

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: JVC Kenwood Corporation :
Serial No: 79262780 :
Mark: JVC (Stylized) **JVC** : Jonathan Robert Falk
Filed: March 27, 2019 : Examining Attorney
Our Ref: JVCK 1918181 : Law Office 111

RESPONSE TO OFFICE ACTION

NO FEE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451


This is in response to the Office action mailed on August 14, 2019.


REMARKS

A. Likelihood of Confusion

The Office action refused registration on the basis of a likelihood of confusion with the mark in U.S. Registration No. 4586500. Specifically, the Office action asserts that “[t]he word portion of the marks are identical in appearance, sound, and meaning, ‘and have the potential to be used . . . in exactly the same manner.’” In support of this statement, the Office cited to In re i.am.symbolic, llc, 116 U.S.P.Q.2d

1406 (T.T.A.B. 2015). For the reasons that follow, Applicant disagrees that confusion is at all likely.

This application is for the mark JVC in the stylized form  in Class 25.

The cited registration is for the mark JVC in the stylized form  for “clothing, namely, t-shirts, shirts, athletic uniforms, undershirts, underpants, dresses, pajamas, trousers, skirts.”

Both marks at issue are special form marks. Unlike a mark in standard characters, where the rights “reside in the wording” and the mark is presumed to be capable of depiction in any manner regardless of font style, size, or color, rights in a special form mark reside only in the particular special form display. See TMEP § 1207.01(c)(iii). That standard character marks are different in kind and are accorded different protection from special form marks is underscored by the fact that special form drawings may not be amended to standard character drawings unless the amendment is not material. See TMEP § 807.03(d). The In re i.am.symbolic, llc decision cited by the Office is inapposite here because the marks at issue there were both standard character marks, namely, “I AM with no stylization.”

Here, the marks have the potential to be used only in the special form display shown in the drawings of the respective registration /application. Applicant’s mark is characterized by an angular presentation of the letters in thick lines on a horizontal

plane. It creates a bold and graphic commercial impression. The cited mark is characterized by a curvilinear presentation of the letters in delicate outlines in a vertical configuration, with the “V” intersecting with and connecting the “J” and “C,” and the whole appearing as if the “V” hangs off the “J,” and the “C” hangs off the “V.” It creates a fanciful and elegant commercial impression. Even in the recollection of the average consumer (not a side-by-side comparison), confusion is not at all likely because the marks are vastly different in appearance and commercial impression.

The Section 2(d) refusal was based on an incorrect premise and analysis, and accords the cited mark broader protection than that to which it is entitled. Because confusion as to source is not at all likely between Applicant’s mark and the cited mark, Applicant respectfully requests that the likelihood of confusion refusal be withdrawn.

B. Identification of Goods

The Office action required that the identification be amended to delete or modify a duplicate entry, remove parentheses and brackets, correct punctuation, and clarify indefinite descriptions. Applicant has amended the identification accordingly.

CONCLUSION

With the above, all questions are now answered, and Applicant respectfully requests that the Section 2(d) refusal be withdrawn and this application approved for publication.

Dated: New York, New York
February 5, 2020

Respectfully submitted,

FROSS ZELNICK LEHRMAN &
ZISSU, P.C.

By: 

KAREN LIM
Attorneys for Applicant
151 West 42nd Street, 17th Floor
New York, NY 10036
(212) 813-5900