

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85919264
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><b><u>Refusal of Registration – Section 2(d) Likelihood of Confusion</u></b></p> <p>The Examining Attorney has maintained a refusal to register the highly stylized design mark D DOCÉ PERFECT NATURALLY &amp; Design in Class 25 based on an alleged likelihood of confusion under Section 2(d) of the Trademark Act with the mark DOCE•9 in U.S. Registration No. 4188796. Applicant respectfully requests reconsideration of the refusal to register under Section 2(d) of the Trademark Act.</p> <p>In considering whether there is a likelihood of confusion, a number of factors are relevant, including the similarity of the marks, similarity of the goods or services, the channels of trade and other factors. As support for the refusal to register, the Examining Attorney states that the marks share “the same term DOCE” and are used with similar clothing goods. However, for the reasons discussed below, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register with respect to the cited registration and allow the subject application to proceed to registration.</p> <p><b>A. The marks of the parties, when considered in their entirety, point to a finding of no likelihood of confusion given the overall differences in appearance, pronunciation, meaning, and commercial impression.</b></p> <p>Under the Lanham Act, a refusal to register grounded in a likelihood of confusion requires that such confusion as to the source of the goods or services is not merely possible, but <b>likely</b>. A mere possibility of confusion is an insufficient basis for rejection under</p>	

Section 2(d). *In re Massey-Ferguson Inc.*, 222 U.S.P.Q. 367 (T.T.A.B. 1983). Moreover, mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. In this case, the differences in the marks themselves unquestionably leads to a finding of no likelihood of confusion. In *Jacobs v. Int'l Multifoods Corp.*, the Court stated that "[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used..." *Jacobs v. Int'l Multifoods Corp.*, 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982) (emphasis added) (footnote omitted). See also *Merritt Foods Co. v. Americana Submarine*, 209 U.S.P.Q. 591, 599 (T.T.A.B. 1980).

When the marks of the parties are viewed in their entirety, Applicant's mark significantly differs from the mark in the cited registration in appearance, pronunciation, meaning and commercial impression such that confusion would not be likely. In analyzing the similarity of the marks, it is not proper to dissect the marks of the parties and to discard or ignore all other non-similar elements. The term "DOCÉ" is only one of four literal elements in Applicant's mark. A visual comparison of the cited mark DOCE•9 and Applicant's mark D DOCÉ PERFECT NATURALLY & Design immediately imparts the visual differences between the marks. Applicant's mark does not include any numbers. Moreover, Applicant's mark prominently displays the letter "d" set against a fanciful free-form design. This stylized design highlights and accentuates the letter "d," creating a unique commercial impression in and of itself. As the Examining Attorney notes, consumers are generally more inclined to focus on the first portion of a mark. See *Presto Prds., Inc. v. Nice-Pak Prods., Inc.* 9 USPQ 2d 1895, 1879 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions.) Applicant respectfully submits that it is the highly stylized "d" - not the term "DOCÉ" - that is the "first part" of Applicant's mark. Thus, the stylized "d" and design will capture consumers' attention and immediately distinguish Applicant's mark from the mark in the cited registration. The parties' marks create completely separate commercial impressions in sight and sound that avoid a likelihood of confusion between marks by prospective consumers.

Furthermore, the term DOCÉ in Applicant's mark does not have an English translation. Thus, Applicant's mark does not share a meaning with the mark in the cited registration. In addition, the term DOCE (with no accent) can translate to "twelve" (the Spanish definition) or "sweet" (the Portuguese definition). That the term DOCE is subject to various meanings also weighs against a finding of likelihood of confusion. *See* TMEP 809.03 ("the existence of a variety of alternative translations...usually indicates lack of a clearly recognized equivalent meaning.").

Applicant's position is further supported by several analogous cases featuring similarly constructed marks. For example, in *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970) the mark "PEAK PERIOD" for personal deodorants was found not to be confusingly similar to the mark "PEAK" for dentifrices. The Court specifically noted that the determination of likelihood of confusion "[m]ust arise from a consideration of the respective marks in their entireties." The Court stated:

The difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties neither look nor sound alike.

*Id.* at 530; *See also Gruner + Jahr USA Publishing v. Meredith Corp.* 26 U.S.P.Q.2d 1583 (2d Cir. 1993) ("PARENTS" and "PARENTS DIGEST" for the same type of magazines determined to be not confusingly similar); *In re Ferrero*, 178 U.S.P.Q. 167 (C.C.P.A. 1973) ("TIC TAC" for candy not held to be confusingly similar to "TIC TAC DOE" for ice cream); *In re Hearst Corp.* 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) ("VARGAS" and "VARGA GIRL", both for calendars, were sufficiently different so that there was no likelihood of confusion); *Paco Sport Ltd. v Paco Rabanne Parfums*, 54 U.S.P.Q.2d 1205 ("PACO" was not confusingly similar to "PACO RABANNE").

Of particular interest is *Bell Laboratories v. Colonial Products*, 231 U.S.P.Q. 569 (S.D. Fla. 1986), in which the Court emphasized the differences in sight and sound between "FINAL" and "FINAL FLIP," both for pesticides. In considering the totality of the marks, the Court stated:

The appearance of the marks in the instant case is quite different. Plaintiff's mark boldly highlights the word "FINAL" in black

against the white background with other black print. The letter "F" is capitalized and the other letters are lower case. The printing is stylized. There is little other ornamentation on the "FINAL" package...

*Id.* at 572. The foregoing case highlights the importance of not only considering the marks in their entireties, but also the importance of recognizing the significance of differences in the overall appearance. Similarly, Applicant's mark features literal, design and stylization elements not present in the mark shown in the cited registration. Accordingly, Applicant respectfully asserts that the differences between the marks are sufficient such that confusion would not be likely.

