

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86649476
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86649476/large
LITERAL ELEMENT	FUNK ZONE PATIO
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.

ARGUMENT(S)

RESPONSE TO FINAL OFFICE ACTION and REQUEST FOR RECONSIDERATION

The Examining Attorney continues to refuse Applicant's registration of Funk Zone Patio for handbags; canvas shopping bags; tote bags, clothing, namely, shirts, hats, beer, wine, restaurant services and catering services based on the conclusion that there is a likelihood of confusion with U.S. Registration No. 4733318. Applicant respectfully disagrees with this conclusion and maintains that the goods and services are not similar and are marketed to different members of the public. Further the registration in question was first used in commerce on November 15, 2014 for wine in class 33. The applicant has been using the mark Funk Zone for several years including since at least January 1, 1998 for clothing, namely, shirts and hats in class 25 and since at least January 1, 2010 for restaurant and catering services in class 43. At the very least the mark should be granted for classes 18, 25, 32 and 43.

I. Likelihood of Confusion

The Examining Attorney has refused Applicant's registration under the Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), stating that the Applicant's mark, when used on or in connection with the identified goods, so resembles the mark in the above listed registered mark as to be likely to cause confusion, to cause mistake, or to deceive. Applicant disagrees and believes that there is no likelihood that purchasers of the Applicant's goods and the Registrants' goods would believe that the goods emanate from a common source.

The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See, e.g., *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

The question of likelihood of confusion between marks is "related not to the nature of the mark but to its effect 'when applied to the goods of the applicant.' The only relevant application is made in the marketplace. The words 'when applied' do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (original emphasis). In determining whether there is a likelihood of confusion, courts look to many factors, including as particularly relevant here:

- The similarity or dissimilarity of the marks in their entirety;

- The similarity or dissimilarity and nature of the goods or services such that one party's goods will be mistaken for those of the other party;
- The channels of distribution of the goods or services;
- The conditions under which the goods or services are purchased (i.e. impulse buying versus purchases made after careful consideration);
- The sophistication of the purchasers of the goods or services;
- The number and nature of similar marks in use on similar goods or services; and
- The nature and extent of any actual confusion.

Id. at 1361.

Applicant respectfully submits that an analysis of these factors here leads inevitably to the conclusion that no confusion will result between Applicant's Mark and the Cited Mark.

A. Confusion Must Be Probable, Not Possible

For confusion to be likely the confusion must be probable; it is irrelevant that confusion is merely possible. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1465 (TTAB 1992) (standard is likelihood of confusion, "not some theoretical possibility built on a series of imagined horrors"); *Rodeo Collection, Ltd. v. West Seventh*, U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("probable, not simply a possibility"). Trademark law is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q.2d 1388 (Fed Cir. 1992), quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 44-45 (CCPA 1969), *aff'g*, 153 U.S.P.Q. 412 (TTAB 1967). Likelihood of confusion "is synonymous with 'probable confusion' it is not sufficient if confusion is merely possible." 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2007). Here, Applicant respectfully submits that there is no probability of confusion with the registered mark due to the fact that applicant's handbags, canvas shopping bags, tote bags, clothing, namely, shirts, hats, beer, wine, restaurant services and catering services and the cited registration's wine are very different in nature and sold to different consumers.

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the source, then, even if the marks are identical, confusion is not likely. *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable not confusingly similar to QR for various products (e.g. lamps, tubes) related to photocopying field. Since the goods here are being purchased by different consumers for unrelated purposes there is no probable likelihood of confusion.

B. Applicant's Goods and the Goods Listed in the Applications Are Distinct

It is well-settled that there is no likelihood of confusion, as opposed to a possibility of confusion, even between identical marks where any confusion would arise only through accident or chance confrontation. This point was underscored by the Board in *In re Fesco Inc.*, 219 U.S.P.Q. 437 (T.T.A.B. 1983), in which the applicant's mark FESCO & Design for use in connection with "distributorship services in the field of farm equipment and machinery" was refused registration in view of the registered mark FESCO for, inter alia, "fertilizer" and "fertilizer coolers and dryers." Although the Board deemed the marks "virtually identical" and observed that the cited mark FESCO was arbitrary and therefore a "relatively strong designation," the Board nonetheless found no likelihood of confusion:

