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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91222153
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 79/151,042
Filed on June 6, 2014
For the Mark BON BON AND DESIGN
Published in the Official Gazette on January 27, 2015

Arcor S.A.I.C.,

Opposer,

-v-

“ROT FRONT” ; Open-type Joint Stock Company,
Applicant.

Opposition No. : 91222153

Trademark :



OPPOSER’S REPLY BRIEF

PRELIMINARY STATEMENT

As set forth in Opposer’s opening brief, this case is about whether a likelihood of confusion exists between applicant Rot Front’s (“Applicant” or “Rot Front”) stylized mark BON BON and opposer Arcor S.A.I.C.’s (“Opposer” or “Arcor”) mark BON O BON, which is the subject of an incontestable United States registration that Applicant has not challenged. A review of the facts of this case demonstrates that the extensive similarities between Opposer’s and Applicant’s marks, as well as the similarities between Opposer’s and Applicant’s goods, must result in a finding of likelihood of confusion.

In its reply brief, Applicant argues that BON BON is descriptive or generic for candy and, as a result, that the dominant portion of its own mark is the stylization and background. To that end, Applicant argues that the design portion of its mark is distinctive and unique, which creates a commercial impression separate and apart from the wording BON BON. Applicant’s position is

that this distinctive design element is sufficient to render a finding of no likelihood of confusion between Opposer's and Applicant's marks.

As explained below, none of the evidence or case law cited by Applicant in its reply brief, however, supports this conclusion. Accordingly, for the reasons set forth herein and in Opposer's opening brief, Opposer is entitled to judgment in its favor.

FACTUAL BACKGROUND

Opposer refers to its opening brief for a full recitation of the facts.

LEGAL ARGUMENT

I. Likelihood of Confusion Overview

Case law is clear, that to determine whether a likelihood of confusion exists between an applied-for mark and a prior mark, thirteen non-exclusive factors set forth in *DuPont* are analyzed on a case-by-case basis. "Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 U.S.P.Q. 1557, 1559 (Fed. Cir. 2001).

In its Reply, Applicant does not dispute that two key considerations in any likelihood of confusion analysis are the similarities between the marks and the similarities between the goods and/or services, *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976), and that all doubts must be resolved in favor of the prior user. *Gillette Canada v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (T.T.A.B. 1992); *see also In re Mighty Leaf Tea*, 94 U.S.P.Q.2d 1257, 1259 ("for the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so."); *In re Phytochrome Pharms., Inc.*, Serial No. 77709896 (T.T.A.B. Mar. 8, 2011).

Rather, Applicant argues that the dissimilarity of the marks alone weighs strongly against a finding of likelihood of confusion. In support of this argument, Applicant cites to the following cases: *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 USPQ2d 1381 (TTAB 2005) (concerning marks ONFOLIO and CARTAGIO); *Kellog Co. v. Pack/Em Enterprises, Inc.*, 21 USPQ2d 1142 (Fed. Cir. 1991) (concerning marks FROOTEE ICE and FROOT LOOPS); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 47 USPQ2d 1459 (Fed. Cir. 1998) (concerning the marks CRYSTAL CREEK and CRISTAL CHAMPAGNE); *Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334 (TTAB 2006) (concerning the marks GENUINE RIDE SKIN CARE and GENUINE BODY, GENUINE SPA, GENUINE SKIN, GENUINE FACE, GENUINE HAIR).

The facts at issue in each of the above cases, however, involve marks that utilize entirely different words from those with which they are compared. In contrast, the sole difference between Applicant and Opposer's marks, particularly when the marks are viewed in standard letter format, is the letter "o" in Opposer's mark, namely BON O BON, as compared with BON BON. This one difference is insufficient to justify a finding of no likelihood of confusion, because the marks are substantially similar and because of the weight of the remainder of the *DuPont* factors.

In this case the relevant *DuPont* factors weigh decidedly in Opposer's favor because: (1) Applicant's mark is similar to Opposer's Mark in appearance, sound, and commercial impression; (2) Applicant has admitted that the nature of the goods are similar; (3) Applicant has admitted that the channels of trade are similar; and (4) the conditions under which sales are made are identical.

Accordingly, a proper comparison of all relevant factors leads to the conclusion that Applicant's mark is likely to cause confusion with Opposer's mark.

II. The Purported Weakness of the Term Bon Bon Does Not Take Away From A Finding Of Confusing Similarity Between the Parties' Marks

Applicant argues that the term Bon Bon is weak and generic, which weighs against a finding of likelihood of confusion. Assuming, without conceding, that the term Bon Bon is descriptive of some of the goods in the parties' marks, a determination of whether Applicant and Opposer's marks are confusingly similar requires a consideration of the marks in their entireties. *See Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion").

Applicant's apparent position is that Bon Bon is a weak mark and, accordingly, consumers are unlikely to be confused because they will assume that the generic term simply identifies the goods. *See Reply Brief at 4.* Applicant's arguments, however, are not supported by the case law that it cites.

For example, in *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986), the Court was analyzing the marks BED & BREAKFAST INTERNATIONAL and BED & BREAKFAST REGISTRY. Although the Court stated that "bed and breakfast" is descriptive, the Court also discussed that the common elements of the marks, even if descriptive, could not be ignored, and that the words "registry" and "international" did not have the same meaning in combination with the term "bed and breakfast." In the end, the applicant's registration was refused because BED & BREAKFAST REGISTRY would be understood to describe a register of bed and breakfast lodgings. *Id.*

Similarly, in *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985), the marks CALIFORNIA COBBLERS and COBBLER'S OUTLET" were at issue. The TTAB considered

the fact that the term “cobbler” was used as the first term in one mark and the second term in the other mark, and that “[b]oth marks have suggestive meanings which are quite different.” *Id.* at 2.

