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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85627379
Applicant	Hughes Furniture Industries, Inc.
Applied for Mark	H HUGHES FURNITURE MOTION EAZE RECLINERS
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Date	07/16/2014

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Serial Number	:	85627379
Mark	:	H HUGHES FURNITURE MOTION EAZE RECLINERS
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Filing Date	:	May 16, 2012
Examining Attorney	:	Alicia Collins Edwards Law Office 115

EX PARTE APPEAL

APPLICANT'S REPLY BRIEF IN RESPONSE TO EXAMINING ATTORNEY'S APPEAL BRIEF

COMES NOW the Applicant, Hughes Furniture Industries ("Hughes Furniture" or "Applicant"), by Counsel, and hereby respectfully submits this Reply Brief in further support of Hughes Furniture's timely filed appeal from the Final Office Action dated April 23, 2013 finally refusing registration of Applicant's mark H HUGHES FURNITURE MOTION EAZE RECLINERS in the following stylized format as applied to furniture ("Applicant's Mark"):

Applicant's Mark has been refused registration pursuant to Section 2(d) of the Trademark Act on the basis of likelihood of confusion with Registration No. 3916977 for the mark BRADLEY HUGHES for residential and commercial furniture (the "Cited Mark").

Applicant maintains that confusion is not likely between Applicant's Mark and the Cited Mark, since, among other things, Applicant's Mark creates a drastically different commercial impression than the Cited Registration, Applicant's Mark includes its own trademark of MOTION EAZE (Principal Register - Registration No. 4038175), the goods and channels of trade are not closely related, and the sophistication of the consumers buying the goods associated with Applicant's Mark and the Cited Mark. Based on the foregoing, it is respectfully submitted that the refusal to register Applicant's Mark should be reversed.

ARGUMENT

A. THE EXAMINING ATTORNEY'S ADDITIONAL EVIDENCE SUBMITTED ON FEBRUARY 2, 2014 SHOULD BE EXCLUDED FROM THE RECORD.

On September 23, 2013, Applicant filed the instant Appeal to the Board. Applicant did not file a request for reconsideration with the Examining Attorney at that time or indicate that a request for reconsideration had previously been filed. On December 23, 2013, Applicant filed its Appeal Brief as well as a Request for Remand and Amendment pursuant to TBMP § 1205 in which Applicant requested that the application's disclaimer be amended to include language proposed by the Examining Attorney. On January 8, 2014, the Board granted the request for remand, suspended the instant appeal, and remanded the application to the Examining Attorney for the consideration of the proposed disclaimer amendment. On February 2, 2014, the Examining Attorney filed a document entitled "Request for Reconsideration Denied" in this proceeding whereby the Examining Attorney renewed the refusal to the registration of Applicant's Mark on the basis of the remaining likelihood of confusion objection. In connection with that filing, the Examining Attorney submitted additional evidentiary material in support of the refusal.

TBMP § 1207.01 states that the evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board and that additional evidence filed after appeal normally will be given no consideration by the Board. *See* TBMP § 1207.01. Applicant understands a timely filed Request to Remand for Additional Evidence pursuant to TBMP § 1207.02 or a timely filed Request for Reconsideration pursuant to TMEP § 715.03 are means by which additional evidence may be submitted into the record. Applicant respectfully submits that neither a Request to Remand for Additional Evidence nor a Request for Reconsideration was ever filed by Applicant in this proceeding and the Examining Attorney's "Request for

Reconsideration Denied" was not in response to any request of Applicant. The Examining Attorney's Brief states that "[a]fter the Trademark Examining Attorney's Final Refusal on the likelihood of confusion issue and disclaimer requirement, the Applicant submitted a Request for Reconsideration and a Notice of Appeal. The Applicant's Request for Reconsideration was in the form of an Appeal Brief." (Examining Attorney's Brief, 2). Applicant made no such Request for Reconsideration and the record should exclude the additional evidentiary materials submitted on February 2, 2014 as they are additional materials submitted after the timely filing of Applicant's appeal.

