

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	78401816
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>In response to the Office Action dated August 26, 2004, from the Trademark Attorney, Applicant states as follows:</p> <p>Registration of Applicant's mark, SPIRAL ("Applicant's Mark"), should not have been refused under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because there is no likelihood of confusion between Applicant's Mark and the mark in U.S. Registration No. 2194722, SPIRAL PRODUCTIONS (and Design) ("Registrant's Mark") owned by the individual, Steven Ayromlooi.</p> <p>Applying the factors set out in <u>In re E.I. DuPont DeNemours &amp; Co.</u>, 476 F.2d 1357, 1361 (C.C.P.A. 1973), there should be no likelihood of confusion between Applicant's Mark and Registrant's Mark.</p> <p><b>Factor 1. Dissimilarity of the Marks.</b></p> <p>Although Applicant's Mark and Registrant's mark share the common element SPIRAL, the existence of a common word element between two marks does not, in and of itself, create a likelihood of confusion. See <u>La Cibeles, Inc. v. Adipar, Ltd.</u>, 2000 U.S. Dist. LEXIS 12676 (S.D.N.Y. 2000) (notwithstanding the existence of common word elements, the addition of the letter "e" at the end of the mark "Petite Cherie" for a fragrance for adult women created "a significant difference" with the mark "Petit Cheri" for baby cologne); <u>Michael Caruso &amp; Co. v. Estefan Enters., Inc.</u>, 994 F. Supp. 1454, 1460 (S.D. Fla. 1998) (the fact that "Bongo" for clothing and "Bongos Cuban Café" for restaurant services both incorporated "a form of the common word 'bongo' [did] not render the marks similar.") (citing cases). Rather, in determining whether a likelihood of confusion exists between two trademarks, each mark must be considered in the way it is perceived by the public - namely, in its entirety. See <u>Opryland USA Inc. v. Great American Music Show, Inc.</u>, 970 F.2d 847, 851 (Fed. Cir. 1992) (citing cases). When viewed as a whole, Applicant's Mark and Registrant's Mark are sufficiently dissimilar in appearance, sound and commercial impression so as not to be confusing.</p> <p>First, Applicant's Mark does not look or sound like Registrant's Mark. Applicant's Mark is comprised of the single, six-letter word SPIRAL. Registrant's mark, on the other hand, is a composite mark, comprised of three elements - the word SPIRAL, the word PRODUCTIONS (each presented in stylized lettering), and a prominent design element.[1] These two additional elements in Registrant's Mark - the word PRODUCTIONS and the design - create significant dissimilarities between the marks so as to render them non-confusing.</p> <p>First, the addition of the word element, PRODUCTIONS, in Registrant's Mark distinguishes Registrant's Mark from Applicant's Mark. While this element may be descriptive of Registrant's services, it adds an additional three syllables to Registrant's Mark, creating an appearance and cadence distinctive from the single word element in Applicant's Mark.</p> <p>Beyond the marks' distinctive appearances and sounds, the use of the word PRODUCTIONS in Registrant's Mark also conveys a specific commercial impression to consumers - one entirely absent from Applicant's Mark. A consumer, knowing nothing about Registrant's services, can tell from the trademark alone that Registrant is in the production business. Not so for Applicant's Mark, where the word SPIRAL is unaccompanied by any descriptive terms, and requires consumer inquiry to understand the nature of Applicant's services. Indeed, Applicant's Mark does not suggest any type of goods or service. Applicant's use of the word SPIRAL as the title of its animated television series is entirely arbitrary.</p> <p>Second, the inclusion of the design element in Registrant's Mark serves to distinguish it from Applicant's Mark. Dominant design elements weigh heavily in the overall impression of a mark and should be considered in making a likelihood of confusion analysis. <u>Hewlett-Packard Co. v. Human Performance Measurement, Inc.</u>, 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991).</p> <p>In Hewlett-Packard, the TTAB dismissed an opposition to the registration of the mark HPM (and Design) based</p>	

upon the opposer's family of HP marks. The TTAB found that the design element in the HPM mark distinguished it from the HP marks. It reasoned:

[C]onsidering the marks in their entireties, we believe that applicant's mark is not confusingly similar to any of opposer's marks. The design elements of applicant's mark, which include a horizontal bar graph superimposed on a profile of a human face enclosed within a square block, are significant features of applicant's mark which are at least as prominent as, if not more prominent than, the letters "HPM".

Id. at 1396. Accordingly, the court found that there was no likelihood of confusion between the marks and allowed the HPM mark to proceed to registration. See also In re TSI Brands, Inc., 2002 TTAB LEXIS 270 (T.T.A.B. Apr. 30, 2002) (confusion was not likely between registrant's AK marks for "athletic clothing" and applicant's AK AMERICAN KHAKIS for "sportswear" because, when considered in their entireties, the marks contained stylized elements significant enough to distinguish them from one another).[2]

As in Hewlett-Packard, Registrant's Mark contains a stylized design element that dominates the mark. The design appears on top of the word elements and is much larger than the other two elements. The design injects the mark with a strong visual commercial impression entirely absent from Applicant's Mark. Accordingly, the design element eliminates any likelihood of confusion between the marks.

