

ESTTA Tracking number: **ESTTA465999**

Filing date: **04/09/2012**

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

| | |
|------------------------|---|
| Proceeding | 77599349 |
| Applicant | Red Antler, Inc |
| Applied for Mark | RED ANTLER |
| Correspondence Address | Eric Adler Adler Vermillion & Skocilich, LLP 68 Jay St.STE 201 Brooklyn, NY 11201 UNITED STATES eric@adlervermillion.com |
| Submission | Appeal Brief |
| Attachments | RedAntlerAppealESTTA458035.pdf (17 pages)(1030983 bytes) |
| Filer's Name | Eric Adler |
| Filer's e-mail | eric@adlervermillion.com |
| Signature | /Eric Adler/ |
| Date | 04/09/2012 |

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------|------------------|
| Applicant | Red Antler, Inc. |
| Serial No. | 77599349 |
| Filed | October 23, 2008 |
| Mark | RED ANTLER |

Law Office 102
Examiner Mark Shiner

ESTTA Tracking No.: ESTTA458035
Notice of Appeal Filed: 02/22/2012

Applicant's Appeal Brief

Red Antler, Inc. seeks to register the word mark RED ANTLER on the principal register. Examiner refused the application under § 2(d) (likelihood of confusion), citing registration number 3,850,611 (the "Trophy Room Design").

Application

Cited Registration

RED
ANTLER

Red Antler, Inc.
Word Mark
For Creative Branding Services
Serial No. 77,599,349



First Drake, LLC d/b/a TrophyRoom.com
Design Mark (Without Color)
For Content Distribution Services
Reg. No. 3,850,611

The issue is whether a theory of "word-picture equivalence" between the two marks above provides an exception to the general rule of dissimilarity between word and designs. This brief argues that the exception is inapplicable, and that there is no likelihood of confusion.

Table of Contents

| | |
|--|----|
| Introduction | 3 |
| Facts..... | 4 |
| Argument..... | 5 |
| 1. Designs are Dissimilar to Words Unless the Two Marks are Concrete Legal Equivalents..... | 5 |
| a. Word-Picture Equivalence Does Not Apply to Abstract Designs. | 5 |
| b. Equivalence Requires the Design to be a “Concrete and Narrowly Focused” Representation of the Word. | 6 |
| c. Pronunciation Caselaw is Inapplicable. Consumers do Not “Call For” Design Marks. | 7 |
| 2. Du Pont Factors: the Marks are Readily Distinguishable. | 8 |
| a. Different Connotation: “Red Antler” is Fanciful and Suggests Creativity; the Cited Design Does Not. | 9 |
| b. The Cited Trophy Room Design is Not Red. | 10 |
| 3. <i>Du Pont</i> Factors: Services are Not Substitutes..... | 11 |
| a. Red Antler <i>Creates</i> , Trophy Room <i>Distributes</i> | 11 |
| b. Red Antler’s Clients are Discerning Consumers, Especially of Brand Identity..... | 13 |
| Conclusion..... | 13 |
| Index of Cases..... | 15 |
| Appendix A: Excerpt of <i>Hansen v. National Bev.</i> | 16 |
| Appendix B: Service Offerings Compared | 17 |

Introduction

Examiner has improperly refused Red Antler’s application. The word mark RED ANTLER is not likely to be confused with the cited design.

The general rule is that word marks and design marks are not similar: they are inherently different in appearance, in sound and commercial impression. There is little need to speculate about whether consumers translate from word to design. If particular words are important to the brand, these words should be registered. If the design is also important, the design should be registered.

Examiner’s theory of “word-picture equivalence” fails to provide an exception to the general rule. Word-picture equivalence is a legal standard requiring literal equivalence. The design must be a “concrete and narrowly focused” depiction of the word. But the cited Trophy Room Design is abstract—a box containing curving lines and points—not a concrete and narrowly focused representation of the words “Red Antler.”