[E]ven identical marks would have little opportunity, in our view, other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regard, the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties. Id. at 438 (emphasis added). See also *In re Frank's Int'l, Inc.*, Ser. No. 76/599,870 (T.T.A.B. March 22, 2007) (no likelihood of confusion between ANACONDA for "machine parts for oilfield equipment, namely, load lift rings, and thread protectors for use on oilfield casing before such casing is run into an earth well bore" and the identical mark ANACONDA for "oil and gas coiled tubing well construction systems and directional drilling services"); See also *Chase Brass & Copper Co., Inc. v. Special Springs, Inc.*, 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978) (finding no likelihood of confusion between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because "while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same

persons in an environment where a likelihood of confusion could occur.”); T.M.E.P. § 1207.01(a)(i) (“[I]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.”)

As such, Applicant respectfully submits that its goods and the cited goods are sufficiently distinct to preclude any likelihood of confusion. Particularly apt is the Board’s decision in *Triumph Mach. Co. v. Kentmaster Mfg. Co. Inc.*, 1 U.S.P.Q.2d 1826 (T.T.A.B. 1987), in which the Board found no likelihood of confusion between the typed mark HYDRO-CLIPPER for “power operated cattle de-horning shears” and HYDRO-CLIPPER & Design for “power mower attachment”: [T]he respective goods, by their very nature, are advertised in different publications, promoted at different trade shows and, in the case of applicant’s goods, sold through specialized channels of trade to a specialized class of customer whose need for opposer’s product, while possible, is unlikely. *Id.* at 1828. See also *In re Lipner*, Serial No. 76571009 (T.T.A.B. August 28, 2006), at 8 (differentiating air filters for air conditioners from air filters for air respirators under identical marks, “it appears to us that, because of the nature of the goods, they would be offered to different classes of purchasers through different channels of trade. As such, it is unlikely that there would be any opportunity for confusion to occur.”)

The Board has consistently held that in order to support a likelihood of confusion, there must be some similarity between the goods beyond the fact that each involves the same general field. See *Groveton Papers Co. v. The Anaconda Co.*, 197 U.S.P.Q. 576, 579 (T.T.A.B. 1977). In fact, the T.M.E.P. states:

“[t]he facts in each such case vary and the weight to be given each factor may be different in light of varying circumstances; thus, there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from use of similar marks in relation thereto.” T.M.E.P. §1207.01(a) (IV). Furthermore, the courts have held that “[t]here is no likelihood of confusion where the potential for confusion is a mere possibility, not a probability.” *Castle Oil Corp. v. Castle Energy Corp.*, 26 U.S.P.Q.2d 1481, (E.D. Pa. 1992) (citing *Electronic Data Sales, Inc. v. Electronic Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1393 (Fed. Cir. 1992)). The Federal Circuit and the CCPA have held: “[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Data Sales*, 954 F.2d at 717. (citing *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969), *aff’g*, 153 U.S.P.Q. 412 (TTAB 1967).

In fact, the USPTO has allowed for coexistent registration in several cases for beer and wine marks which are identical or virtually indistinguishable from one another. A list of registrations for beer and wine that are either identical to, or virtually identical to, one another was provided in our prior response and as such is part of the record.

The goods and services listed for the cited application are for “wine”. The identification of goods should be as complete and specific as possible and protection afforded by the cited registration is limited to only the identified goods and nothing broader. *United Drug*, 248 U.S. at 97; *University of Notre Dame du Lac*, 217 U.S.P.Q. at 507. In contrast, Applicant’s proposed goods are: “handbags; canvas shopping bags; tote bags, clothing, namely, shirts, hats, beer, wine, restaurant services and catering services.” Thus, there is no likelihood of confusion.

