

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial. No.: 87700273

Mark: VOODOO

Dated: July 17, 2018

REMARKS

This response is intended as a full and complete response to the Office Action dated March 17, 2018.

I. Refusal Under Section 2(d) – Likelihood of Confusion Refusal

The Examining Attorney has refused registration based on a likelihood of confusion with the marks VOODOO CHILD (US Reg. No. 4736720) in class 3 for “Body wash; Cleaning and washing preparations; Cosmetic preparations for bath and shower; Cosmetic preparations for body care; Fragrances,” VOODOO ROOTS ORGANICS (US Reg. No. 4793248) in class 3 for a variety of hair and skin care cosmetics, lotions, serums and preparations, and VOODOO PRINCE (US Reg. No. 4862824) in class 3 for “Personal grooming products for men, namely, cosmetic hair and skin care preparations.” The Examining Attorney has also cited prior-filed pending applications for VUDU COSMETICS (U.S. Serial No. 86194061) in class 3 for a variety of cosmetics and VOODOO MAKEUP (U.S. Serial No. 86391325) in class 35 for various consumer services in the field of cosmetics. Applicant respectfully traverses.

Active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. TMEP 1207.01(d)(iii). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider

the extent to which dilution may indicate that there is no likelihood of confusion. TMEP 1207.01(d)(x).

Here, VOODOO is a commonly used term. The Office Action cites three registrations and two applications containing the term VOODOO or VUDU and the examiner should consider the extent to which dilution may indicate that there is no likelihood of confusion. In fact, there are 230 live registrations and applications containing the term VOODOO, including 12 in international class 3. There are 27 live registrations and applications for VOODOO, alone, although notably none are in international class 3. There are an additional 15 live registrations and applications containing the term VUDU.

As one example, VOODOO (U.S. Reg. No. 3158834), VOODOO BBQ (U.S. Reg. No. 3253620), and VOODOO GUMBO (U.S. Reg. No. 5183037) (see attached) are all registered marks in international class 43 for restaurant services. Clearly, VOODOO is so commonly used that the public will look to other elements to distinguish the source of goods or services.

Cancelled or expired third-party registrations for similar marks are not probative evidence of a mark's descriptiveness, suggestiveness, or strength. TMEP 1207.01(d)(iii). However, they are evidence of the Trademark Office's historical practices. To that end, we note that VOODOO (U.S. Reg. No. 2643237) (see attached) in international class 3 for "body spray used as a fragrance and as a personal deodorant" was a live registration between October 29, 2002 and June 6, 2009, when it was cancelled due to a failure to file a Section 8 declaration. The mark coexisted with other marks containing the term VOODOO, including VOODOO DOLLS (U.S. Serial No. 78212101) (see attached) in international class 3 for "perfume body sprays... deodorants; anti-perspirants for personal use;" et. al., which was allowed on October 8, 2007 but abandoned due to a failure to timing file a statement of use.

If allowed, the applied-for mark would be the sole VOODOO mark in class 3. Therefore, it is easily distinguishable on its face from the cited marks in appearance, sound, and meaning. As consumers will look for other distinguishing elements, commonality of the term VOODOO has historically not been a bar to registration and should not now be a bar to registration.

II. Conclusion

For the foregoing reasons, Applicant submits that the application is in condition for publication. Accordingly, both favorable reconsideration of this application and prompt publication are earnestly solicited.

Int. Cl.: 43

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,158,834

Registered Oct. 17, 2006

**SERVICE MARK
PRINCIPAL REGISTER**

Voodoo

HARRAH'S LICENSE COMPANY, LLC (NEVADA
LTD LIAB CO)
TYLER/LAW
ONE HARRAH'S COURT
LAS VEGAS, NV 89119

FOR: RESTAURANT AND BAR SERVICES, IN
CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 3-28-1996; IN COMMERCE 5-27-1997.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,067,474.

SER. NO. 78-873,728, FILED 5-1-2006.

JANICE KIM, EXAMINING ATTORNEY

Int. Cl.: 43

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,253,620

Registered June 19, 2007

**SERVICE MARK
PRINCIPAL REGISTER**

Voodoo BBQ

VOODOO BBQ, LLC (LOUISIANA LTD LIAB CO)
1519 CARONDELET STREET
NEW ORLEANS, LA 70130

OWNER OF U.S. REG. NO. 2,720,801.

FOR: RESTAURANTS, IN CLASS 43 (U.S. CLS. 100
AND 101).

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "BBQ", APART FROM THE MARK
AS SHOWN.

