Response to Office Action

MARK: SPOOKTACULAR CREATIONS

SERIAL NO.: 87660928

APPLICANT: Joyin, Inc.

FILING DATE: October 26, 2017

INTERNATIONAL CLASSES: 016, 025 and 028

TO: Kristin Williams
Examining Attorney
USPTO, Law Office 105

This is in response to the Office Action dated November 6, 2017, wherein the Examining Attorney made a non-final refusal to register the mark "SPOOKTACULAR CREATIONS" under multiple grounds, as summarized in the Summary of Issues: (I) Partial Section 2(d) Refusal – Likelihood of Confusion – Classes 016 and 028; (II) Advisory: Prior-Filed Application; (III) Advisory: Ownership of Prior-Filed Application; (IV) Partial Refusal – Specimen Unacceptable – Class 028; and (V) Disclaimer Required.

I. Amendment of Description of Goods

Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register on this ground.

Applicant hereby amends the description of goods as follows:

(1) Class 016 (*Halloween goodie bags of paper or plastic; Paper Halloween decorations; Replications of human and animal skeletons, or parts of skeletons,* ***specifically as they relate to Halloween decorations*** ~~*and fossils for educational purposes*~~)

(2) Class 028 (*Novelty toy item in the nature of a dispenser of stream material; Novelty toy items in the nature of pop ups; Plush toys; Toy weapons; Toy and novelty face masks; Toy foam novelty items, namely, foam fingers and hands; Electronic novelty toys, namely, toys that electronically record, play back, and distort or manipulate voices and sounds; Novelty toy items in the nature of artificial plush animals or insects; Soft sculpture plush toys; Stuffed and plush toys.* ***All of the aforementioned products are sold as Halloween items***)

II. Likelihood of Confusion Refusal

The Examiner has refused registration of Applicant's mark "SPOOKTACULAR CREATIONS" (the "**Applicant's Mark**"), covering, as amended, Class 016 (*Halloween goodie bags of paper or plastic; Paper Halloween decorations; Replications of human and animal skeletons, or parts of skeletons, specifically as they relate to Halloween decorations*) and Class 028 (*Novelty toy item in the nature of a dispenser of stream material; Novelty toy items in the nature of pop ups; Plush toys; Toy weapons; Toy and novelty face masks; Toy foam novelty items, namely, foam fingers and hands;*

Electronic novelty toys, namely, toys that electronically record, play back, and distort or manipulate voices and sounds; Novelty toy items in the nature of artificial plush animals or insects; Soft sculpture plush toys; Stuffed and plush toys. All of the aforementioned products are sold as Halloween items) on the ground that it gives rise to a likelihood of confusion with the following registrations (the "**Cited Marks**"):

CITED MARK	COVERED GOODS
SPOOKTACULAR, Reg. No. 4296772	IC 016 – Paper, cardboard; goods made from paper and cardboard, not included in other classes, namely, paper bookmarks, advertising pamphlets, advertising signs of paper or cardboard, printed advertising boards of paper or cardboard, albums for photographs, stamps, and events, stationery, paper bags for packaging, banners of paper, bookmarkers of paper, document files, paper folders, paper labels, cardboard packaging boxes, paperboard packaging boxes, paper for wrapping and packaging, decorative paper bows for wrapping, paper gift wrapping ribbons, display banners made of cardboard; printed matter, namely, printed postcards, adhesive printed labels, paper advertisement posters and signs, news bulletins, information packs, namely, booklets, teacher's notes notepads, printed information cards concerning access to further education and higher level university education, alumni magazines, magazines featuring university's educational and research services, manuals in the field of university activities, newsletters in the field of university activities, writing paper pads, printed periodicals in the field of university activities, academic and research offerings and activities in academic fields of arts and humanities, business, computer, mathematics and physical sciences, behavioral and social sciences, education, engineering, health and human performances, communication, library and information services, life sciences, environmental studies, simulation and digital entertainment, and public affairs, university's educational and research services, printed books concerning university admissions, alumni activities and general university information, printed journals on university activities, event programs, adhesive note pads, adhesive note paper, adhesive-backed photographs, adhesive-backed letters and numbers for use in making signs and posters, calendars, day planners; bookbinding materials."
I GAVE SPOOKTACULAR, Reg. No. 4296770	IC 016 - Paper, cardboard; goods made from paper and cardboard, not included in other classes, namely, paper bookmarks, advertising pamphlets, advertising signs of paper or cardboard, printed advertising boards of paper or cardboard, albums for photographs, stamps, and events, stationery, paper bags for packaging, banners of paper, bookmarkers of paper, document files, paper folders, paper labels, cardboard packaging boxes, paperboard packaging boxes, paper for wrapping and packaging, decorative paper bows for wrapping, paper gift wrapping ribbons, display banners made of cardboard; printed matter, namely, printed postcards, adhesive printed labels, paper advertisement posters and signs, news bulletins, information packs, namely, booklets, teacher's notes notepads, printed information cards concerning access to further education and higher level university education, alumni magazines, magazines featuring university's educational and research services, manuals in the field of university activities, newsletters in the field of university activities, writing paper pads, printed

