

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Date: November 28, 2016

In re Application of:
Spoon & Moon, LLC

Docket No.: SPN 401

Serial No. : 87/016,614

Trademark Examining
Attorney: Raul Cordova

Filed : April 27, 2016

For : SLUMBERKINS

Law Office: 114

Commissioner for Trademarks
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REQUEST FOR RECONSIDERATION

Reconsideration of the August 19, 2016 first Office action for the above-identified trademark application is requested in view of the following remarks. In the Office action, registration of Applicant's SLUMBERKINS mark in Class 28 for plush toys and plush toys sold as a unit with printed material was refused under Section 2(d) for allegedly creating a likelihood of confusion with U.S. Registration No. 3,993,500 of the SLUMBER PETS mark for pillows, sleeping bags, stuffed dolls and animals, stuffed toy animals, and toy animals in Classes 20 and 28.

Section 2(d) Refusal

As set forth in the Office action, Applicant's SLUMBERKINS mark, as used on Applicant's goods (plush toys, and plush toys sold as a unit with printed material), is likely to cause confusion with use of the SLUMBER PETS mark, as used for stuffed toy animals and related goods. In particular, the Office action stresses that the marks "are almost identical," and

that the goods are identical and move in the same trade channels. Applicant respectfully disagrees that a likelihood of confusion exists. Applicant's reasons include, but are not limited to, the following:

- The registered mark is entitled to only a narrow scope of protection, as used on the goods at issue, due to the widespread use and registration of similar marks that also include the words "SLUMBER," "PETS," and/or variants thereof, for relevant goods;
- Applicant's SLUMBERKINS mark creates a distinct commercial impression from the registered mark, especially in view of the crowded field of marks that are more similar to the registered mark than is Applicant's mark, so as to preclude a likelihood of confusion; and
- There is evidence that the cited mark is no longer in use by registrant, which even further prevents any risk of a likelihood of confusion between the marks.

Beginning with the weakness of the cited SLUMBER PETS mark, Applicant submits that the mark is a weak mark that is only entitled to a narrow scope of protection within Classes 20 and 28, because so many different parties are using marks containing the terms "SLUMBER" or "PETS" for similar goods.

The TMEP states that "If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it 'is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.'" *Palm Bay Imps., Inc. v. Veuve*

Clicquot Ponsardin Maison Fondee en 1772, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); TMEP § 1207.01(d)(iii).

As Professor McCarthy explains in 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Section 11: 85-88 at 11-143 to 11-150 (1996):

The ultimate test of relative strength is the distinctiveness of a mark in the mind and perception of the relevant customer group. But a mark that is hemmed in on all sides by similar marks on similar goods cannot be very “distinctive.” It is merely one of a crowd of marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.... In a “crowded” field of similar marks, each member of the crowd is relatively “weak” in its ability to prevent use by others in the crowd.... Evidence of third party use of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to only a narrow scope of protection.

A case that shows how a mark can be entitled only to a narrow scope of protection in a crowded field of similar marks for related goods is *In re J.C. Penney Co.*, 179 USPQ 184 (TTAB 1973), where an application was filed to register EL TIGRE for automotive parts. Under the doctrine of foreign equivalents, the English equivalent of the mark, THE TIGER, was used when determining the registrability of the mark. Registration was refused on the ground that the mark was likely to cause confusion with the marks TIGER TRAC for new and re-treaded tires, SUNBEAM TIGER for automobiles, and TIGER for bicycles. The Board noted that there were several additional third-party registrations of TIGER for automotive parts that were not cited by the Examining Attorney, including TIGER ‘TREAD’ for retreaded tires, TIGER-FOOT for rubber vehicle tires, and TIGER TANK and design for truck bodies, and held that TIGER was “a weak mark in the automotive parts and accessories field.” *Id.* at 186. Accordingly, the Board held that marks containing TIGER were entitled only to a narrow scope of protection, and therefore that the applicant’s mark could distinguish the applicant’s goods in the crowded field of automotive


supplies, equipment, and accessories. *Id.* Significantly, THE TIGER was found to be registrable not only over various two-word marks involving TIGER, but also over TIGER alone.