FIRST USE 1-28-2002; IN COMMERCE 1-28-2002.

SER. NO. 78-948,188, FILED 8-9-2006.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

RICHARD WHITE, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

VOODOO GUMBO

Reg. No. 5,183,037

Tassin, Herb (UNITED STATES INDIVIDUAL)
8416 Rolling Hills Drive
Nashville, TN 37221

Registered Apr. 11, 2017

Int. Cl.: 43

CLASS 43: Restaurant services; Take-out restaurant services

Service Mark

FIRST USE 1-2-2017; IN COMMERCE 1-2-2017

Principal Register

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown:
"GUMBO"

SER. NO. 86-912,803, FILED 02-19-2016
MIDGE FAE BUTLER, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 2,643,237

United States Patent and Trademark Office

Registered Oct. 29, 2002

**TRADEMARK
PRINCIPAL REGISTER**

VOODOO

CONOPCO, INC. (NEW YORK CORPORATION),
DBA HELENE CURTIS,
325 NORTH WELLS STREET
CHICAGO, IL 606104713

FIRST USE 7-24-2002; IN COMMERCE 7-24-2002.

SN 75-599,534, FILED 11-25-1998.

FOR: BODY SPRAY USED AS A FRAGRANCE
AND AS A PERSONAL DEODORANT, IN CLASS 3
(U.S. CLS. 1, 4, 6, 50, 51 AND 52).

PATRICIA HORRALL, EXAMINING ATTORNEY

U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 571-273-9550. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: Oct 9, 2007

LYNN A SULLIVAN
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CHICAGO, IL 60601-6731

ATTORNEY
REFERENCE NUMBER

221246

** IMPORTANT INFORMATION: 6 MONTH DEADLINE **

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use " and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at http://www.uspto.gov/teas/index.html (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy:

SERIAL NUMBER: 78/212101
MARK: VODOO DOLLS
OWNER: VODOO DOLLS BRAND LIMITED
GRENVILLE COURT, BRITWELL ROAD
BURNHAM, BUCKINGHAMSHIRE , UNITED KINGDOM SL1 8DF

Section 1(a): NO Section 1(b): YES Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

- 003 - Soaps; perfumery, essential oils for personal use, cosmetics; colognes, eau de toilette, perfume body sprays; body and bath oils, creams and lotions for the skin; shaving foam, shaving gel, pre-shaving and after shaving lotions; talcum powder; preparations for the bath and shower, namely shampoo, bath salts, shower gels and bubble bath; hair lotions, namely conditioners, hair creams, hair dyes, gels, sprays and mousses; dentifrices; non-medicated mouth washes; deodorants; anti-perspirants for personal use; non-medicated toilet preparations, namely toilet waters, eau de colognes, body sprays; make-up; lipstick, lip gloss, lip liner, lip colour, nail colour; non-medicated preparations for the hair, scalp, skin and nails; foundation, face powder, blush, mascara, eyeliner, eye shadow; moisturizers, face creams, body creams, body lotions, shampoo, conditioner, hair gel, hair colour, hair mousse; face make-up powders and creams; all purpose cleaning preparations and substances; hair bleaching preparations; detergent soap; personal care products, namely nonmedicated skin cleansing preparations, suntan and sun screening preparations, shaving lotions and creams, nail polish, cuticle coat and nail polish removers -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE
009 - Video cameras; batteries; spectacles, spectacle cases, sunglasses; radios; telephone cases; radio sets; mouse mats; calculators; compact disk players and recorders; video cameras; loudspeakers; smoke detectors and fire alarms, electric irons; aerials; calculating machines; laser and inkjet printers; monitors for use with computers -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE
018 - Bags adapted for sporting use. -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE
024 - Textile fabrics for the manufacturing of clothing; bed linens and table linens, bed sheets; duvets; quilts; textile napkins; table linen, namely, place mats; cloth coasters; curtains, textile curtain pelmets, cushion covers, pillow covers, towels, tea towels, blinds; shower curtains; handkerchiefs; carpets; rugs; bed blankets; unfitted fabric furniture coverings; wall hangings of textile; eiderdown covers; upholstery fabrics -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE
026 - Hooks and eyes; shoe laces; zip fasteners; pin cushions; artificial flowers and fruit. -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE
028 - Electronic educational games machines for children; electronic game equipment with a watch function; hand held unit for playing electronic games; toys, namely, toy action figures; games, namely, board games; and playthings, namely, dolls; decorations for Christmas trees; and surfboards -- FIRST USE DATE: NONE; -- USE IN COMMERCE DATE: NONE

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED