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

Proceeding	77531925
Applicant	Hunter Douglas Industries Switzerland Gm
Applied for Mark	WHISPER DRIVE
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Submission	Appeal Brief
Attachments	WHISPER DRIVE _CL 9_ Appeal Brief before TTAB for Hunter Douglas Industries Switzerland GmbH.pdf (8 pages)(32720 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

Applicant:	Hunter Douglas Industries Switzerland GmbH
Serial No.:	77/531,925
Filing Date:	July 25, 2008
Mark:	WHISPER DRIVE
Examining Attorney:	Jeffrey S. DeFord
Law Office:	115

Applicant respectfully requests that the Trademark Trial and Appeal Board (the "Board") reverse the Examining Attorney's refusal to register the above identified mark under Trademark Act Section 2 (d) based on a likelihood of confusion with the marks in U.S. Registration Nos. 3621796 and 3549430 for, respectively, WHISPERTRAC and WHISPERSHADE ("Cited Marks").

The sole issue before the Board is whether or not Applicant's mark is likely to be confused with the Cited Marks.

Applicant respectfully asserts that the differences between Applicant's mark and the Cited Marks are more than sufficient to avoid a likelihood of confusion. Applicant's position is supported by the peaceful coexistence of Applicant's "Whisper" marks with the Cited Marks for more than six years in the marketplace and by the United States Patent and Trademark Office's (USPTO) previous decisions to allow Applicant's registered mark WHISPER AUTOMATION to coexist with the Cited Marks. Applicant believes that the Examining Attorney's refusal is not only inconsistent with the USPTO's own prior rulings, but is colored by reliance on the theory that the

Cited Marks are part of a family of marks, which is clearly erroneous under the TMEP. Accordingly, the refusal to register under Trademark Act Section 2(d) should be withdrawn.

A. Comparison of the Marks

Applicant respectfully asserts that its WHISPER DRIVE mark is sufficiently dissimilar in appearance and sound from the Cited Marks that confusion between them is unlikely. Applicant further asserts that the Examining Attorney errored by arguing that the Cited Marks are part of a family of marks, and that Applicant's mark would erroneously be viewed by prospective purchasers as being part of such family of marks. Applicant maintains that the Examining Attorney, by erroneously concluding that the Cited Marks are part of a family of marks, accorded the Cited Marks with a broader scope of rights than should have been the case. Essentially, the Examining Attorney has limited his analysis of the marks solely to the word "Whisper" and has disregarded the other elements in both the Cited Marks and Applicant's mark.

1. The Cited Marks do not Constitute a Family of Marks

The Examining Attorney has stated that "the registrant has a family of WHISPER marks and it appears that the applicant's similar mark is part of the family as it conveys the same overall commercial impression as the marks of the registrant." Applicant respectfully asserts that the Examining Attorney is not only without evidence to establish that a family of marks exists in the present case, but errored in attempting to establish such a family of marks. TMEP Section 1207.01(d)(xi) specifically states that Examining Attorneys should specifically refrain from invoking the family of marks doctrine in a likelihood of confusion analysis, because the Examining Attorney does not have access to evidence and information needed to establish

whether or not a family of marks exists. *In re Mobay Chemical Co.*, 166 USPQ 218 (TTAB 1970).

By invoking the family of marks doctrine, Applicant maintains that the Examining Attorney limited his analysis of the marks to solely the common term "Whisper" and disregarded the important, distinguishing terms "Shade" and "Trac" in the Cited Marks and the term "Drive" in Applicant's mark. In essence, the Examining Attorney accorded the Cited Marks a broader scope of protection than should have been the case. When Applicant's mark is compared to the full Cited Marks (and not just to the term "Whisper" in the Cited Marks), the differences in appearance and soundn are sufficient to avoid a likelihood of confusion.

2. Marks Differ in Appearance

Applicant's mark consists of the readily discernable words "Whisper" and "Drive" with a space between each word, and no additional wording or design element. The Cited Marks, by contrast, are unitary marks that are a combination of the word "Whisper" and the words "Shade" or "Trac" respectively.

Applicant disagrees with the Examining Attorney's unsupported conclusion that the term "Whisper" is the dominant portion of the respective marks, and maintains that the Examining Attorney errored in not giving sufficient weight in his analysis of the marks to the terms "Shade" and "Trac" in the Cited Marks, and the word "Drive" in Applicant's mark. *Glenmore Distilleries Co. v. National Distillers Products Corp.,* 101 F.2d 479, 40 U.S.P.Q. 264 (4th Cir. 1939), cert. denied, 307 U.S. 632, 83 L.Ed. 1515, 59 S.CT. 835, 41 U.S.P.Q. 799 (1939) ("It is impossible to

lay down a general rule that either word in an established trade mark of two words is of such importance that its use in other combinations on the same kind of goods would constitute infringement."); *Mr. Travel, Inc. v. V.I.P. Travel Services, Inc.*, 286 F. Supp. 958, 153 U.S.P.Q. 18 (N.D. Ill. 1966), aff'd, 385 F.2d 420, 155 U.S.P.Q.231 (7th Cir. 1967) (rejects any "first part is dominant" rule).

