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Subject: U.S. TRADEMARK APPLICATION NO. 87298620 - BOYY - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87298620

MARK: BOYY



CORRESPONDENT ADDRESS:

MARY A DONOVAN

COWAN LIEBOWITZ & LATMAN PC

114 WEST 47TH STREET

NEW YORK, NY 10036

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Boyy Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

trademark@cjl.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's¹ refusal to register the trademark "BOYY" on the ground that the applied-for mark is likely to cause confusion with the mark in U.S. Registration No. 4722172 under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Additionally, applicant

¹ The Office has reassigned this application to the undersigned trademark examining attorney.

has appealed the trademark examining attorney's refusal to register the trademark "BOYY" on the ground that the applied-for mark is merely descriptive under Trademark Act 2(e)1, 15 U.S.C. §1052(e)(1)

I. FACTS

Applicant, Boyy Inc., applied to register the standard character mark, "BOYY", for use in connection with "sunglasses; eyeglasses" in International Class 009 on January 12, 2017.

On January 31, 2017, the trademark examining attorney sent an Office action refusing registration of the applied-for mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d) with the mark in U.S. Registration No. 4722172, "BOY", for use in connection with "Jewelry; Wristwatches" in International Class 014, and "Belts for clothing; Footwear for men and women; Headgear, namely, hats, cap; Men's and women's jackets, coats, trousers, vests; Men's suits, women's suits; Men's underwear; Sweatshirts for babies, adults, children, women, men; T-shirts for babies, adults, children, women, men; Women's clothing, namely, shirts, dresses, skirts, blouses" in International Class 25. The trademark examining attorney also refused registration because the applied-for mark merely describes the intended user of applicant's goods under Trademark Act Section 2(e)1, 15 U.S.C. §1052(e)(1),

On July 31, 2017, applicant submitted arguments against both refusals. On August 7, 2017, the trademark examining attorney issued a Final Office action refusing to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d) with the mark in U.S. Registration No. 4722172, as well as a refusing to register the mark under Trademark Act Section 2(e)1, 15 U.S.C. §1052(e)(1) for being merely descriptive.

On February 7, 2018, applicant submitted a Request for Reconsideration after the final office action and instituted this appeal. On February 15, 2018, the trademark examining attorney denied applicant's Request for Reconsideration.

II. ARGUMENT – SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant(s). See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

In this case, the Applicant’s applied-for mark “BOYY” and registrant’s mark “BOY” are likely to be confused by potential consumers because the goods of the applicant and the goods of the registrant are closely related and the marks are phonetic equivalents and have similar commercial impressions.

a. The Marks are Similar in Appearance, Sound, Meaning, and Overall Commercial Impression.

Applicant’s mark is “BOYY” in standard characters and registrant’s mark is “BOY” in standard characters. The marks are highly similar as the marks are phonetic equivalents that differ only by one letter.

Applicant’s mark “BOYY” and registrant’s mark “BOY” are phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly

similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Additionally, the fact that the applicant's mark and registrant's mark differ by one letter does not obviate the refusal. The registrant's mark is entirely incorporated within the applicant's mark. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); TMEP §1207.01(b)(iii).

Because the marks are phonetic equivalents that are identical in sound and similar in appearance, the marks have potential to be used in exactly the same manner. Accordingly, the marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods. *In re i.am.symbolic, llc*, 116 USPQ2d at 1411. Therefore, the marks are confusingly similar for purposes of the likelihood of confusion analysis.

Applicant argues that the marks are not similar because the applied-for mark "has priority over the Cited Registration by virtue of Applicant's earlier incontestable registration..."² Applicant clarifies that it is not attempting to establish a family of marks but rather make a showing that the applicant is "moving into a natural area of expansion in which he has been selling for many years."³ This argument remains unpersuasive. The issue at hand is whether the applied-for mark is likely to cause confusion with the cited registration, and not whether the applied-for mark has become distinctive in connection with the applied-for goods as a result of a prior registration. An applicant's ownership of other similar

² Please see applicant's Response to Office action dated July 31, 2017 page 3.

