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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 87351374

MARK: ROMABIO



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: ROMA USA, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/16/2018

INTRODUCTION AND PREVIOUS ACTIONS

This letter is in response to applicant's communication of February 23, 2018.

On May 25, 2017, the examining attorney refused registration of the applied for mark for likelihood of confusion with U.S. Registration No. 4311113 under Trademark Act Section 2(d). In addition, the examining attorney required an amended mark description.

Applicant's August 8, 2017 response satisfied the requirement for an amended mark description. However, on August 31, 2017, the examining attorney issued a Final refusal based on Trademark Act Section 2(d) for likelihood of confusion.

Applicant requested reconsideration on January 5, 2018. Having considered all of applicant's arguments and found them unpersuasive, and given that such request did not raise any new issues, the examining attorney denied request for reconsideration on January 30, 2018.

On February 23, 2018, applicant filed an appeal to the Trademark Trial and Appeal Board and requested a second reconsideration.

The trademark examining attorney has carefully reviewed all of the evidence and arguments in applicant's February 23, 2018 request for reconsideration and is **denying** the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a).

The following refusal made final in the Office action dated August 31, 2017 is maintained and continues to be final: Trademark Act Section 2(d) for likelihood of confusion. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, as discussed below, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110

USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

The marks are identical in part

As previously discussed, the marks begin with the same wording, ROMA, which is identical in appearance, sound, and overall commercial impression, and, which as applicant points out in its response, conjures a mental association with Rome, Italy and its role in art during the Renaissance period. See previously attached Internet evidence. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Because ROMA is the first wording in the marks, consumers will focus on it for source identification, thereby making it the dominant feature of the marks. Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat’l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

Descriptive wording added to applicant’s mark does not reduce likelihood of confusion

The applicant's mark also includes the wording BIO. However, this addition is insufficient to obviate the similarities between the marks. Specifically, the ‘BIO’ portion of applicant’s

mark refers to the term “biological” and therefore is descriptive of a quality of the paint. See [previously attached evidence](#) from applicant’s website, stating:

“Our products are BIO (bio-logical), made from nature. They are not acrylic or latex paints. Our products are derived from minerals and eco-sustainable resources ... not petroleum resources [*emphasis added*]”

In addition, the attached third party evidence demonstrates that third parties commonly use the prefix “bio” to describe the quality of their paint, namely, that it is derived from natural products or is less harmful for the environment than traditional, or non-bio, paint.

- Scientific research report describing creation of “bio-based paint”: https://www.dsm.com/markets/paint/en_US/technologies/discovery/meet-our-partners/ppg.html (“...manufacturer PPG developed a resin which met the specific needs that PPG had envisioned for Sigma Air Pure, a bio-based wall paint with an air purification effect.”)
- <http://www.ecoathome.com.au/bio-wall-paint-white-4l-70610-012-5/> (“Bio Wall Paint HD (Heavy Duty) is a matt interior paint based on natural, non toxic ingredients. The paint has a pleasant smell and is available in a range of harmonious natural colours...”)
- <http://www.ecoprocoate.com/DuraSoy-One-Bio-Based-Paint-s/114.htm> (“Advanced bio-based chemical engineering is a smarter alternative replacement for toxic solvents traditionally found in paints without compromising performance.”)
- <http://www.daviespaints.com.ph/products/interior-paints/davies-bio-fresh+/> (“DAVIES Bio-Fresh+™, with ultra low volatile organic compound (VOC) level, emits less pollutants into the air and has no unpleasant smell which normally comes with ordinary paints.”)

- <https://www.proremodeler.com/benjamin-moore-bio-renewable-paint> (“Benjamin Moore’s Natura Renew is a premium, bio-renewable paint that is highly durable and plant-based with zero emissions and low odor. It contains up to 40 percent bio-renewable materials and is available in thousands of colors with an eggshell and semi-gloss finish. It is designed to cater to consumers in the growing LOHAS (Lifestyles of Health and Sustainability) U.S. market.”)
- Scientific research report defining “bio-paint”: <https://www.emeraldinsight.com/doi/abs/10.1108/PRT-02-2015-0022> (“Bio-paints are eco-friendly natural paints, low volatile organic compounds (VOC) paints or organic paints alternate to conventional paints.”)

This evidence demonstrates that the wording BIO, with respect to applicant’s goods, does not serve a source identifying function, but rather merely describes a quality of applicant’s goods. Matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)). Thus, this wording is less significant in terms of affecting the mark’s overall commercial impression, and the wording ROMA remains the dominant element of the marks.