C. There Is No Likelihood of Confusion Because the Goods Are Directed to Different Target Markets

The same consumers are not likely to encounter the Applicant’s goods and the goods of the cited application because the respective applicants target completely different sets of consumers. Even in cases of identical marks used in the same industry, to support a claim of confusion, there must be a reasonable basis for finding that the marks would be encountered by the same persons other than by chance. See *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 U.S.P.Q. 222, 224 (TTAB 1983); *In re Fresco Foods, Inc.*, 219 U.S.P.Q. 437, 438 (TTAB 1983) (“the recited goods are not so related that they would come to the attention of the same kinds of purchaser and, therefore, we agree with applicant that any likelihood of confusion is remote. This being the case, even identical marks would have little opportunity other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regards, the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties”); *In re Unilever, Ltd.*, 222 U.S.P.Q. 981, 982-83 (TTAB 1984); *Murray v. Cable National Broadcasting Co.*, 39 U.S.P.Q.2d 1214, 1216 (9th Cir. 1996); *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 U.S.P.Q. 81, 84 (TTAB 1983). In addition, it is well-settled that the likelihood of confusion is

reduced where purchasers and potential purchasers of the products or services are sophisticated. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, inter alia, both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source."). See also TMEP § 1207.01(d) (vii) (care in purchasing tends to minimize the likelihood of confusion). "In making purchasing decisions regarding expensive goods, the reasonably prudent purchaser standard [that is normally applied in determining likelihood of confusion] is elevated to the standard of the 'discriminating purchaser.'" *Weiss Associates v. HTL Associates Inc.*, 14 U.S.P.Q.2d 1840, and 1841-42 (Fed. Cir. 1990). See also *Chase Brass & Copper Co., Inc. v. Special Springs, Inc.*, 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978) (finding no likelihood of confusion between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because "while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same persons in an environment where a likelihood of confusion could occur."); T.M.E.P. § 1207.01(a)(i) ("[I]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.")

Nor does Applicant agree that "the applicant's goods are . . . in the normal field of expansion of the registrant." There is no evidence in the record that such expansion would be normal.

The goods and services listed for the cited marks are for wine. Applicant's goods and services include handbags, canvas shopping bags, tote bags, clothing, shirts, hats, beer, wine, restaurant services and catering services. The cited application's goods are directed to a completely different consumer market. The respective consumers would find the two goods entirely distinct and used in such separate markets that consumers would not believe the sources to be related. Applicant's goods are different, serve different purposes and are purchased by different customers. The goods and services are being purchased by different consumers for unrelated purposes. Accordingly, this factor weighs against a likelihood of confusion.

D. Dissimilarity of the Marks

The examining attorney indicated that there may be a likelihood of confusion between the Applicant's mark for "FUNK ZONE PATIO" and Registration No. 4733318 for Funk Zone. However, the fact remains that there is no likelihood of confusion with Applicant's mark. Applicant's mark is **visually and phonetically different** the registered mark.

One of the primary considerations in testing for likelihood of confusion is the similarity or dissimilarity of the marks in their entireties as to appearance, sound and meaning or connotation. TMEP § 1207.01(b) (i). Applicant's mark is FUNK ZONE PATIO and the mark in the cited registrations is Funk Zone. While the marks both have words funk zone, the applicant's mark also has the word "PATIO. As a result, the applicant's mark is dissimilar in appearance and sound. TMEP § 1207.01(b) (i). The applicant respectfully submits that because the marks are dissimilar in appearance and sound that there is no likelihood of confusion between the marks.

II. Disclaimer of the Wording in the Mark is Inappropriate

The Office has requested a disclaimer of the wording "Patio" on grounds it is descriptive of the services. Applicant respectfully disagrees. A disclaimer of the wording Patio from the mark is inappropriate because: (a) the mark consists of a unitary slogan and (b) any doubt as to descriptiveness should be resolved in favor of Applicant.

A. Funk Zone Patio is a unitary slogan

Applicant asserts that it is not necessary to disclaim Patio because Funk Zone Patio is a unitary slogan.

A slogan is a unitary phrase that should not be broken up for purposes of requiring a disclaimer. TMEP §1213.05(b). The continuum of distinctiveness/descriptiveness indicates that coined/fanciful slogans are unique, unitary taglines or phrases that are displayed and portrayed in a manner that consumers will view the wording together in its entirety, which typically renders the mark as inherently distinctive. TMEP §1209.01. Because consumers generally view slogans as a unitary whole and do not focus on one part/word of the mark as being separable, it is both unnecessary and improper to parcel wording for purposes of a disclaimer. TMEP §1213.05 and TMEP §1209.01. A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate and apart from the meaning of its constituent elements. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991); see also, *In re Kraft, Inc.*, 218 USPQ at 573 (the elements of a unitary mark are so integrated or merged that they cannot be regarded as separate elements, and it is obvious that no claim is made other than to the entire mark). In *Kraft*, the Board explained that a unitary mark could be created "where the words

