

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86963759
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/86963759/large
LITERAL ELEMENT	CHROMA
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.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1-12146203103-20170807194415756942_.CHROMA.Resp.FOA.pdf
CONVERTED PDF FILE(S) (20 pages)	\\TICRS\EXPORT17\IMAGEOUT17\869\637\86963759\xml4\RFR0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Response to Final Office Action and Exhibits A-F.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Jesse A. Salen/
SIGNATORY'S NAME	Jesse A. Salen
SIGNATORY'S POSITION	Attorney of record, California bar member
SIGNATORY'S PHONE NUMBER	(858) 720-8900
DATE SIGNED	08/07/2017
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Aug 07 20:23:31 EDT 2017
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20170807202331388588-8696 3759-5108c9094bb6971aedbb d8573245ae7a70f5a8c9d9365 4435352947277fc867a-N/A-N /A-20170807194415756942

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Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86963759** CHROMA(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/86963759/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of Response to Final Office Action and Exhibits A-F. has been attached.

Original PDF file:

[evi_1-12146203103-20170807194415756942_.CHROMA_Resp_FOA.pdf](#)

Converted PDF file(s) (20 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)
[Evidence-15](#)
[Evidence-16](#)
[Evidence-17](#)
[Evidence-18](#)
[Evidence-19](#)
[Evidence-20](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Jesse A. Salen/ Date: 08/07/2017

Signatory's Name: Jesse A. Salen

Signatory's Position: Attorney of record, California bar member

Signatory's Phone Number: (858) 720-8900

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86963759

Internet Transmission Date: Mon Aug 07 20:23:31 EDT 2017

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XXX-201708072023313

88588-86963759-5108c9094bb6971aedbbd8573

245ae7a70f5a8c9d93654435352947277fc867a-

N/A-N/A-20170807194415756942

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jayden Star LLC

Serial No: 86/963,759

Filed: Apr. 4, 2016

Class: 14

Mark: CHROMA

Examining Attorney

Shaila E. Lewis

Law Office: 114

**REQUEST FOR RECONSIDERATION IN
RESPONSE TO FINAL OFFICE ACTION**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant submits the following remarks and exhibits and requests reconsideration of the Final Office Action mailed on February 6, 2017 (hereinafter “Action”), concurrently with Applicant’s timely filed Notice of Appeal.

REMARKS

I. Likelihood of Confusion

The Action maintains the refusal to register the proposed trademark, “CHROMA,” under Trademark Section 2(d) (15 U.S.C § 1052(d)) because Applicant’s Mark is allegedly confusingly similar to U.S. Registration Nos. 1,302,514 (“KROMA”) as to likely to cause confusion, to cause mistake, or to deceive.

Specifically, the Action alleges that Applicant’s Mark is likely to cause confusion over the Cited Mark because Applicant’s Mark is allegedly similar in appearance, nature of the goods, and trade channels to the Cited Mark. Applicant respectfully disagrees. As discussed in Applicant’s previous response to the Non-Final Office Action, consumers would not likely be confused between these marks because: (1) the marks have different appearances and

connotations; (2) the Cited Mark is only one mark in a crowded field, and therefore should be afforded only narrow protection; and (3) the Action fails to address all but two of the *DuPont* factors, most of which weigh heavily against finding a likelihood of confusion. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

Moreover, and importantly, the Registrant sells its jewelry in connection with the Cited Mark via an entirely different channel of trade. Specifically, Registrant is an online retailer who bypasses traditional commercial jewelry retailers to sell its products in connection with the Cited Mark directly to consumers (e.g., through trade websites such as Etsy). (*See Exhibits A and B.*) In stark contrast, Applicant is a jewelry distributor that exclusively distributes jewelry in connection with Applicant's Mark on a wholesale basis to retailers, many of whom operate traditional bricks and mortar stores. (*See Exhibits C.*) This fact weighs strongly in favor of a finding that there is no likelihood of confusion. *See* TMEP § 1207.01; *Du Pont*, 476 F.2d at 1362-63.