Without this exception, there is no likelihood of confusion. But, even if the word-picture gap were bridged, the *du Pont* factors weigh against a finding of confusion:

- (1) **Different Services.** Red Antler provides *creative* services (like Mad Men); Trophy Room provides content *distribution* services (like NBC).
- (2) **Sophisticated Buyers.** Business professionals buy creative branding services. Impulse shoppers do not.
- (3) **Different Connotation.** As antlers are not normally red, “Red Antler” connotes creativity. Trophy Room’s registration is an abstract design. If anything, it connotes a hunting trophy.
- (4) Finally, the cited registration is simply **not red**.

Facts

Red Antler, Inc. has applied to register the work mark RED ANTLER. This is the name it has actually used in commerce for over 5 years. Red Antler is in the *creativity* business: it designs branding, logos and advertisements.

First Drake, LLC, doing business as Trophy Room, appears to own registered trademark number 3,850,611 (the “Trophy Room Design”). This design mark is a box containing branching lines terminating in points. It is claimed without color. Trophy Room is in the *distribution* business: it distributes advertising.

| Application | Cited Registration |
|--|--|
| <p>RED ANTLER</p> <p>Word Mark For Creative Services</p> |  <p>Design Claimed Without Color For Content Distribution</p> |

The following timeline is provided for convenience:

- 10/23/2008 Red Antler’s “Application”
- 2/23/2011 Examiner’s “First Refusal”
- 8/3/2011 Red Antler’s “First Response”
- 8/24/2011 Examiner’s “Final Rejection”
- 2/22/2012 Notice of Appeal Filed

Argument

1. Designs are Dissimilar to Words Unless the Two Marks are Concrete Legal Equivalents.

The general rule is that word marks are not likely to be confused with design marks. Words and designs are necessarily different in appearance, sound, and meaning. Unless similarity can be found under the doctrine of word-picture equivalence, the other *Du Pont* factors cannot overcome the word-picture distinction.

Word-picture equivalence “must not be literally and indiscriminately applied without regard to the particular marks.” *Spaulding Bakeries, Inc. v. Interstate Brands Corp.*, 209 USPQ 355 (TTAB 1980). A thorough factual analysis is needed. (picture of what might be an old mill not equivalent to the words “Old Mill”).

a. Word-Picture Equivalence Does Not Apply to Abstract Designs.

Abstract images may suggest thousands of words, but suggestion is not equivalence. *In re Serac, Inc.*, 218 USPQ 340 (TTAB 1983). In *Serac*, the Board held the word mark RAM’S HEAD was not likely to be confused with a stylized picture which might be a “ram’s head” because the picture was “too fanciful and abstract to call into play the doctrine of word/picture equivalents.” *Id.* at 341-42.



No Word-Picture Equivalence

The fact that Serac labeled its design as a “Ram Design” had no bearing on the outcome. *Id.* The Board held that even where applicant identified its design as “Ram Design,” consumers may regard the it as something else. *Id.*, see also, *Spaulding Bakeries*, 209 USPQ at 356 (picture of what might be an old mill not equivalent to the words OLD MILL).

Here, the cited Trophy Room Design is a monochrome rectangle of branching curves and points. Standing alone, it’s abstract. Like a Rorschach inkblot, any meaning is supplied by external context. When paired with the phrase “Trophy Room” it may be antlers, but when paired with “Garden Room,” it could be a leafless plant. If paired with “Hydrology Consultants” is would be a mountain stream. But pairing the design to any phrase is improper. *In re Serac, Inc.* Although the registration labels the design as “stylized antlers,” this label is for indexing convenience; it is not part of the mark. *Id.*


Examiner acknowledges, the abstract nature of the cited design: “it is impossible to determine how a consumer will interpret the [Trophy Room] design.” *Final Rejection*. Since the Trophy Room design is abstract, word-picture equivalence does not apply, and there can be no likelihood of confusion.

b. Equivalence Requires the Design to be a “Concrete and Narrowly Focused” Representation of the Word.

Word-picture equivalence applies only if the “word mark and its pictorial representation are concrete and narrowly focused.” *Hansen Beverage Co. v. National Beverage*, 493 F. 3d 1074, 1079 (9th Cir. 2007); see also, *Riceland Foods, Inc. v. Pac. E. Trading Corp.*, 26 USPQ.2d 1883, 1885 (TTAB 1993).

