

## Response to Office Action

MARK: ACE

SERIAL NO.: 88843823

APPLICANT: Grace Aviation Holdings LLC

FILING DATE: March 23, 2020

INTERNATIONAL CLASSES: 039

TO: Timothy J. Callery  
Examining Attorney  
USPTO, Law Office 121

Applicant, Grace Aviation Holdings LLC, (“Applicant”) respectfully submits this Response to the Office Action issued on June 15 2020, against Application Serial No. 88843823 for the ACE Mark (for “*Airline check-in services; Airline transportation services*” in Class 039).

The Examiner has refused registration on the ground the Applicant’s Mark is likely to cause confusion with the trademarks bearing Registration Nos. 5974801 (ACE in Class 039), 5974800 (ACE TO THE RESCUE! in Class 039), and 5974799 (ACE AIR CARGO in Class 039) (the “Cited Marks”), as we all as a possible likelihood of confusion with prior-pending application bearing Serial No. 87890667 (CAPTAIN ACE) (the “Prior-Pending Mark”). The Cited Marks and the Prior-Pending Mark are all owned by same entity, Alaska Central Express, Inc. Applicant maintains that, for the reasons set forth below, confusion is unlikely, and therefore the Cited Marks and the Prior-Pending Mark should not pose a bar to registration.

As each issue in the Office Action letter of June 15 has been addressed, Applicant respectfully requests that the ACE mark be granted registration.

### I. Potential Likelihood of Confusion

#### 1. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969). As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording. Moreover, registrations for identical marks (which Applicant’s mark and Cited Mark are not) for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion.

2. The Applicant's Mark is Visually and Aurally Dissimilar From The Cited Mark and the Prior-Pending Application and The Marks Create Distinct Commercial Impressions In Their Respective Contexts

The Applicant's Mark is dissimilar from the Cited Marks and the Prior-Pending Application in appearance and overall commercial impression.

In determining likelihood of confusion, marks being compared should be considered in their entirety. *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."). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

In determining the commercial impression created by a mark, the mark must be viewed in its entirety. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although "Vargas" and "Varga" were similar, "the marks must be considered in the way they are used and perceived ... and all components thereof must be given appropriate weight." The court went on to say that "[b]y stressing the portion 'varga' and diminishing the portion 'girl', the Board inappropriately changed the mark." *In re Hearst Corp.* at 1239, see also *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not likely to cause confusion with ALL, both for household cleaning products).

The Examining Attorney, in their letter of June 15 submits that Applicant's Mark, ACE, in standard characters, is overly similar to the Cited Marks, ACE, with logo, and to both ACE TO THE RESCUE! and ACE AIR CARGO in standard characters. For the reasons set forth below, applicant respectfully disagrees.

As far as the Cited Mark "ACE", the Examining Attorney is correct that the similarity of the marks should be considered, however, it is just one of many relevant factors to be considered here. Though Applicant acknowledges that its Mark and the Cited Mark "ACE" are identical in sound, equally significant is the dissimilarity in overall appearance, the dissimilarity of the nature of the services, the dissimilarity of the trade channels used to target the respective customers, and the degree of care used by the relevant consumer market. Further, the marks are not identical in appearance in that Applicant's Mark is a standard character mark, while the Cited Mark "ACE" is incorporated into a distinct logo design. Specifically, the Cited Mark consists of the word "ACE" in a stylized font centered above three horizontal stripes with an encircled star superimposed in the center. The consumer's eyes are drawn to the graphic logo as a whole owing to its highly stylized design. Thus, Applicant's Mark, visually displaying only three standard characters in black font, is visually distinct from Registrant's Mark.