Additionally, Applicant respectfully notes that the Cited Mark—KROMA—is a Hindi word that means “chrome.” (*See Exhibit D.*) When the wording of one mark is entirely in English and the wording of the other marks are entirely in a foreign language, it is clearly established that *all* the relevant *du Pont* factors must be applied to assess whether there is a likelihood of confusion between the marks. *See Id.*; *In re L'Oreal S.A.*, 222 USPQ 925, 926 (TTAB 1984) (noting that “similarity in connotation [of the marks] must be viewed as but a single factor in the overall evaluation of likelihood of confusion.”). For the reasons explained in detail below, there is no likelihood of confusion amongst Applicant's Mark and the Cited Mark in view of all the *du Pont* factors.

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Office Action “must present sufficient evidence and argument that the mark is barred from registration.” *Id.* § 19-128 at 19-383. For the reasons discussed below, the Action, respectfully, has not met its burden.

1. Applicant’s Mark and the Cited Mark Have Different and Distinct Appearances and Connotations

As discussed in Applicant’s response to the Non-Final Office Action, Applicants Mark and the Cited Mark are dissimilar in appearance, connotation, and commercial impression. *See DuPont*, 476 F.2d at 1361. In particular, when comparing an applied-for mark to a registered mark, the marks should not be dissected, and no feature should be ignored. *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (rehearing *en banc* denied).

First, the marks differ in appearance. As an initial matter, the first letters in each mark in each mark is different—‘C’ in the case of “CHROMA” and ‘K’ in the case of “KROMA.” Consumers will easily distinguish these words based on that feature alone.

Second, the marks each incorporate suggestive terms—CHROMA or KROMA, respectively—that have different connotations. For example, as discussed *supra*, the Cited Mark means “chrome” in Hindi (**Exhibit D**) whereas the Applicant’s Mark means “purity of a color,” or “intensity of distinctive hue” (**Exhibit E**). When viewed in the context of jewelry, the Cited Mark suggests to consumers that the jewelry may include “chrome” or, at least, have the appearance of “chrome” metal, whereas the Applicant’s Mark suggests to consumers that the jewelry may be colorful. These are distinct connotations, and thus convey distinct commercial impressions to consumers.

Moreover, the Cited Mark is only a small sample from the large field of registered marks that incorporate words with similar sounds to KROMA and CHROMA—words that are suggestive, in the context of jewelry, of some characteristic of the goods. (See **Exhibit F**.) Indeed, when marks incorporate a suggestive word that is commonly used in other marks in the same class, “consumers are able to distinguish between different...marks based on small differences in the marks.” *In re Hartz Hotel Servs.*, 2012 TTAB LEXIS 75, *16, 102 U.S.P.Q.2D (BNA) 1150, 1155 (Trademark Trial & App. Bd. Mar. 19, 2012). Specifically, in *Hartz Hotel*, the Board found that the marks GRAND HOTELS NYC and GRAND HOTEL were not confusingly similar “because of the highly suggestive nature of the term “Grand Hotel, ” the third-party registrations [five of them in the same class incorporating the words “Grand Hotel”], and the evidence of third-party use of marks incorporating the term “Grand Hotel.” Based on these inferences, the Board “presume[d] that the owner of the cited registration did not have a problem with the registration of these third-party marks, as they all issued after the registration of the cited registrant’s registration without challenge by the registrant.” *Id.*, at *11. Moreover, in view of “the numerous third-party uses” of similar sounding marks to KROMA and CHROMA, and “unlike a situation involving an arbitrary or fanciful mark, the addition of other matter to a laudatory or suggestive word may be enough to distinguish it from another mark.” *Id.*, at *11-12. Indeed, the Cited Mark should be afforded very narrow and limited protection for the word KROMA as incorporated therein. That is to say, “a mark which is hemmed in on all sides by similar marks on similar goods cannot be very distinctive. It is merely one of a crowd of marks.” *See Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988).