Another case that shows how a mark can be entitled only to a narrow scope of protection in a crowded field of similar marks for related goods is *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981), where an application was filed to register AQUA-QUILT for paper towels. The Examining Attorney refused registration on the ground that the mark was likely to cause confusion with AQUA-GARD for paper towels. The Board noted that there were several third-party registrations of AQUA for paper goods that were not cited by the Examining Attorney, including AQUA PHIL, AQUA SOFT, AQUALIZED, AQUA KRAFT, AQUA-TUF, AQUA-FIBR, AQUA-CORD, and AQUASTRONG, and held that “the presence of the ‘AQUA’ prefix in two otherwise dissimilar marks can be an insufficient basis upon which to predicate a holding that the marks as a whole are likely to conflict in the marketplace.” *Id.* at 862-863. Accordingly, the Board held that the applicant’s mark could distinguish the applicant’s goods in the crowded field of paper goods. *Id.* at 863.

The present case is like these cases because marks that begin with “SLUMBER” are used by a wide variety of different parties for related goods in Classes 20 and 28, just as TIGER and AQUA were respectively used for automotive parts and paper products by a variety of different parties. Therefore, the term “SLUMBER” is only entitled to a narrow scope of protection in these Classes, and the cited mark is essentially limited to the particular mark itself, without being broad enough to create a likelihood of confusion with other marks containing the term “SLUMBER.” In support, Applicant submits the following table of representative federally registered marks containing this widely used term and variants thereof. Each of these marks is registered for goods related to those goods that the cited mark is registered for, and that Applicant seeks registration for. Furthermore,

Applicant submits evidence showing actual use of these third party marks in the U.S. for the registered goods, thereby also demonstrating not only registration, but also use, of these marks for these goods. Copies of these registrations, the most recent specimen submitted for each registration (where applicable), and evidence of actual use (where applicable) of the corresponding marks are submitted with this response as Exhibits 1a-1b.

| Mark | Owner | Representative Goods |
|--|--|--|
| SLUMBER FRIENDS Reg. No. 4,258,144 | Cloud B, Inc. | aromatic pillows comprising potpourri in fabric containers; pillows |
| SLUMBER WUNDERS Reg. No. 4,712,016 | Hans Herbert Pompen | stuffed dolls and animals; stuffed toy animals; toy animals |
| SLUMBER ON THE GO Reg. No. 4,870,907 | Idea Nuova, Inc. | pillows; sleeping bag pads; sleeping bags; sleeping mats; plush toys; stuffed toys |
| SLUMBER BEAR Reg. No. 3,321,667 | Prince Lionheart, Inc. | infant/baby toy which produces intra-uterine recorded womb sounds |
| SLUMBER MATE Reg. No. 4,396,116 | Sports Coverage, Inc. | novelty pillows |
| slumbr SLUMBR (stylized) Reg. No. 4,957,496 | Slumbr, Inc. | bed pillows; pillows |
| SLUMBER PARTY SAFARI Reg. No. 4,109,979 | Mattel, Inc. | toy vehicles and accessories therefor |
| CHIROSLUMBER Reg. No. 5,045,121 | ChiroSlumber, LLC, dba ChiroSlumber.com | mattress toppers; mattresses and pillows; sleep products, namely, mattresses, spring mattresses, box springs and mattress foundations |
| SLUMBER SUITCASE Reg. No. 4,871,449 | Cloud B, Inc. | kits comprised of color pencils, coloring and craft books and blankets, sold together with a decorative carrying box |
| SLUMBER SLEEPER Reg. No. 4,758,896 | Swanling Innovations | bedding, namely, sheets, blankets; baby bedding, namely, swaddling blankets, fitted crib sheets, crib sheets, crib blankets, baby blankets, bed linen; bed blankets; bed sheets; bed throws; sleeping bags in the nature of sheeting; children's blankets; infant wearable bed pads; infant wearable bed sheets; infant wearable blankets; infant wearable crib sheets |

