

The August 16, 2021 Nonfinal Office Action refused registration under Section 2(d) and required further clarifications to Applicant's identification of services. Applicant has carefully reviewed the cited registration and the Examining Attorney's comments, and responds as follows:

### **Identification of Services**

Applicant appreciates the Examining Attorney's suggested revisions to its identification of services. Please amend Applicant's service description to:

"Financial services, namely, **issuing catalog and mail-order** store credit cards for customer **featuring** a payment plan for customers to purchase consumer household items through mail order and online catalogs, a payment plan for customers to purchase goods and services through mail order and online catalog ordering services in the field of consumer household items, home and garden décor, storage items, holiday decorations, toys, candles, giftware, and apparel; **financial services, namely, issuing online and print catalog store credit cards for customers featuring** a store credit account to be used for purchases; providing financing and credit **loan** services for consumer membership plans in connection with mail order and online catalog services in the field of consumer household items, in International Class 36."

### **Argument**

The Examining Attorney contends that Applicant's READYCREDIT mark, when applied to Applicant's services, may likely create confusion with the mark CREDIT READY in U.S. Reg. 90495608 for "financial services, namely, money lending and credit services; credit reporting services; financial services, namely, financial credit scoring services." Applicant respectfully disagrees. The significant differences in **appearance, sound, meaning, and concept** between READYCREDIT and the cited registration will sufficiently avoid any likelihood of confusion for at least two primary reasons: 1) "CREDIT READY" is a generic or highly descriptive term that consumers regularly encounter and therefore do not associate with one commercial source; and 2) the transposition of words "Credit" and "Ready" in Applicant's mark successfully creates a distinctly different commercial impression that even minimally-attentive consumers will readily distinguish from CREDIT READY.

Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) (the "du Pont factors"). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight

in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)). In the instant case, three *du Pont* factors are particularly relevant: (1) the strength of the registered mark; (2) similarity of the marks; and (3) similarity of the services. These and other factors are discussed below.

### **CREDIT READY is Generic or Highly Descriptive**

“CREDIT READY” is a descriptive term commonly used throughout the mortgage and financial industry to describe a potential borrower whose financial credit score is good enough to qualify them to obtain a mortgage or other major financial loan. **EXHIBIT 1** (downloaded from the indicated URLs on February 8, 2022) contains 34 examples of CREDIT READY used in this generic way to describe borrowers or the goal of pre-qualifying for a loan.

The cited Registration’s February 14, 2019 Statement of Use specimen uses CREDIT READY exactly in this generic way, i.e., to identify a potential borrower’s goal of having credit ready to qualify for a loan.

As shown in **EXHIBIT 1**, there is extensive third party use CREDIT READY. Evidence of extensive third-party use or registration of a term on the same or very similar services is “powerful” evidence to show that a mark is weak and entitled to only a narrow scope of protection. *See 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); *Juice Generation*, 115 USPQ2d at 1674.

Active third-party registrations may also be relevant to show that a mark or term is descriptive, suggestive, or so commonly used in a particular industry that the public will look to other elements to distinguish the source of the services. *See Juice Generation* at 1674-75; TMEP § 1207.01(d)(iii). *See also e.g., Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 U.S.P.Q.2d 1030, 1036 (T.T.A.B. 2016) (“[R]elevant customers [were] exposed to so many different ROSE and ROSE-formative marks and names in connection with senior living communities that they likely ha[d] become alert to ‘minute distinctions’ among the various marks”).

Currently there are three active third-party registrations that in USPTO for Class 36 marks that include both CREDIT and READY. *See EXHIBIT 2*.

As a result, consumers are unlikely to recognize “CREDIT READY” as a source indicator. Nor are they likely to assume that all marks that contain “Credit” and “Ready” emanate from a common commercial source.