Hansen Beverage is instructive. In overturning a finding of confusing similarity, the 9th Circuit surveyed word-picture equivalency case law. *Excerpted in Exhibit A*. The court determined that the doctrine was limited to instances of concrete and narrowly focused equivalence. *Hansen Bev.* at 1079. Applying the

concrete and narrowly-focused standard, the court concludes “the word mark ‘MONSTER’ is so broad and ambiguous that consumers are unlikely to equate it with any particular image or symbol—much less an image as disembodied and stylized as the Freek Man.”

| National Beverage | Hansen Beverage |
|---|---|
|  | MONSTER |
| Freek Man - Design For Caffeinated Beverage | Monster - Word Mark For Caffeinated Beverage |

No Word-Picture Equivalence

Here, as in *Hansen Beverage*, the “concrete and narrowly focused” standard is not satisfied. Examiner has not shown that consumers equate the Trophy Room design with any particular image or symbol. In fact, examiner concedes that the very opposite: “it is impossible to determine how a consumer will interpret the design.” *Examiner’s Final Rejection*.

The cited Trophy Room design is an inkblot, not a concrete representation. If there is some tenuous relation between the cited design and the words “Red Antler”, it is not the narrowly-focused legal relationship of “equivalence.” Consumers reading the Red Antler word mark are not likely to think its associated with the cited design.

c. **Pronunciation Caselaw is Inapplicable. Consumers do Not “Call For” Design Marks.**

Pronunciation cases hold that sets of similar words cannot be differentiated by subtle variations in pronunciation. For example, TRUCOOL and TURCOOL in *Lamson Oil*; or ICE SHINE and I-SHINE in *Centraz v.*

Spartan. Here, applicant is not relying on subtle variations in pronunciation to distinguish its mark from the cited Trophy Room Design.

In fact, consumers will probably never vocalize the design at all. Design marks are used to identify goods by association, not to literally discuss them. People do not invite their friends to grab a coffee at “that green mermaid café.” It is hard to imagine *any* scenario (let alone a *likely* scenario) where a consumer would need to vocalize a company’s logo.

Examiner presents neither evidence nor caselaw for the assertion that consumers “will need to vocalize the design.” *Final Rejection*. Instead, To find confusion, Examiner relies on an analogy: “Much like with pronunciation, there is no correct way to interpret the design as it is impossible to determine how a consumer will interpret the design.” *Final Rejection*.

There is no need for analogy when word-picture equivalence provides a directly applicable analysis. That is, words and pictures are not similar unless the design is a “concrete and narrowly focused” representation of the word.

Since the narrow exception of word-picture equivalence does not apply, there can be no likelihood of confusion, and consideration of the *Du Pont* factors is unnecessary. However, if a full weighing of the likelihood of confusion factors is required, the scales tip in favor of allowing Applicant’s mark for registration.

2. Du Pont Factors: the Marks are Readily Distinguishable.

At the risk of belaboring: design marks are inherently dissimilar from word marks. Here, the two marks create different commercial impressions as well. If the cited Trophy Room Design evokes any impression, it’s the website’s theme of backwoods sportsmanship. In contrast, “Red Antler” suggests a creature of myth and fantasy. It evokes the firms vibrant creativity, not a weekend in the woods.

The comparison of service offerings is more nuanced. Both firms list “advertising.” But this is a broad category. It describes many types of services that cannot be substituted for one another. To find confusion, “is not sufficient that a particular term may be found which may broadly describe the goods.” *In re The W. W. Henry Co.*, 82 USPQ.2d 1213 (TTAB 2007).

a. **Different Connotation: “Red Antler” is Fanciful and Suggests Creativity; the Cited Design Does Not.**

Antlers are expected to come in a palate of muted earth tones. The phrase RED ANTLER sharply departs from expectation. It suggests the vibrant creativity of the Red Antler design firm, and its offering to create memorable brands and marketing campaigns.

According to the cited ‘611 mark, “Trophy Room is an online video destination and information source for hunters and fishermen.”