³ Please see applicant Appeal Brief page 8.

marks has little relevance in this context because the focus of a likelihood of confusion analysis in an *ex parte* case is on the mark applicant seeks to register, rather than other marks applicant has used or registered. *In re Cynosure, Inc.*, 90 USPQ2d at 1645-46; *In re Ald, Inc.*, 148 USPQ 520, 521 (TTAB 1965); TMEP §1207.01(d)(xi). The case set forth by the applicant, *Brookfield Comms. Inc. v. West Coast En'mt Corp.*, discusses that an applicant may “tack on” use to support a claim of distinctiveness. However, this does not rise to level of claiming priority of use as to overcome a likelihood of confusion. Likewise, marks that are considered “legal equivalents” because they create the same, continuing commercial impression such that the consumer would consider them both the same mark, does not mean that the applicant may then claim a priority of use over a cited registration.

Additionally, the “expansion-of-trade doctrine” is normally applied in *inter partes* rather than *ex parte* proceedings. *Per* TMEP 1207.01(a)(v):

“*See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015) (noting that the “natural zone of expansion” doctrine normally applies in *inter partes* cases in the context of the parties’ dueling claims of priority); 1st USA Realty Prof’ls, 84 USPQ2d at 1584. However, in the *ex parte* context, the normal relatedness analysis is applied: [W]e look at the question of the relatedness of the services identified in applicant's application and those in the cited registration based on whether consumers are likely to believe that the services emanate from a single source, rather than whether the Examining Attorney has shown that the registrant . . . has or is likely to expand its particular business to include the services of applicant.”

As this is an *ex parte* proceeding, the normal relatedness analysis is applied.

Further, applicant argues that it would “unfairly prejudice Applicant to prevent it from expanding to closely related goods due to an intervening registration.”⁴ As noted above, that *ex parte* examination of the instant application is not the appropriate venue for applicant to raise issue with the

⁴ Please see applicant Appeal Brief page 9.

“intervening registration.” Thus, this argument is unpersuasive in regards to the finding that the applied-for mark is likely to be confused with the mark in the cited registration.

Applicant also argues that the marks are not similar because the applied-for mark spells the word “BOYY” with two letters “Y”, and this “distinctive misspelling” distinguishes the parties’ marks.⁵ This argument is unpersuasive. Despite the difference in spelling, the marks nonetheless sound the same. The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Applicant further argues that the marks are not similar because “it is not clear that a consumer would immediately equate the mark BOYY with the common term “boy” but might think it an acronym or a foreign term.”⁶ This argument is unpersuasive. There is no evidence of record to suggest that the wording “BOYY” written with two letters “Y” refers to a foreign acronym of which consumers in the United States would recognize. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Applicant further argues that “there is no rule that confusion is automatically likely if a junior user has a mark that begins with the beginning of another’s mark.”⁷ This argument is unpersuasive.

⁵ Please see applicant Response to Office action dated July 31, 2017 page 9.

⁶ Please see applicant Appeal Brief page 4.

⁷ Please see applicant Appeal Brief page 5.

Applicant's mark does not merely "begin" with another's mark, applicant's mark entirely incorporates the registrant's mark and only differs by one letter. There are no other words or phrases to differentiate applicant's mark from the registrant's mark. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part. Thus, the terms "BOYY" and "BOY" appear and sound highly similar as to create the same overall commercial impression amongst consumers.

Lastly, The Trademark Act not only guards against the misimpression that the senior user is the source of a junior user's goods, but it also protects against "reverse confusion," where a significantly larger or prominent junior user is perceived as the source of a smaller, senior user's goods such that the "senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user" for related goods. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1329, 123 USPQ2d 1744, 1752 (Fed. Cir. 2017) (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994).

b. Applicant's Goods are related to Registrant's Goods.

The goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, applicant’s goods “sunglasses; eyeglasses” in International Class 9 are related to registrant’s goods “Belts for clothing; Footwear for men and women; Headgear, namely, hats, cap; Men's and women's jackets, coats, trousers, vests; Men's suits, women's suits; Men's underwear; Sweatshirts for babies, adults, children, women, men; T-shirts for babies, adults, children, women, men; Women's clothing, namely, shirts, dresses, skirts, blouses” in International Class 25 as these are goods are both sold together and marketed under the same mark.

