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Examining Attorney: BENMAMAN, ALICE

Serial Number: 76/717794



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Ming D&Y Inc.

Serial No.: 76/717,794

Exam. Attorney: Benmaman

Filed: April 1, 2015

Law Office: 116

For: BSEEN (Word mark alone)

NOTICE OF APPEAL AND APPEAL BRIEF

Applicant hereby appeals the Final Rejection of January 22, 2016. A Form PTO-2038 is provided for payment of the appeal fee of \$200.00 (two classes). Applicant also contemporaneously submits its appeal brief herewith.

Respectfully submitted,

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Description of the Record

The application was filed April 1, 2015 as an intent to use application for the word mark BSEEN initially only in Int. Class 009. A first action rejection was mailed July 13, 2015. An amendment was received by the PTO December 7, 2015. The amendment revised the goods description for the Class 009 goods, and added another recitation of goods for Int. Class 018, and included an Amendment to Allege Use for both the Class 009 and 018 goods. The Amendment to Allege Use was accepted January 22, 2016. The amendment of December 7 also included evidentiary materials in the form of a Declaration of Robert A. Vanderhye as well as Exhibits A & B thereto. Exhibit A provided copies of documentary proof of present active commercial use of the marks of four different third party trademark registrations with various versions of the words “be” and “seen” all in Int. Class 009, as well as three other active commercial uses of “be” and “seen” for goods that would be in Class 009 if they were the subject of trademark registrations. Exhibit B to the Vanderhye declaration provided printouts from the on-line records of the USPTO of the four third party registrations related to the commercial uses of Exhibit A, along with one other third party registration for Class 009.

After receipt of the Amendment of December 7, on January 22, 2016 the PTO issued a final rejection of the application under 15 USC §1052(d) for both the Class 009 and 018 goods. This notice of appeal and appeal brief are applicant’s response to the final rejection.

Statement Of The Issues

There is only one issue. Is applicant's mark for BSEEN for goods in Int. Classes 009 and 018 likely to be confused under 15 USC §1052(d) with the "BE SEEN. RUN LONGER." mark of Registration 4621045 in Class 009 issued October 14, 2014 ("the '045 registration")?

Recitation Of The Facts

Applicant's made-up all-one-word mark BSEEN is applied to: "Safety products for humans, namely reflective and illuminated armbands, safety belts, safety markers, and safety vests; and road safety products for pets, namely reflective and fluorescent collars, leashes, collar covers, and pet markers; flashing safety lights attachable to pets and reflective pet collars, vest, leashes, and collar covers, in International Class 009. Backpacks and fanny packs in International Class 018."

The '045 registration, issued in October, 2014, is for: "Safety products, namely, reflective and fluorescent ankle bands, belts, gloves, headbands, shoe pockets, vests, wrist bands and wrist pockets" in Int. Class 009. The mark is four words and includes two punctuation marks (periods), namely: "BE SEEN. RUN LONGER."

The evidentiary declaration, with attached Exhibits A & B, of Vanderhye demonstrates that there are four third party registrations in Class 009, the marks of which are all still in active use today, that include various forms of "be" and "seen" although none of them are all one word with no punctuation as is applicant's mark. All four registrations were issued before the '045 registration. Included in these registrations is Registration 3745129 ("the '129 registration) for "BE SEEN. BE SAFE." four words with two periods with three of the words and the two periods exactly the same as in the '045 registration. That registration was issued February 2, 2010, more

than four years before the '045 registration. All four of the third party registrations are for illuminated or reflective safety products still sold by the trademark owners today.

The Vanderhye declaration also provided proof that there are three other active commercial uses of trademarks including some iteration of the words “be” and “seen” for illuminated or reflective safety products. Still further, the Vanderhye declaration provided a fifth third party registration for “BE COOL, BE SAFE, BE SEEN” for safety clothing in Class 009.

The PTO has not disputed the accuracy of the evidence presented by way of the Vanderhye declaration. The PTO has not even referenced the commercial uses of the marks of the registrations and has stated that the goods of the third party registrations are “predominantly different or unrelated to those identified in applicant’s application.” [See the penultimate and third to last paragraphs on unnumbered page 2 of the final rejection.]

Argument

Reconsideration and reversal are respectfully requested of the likelihood of confusion rejection primarily in view of the first and sixth *DuPont* factors.¹

With respect to the first *DuPont* factor, sight, sound, and commercial impression (sometimes indicated as “meaning”), the differences between BSEEN and “BE SEEN. RUN LONGER.”² could scarcely be more stark. The mark of the application is one continuous “word,” and an invented word at that, namely BSEEN. The mark of the '045 registration is four

¹ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973).

