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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79194717

MARK: DRAGONFLY



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Quorning Boats ApS

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTERNATIONAL REGISTRATION NO. 1315800**

Applicant appeals the trademark examining attorney's Final refusal to register the mark DRAGONFLY (standard characters) for "boats; water vehicles, namely, hydrofoil boats supported by single or multi hulls, and structural parts therefor; trimarans; trailers for towing boats; collapsible inflatable boats; leisure boats; vessels boats and ships; replacement structural parts and fittings for water vehicles; masts for boats; booms for boats; water vehicles for rental and commercial use, namely,

speed boats; water vehicles for transporting people, namely, pontoon boats.” Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because Applicant’s mark when used in connection with the identified goods is likely to be confused with U.S. Registration Nos. 3475967 and 3471075 for the marks DRAGONFLY (standard characters) for, “boat hulls; boats; boats and structural parts therefor; fishing boats; structural parts for boats; vessels; Jon boats; kayak-like boats”, and DRAGONFLY BOATWORKS LLC BY MARK CASTLOW (stylized) for, “boats; boat hulls; boats and structural parts therefor; fishing boats; kayak-like boats.”

### **STATEMENT OF FACTS**

On August 30, 2016, Applicant, Quorning Boats ApS, filed an application under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol), for the standard character mark DRAGONFLY for “boats; water vehicles; trimarans; trailers for towing boats; collapsible boats; leisure boats; vessels [boats and ships]; parts and fittings for water vehicles; masts for boats; booms for boats; water vehicles for rental and commercial use; water vehicles for transporting people.”

On December 16, 2106, the examining attorney issued an Office action refusing registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered marks in U.S. Registration Nos. 3475967 and 3471075.<sup>1</sup>

On June 19, 2017, Applicant responded by arguing against the likelihood of confusion refusal, and on June 22, 2017, a Suspension Letter issued suspending the application pending cancellation proceedings against the cited registrations while maintaining the refusal to register under Trademark Act Section 2(d).<sup>2</sup>

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<sup>1</sup> A requirement for a definite identification of goods was also issued.

<sup>2</sup> Applicant did not address the requirement for a definite identification of goods and so it was also maintained.

On December 29, 2017, after termination of the cancellation proceedings, examination of the application resumed with the examining attorney issuing a Final Office action maintaining the refusal to register under Trademark Act Section 2(d) with regard to U.S. Registration Nos. 3475967 and 3471075.<sup>3</sup>

On June 28, 2018, Applicant filed a notice of appeal to the Trademark Trial and Appeal Board (Board), and a Request for Reconsideration of the final refusal. The Request for Reconsideration argued against the refusal to register, and contained a consent agreement between the parties.<sup>4</sup>

On July 23, 2018, after consideration of the arguments and consent agreement, the examining attorney issued a subsequent Final Office action denying registration under Trademark Act Section 2(d) with regard to U.S. Registration Nos. 3475967 and 3471075.<sup>5</sup>

On October 11, 2018, the appeal to the Board resumed, on December 10, 2018, Applicant filed his Appeal brief, and on December 12, 2018, the application was remanded to the examining attorney.

### **ISSUES ON APPEAL**

- 1. Whether Applicant's proposed mark, DRAGONFLY, is likely to cause confusion with Registrant's, DRAGONFLY and DRAGONFLY BOATWORKS LLC BY MARK CASTLOW, marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d).**
- 2. Whether the consent agreement submitted by Applicant and all of the surrounding circumstances related thereto reflect the reality of no likelihood of confusion in the marketplace.**

### **ARGUMENT**

#### **A LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT'S MARK AND REGISTRANT'S MARKS**

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<sup>3</sup> The requirement for a definite identification of goods was also maintained and made final.

<sup>4</sup> The Request for Reconsideration included a proposed amended identification of goods also.

<sup>5</sup> The proposed amended identification of goods was accepted.

Applicant's DRAGONFLY mark creates a likelihood of confusion when compared to Registrant's DRAGONFLY, and DRAGONFLY BOATWORKS LLC BY MARK CASTLOW marks. The marks are very similar, if not identical, and the goods are identical, in part, and closely related.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). 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, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); *see In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (C.C.P.A. 1976); TMEP §1207.01.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP

§1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

**Applicant's Goods Are Closely Related to Registrant's Goods.**

Determining whether the goods are related or similar for likelihood of confusion purposes is based upon a comparison of the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In the present case, the goods identified in the registrations are identical in part, and closely related, to the goods identified in the application. See, e.g., *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Both the application and registration identify boats, vessels, parts for boats and related goods. Thus, applicant's goods and registrant's goods are legally identical, at least in part. See, e.g., *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)). Further, neither the registrations nor application contain any restriction as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Consequently, Applicant's goods and Registrant's goods are considered related for likelihood of confusion purposes.

