

RESPONSE TO OFFICE ACTION

Applicant RH US, LLC hereby responds to the United States Patent and Trademark Office Action dated June 13, 2019 (the “Office Action”). In the Office Action, the examining attorney (the “Examiner”) refused registration of Applicant’s mark RH (“Applicant’s Mark”) on the basis that there is a likelihood of confusion between Applicant’s Mark and U.S. Registration No. 5,775,884 for RH & Design in Class 43 (the “Cited Registration”).

Applicant responds by, first, amending the Application, and second, respectfully asserting that there is no likelihood of confusion between Applicant’s Mark and the Cited Registration because (a) the Applicant owns a prior registration for an identical mark which has coexisted with the Cited Registration without evidence of confusion; and (b) the amended services are different and distinct enough to eliminate any confusion.

ARGUMENT

I. Applicant requests amendments to the Application

Applicant requests that the Examiner amend the identification of goods and services as shown below:


Class 43: Hotel services; ~~restaurant services; bar services;~~ cocktail lounge services; ~~coffee bars;~~ providing a database in the field of recipes and cooking information

II. There is no likelihood of confusion between Applicant’s Mark and the Cited Registration because the two marks are visually distinct, have different pronunciations and therefore aurally distinct, and Applicant is the owner of an existing registration for RH in Class 43.

a. The two marks are visually distinct

The Cited Registration is a composite mark, which means that protection was given to a combination of word and design. In other terms, the Cited Registration is not a standard word mark, but rather a composite of word and design. As such, the Cited Registration is awarded a narrower scope of protection, limited to that combination of word and design. The design element in the Cited Registration is missing from Applicant’s Mark, which creates a distinction between the two marks and lessens any likelihood of confusion.

Additionally, when comparing Applicant’s Mark and the Cited Registration in their entireties, as the Board requires, the marks have obvious visual dissimilarities. Applicant’s Mark only contains the RH term while the Cited Registration shows a very stylized design that is not obviously read as “RH.” Even if the Cited Registration is understood as consisting of letters, the “R” letter is shown facing backwards and the back of the “R” is connected to the front of the “H,” creating a combination letter design that is not obviously one or the other or both. In addition, the Cited Registration incorporates an inverted arc below the letter design. See a comparison below:

Applicant's Mark	Cited Registration
RH	

Therefore, the visual differences allow consumers to readily distinguish the marks and reduces any probability of confusion.

b. The two marks are pronounced differently

Aside from their visual differences, the two marks are also pronounced differently, creating an aural distinction that lessens any possibility of confusion. Applicant's Mark is pronounced by saying the two letters, "R" "H," as there is no other way to read the word mark for an English speaker. That is not the case for the Cited Registration, however. As shown on the main webpage for the Cited Registration's owner, <https://rawahranch.com/> (a printout attached as **Exhibit A**, and a copy of the main logo shown below), the Cited Registration is used as a design mark for the RAWAH RANCH mark. As a result, any consumer viewing the Cited Registration is likely to understand it as simply a design, and pronounce the entire mark together as "RAWAH RANCH." It is unlikely that any consumer would even identify the Cited Registration as consisting of "RH."





Therefore, the different pronunciations and the resulting oral distinctions further support a finding of no confusion.

c. Applicant owns a prior registration for an identical mark that has coexisted with Cited Registration with no known instances of confusion.


Even if the marks were not visually and aurally distinct, which they are, Applicant's ownership of an existing registration for the identical mark in Class 43 weighs against a finding of confusion. Applicant owns U.S. Trademark Reg. No. 5,788,021 (the "021 Registration"), which is also for the RH mark and is also in Class 43 (registration certificate attached as **Exhibit B**). Because Applicant already owns a registration for the identical mark in the identical class, this also supports a finding of no likelihood of confusion.

According to the TMEP 1207.01, the Examining Attorney should consider: "(1) whether the applicant's prior registered mark is the same as the applied-for mark or is otherwise not meaningfully different; (2) whether the identifications of goods/services in the application and the applicant's prior registration are identical or identical in relevant part; and (3) the length of time the applicant's prior registration has co-existed with the registration being considered as the basis for the §2(d) refusal." *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1400 (TTAB 2012). The duration of coexistence is not dispositive of § 2(d) refusal, but it should be considered together with the other *du Pont* factors. TMEP § 1207.01.

In *Strategic Partners*, the TTAB reversed the Examining Attorney’s conclusion that the applied

for mark,  , was likely to be confused with a registration for  . *Id.* at 1399. Although the applied for mark and the cited registration shared the dominant term ANYWEAR, the Applicant owned a prior registration for a mark that was substantially similar to the applied for mark and this prior registration had coexisted with the cited registration for over five years. *Id.* The TTAB concluded that this tipped the scale in favor of applicant and a finding of no likelihood of confusion. *Id.*

Similar to *Strategic Partners*, Applicant’s ‘021 Registration is substantially similar to Applicant’s Mark (in fact, it is the identical mark) and for the same goods (in fact, it is the identical class). These registrations have coexisted with the Cited Registration for several months, as shown in the table below:

<u>Mark and Registration Number</u>	<u>Owner</u>	<u>Goods/Class</u>	<u>Registration Date</u>	<u>Disclaimer</u>
RH (Reg. No. 5,788,021)	Applicant	IC 43: Restaurant services; bar services; coffee bars	June 25, 2019	None
 RH & Design (Reg. No. 5,775,884)	Owner of Cited Reg.	IC 43: Providing western, mountain, and outdoor related temporary lodging services; dude ranch services; hotel, bar and restaurant services; providing temporary lodging; Providing temporary lodging accommodation services	June 11, 2019	None

The mark in the prior registration is identical to Applicant’s Mark and covers “restaurant services; bar services; coffee bars” in class 43. Although Applicant’s prior registration and the Cited Registration have not coexisted on the register for five years, Applicant’s prior registration claims a first use date of October 2015 and the Cited Registration claims a first use date of December 31, 1948. This indicates that Applicant’s Mark and the Cited Registration mark have been able to coexist in the marketplace for nearly five years without any evidence of confusion.

This fact that the two above registrations have coexisted both in the marketplace and as registrations in Class 43 for so long is evidence that the Cited Registration is unlikely to be confused with a word mark for RH, particularly one owned and used by Applicant. And this further supports a finding of no likelihood of confusion between the Mark and the Cited Registration.

III. Conclusion

For the reasons stated above, Applicant believes there is no likelihood of confusion between Applicant’s Mark and the Cited Registration, as the two marks are visually and aurally distinct, Applicant is the owner of a registration for the identical mark in the identical class, and the Cited Registration has been able to coexist with Applicant’s use of RH without evidence of confusion. Therefore, Applicant respectfully requests the Application be approved for publication.