	periodicals in the field of university activities, academic and research offerings and activities in academic fields of arts and humanities, business, computer, mathematics and physical sciences, behavioral and social sciences, education, engineering, health and human performances, communication, library and information services, life sciences, environmental studies, simulation and digital entertainment, and public affairs, university's educational and research services, printed books concerning university admissions, alumni activities and general university information, printed journals on university activities, event programs, adhesive note pads, adhesive note paper, adhesive-backed photographs, adhesive-backed letters and numbers for use in making signs and posters, calendars, day planners; bookbinding materials

(A) Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969).

As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording, as demonstrated in numerous federal cases and Board proceedings. See, e.g., *IN RE HARTZ HOTEL SERVICES, INC.*, 2012 WL 1267900 (T.T.A.B. 2012) (no likelihood of confusion between GRAND HOTELS NYC and GRAND HOTEL for hotel services); *IN RE INTELISTAF HEALTHCARE MANAGEMENT, L.P.*, 2006 WL 936990 (T.T.A.B. 2006) (no likelihood of confusion between INTELLICASH for consumer debit card services and INTELECASH for business services involving debit cards); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON TEA PARTY for tea and BOSTON SEA PARTY for restaurant services); *Omaha Nat. Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231 (D. Neb. 1986) (no likelihood of confusion between BANK IN A BILLFOLD and BANK IN A WALLET for banking credit card services); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344 (Fed. Cir. 2011) (no likelihood of confusion between CAPITAL CITY BANK and CITIGROUP for banking and financial services); *Franklin Resources, Inc. v. Franklin Credit Management Corp.*, 988 F. Supp. 322 (S.D. N.Y. 1997) (no likelihood of confusion between FRANKLIN for investment services and same mark for debt collection services); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029 (S.D. N.Y. 1990) (no likelihood of confusion between COMSTOCK for stock and commodity trade information services and same mark for money management services); *Allstate Ins. Co. v. Allstate Inv. Corp.*, 210 F. Supp. 25 (W.D. La. 1962), judgment aff'd, 328 F.2d 608 (5th Cir. 1964) (no likelihood of confusion between ALLSTATE for insurance services and same mark for mortgage brokerage services).

Indeed, as the Board has frequently held, registrations for identical marks for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion. *See, e.g., In re Itec Manufacturing, Ltd.*, 2008 WL 885926, *4–5 (T.T.A.B. 2008) (PAL for a patient-lifting medical device and PAL for lithotomy medical devices and patient support mattress pumps); *In re Hyundai Motor America*, 2009 WL 4086577 (T.T.A.B. 2009) (ECHELON for automobiles

and ECHELON for automotive tires); *In re Kaemark, Inc.*, 2008 WL 5256390 (T.T.A.B. 2008) (LUXE for salon furniture and LUXE for furniture); *IN RE HAGEMEYER NORTH AMERICA, INC.*, 2007 WL 2698300 (T.T.A.B. 2007) (VERSAPRO for weed killer and VERSAPRO for garden tools); *IN RE APOLLO COLORS, INC.*, 2005 WL 1787221 (T.T.A.B. 2005) (APOLLO for color pigments in the graphic arts industry and APOLLO for dye and pigments used in the leather and textile industry).

Not all of the DuPont factors are relevant to every case and the significance of a particular factor may differ from case to case. In re Mighty Leaf Tea, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *In re Majestic Distilling Co.*, Inc., 315 F.3d 1311, 1315 (Fed. Cir. 2003); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946 (Fed. Cir. 2000); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406–07 (Fed. Cir. 1997).

The Examining Attorney is correct that the similarity of the marks should be considered, but it is just one of many relevant factors. Equally significant here are the dissimilarity and nature of the goods, the dissimilarity of the trade channels used to target the respective customers, the degree of care used by the consuming public, and the relative weakness of the Cited Marks. Applicant respectfully submits that, here, a proper comparison of the DuPont factors reveals that consumer confusion is unlikely.