Applicant argues that his goods are sufficiently dissimilar from Registrant's goods such that confusion as to source or origin is unlikely if he is permitted registration. However, this argument is unpersuasive.

That the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. The compared goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

As stated above, it is the identification of goods stated in the application and registration that are considered, not extrinsic evidence of actual use. *Id.*

Here, the goods identified in the registrations are identical in part, with the goods identified in the application. The registrations and application identify, "boats", "vessels" and "structural parts therefor", and related items for boats. As such, the goods are legally identical, at least in part, and closely related.<sup>6</sup> Moreover, even if Applicant's argument is considered, it is not convincing because the

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<sup>6</sup> See e.g. excerpted third party registrations attached to December 29, 2017, Office action showing the same mark registered for goods listed in the application and/or registration.

alleged goods for use in the registrations and application remain closely related. More specifically, Applicant alleges that his boats are “multihulls, catamaran sailboats, [and] trimaran sailboats”, whereas Registrant’s boats are fishing boats, including shallow water and skiffs. Clearly, the previously attached evidence shows multihull boats, including catamaran sailboats and trimaran sailboats, and fishing boats, including shallow water boats and skiffs, to be closely related.

Exhibit A, from the July 23, 2018, Office action, included webpages from the manufacturers, *Mowdy, Carolina Skiff, Lund, Ranger Boats, NRS, Outcast, and Sea Eagle*, showing that they offer shallow water fishing boats and/or skiffs as well as multihull boats, such as catamarans and pontoons, including inflatables. Exhibit B, from the same Office action, included webpages from the retailers *Sea Water Marine, Sunrise Marine, Boat and Motor Superstore, Cabela's, Highway Marine, and Robbins Marine*, showing that they offer shallow water fishing boats and/or skiffs and multihull boats, such as catamarans and pontoons, in the same channels of commerce. And, Exhibit C, from the same Office action, showed that multihull boats, such as catamarans, are frequently offered as a skiff or shallow water fishing boat, and that hybrid vessels are sold having the characteristics of a catamaran and yet are able to fish in shallower waters. Consequently, the parties’ goods are identical in part, closely related, are manufactured by the same entities, exist in the same channels of commerce, and are available to the same end consumers.

**Applicant’s Mark Is Very Similar To Registrant’s Mark.**

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En*, 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.”



*In re Inn at St. John's, LLC*, 126 USPQ2d at 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

*U.S. REGISTRATION NO. 3475967*

In this case, Applicant's mark is identical to Registrant's mark. Both are for the wording DRAGONFLY, as a standard character mark. Thus, the marks share the same overall sound, appearance, meaning and commercial impression in the mind of the average consumer.

*U.S. REGISTRATION NO. 3471075*

When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. *In re Viterro Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Matter that is descriptive of or generic for a party's goods is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)). Consumers are more likely to perceive a distinctive term, even if suggestive, rather than a generic or descriptive term as the source-identifying feature of the mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059-60 (TTAB 2017) (citing *In re Dixie Rests.*,

*Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009)).

In this case, the registered mark is dominated by the wording DRAGONFLY. This wording appears first and in large lettering at the top of the registered mark, followed at the bottom by the wording, “Boatworks LLC”, and separated in the middle by a design of a dragonfly. Given the highly descriptive nature of the wording, “Boatworks LLC”, the average consumer is likely to attribute little, if any, significance to this wording, or the dragonfly design itself, apart from it reinforcing the preceding arbitrary wording DRAGONFLY. Similarly, the additional wording, “By Marc Castlow”, appears in a much smaller size and beside the DRAGONFLY design. In this location and size, this wording merely identifies a house mark for the boating line DRAGONFLY. Adding a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section 2(d). *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR and CACHET confusingly similar); TMEP §1207.01(b)(iii). Consequently, the marks are similar.

Applicant asserts that confusion as to source or origin is unlikely if his mark were permitted registration given the sophistication of the average consumer. However, this argument is unconvincing.