² It is a seemingly inequitable contradiction of trademark law that applicants have to provide proof of commercial use of third party registrations but cannot submit proof regarding commercial use of a registration cited in a 2(d) rejection. If applicant here were able to legally provide such proof applicant would be able to demonstrate that the owner of the mark of '045 registration uses the mark as “SEE. BE SEEN. RUN LONGER.” not just what is in the registration, which provides an entirely different commercial impression. See <http://www.nathansports.com/visibility>

distinct words and with two punctuation marks (periods). In *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1350, 98 USPQ2d 1253 (Fed. Cir. 2011) the Court determined that the difference between a compound word and two words was very significant in evaluating the first *DuPont* factor, and found no likelihood of confusion.

Also, the mark of the application is not a real word while all four words and the punctuation marks of the '045 registration are common words and symbols. Thus all of sight, sound, and commercial impression are vastly different.

The mere fact that the pronunciation of applicant's made-up word and the first two words of the '045 registration would be the same (although the period at the end of "BE SEEN." in the '045 registration might change the sound for some people) is not enough to establish a *prima facie* case of similarity under 2(d). See *Seven-Up Co. v. Tropicana Products, Inc.*, 142 USPQ 384 (TTAB 1964), affirmed, 356 F.2d 567, 568 (CCPA 1966), where the differences in the marks "SUN-UP" and "SEVEN-UP" for basically the same goods (non-alcoholic beverages) were considered and no likelihood of confusion was found. The TTAB's holding was that "...a small difference in spelling or appearance may be sufficient to distinguish them and avoid a finding of confusing similarity."

Without success, the final rejection strings together citations of unrelated cases in an attempt to demonstrate that the first *DuPont* factor is not in applicant's favor. This includes making the assertion that marks similar in sound alone may be sufficient to support a finding of confusing similarity under 2(d), even though the cases cited do not really support that proposition and in any event are not relevant here.

In the case of *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988), for example, the marks were found similar in both sound and sight. Even with those similarities the Board indicated that if White Swan had been able to prove a difference in meaning (commercial impression) that a finding of likelihood of confusion could have been avoided. Unlike *White Swan* here the marks are vastly different in sight and meaning/commercial impression, and the identity of sound is only between the first two words of the mark of the '045 registration and applicant's single made-up word. If the sound of the entire mark of the '045 registration is considered the sounds are vastly different too. This makes this situation immeasurably dissimilar to the situation in *White Swan* and more like the situations in *Seven-Up* and *Citigroup*.

Similarly, *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) is irrelevant to the situation here. While the *1st USA* decision has dicta that sound alone can support a holding of likelihood of confusion, the situation was much more complex there, and irrelevant here. The marks at issue were "1st USA" and "First USA" for services in the same class. In other words the marks were both two common words, the second words identical, and the first words also known to be identical in common vernacular. That has nothing to do with the situation here where applicant's mark is one made-up word and the mark of the registration is four words and two punctuation marks.

Although primarily related to the sixth *DuPont* factor, as will be discussed below, the existence of third party registrations AND uses clearly belies the PTO's interpretation of sight, sound and meaning. If the standards applied against applicant were applied against the '045 registration, it never would have issued:

--The '029 registration issued February 2, 2010 for "High visibility safety apparel..." in Class 009 for "BE SEEN. BE SAFE."

--The '045 registration issued October 14, 2014 for "Safety products, namely reflective and fluorescent...gloves, headbands,...vests, wrist bands..." in Class 009 for "BE SEEN. RUN LONGER."

The PTO cannot apply one standard in issuing the '045 registration over the '129 registration and then apply a totally different tougher standard when considering applicant's application. In summary, just on the basis of the first *DuPont* factor alone there is no likelihood of confusion under 2(d).

Even more significant than the first *DuPont* factor in this case is the sixth *DuPont* factor, "the number and nature of similar marks in use on similar goods." *DuPont*, 476 F.2d at 1361. According to TMEP §1207.01 the sixth *DuPont* factor is among those "most relevant" in an *ex parte* case, and dispositive here.

Evidence of third-party use falls under the sixth du Pont factor - the "number and nature of similar marks in use on similar goods," *supra*. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); J. Thomas McCarthy, 2 *McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed.2001). In particular, see the following holding in *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626-27 (8th Cir.1987) which was quoted with approval by the Federal Circuit in *Palm Bay*:

“Third, although Kellogg argues that evidence of third party registrations without accompanying proof of the extent and length of actual use is of slight evidentiary value, evidence of third party usage of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to a narrower scope of protection...[internal citations omitted] (the greater the number of identical or more or less similar trademarks already in use, the less is the likelihood of confusion). The district court did not rely solely on evidence of third party registrations, but also looked at evidence of other currently used marks which incorporate words identical or similar to the word "crisp." Given the evidence of actual third party use and of the mark's descriptive nature, the district court did not clearly err in finding that APPLE RAISIN CRISP is likely a relatively weak mark.”

