828 Registration is still deemed to be "live" by the PTO, the Applicant reserves the right to respond to the Examining Attorney's objections in a response to a subsequent office action.

**II. The 116 Registration** Subsequent to the issuance of the office action on May 31, 2019, it is noted that the applied-for mark has been amended to delete wireless speakers and audio speakers from the identified goods. (Please see the Amendment to Allege Use that was filed with the PTO on November 5, 2019.) Thus, for purposes of the likelihood of confusion analysis, the comparison is between Registrant's registration for STUDIO 35 BEAUTY (in design plus word form) for sunglasses and Applicant's STUDIO 35 application (in standard character form) for headphones and earphones.

#### **A. Comparison of the Marks**

As noted by the Examining Attorney in the office action, "[w]hen comparing marks, '[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.' *Cai v. Diamond Hong, Inc.*, \_\_\_ F.3d \_\_\_, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach*

*Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); TMEP §1207.01(b).”

Here, the Registrant’s mark is STUDIO and BEAUTY in lower case boldface lettering, with a stylized 35 in the middle, creating the commercial impression that Registrant’s products are related to the beauty field, whereas Applicant’s mark creates no such impression, instead evoking the commercial impression of a traditional film, television or recording studio.

The registered mark is for a number of goods that are all in the beauty, beauty accessories, and cosmetics fields. Other than sunglasses (which happens to be classified in class 9, along with a wide variety of other products that have nothing to do with beauty-related products), these goods are all classified in classes related to beauty products, namely, 3, 8, 11, 20, 21, and 26. None of the goods covered by the registration, including sunglasses, are for or related to audio electronics, such as Applicant’s headphones and earphones. Thus, the nature of the goods covered by Registrant’s mark all support the commercial impression created by the BEAUTY word-portion of the registered mark, which is vastly different from the commercial impression created by the STUDIO portion of Applicant’s mark for use in connection with audio electronics, which products are often associated with a music studio.

In addition, there have been six previous cancellations for six other registrations by Registrant using just STUDIO 35 in beauty-related fields, namely, U.S. Registration No. 3423356 for STUDIO 35 (in standard character form) for sunglasses and hair appliances; U.S. Registration No. 3389395 (in design plus word form) also for sunglasses and hair appliances; U.S. Registration No. 3814491 for STUDIO 35 (in standard character form) for topical skin sprays for cosmetic purposes; U.S. Registration No. 3779493 for STUDIO 35 (in standard character form) for foam toe separators and cosmetic brushes and applicators; U.S. Registration No. 3441254 for STUDIO 35 (in standard character form) for wearing apparel; and U.S. Registration No. 3342548 for STUDIO 35 (in standard character form) for mirrors. By abandoning the use of STUDIO 35 alone (without “BEAUTY”) for goods in the beauty, beauty accessories, and cosmetics fields, this too demonstrates that the word “BEAUTY” plays a greater role than the number “35” in creating the commercial impression since there is no apparent connection between the number “35” and goods in beauty-related fields.

On the other hand, there is a connection between “35” and the goods identified in the applied-for mark. The well-known professional basketball star, Kevin Durant, is the sponsor of the STUDIO 35 headphones and earphones. The number 35 commemorates his first basketball coach, Charles Craig, who passed away at age 35 and is the number Mr. Durant wore throughout his collegiate career at the University of Texas and throughout his NBA career, until the number was recently retired by his previous professional basketball team, the Golden State Warriors. Apart from this connection, the number “35” in the mark has no meaning or significance in the

trade or industry in which the Applicant's (or the assignee's) goods are manufactured or provided, nor is "35" a term of art within such industry.

Thus, it is submitted that the commercial impression created by the two marks is between STUDIO 35, on the one hand, and STUDIO BEAUTY, on the other hand, and that consumers looking for STUDIO 35 headphones and earphones are unlikely to go to Walgreens' STUDIO 35 BEAUTY, which is focused on products in the beauty, beauty accessories, and cosmetics fields, and vice versa.

Notwithstanding the foregoing, even if the respective marks are considered to convey a similar commercial impression, this does not end the inquiry, because similarity alone is not dispositive. As indicated in the next section, the relatedness of the goods also must be taken into account.