Even if consumers of the compared goods could be considered sophisticated and discriminating, it is settled that “even sophisticated purchasers are not immune from source confusion, especially in cases such as the present one involving identical marks and related goods.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015) (citing *In re Research & Trading Corp.*, 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986)), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). The identity of the marks and the relatedness of the goods “outweigh any presumed sophisticated purchasing decision.” *In re*

*i.am.symbolic, llc*, 116 USPQ2d at 1413 (citing *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

**THE CONSENT AGREEMENT SUBMITTED BY APPLICANT DOES NOT REFLECT THE REALITY OF NO LIKELIHOOD OF CONFUSION IN THE MARKETPLACE.**

*In re E. I. DuPont* held that all evidence of record relating to the issue of likelihood of confusion must be considered in reaching a conclusion on that issue, and it provided guidance by listing some thirteen factors which may enter into that determination. *Id.* at 1361, 177 USPQ at 567. A consent to registration is one of those factors. 476 F.2d at 1363, 177 USPQ at 569.

In *In re Mastic Inc.*, 4 USPQ2d 1292 (Fed. Cir. 1987), the Court of Appeals for the Federal Circuit stated that *In re DuPont* does not make a consent agreement dispositive on the issue of likelihood of confusion. Instead, all of the surrounding circumstances must be considered to determine whether the parties' agreement reflects marketplace realities, and not merely a bargain struck between the parties that may be beneficial to their own interests, regardless of confusion of the public. A consent agreement is simply evidence which enters into the likelihood of confusion determination and may or may not tip the scales in favor of registrability, depending upon the entirety of the evidence. 4 USPQ2d at 1294, citing *In re DuPont*, 476 F.2d at 1362-63, 177 USPQ at 567-69; 1 J. Gilson, *Trademark Protection and Practice* §3.04[3], at 3-64 (1987).

In the present case, the *Consent Agreement*, (hereinafter *CA*), does not obviate a likelihood of confusion because the undertakings of the parties do not reflect the reality that virtually identical, if not identical, marks used on identical and closely related goods would be likely to cause confusion. *See In re Permagrain Prods., Inc.*, 223 USPQ 147 (TTAB 1984) (finding a consent agreement submitted by applicant did not alter the conclusion that confusion was likely, because the agreement was "naked" in

that it merely indicated that each party would recognize, and refrain from interfering with, the other's use of their respective marks and that the applicant would not advertise or promote its mark without its company name, but the agreement did not restrict the markets or potential customers for their goods in such a way as to avoid confusion) see also *In Re Bay State Brewing Co.*, 117 USPQ2d 1958 (TTAB 2016) (affirming refusal to register the mark TIME TRAVELER BLONDE because it was likely to be confused with the mark TIME TRAVELER, despite a consent agreement between parties specifying where and how the marks were to be used). The undertakings of the parties consists of using their respective marks in connection with distinctive stylization and logo, and restricting what goods they will offer in commerce in connection with the marks. However, as more fully discussed below, these restrictions are inadequate and unrealistic to obviate a likelihood of confusion.

The CA stipulates overlapping goods of the parties, and the commercial impression of the marks as displayed in the CA remain dominated by the same distinctive wording.

The CA recites the reasons why the parties believe confusion would not be likely. In pertinent part, it indicates that confusion would not be likely because:

- \* The display of the respective marks are distinctively dissimilar from one another,
- \* The goods are different,
- \* The average consumer is knowledgeable and sophisticated, and
- \* There is no known instances of actual confusion

### ***Similarity of the Display of the Marks***

As to the display of the marks, the CA is not consistent with, nor reflected in the application and registrations. Both the application and U.S. Registration No. 3475967 are standard character marks. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the

wording or other literal element and not in any particular display or rendition. See *In re Vitterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). However, in this case the terms of the CA restrict the marks to a particular stylization that is not reflected in the registration or application. Consequently, allowing this application to register as a standard character mark would impart greater rights than is stipulated in the CA. In addition, use of the mark in U.S. commerce must be predicated upon the application as filed because it is based upon Trademark Act Section 66(a), a non-use based application basis. Any restriction as to the display of the mark is only made public and notice provided when part of the application and resulting registration therefrom.

This situation is similar to *In Re Bay State Brewing Co.*, in which the Board affirmed a refusal to register an Intent-to-Use application for the mark TIME TRAVELER BLONDE because of a likelihood of confusion with TIME TRAVELER, despite a consent agreement between parties specifying where and how the marks were to be used. In evaluating the terms of the parties' consent agreement, the Board stated that, "Applicant desires a decision based on its mark, not as applied for, but rather as promised. These promises as to trade dress and house mark usage represent another deviation from the parameters of the application and registration, and thus would result in a failure of the public notice function of registrations." 117 USPQ2d at 1966. As in *In Re Bay State Brewing Co.*, Applicant desires to register a mark based upon a promise of how it will be used, that does not put the public on notice, and that he is not required to use.

