

Won T. Oh, Esq.
Trademark Examining Attorney
Law Office 114

Re: Serial No. 85646719 – GOOP

Dear Mr. Oh:

This is in response to your Office Action dated September 17, 2012 (the "Office Action").

With regard to your comments under the heading "Section 2(d) Refusal - Likelihood of Confusion" with respect to Classes 3 and 25 only, please be advised as follows:

The Office Action refuses registration of the Applicant's mark "GOOP" (the "Proposed Mark"), in Classes 3 and 25 only on the basis that there may be a likelihood of confusion with U.S. Registration Nos. 0557190 and 3517557 (the "Registered Marks"). The Office Action cites as its rationale for refusing registration that the Proposed Mark "is highly similar" to the Registered Marks and that the Applicant's goods are also "either highly related or highly similar" to the goods of each of the registrants.

Registration No. 0557190 in Class 3

In response to the Office Action's refusal on the basis of Registration No. 0557190 ("Registered Mark 1") in Class 3, set forth below are facts and evidence that we believe demonstrate no likelihood of confusion exists between the Proposed Mark and Registered Mark 1 because, despite the fact the Proposed Mark is identical in sound and appearance to Registered Mark 1, the Proposed Mark is used in connection with significantly different goods which will be marketed to significantly different customers through significantly different channels of trade .

When determining a likelihood of confusion between two marks "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." See Local Trademarks, Inc. v. Handy Boys Inc., 16 USPQ2d 1156 (TTAB 1990).

The Office Action refuses registration of the Proposed Mark on the basis that the cosmetic and personal care items described in Applicant's application, and in connection with which Applicant intends to use the Proposed Mark, are "highly related" to the "hand cleaner" cited in the Office Action which is marketed and sold by Critzas Industries, Inc. ("Registrant 1") and in connection with which Registrant 1 is using Registered Mark 1.

Based on the information provided by Registrant 1 on its website, the "hand cleaner" cited in the Office Action is a waterless hand cleaner which was "originally designed for mechanics to wash their hands without water" but is now known, marketed and used as an all-purpose cleaner to remove grease, tar, ink, blood and other tough stains from a variety of different surfaces in work and household environments. See <http://goophandcleaner.com/products/original-goop>. Registrant 1 claims that its hand cleaner is "fantastic for cleaning dirty, grimy hands...but you can tackle a lot of other tough cleaning jobs

with it too” and encourages the consumer to “learn all the ways that you can use Goop around the house, in the workshop, or just about anywhere.” See <http://goophandcleaner.com>. Furthermore, the logos used by Registrant 1 on its Goop hand cleaners, in connection with which Registrant 1 uses Registered Mark 1, read “Multi-Purpose Goop,” indicating that Registrant 1 intends the product to be used in a variety of ways to clean a variety of surfaces, including, but not limited to, hands. See <http://goophandcleaner.com/products/original-goop>. Also, the packaging of Registrant 1’s Goop hand cleaners include statements highlighting the product’s ability to remove stains, such as “The Ultimate Stain Remover” and “Removes Stain from Washable Clothing,” and, on certain containers, an image of a laundry clothing line with clothes hanging off of it, which, in each case, demonstrate Registrant 1’s intention to market Goop hand cleaners as a household cleaning product. See <http://goophandcleaner.com/products/original-goop>.

Registrant 1 also uses Registered Mark 1 in connection with other cleaning products, not cited in the Office Action, including fabric stain removers, cleansers designed for pet grooming, ink and paint removers, industrial-sized jugs of soap, and disposable towels and hand wipes. See <http://goophandcleaner.com/products/moms-goop/>; <http://goophandcleaner.com/products/groomers-goop/>; <http://goophandcleaner.com/products/orange-goop/>; <http://goophandcleaner.com/products/soaps/>; and <http://goophandcleaner.com/products/towels/>. In addition to cleaning products, Registrant 1 uses Registered Mark 1 in connection with hand creme which Registrant 1 describes on its website as “industrial lotion for tough conditions” designed for “guys who work with their hands all day,” suggesting that Registrant 1’s hand creme is intended to be used in the context of manual labor. See <http://goophandcleaner.com/products/hand-creme>. Based on the information provided in Registrant 1’s website, all of the goods sold by Registrant 1 in connection with which Registered Mark 1 is used are cleaning supplies or related items which address certain needs which arise in the context of manual labor, household work or pet grooming.