B. ANALYSIS

As previously discussed in Applicant's Appeal Brief, the following *DuPont* factors are highly relevant to this application:

> (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
>
> (2) The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use;
>
> (3) The similarity or dissimilarity of established, likely-to-continue trade channels; and
>
> (4) The conditions under which and buyers to whom sales are made, *i.e.*, "impulse" vs. careful, sophisticated purchasing;

See E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

1. Applicant's and Registrant's Mark Create a Drastically Different Overall Commercial Impression

Applicant's Mark, a design mark consisting of over ten literal and design elements, cannot be reasonably construed as having a similar commercial impression as the Cited Mark, a standard character mark containing two literal terms—BRADLEY and HUGHES. As the

Examining Attorney notes, the marks are to be compared in their entireties under a Section 2(d) refusal. See T.M.E.P. § 1207.01(b). Applicant respectfully submits that the drastically different commercial impression created by Applicant's Mark and the Cited Mark when the two marks are compared is the most probative of the *DuPont* factors. See Kellogg Co. v. Pack 'em Enters., Inc., 951 F.2d 330, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991) (affirming Board's holding that the dissimilarity of the marks – FROOTEE ICE and FROOT LOOPS – was dispositive, reasoning "We know of no reason why, in a particular case, a single DuPont factor may not be dispositive"). The Examining Attorney suggests that marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark; however, every case the Examining Attorney cites in support of that contention involved a comparison of simple marks with only minor variation.[1] (Examining Attorney's Brief, 5). Applicant submits that the instant appeal involves marks that differ by far more than a few letters.

The Examining Attorney goes to great lengths to dissect Applicant's Mark into its technical components in an attempt to reinforce the Examining Attorney's unsubstantiated belief that "HUGHES" is the only important element of Applicant's Mark. This stands in contrast to the longstanding principle that marks should be compared in their entireties. In fact, dissection and piecemeal analysis are looked upon with disfavor. See Jet, Inc. v. Sewage Aeration Sys., 165 F.3d 419, 49 U.S.P.Q.2d 1355, 1359 (6th Cir. 1999) ("[T]he 'anti-dissection rule' … serves to remind courts not to focus only on the prominent features of the mark, or only on those features that are prominent for purposes of the litigation, but on the mark in its totality."); see

[1] COMMCASH and COMMUNICASH; 21 CLUB and "21" CLUB; CONFIRM and CONFIRMCELLS; COLLEGIAN OF CALIFORNIA and COLLEGIENNE; MILTRON and MILLTRONICS; and LUTEXAL and LUTEX.

also Forschner Grp., Inc. v. Arrow Trading Co., 124 F.3d 402, 409 (2d Cir. 1997) ("[W]e are not so much concerned with dissecting the competing trade dress and enumerating discrete points of similarity, but rather we focus on the overall image created."). "The commercial impression of a trademark is derived from it as a whole, not from elements separated and considered in detail." Opryland USA, Inc. v. Great Am. Music Show Inc., 970 F.2d 847, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992) (quoting Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 545-46 (1920)). Furthermore, the consuming public cannot be assumed to understand the nuances of trademark common law and ignore portions of Applicant's Mark that the Examining Attorney considers suggestive, descriptive, or disclaimed. See In re Nat'l Data Corp., 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) ("The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO."); see also In re Johnson Prods. Co., 220 U.S.P.Q. 539, 540 (TTAB 1983) ("studied analysis" of marks unlikely to occur in marketplace).

While the Examining Attorney's arguments may have been persuasive if the Cited Mark consisted only of "HUGHES," the first word encountered by a consumer with respect to the Cited Mark is "BRADLEY" – a distinctive term in and of itself. The first part of a mark, especially if distinctive, is most likely to catch the eye and ear and make an impression on the purchaser's mind. See Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). Applicant suggests that the term "BRADLEY," the first word encountered by a consumer, leaves a lasting impression on the consumer, much more so

than the term "HUGHES" which appears secondary to "BRADLEY."[2] Applicant respectfully submits that a true comparison of the marks under the traditional sight, sound and meaning test, as described in great detail in Applicant's Appeal Brief, reveals the commercial impression of the two marks at issue is significantly different and this factor weighs heavily in favor of Applicant.

Applicant also reiterates that it owns a U.S. Trademark Registration for the standard character trademark "MOTION EAZE," which registered on October 11, 2011. Applicant's Mark contains, in its entirety, the "MOTION EAZE" trademark. The Examining Attorney offers no support in opposition to the contention that the inclusion of "MOTION EAZE" into Applicant's Mark prevents a likelihood of confusion with the Cited Mark; however, Applicant further notes that it is not relying solely on the inclusion of "MOTION EAZE" to obviate the refusal based on likelihood of confusion. The Examining Attorney does not refute Applicant's position that the overall commercial impression of "MOTION EAZE" relates directly to Applicant and that its inclusion into Applicant's Mark assists consumers in associating Applicant's Mark with Applicant, and not with the owner of the Cited Mark. As previously mentioned, Applicant's Mark will always include Applicant's "MOTION EAZE" trademark in its entirety.

2. Hughes Furniture's and Registrant's Goods are Different and Cannot be Generalized

The Examining Attorney suggests that because Applicant's Mark and the Cited Mark are necessarily similar because both relate to "furniture." This oversimplifies and generalizes the

[2] As mentioned in Applicant's prior Responses and Appeal Brief, the owner of the Cited Mark has rebranded to simply using "BRADLEY" while dropping the "HUGHES" component, indicating that even the owner of the Cited Mark believes "BRADLEY" to be the dominant portion of the Cited Mark.

goods description and suggests that the owner of the Cited Mark has a monopoly right in the Cited Mark over any and all goods that may fit in the generalized furniture category. The Examining Attorney does not refute Applicant's argument that the issue of relatedness of goods and services relates specifically to consumer expectations. The fact that both Applicant and Registrant's goods relate to furniture which can be categorized as the same "industry" does not in and of itself provide sufficient basis for finding the goods related. See Yankee Publ'g, Inc. v. News Am. Publ'g, Inc., 809 F.Supp. 267, 25 U.S.P.Q.2d 1752, 1757 (S.D.N.Y. 1992) (rejecting identification of both parties' goods simply as "magazines"; "This is … too crude a characterization"); Safeguard Bus. Sys., Inc. v. New England Bus. Sys., 696 F.Supp. 1041, 9 U.S.P.Q.2d 1051, 1055 (E.D. Pa. 1988) (similarity in one, generalized aspect may not be enough if otherwise the goods are "plainly different things, different in size, shape, concept, purpose, appearance, and price"). Simply because products may fall into the same general category does not automatically mean they are related. See H.D. Lee Co. v. Maidenform, Inc., 87 U.S.P.Q.2d 1715, 1723 (TTAB 2008) (clothing); Mason Tackle Co. v. Victor United, Inc., 216 U.S.P.Q. 197, 203 (C.D. Cal. 1982) (sporting goods); Astra Pharm. Prods., Inc. v. Beckham Instruments, Inc., 718 F.2d 1201, 220 U.S.P.Q. 786, 790, 792 (1st Cir. 1983).

The actual goods, as described in the materials within this record and in Applicant's Appeal Brief, of Applicant and the owner of the Cited Mark vary significantly, are marketed differently, and appeal to significantly different segments of the consumer population, and, as such, are clearly dissimilar. The Examining Attorney has offered no evidence of goods similarity other than indicating Applicant's and Registrant's goods co-exist in the same broad market industry. The Board has held that to be insufficient reasoning and this factor, therefore, strongly favors the Applicant.

3. Purchasers of Hughes Furniture's and Registrant's Goods are Sophisticated Consumers

Applicant respectfully disagrees with the Examining Attorney's position that Applicant's position with respect to customer sophistication is based on merely "self-serving statements." Applicant has proffered detailed comparisons of the goods of the Applicant and the goods of the owner of the Cited Mark. The goods in question are not chewing gum or some other fairly inexpensive disposable product. Rather, they are expensive pieces of home décor that a consumer is unlikely to regularly purchase.

The custom nature of the goods related to the Cited Mark evidence a sophisticated consumer with a discerning eye as to what he or she wants and who is likely to have done extensive research into their purchase. This stands in stark contrast to the goods of the Applicant which are widely available to the consuming public and not restricted as the goods of the Cited Mark are, as discussed in Applicant's Appeal Brief. The relevant inquiry is whether "the conditions surrounding [the goods'] marketing are such that they would be encountered by the **same** purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source." In re Total Quality Group, Inc., 51 U.S.P.Q.2d 1474, 1476 (TTAB 1999) (emphasis added). The Examining Attorney has not refuted Applicant's position that the respective buyers of the goods at issue will likely never encounter each other by the very nature of the significant differences in the goods of Applicant and of the owner of the Cited Mark. Further, the Examining Attorney has not refuted Applicant's argument with respect to the pricing of the goods in question and that a higher price would generally make a consumer more careful of their purchase. It cannot be reasonably argued that custom-made furniture (or even manufactured furniture) is an inexpensive impulse-buy type of item. See Weiss Assocs., Inc. v. HRL Assocs., Inc., 902 F.2d 1546, 1548, 14 U.S.P.Q.2d 1840, 1841 (Fed. Cir. 1990) (in making

purchasing decisions regarding expensive goods, "the reasonably prudent person standard is elevated to the standard of the 'discriminating purchaser'").

CONCLUSION

Based on the foregoing, as well as Applicant's initial Appeal Brief, it is respectfully submitted that the refusal to register Applicant's Mark based on the Cited Mark should be reversed, and Applicant's Mark should proceed to the publication phase of the application process.

Respectfully submitted, this the 16th day of July, 2014.

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