Moreover, even if the sample displays of the mark as pictured in the CA are compared, the same arbitrary wording DRAGONFLY dominates the marks, and is reinforced by the visual image of a dragonfly. The slightly different stylization does not result in any meaningful distinction or dissimilarity between the marks that avoids a likelihood of confusion. Instead, it is the wording DRAGONFLY that

remains dominant in establishing the meaning and impression retained by the average consumer. As such, this provision is unpersuasive, inaccurate, and should be disregarded.

### ***Similarity of the Goods***

The provision in the CA that states that the goods are different is unconvincing, inaccurate and disproven by the evidence of record.

Neither the application nor registrations include any of the restrictions imposed by the CA. As such, the public has not been placed on notice as to what the actual goods are, imparting protection to a mark for a greater scope of goods than that which was agreed upon, and fails to reflect the realities of the marketplace.

A similar situation was presented in *In Re Bay State Brewing Co.* In that case, the Board concluded that a geographic limitation stipulated in a consent agreement between the parties was misleading because it was missing from the application, and failed to put the public on notice as to the true nature of the marks and goods upon which it is used. The Board stated, "... when marks are being searched and cleared, there is a presumption by searchers and attorneys afforded to an unrestricted registration that Applicant's registration would not and should not be entitled to. Given that a significant purpose of the register is to provide the public with notice of the extent of actual or presumptive trademark rights, Applicant's registration would be misleading." 117 USPQ2d 1958, 1965 (TTAB 2016).

As in *In Re Bay State Brewing Co.*, the restrictions stipulated in the CA are absent from the identification of goods in the application and registration. This fails to reflect marketplace realities imparting greater protection to the applicant/registrant than is agreed upon in the CA, and fails to provide notice to others as to the true nature of the mark and goods. Consequently, this provision is misleading and should be disregarded.

In addition, the goods of the parties' as identified in the CA overlap in the marketplace, with the potential for same average consumer to encounter both the Applicant's goods and Registrant's goods with the mistaken belief that they are related or somehow affiliated. Exhibit A shows that shallow water fishing boats and multihull boats are manufactured by the same entities, Exhibit B shows that retailers of shallow water fishing boats also sell multihull boats, and Exhibit C shows that multihull boats are frequently offered as a shallow water fishing boat, and that hybrid vessels are sold having the characteristics of a catamaran yet are able to fish in shallower waters. Clearly the terms of the CA are incompatible and at odds with the evidence of record. The reality is that multihull boats, such as catamarans and pontoons, often include shallow water fishing boats, that they are manufactured by the same entities, and that they are offered in the same channels of commerce to the same consumers. As such, this provision is inaccurate and should be disregarded.

### ***Consumer Sophistication***

As stated above, even sophisticated purchasers are not immune from source confusion, especially in cases such as the present one involving identical marks and closely related goods. The conclusion in the CA that likelihood of confusion is unlikely because the average consumer is knowledgeable and sophisticated is not persuasive. All consumers do not exercise the same degree of care in their purchasing decision, and given that highly similar marks are used on closely related goods, it is likely that the average consumer may be confused as to the source or origin of goods to be purchased in retail and resale environments.

### ***Lack of Actual Confusion***

The conclusion in the CA that there is no likelihood of confusion based upon the parties being unaware of any actual confusion is not persuasive. Knowledge about instances of actual confusion is after-the-fact and undermines the purpose and use of trademarks. After-the-fact knowledge does not

address instances of initial actual confusion nor instances of a likelihood of confusion. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984); TMEP §1207.01(d)(ii).

In summary, as in *In Re Bay State Brewing Co.*, and for the reasons set forth above, the terms of the CA are inaccurate or legally insignificant and cannot be fulfilled by the current application, and it should therefore not be entitled to significant weight. The undertakings of the parties do not reflect the reality that virtually identical marks on identical and closely related goods would be likely to cause confusion.

### **CONCLUSION**

Applicant's mark shares the same overall sound, appearance, meaning and commercial impression as Registrant's marks. Specifically, the arbitrary and distinctive wording DRAGONFLY dominates both Applicant's mark and Registrant's marks. It is the sole component of the marks in the application and U.S. Registration 3475967, and dominantly displayed and reinforced by an image of a dragonfly in U.S. Registration No. 3471075. In addition, Registrant's goods are closely related to Applicant's goods because they are legally identical, exist in the same channels of commerce and are available to the same end consumers. Consumers familiar with Registrant's marks, upon encountering Applicant's mark and goods, would likely mistakenly believe that Applicant's goods emanate from a common source or are somehow associated with Registrant.

For all of the foregoing reasons, the refusal to register Applicant's mark, because of a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052 (d), should be affirmed.

Respectfully submitted,



/VJ/

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