Considering applicant’s mark in light of the two ROMA marks presently registered and referenced by applicant (Registration Nos 4737087 and 2463529)—not including the cited registration— applicant’s mark differs because it contains the identical matter ROMA plus the descriptive matter BIO. The other registrations contain the identical matter ROMA plus distinctive prefixes and suffixes ARCH and TEX. The addition of distinctive matter on these marks differentiates them in a meaningful way from the registration, while the inclusion of the descriptive matter BIO in the applied for mark does not. *Id.*

Further, even if potential purchasers realize the apparent differences between the marks, they could still reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that applicant’s goods and services sold under the “ROMABIO” mark constitute a new or additional product line from the same source as the goods and services sold under

the “ROMA” mark with which they are acquainted or familiar, and that applicant’s mark is merely a variation of the registrant’s mark. *See, e.g., SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant’s marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an association by consumers with opposer’s preexisting mark [ANDREA SIMONE] for its established line of clothing.”).

Respective design elements in the marks do not diminish likelihood of confusion

The applicant's mark also includes the design of stars and a wolf head forming the letter “R,” and the registrant's mark contains the design of a column with a wolf standing on top. However, these additions are insufficient to obviate the similarities between the marks. In fact, although the designs are different in overall appearance, they both contain the common element of a wolf, which, because it is considered a symbol for Rome, tends towards a similarity in overall commercial impression and therefore a likelihood of confusion. *See* previously attached Internet evidence.

Existing third-party registration do not mitigate likelihood of confusion

Applicant argues that six third-party registrations for similar goods containing the wording ROMA in some form is evidence of dilution to such a degree that the registration should be afforded limited protection.

As previously discussed, third-party registrations are entitled to little weight on the issue of confusing similarity because the registrations are “not evidence that the registered marks are actually in use or that the public is familiar with them.” *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); *see* TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Total Quality Grp., Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

In addition, the examining attorney notes that while evidence of widespread third-party use of similar marks with similar goods and/or services “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection” in that particular industry or field, evidence comprising only a small number of third-party registrations for similar marks with similar goods and/or services, as in the present case, is generally entitled to little weight in determining the strength of a mark. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003); See *In re i.am.symbolic, llc*, 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 are insufficient to establish that the wording ROMA is weak or diluted.

Applicant also argues that because the ROMA portion of the cited mark is weak it is afforded less protection and should not be considered the dominant portion of the mark in the analysis of similarity of the marks. Applicant asserts that precedent from the Federal Circuit and the Trademark Trial and Appeal Board support this conclusion.

The examining attorney notes that ROMA is disclaimed in the registration. However, the examining attorney also notes that the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). In addition, the consuming public is largely unaware that a portion of a mark may be disclaimed or what that disclaimer means. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985), citing *Sleepmaster Products Co. v. American Auto-Felt Corp.*, 241 F.2d 738, 741, 113 USPQ 63, 65 (CCPA 1957). *Accord, Paul Sachs Originals Co. v. Sachs*, 217 F. Supp. 407, 417, 137 USPQ 240, 247 (S.D. Cal.), *aff’d*, 325 F.2d 212, 139 USPQ 414 (9th Cir. 1963).

Further, the underlying facts in the cases referenced by applicant in support of its arguments are different than those at issue here. These differences make the findings in those cases inapplicable to the present case. Specifically, in *Juice Generation Inc. v. GS Enterprises LLC*, 794 F. 3d 1334 (Fed. Cir. July 20, 2015) the Federal Circuit found the Board's refusal to register the mark to be in error because of the weakness of the matter in common between the marks; however, in that case, the evidence of record included eight examples of third-party uses and an additional twelve registrations containing matter identical to that of the applicant and registrant in that case. Here, applicant has identified six registrations, only two of which contain the wording ROMA, rather than ROMAN; and, as discussed, the examining attorney disputes the similarity of ROMA versus ROMAN marks.

Likewise, applicant's analysis of *In re Sanyet Ferdinand*, Serial No., 77965837, (TTAB Sept. 7, 2012) (not precedential) fails to consider that the services at issue between the applicant and registrant in that case were different – distributorship of perfume goods versus retails services related to perfume. Where the goods and/or services of an applicant and registrant are “similar in kind and/or closely related,” as they are here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

In addition, while the design portion of the application in *In re Sanyet Ferdinand* was found to be the dominant and distinctive portion of the mark in light of the geographical overall descriptiveness of the wording, as discussed, such a finding is not helpful to applicant in this case because applicant's mark and the registration both depict a wolf.

Relatedness of the Goods

The goods of the parties 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) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods 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).

As previously discussed, and as applicant does not dispute, the applicant's goods are not only closely related to the registrant's, but are in fact encompassed by registrant's goods.

Because the marks are confusingly similar and the goods are closely related, consumers are likely to be confused as to the source of the goods. Thus, registration is refused pursuant to Trademark Act Section 2(d).

Accordingly, the request for reconsideration is denied.

WHAT HAPPENS NEXT

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

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PRODUCTS

Benjamin Moore Bio-Renewable Paint

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April 24, 2014



Benjamin Moore's Natura Renew is a premium, bio-renewable paint that is highly durable and plant-based with zero emissions and low odor. It contains up to 40 percent bio-renewable materials and is available in thousands of colors with an eggshell and semi-gloss finish. It is designed to cater to consumers in the growing LOHAS (Lifestyles of Health and Sustainability) U.S. market.

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