Confusion as to the source of the respective goods is likely in this case because, as shown by the evidence attached to prior Office actions, applicant’s goods and registrant’s goods are provided by the same entity and marketed under the same mark. The evidence consists of several third party websites showing the goods of the applicant and goods of the registrant within the same trade channels as well as several third party registrations showing the same. Specifically, the trademark examining attorney has attached the following in prior Office actions:

- Belk.com (Office action dated 1/31/17 pgs. 7-26)
 - Pages 7-22 show a variety of clothing under the same brand
 - Pages 17-20, 23-26 show a variety of eyewear under the same brand

- DesignerOptics.com (Office action dated 1/31/17 pgs. 27-29 and pgs. 90-92)
 - Show designer Calvin Klein® eyewear
 - Show designer Ralph Lauren® eyewear
- Macys.com (Office action dated 1/31/17 pgs. 30-55)
 - Show designer Calvin Klein® jewelry and clothing
- CalvinKlein.us (Office action dated 1/31/17 pgs. 56-65)
 - Show website providing watches and clothing under the mark Calvin Klein®
- HM.com (Office action dated 1/31/17 pgs.66-70)
 - Show website providing clothing, jewelry, watches
- Gap.com (Office action dated 1/31/17 pgs. 71-89)
 - Show website providing eyewear and clothing
- RalphLauren.com (Office action dated 1/31/17 pgs. 93-95)
 - Show website providing clothing under the mark Ralph Lauren®

Additionally, in the Final Office action dated August 7, 2017, the trademark examining attorney attached evidence from the USPTO's X-Search database consisting of a representative sample of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case.⁸ All of this evidence shows that the goods listed therein, namely sunglasses, eyeglasses, and jewelry, are of a kind that may emanate from a single source under a single mark. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii). Applicant even agrees that the goods are related.⁹

⁸ Please see Final Office action dated August 7, 2017 pages 2-36

⁹ Please see applicant Appeal Brief page 7 which states "The Examining Attorney has himself submitted almost 100 exhibits to the effect that the goods are related by showing that clothing companies, particularly by designers, often make a range of products from clothing, shoes, jewelry, bags, sunglasses, fragrance and beauty products. Indeed both parties submitted evidence to support this."

Applicant argues that the goods are not likely to be confused because consumers of applicant's goods will exercise a high degree of care when purchasing applicant's goods because the goods are "clearly high-end."¹⁰ This argument is unpersuasive. The fact that applicant's goods may be classified as "luxury," have a higher cost, or made from "exotic or rare materials"¹¹ does not make the applicant's products immune from trademark confusion. The identity of the marks and the relatedness of the goods "outweigh any presumed sophisticated purchasing decision." *In re i.am.symbolic, llc*, 116 USPQ2d at 1413 (citing *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

Additionally, where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a).

Applicant further argues that that confusion is not likely because consumers of the applicant's goods are sophisticated in the field of eyewear.¹² The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for

¹⁰ Please see applicant Response to Office action dated July 31, 2017 page 9.

¹¹ Please see applicant Response to Office action dated July 31, 2017 page 11.

¹² Please see applicant Response to Office action dated July 31, 2017 page 11.

purchasing the goods is that of the least sophisticated potential purchaser. *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163).

Applicant argues that, while agreeing “with the Examining Attorney that the goods are overlapping and/or similar,” there is no confusion as to the source of the goods.¹³ Applicant’s argument is based on the fact that there “are over 800 citations of active applications and registrations for clothing products per TTABVue.” This argument is unpersuasive. First, applicant has not attached over 800 citations of active applications for consideration but rather 15 third party registrations in order to show that the goods of the applicant and registrant are similar.¹⁴ These registrations are not probative to show that the use of the singular term “BOY” in relation to the goods in question is weak or dilute. Evidence comprising only a small number of third-party registrations for similar marks with similar goods, as in the present case, is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, Ilc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few registrations are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; *see Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Thus, the few similar third-party registrations submitted by applicant which contain the wording “BOY” are insufficient to establish that the wording ‘BOY’ is weak or diluted. Applicant’s evidence only further shows that the goods of the applicant and registrant are highly related and travel in the same trade channels.

III. ARGUMENT – SECTION 2(e)1 REFUSAL - MERELY DESCRIPTIVE

a. *The applied-for mark is merely descriptive of applicant’s goods.*

¹³ Please see applicant Appeal Brief page 3.