The goods described in Applicant’s application, on the other hand, are cosmetic and personal care items used primarily for the purpose of beautification and/or health and wellness. Applicant does not intend to use the Proposed Mark in connection with the sale of any cleaning supplies, household cleaners, pet grooming products or lotions specifically formulated or designed to address the effects of manual labor on an individual’s hands. Furthermore, Applicant does not intend to market cosmetic and personal care items as “multi-purpose” or as having the ability to be used on any surface other than a consumer’s skin, hair and/or body. There is, therefore, a distinct difference between the goods Applicant intends to market and the goods marketed by Registrant 1.

Furthermore, Registrant 1’s website includes a claim that the brand Goop (of which Registered Mark 1 is a part) is “The Trusted Brand for Generations...in the house...in the garage...and on your pets” and presents Goop hand cleaner as a cleaning product intended to be used in connection with manual labor, mechanical repairs, home improvement and household work. See <http://goophandcleaner.com>. On its website, Registrant 1 promotes “Original Goop” hand cleaner, in connection with which Registered Mark 1 is used, as “originally designed for mechanics” and “a fixture in households all over America” which “ saves you time and money in the workshop, laundry, on the road, in your car and anywhere you and the kids get into a mess.” See <http://goophandcleaner.com/products/original-goop>. In addition, Registrant 1 uses Registered Mark 1 in connection with (i) a variation on its original hand cleaner with citrus as an ingredient, “Orange Goop,” which Registrant 1 promotes as offering “an increased ability to remove inks and paint because of its citrus,” (ii) “Mom’s Goop,” a fabric stain remover which, as its name suggests, is marketed to mothers, and (iii) “Groomer’s Goop,” a pet grooming product which,

according to Registrant 1's website, is "...the professionals' choice to remove oils from the coats of cats, like Persian, Himalayan, and Maine Coon Cats" and "also the breeder's and groomer's choice for power cleaning all long-haired dogs." See <http://goophandcleaner.com/products/orange-goop>, <http://goophandcleaner.com/products/moms-goop> and <http://goophandcleaner.com/products/groomers-goop>. It is apparent from Registrant 1's marketing materials that Registrant 1's goods are targeted towards consumers engaged in manual labor (whether in a workshop, in connection with professional pet care or at home) who are seeking a means to remove dirt, stains, grease, tar, ink or other materials that are the subject of, incidental to or resulting from such manual labor. In fact, Registrant 1 specifically identifies certain categories of the working consumers that Registrant 1 is targeting, namely, mechanics, mothers doing the laundry and professional pet groomers.

By contrast, the cosmetic and personal care items described in Applicant's application are targeted exclusively to women and fans of celebrity actress Gwyneth Paltrow who wish to purchase goods sold on Applicant's lifestyle website primarily because such goods are created or endorsed by Ms. Paltrow. Applicant is targeting consumers who will purchase the goods described in Applicant's application in the context of leisure rather than in the context of work or in connection with manual labor. There is, therefore, a distinct difference between the consumers that Applicant intends to sell cosmetic and personal care items to and the consumers of Registrant 1's goods.