**B. Conclusion.**

For all of the above reasons, there is no likelihood of confusion between the concurrent use of Applicant's mark and the mark shown in the cited registration. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register under Section 2(d) of the Trademark Act.

**GOODS AND/OR SERVICES SECTION (025)(no change)**

**GOODS AND/OR SERVICES SECTION (032)(current)**

INTERNATIONAL CLASS	032
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**DESCRIPTION**

Beverages, namely water, coconut water, and coconut-based beverages not being milk substitutes

FILING BASIS	Section 1(b)
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**GOODS AND/OR SERVICES SECTION (032)(proposed)**

INTERNATIONAL CLASS	032
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**TRACKED TEXT DESCRIPTION**

~~Beverages, namely water, coconut water, and coconut-based beverages not being milk substitutes;~~  
[Beverages, namely aerated water, bottled water, drinking water, still water, table water, coconut water, and coconut-based beverages not being milk substitutes](#)

**FINAL DESCRIPTION**

Beverages, namely aerated water, bottled water, drinking water, still water, table water, coconut water, and coconut-based beverages not being milk substitutes

FILING BASIS	Section 1(b)
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**ADDITIONAL STATEMENTS SECTION**

<b>TRANSLATION</b>	The wording DOCÉ has no meaning in a foreign language.
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Joanne Ludovici/
<b>SIGNATORY'S NAME</b>	Joanne Ludovici
<b>SIGNATORY'S POSITION</b>	Attorney of Record, DC Bar Member
<b>DATE SIGNED</b>	09/17/2014
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Wed Sep 17 17:41:50 EDT 2014
<b>TEAS STAMP</b>	USPTO/RFR-38.103.60.23-20 140917174150237386-859192 64-500904a8e408c9cdd51f18 ce9c7ff769b7673d82e022f62 bce766b51e67714c6-N/A-N/A -20140917173212631518

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

Application serial no. **85919264** has been amended as follows:

**ARGUMENT(S)**

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

**Refusal of Registration – Section 2(d) Likelihood of Confusion**

The Examining Attorney has maintained a refusal to register the highly stylized design mark D DOCÉ PERFECT NATURALLY & Design in Class 25 based on an alleged likelihood of confusion under Section 2(d) of the Trademark Act with the mark DOCE•9 in U.S. Registration No. 4188796. Applicant respectfully requests reconsideration of the refusal to register under Section 2(d) of the Trademark Act.

In considering whether there is a likelihood of confusion, a number of factors are relevant, including the similarity of the marks, similarity of the goods or services, the channels of trade and other factors. As support for the refusal to register, the Examining Attorney states that the marks share “the same term DOCE” and are used with similar clothing goods. However, for the reasons discussed below, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register with respect to the cited registration and allow the subject application to proceed to registration.

**A. The marks of the parties, when considered in their entirety, point to a finding of no likelihood of confusion given the overall differences in appearance, pronunciation, meaning, and commercial impression.**

Under the Lanham Act, a refusal to register grounded in a likelihood of confusion requires that such confusion as to the source of the goods or services is not merely possible, but **likely**. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). *In re Massey-Ferguson Inc.*, 222 U.S.P.Q. 367 (T.T.A.B. 1983). Moreover, mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. In this case, the differences in the marks themselves unquestionably leads to a finding of no likelihood of confusion. In *Jacobs v. Int'l Multifoods Corp.*, the Court stated that “[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used....” *Jacobs v. Int'l Multifoods Corp.*, 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982) (emphasis added) (footnote omitted). *See also Merritt Foods Co. v. Americana Submarine*, 209 U.S.P.Q. 591, 599 (T.T.A.B. 1980).

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Cir. 1993) ("PARENTS" and "PARENTS DIGEST" for the same type of magazines determined to be not confusingly similar); *In re Ferrero*, 178 U.S.P.Q. 167 (C.C.P.A. 1973) ("TIC TAC" for candy not held to be confusingly similar to "TIC TAC DOE" for ice cream); *In re Hearst Corp.* 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) ("VARGAS" and "VARGA GIRL", both for calendars, were sufficiently different so that there was no likelihood of confusion); *Paco Sport Ltd. v Paco Rabanne Parfums*, 54 U.S.P.Q.2d 1205 ("PACO" was not confusingly similar to "PACO RABANNE").

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#### **B. Conclusion.**

For all of the above reasons, there is no likelihood of confusion between the concurrent use of Applicant's mark and the mark shown in the cited registration. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register under Section 2(d) of the Trademark Act.

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

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



**Current:** Class 032 for Beverages, namely water, coconut water, and coconut-based beverages not being milk substitutes

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Proposed:**

**Tracked Text Description:** ~~Beverages, namely water, coconut water, and coconut-based beverages not being milk substitutes~~; Beverages, namely aerated water, bottled water, drinking water, still water, table water, coconut water, and coconut-based beverages not being milk substitutes

Class 032 for Beverages, namely aerated water, bottled water, drinking water, still water, table water, coconut water, and coconut-based beverages not being milk substitutes

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

## **ADDITIONAL STATEMENTS**

### **Translation**

The wording DOCÉ has no meaning in a foreign language.

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /Joanne Ludovici/ Date: 09/17/2014

Signatory's Name: Joanne Ludovici

Signatory's Position: Attorney of Record, DC Bar Member

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: 85919264

Internet Transmission Date: Wed Sep 17 17:41:50 EDT 2014

TEAS Stamp: USPTO/RFR-38.103.60.23-20140917174150237

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ff769b7673d82e022f62bce766b51e67714c6-N/

A-N/A-20140917173212631518