### **B. Relatedness of the Goods**

Applicant's goods (as amended) are identified as headphones and earphones, and Registrant's goods are identified as sunglasses. The only evidence of relatedness offered by the Examining Attorney is Internet evidence consisting of five website screenshots from [www.sony.com](http://www.sony.com), <https://shop.panasonic.com>, <https://shop.canon.com>, [www.bose.com](http://www.bose.com), and [www.katespade.com](http://www.katespade.com). However, the first three (Sony, Panasonic, and Cannon) are not apposite because they all relate to the 828 Registration for cameras, which (as noted above) appears to have lapsed. The last (Kate Spade) is also not apposite because Applicant no longer identifies speakers as covered goods, and Kate Spade does not offer headphones and earphones. Thus, the only remaining relevant evidence is Bose, which offers sunglasses, speakers, and headphones. It is submitted that only one example is insufficient to support the Examining Attorney's conclusion that "[t]his evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods." In addition, it is noted that Bose is primarily an audio electronics company and that the Examining Attorney has not offered any evidence of companies primarily in the beauty, cosmetics and fashion design fields, such as Kate Spade, that also offer headphones and earphones.

On the other hand, a search of Walgreens' website (<https://www.walgreens.com/store>) under the words "Studio 35" lists the following product types as being offered under that search term: hand & body lotions, face masks, bath sponges & brushes, facial moisturizers, nail polish remover, makeup brushes, and sponges & applicators. There is nothing about sunglasses. In fact, a search for "Studio 35 sunglasses" on Walgreens' website yields the following result: "[I]ooks like we don't have any matches for 'studio 35 sunglasses'". Please see Attachments 1 and 2, respectively, hereto. This suggests that Registrant is no longer using the registered mark for sunglasses.

Even if headphones and earphones are considered to be within Walgreens' field of products, there still would be no likelihood of confusion because to find that Walgreens'

registration for use of a mark in connection with one kind of consumer good bestows upon it priority as to use of that mark in connection with every other type of consumer good that happens to be a similar international classification category is contrary to PTO and public policy. See e.g., *Times Corp. v. AAI.Fostergrant, Inc.*, Civil Action No. 3:00CV295 (CFD) (D. Conn. Sep. 14, 2000) (no confusion likely between EXPEDITION for watches and EXPEDITION for sunglasses).

Lastly, and perhaps of even greater significance, it should be noted that although sunglasses and headphones/earphones happen to fall within the same international class 9, they really are not related goods. See *Oakley, Inc. v. JMM Lee Properties, LLC*, TTAB Opposition No. 91231865 (Opinion by Administrative Trademark Judge Bergsman). In that case, the applicant sought to register FROGSKINS (in standard character form) for “protective covers and cases for cell phones, laptop computers, tablet computers and portable media players” in class 9. This was opposed by the registrant of the identical mark, FROGSKINS (also in standard character form), for “eyewear, namely sunglasses and accessories for sunglasses, namely, replacement lenses, ear stems and nose pieces” also in class 9. The TTAB dismissed the opposition and allowed the application to proceed because the registrant failed to prove that applicant’s protective covers are within the natural scope of expansion for registrant’s sunglasses and accessories for sunglasses, and thus that applicant’s protective covers are not related to registrant’s sunglasses and sunglass accessories. Similarly, it is submitted that the headphones and earphones of the Applicant here are not within the natural scope of expansion for Registrant’s sunglasses, and thus that Applicant’s goods are not related to Registrant’s goods.

### **III. Conclusion**

Based on all of the foregoing reasons, it is submitted that the Section 2(d) refusal to register the applied-for mark because of a likelihood of confusion with the 828 Registration and the 116 Registration should be denied and that the applied-for mark should be allowed to proceed. In the event that the Examining Attorney decides to deny these arguments and uphold the initial Section 2(d) refusal, it is respectfully requested that Application No. 88362839 be put on SUSPENSE pending the outcome of the respective Section 9 and Section 8 filings in class 9 for the aforesaid registrations. It is noted that the deadline for the Section 9 filing for the 828 Registration was as indicated in paragraph I above and that the deadline for the Section 8 filing for the 116 Registration was November 5, 2019, which Section 8 filing is now in the six-month grace period for late filing.