Just like the use of GRAND HOTEL in the *Hartz Hotel* case, marks with similar sounding words to KROMA and CHROMA appear in numerous third-party marks (*e.g.*,

CHROME HEARTS, CROME, CHROME MARCASITE, CHROME GIRL, CHROMCRAFT REVINGTON, etc.) —none of which were opposed by the registrant of the Cited Mark. Specifically, 18 live and registered marks appear in the U.S. Patent and Trademark Office’s TESS database that incorporate these similar sounding terms and are used in connection with jewelry. (**Exhibit F**.) Similar to the owner of the GRAND HOTELS NYC mark in *Hartz Hotel*, neither the owner for the Cited Mark, nor the U.S. Patent and Trademark Office itself (the “Office”), opposed registration of any of those subsequently filed marks. Thus, not only is the registrant of the Cited Mark amenable to the coexistence of its mark with the subsequently filed third party marks listed in **Exhibit F**, the Office itself has previously been satisfied that no likelihood of confusion exists between those marks sufficient to bar registration.

Moreover, the present case is even more compelling against finding a likelihood of confusion when considering that the Board in *Hartz Hotel* found that two marks that were virtually identical, in that they overlapped with two words that made up nearly the entire content of each mark (GRAND HOTELS NYC and GRAND HOTEL), were nevertheless not likely to elicit confusion in the marketplace. In contrast, here, the Applicant’s Mark only overlaps the Cited Mark by a portion of a single word (.ROMA) as compared with Applicant’s Mark (CHROMA). Thus, this is an exemplary case whereby the suggestive nature of the words “CHROMA” and “KROMA,” the crowded nature of the field of marks incorporating that word, and the lack of resistance to new entrance of third party marks that incorporate the word elicit the conclusion that consumers would not be confused by an allowance of Applicant’s Mark *Hartz Hotel*, 2012 TTAB LEXIS 75, at *16.

2. The Action Fails To Consider Other DuPont Factors

The Action only applies a portion of the *DuPont* test despite the existence of evidence relating to other factors. In analyzing whether there is a likelihood of confusion, the Action must

consider all relevant *DuPont* factors. *Du Pont*, 476 F.2d at 1361. In particular, in addition for the reasons explained above, at least the following *DuPont* factors, have not been considered by the Action, which weigh heavily against a finding of likelihood of confusion: (1) Applicant's and Registrant's distinct channels of trade; (2) the Cited Mark is not famous and therefore deserves only narrow protection; (4) there has yet to be any actual confusion; and (5) the *de minimis* effect of any potential confusion.

First, as discussed above, Applicant and Registrant use their respective marks to sell jewelry through distinct channels of trade. Specifically, Registrant uses the Cited Mark to bypass commercial retailers and sell jewelry directly to consumers (e.g., through trade websites such as Etsy). (See **Exhibits A and B**.) In stark contrast, Applicant uses Applicant's Mark to distribute jewelry to those commercial retailers, who in turn, sell the jewelry to consumers, usually through traditional bricks-and-mortar stores. (See **Exhibits C**.) This fact weighs strongly in favor of a finding that there is no likelihood of confusion. See TMEP § 1207.01; *Du Pont*, 476 F.2d at 1362-63.

Second, the lack of notoriety of the Cited Mark further supports the Applicant's position that its mark is not likely to confuse consumers. See *DuPont*, 476 F.2d at 1361. A well-known or famous mark is entitled to a broader scope of protection than one which is relatively unknown. See *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1900 (TTAB 1989). The Cited Mark is not a famous mark like MCDONALD'S, COCA-COLA, NIKE, or APPLE. Indeed, an Internet search for the cited brands has failed to even identify a single use of the Cited Mark in commerce, nor has the Office Action identified any such use¹. Thus, the Cited Mark clearly has a very limited presence in the market, if any at all. Under these circumstances, the Cited Mark is only entitled to a narrow scope of protection for the services identified in its description and no

¹ The Cited Mark is likely subject to cancelation for non-use.

more. The fact that the Cited Mark is not famous weighs in favor of a finding that there is no likelihood of confusion.