| Mark | Owner | Representative Goods |
|--|-------------------------------|--|
| SLUMBERCOOL Reg. No. 4,683,757 | Precision Custom Coatings | furniture, namely, mattress toppers, mattress covers, mattress protectors and encasements, pillows; bed sheets, fitted bed sheet covers, bed flat sheets, and pillow cases; bedding protection; pillow cases; pillow covers; pillow shams; pillow-top, low-profile bed skirts; bed blankets; lap blankets; woolen blankets |
| SLUMBERBUMP Reg. No. 4,642,124 | Slumber Bump, LLC | a sleep positioner cushion, not for medical purposes, worn while sleeping to prevent the individual from lying on their back |
| SLUMBERWICK Reg. No. 4,026,073 | Exxel Outdoors, LLC | sleeping bag liners |
| SLUMBERLOFT Reg. No. 4,026,079 | Exxel Outdoors, LLC | pillows |
| SLUMBERJACK Reg. No. 4,311,308 | Exxel Outdoors, LLC | chairs; cots; outdoor furniture; pillows; sleeping bag liners; sleeping bag pads; sleeping bags; sleeping mats |
| SLUMBER'S ALLURE Reg. No. 4,385,616 | Pacific Coast Feather Company | pillows |
|  Slumber Cloud SLUMBER CLOUD & Design Reg. No. 4,548,991 | Global Web Horizons, LLC | bed pillows; beds, mattresses, pillows and bolsters; bed covers; bed linen; bed pads; bed sheets; bed spreads |
| SLUMBER WRAP Reg. No. 3,909,360 | Hot Headz of America, LLC | comforters for adults, children and beds; bed blankets; children's blankets; throws; and afghans |
| SLUMBER SACK Reg. No. 3,838,935 | Summer Infant (USA) Inc. | wearable children's blankets, infant blankets for sleeping, children's blankets, convertible children's blankets; infant sleepwear, swaddling clothes |
| SLUMBER CORE Reg. No. 2,798,849 | Pacific Coast Feather Company | pillows |
| SLUMBERLAND Reg. No. 4,739,125 | Slumberland, Inc. | on-line retail store services featuring furniture and mattresses; retail store services featuring furniture and mattresses |
| SLUMBER SOFT Reg. No. 2,737,902 | Perfect Fit Industries, LLC | pillows |

Notably, these registered marks include more than twenty registered “SLUMBER” marks with evidence of actual use in the U.S. or specimens of record, including two such marks that are registered for plush toys or similar items and at least thirteen such marks that are registered for pillows and/or sleeping bags – the exact goods for which the cited mark is registered. The nature of the goods that were sold under the cited SLUMBER PETS mark is essentially animal-shaped pillows for children, examples of which are shown in Exhibit 2 (note that the goods are no longer available, even on the “daily deal” liquidating sites such as kidsteals.com and woot.com). According to one web site on which the goods were previously sold, “Zoobies Slumber Pets™ are oversized plush toys with a built-in pillow and sleeping bag.” While some of the registered marks listed in the table above categorize the goods with different terms, the goods are essentially the same. For example, the SLUMBER FRIENDS mark above is registered in Classes 3 and 20 for, e.g., aromatic pillows, but the actual goods consist of combined stuffed animal/pillows, just as did the goods that were sold under the cited SLUMBER PETS mark. An example of the goods sold under the SLUMBER FRIENDS mark is included in Exhibit 1b.

In addition to the above-presented registered marks that utilize various “SLUMBER” terms for related goods in Classes 20, 24, and 28 (among others), Applicant also submits the following additional unregistered uses of “SLUMBER” and variants thereof in the U.S. for related goods (e.g., plush toys, combined animal shaped pillows and sleeping bags, and pillows). Printouts from websites from which each of these goods may be purchased or accessed are attached with this response as Exhibit 3.

| Mark | Goods |
|-----------------|---------------------------------|
| SLUMBER BUDDIES | animal pillows |
| SLUMBER ANIMALS | animal pillows |
| SLUMBER | sleeping bag with animal pillow |

| Mark | Goods |
|---|------------------|
| SLUMBER TIME SINGING MOON | plush toy/pillow |
| SWEET SLUMBER | pillow |
| SLUMBERFRESH | pillow |
| PEPPA PIG HUG N' OINK GEORGE SLUMBER PLUSH | plush toy |
| SLUMBER | mattress |
| ROYAL SLUMBER | pillow |
| THE ORIGINAL COOL SLUMBER | pillow pad |

Even further, while Applicant's mark does not contain the term "PET" or "PETS," that portion of the cited mark further weakens the cited SLUMBER PETS mark. Applicant submits the following table of representative federally registered marks containing this widely used term and variants thereof. Each of these marks is registered for goods related to those goods that the cited mark is registered for, and which Applicant seeks registration for. In fact, all but one of the below marks is registered for plush toys, and the one exclusion is registered for pillows, each of which are among the goods for which the cited SLUMBER PETS mark is registered for. Furthermore, Applicant submits evidence showing actual use of these third party marks in the U.S. for the registered Class 28 (or Class 20) goods, thereby also demonstrating not only registration, but also use, of these marks for these goods. Copies of these registrations, the most recent specimen submitted for each registration (where applicable), and evidence of actual use (where applicable) of the corresponding marks are submitted with this response as Exhibits 4a-4b.

