In re:

U.S. Application Serial No. 88676758

Mark: XACT

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Docket No. 4092.11

Argument in Support of Registration

Applicant respectfully requests reconsideration of the Examiner's refusal of the instant application based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Summary of Rejection

In an Office Action dated February 10, 2020, Applicant's Trademark Application No. 88676758 ("Applicant's mark") has been refused registration on the Principal Register based upon a determination by the Examiner that a likelihood of confusion may exist between Applicant's mark and the following trademark registrations:

U.S. Registration Nos. 4833305 and 5289889.

Applicant deletes goods from application

Applicant has deleted all of its Class 9 goods and the following Class 18 goods in this response: Athletic bags; Duffel bags; Fanny packs; Messenger bags; Toiletry bags sold empty; Tote bags; Travel cases; Travelling bags, leaving only the following goods in Class 18: Backpacks. Applicant contends that this absolves any likelihood of confusion with U.S. Registration Nos. 4833305 and 5289889 because Applicant's goods and Registrants' goods are no longer similar.

No likelihood of confusion exists with prior-pending applications

No likelihood of confusion exists between Applicant's mark and prior-pending applications cited by the Examiner. In the Office Action, the Examiner cites two prior-pending applications which may be potentially similar to Applicant's mark: Application Nos. 87398900 and 87512378 ("Pending marks"). Applicant contends there is no likelihood of confusion among Applicant's mark and Pending marks when considering the relevant *du*

Pont factors.[1] In this case, the dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression are applicable. These differences result in no likelihood of confusion between Applicant's mark and Pending marks.

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Dissimilar appearances

Applicant's mark and Pending marks are not similar in appearance. This is the first *du Pont* factor to consider in a likelihood of confusion analysis.[2] Applicant's mark contains four letters: XACT. Pending marks contain two words: EXACT FIT. These marks are not similar in sight. Applicant's mark begins with the letter "X" and is not a word. Instead, consumers must use imagination to determine if Applicant's mark should be read as the letters "X-A-C-T" or if consumers should try using the letters in Applicant's mark to form a word. Pending marks consist of two words and four letters not appearing in Applicant's mark. Because Applicant's mark and Pending marks do not appear similar, no potential likelihood of confusion exists.

Dissimilar sounds

Applicant's mark and Pending marks do not sound similar. Sound is a relevant factor to consider in a likelihood of confusion analysis.[3] Phonetic similarity is merely one element to consider in laying out a mosaic of pieces of similarity which may or may not add up to a likelihood of confusion as to overall impression.[4] Even if the marks are phonetically similar, for example, V-8 and VA, other elements of difference may lead to a final finding of no likely confusion.[5] There is no "correct" pronunciation of a word when making a phonetic comparison of conflicting word marks.[6] Applicant's mark consists of four letters, again,

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[1] *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (listing the factors for finding a likelihood of confusion); TMEP § 1207.01(b).
[2] *Id.*
[3] *See In re du Pont*
[4] *Lebow Bros., Inc. v. Lebole Euroconf S.p.A.*, 503 F. Supp. 209, 212, 212 U.S.P.Q. 693 (E.D. Pa. 1980) (Similar pronunciation does not prove likely confusion if other factors weigh more heavily).
[5] *Standard Brands v. Eastern Shore Canning Co.*, 172 F.2d 144, 146, 80 U.S.P.Q. 318 (4th Cir. 1949) (No likelihood of confusion between plaintiff V-8 vegetable juice and defendant's VA tomato juice, rejecting the argument that the marks are confusingly similar because of a similar pronunciation.).
[6] *E.g. StonCor Group, Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 U.S.P.Q.2d 1649 (Fed. Cir. 2014) ("There is no correct pronunciation of a trademark that is not a recognized word . . . . Where a trademark is not a recognized word and the weight of the evidence suggests that potential consumers would pronounce the mark in a particular way,

leaving it to the consumer's imagination whether or not to sound out the letters: "X-A-C-T" or to pronounce the letters to form a word. Either way, this does not sound similar to Pending marks: EXACT FIT. This is especially true given the additional word "FIT" that is not present in Applicant's mark. The third syllable in Pending marks does not exist in Applicant's mark. Because Applicant's mark and Pending marks have unique sounds, no likelihood of confusion exists.

Dissimilar connotations and commercial impressions

Applicant's mark and Pending marks have unique connotations and commercial impressions. It has been well established in trademark law that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail."[7] "For this reason, it should be considered in its entirety."[8] In a likelihood of confusion analysis, focusing on one part, or the prominent part of a mark while ignoring other elements violates the anti-dissection rule.[9] In fact, the use of the same word does not automatically mean that two marks are so similar that a likelihood of confusion exits.[10] "Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight."[11]

Applicant's mark and Pending marks differ in connotation and commercial impression. No connotation or commercial impression exists between the word "XACT" and backpacks. However, Pending marks create a connection between the marks and the goods associated

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it is error for the Board to ignore this evidence entirely and supply its own pronunciation." No confusing similarity was found between senior user's STONSHIELD and applicant's ARMORSTONE, both for epoxy floor coating.).

[7] *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545–46, 64 L. Ed. 705, 40 S. Ct. 414 (1920).

[8] *Id*.

[9] *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (C.C.P.A. 1974). *See Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features"). *See*, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc*., 432 F.2d 1400 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to incorporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). *See Monsanto Co. v. CIBA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion).

[10] *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047 (holding that the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean."

[11] *In re Hearst*, 982 F.2d 493, 494 (Fed. Cir. 1992).

with the prior-pending applications. Pending application Serial No. 87398900, is for the following goods:

> All-purpose carrying bags; Attaché cases; Backpacks; Beach bags; Briefcases; Business card cases; Duffel bags; Grooming organizers for travel; Gym bags; Handbags; Key cases; Kit bags; Leather pouches; Luggage; Luggage tags; Messenger bags; Overnight bags; Shaving bags sold empty; Toiletry bags sold empty; Tote bags; Travel bags; Travelling cases of leather; Umbrellas; Wallets.

Pending application Serial No. 87512378, is for the following goods:

> Computer cases; Protective covers and cases for cell phones, laptops and portable media players; Protective covers and cases for tablet computers; Carrying cases for cell phones.

The word "FIT" in the Pending marks creates a connotation and commercial impression that is different from any meaning in Applicant's mark. Pending marks create a connotation and commercial impression that consumers need not worry if the case, bag, or protective cover they purchase is compatible with their device or what they need to stow away: it is an "exact fit." Pending marks convey a connotation and commercial impression of compatibility that does not exist in Applicant's mark. Pending marks have a connotation and commercial impression that consumers do not need to compare goods and shop around: Pending marks' are an exact fit for the consumer, and the goods fit consumers' needs. This connotation and commercial impression does not exist in Applicant's mark. Because Applicant and Pending marks create different connotations and commercial impressions when viewed in their entireties, no likelihood of confusion exists.

Conclusion

There is no likelihood of confusion between Applicant's mark and Pending marks. Differences in sight, sound, and connotation and commercial impression support Applicant's contention. Applicant respectfully requests the Examiner allow registration of Applicant's mark on the Principal Register.