Respectfully Submitted,

*/ Leslie Steinau /*

Attorney for  
the assignee of the Applicant

Buy 2 get 3rd FREE mix & match skin care Shop now

Holiday Sh

Search by keyword or item #

Your account | Find a store

Rx Refills Find Care Contact Lenses Shop Photo Weekly Ad & Coupons Balance Rewards

Home Shop

Studio 35

All Products Online (31) In Stores (77)

Product Type

80 items

Sort by: Top Sellers

Items per page: 24

- Hand & Body Lotions (12)
- Face Masks (10)
- Bath Sponges & Brushes
- Facial Moisturizers (6)
- Nail Polish Remover (6)
- Makeup Brushes (5)
- Sponges & Applicators (4)

Price and inventory may vary from online to in store.

View More

Deals & Promotions

- Gift With Purchase (37)
- Sales & Offers (5)

Price

- Under \$5 (18)
- \$5 - \$10 (10)
- \$10 - \$20 (3)

Enter a custom value

\$ Min to

\$ Max

Apply

Skin Type

- All Skin Types (3)



Studio 35 Gel Nail Polish Remover Pads  
10 ea

★★★★★ (4)

\$5.79

FREE Gift With Purchase

Find at a store

Add to cart

Compare



Studio 35 Beauty Premium Cotton Rounds  
80 ea

★★★★★ (4)

2/ \$7.00 or  
1/ \$3.79

\$0.05 / ea

Find at a store

Add to cart

Compare



Studio 35 Beauty 100% Acetone Nail Polish Remover  
9 fl oz  
★★★★★ (7)

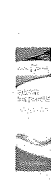
\$4.29

FREE Gift With Purchase

Find at a store

Add to cart

Compare



Studio 35 Shampoo Sensitive Skin  
12 oz.

★★★★★ (3)

\$6.99 \$0.58 / oz.

FREE Gift With Purchase

Find at a store

Out of stock online

Compare



Studio 35 Faux Sea Sponge Tan  
1 ea

★★★★★ (2)



Studio 35 Dead Sea Mineral Face Mask  
0.5 oz

★★★★★ (15)



Studio 35 Cucumber Peel Off Face Mask  
0.5 oz.

★★★★★ (19)



Studio 35 Mint Julep Mask  
8 oz.

★★★★★ (29)

# ATTACHMENT 2

Buy 2 get 3rd FREE mix & match skin care Shop now

Holiday Sh

studio 35 sunglasses

Your account | Find a store

- Rx Refills
- Find Care
- Contact Lenses
- Shop
- Photo
- Weekly Ad & Coupons
- Balance Rewards

## Looks like we don't have any matches for "studio 35 sunglasses"

- Check for typos or use a different search term
- View items you've purchased before
- Browse products, photo services, or health info
- Note that some products sold in stores aren't listed online
- Need assistance with a customer service issue? Visit our Contact Us page to contact the appropriate department.

If you still can't find what you're looking for, send feedback to help improve our site.

### Deals at this store

721 9TH AVE  
NEW YORK, NY 10019

**Today's Hours**

Store & Photo: 24 hours Open now  
Pharmacy: 8AM - 9PM Open now

[Find another store](#)

### Deals online and in stores

[More](#)



Buy 2 Get 3,000  
Loyalty Points



Spend \$10, Get  
2000 pts  
Buy \$10 or more  
participating Rimmel  
Cosmetics and  
receive 2000 Pts.



Buy 4, Get 4000  
pts  
Buy 4 or more  
participating  
Degree, Axe or  
Dove products and  
receive 4000 Pts.



Buy 2 Get 3,000  
Loyalty Points



Spend \$2  
5000 pts  
Buy \$20 or  
participating  
Charmin, C  
Puffs, Swi  
Febreze, I  
Clean, Pep  
and Prilos  
receive 5000

### Sponsored products