(B) The Applicant's Mark Is Visually and Aurally Dissimilar From The Cited Marks and They Create Distinct Commercial Impressions In Their Respective Contexts

The Applicant's Mark is dissimilar from the Cited Marks in appearance, sound, and overall commercial impression. The Examining Attorney has improperly concluded that the marks are confusingly similar, in part, based on the fact that the marks all contain the word "Spooktacular." In fact, there is no *per se* rule that confusion automatically exists between marks containing the same term. Here, a proper comparison of the marks in their entireties reveals that confusion is unlikely.

i. The Marks Are Dissimilar In Appearance

In determining likelihood of confusion, marks being compared should be considered in their entireties. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 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."). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). The fact that two marks contain an identical element does not alone indicate a likelihood of confusion. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) ("The use of identical, even dominant words in common does not automatically mean that two marks are similar.").

In fact, courts have repeatedly found that marks containing the same or similar elements used for the same or similar goods and services are not confusingly similar. *See Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875 (C.C.P.A. 1979) (no likelihood of confusion between service marks SANDWICH CHEF & Design and BURGER CHEF used alone or with design for identical services). Moreover, there is no per se rule that confusion is automatically likely between marks merely because they share similar wording. *See, e.g.*, Miller Brewing Company v. Premier Beverages, Inc., 210 U.S.P.Q. 43, 1981 WL 40422 (T.T.A.B. 1981) (no likelihood of confusion between MILLER and OL' BOB MILLER'S, both for beverages); *United Drug Co. v. Mercirex Co.*, 182 F.2d 222 (C.C.P.A. 1950) (no likelihood of confusion between REX and MERCIREX, both for pharmaceuticals); *Conagra Inc. v. Saavedra*, 4 U.S.P.Q.2d 1245, 1247, 1987 WL 123843 (T.T.A.B. 1987) (no likelihood of confusion between PATIO for Mexican style foods and TOPATIO for Mexican-themed hot sauce); *Howard Johnson Company v. the Ground Pat'l Inc.*, 214 U.S.P.Q. 214, 1982 WL 50439 (T.T.A.B. 1982) (THE

GROUND PAT'I and THE GROUND ROUND, both for restaurants serving beef, are not confusingly similar marks).

In *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402 (C.C.P.A. 1970), the Court found no likelihood of confusion between PEAK and PEAK PERIOD, stating:

> [T]he mere presence of the word "peak" in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion or deception. That determining must arise from a consideration of the respective marks in their entireties. The difference in appearance and sound of the marks is too obvious to render detailed discussion necessary. In their entireties, they neither look nor sound alike.

Similarly, here, the mere fact that the marks all contain the shared word "Spooktacular" does not create a likelihood of confusion. The Applicant's Mark is a two-word mark which has the word "Spooktacular" followed by the word "Creations". In contrast, one of the Cited Marks is a one-word mark containing the word "Spooktacular" and the other is a two-word mark containing the word "igave" and the word "Spooktacular". These differences serve to visually distinguish the Applicant's Mark from the Cited Marks, and Applicant's addition of "creations" to the word "spooktacular" is sufficient to mitigate any alleged confusion between the Applicant's Mark and the Cited Marks. *See Plus Products v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541, 1983 WL 51884 (T.T.A.B. 1983) (no likelihood of confusion between MEAT PLUS for pet food and PLUS for dietary food supplements for dogs and cats, stating "it is our view that the addition of "MEAT" to "PLUS" is sufficient to distinguish applicant's mark as a whole from that of PLUS" per se, notwithstanding the descriptive significance of "MEAT" and the fact that said term has been disclaimed"); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404 (C.C.P.A. 1975) ("COUNTRY VOGUE" not confusingly similar to "VOGUE"); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520, 522, 1975 WL 20861 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS are not confusingly similar). Applicant submits that, when viewed as a whole, the mere fact that the Applicant's Mark shares a common word with the Cited Marks does not render the marks visually similar.

ii. The Marks Are Distinct In Sound

For the same reasons as noted above, the differences between Applicant's Mark and the Cited Marks render the marks dissimilar in sound as well.

iii. The Marks Create Distinct Commercial Impressions In Their Respective Contexts

Most importantly, the marks create distinct connotations in their respective contexts. In determining the commercial impression created by a mark, the mark must be viewed in its entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, in assessing the connotation presented by marks as a whole, courts must evaluate how words within a mark function together to create particular meanings. For example, in *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1408–09, 1998 WL 766704 (T.T.A.B. 1998) the Board examined the meaning implied by the marks HARD ROCK CAFÉ & Design and COUNTRY ROCK CAFÉ & Design by addressing the connotation of the word ROCK as determined by the word preceding it. The Board determined that each mark presented an overall connotation of music, but suggested a distinct genre within the broad category of "music," such that the respective marks created "quite different images for consumers." *Id.* HARD ROCK CAFÉ evoked an image of a rock music restaurant, while COUNTRY ROCK CAFÉ evoked an image of a country music restaurant. *Id*.