Based upon the different appearances, sounds, and meanings of Registrant's Mark and Applicant's Mark, the commercial impressions created by the marks are entirely distinctive, and there is no likelihood of confusion between the two.

#### Factor 2. Dissimilarity and Nature of the Goods and Services.

Registrant's use of its mark is not likely to cause confusion with Applicant's because the nature of the services offered under the two marks is dissimilar. Registrant is engaged in the business of producing motion pictures and uses its mark to designate these services. It does not, however, claim trademark protection in its use of the mark as the title of any of the motion pictures that it produces.

Applicant, on the other hand, is seeking to register its mark as the title of its television series. It does not, however, claim trademark protection in its use of the mark in connection with the production of this series.

The nature of Registrant's production services and Applicant's television series are entirely dissimilar. Accordingly, there is no likelihood of confusion.

#### Factor 3. Dissimilarity of Trade Channels and Buyers.

The trade channels through which Registrant's motion picture production services and Applicant's television series are sold are also dissimilar. Registrant produces motion pictures. Registrant will be seeking to sell its production services to holders of intellectual property rights (who may be interested in selling that intellectual property to Registrant for use in a motion picture), to investors (who may be interested in financing the production of the motion picture), and to entertainment industry talent (who may be interested in appearing in or rendering services in connection with motion pictures to be produced by Registrant).

Applicant, on the other hand, is dealing with a series that has already been produced. It will not be seeking to sell the series to rights holders, investors or talent. Rather, its consumers will be potential distribution outlets for its television series, such as cable networks and television stations.

Accordingly, the channels of trade through which Registrant's production services and Applicant's television series are sold militate against any likelihood of confusion between the marks.

#### Factor 4. Dissimilarity of Conditions of Purchase.

The conditions under which Registrant's motion picture production services and Applicant's television series are sold are also dissimilar.

In the case of Registrant's motion picture production services, Registrant will be dealing with consumers who are sophisticated and are not likely to confuse the name of a production company with the name of an animated television series. Each of the likely consumers of Registrant's services will bring a high level of sophistication to the table in dealing with Registrant.

Independent motion pictures are generally produced with six-figure budgets, and even some of the more famously inexpensive productions still had budgets of around \$30,000.[3] In addition, an individual's association with a failed or poorly received motion picture could have a dramatically negative effect on his or her career. Accordingly, decisions as to whether to license intellectual property, invest in a motion picture production, or render services for use in such a production will not be made lightly, but rather will entail a great deal of thought and investigation. Accordingly, there is no likelihood that any of these decision makers will confuse the name of the production company and the name of the motion picture being produced.

A similarly high level of investigation is involved before a distribution outlet such as a cable network or television station purchases an animated series. A number of considerations will factor into the decision as to whether to purchase the series. These include the nature of the series (*e.g.*, an animated series will be more likely to find a home on *Cartoon Network* than it

content, appealing to children, but some animated series contain darker content and are aimed towards a more mature audience), the time of day in which the series can be shown (e.g., an animated series that will be shown late-night will cost less to license than a series that will be shown in prime time), and the producer of the series (e.g., certain producers have proven track records of success and deference may be given to this fact in making a purchasing decision). This type of analysis is highly sophisticated and particular to each network. It is therefore extremely unlikely that a distribution outlet will be confused between the name of the production company that has produced a series it is thinking about buying and the name of the series itself.

As Registrant's motion picture production services and Applicant's television series will be sold to different types of sophisticated consumers, there will be no likelihood of confusion between the marks.

Factor 5. Fame of Applicant's Mark.

There is no evidence that Registrant's Mark is a famous mark.[4]

Factor 6. The Number and Nature of Similar Marks in Use on Similar Goods.

The word SPIRAL is not an invented word and it is used in a number of different trademarks in connection with a variety of types of goods and services, thereby significantly reducing, if not eliminating, any possibility of confusion between Applicant's mark and Registrant's mark. In fact, an online search of the records of the USPTO shows at least 108 live applications incorporating the word SPIRAL, eighty-four of which have matured into registration. At least ten of these eighty-four registrations were filed in International Class 041 for entertainment or education services.

Due to this extensive use, the mark SPIRAL is not particularly strong. Accordingly, there should be no likelihood of confusion between Applicant's mark and Registrant's mark.

The Remaining Factors.

The other DuPont factors are simply inapplicable to a determination of the likelihood of confusion between Registrant's Mark and Applicant's Mark or have been discussed in the context of the other factors.

For the foregoing reasons, there is no likelihood of confusion between Registrant's Mark and Applicant's Mark. Accordingly, Applicant's Mark should be published for opposition in due course.