Trophy Room - 3,850,611 Mark,
Statement of Use, June 29, 2010, Page 10).

The difference between Applicant’s fanciful RED ANTLER imagery and the cited registration’s natural imagery weighs strongly against a finding of confusion.

b. The Cited Trophy Room Design is Not Red.

Trademarks rights spring from use in commerce. The Lanham Act’s very definition of “trademark” is a word or symbol “used by a person,” 15 USC §1127, and the right to register a mark flows from this use in commerce. *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1473, (Fed. Cir. 1987). A design without color claim may offer trademark protection against a similar design of a particular color. But claiming a design *without* color does not make it a red design. Examiner’s analysis distorts the principle:

Further, because the mark is without a color claim, the registrant can present its mark in any color, including the color red, *making the design a red antler.*

Final Rejection, p. 3 (emphasis added).

For the purposes of comparison, the design must be considered as it appears on the register, not as all possible color variations of the design. This is particularly true here, because the applied-for mark involves an unexpected color association.

Examiner’s theory would extend trademark protection first to all possible color combination, and then further to all words with a color connotation. Examiner must defend—not assume—this bold departure from the statutory principle of use-in-commerce. Instead, he cites no precedent.

Application of Data Packaging is the case often cited for similar color-related propositions. But if Examiner intended to rely on *Data Packaging*, his reliance would be misplaced. 453 F. 2d 1300 (CCPA 1972). *Data Packaging* held that product packaging in the form of “a narrow annular band mounted on the front reel flange” and “in a color which contrasts with the reel flange” was sufficiently specific to *function as a trademark. Id.* at 1301.

Data Packaging is inapplicable here for two reasons. First, the mark in *Data Packaging* involved detailed limitations on the color choice (annular bands

of contrasting colors). Second, the issue in *Data Packaging* was not confusion, but whether the mark was sufficiently definite for registration.

Likelihood of Confusion analysis must begin with the mark that exists on the register, not with conjecture as to how the mark might be used. Here, the cited Trophy Room Design is claimed without color. This weighs strongly against a finding of confusion.

3. *Du Pont* Factors: Services are Not Substitutes.

a. *Red Antler Creates, Trophy Room Distributes.*

The goods and services provided by Trophy Room and Red Antler are different. Although both work in the field of advertising, “it is not sufficient that a particular term may be found which may broadly describe the goods.” *In re The W.W. Henry Co.*, 82 USPQ.2d 1213 (TTAB 2007).

“Advertising” is a broad category of services, not a specific offering. Red Antler is an author; it *creates* advertising. Trophy Room is a publisher; it *distributes* advertising. The two companies work in the field of advertising, but their offerings do not satisfy the same need. When the lists of offerings are sorted into a table, the distinction is readily recognizable. *See Exhibit B.*

Examiner cites *Shen Mfg. Co. v. Ritz Hotel* for the proposition that closely related services require a lower showing of mark similarity, and conversely, unrelated services require a higher showing of similarity. 393 F.3d 1238, 73 USPQ.2d 1350, 1354 (Fed. Cir. 2004). The proposition is valid, but a review of the marks at issue in *Shen v. Ritz* highlights the flaws in Examiner’s analysis.

RITZ

for Kitchen Textiles

RITZ

for Cooking Classes

No Likelihood of Confusion: “aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from the same source.” *Id.*

In comparing identical “Ritz” marks, the Federal Circuit found no likelihood of confusion because the services (kitchen textiles vs. cooking classes) were unrelated. Even though kitchen textiles are used in cooking classes, the two are not likely to come from the same source. *Id.*

The same rationale applies here. Content providers (like Trophy Room) distribute the branding produced by creative agencies (like Red Antler). But the fact that an advertisement created by Red Antler could appear on TrophyRoom.com does not mean the services are closely related. *Id.* In fact, it suggests they are not substitutes at all. As in *Shen Mfg.*, there is no indication that the public would perceive the services as coming from the same source.

Shen v. Ritz continues, next comparing dissimilar marks on related goods. Again, the court finds no likelihood of confusion.