which have been put together function as a unit, with each relating to the other rather than directly to the goods.” 218 USPQ at 573; see also *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981). To determine whether a composite mark is unitary, the Board must determine “how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark.” *Id.*, quoting *In re Magic Muffler Service*, 184 USPQ 125, 126 (TTAB 1974). The Funk Zone Patio mark is a “unitary” slogan, which possesses a non-descriptive meaning that is greater than the sum of its parts. Applicant’s mark creates a commercial impression separate and apart from any unregistrable component, as the elements are so merged together that they cannot be divided to be regarded as separable elements. TMEP§ 1213.05. Registrable slogans are considered “unitary” and should not be broken up for purposes of requiring a disclaimer. TMEP§ 1213.05(b). Moreover, when a mark is deemed “unitary” an individual component of the mark that would otherwise be unregistrable need not be disclaimed. TMEP§ 1213.02.

B. Any Doubts Regarding the Mark's Descriptiveness Should Be Resolved In Favor Of Applicant

It is well established that the burden is on the Office to prove descriptiveness of words. *In re TBG, Inc.*, 229 U.S.P.Q. 759, 760 (T.T.A.B. 1986). The Office provides the definition of the words "Patio". However, Applicant reiterates that no disclaimer should be required since the mark as a whole is a unitary slogan. Accordingly, the evidence does not support a disclaimer requirement.

The intent of Section 2(e)(1) and subsequent disclaimers is to protect the competitive needs of others by ensuring that descriptive words and phrases are left free for public use. *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1058 (TTAB 1989). Applicant uses the word "Patio" within a specific, unitary context and the public would not be deprived of the use of these individual terms.

Moreover, any doubt as to whether a mark or wording is descriptive should be resolved in favor of the Applicant. As stated in *McCarthy on Trademarks and Unfair Competition*, because the line between merely descriptive and only suggestive terms is 'so nebulous,' the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination. *McCarthy, supra*, § 11.51 at 11-124.

This reasoning has been followed in many cases. For instance, in *In re Penwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972), the Trademark Trial and Appeal Board, in finding that the mark DRI-FOOT for foot deodorant was not descriptive, noted that although the conclusion that DRI-FOOT was not descriptive was not "free from doubt . . . the doubt should be resolved in favor of the applicant." *Id.* See also *In re Women's Publishing Co.*, 23 U.S.P.Q.2d 1876, 1877 (T.T.A.B. 1992) (finding that the mark DECORATING DIGEST for a magazine featuring articles on decorating to be not descriptive and noting that "in accordance with precedent, we must resolve any reasonable doubt in favor of applicant"); *In re Merrill Lynch, Pierce, Fenner and Smith*, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) ("It is incumbent on the Board . . . to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.").

Applicant respectfully submits that it has raised doubts regarding the descriptiveness of "Patio" given the unitary nature of its mark. As such, those doubts should be resolved in favor of Applicant.

Since likelihood of confusion is not probable, the respective goods are distinct, the marks and respective goods are directed to different target markets. Consequently, the differences between the respective marks in this case are more than enough to avoid confusion as to either source of origin or sponsorship. Applicant respectfully requests that there are no potential 2(d) rejections with respect to the current application.

Passage of the application to publication is respectfully requested.

SIGNATURE SECTION	
RESPONSE SIGNATURE	/Jaye G. Heybl/
SIGNATORY'S NAME	Jaye G. Heybl
SIGNATORY'S POSITION	Attorney of record, California Bar Member
SIGNATORY'S PHONE NUMBER	805-373-0060
DATE SIGNED	10/18/2016

AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Oct 18 19:15:58 EDT 2016
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Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86649476** FUNK ZONE PATIO(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86649476/large>) has been amended as follows:

ARGUMENT(S)

