

## Office Action Response

### U.S. Trademark Application Serial No. 90179173

Applicant submits that the Office Action has erred in concluding that there would be a likelihood of confusion between the mark in the instant application and the mark in U.S. Registration No. 4861125. As applicable here, the rejection erroneously relies upon similarities in the marks that pertain only to descriptive or suggestive terminology, and fails to focus on the dominant portion of the respective marks. Specifically, the cited mark is used with brackets that terminate walls (e.g., at a top end thereof) and prevent the walls from moving. For reference, an image from a web page depicting the use of the mark is included below, as a well terminator bracket. As such, the literal component "TERMINATOR" is descriptive of the function of the bracket as also depicted in the mark. In accordance with TMEP § 1207.01(b) (iii) and controlling law, descriptive or suggestive aspects of the cited mark should be considered as unreliable for distinguishing goods (*i.e.*, least likely to raise a likelihood of confusion issue). For instance, "suggestive" terms are readily distinguished when adding other dominant aspects of the mark. *See In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks). Furthermore, descriptive aspects of a mark are not likely to cause confusion. *See Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellent used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellent for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" is descriptive as applied to the relevant goods and thus has no source-indicating significance). *See also Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks). TMEP § 1207.01(b)(iii) further cites to *In re Energy Images, Inc.*, 227 USPQ 572, 573 (TTAB 1985) (holding "because of the descriptive significance of the term "SCAN," it would be the portion of applicant's mark that consumers would least likely rely upon to distinguish applicant's goods").

As applicable here, the §2(d) refusal relies entirely upon the descriptive/suggestive portion "Terminator" of the cited mark, as applied to brackets use to terminate walls, and fails to give proper weight to the dominant portions of the respective marks as shown below:



As consistent with TMEP § 1207.01(b) (iii), the dominant portions of the respective marks are sufficient to avoid a likelihood of confusion where the common term (TERMINATOR) in the cited reference is descriptive or suggestive. Specifically, “[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB’s holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant’s marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer’s marks) (emphasis added).

As applicable here, like the *Citigroup* decision noted above, Applicant submits that the dominant elements of the cited mark and the instant mark impart wholly distinct commercial impressions, with the former depicting a functional termination bracket and the latter depicting a green fictional chupacabra creature. Applicant further submits that the Office Action’s attempt to assert that the “word portion is normally accorded greater weight” fails to consider the descriptiveness of the cited mark as to wall termination brackets. The Office Action also fails to discuss (or apparently consider) the drastically different design elements, improperly concluding that all design elements can be disregarded, regardless of their nature. Indeed, the Office Action provides no analysis whatsoever as to the actual design elements present in the mark. Further, the Office Action has provided no support for any assertion that the word “Terminator” for the cited termination bracket would impart a distinct impression that is neither descriptive nor suggestive.

Accordingly, Applicant submits that the Office Action has failed to properly evaluate the marks for the dominant aspects therein, has improperly relied upon descriptive aspect of the cited terminator bracket, and has thus not established that a likelihood of confusion would exist between the instant mark and that in U.S. Registration No. 4861125.

Website image from URL [http://www.thereinforcer.com/the\\_terminator\\_i6.html](http://www.thereinforcer.com/the_terminator_i6.html), obtained on August 2, 2021):

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## THE TERMINATOR™

Stop Basement Walls From Moving at the Top!

- Patent Pending
- Engineered Technology
- Resists up to 6,000 pounds of force
- Prevents the wall from sliding laterally inward at the top
- Constructed of High Strength Steel
- Easy installation
- Compact sleek design
- Can be with or without The Reinforcer
- Free engineering design & support
- Lifetime manufacturer warranty



The Terminator™ is a Patent Pending steel bracket that is designed and manufactured by Nationwide Reinforcing, Ltd.