Similarly here, while the marks all contain the shared word "spooktacular", the connotation of the mark must be assessed by viewing the mark in its entirety. Applicant's Mark "Spooktacular Creations",

when viewed in the context of the covered goods, connotes a very limited idea of Hallowen related products. In contrast, the Cited Marks connote the idea of university bookstore related products and charitable giving. This is amplified by each Cited Marks' registration in the additional Class 036, which covers, among other services, "charitable fundraising . . . corporate funds management . . . charitable fundraising to promote education and academic studies . . . and charitable foundation services in the nature of providing funding for research and educational scholarships." Moreover, the Cited Marks' owner is in fact a University (Nanyang Technological University, in Singapore). Therefore, the Cited Marks as viewed in their respective entirety gives an extremely different commercial impression than Applicant's Mark, which pertains to Halloween related products. In combination, these differences between the marks result in distinct commercial impressions, making confusion between them unlikely.

(C) The Respective Goods Are Distinguishable

The goods offered under the respective marks are dissimilar. The Examining Attorney states that "Applicant's [goods] are closely related to registrant's [goods] because the attached Internet evidence establishes that the same entity commonly manufactures the relevant goods, that the relevant goods are complementary in terms of purpose or function, and that the goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use" and "[t]herefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes."

There is no *per se* rule that goods or services which fall into the same broad, general field are "related" for Section 2(d) purposes. *See Umc Industries, Inc. v. Umc Electronics Co.*, 207 U.S.P.Q. 861, 879, 1980 WL 30155 (T.T.A.B. 1980) ("[T]he fact that one term, such as 'electronic', may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.").

Applicant offers a very narrow category of goods in connection with its Mark. Specifically, Applicant sells Halloween-related products bearing its Mark. It does not sell university bookstore related products. In contrast, the goods covered under the Cited Marks are for university, and otherwise educational or charitable, related products and services. These goods/services do <u>not</u> include Halloween-related products in connection with its Marks.

There are fundamental differences in the goods offered by the Applicant and those covered under the Cited Marks. The parties do not compete with one another. The differences between the goods covered by the Applicant's Mark and the goods covered by the Cited Marks obviate any likelihood of confusion.

(D) Conditions Under Which Sales Are Made and The Buyers To Whom They Are Made Renders Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. When the relevant buyer class is composed of seasonal purchasers such as purchasers buying Halloween costumes and accessories during the Halloween season, the likelihood of confusion will be lower. See *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); *See also, In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public).

The Applicant's goods consist of Halloween costumes, accessories and other related goods. Applicant sells its goods primarily around the Halloween sales season. Accordingly, Applicant's goods are generally not available to public consumers other than during the general Halloween season. Moreover, consumers of Applicant's goods would likely be Halloween costume and/or accessories purchasers. Thus, it is reasonable to conclude that consumers of the Applicant's goods are likely to exercise a high degree of care in their purchasing decisions and that purchase of the Applicant's goods would likely be the result of forethought and analysis.

In contrast, the conditions under which the goods offered under the Cited Marks are sold are quite different. The goods sold under Registrant's Cited Marks appear to be sold primarily through university bookstores or otherwise in the university and/or educational setting. Consumers of Cited Marks' goods and services presumably know if they are buying university related and would only make a purchase after exercising care and consideration about the item. Thus, such purchasers would be unlikely to be confused.

(E) Conclusion

Given (1) the differences between the respective marks, (2) the distinctions in the nature and purpose of the respective goods, and the conditions under which sales are made and the buyers to whom they are made, consumer confusion is unlikely. Therefore, Applicant respectfully requests that the Section 2(d) refusal be withdrawn.

III. Prior Pending Application

The Examining Attorney notes that the filing date of pending U.S. Application Serial No. 87573831 ("Pending Mark") precedes applicant's filing date and that if the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks.

Applicant notes that it is the owner of the Pending Mark and concurrent with the submission of this office action response, submits the following verified statement (both herein and through the USPTO's Office Action Response Form): Applicant is the owner of Application Serial No. 87573831.

IV. Conclusion

Because, as described in greater detail above, Applicant has appropriately responded to each of the Examining Attorney's grounds for refusal, Applicant submits that the Mark is entitled to registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-561-1172.

Respectfully submitted,
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