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

RESPONSE TO FINAL OFFICE ACTION and REQUEST FOR RECONSIDERATION

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It is well-settled that there is no likelihood of confusion, as opposed to a possibility of confusion, even between identical marks where any confusion would arise only through accident or chance confrontation. This point was underscored by the Board in *In re Fesco Inc.*, 219 U.S.P.Q. 437 (T.T.A.B. 1983), in which the applicant's mark FESCO & Design for use in connection with "distributorship services in the field of farm equipment and machinery" was refused registration in view of the registered mark FESCO for, inter alia, "fertilizer" and "fertilizer coolers and dryers." Although the Board deemed the marks "virtually identical" and observed that the cited mark FESCO was arbitrary and therefore a "relatively strong designation," the Board nonetheless found no likelihood of confusion:

[E]ven identical marks would have little opportunity, in our view, other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regard, the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties. Id. at 438 (emphasis added). See also *In re Frank's Int'l, Inc.*, Ser. No. 76/599,870 (T.T.A.B. March 22, 2007) (no likelihood of confusion between ANACONDA for "machine parts for oilfield equipment, namely, load lift rings, and thread protectors for use on oilfield casing before such casing is run into an earth well bore" and the identical mark ANACONDA for "oil and gas coiled tubing well construction systems and directional drilling services"); See also *Chase Brass & Copper Co., Inc. v. Special Springs, Inc.*, 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978) (finding no likelihood of confusion

between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because “while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same persons in an environment where a likelihood of confusion could occur.”); T.M.E.P. § 1207.01(a)(i) (“[I]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.”)

As such, Applicant respectfully submits that its goods and the cited goods are sufficiently distinct to preclude any likelihood of confusion. Particularly apt is the Board’s decision in *Triumph Mach. Co. v. Kentmaster Mfg. Co. Inc.*, 1 U.S.P.Q.2d 1826 (T.T.A.B. 1987), in which the Board found no likelihood of confusion between the typed mark HYDRO-CLIPPER for “power operated cattle de-horning shears” and HYDRO-CLIPPER & Design for “power mower attachment”: [T]he respective goods, by their very nature, are advertised in different publications, promoted at different trade shows and, in the case of applicant’s goods, sold through specialized channels of trade to a specialized class of customer whose need for opposer’s product, while possible, is unlikely. *Id.* at 1828. See also *In re Lipner*, Serial No. 76571009 (T.T.A.B. August 28, 2006), at 8 (differentiating air filters for air conditioners from air filters for air respirators under identical marks, “it appears to us that, because of the nature of the goods, they would be offered to different classes of purchasers through different channels of trade. As such, it is unlikely that there would be any opportunity for confusion to occur.”)

The Board has consistently held that in order to support a likelihood of confusion, there must be some similarity between the goods beyond the fact that each involves the same general field. See *Groveton Papers Co. v. The Anaconda Co.*, 197 U.S.P.Q. 576, 579 (T.T.A.B. 1977). In fact, the T.M.E.P. states:

“[t]he facts in each such case vary and the weight to be given each factor may be different in light of varying circumstances; thus, there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from use of similar marks in relation thereto.” T.M.E.P. §1207.01(a) (IV). Furthermore, the courts have held that “[t]here is no likelihood of confusion where the potential for confusion is a mere possibility, not a probability.” *Castle Oil Corp. v. Castle Energy Corp.*, 26 U.S.P.Q.2d 1481, (E.D. Pa. 1992) (citing *Electronic Data Sales, Inc. v. Electronic Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1393 (Fed. Cir. 1992)). The Federal Circuit and the CCPA have held: “[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Data Sales*, 954 F.2d at 717. (citing *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969), *aff’d*, 153 U.S.P.Q. 412 (TTAB 1967).

In fact, the USPTO has allowed for coexistent registration in several cases for beer and wine marks which are identical or virtually indistinguishable from one another. A list of registrations for beer and wine that are either identical to, or virtually identical to, one another was provided in our prior response and as such is part of the record.

The goods and services listed for the cited application are for “wine”. The identification of goods should be as complete and specific as possible and protection afforded by the cited registration is limited to only the identified goods and nothing broader. *United Drug*, 248 U.S. at 97; *University of Notre Dame du Lac*, 217 U.S.P.Q. at 507. In contrast, Applicant’s proposed goods are: “handbags; canvas shopping bags; tote bags, clothing, namely, shirts, hats, beer, wine, restaurant services and catering services.” Thus, there is no likelihood of confusion.