Third, the Action does not cite, and Applicant is not aware of any evidence indicating there has been actual confusion in the marketplace between the Cited Mark and any of the 18 similar co-registered marks identified in **Exhibit F**, nor with the Applicant's Mark. Indeed, as discussed above, it appears that the Cited Mark is not even used in commerce at this time, or is at least, difficult to find in the marketplace. This fact also weighs in favor of a finding that there is no likelihood of confusion. Third, any actual confusion would be *de minimus* in nature. In the highly unlikely scenario that a consumer does indeed mistakenly purchase Applicant's jewelry thinking it was associated with the Cited Mark and/or the registrant's goods, that consumer would merely need to return the mistakenly purchased jewelry for a refund. Additionally as discussed above, there is no evidence that a consumer could even purchase the registrant's goods, as goods advertised in connection with the Cited Mark could not be found. The *de minimus* impact of confusion also weighs against refusing registration to the Applicant's Mark.

Accordingly, in view of all of the *DuPont* factors as discussed above, there is no likelihood of confusion amongst the Applicant's Mark and the Cited Mark. Thus, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register and allow the mark.

CONCLUSION

In view of the analysis discussed above, Applicant respectfully submits that its mark is not confusingly similar to the Cited Mark. Accordingly, Applicant respectfully requests the withdrawal of the refusal to register and that the mark be allowed.

Respectfully submitted,

Dated: August 7, 2017

/Jesse Salen/

Jesse Salen

SHEPPARD MULLIN RICHTER & HAMPTON LLP

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Telephone: 858 720 8900

Facsimile: 858 509 3691

Exhibit A



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kroma jewelry



KromaJewelry

Dichroic Glass Jewelry and Art

📍 Gulfport, Florida | 38 Sales | On Etsy since 2012

★★★★★ (9)

♡ Favorite shop (48)

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	15
rings	3
s	1
endants	1
js	2
laces	1
celets	3

✉ Contact shop owner

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dmirers

Five piece dichroic pendant
\$180.00Blue Green Dichroic Ring Set In S...
\$150.00Dichroic Glass Blue Necklace Set ...
\$150.00Dichroic Glass Bracelet With Vari...
\$400.00Blue And Green Dichroic Glass N...
\$300.00Dichroic Glass 3 Piece Ring
\$125.00

Exhibit B

kroma jewelry - Google X

Secure | https://www.google.com/search?q=kroma+jewelry&rlz=1C1CHZL_enUS743US743&oq=kroma+jewelry&...

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kroma jewelry

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Searching for the perfect kroma jewelry items? Shop at Etsy to find unique and handmade kroma jewelry related items directly from our sellers.

Dichroic Glass Jewelry and Art by KromaJewelry on Etsy

<https://www.etsy.com/shop/KromaJewelry>

Jul 19, 2016 - Browse unique items from KromaJewelry on Etsy, a global marketplace of handmade, vintage and creative goods.

kroma jewelry – Etsy

<https://www.etsy.com/search?q=kroma+jewelry>

Shop for kroma jewelry on Etsy, the place to express your creativity through the buying and selling of handmade and vintage goods.

Kroma Dichroic Jewelry Designers - Art Glass by Gary

artglassbygary.com/Jewelry-Designers/Kroma-c94/

Artists Biography * Designers of Silver & Glass Jewelry. Kroma has been making decorative glass products for many years. We specialize by using Dichroic glass ...

Images for kroma jewelry



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Report images

Kroma Jewelry Designers Seven Gemstone Pendant Three Bar Ring

artglassbygary.com/Jewelry.../Kroma/Seven-Stone-Snake-Chain-Necklace-p526.html

Kroma Jewelry Designers. Fashion designed exquisite seven gemstone pendant, set in 92.5 fine sterling silver. Gemstones are set on 18.5" snake chain and ...

Kroma Studio - Home | Facebook

<https://www.facebook.com/Kroma-Studio-359508050812478/>

See more of Kroma Studio by logging into Facebook ... Fused glass jewelry class in Gulfport, FL. KROMA ART has added more jewelry to our ETSY SITE!!