In the present case, the weakness of cited mark and the differences in the marks deserve greater weight in the likelihood of confusion analysis. As the Court noted in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 117 USPQ at 297: “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 marks are not similar in appearance, sound, meaning, and concept. READYCREDIT and CREDIT READY do not look the same. They appear different and are distinct. Nor do READYCREDIT and CREDIT READY sound the same. Further, the meaning of CREDITREADY and READY CREDIT are much different. READYCREDIT means that credit is readily available, that the lender is ready to issue credit/loans. CREDIT READY means that the borrower has taken steps necessary to increase the credit score to qualify for a mortgage or loan. Finally, READYCREDIT and CREDIT READY are different in concept. READYCREDIT may apply to the lender whereas CREDIT READY applies to the borrower.

### **Transposition Creates Distinctly Different Commercial Impression**

Applicant’s READYCREDIT mark and the cited mark differ significantly in appearance, sound, meaning, and concept. The marks do not have the same appearance – READYCREDIT does not appear identical to CREDIT READY. The marks do not sound the same – READYCREDIT does not sound the same as CREDIT READY. Further, the meaning of READYCREDIT and CREDIT READY are much different. READYCREDIT means that credit is readily available. CREDIT READY implies that the borrower has taken the steps necessary to achieve a credit score that is sufficient for a lender to provide a loan or mortgage. Finally, the concepts are different. The concept of READYCREDIT is that a lender is ready to loan whereas the concept of CREDIT READY is that the borrower is ready to borrow.

If the transposed mark creates a distinctly different commercial impression, then confusion is not likely. *In re Best Products Co., Inc.*, 231 USPQ 988 (TTAB 1986); *In re Akzona Inc.*, 219 USPQ 94, 96 (TTAB 1983) (“Applicant’s mark ‘SILKY TOUCH,’ conveys the impression that applicant’s synthetic yarns are silky to the touch. On the other

hand, registrant's mark 'TOUCH O' SILK,' suggests that registrant's clothing products contain a small amount of silk."); see e.g., *Kampgrounds of America, Inc. v. North Delaware A-OK Campground, Inc.*, 190 U.S.P.Q. 437 (D. Del. 1976), affirmed, 556 F.2d 566 (3rd Cir., 1977) (holding that A-OK and KOA are not confusingly similar, even though both marks relate to campgrounds); *Carefirst of Maryland, Inc. v. First Care, P.C.*, 73 U.S.P.Q.2d 1833, 1839-1840 (E.D. Va. 2004), affirmed, 77 U.S.P.Q.2d 1577 (4th Cir. 2006) (holding that FIRST CARE for physicians' medical practices did not infringe CAREFIRST for health insurance); *In re Mavest, Inc.*, 130 U.S.P.Q. 407 (T.T.A.B. 1961) (holding that SQUIRETOWN for men's sport coats creates a different commercial impression from TOWN SQUIRE for related goods, namely, men's shoes). See also *Mccallum-Legaz Fish Co., Inc.*, 118 U.S.P.Q. 178 (Com'r Pat. & Trademarks July 11, 1958) ("Applicant's mark appears to be considerably more than a mere reversal of the terms "sea" and "frost" in that "FROSTY SEAS" stimulates an association with cold sea water, whereas "SEAFROST" conjures an association with white frost crystals.

READYCREDIT and CREDIT READY create distinctly different commercial impressions. Therefore, confusion is not likely.

### **Comparison of the Services**

While there is no evidence of record to demonstrate that the cited CREDIT READY registration has ever been used in connection with "money lending," or to promote "credit services" beyond those specifically relating to financial credit score repair and reporting, Applicant acknowledges that the "Credit services" identified in Reg. 90495608 shall be broadly interpreted to overlap with Applicant's narrowly defined catalog and mail-order store credit account services. However, the weakness of the highly descriptive cited mark and the differences in **appearance, sound, meaning, and concept** are sufficient to distinguish the marks even when applied to identical services.

Moreover, the legal significance and personal nature of credit services in general—whether applying for a retail catalog store credit account, or exposing one's private financial history in effort to qualify to obtain a home mortgage—suggests that consumers exercise a higher degree of care in these purchasing decisions. "Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion." TMEP § 1207.01(d)(vii) citing *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that because only sophisticated purchasers would purchase the relevant goods there would be no likelihood of

confusion merely based on the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, “even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily.