

Applicant Heartbeat Distributors Ltd (“Applicant”), files this Response to the Office Action dated September 11, 2019 (the “Office Action”). The Office Action concerns Application Serial Number 88/479,672 (the “Application”) for the stylized mark HB (“Applicant’s Mark”), for use in connection with “Cymbals, drums, drum sets, snare drums, drum sticks; hand percussion instruments; conga drums, bongo drums, djembes; musical instrument accessories, namely, stands, pedals for musical instruments, and storage bags; musical instrument cases for drums, guitars, hardware being pedals for musical instruments, cymbals and drum sticks,” as amended, in Class 15 and “Wholesale store services, retail store services and distribution of samples for publicity purposes all in the fields of musical instruments and music equipment,” as amended, in Class 35. Applicant’s Mark was refused based on a perceived likelihood of consumer confusion with a third-party mark (the “Cited Mark”).

Applicant disagrees with the refusal and respectfully requests that Applicant’s Mark be added to the Principal Register. Applicant’s Mark is not likely to be confused with the Cited Mark. Significantly, Applicant’s Mark and the Cited Mark differ in sight, sound, and meaning. Moreover, the USPTO has routinely approved registration of “HB” marks in the same class, including the Cited Mark and a number of other marks. Finally, there has been no history of consumer confusion between Applicant’s Mark and the Cited Mark. In light of these circumstances, and considering the differences between Applicant’s Mark and the Cited Mark, consumer confusion is not likely.

Accordingly, Applicant respectfully requests that the refusal be withdrawn, and the Application proceed to publication. Applicant submits the following response in support of this request.

## **SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

### **I. BACKGROUND**

Applicant is a Canadian company. It distributes exclusive musical instruments, professional audio, and professional stage accessory product lines throughout the world. Applicant also produces and distributes its own brand of percussion products and accessories. See Exhibit A, Screenshot of Applicant's Home Page accessed on March 4, 2020 at <https://heartbeatdistributors.com>.

Registrant, Thomann GmbH is a German company that owns the Harley Benton brand (“Registrant”). Under the Harley Benton brand, Registrant sells guitars and

guitar accessories. See Exhibit B, Screenshot of Harley Benton Page from Registrant's Website, accessed on March 4, 2020 at [https://www.thomannmusic.com/harley\\_benton.html](https://www.thomannmusic.com/harley_benton.html).

## II. DISCUSSION

Likelihood-of-confusion analysis is guided by a number of factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Relevant factors include, among others, the similarity or dissimilarity of the marks *in their entireties*, the variety of products on which a mark is used or not used, and the similarity or dissimilarity of established, likely-to-continue trade channels. *Id.* (emphasis added). In this case, when Applicant's Mark and the Cited Mark are compared in their entireties, consumer confusion is not likely.

### A. Applicant's Mark is distinguishable from the Cited Mark.

Applicant's Mark is different from the Cited Mark such that consumer confusion is unlikely. The Office Action focused on the letters "HB" in the relevant marks. The Office Action largely ignored the differences in how consumers might view the marks and the different meanings of the letters within the marks (were a consumer to even read both marks as the letters "HB"). Additionally, the Office Action does not give sufficient weight to the distinct stylistic differences between the marks. Furthermore, the Office Action does not consider that "HB" in the Cited Mark means "Harley Benton" while "HB" in Applicant's Mark means "Heartbeat," short for Heartbeat Distributor Ltd.

The mere identification of common elements between two marks does not mean that a likelihood of confusion exists. See *Source Srv. Corp. v. Chicagoland JobSource Inc.*, 1 U.S.P.Q.2d 1048 (N.D. Ill. 1986). When comparing marks, the Examining Attorney must observe the "Anti-Dissection Rule," which dictates that marks are not to be dissected, but rather are to be considered as a whole in a likelihood of confusion analysis. See TMEP § 1207.01 (citing *In re National Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985)); *McCarthy*, at § 23:41.

It has been held to be a violation of the Anti-Dissection Rule to focus on the "prominent" features of a mark and decide likelihood of confusion solely on those features, ignoring other elements of the mark. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 U.S.P.Q. 277 (C.C.P.A. 1974). "No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." See *In re Electrolyte Laboratories*, 6 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) (T.T.A.B. erred in its dominant focus on

the K+ in both marks, to the substantial exclusion of the other elements of both marks). *See also Spice Islands, Inc. v. Frank Tea & Spice Co.*, 184 U.S.P.Q. 35 (C.C.P.A. 1974) (improper to ignore portion of composite mark). “Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight” when assessing a mark’s appearance, sound, sight, and commercial impression. *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992).

**1. Applicant’s Mark and the Cited Mark differ in sight.**

Applicant’s Mark and the Cited Mark are differentiated by their design elements. “[W]hile it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case.” *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) [precedential]; *see Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966) (confusion was unlikely between applicant’s mark and several marks owned by opposer consisting of or containing FERRO, due to the dominance of the design elements of applicant’s mark and the relatively small typeface in which FERRO appeared); *accord Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (prominently displayed design considered to be dominant element of the [BODYMAN] mark because it catches the eye and engages the viewer before the viewer looks at the word “Bodyman”).

Here, Applicant’s Mark and the Cited Mark both employ rare, eye-catching fonts and different structures. Applicant’s Mark consists of two, separate letters on the same plane: an uppercase “H” and a lowercase “b,” as pictured below:



The Cited Mark consists of two overlapping elements on separate planes, as pictured below:



Consumers (without the knowledge of the Mark Description in the Registrant's trademark application) may interpret the Cited Mark as:

- an uppercase "H" and the number "3";
- the number "11" and the number "3";
- two upper case "Is" and the number "3";
- two upper case "Is" and an uppercase "B"; or
- an uppercase "H" and an uppercase "B," which is the only interpretation considered in the Office Action.