| <u>Mark</u> | <u>Owner</u> | <u>Representative Goods</u> |
|-------------------------------------|----------------------------|--|
| PILLOW PETS Reg. No. 4,139,534 | CJ Products, LLC | backpacks; children's blankets; slippers; stuffed and plush toys; stuffed dolls and animals; stuffed toy animals; stuffed toys |
| TREASURE PETS Reg. No. 4,660,783 | Eliot Stein | action figure toys; collectable toy figures; plush toys; stuffed and plush toys; stuffed toy animals |
| GLOW PETS Reg. No. 4,538,392 | Ontel Products Corporation | stuffed and plush toys; plush toys with built in electric lights |

| Mark | Owner | Representative Goods |
|--------------------------------------|------------------------------------|---|
| COZY PETS Reg. No. 4,241,679 | Philip Charles Gannon | plush dolls; plush toys; stuffed and plush toys; stuffed dolls and animals; stuffed toy animals; stuffed toy bears; stuffed toys |
| STORYTIME PETS Reg. No. 4,713,905 | E. Mishan & Sons, Inc. | animatronics animated toys; talking toys; plush toys |
| POLAR PETS Reg. No. 4,790,568 | Elf Magic LLC | stuffed and plush toys; toy animals and accessories therefor; toy figures |
| CLOUD PETS Reg. No. 4,749,266 | On Demand Direct Response III, LLC | stuffed and plush dolls and toys; stuffed and plush toy animals; electronic novelty toys, namely, toys that electronically record, play back, and distort or manipulate voices and sounds; electronic stuffed and plush dolls, animals and toys |
| ARM PETS Reg. No. 5,060,004 | Griemsmann Industries, LLC | stuffed and plush toys |
| BABY PETZ Reg. No. 4,789,519 | K.S. Toys Ltd. | plush toys; soft sculpture plush toys; stuffed and plush toys |
| FLOOR PETS Reg. No. 4,168,900 | Idea Nuova, Inc. | pillows; bed blankets; bed canopies; bed covers; bed linen; bed sheets; bed skirts; bed spreads; bed throws; curtains; plush toys; stuffed toys |
| PET PILLOW Reg. No. 4,665,465 | Antonio Argento | children's bed pillows |

The above-listed registrations and unregistered uses demonstrate that marks that include "SLUMBER" or "PETS" are commonly used for plush toys and pillows (and other related goods), within Classes 20 and 28. This widespread use of such terms and phrases for related goods is reinforced by the evidence of actual use of the registered marks that is included in Exhibits 1a-1b and 4a-4b. Because of this widespread use by many different parties, the cited mark should be afforded a comparatively narrow scope of protection, just as TIGER and AQUA were afforded narrower scopes of protection in the cases cited above.

Applicant is not arguing that the cited mark should not have been registered or has no scope of protection. Instead, Applicant requests reconsideration of the refusal of registration in view of the weakness of the cited mark for goods in Class 28, and thus the narrow scope of

protection that should be afforded to the cited mark. Simply put, since consumers are so used to seeing many different parties use variants of “SLUMBER” and/or “PETS” for plush toy products, pillows, and related goods, it follows that the cited mark does not offer much distinctiveness, and thus its scope of protection should be limited to the more particular mark itself (e.g., with both the “SLUMBER” and “PETS” elements) as registered, rather than extending to any exclusive rights to either element individually for such goods.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that a weak mark may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Third-party registrations may be relevant to show that a mark or a portion of a mark is ... so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., Id.* at 1338-40; 115 USPQ2d at 1674-75; *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015).

“[E]vidence of third-party use bears on the strength or weakness of an opposer’s mark.” *Juice Generation*, 794 F.3d at 1338, 115 USPQ2d at 1674. “The weaker [a] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* “Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fonden En 1772*, 376 F.3d 1369, 1373 (Fed. Cir. 2005). Just a few months ago, third-party registrations were used to determine that a commonly used mark (FAVORITES for mail order catalogs featuring sporting goods and other goods) was sufficiently weak that a likelihood of

confusion did not exist for the applicant's phonetically similar mark (FAVORIT for goods that include bicycles and sporting goods). *See In re Favorit Czechoslovakia s.r.o.*, Serial No. 79133133 (TTAB April 22, 2016) (non-precedential).

