

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86782228
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION	
MARK	WATCH OUT WATCHES
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1739019377-20161006171156818535_. Watch Out Watches Response.pdf
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT17\IMAGEOUT17\867\822\86782228\xml3\RFR0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\867\822\86782228\xml3\RFR0003.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\867\822\86782228\xml3\RFR0004.JPG
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	\\TICRS\EXPORT17\IMAGEOUT17\867\822\86782228\xml3\RFR0007.JPG
DESCRIPTION OF EVIDENCE FILE	Legal argument in favor of registration
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	014
DESCRIPTION	Watches
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	014
TRACKED TEXT DESCRIPTION	
Watches ; Personal protective watches with personal safety alarm system, not including watch bands and straps	
FINAL DESCRIPTION	
Personal protective watches with personal safety alarm system, not including watch bands and straps	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/kevinkeener/

SIGNATORY'S NAME	Kevin Keener
SIGNATORY'S POSITION	Attorney of record, Illinois bar member
SIGNATORY'S PHONE NUMBER	3125232164
DATE SIGNED	10/06/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Oct 06 17:14:53 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XX.XXX.XX-2 0161006171453420199-86782 228-570bc2d6ceae9cff4e11c 7afdf3a1ea6ca153d515e64af a227b93858625aca1f22-N/A- N/A-20161006171156818535

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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86782228** WATCH OUT WATCHES(Standard Characters, see) has been amended as follows:

EVIDENCE

Evidence in the nature of Legal argument in favor of registration has been attached.

Original PDF file:

[evi_1739019377-20161006171156818535_-_Watch_Out_Watches_Response.pdf](#)

Converted PDF file(s) (6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 014 for Watches

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: [Watches; Personal protective watches with personal safety alarm system, not including watch bands and straps](#)

Class 014 for Personal protective watches with personal safety alarm system, not including watch bands and straps

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /kevinkeener/ Date: 10/06/2016

Signatory's Name: Kevin Keener

Signatory's Position: Attorney of record, Illinois bar member

Signatory's Phone Number: 3125232164

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 86782228

Internet Transmission Date: Thu Oct 06 17:14:53 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XXX.XX-2016100617145342

0199-86782228-570bc2d6ceae9cff4e11c7afdf

3a1ea6ca153d515e64afa227b93858625aca1f22

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RESPONSE TO OFFICE ACTION

I. INTRODUCTION

Applicant responds to Examiner's final rejection of its mark for WATCH OUT WATCHES. For the reasons set forth herein there is no likelihood of confusion between Applicant's mark and the cited registration.

II. APPLICANT'S MARK MUST BE CONSIDERED IN ITS ENTIRETY

"[T]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety...." In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1345- 46, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001) (quoting Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 545- 46, 40 S.Ct. 414 (1920); see also China Healthways Inst., Inc. v. Wang, 491 F.3d 1337, 1340, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007) ("[t]he marks must be compared in their entirety, at least when the overall commercial impression is reasonably based on the entirety of the marks").

Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. See, e.g., In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570-71, 218 USPQ 390, 395 (Fed. Cir. 1983); see also TMEP §1207.01(b)(iii). However, the fundamental rule in this situation is that the marks must be considered **in their entireties**. See In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); Massey Junior Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (C.C.P.A. 1974) (emphasis added).

The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. See, *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (holding VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause confusion); See TMEP 1207.01(c)(ii).

In this matter, Applicant's mark is WATCH OUT WATCHES. Although WATCHES is descriptive of Applicant's products, Applicant's mark is the complete phrase WATCH OUT WATCHES. Instead of considering the entirety of Applicant's mark, the Examining Attorney improperly dissected the mark, applying a mechanical rule to determine that Applicant's mark had a dominant feature. Applicant asserts that the entirety of Applicant's mark should be considered.

III. APPLICANT'S MARK HAS A DIFFERENT CONNOTATION THAN THE CITED MARK

The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. See, e.g., *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause

confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); In re Sydel Lingerie Co., 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

In this case, Applicant's mark creates a separate and distinct connotation from the cited registration. Applicant's mark is WATCH OUT WATCHES. When applied to Applicant's goods of "Personal protective watches with personal safety alarm system, not including watch bands and straps," Applicant's mark creates the distinct connotation that WATCH OUT means BEWARE or TAKE HEED, particularly given that Applicant's goods provide a personal safety alarm. In contrast, the cited registration of WATCHOUT!, when applied to watch bands and straps, has the connotation that the product is just a band and does not include a watch- that Registrant's goods are so distinct the value of the band to the consumer is greater than the value of the timepiece (which is contrary to the standard reason for wearing a wristwatch). Therefore, Applicant's mark creates a distinct and separate connotation than the cited mark. For this reason there is no likelihood of confusion between the marks.

IV. APPLICANT'S GOODS ARE DIFFERENT THAN THOSE COVERED BY THE CITED MARK

If the goods or services in question are not related or 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, even if the marks are identical,

confusion is not likely. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *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); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *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). See TMEP 1207.01(a)(i).

Furthermore, the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. See, e.g., *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed.

Cir. 2014). If the cited registration describes goods or services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. See, e.g., *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). Similarly, there may be a likelihood of confusion where an applicant identifies its goods or services so broadly that the identification encompasses the goods or services identified in the registration of a similar mark. See, e.g., *In re Fiesta Palms LLC*, 85 USPQ2d 1360 (TTAB 2007) (holding CLUB PALMS MVP for casino services, and MVP for casino services offered to preferred customers identified by special identification cards, likely to cause confusion); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (holding RESPONSE for banking services, and RESPONSE CARD for banking services rendered through 24-hour teller machines, likely to cause confusion).

In this case the Applicant has amended its description of goods to “Personal protective watches with personal safety alarm system, not including watch bands and straps.” By contrast the cited registration covers “watch bands and straps.” There is no overlap between Applicant’s goods and the goods of the cited registration. Primarily, Applicant has amended its description to narrow the scope of coverage of Applicant’s goods so that its identification does not encompass the goods of the cited registration. In addition, Applicant has explicitly removed the goods of the cited registration from the description of goods in the current application. Therefore, there is no overlap between the goods of the cited registration and Applicant’s goods. Because there is no overlap then there is no likelihood of confusion.

V. CONCLUSION

For the reasons set forth herein, Applicant asserts that there is no likelihood of confusion between Applicant's mark and the cited registration. Applicant respectfully requests that the rejection be removed and the Applicant's mark be allowed to proceed to publication.

Respectfully Submitted,

/kevinkeener/

Kevin Keener

Attorney for Applicant