

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85610213
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 102
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<b>response to the substantive refusal(s), please note the following:</b>	
<b><u>Request for Reconsideration</u></b>	
<p>Applicant hereby responds to the Office Action dated, February 13, 2013, wherein the Examining Attorney (“Examiner”) maintains and makes FINAL the refusal to register applicant’s RESORTIST mark for leather bags, suitcases and wallets, leather purses, purses, luggage, and backpacks in International Class 18 on the basis of likelihood of confusion with a prior registration for RESORT (U.S. Registration 3577457) for, inter alia, luggage and purses in International Class 18 and coin holders, document holders, and notebooks in International Class 16 based on Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).</p>	
<p>Applicant maintains its position that the mark in the subject application is not confusingly similar to the cited mark and should therefore be permitted to register for the reasons set forth in its previous Office Action response dated January 28, 2013 and further maintained below.</p>	
<b><u>No Likelihood of Confusion</u></b>	
<b><i>I. Likelihood of Confusion Standard</i></b>	
<p>In making a determination as to whether or not a likelihood of confusion exists, “[t]he issue is not whether the actual goods are likely to be confused, but rather whether there is a likelihood of confusion as to the source of the goods.” Trademark Manual of Examining Procedure (“TMEP”) § 1207.01. For likelihood of confusion to exist, consumer confusion as to the source of the goods must be probable, not</p>	

simply possible. *Cohn v. Petsmart, Inc.*, 281 F.3d 897, 842 (9th Cir. 2002) (internal citations omitted); see also *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998) (“Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion.”) (emphasis added).

Applicant respectfully maintains that likelihood of confusion between RESORTIST and RESORT is not probable based on the dissimilarity of the respective marks in sight, sound, and overall commercial impression.

## ***II. The Differences in the Respective Marks Result in No Likelihood of Confusion.***

In comparing the RESORTIST mark with the RESORT mark, the marks must be considered in their entireties, rather than dissected or split into component parts, and each part compared with other parts.

*In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (“The basic principle in determining confusion between marks is that marks must be compared in their entireties [and thus] likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Moreover, no feature of the mark should be ignored. *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (“No feature of a [composite] mark is ignored” in the likelihood of confusion analysis.); *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (CCPA 1974) (“Arguments to the effect that one portion of a mark possesses no trademark significance leading to direct comparison between only what remains is an erroneous approach.”). More or less weight may be given to a particular element of a mark, but only if the final determination is based on the marks in their entireties. See *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000). Comparisons involving a composite mark “must be done on a case-by-case basis without reliance on mechanical rules of construction.” TMEP § 1207.01 (c)(ii).

### **A. The Marks are Different in Visual Appearance.**

RESORTIST is dissimilar from RESORT in visual appearance. Although each contains the common term RESORT, that is where the similarity of the respective marks ends. RESORTIST is a longer, three-syllable word, where as RESORT is a shorter, two-syllable word. The visual comparison of the marks reveals these obvious dissimilarities that alleviate any likelihood of confusion.

Applicant believes that the Examiner is erroneously focusing on only one portion of the respective marks in her concluding that consumer confusion between them is likely. Although both marks contain the term “RESORT,” the mere fact that two marks share a common component is insufficient to create a likelihood of confusion between them, particularly where the common element is a weak term, such as “RESORT.” *See Clairol, Inc. v. Cosmair, Inc.*, 592 F. Supp. 811, 815 (S.D.N.Y. 1984) (“In assessing likelihood of confusion, the mere fact that two marks may share words in common is not determinative.”). The manner in which the owner of the cited registration has used the mark further confirms that RESORT is weak. The owner, Samsonite, has used the mark in connection with two other, stronger marks: SAMSONITE and BLACK LABEL. Thus, the mark appeared in the marketplace as SAMSONITE BLACK LABEL RESORT, the “RESORT” being the weakest component. Moreover, it is unlikely that a consumer would encounter the mark and confuse it with Applicant’s goods, since the source of Samsonite’s goods is made clear by use of the SAMSONITE house mark in close proximity to the RESORT mark.