Thus, while "SLUMBER" may be suggestive of Class 20 and/or Class 28 goods when considered independently, the term is rendered weak due to the widespread use and registration by many different parties for Class 20 and 28 goods, including goods that are identical to the registered goods. It is well established that if the common element of two marks is suggestive of the named goods, consumers will not be confused unless the overall combinations share other commonalities. TMEP § 1207.01(b)(viii); *see, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY not confusingly similar with BED & BREAKFAST INTERNATIONAL). In *Bed & Breakfast Registry*, the Trademark Trial and Appeal Board determined that BED & BREAKFAST REGISTRY could not be registered for "making lodging reservations for others in private homes" due to a prior registration of BED & BREAKFAST INTERNATIONAL for "room booking agency services." *Bed & Breakfast Registry*, 791 F.2d at 158. In reversing that decision, the Federal Circuit stated:

We agree with the applicant that travellers acquainted with the term "bed and breakfast" are more likely to rely on the non-common portion of each mark, e.g., "registry" vs. "international", to distinguish among similar services. Overall, BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not confusingly similar in either sound or appearance. The words "registry" and "international" do not have the same meaning, either alone or in combination with the term "bed and breakfast".

Id. at 159.

In contrast to *Bed & Breakfast Registry*, here, the Examining Attorney indicates that Applicant's SLUMBERKINS mark, as used on plush toys, is confusingly similar to the cited SLUMBER PETS mark, as used on plush toys and pillows, because both marks begin with

“SLUMBER.” However, under *Bed & Breakfast Registry*, Applicant's mark is not confusingly similar to the cited mark simply because the marks share a common element. Applicant's mark contains additional distinct elements not present in the cited mark (and *vice versa*) so that the consumer is likely to use the non-common portions of the marks to distinguish between them. Namely, Applicant's mark adds the suffix “KINS” to the end of “SLUMBER,” creating a coined compound word. Registrant's SLUMBER PETS mark does not contain “KINS,” and likewise, registrant's mark contains an additional term (“PETS”) that is not present in Applicant's SLUMBERKINS mark. Moreover, “PETS” is presented as a stand-alone word that is separate from “SLUMBER.” That is, Applicant's mark is a coined term, and the cited mark consists of two distinct non-coined words. Because the common term “SLUMBER” is suggestive of the goods, and because both registrant's mark and Applicant's mark contain non-common elements, Applicant's SLUMBERKINS mark creates a distinct commercial impression from the cited SLUMBER PETS mark, sufficient to prevent a likelihood of confusion between the marks.

Finally, Applicant notes that there is some indication that registrant is no longer in existence, and no longer uses the cited SLUMBER PETS mark. For example, the business registration for Smoot Brothers IP Holdings, LLC (the registered owner of the SLUMBER PETS mark) is listed as expired, last being renewed in 2013. A copy of this information obtained from the Utah Secretary of State is attached as Exhibit 5. Additionally, Applicant was unable to find evidence of the registrant offering goods for sale using the SLUMBER PETS mark online. The listings in Exhibit 2 from amazon.com, Walmart.com, woot.com, and kidsteals.com all list the goods as unavailable. The website previously used by registrant (zoobies.com) is non-functional, with no content and no goods for sale. Even further, the last post made on “The Official Zoobies LLC Facebook page” is from 2013 (also included in Exhibit 5), all of which

indicates that the mark has been abandoned. Nonetheless, Applicant submits that the weakness of the cited mark alone is sufficient to prevent a likelihood of confusion even if the SLUMBER PETS mark were being used on such goods.

For at least the above reasons, Applicant believes the refusal of registration should be reconsidered and withdrawn. Simply put, the cited SLUMBER PETS mark, as used on the plush toys and pillows at issue, is a weak mark that is only entitled to a narrow scope of protection, and Applicant's SLUMBERKINS mark is not sufficiently similar to the cited mark to create a likelihood of confusion.

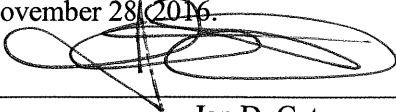
Conclusion

For the reasons discussed above, Applicant believes that the refusal of registration over U.S. Reg. No. 3,993,500 should be reconsidered and withdrawn. If the Examining Attorney has any questions or believes there are any remaining issues, the Examining Attorney is invited to contact Applicant's undersigned counsel via phone (503-224-7529) or email (ian@dascenzoiplaw.com) if doing so would help advance the present application to publication.

Respectfully submitted,

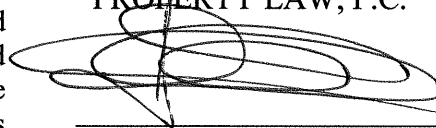
CERTIFICATE OF E-FILING

I hereby certify that this correspondence and the accompanying Exhibits 1a-1b, 2-3, 4a-4b, and 5 are being transmitted electronically via the United States Patent and Trademark Office's Trademark Electronic Application System on November 28, 2016.



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