C. There Is No Likelihood of Confusion Because the Goods Are Directed to Different Target Markets

The same consumers are not likely to encounter the Applicant’s goods and the goods of the cited application because the respective applicants target completely different sets of consumers. Even in cases of identical marks used in the same industry, to support a claim of confusion, there must be a reasonable basis for finding that the marks would be encountered by the same persons other than by chance. See *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 U.S.P.Q. 222, 224 (TTAB 1983); *In re Fresco Foods, Inc.*, 219 U.S.P.Q. 437, 438 (TTAB 1983) (“the recited goods are not so related that they would come to the attention of the same kinds of purchaser and, therefore, we agree with applicant that any likelihood of confusion is remote. This being the case, even identical marks would have little opportunity other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regards, the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties”); *In re Unilever, Ltd.*, 222

U.S.P.Q. 981, 982-83 (TTAB 1984); Murray v. Cable National Broadcasting Co., 39 U.S.P.Q.2d 1214, 1216 (9 Cir. 1996); Cooper Industries, Inc. v. Repcoparts USA, Inc., 218 U.S.P.Q. 81, 84 (TTAB 1983). In addition, it is well-settled that the likelihood of confusion is reduced where purchasers and potential purchasers of the products or services are sophisticated. See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, inter alia, both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source."). See also TMEP § 1207.01(d) (vii) (care in purchasing tends to minimize the likelihood of confusion). "In making purchasing decisions regarding expensive goods, the reasonably prudent purchaser standard [that is normally applied in determining likelihood of confusion] is elevated to the standard of the 'discriminating purchaser.'" Weiss Associates v. HTL Associates Inc., 14 U.S.P.Q.2d 1840, and 1841-42 (Fed. Cir. 1990). See also Chase Brass & Copper Co., Inc. v. Special Springs, Inc., 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978) (finding no likelihood of confusion between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because "while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same persons in an environment where a likelihood of confusion could occur."); T.M.E.P. § 1207.01(a)(i) ("[I]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.")

Nor does Applicant agree that "the applicant's goods are . . . in the normal field of expansion of the registrant." There is no evidence in the record that such expansion would be normal.

The goods and services listed for the cited marks are for wine. Applicant's goods and services include handbags, canvas shopping bags, tote bags, clothing, shirts, hats, beer, wine, restaurant services and catering services. The cited application's goods are directed to a completely different consumer market. The respective consumers would find the two goods entirely distinct and used in such separate markets that consumers would not believe the sources to be related. Applicant's goods are different, serve different purposes and are purchased by different customers. The goods and services are being purchased by different consumers for unrelated purposes. Accordingly, this factor weighs against a likelihood of confusion.

D. Dissimilarity of the Marks

The examining attorney indicated that there may be a likelihood of confusion between the Applicant's mark for "FUNK ZONE PATIO" and Registration No. 4733318 for Funk Zone. However, the fact remains that there is no likelihood of confusion with Applicant's mark. Applicant's mark is **visually and phonetically different** the registered mark.

One of the primary considerations in testing for likelihood of confusion is the similarity or dissimilarity of the marks in their entireties as to appearance, sound and meaning or connotation. TMEP § 1207.01(b) (i). Applicant's mark is FUNK ZONE PATIO and the mark in the cited registrations is Funk Zone. While the marks both have words funk zone, the applicant's mark also has the word "PATIO. As a result, the applicant's mark is dissimilar in appearance and sound. TMEP § 1207.01(b) (i). The applicant respectfully submits that because the marks are dissimilar in appearance and sound that there is no likelihood of confusion between the marks.

II. Disclaimer of the Wording in the Mark is Inappropriate

The Office has requested a disclaimer of the wording "Patio" on grounds it is descriptive of the services. Applicant respectfully disagrees. A disclaimer of the wording Patio from the mark is inappropriate because: (a) the mark consists of a unitary slogan and (b) any doubt as to descriptiveness should be resolved in favor of Applicant.

A. Funk Zone Patio is a unitary slogan

Applicant asserts that it is not necessary to disclaim Patio because Funk Zone Patio is a unitary slogan.

