

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Georgette, LLC

Serial No. : 88643979



For :

Examiner : Erin Falk


Law Office : 101

**RESPONSE TO OFFICE ACTION DATED JANUARY 14, 2020**

The Applicant submits this substantive argument response to the Examining Attorney's Office Action dated January 14, 2020 (the "Office Action"). Applicant thanks the Examining Attorney for their time and attention to this matter and for their consideration of the arguments herein.

**Section 2(d) Refusal – Likelihood of Confusion**




Applicant Georgette, LLC seeks registration of “” design mark in, as amended herein, International Class 032 for “water.”

Registration for the applied-for mark stands refused because the Examining Attorney has asserted a likelihood of confusion with Registration No. 2230702 for “ARCUS,” word mark in International Class 025 for “footwear.” Because class 025 goods are no longer part of the present application, Applicant asserts this refusal is now moot and respectfully requests withdrawal of this refusal. In the event that this refusal stands, please consider the following remarks.

**A. Side-by-Side Mark Comparison**


When viewed in their entireties, the marks are not similar in appearance, sound, meaning, or commercial impression. The mark incorporates a design of an apple with stylized font that says “I AM Arcus”, whereas the Registrant’s mark does not make use of an apple design but merely the word ‘ARCUS.’ Below is a side-by-side comparison of the Applicant’s mark next to the Registrant’s mark cited as the basis for the 2(d) likelihood of confusion refusal.

| <b>Side-by-Side Mark Comparison:</b>   |  |
|--|--|
| <p><b>App. Serial No. 88643979 (Applicant’s Mark)</b></p>  <p><b>Class 032 (amended):</b><br/>water</p> | <p><b>App. Serial No. 75440221 (Registrant’s Mark)</b><br/><b>Registration No. 2230702</b></p> <p><b>ARCUS</b></p> <p><b>Class 025:</b><br/>Footwear</p> |


**B. The meanings of the marks are very different**

The Applicant respectfully notes and asserts herein that the Applicant is amending the applied for goods to International Class 32 to “water.” The Applicant’s amendment does not include any goods in International Class 25 which is the basis for this Office Action. Additionally, the Applicant’s mark and the Registrant’s mark are quite different in meaning in that the Applicant’s mark focuses on diversity and unity. In contrast, the Registrant’s mark is meant to identify a footwear line. The addition of “I AM” at the beginning of the name and the use of the apple design is a key difference that distinguishes the marks from each other. The Applicant’s



Mark “” represents a good, distinct from the Registrant’s “ARCUS” mark which identifies only footwear. Conversely, someone seeking the Applicant’s mark or reading about it



for the first time will easily understand “” is the name of bottled water representing diversity and unity by looking at the design mark.

Below are screenshots, marked up for emphasis, of the Registrant’s goods which reflect their purpose and target demographic. Notable are the product offerings limited to footwear.

### Registrant’s Goods

INSPIRATIONS NEW ARRIVALS WOMEN MEN CHILDREN 676 BRANDS SPORT EXCLUSIVES OUTLET LUXURY

**ARCUS**

GIVE YOUR OPINION

FILTER BY


SHOES ARCUS : 1 articles [Clear criteria](#) Filter by importance ▾

SIZE  
36

COLOUR  
●

PRICE

TOP 5 SALES

1 

**OUTLET**  
Arcus  
Perdol  
~~USD/\$178.00~~ USD/\$142.40  
ORIGIN FRANCE

-20%

♡

2 results for Shoes &amp; Bags : Arcus

Sort by: Featured

## Department

Shoes & Bags  
Shoes

## Price

£50 - £200

£ Min

£ Max

Go

## Seller

- Rue de la chaussure  
 Spartoo SAS

## Availability

- Include Out of Stock

Price and other details may vary based on size and colour




**Arcus**  
 Perdol Loafers & Boat Shoes  
 Women Blue Loafers Shoes  
 £104<sup>96</sup>




**Arcus**  
 Pera Women's Loafers Beige  
 £104<sup>10</sup>



In contrast, as mentioned above, the Applicant's use of "  " in its name conveys a very different meaning, and in conjunction with the visual and written impression of the Applicant, makes a clear and un-confusing distinction from the Registrant's brand and mark.

Below are images of the Applicant's goods using the mark which fully distinguishes the goods from the Registrant's. For this reason too, the consumer is highly unlikely to be confused

by the Applicant's usage of "  ".

Screenshots of Applicant's Goods








**C. Important Differences Between Registrant's Goods and the Applicant's Goods Exist**

There is no *per se* rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. *See Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25

USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD’S for barbecued meats based on LLOYD’s for restaurant services).

Here, the Applicant’s mark amended herein is for, “water” in International Class 032. The Registrant’s mark is for “Footwear” in International Class 025.



Applicant notes that its identification of goods amended herein as “” are focused exclusively on water. This is entirely different from the mark alleged to conflict with a footwear line. The Applicant’s goods, then, are clearly designed for a section of the population with needs completely distinct to the highly specific – and separate section of the population for which the Registrant’s services are intended. A consumer looking for bottled water would not encounter the Registrant’s goods in a search to purchase such products nor confuse the Registrant’s services with the Applicant’s services.

One would be unlikely to confuse either the Applicant’s goods or the Registrant’s goods for each other, or even for a more general “Arcus” brand, due to how highly visible and emphasized their respective target demographics are.


The fact that services may be sold in the same “field” or “industry” is not grounds for refusal. For example, a refusal to register was reversed in *In re Sentry Drug Centers, Inc.*, 1777 USPQ 208 (TTAB 1973) where the Examiner refused to register the mark SENTRY DRUG CENTERS (drug centers disclaimed), for retail drug stores services in view of the registration for the mark SENTRY for an oral antiseptic mouthwash and for vitamins-dietary supplement. *See also, Mason Tackle Co. v. Victor United, Inc.*, 1982 U.S. Dist. LEXIS 16828 (C.D. Cal. Apr. 14, 1982) (no likelihood of confusion between identical marks used for outdoor sporting activities, i.e., T-LINE for fish line and leader and T-LINE for golf clubs and head covers); *Shen v. Ritz*, 393



F.3d 1238, 1245-46 (Fed. Cir. 2004) (marks for different kinds of hand coverings, e.g., oven mitts and children's gloves, and different kinds of head coverings, e.g., hard hats and fedoras not likely to cause confusion). “A prior user of a trademark in one segment of a broad field...should not be permitted to extend the use of his trademark or a similar mark to other segments of the broad field.” *Mason Tackle Co.* 1982 U.S. Dist. LEXIS 16828 at \*20.

**D. Conclusion**

For at least the reasons listed herein, the Applicant respectfully requests that the Examining

Attorney withdraw the Section 2(d) refusal for the trademark “” and approve the application for registration on the Principal Register.

Respectfully Submitted:



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