PUTTING ON
THE RITZ

for Shower Curtains

RITZ

for Bathroom Towels

No Likelihood of Confusion: “bathroom towels and shower curtains are related” but the “dissimilarity of the marks prevents a likelihood of confusion.” *Id.*

Here, even if the services are found related, the dissimilarity between the RED ANTLER word mark and Trophy Room design mark is greater than between RITZ and PUTTING ON THE RITZ.

b. Red Antler’s Clients are Discerning Consumers,
Especially of Brand Identity

Red Antler sells creative branding and communication services to sophisticated business owners. Examiner concludes, without evidence, that “regular consumers” also buy creative branding and advertising services. This is incorrect. “Regular consumers” (as opposed to business owners) have no products or services to sell and no brand to promote. They will never hire a creative branding agency. Only sophisticated business owners purchase creative branding services.

Not only are the relevant consumers sophisticated, they are particularly attuned to branding and brand identity. Since they are shopping for a creative advertising agency, branding issues are at the forefront of their minds. They are more likely to notice even small differences in service marks. This weighs against a finding of confusion.

Conclusion

Examiner’s narrative from the cited design to the words “red antler” requires three leaps of logic: (1) abstract lines to antlers, (2) monochrome to red, (3) picture with such hypothetical color scheme to words causing consumer confusion. But likelihood of confusion cannot be based on “pure conjecture or a fetching narrative.” *Libman Co. v. Vining Indus.*, 69 F.3d 1360 (7th Cir. 1995).

The marks are not similar. One is a phrase, the other an abstract and unrelated picture. The services are unrelated: one mark is for distribution, the other for creation. The relevant customers are sophisticated and attuned to branding. All of these factors weigh against a finding of confusion. The Red Antler application should be allowed for registration.

Respectfully Submitted,

Eric Adler

Eric Adler
Attorney for Applicant
Adler Vermillion & Skocilich, LLP
68 Jay St., Ste. 201
Brooklyn, NY 11201
347 620 5291
eric@adlervermillion.com

Index of Cases

Cases

| | |
|--|---------|
| <i>Application of Data Packaging Corp.</i> , 453 F. 2d 1300 (CCPA 1972)..... | 12 |
| <i>Centraz Indus. Inc. v. Spartan Chem. Co.</i> , 77 USPQ.2d 1698, 1701 (TTAB 2006)..... | 8 |
| <i>Hansen Beverage Co. v. National Beverage Corp.</i> , 493 F. 3d 1074, 1079 (9th Cir. 2007)..... | 7, 8 |
| <i>Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.</i> , 811 F.2d 1470, 1473, (Fed. Cir. 1987)..... | 11 |
| <i>In re E. I. du Pont de Nemours & Co.</i> , 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)..... | 3, 5, 9 |
| <i>In re Lamson Oil Co.</i> , 6 USPQ.2d 1041, 1042 n.3 (TTAB 1987)..... | 8 |
| <i>In re Serac, Inc.</i> , 218 USPQ 340 (TTAB 1983)..... | 5, 6 |
| <i>In re The W.W. Henry Co.</i> , 82 USPQ.2d 1213 (TTAB 2007)..... | 10, 12 |
| <i>Libman Co. v. Vining Indus.</i> , 69 F.3d 1360 (7th Cir. 1995)..... | 15 |
| <i>Riceland Foods, Inc. v. Pac. E. Trading Corp.</i> , 26 USPQ.2d 1883, 1885 (TTAB 1993)..... | 7 |
| <i>Shen Mfg. Co. v. Ritz Hotel Ltd.</i> , 393 F.3d 1238, 73 USPQ.2d 1350 (Fed. Cir. 2004)..... | 13 |
| <i>Spaulding Bakeries, Inc. v. Interstate Brands Corp.</i> , 209 USPQ 355 (TTAB 1980)..... | 5, 6 |



Statutes

| | |
|-------------------------------|----|
| Lanham Act, 15 USC §1127..... | 10 |
|-------------------------------|----|

Appendix A: Excerpt of *Hansen v. National Bev.*

Hansen Beverage Co. v. National Beverage Corp., 493 F. 3d 1074 - 9th Cir. 2007.

