

I. Section 2(d) Refusal.

The Examining Attorney has refused registration based on a likelihood of confusion with the mark in U.S. Reg. No. 5711305.

The mark in Reg. No. 5711305 (the '305 Registration) is E&S OUTDOOR in the following stylized format:



The '305 Registration is registered for "coats for men and women; jackets and socks; hiking jackets; outer jackets; rain coats; rain jackets; rainproof jackets; reversible jackets; sports jackets; trekking jackets; waterproof jackets and pants; wind-jackets; windbreakers; winter coats; hats; athletic pants; athletic shirts; camp shirts; long-sleeved shirts; moisture-wicking sports pants; moisture-wicking sports shirts; short-sleeve shirts; sport shirts; sports pants; sports caps and hats; stocking hats; wind

pants; wind shirts in Int. Class 025. Registrant disclaimed exclusive right to "OUTDOOR". The '305 Registration is owned by a Kansas limited liability company named Equinox and Solstice Outdoor Limited Company.

Applicant's mark is E&S PETS and the identification is "pajamas; sleepwear; slippers; socks in Int. Class 025."

A. The DuPont Factors Weigh in Applicants Favor.

In *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals (CCPA) announced thirteen factors relevant for determining likelihood of confusion under §2(d). These factors are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.

5. The fame of the prior mark (sales, advertising, length of use);
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);
10. The market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use, (b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party, (c) assignment of mark, application, registration and good will of the related business, or (d) laches and estoppel attributable to the owner of the prior mark and indicative of lack of confusion;
11. The extent to which the applicant has a right to exclude others from use of its mark on its goods;
12. The extent of potential confusion, i.e., whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.

See In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

No single factor is dispositive. However, Applicant believes that the *Du Pont* factors weigh in Applicant's favor and requests the Examiner reconsider and withdraw the Section 2(d) refusal.

B. The Marks Must Be Considered in their Entireties.

In comparing Applicant's and Registrant's marks, the marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. See e.g., *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974) ("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."); *Dreyfus Fund, Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 213 U.S.P.Q. 872 (S.D.N.Y. 1981) (quoting treatise); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) ("[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark."); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) ("[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features."); *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996) ("Rather than consider the similarities between the component parts of the marks, we must evaluate the

impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products.”).

A significantly different display of the same term or an addition of a distinctive element (i.e. term or design) can avoid a likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). The use of a design as part of a mark minimizes any likelihood of confusion. *Harlem Wizards*, 952 F. Supp. At 1096 (citing McCarthy at §23:15[5]). See also, *In re NBA Properties, Inc.*, 2000 TTAB LEXIS 863 (TTAB 2000) (when considered in their entireties, the marks differ in appearance and create distinctly different commercial impressions; applicant’s mark is a composite consisting of a word and a design, both of which must be considered in determining the overall commercial impression the mark conveys).

Applicant respectfully submits that the Examiner erred in failing to give due weight to the differences between Applicant’s Mark and the mark in the cited registration. "Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, the Applicant sought to register VARGA GIRL for calendars. The Trademark Trial and Appeal Board refused registration in light of the prior registration VARGAS,

registered for posters, calendars, greeting cards" and related goods. On Appeal, the Federal Circuit reversed the Board's refusal.

The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl." By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark. Although the weight given the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word "girl". When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely. *Id.*

Similarly, Applicant's E&S PETS mark must be viewed in its entirety. Applicant respectfully submits that the addition of the word PETS changes the overall impression of the mark. Applicant submits that the Examiner has effectively removed these significant portions from its mark. When all portions of Applicant's mark are given proper consideration, Applicant contends that the two marks are sufficiently distinguishable in sight, sound and meaning to create distinguishable overall commercial impressions.

It is well settled that, depending on the circumstances, the same or highly similar marks can be used on different types of clothing items without creating a likelihood of confusion. See e.g., H. Lubovsky, Inc. v. Esprit de Corp., 627 F. Supp. 483, 228

U.S.P.Q. 814 (S.D.N.Y. 1986) (ESPRIT on shoes was found to be strong enough to create confusion from use on shoes, but not from use on wearing apparel); In re Shoe Works, Inc., 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (no likelihood of confusion between PALM BAY women's shoes and PALM BAY shorts and pants). If use of the popular ESPRIT and PALM BAY marks on clothing did not create a likelihood of confusion with the *identical* marks on shoes, it would follow that use of E&S OUTDOOR on clothing would not create confusion with the relatively distinguishable E&S PETS on sleepwear. See also McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 202 U.S.P.Q. 81 (2d Cir. 1979) (no likelihood of confusion between senior user's DRIZZLER for men's golf jackets and junior user's DRIZZLE for women's overcoats and raincoats); Clark & Freeman Corp. v. Heartland Co., 811 F. Supp. 137, 25 U.S.P.Q.2d 2030 (S.D.N.Y. 1993) (senior user on boots and shoes cannot, by launching a line of clothing, prevent intervening user's use on shirts because at the time of the intervening user's first use, there was no likely confusion caused by the use on shirts); A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 166 F.3d 191, 49 U.S.P.Q.2d 1493 (3d Cir. 1999) (no likelihood of confusion between senior MIRACLESUIT for swimwear versus junior MIRACLE BRA on lingerie); A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 57 F. Supp. 2d 155, 52 U.S.P.Q.2d 1143 (E.D. Pa. 1999) (no likelihood of confusion