Moreover, according to Registrant 1's website, Registrant 1 sells its goods at "automotive, grocery, home improvement, hardware, and national chain retailers." See <http://goophandcleaner.com>. A diligent search of the internet reveals that the goods in connection with which Registrant 1 uses Registered Mark 1 can be purchased at mass market e-commerce websites such as www.amazon.com, where Registrant 1's goods are classified as all-purpose household cleaners in the "Home Improvement" category, and national discount retail chain stores such as Dollar Tree and Sam's Club, where Registrant 1's goods are classified under "Office Supplies" and "Garage and Shop Accessories", respectively. See <http://www.amazon.com/Original-Formual-Multi-Purpose-Cleaner/dp/B001ENOLZ2>, <http://www.dollartree.com/Orange-Power-Goop-Hand-Cleaner-5-oz-/p301301/index.pro> and <http://www.samsclub.com/sams/orange-goop-hand-cleaner-1-gal/prod2560040.ip>. The goods sold by Registrant 1 in connection with which registrant uses Registered Mark 1 may also be purchased from companies such as Harbor Freight Tools, where goods are marketed to working people in need of tools, and [Globalindustrial.com](http://www.globalindustrial.com), where goods are marketed to corporations, institutions and consumers in need of industrial equipment and supplies. See <http://www.harborfreight.com/45-lb-goop-hand-cleaner-40717.html>, and <http://www.globalindustrial.com/p/janitorial-maintenance/cleaning-supplies/cleaners/goop-pre-moistened-towels-and-wipes-90-ct-goop-towels>). Also, Registrant 1 sells its goods at low prices. For example, Registrant 1's retail website sets forth prices for Original Goop ranging from \$2.06 for a 5oz. tube to \$44.00 for a 25lb bucket of Original Goop. See <http://www.momsgoop.com/items/2/18/goop-original-gel.aspx>.

Applicant intends to sell the cosmetics and personal care items listed in Applicant's application exclusively through Applicant's lifestyle website at high end prices and does not intend to market its goods as incidental to work. Applicant does not intend to provide hand cleaners for use in connection with manual labor or to distribute its goods through mass market e-commerce websites or national discount chain retail stores. There is, therefore, a distinct difference between the channels of trade of the respective goods marketed by the Applicant and Registrant 1. It is therefore highly unlikely that the Applicant will market its goods in any way that would cause confusion among the customers of Registrant 1 as to the source of Applicant's or Registrant 1's goods.

In addition, there are four marks registered with the USPTO containing the term “GOOP” in Class 3, including the marks “THE SUPER DEGOOPER” in connection with stain removers and all-purpose cleaners, “MONKEY BRAINS GOOP OUT” in connection with shampoo, and “SUPERGOOP!” in connection with sunscreen. The fact that these marks can co-exist with Registered Mark 1 further supports the allowance of the Applicant’s application for the Proposed Mark.

For the foregoing reasons, it is respectfully submitted that the Proposed Mark be accepted for registration in Class 3 for use on the cosmetic and personal items described in Applicant’s application.

Registration No.3517557 in Class 25

In response to the Office Action’s refusal on the basis of the Registered Mark in Class 25 (“Registered Mark 2”), Applicant requests reconsideration that the Proposed Mark is not likely to be confused with Registered Mark 2. According to the website of the Florida Department of State Division of Corporations, the registrant, Goop Apparel Inc. (“Registrant 2”), is “inactive” and was administratively dissolved on September 9, 2009 for failure to file an annual report. Such evidence of dissolution suggests that Registrant 2 may no longer be in business. Furthermore, a diligent search of the internet found no current instances of the use of Registered Mark 2 by Registrant 2 in connection with clothing, or any goods or services for that matter. It is acknowledged by Applicant that the appropriate venue for a substantive claim that a registered mark may not be used in connection with the goods and services for which such mark is registered is not with the USPTO, nor is Applicant attempting to make such a claim in this response. However, the factual results of such diligent search compels the conclusion that there is no possibility of confusion since the consumer would never have an opportunity to see any goods bearing Registered Mark 2 and thus could not confuse such goods with the Applicant’s goods.

For the foregoing reasons, it is respectfully submitted that the Proposed Mark be accepted for registration in Class 25 for use on the clothing described in Applicant’s application, as well as for the uncontested goods listed on the subject application.

Very truly yours,

/Lila Subramanian/
Lila Subramanian
Attorney