Registrant's Marks "ACE TO THE RESCUE!" and "ACE AIR CARGO" are both visually and aurally distinguishable from Applicant's Mark. While consumers generally tend to focus on the first part of a trademark as the dominant feature, the fact that Applicant's Mark solely contains one word, while Registrant's Marks contain 3-4 words, makes the Mark so distinct that there cannot be any confusion as to the marks in their entirety. Specifically, despite the marks all beginning with the word "ACE", Applicant's Mark ends there while the Cited Marks continue with "TO THE RESCUE!" and "AIR CARGO". By leaving out additional words in the mark, Applicant's Mark is highly vague and ambiguous as compared to the Cited Marks, which more specifically allude to Registrant's aviation business.

Finally, Applicant's Mark is one word, three letters, and one syllable, whereas the Cited Marks are significantly longer. The Cited Mark ACE TO THE RESCUE! contains four words, fourteen letters, one special character, and five syllables. The Cited Mark ACE AIR CARGO contains three words, eleven letters, and four syllables. Applicant's Mark is short and easy pronounce since it consists of only one syllable, whereas the Cited Marks are much longer, thus making them aurally distinct.

Lastly, as far as the Prior-Pending Mark, once again, it is axiomatic that consumers tend to focus on the first part of a trademark when allocating source-identifying significance. The first parts of the marks in question in this case are different: the first part of Applicant's Mark is ACE whereas the first part of the Prior-Pending Mark is CAPTAIN. These are both distinct as completely different words with different connotations. They further render a larger overall difference in length, both aurally and visually.

In combination, respectfully these differences between the marks result in distinct commercial impressions, making confusion between them unlikely.

3. Applicant's Goods and Services and Cited Mark's Goods Are Sufficiently Unrelated To Render Consumer Confusion Unlikely

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207, 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). TMEP 1207.01(a).

Registrant's services are *Air transport services* in Class 039 across all marks, including the Prior-Pending Mark.

Applicant's services are *Airline check-in services; Airline transportation services* in Class 039.

Despite both Registrant and Applicant existing in the air transport industry, there is no *per se* rule that goods or services which fall into the same broad, general field are "related" for Section 2(d) purposes. *See Umc Industries, Inc. v. Umc Electronics Co.*, 207 U.S.P.Q. 861, 879, 1980 WL 30155 (T.T.A.B. 1980) ("[T]he fact that one term, such as 'electronic', may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.").

The services overlap in the sense that they exist in the same industry, however, they exist in different facets of the industry. The Cited Mark is associated with a singular service, namely, air transport, whereas Applicant's services encompass not only airline transportation, but also airline check-in services. As such, Applicant's services are broader than the Registrant's single service.

Further, given the significantly more meaningful distinctions between the two marks, described above, the Office must show a proportionally higher degree of relatedness to support a finding that the two marks would overall be confused in the marketplace.

Applicant respectfully maintains that in light of the forgoing arguments these goods and services are not sufficiently related to warrant the finding of 2(d) confusion.

4. The Channels of Trade and Conditions Under Which Sales Are Made Render Consumer Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. See also *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); See also, *In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public). Additionally, where goods or services move in different channels of trade, confusion as to source is unlikely. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between opposer's mark E.D.S. for computer services and applicant's mark EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets).

Applicant's Mark and the Cited Marks are unlikely to be confused for the reasons set forth above, and because the channels of trade at issue here are distinct. The Registrant's services appear to only be available in the State of Alaska. (See, <http://www.aceaircargo.com/>). In Fact, the Cited Mark "ACE" is an acronym for the entity "Alaska Central Express, Inc". As such, consumers will only encounter the Registrant's services if they require air transport services within Alaska. Such a geographic boundary mitigates the risk of consumer confusion across the United States.

Further, the Applicant's Mark and the Cited Marks are unlikely to be confused because the associated services, pertaining to air transport and airline check-ins, are classes of services in which consumers are likely to exercise a heightened degree of care in pursuing. Given the high cost of air transport, the likely consumers of these services are indisputably sophisticated who are highly adept at pinpointing their specific needs and distinguishing between brands and providers.

Therefore, the channels of trade and the conditions under which the respective products are sold are distinct, and the 2(d) refusal should be withdrawn.

## **II. Conclusion**

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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