A slogan is a unitary phrase that should not be broken up for purposes of requiring a disclaimer. TMEP §1213.05(b). The continuum of distinctiveness/descriptiveness indicates that coined/fanciful slogans are unique, unitary taglines or phrases that are displayed and portrayed in a manner that consumers will view the wording together in its entirety, which typically renders the mark as inherently distinctive. TMEP §1209.01. Because consumers generally view slogans as a unitary whole and do not focus on one part/word of the mark as being separable, it is both unnecessary and improper to parcel wording for purposes of a disclaimer. TMEP §1213.05 and TMEP §1209.01. A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate and apart from the meaning of its constituent elements. Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991); see also, In re Kraft, Inc., 218 USPQ at 573 (the elements of a unitary mark are so integrated or merged that they cannot be regarded as separate elements, and it is

obvious that no claim is made other than to the entire mark). In *Kraft*, the Board explained that a unitary mark could be created "where the words which have been put together function as a unit, with each relating to the other rather than directly to the goods." 218 USPQ at 573; see also *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981). To determine whether a composite mark is unitary, the Board must determine "how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark." *Id.*, quoting *In re Magic Muffler Service*, 184 USPQ 125, 126 (TTAB 1974). The Funk Zone Patio mark is a "unitary" slogan, which possesses a non-descriptive meaning that is greater than the sum of its parts. Applicant's mark creates a commercial impression separate and apart from any unregistrable component, as the elements are so merged together that they cannot be divided to be regarded as separable elements. TMEP§ 1213.05. Registrable slogans are considered "unitary" and should not be broken up for purposes of requiring a disclaimer. TMEP§ 1213.05(b). Moreover, when a mark is deemed "unitary" an individual component of the mark that would otherwise be unregistrable need not be disclaimed. TMEP§ 1213.02.

B. Any Doubts Regarding the Mark's Descriptiveness Should Be Resolved In Favor Of Applicant

It is well established that the burden is on the Office to prove descriptiveness of words. In *re TBG, Inc.*, 229 U.S.P.Q. 759, 760 (T.T.A.B. 1986). The Office provides the definition of the words "Patio". However, Applicant reiterates that no disclaimer should be required since the mark as a whole is a unitary slogan. Accordingly, the evidence does not support a disclaimer requirement.

The intent of Section 2(e)(1) and subsequent disclaimers is to protect the competitive needs of others by ensuring that descriptive words and phrases are left free for public use. *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1058 (TTAB 1989). Applicant uses the word "Patio" within a specific, unitary context and the public would not be deprived of the use of these individual terms.

Moreover, any doubt as to whether a mark or wording is descriptive should be resolved in favor of the Applicant. As stated in *McCarthy on Trademarks and Unfair Competition*, because the line between merely descriptive and only suggestive terms is 'so nebulous,' the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in *ex parte* examination. *McCarthy, supra*, § 11.51 at 11-124.

This reasoning has been followed in many cases. For instance, in *In re Penwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972), the Trademark Trial and Appeal Board, in finding that the mark DRI-FOOT for foot deodorant was not descriptive, noted that although the conclusion that DRI-FOOT was not descriptive was not "free from doubt . . . the doubt should be resolved in favor of the applicant." *Id.* See also *In re Women's Publishing Co.*, 23 U.S.P.Q.2d 1876, 1877 (T.T.A.B. 1992) (finding that the mark DECORATING DIGEST for a magazine featuring articles on decorating to be not descriptive and noting that "in accordance with precedent, we must resolve any reasonable doubt in favor of applicant"); *In re Merrill Lynch, Pierce, Fenner and Smith*, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) ("It is incumbent on the Board . . . to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.").

Applicant respectfully submits that it has raised doubts regarding the descriptiveness of "Patio" given the unitary nature of its mark. As such, those doubts should be resolved in favor of Applicant.

Since likelihood of confusion is not probable, the respective goods are distinct, the marks and respective goods are directed to different target markets. Consequently, the differences between the respective marks in this case are more than enough to avoid confusion as to either source of origin or sponsorship. Applicant respectfully requests that there are no potential 2(d) rejections with respect to the current application.

Passage of the application to publication is respectfully requested.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Jaye G. Heybl/ Date: 10/18/2016

Signatory's Name: Jaye G. Heybl

Signatory's Position: Attorney of record, California Bar Member

Signatory's Phone Number: 805-373-0060

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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.

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