Numerous courts have found that the mere sharing of common terms alone is insufficient to establish a likelihood of confusion, even in instances where the marks in question were used in connection with identical goods or services. This is particularly true where the common term or portion of a mark is weak. *See* 4 McCarthy on Trademarks & Unfair Competition § 23:48 (4th ed.) (“If the common element of conflicting marks is a word that is “weak” then this reduces the likelihood of confusion. A portion of a mark may be “weak” in the sense that such portion is descriptive, highly suggestive, or is in common use by many other sellers in the market.”):

- **CHIROPRACTIC** and **CHIRO-MATIC** for mattresses: no likelihood of confusion because “chiro” is weak as suggestive of healthful support. *The Land-O-Nod Company v. Paulison*, 220 U.S.P.Q. 61 (T.T.A.B. 1983).
- **DIGIRAY** and **DIGIRAD** for an electronic X-ray system and radiation sensors, respectively: no likelihood of confusion because “DIGI” is commonly used for digital equipment and knowledgeable buyers will be very aware of the different connotation of RAY (for X-ray) and RAD (a measure of radiation). *In Re Digirad Corp.*, 45 U.S.P.Q.2d 1841 (T.T.A.B. 1998).
- **THERMEX** and **THERM-A-JUG**: no likelihood of confusion, as common “THERM” is suggestive of heat-insulating. *Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 U.S.P.Q. 412

(T.T.A.B. 1962).

- **KICK-ER** and **KIK-IT** for tabletop soccer games: not to cause likely confusion, the court noting that the common element “kick” is suggestive of such games. *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 185 U.S.P.Q. 321 (2d Cir. 1975).
- **ROMAN** and **ROMANBURGER** for food products “are not similar in appearance.” *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888 (Fed. Cir. 1986).

In this case, the term “resort” is weak when used in connection with goods that may be used by guests at resorts.

**B. The Respective Marks are Phonetically Dissimilar.**

Further, when the respective marks are pronounced aloud, there are audible differences. The consumer can clearly hear the phonetic differences in pronunciation between them, especially given the suffix, i.e., -IST, in Applicant’s mark, and be able to aurally distinguish the marks from one another without confusion, further supporting that likelihood of confusion is not probable.

**C. The Marks Have Different Meanings.**

In addition and perhaps most importantly, RESORTIST and RESORT do not have similar meanings. Indeed, RESORTIST is a coined term that does not exist in the English language and, therefore has no meaning. However, because “IST” is used to refer to a person who practices something (i.e., a PSYCHOLOGIST practices psychology and a SOCIALIST practices socialism), it is possible that consumers might construe RESORTIST to mean someone who is adept at enjoying vacations. Even if this were the case, it clearly refers to a person, which RESORT refers to a place -- a popular destination for vacations. As a result, even if consumers were able to conjure up a meaning for RESORTIST, it is not the same as or confusingly similar to the meaning of RESORT.

**D. The Marks Have Dissimilar Overall Commercial Impressions.**

Finally, even where marks possess terms in common with one another, the commercial impressions they convey may still be distinct. According to TMEP § 1207.01 (b)(v), “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.” The courts have consistently held that no likelihood of confusion exists between marks sharing a common term if the

marks create a distinct commercial impression, as is the case here. *Shen Mfg. Co., Inc. v. The Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004); *see also Republic Steel Corp. v. M.P.H. Mfg. Corp.*, 312 F.2d 940, 136 U.S. P. Q. 447 (C.C.P.A. 1963) (different connotation of TRUSS-SKIN and TRUSCON for metal building parts); *Morrison Milling CO. v. General Mills, Inc.*, 436 F.2d 1050, 168 U.S.P.Q. 591 (C.C.P.A 1971) (different connotation of CORN-KITS and CORN KIX); *House of Worsted-Tex, Inc. v. Superbra Cravats, Inc.*, 284 F.2d 528, 128 U.S.P.Q. 119 (C.C.P.A. 1960) (IVY LEAGUE for clothing and IVY HALL for neckties not confusingly similar); *Holiday Inns, Inc. v. Holiday Out in America*, 481 F.2d 445, 178 U.S.P.Q. 257 (5th Cir. 1973) (HOLIDAY INN for motels and campgrounds held not confusingly similar to HOLIDAY OUT for trailer parks).