¹⁴ Please see applicant response to Office action dated July 31, 2017, pages 21-31 attaching ten active registrations and applicant Request for Reconsideration dated February 7, 2018, pages 5-13, attaching five active registrations.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In this case, the applied-for mark "BOYY" is used to identify sunglasses and eyeglasses. The fact that the applied-for mark is a novel spelling does not obviate the refusal as it is the phonetic equivalent of the descriptive term "BOY." A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. *See In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 526 & n.9, 205 USPQ 505, 507 & n.9 (C.C.P.A. 1980) (holding "QUIK-PRINT," phonetic spelling of "quick-print," merely descriptive of printing and photocopying services); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1163 (TTAB 2017) (holding "SHARPIN", phonetic spelling of "sharpen," merely descriptive of cutlery knife blocks with built-in sharpeners); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding "URBANHOUSING," phonetic spelling of "urban" and "housing," merely descriptive of real estate services); TMEP §1209.03(j).

The attached evidence from the January 31, 2017 Office action defines “BOY” as “a male child.”¹⁵ Additionally, the attached evidence from the August 7, 2017 Final Office action provides several third party websites showing that the term “boy” is often used in association with eyeglasses and sunglasses to market these goods that are intended to be used by male children and/or male adults. The third party websites evidence consists of:

- FramesDirect.com (Final Office action dated 8/7/17 pgs. 41-44)
 - Shows website page entitled “Sunglasses for BOYS”
- OldNavy.com (Final Office action dated 8/7/17 pgs. 45-51)
 - Shows website page entitled “BOYS SUNGALSSES”
- Amazon.com (Final Office action dated 8/7/17 pgs. 52-65)
 - Shows products listed under the category “BOYS’ SUNGLASSES” (52-61)
 - Shows products listed under the category “Boy eyeglasses” (62-65)
- JonasPaulEyewear.com (Final Office action dated 8/7/17 pgs. 66-71)
 - Shows products available under “Shop boys glasses”

The attached evidence from the Final Office action dated 8/7/17 also includes a screenshot from applicant’s own website which states “The design language of the brand meets the eye with fundamental, masculine shapes and sharp lines that bear high quality details...”

Based on this evidence, the applied-for mark is merely descriptive of the intended users of applicant’s goods, namely, goods intended to be used by male children. A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g., In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ

¹⁵ Please see attached evidence from A Dictionary from the Office action dated January 31, 2017 pages 96-98.

1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); see TMEP §1209.03(i). Thus, registration must be refused under Section 2(e)(1) of the Trademark Act.

Applicant argues that the applied for mark “would not immediately glean the nature of those goods from the mark.”¹⁶ This argument is unpersuasive. The test is not whether consumers would be able to surmise the applied-for goods merely by looking at the applied-for mark but rather whether the applied-for mark considered in relation to the applied-for goods conveys a feature of the goods. The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). In this case, the applied-for mark “BOYY” considered in relation to applicant’s goods “sunglasses and eyeglasses” immediately convey the intended audience of applicant’s goods, namely, a young male.

The fact that the applied-for mark does not describe all possible target audiences or other goods of the applicant does not make the applied-for mark suggestive. “A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re*

¹⁶ Please see applicant Response to Office action dated July 31, 2017 page 12.

The Chamber of Commerce of the U.S., 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Lastly, two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods to the public in advertising and marketing materials. See *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). Therefore, as there is no doubt as to whether the mark is descriptive, registration is rightfully refused.

IV. CONCLUSION

Applicant's applied-for mark "BOYY" and registrant's mark "BOY" are likely to be confused by potential consumers because the goods of the applicant and the goods of the registrant are closely related and the marks are phonetic equivalents and have similar commercial impressions. Therefore, consumers encountering applicant's mark and the cited mark in the marketplace are likely to mistakenly believe that the goods emanate from a common source. Additionally, the applied-for mark "BOYY" merely describes the intended consumers of the applicant's identified goods, "sunglasses; eyeglasses." For the foregoing reasons, it is respectfully requested that the Board affirm the refusals under Section 2(d) of the Trademark Act 15 U.S.C. § 1052(d), and Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e).

Respectfully submitted,

/Alexandra Suarez/

Trademark Examining Attorney

U.S. Patent and Trademark Office

Law Office 120

p) 571-272-4845

e) alexandra.suarez@uspto.gov

David Miller

Managing Attorney

Law Office 120