Contrary to the perfunctory analysis of applicant's evidence indicated in the final rejection (the third to last and penultimate paragraphs on unnumbered page 2) applicant did not merely submit third party registrations. Applicant's evidence showed that four of the five third party registrations submitted were in active commercial use now, and additionally there were three other active commercial uses that also contain “be” and “seen” in one iteration or the other and for goods that would clearly fall within Class 009, and that the goods are directly related to both the goods of the '045 registration and applicant's goods.

For example, for the three active commercial uses of Exhibit A to the Vanderhye registration that are not presently the subject of registrations compared to the '045 registration and the instant application see the following comparison (1. is Total Women's Cycling, 2. is Govivo, 3. is Nike, 4. is the '045 Registration, 5. is applicant):

Mark:	Goods:
1. BE SURE TO BE SEEN	Reflective clothing
2. BE SEEN AND STAY SAFE	Reflective safety vests
3. BE SEEN. STAY DRY.	Reflective running outfits
4. BE SEEN. RUN LONGER.	Reflective vests, wrist bands, gloves & head bands
5. BSEEN	Reflective and illuminated arm bands, safety vests

This is not simply a situation where applicant has provided copies of some registrations (as was done and rejected in *In re 1st USA Realty*, supra); rather the third party registrations have been matched with present actual commercial uses, and additional relevant third party uses are provided.

The statement in the third to last paragraph on page 2 of the final rejection alleging that the goods of the third party registrations are “predominantly different or unrelated to those identified in applicant’s application” is grossly factually inaccurate, and also misses the point [the goods should also be compared to those of the ‘045 registration]. For example, and example only, how is it possible to seriously allege that the “high visibility safety apparel” of the ‘129 registration, proven by the Vanderhye declaration to still be in use today by its owner White Knight, is “different or unrelated to” the “reflective and illuminated...safety vests” of applicant’s goods description or the “reflective and fluorescent...vests” of the ‘045 registration?

Still further, if the allegation of “predominantly different” was correct then applicant’s goods are sufficiently distinct from the goods of the ‘045 registration to also prove no likelihood of confusion under the second *DuPont* factor.

The entire analysis in the final rejection is based upon an erroneous factual premise and ignores the fact and law which demonstrate that the mark of the ‘045 registration is very weak and cannot be interpreted to demonstrate likelihood of confusion with applicant’s mark.

Put another way, with regard to the sixth *DuPont* factor, applicant has presented irrefutable evidence in the form of third party prior registrations in Class 009, and their counterpart commercial uses as of October 2, 2015, that the ‘045 registration would never have issued if it had a monopoly on “BE SEEN,” but rather it is necessarily restricted to the entire

mark and cannot be used to establish likelihood of confusion with applicant's mark. Seven commercial uses and five third party registrations for similar to identical goods provide a very significant number, certainly not inconsequential, and they cannot be ignored as has been done in the final rejection.

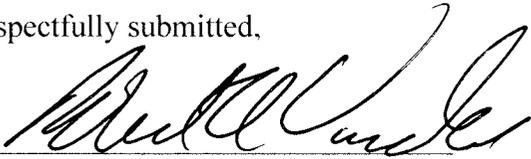
It is also noted that none of the prior registrations, or the uses, in Exhibits A & B to the Vanderhuy declaration relate to applicant's mark, BSEEN as a single made-up "word" with no punctuation. This distinguishes it from all marks in Class 009 and the uses in Exhibit A, demonstrating no likelihood of confusion.

Still further, the '045 registration is clearly not relevant to the goods in Class 018. The only "evidence" provided by the PTO to rebut this is information from the website of a SINGLE company, namely REI. One such use can hardly provide proof that applicant's goods in Class 018 are normally sold in the same channels of commerce as the Class 009 goods and would be expected to be so sold by consumers, and therefore there is no likelihood of confusion with respect to the Class 018 goods under both the second and third *DuPont* factors. This is especially so here where the PTO did not consider seven commercial uses significant when applicant presented them with respect to the sixth *DuPont* factor, and when there are no registrations of record listing goods in both Classes 009 and 018, let alone applicant's specific goods.

Conclusion

In conclusion when the proper law is applied to the proven facts there clearly is no likelihood of confusion between applicant's mark and that of the '045 registration. Therefore early reversal of the final rejection and passage of the application to publication are earnestly solicited.

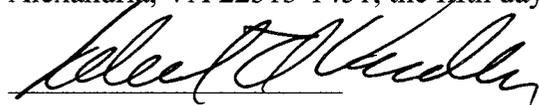
Respectfully submitted,



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Certificate of Mailing

I hereby certify that I mailed the foregoing notice of appeal, appeal brief, and form PTO-2038, first class, postage prepaid, addressed to Commissioner for Trademarks, P O Box 1451, Alexandria, VA 22313-1451, the fifth day of February, 2016.



Robert A. Vanderhye