The combination of the word "Whisper" and the words "Shade" or "Trac" (without a space between each word) in the Cited Marks, create visually unique and distinctive looking marks that, at first glance, would not be recognized as a combination of two ordinary words, but rather as an inventive, fanciful marks. Applicant maintains that when the respective marks are viewed in their entireties, the visual differences are great and sufficient to avoid a likelihood of confusion.

3. Marks Differ in Sound

Applicant's two word WHISPER DRIVE mark has only one pronunciation that is immediately apparent upon initial view. By contrast, the lack of a space between the word "Whisper" and the words "Shade" or "Trac" in the Cited Marks results in multi-syllabic unitary marks whose pronunciations are not so readily apparent, but nevertheless are sufficiently different from the pronunciation of Applicant's WHISPER DRIVE mark. Applicant maintains that the differences in pronunciation of the respective marks further helps to avoid a likelihood of confusion between the marks.

B. Applicant and Registrant Peacefully Coexist in the Market Place

Applicant respectfully asserts that Applicant and the owner of the Cited Marks have peacefully coexisted in the market place for over six years, and on the Principal Register for nearly three years. As Applicant previously stated in the record for this mark, Applicant is not only the owner of the companion WHISPER mark, U.S. Serial No. 77/531829 but also the owner of the mark WHISPER AUTOMATION, U.S. Registration 35448145 that registered on December 9, 2008. Applicant notes that the cited mark WHISPERSHADE registered on December 23, 2008 and WHISPERTRAC registered on May 19, 2009. The USPTO had no problem permitting these marks to coexist on the Principal Register, and neither party opposed or otherwise objected to use of the marks in the marketplace by the other.

Applicant respectfully asserts that the lack of any opposition or cancellation proceeding filed against the WHISPER AUTOMATION mark or any infringement suit filed against Applicant's current WHISPER mark clearly establishes that the owner of the Cited Marks does not view Applicant's "Whisper" marks as likely to cause confusion with either of the Cited Marks. As such, this lack of action on the part of the owner of the Cited Marks constitutes implied consent.

The Examining Attorney, in refuting Applicant's position that implied consent exists, notes that Applicant cancellation proceeding against the Cited Marks was dismissed without prejudice and states that because of the results of the cancellation proceeding the "registrant did not believe that there was any implied consent or the Cancellation Proceeding would have been successful." Applicant respectfully asserts that the Examining Attorney is without knowledge to make such a conclusion because he is not privy to the reasons why Applicant withdrew the cancellation

proceeding. Applicant further notes that registrant consented to the cancellation proceeding being dismissed *without prejudice*, when it clearly could have withheld its consent resulting in the cancellation proceeding being dismissed *with prejudice.* Applicant again respectfully asserts that implied consent exists between Applicant and the owner of the Cited Marks.

C. Prior Decisions of the Trademark Office

Applicant is well aware that previous decisions of Examining Attorneys are not binding on the USPTO or the Board, however, in the present case, Applicant is at a loss to understand how the USPTO can now claim that Applicant's current WHISPER DRIVE mark is likely to be confused with the Cited Marks when the Cited Marks were found not to be confusingly similar to Applicant's prior registered WHISPER AUTOMATION mark; especially with the term AUTOMATION being disclaimed resulting in WHISPER being the dominant feature of the mark.

Based on the reasoning in the arguments presented by the Examining Attorney in the present case, one could argue that the Cited Marks are likely to be confused with Applicant's WHISPER AUTOMATION mark. This was clearly not the position taken by the USPTO when the Cited Marks were prosecuted, nor should it be the position taken by the USPTO in the present case.

In addition to Applicant's WHISPER DRIVE mark and the Cited Marks not being confusing similar, principles of equity compel the USPTO to allow Applicant's mark to be passed to publication in light of the USPTO's prior decision to allow the Cited Marks to coexist on the Principal Register with Applicant's previously registered WHISPER AUTOMATION mark. If the current refusal is maintained and the USPTO permitted to disregard its earlier decisions, then

Applicant and other trademark owners will be forced to conduct their legal activities based not upon business considerations but upon the USPTO's unpredictability. In the future, a trademark owner that does not consider another party's mark as likely to cause confusion with its own mark would be compelled to oppose it anyway. The trademark owner could not take the risk that by allowing the mark, it might someday be precluded from expanding its own brand due to USPTO decision-making.

Conclusion

In conclusion, Applicant respectfully asserts that its mark is not likely to cause confusion with either of the Cited Marks for all the reasons previously discussed. Based on the foregoing, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal and order the publication of this mark.

This the 15th day of October, 2011.

Respectfully submitted,

Michael J. Burke
Attorney for Applicant
Hunter Douglas Industries Switzerland GmbH

INDEX OF CITED CASES

1. *Glenmore Distilleries Co. v. National Distillers Products Corp.*, 101 F.2d 479, 40 U.S.P.Q. 264 (4th Cir. 1939), cert. denied, 307 U.S. 632, 83 L.Ed. 1515, 59 S.CT. 835, 41 U.S.P.Q. 799 (1939)

2. *In re Mobay Chemical Co.*, 166 USPQ 218 (TTAB 1970).

3. *Mr. Travel, Inc. v. V.I.P. Travel Services, Inc.*, 286 F. Supp. 958, 153 U.S.P.Q. 18 (N.D. Ill. 1966), aff'd, 385 F.2d 420, 155 U.S.P.Q.231 (7th Cir. 1967)