

**HB Heart Design Logo**  
**US Serial No. 88/479,672**  
**Response to Second Office Action**

Applicant Heartbeat Distributors Ltd (“Applicant”), files this Response to the Second Office Action dated April 3, 2020 (the “Second Office Action”) related to U.S. Application Serial No. 88/479,672 for Applicant’s stylized heart design HB logo (“Applicant’s Mark”). The Second Office Action maintained the likelihood of confusion refusal issued in the Office Action dated September 11, 2019 (the “First Office Action”) and raised several new specimen-related issues. Applicant has filed additional specimens contemporaneously herewith to address such issues. Furthermore, Applicant incorporates by reference its response to the First Office Action dated March 10, 2020 (the “First Office Action Response”).

Applicant maintains that confusion between Applicant’s Mark and U.S. Reg. No. 5,761,032 (the “Cited Mark”) is unlikely because the marks differ in sight, sound, and meaning, HB-formative marks have routinely been registered in the same Class, and there is no history of confusion.

Accordingly, Applicant respectfully requests that the refusal be withdrawn, and the Application proceed to publication.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**

**A. Applicant’s Mark is distinguishable from the Cited Mark.**

As Applicant noted in the First Office Action Response, the marks may be interpreted as sharing the elements “HB.” In Applicant’s Mark, the “HB” stands for the word “heartbeat” its trade names, Heartbeat or Heartbeat Percussion, and its business entity name, Heartbeat Distributor Ltd., while, in the Cited Mark, “HB” stands for “Harley Benton.” Therefore, the marks have a different meaning.

Additionally, the marks differ significantly in their respective designs. The Second Office Action argues that Applicant’s Mark “does not contain a heart design” despite the heart design in Applicant’s Mark, as pictured below and circled in red for the sake of clarity.



The Second Office Action argues that there is no heart design because the description of the mark did not include a reference to the heart design. As Applicant alluded to in the First Office Action Response, consumers are not aware of the mark description in a trademark application or registration when they encounter marks. In any event, Applicant has amended the mark description to make clear that the mark intentionally includes a heart design, which is a reference to Applicant's trade names, Heartbeat, Heartbeat Percussion, and its entity name, Heartbeat Distributor Ltd.

In contrast, the Cited Mark, pictured below, can be interpreted in a number of ways by consumers, which, again, do not have the benefit of a mark description when encountering a mark.



Consumers 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 combination of these differences along with the other arguments presented in the First Office Action Response demonstrate that consumers are not likely to confuse Applicant's Mark and the Cited Mark.

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

As Applicant previously argued, the instant refusal is inconsistent with the USPTO's treatment of marks using the letters "H" and "B," as argued in the First Office Action Response.

Furthermore, the Cited Mark is weak. One relevant *du Pont* factor, not discussed in the Office Action, is the number and nature of similar marks currently in use. *E.I. du Pont de Nemours & Co.*, 177 USPQ at 567. The TTAB recognizes that some marks are weak and entitled only to limited protection. For example, marks that are based on common words and phrases are weak, because the public will look to other elements to identify the source. *See, e.g., Sure-Fit Prod. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958); *In re DCT LSPD, LLC*, Serial No. 87019660 (T.T.A.B. September 13, 2017); *In re Hartz Hotel Servs., Inc.*, 102 U.S.P.Q. 2d 1150, 1153-54 (T.T.A.B. 2009); *In re FabFitFun, Inc.*, 127 USPQ2d 1670 (TTAB 2018).

As explained in *Sure-Fit Prod. Co.*:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

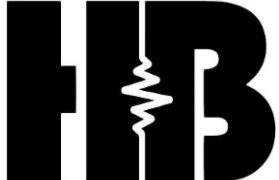
117 USPQ at 297.







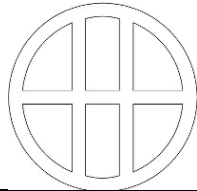

This logic is especially powerful when, as in this case, the shared elements cited as grounds for refusal are frequently associated with particular types of goods or services in the marketplace. *See, e.g., In re FabFitFun, Inc.*, 127 USPQ2d 1670.

When a mark is weak, even minimal differences between that mark and an applied-for mark can be sufficient to prevent confusion. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“evidence of third-party use of similar marks on similar goods ‘can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.”); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (“The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”).

Consider the TTAB’s recent precedential opinion in *In re FabFitFun, Inc.*, 127 USPQ2d 1670 (TTAB 2018). In that case, the Examining Attorney had initially refused the mark I’M SMOKING HOT for a wide variety of cosmetic and personal care products, based on a perceived likelihood of confusion with the registered mark SMOKIN’ HOT SHOW TIME for cosmetics and mascara. The applicant submitted proof of **ten** third-party uses of SMOKIN’ HOT related to a variety of cosmetics to demonstrate the weakness of the “SMOKIN’ HOT” phrase element. The TTAB determined that the “third-party uses . . . tend to show consumer exposure to third-party use of the term on similar goods.” As such, the TTAB found that the weakness of the element SMOKIN’ HOT weighed in favor of a finding of no likelihood of confusion. After noting the differences in the two marks beyond the shared weak SMOKIN’ HOT element, the TTAB held that confusion was not likely and reversed the refusal.

Here, there are at least **eleven** trademark registrations for marks entirely comprised of the elements “HB” plus design in categories relevant to the Cited Mark, which are listed in the chart below. This does not even take into account other third-party uses that are not known to the trademark office.

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 Exhibit 1.<sup>1</sup>

<sup>1</sup> Several Exhibits Applicant intended to submit with the First Office Action Response either appear blank or did not properly load into the USPTO system. Applicant has filed Exhibit 1, which was cited as Collective Exhibit C in the First

As previously argued, 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.

Moreover, these third-party uses demonstrate that the Cited Mark is weak. Members of the public are used to seeing stylized versions of the letters “HB” used in connection with a variety of products in Classes 9 and 15. Thus, consumers can be expected to look to differences in other design features to distinguish among marks such as Applicant’s Mark and the Cited Mark. *See In re Hartz Hotel Servs., Inc.*, 102 U.S.P.Q. 2d 1150, 1153-54 (T.T.A.B. 2009).

Thus, similar to the registrant in *In re FabFitFun, Inc.*, the registrant in the present case is not entitled to a broad scope of protection that would bar the registration of every mark composing, in whole or in part, the letters “HB” regardless of the differences in presentation and meaning.

In light of weakness of the Cited Mark, the USPTO’s prior treatment of HB-formative marks, and the differences between Applicant’s Mark and the Cited Mark, the instant refusal should be withdrawn, and Applicant’s Mark should be approved for publication.

### **C. Conclusion**

Applicant respectfully contends that for the above reasons and the reasons stated in the First Office Action Response 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.

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Office Action Response, and Exhibit 2, which was cited as Exhibit A in the First Office Action Response, with this response.