The font used in Applicant's Mark is a broad, standard font. This is dissimilar to the font used in the Cited Mark, which is stylized with narrow, cursive elements. Also, the letters in Applicant's Mark do not intersect, while the letters in the Cited Mark do. This allows for multiple consumer interpretations of the Cited Mark, as discussed above. Therefore, it is possible that consumers would not view the marks as having a single similar literal element.

Perhaps more important than the font and literal element differences is the significant impression created by the prominent heart design featured in Applicant's Mark. Indeed, neither letter that comprises Applicant's Mark is as large as the dominant heart logo design in Applicant's Mark, which is formed by shared the entirety of the "b" and a portion of the "H." It is eye-catching and creates a direct correlation between Applicant's name, **Heartbeat** Distributors Ltd, and Applicant's branding.

The recent TTAB opinion in *In re Primeway International LLC* is instructive. (Copy attached as Exhibit K). In that matter, the TTAB reversed a refusal to register two Class 25 marks including the literal element "INCOGNITO." The

TTAB found that the two marks were not similar in commercial impression due to the prominent design features in the registrant's mark.

In reversing, the TTAB pointed to several well-known cases where a similar conclusion was reached, including:

- *In re Covalinski*, 113 USPQ2d 1166, 1169 (TTAB 2014): no likelihood of confusion between RACEGIRL (in standard characters) and REDNECK RACEGIRL and design for clothing due to prominence of overlapping letters "R".



- *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987): no likelihood of confusion between for restaurant services and STEVE'S (in typed characters) for ice cream, stating, "Even with the word 'STEVE'S' appearing above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form."



As in the above cited matters, the design element in the Applicant's Mark is large and eye-catching. The *Steve's Ice Cream* case is particularly analogous. There, the use of an identical literal element in an arched shape above a design was not found likely to cause confusion with the same literal element in block letter form.

Because Applicant's Mark and the Cited Mark have distinct visual elements and because the Cited Mark may be interpreted in a way that what not include any shared elements with Applicant's Mark, the marks differ in sight.

## **2. Applicant's Mark and the Cited Mark differ in sound.**

Applicant’s Mark consists of two letters and thus, two syllables, and is pronounced as it is seen - - of the letters, “H” “B.” In contrast, as discussed above, the Cited Mark can be seen a variety of ways, in various syllables and pronounced differently, such as “H three”; “eleven three”; “eye eye three”; or “eye eye bee.” Because of all the potential ways consumers may sound out the Cited Mark, consumer confusion is not likely.

**3. Applicant’s Mark and the Cited Mark differ in meaning.**

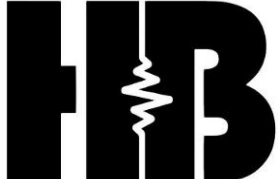
As discussed above, Applicant’s Mark consists of two separate and distinct letters, “H” and “b.” This is an abbreviation for Applicant’s company, Heartbeat Distributors Ltd. Indeed, as noted above, Applicant’s Mark includes the dominant element of a heart to reinforce this connection. The combination of the letters “Hb” and the dominant heart design create a commercial impression in consumers of Applicant’s name, Heartbeat Distributors Ltd.







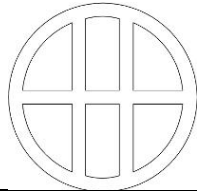

This is unlike the Cited Mark, which is simply an acronym for Registrant’s brand, **H**arley **B**enton. Put simply, the commercial impression created by Applicant’s Mark relates to Heartbeat Distributors Ltd while the commercial impression for the Cited Mark relates to Harley Benton. Heartbeat Distributors Ltd and Harley Benton are not confusingly similar in any manner. Therefore, the differences in the meanings of the respective marks support a finding that there is no likelihood of confusion between the marks.

**B. The Office Action is inconsistent with the USPTO’s prior handling of HB marks, including the Cited Mark.**

Applicant respectfully submits that the Cited Mark has been afforded more protection than it is entitled to in this matter, and that the Office Action is inconsistent with the USPTO’s treatment of marks using the letters “H” and “B.”

The Cited Mark is registered in both Class 9 and Class 15. Numerous marks featuring the stylized letters “HB” in Class 9 have been allowed to register, including:

U.S. Reg. No.	Literal Element	Mark
5966197	HB	

5185433	HB	
5771923	HB	
5007474	HB	
4851881	HB	
4756219	HB	
4229021	HB	
4136088	HB	
1570679	HB	
4637616	H-B	H-B

Copies of the Certificates of Registration for the “HB” marks cited above are attached as Collective Exhibit C.

The implication of these registrations is that the USPTO recognizes that stylized marks consisting of only the letters “HB” can co-exist the same class so long as the differences in stylization are discernable to consumers. Given the distinctions between Applicant’s Mark and the Cited Mark, Applicant should be afforded the

same ability to register its mark in Class 15, just as Registrant and owners of other marks involving the letters “H” and “B” have been afforded in Class 9.

**C. There is no evidence of confusion between Applicant’s Mark and the Cited Mark.**

Applicant has been using its Mark since at least 2018. Applicant has received no notice of actual confusion of Applicant’s Mark with the Cited Mark. This further supports a finding that there is not a likelihood of consumer confusion sufficient to prevent registration of Applicant’s Mark.

**III. CONCLUSION**

Applicant respectfully contends that for the above reasons there is no likelihood of confusion between Applicant’s Mark and the Cited Mark. Accordingly, Applicant respectfully requests that the refusal be withdrawn, and Applicant’s Mark be registered.