In the final office action, the Examiner maintains that “[t]he only difference [between the marks] is the addition of the suffix ‘IST’ to the applicant’s mark which does nothing to change the commercial impression.” The Applicant respectfully disagrees. ***Applicant’s RESORTIST mark, as a coined term, has no meaning but might bring to mind a person who is adept at enjoying vacations.*** Considering the goods named in the application, it follows that the commercial impression conveyed is an association between RESORTIST and luxury travel products, such as luggage, purses, and leather goods. In a recent article, a writer saw the term RESORTIST on Applicant’s advertisements, and explained her impression of the mark:

When I think resortist, I think class, elegance, and style. I see beautiful people lounging by the pool, playing golf, or leisurely indulging whatever strikes their fancy. Resortists enjoy fine wines, glamorous meals, and superbly appointed hotel rooms.

Holly Green, *Are You a Tourist or Resortist?* Forbes.com, February 7, 2012. A true and correct copy of the article is submitted herewith.

In contrast, RESORT brings to a mind a destination hotel for vacations and, when used on luggage and purses, luggage and purses sold in a resort. Accordingly, the overall commercial impressions of the respective marks are different and therefore distinguishable. Based on these differences, the commercial impression each mark conveys is distinct in the marketplace, thereby further weighing against a likelihood of confusion.

### **III. Conclusion**

Applicant is aware that the overriding concern is to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. In that regard, Applicant urges that those in the industry itself can decide whether or not they believe that registration of its RESORTIST

mark will inhibit their right to compete or adversely impact their business.

Applicant believes all outstanding issues with respect to the application for the mark have been resolved, and requests that its mark be approved for publication.

Applicant further notes that it is simultaneously filing a Notice of Appeal with the Trademark Trial & Appeal Board in the event the Examiner remains unpersuaded by the evidence and arguments presented by Applicant

## EVIDENCE SECTION

### EVIDENCE FILE NAME(S)

**ORIGINAL PDF FILE**

[evi\\_20616950186-204820322 . RESORTIST \\_18 .pdf](#)

**CONVERTED PDF  
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(5 pages)**

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**DESCRIPTION OF  
EVIDENCE FILE**

Forbes article

## SIGNATURE SECTION

**RESPONSE SIGNATURE**

/Michael J. McCue/

**SIGNATORY'S NAME**

Michael J. McCue

**SIGNATORY'S  
POSITION**

Attorney

**SIGNATORY'S PHONE  
NUMBER**

702.949.8200

**DATE SIGNED**

08/13/2013

**AUTHORIZED  
SIGNATORY**

YES

**CONCURRENT APPEAL  
NOTICE FILED**

YES

## FILING INFORMATION SECTION

**SUBMIT DATE**

Tue Aug 13 20:52:02 EDT 2013

**TEAS STAMP**

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65d1ad85ae2f8ba8c4-N/A-N/

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **85610213** has been amended as follows:

**ARGUMENT(S)**

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

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**Request for Reconsideration**

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***No Likelihood of Confusion***

***I. Likelihood of Confusion Standard***

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*Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998) (“Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion.”) (emphasis added).

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Holly Green, *Are You a Tourist or Resortist?* Forbes.com, February 7, 2012. A true and correct copy of the article is submitted herewith.

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#### **EVIDENCE**

Evidence in the nature of Forbes article has been attached.

#### **Original PDF file:**

[evi\\_20616950186-204820322 . RESORTIST\\_18 .pdf](#)

**Converted PDF file(s)** (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /Michael J. McCue/ Date: 08/13/2013

Signatory's Name: Michael J. McCue

Signatory's Position: Attorney

Signatory's Phone Number: 702.949.8200

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85610213

Internet Transmission Date: Tue Aug 13 20:52:02 EDT 2013

TEAS Stamp: USPTO/RFR-206.169.50.186-201308132052026

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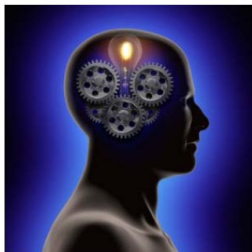
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'Jobs' Film Director R Steve's Ear Struggle To Communicate Simply

