

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85627251
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In a final office action, mailing date March 25, 2013, the examining attorney continued to refuse registration based on a likelihood of confusion. For the reasons set forth below, Applicant respectfully requests that this application be reconsidered for registration on the Principal Register.</p> <p>1. <u>Likelihood of Confusion</u></p> <p>The examining attorney continues to note that there may be a likelihood of confusion under Section 2(d) of the Act between Applicant's mark and Registration Nos. 2927554 and 3579672. Applicant submits that there is no likelihood of confusion between Applicant's mark and the Registrations for the reasons discussed below.</p> <p>While the marks at issue are nearly identical, Applicant continues to assert that the registered goods and services, while all encompassed under the broad category of clothing, are not confusingly similar. Registration No. 2927554 is for the mark "SOLO" in a stylized form for "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats." It is owned by Semore, Inc., which according to its website, http://www.solojeansla.com/about/, sells men's designer jeans. Registration No. 3579672 is for the mark "SOLO" in a stylized form for "footwear." Applicant's mark is for "SOLO" for "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks."</p> <p>The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. <i>See, e.g., Paula Payne Prods.</i></p>	

Co. v. Johnson's Pub'g Co., 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) (“[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.”).

Mere use of identical marks, even if used in the same broad industry, does not demonstrate likelihood of confusion. *Id.*, see also *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201 (1st Cir. 1983). In *Astra*, applicant applied for registration of the mark “ASTRA” in connection with computerized blood analyzer machines and products associated therewith. Registrant had five active registrations for “ASTRA” in connection with pharmaceutical products and syringes. The Registrant sued for trademark infringement and the District Court’s dismissal of the suit on summary judgment was upheld by the Court of Appeals, who agreed that there was no likelihood of confusion of the source of the products, even though those products emanated from the same broad category of products used in the medical health field. *Id.* at 1205-1206.

Similarly, there is no likelihood of confusion as to the source of Applicant’s and Registrants’ respective goods. In fact, all three marks have peacefully coexisted for over five years. The first date of use for Applicant’s mark and Registration No. 3579672 is in 2008, and for Registration No. 2927554, the first date of use is in 2003.

Further, as Applicant has previously noted, the presence of multiple marks that use the word “solo” with regard to clothing, is evidence that “it is merely one of a crowd of marks.” 2 McCarthy on Trademarks, § 11:85 (4th ed. 2008). In such a crowd, consumers will not be confused between any two similar marks and may have learned to carefully pick out one from the other. *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385 (T.T.A.B. 1976). Such a finding applies to this case, as evidenced by the following list of registered marks which contain the term “solo” for goods in the broad category of clothing:

- LOBO SOLO, Registration No. 4358788, for “Clothing, namely, shirts, t-shirts, pants, shorts, and sweatshirts.”
- KORET SOLOS, Registration No. 2925465, for “Women's clothing, namely, blouses, skirts, shorts, skorts, pants, sweaters, tops, dresses, suits, vests, jackets and coats.”
- SOLO MODA (with MODA disclaimed), Registration No. 4307130, for “Clothing, in the nature of athletic, exercise, casual and outdoor winter clothing, namely, shirts,

trousers, pants, jackets, T-shirts, tops, coats, jerseys, belts, socks, sweaters, sweatshirts, vests, socks, blouses, dress suits, dresses; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms, coats; formalwear, namely, suits, dress suits, dresses, pants, shirts, blouses; loungewear, beachwear, rainwear, sleepwear, and undergarments.”

- SOLO THE CAT, Registration No. 3848218, for “Clothing and apparel, namely, hats, socks, and shirts.”

- SOLO NOVE, Registration No. 3423837, for “Clothing, namely, shirts, T-shirts, polo shirts, pants, trousers, sweaters, jump suits, tops, tank tops, halter tops, sweat pants, warm-up suits, jogging suits, blouses, skirts, dresses, blazers, turtlenecks, not sold through or associated with restaurants or food service establishments.”

- SOLOS KORET, Registration No. 2042095, for “women's clothing, namely, skirts, pants, shirts, jackets and tops.”

