

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Soremartec SA  
Serial No. : 79/221,172  
Mark : **KINDER PINGUI & Design**  
Int'l Classes : 30

Law Office : 116  
Examining : Sean Crowley  
Attorney

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE TO OFFICE ACTION**

Applicant hereby submits this response to the Office Action dated December 15, 2017 issued against Application Serial No. 79/221,172 to register the mark KINDER PINGUI (& Design) (“**Applicant’s Mark**”) on the Principal Register.

**RESPONSE**

**TRANSLATION REQUIREMENT**

While Applicant has adopted the Examining Attorney’s suggested translation of the word KINDER in Applicant’s Mark, Applicant respectfully declines to enter the Examining Attorney’s suggested translation for the term PINGUI. While the word PINGUI is suggestive of the Italian word "PINGUINO," which translates to PENGUIN, PINGUI is not an actual word in Italian, and to the best of Applicant’s knowledge, is also not an actual word in any other language. In support of this assertion, Applicant submits Exhibit A, which is a Google translation for the term PENGUIN into Italian, which demonstrates that the Italian word for PENGUIN is PINGUINO, as well as a Google translation for the term PINGUI, which shows that there is no corresponding English word. See Exhibit A.

## SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration of Applicant's Mark based on a likelihood of confusion with the marks in U.S. Registration No. 4762649 and U.S. Application Serial No. 86544023. However, a likelihood of confusion between Applicant's Mark and the cited registration and application will be averted through the doctrine of common control because this registration and application are owned by Ferrero S.p.A., which is a sister company of Applicant and part of the Ferrero Group, under the common ownership and control of Ferrero International S.A. An affidavit to this effect by Jorge De Moragas and Fabrizio Minneci, Directors of Ferrero International S.A. is attached as Exhibit B. Exhibit A confirms that Applicant and Ferrero S.p.A. are part of the Ferrero Group and controlled by Ferrero International S.A., either by a majority stock or by exercising de facto control of the management or through the appointment of the Board of Directors and/or some of their Managers. This affidavit explains that the decision to authorize the filing of trademark applications in different names within the Ferrero Group is directed at rationalizing the various activities of the different companies within the Group through a more efficient distribution of the different tasks and duties. Nonetheless, the affidavit confirms that the goods covered by trademarks owned by Applicant and Ferrero S.p.A. have the same source of origin, in that these goods, as well as mode of use of the goods, is subject to uniform quality standards within each company. Thus, the Ferrero Group exerts a unity of control over all activities of Ferrero S.p.A. and Applicant, including the selection, adoption, and use of trademarks owned by them.

That Applicant and Ferrero S.p.A. represent a single source is further established by the January 26, 1990 Agreement between them. A copy and an English translation of the relevant portions are attached hereto as Exhibit C. This Agreement clarifies that the activities and

operations of the two companies, including *inter alia*, selection, adoption, and use of trademarks, are under the unified control of a single management. Specifically, the attached Agreement states that due to the unification of the European market and the international concentration of the confectionary products sector, the Ferrero Group has further standardized its management policy. As a result, Applicant has been entrusted with providing Ferrero S.p.A. with all of the research and development services necessary for the manufacture of, *inter alia*, confectionary products, and their presentation and packaging, as well as the marketing and advertising concepts therefor. The research and development activities include, for example, data collection, product development (including brand name research) and product innovation. All of these activities of Applicant are to be conducted for the benefit of Ferrero S.p.A. and other companies comprising the Ferrero Group.

It is well-settled that products emanating from more than one company may be considered to emanate from the same source if there is a legal relationship between the companies, such that there is unity of control over the use of the trademarks. *See* TMEP § 1201.07 et seq; *In re Wella A.G.*, 5 U.S.P.Q.2d 1359 (T.T.A.B. 1987)(WELL family of marks owned by Wella A.G. and Wella U.S. held to emanate from single source, based on the unity of control doctrine). Moreover, Applicant notes that refusals have arisen several times in the past with respect to trademark applications owned by Applicant or one its sister companies owned by the Ferrero Group, and in such instances, the U.S. Patent and Trademark Office has approved the marks for publication. For example, the mark NUTELLA & GO, Registration No. 3,508,800, owned by Applicant received a refusal based on Ferrero S.p.A.'s prior registrations. However, the mark was ultimately granted registration based on arguments that Applicant and Ferrero S.p.A. fall under the common control of the Ferrero Group. Similar arguments were presented

for Applicant's Application Serial No. 79,206,229 for FERRERO GOLDEN GALLERY  
MASAICO (now Registration No. 5393489) and Application Serial No. 79202538 for  
FERRERO GOLDEN GALLERY WORLD CHOCOLATE CLUB & Design (now Registration  
No. 5483054) and these marks were also allowed to mature to registration. Applicant therefore  
respectfully requests that the Examining Attorney reconsider his 2(d) refusal.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests that  
the Examining Attorney withdraw its refusal of registration for Application No. 79/221,172  
based on Section 2(d) and allow Applicant's Mark to proceed toward registration on the  
Principal Register.