For similar reasons, we reject Hansen’s argument that the Freek Man is the picture-equivalent of the word mark “MONSTER.” Courts have applied the doctrine of word-picture equivalency only when the word mark and its pictorial representation are concrete and narrowly focused. In *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257 (2d Cir.1987), for instance, the Second Circuit held that the word mark “Pegasus” was the legal equivalent of Mobil’s flying horse logo. Similarly, in *Beer Nuts, Inc. v. King Nut Co.*, 477 *1080 F.2d 326 (6th Cir.1973), the Sixth Circuit affirmed the district court’s finding that a pictorial representation of nuts and a stein of beer had the same legal effect as the word mark “BEER NUTS.” *Id.* at 329; see also *Jockey Int’l, Inc. v. Butler*, 3 U.S.P.Q.2d 1607 (T.T.A.B. 1987) (picture of a jockey riding a horse held legally equivalent to word mark “JOCKEY”); *Squirrel Brand Co. v. Green Gables Inv. Co.*, 223 U.S.P.Q. 154 (T.T.A.B.1984) (picture of a squirrel held equivalent to word mark “SQUIRREL”). Here, in contrast, the word mark “MONSTER” is so broad and ambiguous that consumers are unlikely to equate it with any particular image or symbol — much less an image as disembodied and stylized as the Freek Man. See *Fisher Radio Corp. v. Bird Elec. Corp.*, 162 U.S.P.Q. 265, 266 (T.T.A.B.1969) (picture of a swallow-like bird held not equivalent to word mark “BIRD” because “the term ‘BIRD’ is a word which broadly encompasses an extremely wide range of feathered vertebrate...”). All told, when the sight, sound, and meaning of the two marks are evaluated in combination, it is clear that the marks overall, and as encountered in the marketplace, are not similar.

| National Beverage | Hansen Beverage |
|---|--|
|  |  |
| Freek Man - Design For Caffeinated Beverage | Monster - Word Mark For Caffeinated Beverage |
| No Word-Picture Equivalence | |

Appendix B: Service Offerings Compared

| Red Antler | Trophy Room |
|---|--|
| Content Creation | Content Distribution |
| <p>Advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information <i>and news</i> of third parties through print, audio, video, digital and on-line medium;</p> | <p>Advertising, <i>marketing, promotion</i> and publicity services, namely, promoting the goods, services, brand identity and commercial information of third parties through print, <i>electronic</i>, audio, video, digital and on-line media;</p> |
| <p>Advertising consultation;</p> | |
| <p>Advertising services, namely, creating corporate and brand identity for others;</p> | |
| <p>Advertising, marketing and promotion services;</p> | |
| <p>Brand concept and brand development services for corporate clients;</p> | |
| <p>Brand imagery consulting services;</p> | |
| <p>Business advice and analysis of markets;</p> | |
| <p>Business consultation and management regarding marketing activities and launching of new products;</p> | |
| <p>Business consulting services, namely, providing assistance in development of business strategies and creative ideation;</p> | |
| <p>Consumer research;</p> | |
| <p>Creative marketing design services;</p> | |
| <p>Design of internet advertising;</p> | |
| | <p>dissemination of advertising for others via print, electronic, audio, video, digital and on-line media;</p> |
| <p>Development of marketing strategies and concepts;</p> | |
| <p>Market research;</p> | |
| <p>Market research consultation;</p> | |
| <p>Marketing and branding services, namely, performing consumer insight and brand strategy of company logos;</p> | |
| <p>Marketing services, namely consumer marketing research;</p> | <p>organizing, arranging and conducting exhibitions, trade fairs, presentations and shows for the advertisement, promotion and sale of the goods and services, of others;</p> |
| | <p>promoting the sale of goods and services of others via promotional contests, drawings and giveaways through print, electronic, audio, video, digital and on-line media.”</p> |
| <p>Providing business management information in connection with consulting and advisory services in the field of strategic planning.”</p> | |
| | <p>rental of advertising space on a website.</p> |