PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85885460
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	

REQUEST FOR RECONSIDERATION

Applicant Restoration Hardware, Inc. hereby responds to the United States Patent and Trademark Office ("USPTO") Action dated December 17, 2013 ("Office Action") wherein the Examining Attorney ("Examiner") maintains and makes FINAL the refusal to register Applicant's RH mark in connection with luggage, handbags, wallets, and other goods in International Class 18, asserting a likelihood of confusion with a prior registrations for R.H. VINTAGE (Stylized) (Reg. No. 2478565) for purses, handbags, backpacks, fanny packs, tote bags, coin purses and wallets in International Class 18, based on Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d).

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 December 6, 2013 and further maintained below.

I. No Likelihood of Confusion

A. Likelihood of Confusion Standard

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 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).

Likelihood of confusion between RH and R.H. VINTAGE is not probable based on the dissimilarity of the respective marks in sight, sound, and overall commercial impression.

B. The Differences in the Respective Marks Result in No Likelihood of Confusion.

In comparing the RH mark with the R.H. VINTAGE 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."). 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.).
Applicant submits that the Examiner bases his determination of the existence of a likelihood of confusion by relying on the mere sharing of the RH within the respective marks, rather than taking into account that the registrant's mark contains the added wording VINTAGE, which differentiates the marks and conveys a distinct commercial impression.

1. <u>The Marks Convey Dissimilar Overall Commercial Impressions</u>.

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).

The cited mark contains matter that it is not present in the RH mark, i.e., VINTAGE. "Vintage" refers to something of old, recognized, and enduring interest, importance, or quality. In the fashion industry, "vintage" refers to a style that dates back to a different historical period. Thus, when used in connection with purses, handbags, backpacks, fanny packs, tote bags, coin purses and wallets, consumers would immediately recognize that the VINTAGE in the mark refers to the style of the goods. No such association will be made in connection with Applicant's RH mark.

Moreover, the RH in Applicant's mark stands for something quite different than the RH in the cited mark, which further alleviates any likelihood of confusion. 4 McCarthy on Trademarks and Unfair Competition § 23:33 (4th ed.); *see also The Christian Broadcasting Network, Inc. v. ABS-CBN Int'l* , 84 U.S.P.Q.2d 1560, 1569, 2007 WL 2253483 (T.T.A.B. 2007) (requiring evidence that the public is aware of the meaning of the conflicting initials). The R.H.in the R.H. VINTAGE mark stands for RON HERMAN, which is the house mark used in connection with a high-end retail clothing store. On the other hand, the goods sold under the applied-for mark will be sold by Restoration Hardware. Thus, consumers will be immediately aware that the RH stands for Restoration Hardware, which is the house mark for all goods sold by Applicant, a public company founded in 1979 with a strong Internet and brick-and-mortar retail presence throughout the United States. Consumers are unlikely to be confused by goods sold by Restoration Hardware and goods sold by Ron Herman.

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.

2. <u>The Marks are Different in Visual Appearance</u>.

RH is dissimilar from R.H. VINTAGE in visual appearance. RH is a single, unitary mark that functions (and appears) as an acronym, while R.H. VINTAGE is a two-word mark composed of the initials R and

H, and the descriptive term VINTAGE. The visual comparison of the marks reveals these obvious dissimilarities that alleviate any likelihood of confusion. Moreover, the R.H. VINTAGE mark is stylized, as shown below, while the applied-form mark is plain word mark. Generally, highly stylized, highly contrasting letter design logos are less likely to be found confusingly similar. 4 McCarthy on Trademarks and Unfair Competition § 23:33 (4th ed.) See rendering for R.H. VINTAGE attached

Although both marks contain the letters "R" and "H," the mere fact that two marks share common components is insufficient to create a likelihood of confusion between them. *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."). Numerous courts have found that the mere sharing of common terms 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.

- **AMI** and **BAMI** for healthcare services held not confusingly similar. *Basic American Medical, Inc. v. American Medical Int'l, Inc* ., 649 F. Supp. 885, 1 U.S.P.Q.2d 1217 (S.D. Ind. 1986)

- **NEC** and **NECS** for computer chips held not confusingly similar where plaintiff NEC is a well-known manufacturer of electronic components, including computer chips, and defendant NECS is an independent broker of computer chips selling to sophisticated purchasers "unlikely to confuse" the two. *NEC Electronics v. New England Circuit Sales, Inc.*,722 F. Supp. 861, 13 U.S.P.Q.2d 1058 (D. Mass. 1989)

- **B.V.D** and **B.A.D.** for clothing not confusingly similar because consumers likely to react to junior user's mark as the common work "bad," not as a simulation or suggestion of the well-known mark B.V.D. *B.V.D. Licensing Corp. v. Body Action Design, Inc*., 846 F.2d 727, 6 U.S.P.Q.2d 1719 (Fed. Cir. 1988)

Thus, the mere existence of a common term is insufficient to conclude a likelihood of confusion exists. Additional wording -- such as that found in the marks at issue -- can differentiate one mark from another even where the goods or services are similar. The visual differences between RH and R.H. VINTAGE indicate that confusion is not likely.

3. <u>The Respective Marks are Phonetically Dissimilar</u>.

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 additional terms contained in the cited mark, i.e., VINTAGE, and be able to aurally distinguish the marks from one another without confusion, further supporting that likelihood of confusion is not probable.

4. <u>Moving Goods From Companion Application</u>.

Pursuant to TMEP §1402.08, please move the following goods from companion Application Serial No. 85/885863: "patio umbrella bases." Section 1402.08 of the TMEP provides for the moving of services between companion applications where (1) "the application from which the item is to be moved was filed at least as early as the application to which it has to be moved," and (2) "the applications involved have not yet been published in the *Official Gazette*." In the present case, these applications at issue

were filed contemporaneously on March 25, 2013, and neither application has advanced to publication in the *Official Gazette*. Accordingly, Applicant's amended recitation of services should meet the Examining Attorney's approval.

II. Conclusion

Applicant is cognizant that the Office's 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 RH mark will inhibit their right to compete or adversely impact their business.

Applicant believes all outstanding issues with respect to the application for the subject mark have been resolved, and requests approval of the same 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_20616950186-191543491_._rhvintage.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\858\854\85885460\xml8\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	Rendering of R.H. VINTAGE
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Stephanie S. Buntin/
SIGNATORY'S NAME	Stephanie S. Buntin
SIGNATORY'S POSITION	Attorney
SIGNATORY'S PHONE NUMBER	702.949.8200
DATE SIGNED	06/17/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Jun 17 19:27:28 EDT 2014
	USPTO/RFR-206.169.50.186-20140617192728114027-8588

TEAS STAMP	5460-500837433d274f6e5ec8 cdd1141af2e6186669a1e9085 d7ef774dee5d26493e0-N/A-N /A-20140617191543491791

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To the Commissioner for Trademarks:

Application serial no. **85885460** has been amended as follows:

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

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EVIDENCE
Evidence in the nature of Rendering of R.H. VINTAGE has been attached.
Original PDF file:
evi_20616950186-191543491_._rhvintage.pdf
Converted PDF file(s) (1 page)
Evidence-1

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /Stephanie S. Buntin/ Date: 06/17/2014
Signatory's Name: Stephanie S. Buntin
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: 85885460
Internet Transmission Date: Tue Jun 17 19:27:28 EDT 2014
TEAS Stamp: USPTO/RFR-206.169.50.186-201406171927281
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R.H.
VINTAGE