Carmine Gallo Contributor

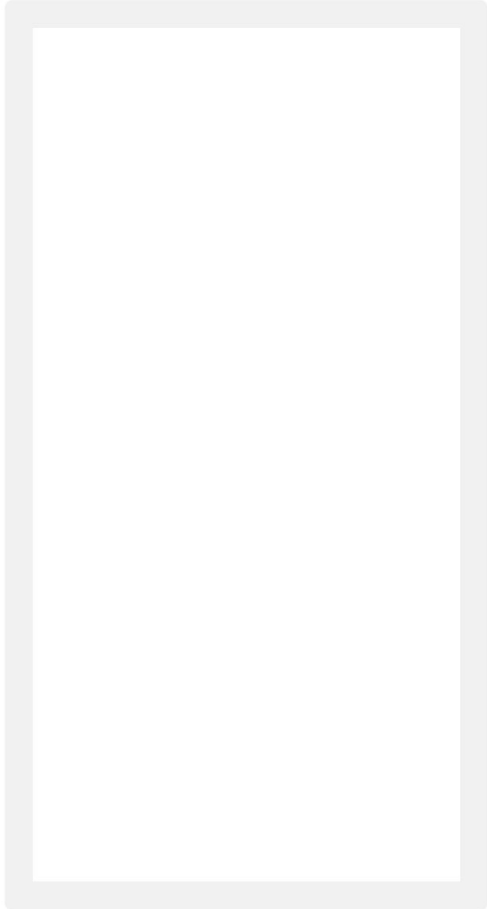


I was driving on the highway the other day and saw a billboard that really caught my eye.



The advertisement was promoting Mandalay Bay, an upscale resort in Las Vegas. I don't remember the exact wording, but it said something like "At Mandalay Bay you're not a tourist, you're a *resortist*." I immediately thought, "What a cool word — resortist." And what a clever way to position their product offering.

When I hear the word "tourist" it conjures up images of crowded bus rides, two-star hotels, and cheap food eaten on the run. I see families with bored, whining kids rushing from one place to another in a frenzy to take in as many of the sights as possible. I see people trying hard to blend in with the locals while standing out like sore thumbs. And I see people looked down upon by the local inhabitants, and generally unwanted except for the



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## 10 Brainteasers to Test Your Mental Sharpness

 **Holly Green**  
Contributor

money in their wallets. But the word *resortist* suggests something entirely different! When I think resortist, I think class, elegance, and style. I see beautiful people lounging by the pool, playing golf, or leisurely indulging whatever strikes their fancy. Resortists enjoy fine wines, glamorous meals, and superbly appointed hotel rooms. They get welcomed with open arms and treated with expert care rather than contempt. Tourists get tolerated, resortists get pampered.

Okay, maybe I'm exaggerating a bit here. But the point is that language matters. When one small word can change the way we think about a product or service, it behooves us to pay close attention to the language we use.

Language also matters in our organizations, especially in the way we treat our employees, customers, and other stakeholders.

For example, do you have employees or associates? Do you have personnel or team members? Do you have customers or clients? Do you have suppliers or trusted partners? Do you have satisfied customers or advocates in the marketplace? Do you say "my" team instead of "our" team? Again, small differences in word choice can make big differences in the attitudes and perceptions of people internal and external to your business.

Think about other common phrases heard in organizations. For example, "We need to cascade this down the organization." *Down* the organization? Really? What kind of message does that send? Why not use more inclusive and empowering language, like "We want to engage everyone around this issue...?"

Both approaches basically say the same thing. But if you're one of the people being cascaded down upon, which one would make you feel more respected, included, and empowered?

Here's the real challenge for business leaders: you can't just use the right language. You also have to live it. Your actions have to match the words. Otherwise, it creates a huge disconnect that destroys your credibility.

The classic example is companies that proudly proclaim, "Our people are our most important asset!", and then treat them like so many disposable parts. Most don't do it intentionally. They're just running so fast that they don't pause to look at the language they use or the disconnect between that language and their behaviors.

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