In addition, even where the marks are identical, if the goods or services in question are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then confusion is not likely. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties’ respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

While it is acknowledged that the Applicant’s goods and Registrants’ goods fall within the same broad category of clothing, they are indeed very different, are marketed to different consumers and are purchased by different consumers. Applicant’s goods are not sold at department or other casual clothing stores. Applicant’s specialized clothing can only be purchased through authorized dealers who specialize in selling snowmobile, motorcycle and ATV parts and clothing, or through Applicant’s

catalog and/or website, which is marketed to snowmobile, motorcycle and ATV enthusiasts.

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). The examining attorney has not met his burden in this case.

Finally, the facts in each case vary and the weight to be given each relevant *du Pont* factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (regarding alcoholic beverages); *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171–72 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (regarding clothing).

For example, in *In re British Bulldog, supra*, in a “close” call, the Board reversed the refusal to register the design mark “PLAYERS” for men’s underwear based on a likelihood of confusion with an existing registration for the mark “PLAYERS” for shoes. The Board noted that while “it is true that the goods in question, namely, men's underwear and shoes, are items of wearing apparel to be sold in the same stores to the same classes of purchasers,” “they are distinctly different when sold in the same stores” in terms of their placement in the store and how each product is purchased, i.e., underwear is an “off-the-shelf” item whereas shoes are typically purchased with the assistance of a salesperson. *Id.* at 856.

In sum, there is no likelihood of confusion sufficient to prevent registration of Applicant’s mark. Based upon the marked and distinct differences between Applicant’s goods and Registrants’ goods, the fact that they travel in different trade channels and the fact that they are marketed and sold to different, sophisticated purchasers, Applicant respectfully requests the examining attorney reconsider the allowance of this application on the Principal Register.

In light of Applicant’s submission above, Applicant respectfully requests the examining attorney to

allow
registration of Applicant's mark on the Principal Register.

SIGNATURE SECTION

RESPONSE SIGNATURE /Kimberly A. Berger/

SIGNATORY'S NAME Kimberly A. Berger

SIGNATORY'S POSITION Attorney of record

SIGNATORY'S PHONE NUMBER 3134967912

DATE SIGNED 09/25/2013

AUTHORIZED SIGNATORY YES

CONCURRENT APPEAL NOTICE FILED NO

FILING INFORMATION SECTION

SUBMIT DATE Wed Sep 25 15:21:51 EDT 2013

TEAS STAMP
USPTO/RFR-10.1.8.31-20130
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**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85627251** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

In a final office action, mailing date March 25, 2013, the examining attorney continued to refuse registration based on a likelihood of confusion. For the reasons set forth below, Applicant respectfully requests that this application be reconsidered for registration on the Principal Register.

1. Likelihood of Confusion

The examining attorney continues to note that there may be a likelihood of confusion under Section 2(d) of the Act between Applicant's mark and Registration Nos. 2927554 and 3579672. Applicant submits that there is no likelihood of confusion between Applicant's mark and the Registrations for the reasons discussed below.

While the marks at issue are nearly identical, Applicant continues to assert that the registered goods and services, while all encompassed under the broad category of clothing, are not confusingly similar. Registration No. 2927554 is for the mark "SOLO" in a stylized form for "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats." It is owned by Semore, Inc., which according to its website, <http://www.solojeansla.com/about/>, sells men's designer jeans. Registration No. 3579672 is for the mark "SOLO" in a stylized form for "footwear." Applicant's mark is for "SOLO" for "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks."

The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. *See, e.g., Paula Payne Prods. Co. v. Johnson's Pub'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.").

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In light of Applicant's submission above, Applicant respectfully requests the examining attorney to allow registration of Applicant's mark on the Principal Register.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Kimberly A. Berger/ Date: 09/25/2013

Signatory's Name: Kimberly A. Berger

Signatory's Position: Attorney of record

Signatory's Phone Number: 3134967912

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85627251

Internet Transmission Date: Wed Sep 25 15:21:51 EDT 2013

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