Amazon.com: Kroma

<https://www.amazon.com/Kroma/pages/9389137011>

Results 1 - 16 of 27 - Online shopping for Kroma at Amazon.com. ... iPhone 6S Glass Screen Protector, Kroma™ [Krystalin Series] World's Thinnest Ballistic Glass, ...

Dichroic glass Konfetti necklace by Kroma | Art Glass | Pinterest ...

<https://www.pinterest.com/pin/5277724536328424/>

Dichroic glass Konfetti necklace by Kroma. ... Pink and Purple Necklace Dichroic Glass Pendant Pink Dichroic Jewelry. Dichroic Glass JewelryGlass ...

Exhibit C

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Thousands of new products to see in a booth designed to get you in and out in 15 minutes.



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Once you complete the sign-up process we will promptly approve your application. After you are approved you will be able to view our entire collection of jewelry.



[CLICK HERE TO REGISTER](#)

Exhibit D

English Hindi Dictionary | अंग्रेज़ी हिन्दी शब्दकोश

Q Search

Keyboard: OFF Language: ENGLISH

Forums



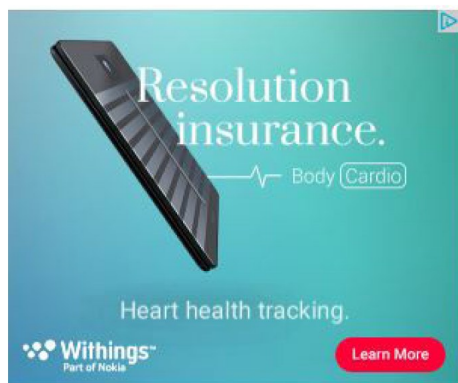
Interpreted your input "kroma" as "क्रोम".

 krōma kroma

Meanings of क्रोम in English

noun

1.  chrome (m)



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Synonyms of क्रोम

No matches.

Antonyms of क्रोम

No matches.



Exhibit E

Google Wifi



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fast Wi-Fi for all

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chroma 🔊

[**kroh**-muh]

Word Origin

[See more synonyms on Thesaurus.com](#)

noun

1. the purity of a color, or its freedom from white or gray.
2. intensity of distinctive hue; saturation of a color.

Origin of chroma



1885-90; < Greek *chrôma* color

Dictionary.com Unabridged

Word of the Day

katzenjammer 🔊

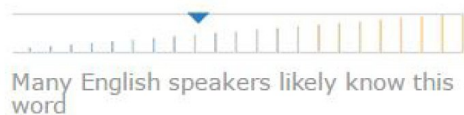
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Difficulty index for chroma



Word Value for chroma

13	14
Scrabble	Words With Friends

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Ghosting defined

Exhibit F



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Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
501149		KROMAGNON	TSDR	LIVE
501071		KROMAGNON	TSDR	LIVE
009707		CHROMA CRYSTALS	TSDR	LIVE
963759		CHROMA	TSDR	LIVE
026755	4504948	CHROME HEARTS	TSDR	LIVE
037094	4501511	CHROME HEARTS	TSDR	LIVE
026699	4510061	CHROME HEARTS	TSDR	LIVE
057677	3937133	CH	TSDR	LIVE
06000	4407734	RADO HYPERCHROME	TSDR	LIVE
370752	4169450	CHROME MARCASITE	TSDR	LIVE
192628	2978428	CHROME GIRL	TSDR	LIVE
547428	3944755	CHROMCRAFT REVINGTON	TSDR	LIVE
590713	2954539	CH	TSDR	LIVE
892230	2531301	SPECTRACHROME	TSDR	LIVE
476249	2216570	CHROME HEARTS	TSDR	LIVE
490650	2307126	CHROME HEARTS	TSDR	LIVE
399215	2284625	CHROME HEARTS	TSDR	LIVE
106186	1665791	CHROME HEARTS	TSDR	LIVE
444650	1302514	KROMA	TSDR	LIVE

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