[ 1 ] For convenience, the following image, obtained from the United States Patent and Trademark Office ("USPTO") website, depicts Registrant's composite mark:

[ 2 ] So as to not mislead the Trademark Attorney, because the TSI Brands disposition was not officially reported, it is not citable as precedent of the T.T.A.B. It is cited in this Response as Applicant believes its reasoning is instructive.

[ 3 ] For example, the film *The Blair Witch Project* was produced for an estimated \$35,000, and *Clerks* was produced for an estimated \$27,000 (though after post-production, the budget had increased to \$230,000). See The Internet Movie Database, at [www.imdb.com](http://www.imdb.com).

[ 4 ] Indeed, a Google search using the terms "Spiral Productions" and "Ayromlooi" (Registrant's name), results in a single "hit", a reference to a 1999 production of a thirty-minute film called *Nathan Grimm*, which was entered into The Third Annual Hollywood Film Festival. (Copies of the applicable pages from the search results are attached to this Response as Exhibit A.)

**EVIDENCE SECTION**

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EVIDENCE FILE NAME	<a href="\\ticters\EXPORT11\IMAGEOUT 11\784\018\78401816\xml4\ROA0003.JPG">\\ticters\EXPORT11\IMAGEOUT 11\784\018\78401816\xml4\ROA0003.JPG</a>
DESCRIPTION OF EVIDENCE FILE	Google Search results
EVIDENCE FILE NAME	<a href="\\ticters\EXPORT11\IMAGEOUT 11\784\018\78401816\xml4\ROA0004.JPG">\\ticters\EXPORT11\IMAGEOUT 11\784\018\78401816\xml4\ROA0004.JPG</a>
DESCRIPTION OF EVIDENCE FILE	Hollywood Film Festival results 1 of 2
EVIDENCE FILE NAME	<a href="\\ticters\EXPORT11\IMAGEOUT 11\784\018\78401816\xml4\ROA0005.JPG">\\ticters\EXPORT11\IMAGEOUT 11\784\018\78401816\xml4\ROA0005.JPG</a>

DESCRIPTION OF EVIDENCE FILE	Hollywood Film Festival results 2 of 2
<b>SIGNATURE SECTION</b>	
SIGNATURE	/Eric P. Bergner/
SIGNATORY NAME	Eric P. Bergner
SIGNATORY POSITION	Attorney for Applicant
SIGNATORY DATE	11/02/2004
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Tue Nov 02 11:19:38 EST 2004
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## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **78401816** is amended as follows:

#### Argument(s)

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

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Applying the factors set out in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973), there should be no likelihood of confusion between Applicant's Mark and Registrant's Mark.

#### Factor 1. Dissimilarity of the Marks.

Although Applicant's Mark and Registrant's mark share the common element SPIRAL, the existence of a common word element between two marks does not, in and of itself, create a likelihood of confusion. See La Cibeles, Inc. v. Adipar, Ltd., 2000 U.S. Dist. LEXIS 12676 (S.D.N.Y. 2000) (notwithstanding the existence of common word elements, the addition of the letter "e" at the end of the mark "Petite Cherie" for a fragrance for adult women created "a significant difference" with the mark "Petit Cheri" for baby cologne); Michael Caruso & Co. v. Estefan Enters., Inc., 994 F. Supp. 1454, 1460 (S.D. Fla. 1998) (the fact that "Bongo" for clothing and "Bongos Cuban Café" for restaurant services both incorporated "a form of the common word 'bongo' [did] not render the marks similar.") (citing cases). Rather, in determining whether a likelihood of confusion exists between two trademarks, each mark must be considered in the way it is perceived by the public - namely, in its entirety. See Opryland USA Inc. v. Great American Music Show, Inc., 970 F.2d 847, 851 (Fed. Cir. 1992) (citing cases). When viewed as a whole, Applicant's Mark and Registrant's Mark are sufficiently dissimilar in appearance, sound and commercial impression so as not to be confusing.

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Applicant's Mark. While this element may be descriptive of Registrant's services, it adds an additional three syllables to Registrant's Mark, creating an appearance and cadence distinctive from the single word element in Applicant's Mark.

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Second, the inclusion of the design element in Registrant's Mark serves to distinguish it from Applicant's Mark. Dominant design elements weigh heavily in the overall impression of a mark and should be considered in making a likelihood of confusion analysis. Hewlett-Packard Co. v. Human Performance Measurement, Inc., 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991).

In Hewlett-Packard, the TTAB dismissed an opposition to the registration of the mark HPM (and Design) based upon the opposer's family of HP marks. The TTAB found that the design element in the HPM mark distinguished it from the HP marks. It reasoned:

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Id. at 1396. Accordingly, the court found that there was no likelihood of confusion between the marks and allowed the HPM mark to proceed to registration. See also In re TSI Brands, Inc., 2002 TTAB LEXIS 270 (T.T.A.B. Apr. 30, 2002) (confusion was not likely between registrant's AK marks for "athletic clothing" and applicant's AK AMERICAN KHAKIS for "sportswear" because, when considered in their entireties, the marks contained stylized elements significant enough to distinguish them from one another).[2]

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