The cases do not state, as Applicant suggests, that the words “bed & breakfast” or “cobbler” should be ignored as generic, while the remainder of the marks are analyzed to determine the likelihood of confusion. Rather, the cases demonstrate that the marks taken as a whole must be considered. *See Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

Moreover, Applicant has proffered records of ten trademark registrations that it claims represent a crowded field of “bon bon”-formative marks. According to Applicant, the existence of such registrations means that consumers are able to distinguish among these marks based upon design elements, rather than by names of the actual products.

Records of the registrations cited by Applicant, however, do not demonstrate the perception of the public toward such marks, or the manner in which they are used. “Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive.” TMEP § 1207.01(d)(iii).

Here, the registered mark BON O BON and the Applicant’s mark BON BON (and design) differ in relevant part by just a single letter. On the other hand, all of the registrations Applicant has cited in support of its position contain significant additional wording, such as the rhyming LE BON BONBON NAPOLEON and the alliterative BEDAZZLE MY BONBONS. Comparing these marks with Opposer’s mark BON O BON is not appropriate.

Regardless of whether Bon Bon is generic or descriptive, the Applicant and Opposer’s marks are nearly identical, with the single exception being one vowel, the letter “o”, in Opposer’s

mark. The marks do not have additional or different wording, nor do they convey separate connotations. Accordingly, the purported genericness of Bon Bon does not detract from the confusing similarity between the marks.

II. The Dominant Portion of Applicant's Mark is BON BON and the Design Elements Are Not Distinctive

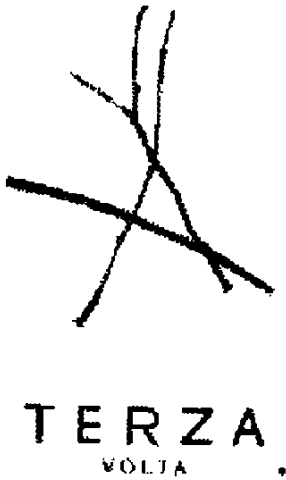
In its reply brief, Applicant argues that where a distinctive design element is involved, likelihood of confusion is unlikely. This argument makes two assumptions: (1) that Applicant's design element is distinctive, and (2) that Applicant's design element should be given greater weight in determining likelihood of confusion. Neither of these assumptions are true in this case.

Case law is clear that when a mark is comprised of a word portion and a design portion, the word portion is more likely to be recalled by a purchaser and, accordingly, is given greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (T.T.A.B. 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (T.T.A.B. 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (T.T.A.B. 1976). Moreover, when the Applicant's design elements consist of mere background to the words, the word portion of Applicant's Mark is dominant. *See In Re 1st USA Realty Professionals, Inc.*, 84 U.S.P.Q.2d (T.T.A.B. 2007); *In re Kysela Pere et Fils, Ltd.*, 98 U.S.P.Q.2d (T.T.A.B. 2011). Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (T.T.A.B. 1987).

The Examiner of Applicant's mark did not find the design portion of Applicant's mark to be distinctive and entitled to separate registration. The Examiner simply found that in combination the word and design portions of Applicant's mark are distinctive.

Applicant has not offered any support to rebut its position that this well-settled case law “conflicts with current practice.” Reply brief at 8. Accordingly, here, the dominant portion of Applicant’s Mark is BON BON, which is essentially identical to Opposer’s Mark BON O BON.

Applicant has cited to a few examples in which the TTAB has found no likelihood of confusion in marks containing a distinctive and prominent design element. For example, in *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009), the marks markVOLTA and TERZA VOLTA were at issue.



The TTAB evaluated the appearance of the mark, in which it found that the prominent design feature, consisting of a distinctive design element located above the wording, in addition to the design feature, differentiated the applicant’s mark from the opposer’s mark. *Id* at 2.

This case is distinguishable from the instant case. The goods identified by the marks markVOLTA and TERZA VOLTA were not identical, which should be given heavy weight into the analysis. Furthermore, the additional word TERZA, was found to be dominant. Here, on the other hand, the goods are identical and there is no additional word or design feature to separate Opposer’s and Applicant’s marks.

Similarly, in *Ferro Crop. v. Ronco Labs., Inc.*, 356 F.2d 122, 148 USPQ 497 (CCPA 1966), the Court found no likelihood of confusion in part, because of the presence of an animated bolt carrying a flag in the applicant's mark.



Unlike the above cases, as well as the remainder of the cases cited by Applicant, Applicant's mark here does not contain a similarly distinctive design element. Instead, the design element is an indistinctive purple, square background. *See In re Harrison*, 2016 WL 4702452 (TTAB, Aug 16, 2016) (finding that "purple swirl" background is not dominant feature as it is unlikely to be articulated and more likely to be viewed as background or carrier for words).

Therefore, when properly viewing the parties' marks in their entireties, Applicant's Mark is confusingly similar to Opposer's Mark in appearance, sound, and commercial impression, and Applicant's arguments to the contrary are unavailing.

CONCLUSION

For the foregoing reasons, Opposer is entitled to judgment in its favor.

Dated: July 24, 2017

Arcor S.A.I.C.
By its Attorneys,

/Perla M. Kuhn/

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CERTIFICATE OF SERVICE

I hereby certify that I am over the age of 18 years, not a party to this action, and that on the 24th day of July, 2017, I caused to be served a true and correct copy of the foregoing Opposer's Reply Brief by Email to the following attorney for the Applicant:

Alexander S. Lazouski
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Dated: New York NY
July 24, 2017

By: /Varant Ekmekjian/
Varant Ekmekjian