

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

Applicant:	Cloud9 Esports, Inc.	Examining Attorney:	Shaunia P. Carlyle
Mark:	CLOUD9	Law Office:	110
Docket No.:	34641.6001		
Serial No.:	87/902,886		
Filed:	May 1, 2018		

**Response to Office Action**

**I. INTRODUCTION**

Applicant Cloud9 Esports, Inc. (“Applicant”) is responding to the Office Action dated August 27, 2018 concerning its application to register the word mark CLOUD9, shown at App. Serial No. 87/902,886 (“Applicant’s Mark”) as amended for “Plush toys; musical toys; action figure toys; electronic action toys; mechanical action toys; battery operated action toys; card games; board games; tabletop games; action skill games; trading card games; bobble head dolls” in Class 28.

The Examining Attorney has initially refused registration on the Principal Register pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a finding of likelihood of confusion with the marks TREECLOUD 9 registered for “Stands for electronic game playing apparatus, namely, headset, goggles, and hand controllers used for navigation and interaction within virtual reality, augmented reality and mixed reality environments” in class 28, and CLOUD 9 registered for “Electronic gaming machines, namely, devices which accept a wager; Gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output; Gaming machines; Gaming machines featuring a device that accepts wagers; Gaming machines including slot machines or video lottery terminals; Gaming machines that generate or display wager outcomes; Gaming machines, namely, slot machines and video lottery terminals; Gaming machines, namely, devices which accept a wager; Gaming machines, namely, electronic slot and bingo machines” in class 28 (the “Cited Marks”).

As detailed below, Applicant respectfully disagrees with the Examining Attorney’s conclusion that there is a likelihood of consumer confusion as to the source of the goods offered under the Cited Marks and those provided under Applicant’s Mark as amended. As set forth more fully below, the Cited Marks are not likely to be confused with Applicant’s Mark when each of the relevant factors is considered.

**II. THERE IS NO POTENTIAL LIKELIHOOD OF CONFUSION WITH RESPECT TO APPLICANT’S MARK AND THE CITED MARKS.**

Registration should only be denied when the applicant’s mark “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to

deceive.” 15 U.S.C. §1052. A determination of likelihood of confusion between marks is determined on a case-by-case basis. *In re Dixie Restaurants Inc.*, 41 USPQ 2d 1531, 1533 (Fed. Cir. 1997). The test for likelihood of confusion is whether a “reasonably prudent consumer” in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 476 F.2d 1357 (C.C.P.A 1973). In determining whether a likelihood of confusion exists, some of the factors essential to the analysis include the similarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression, the likely consumers, and the number and nature of similar marks in use on similar goods or services. *Id.* at 1361; TMEP § 1207.01. An application of the relevant *DuPont* factors to the instant case results in no likelihood of confusion between Applicant’s Mark and the Cited Marks.

**A. The Goods Provided Under Applicant’s Mark Are Distinguishable.**

When considering the similarity of the goods and services associated with the marks, the relevant question is whether purchasers would perceive both parties’ services as emanating from the same source. *See Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ 2d 1917, (TTAB 2006). It is not sufficient to demonstrate that goods and services are related by finding a particular term that broadly describes the goods or services. *See In re The W.W. Henry Company, L.P.*, 82 USPQ 2d 1213, (TTAB 2007).

Even if the marks are similar, if the goods and 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 *confusion is not likely*. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ 2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ 2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER & Design for advertising services, namely, the formulation and preparation of advertising copy and literature in the plumbing field); *See generally* TMEP §1207.01(a)(i).

Merely because the parties operate in a broad industry does not by itself establish that their services are related. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate); *National Rural Electric Cooperative Association v. Suzlon Wind Energy Corporation*, 78 USPQ 2d 1881, (TTAB 2006). Even where marks are placed within the same class, it is possible to avoid a likelihood of confusion where the goods and/or services vary. *See, e.g., Taj Mahal Enterprises, Ltd. v. Trump*, 16 USPQ 2d 1577 (D.N.J. 1990). In *Taj Mahal*, the marks under scrutiny were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort. *Id.* The court held that the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for casino-hotel evokes images of grandeur, opulence, and

extravagance. *Id.* Therefore, despite both falling under the same class of services for the purposes of registration, the *Taj Mahal* court found that there was no likelihood of confusion. *Id.*

Applicant's mark is used in connection with toys and games, such as plush toys, musical toys, action figures, card games, board games and tabletop games. For example, Applicant uses its mark in connection with a plush toy in the shape of a cloud. *See* Ex. A. [<https://www.cloud9.gg/products/cloud9-plushie>]. In contrast, the goods provided under the first registration cited by the Examining Attorney for the mark TREECLOUD 9 are **stands** for headsets, goggles, and hand controllers used for navigation and interaction within virtual reality, augmented reality and mixed reality environments. The goods provided under this mark are not toys or games themselves, but stands for holding headsets, goggles, and hand controllers to be used in connection with virtual reality products. *See* Ex. B. [<http://tsdr.uspto.gov/documentviewer?caseId=sn87611064&docId=SPE20170920063915#docIndex=10&page=1>] and Ex. C [<https://www.amazon.com/s?marketplaceID=ATVPDKIKX0DER&me=A2KNPWL6N78VVQ&merchant=A2KNPWL6N78VVQ>]. Similarly, the goods provided under the second registration cited by the Examining Attorney for the mark CLOUD 9 are electronic slot and bingo gambling machines. The goods provided under this mark are not toys or board games, but are sophisticated gambling devices for use in casinos. *See* Ex. D. [<http://tsdr.uspto.gov/documentviewer?caseId=sn85742715&docId=SPE20140212152740#docIndex=5&page=1>] and Ex. E. [<http://www.ksg.com/about>]. Thus, while Applicant's mark is used in connection with plush toy products, the Cited Marks are used in connection with stands for holding headsets and electronic slot machines, respectively. The goods are not the same nor are they related.

In making a determination that the goods and services are related, an examining attorney must "provide evidence showing that the goods and services are related to support a finding of likelihood of confusion." TMEP 1207.01(a)(vi); *See also In re White Rock Distilleries Inc.*, 92 USPQ 2d 1282, 1285 (TTAB 2009). In this case, the Examining Attorney has not put forth any evidence to show that Applicant's amended goods, which are plush toys, musical toys, action figures, card games, board games and tabletop games, are similar to those offered under the Cited Marks, which are stands for headsets, goggles, and hand controllers, and electronic slot and bingo gambling machines. As there is no evidence demonstrating that the Cited Marks' goods and the goods provided by Applicant are related, there can be no likelihood of confusion with respect to the marks at issue.

**B. Applicant's Mark is Different in Appearance and Visual Impression Than the TREECLOUD 9 Cited Mark.**

When the marks are considered in their entireties, Applicant's Mark is not similar in appearance or commercial impression as compared to the TREECLOUD 9 Cited Mark.

For purposes of determining whether a likelihood of confusion exists between two marks, the overall visual impression of the marks derived from viewing the marks in their entireties is controlling. See *In re Homeland Vinyl Products, Inc.*, 81 USPQ 2d 1378, (TTAB 2006); *Messey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399 (C.C.P.A. 1974) (“It is axiomatic that a mark should not be dissected and considered piece meal; rather, it must be considered as a whole in determining likelihood of confusion.”). The key analysis is whether the total effect conveyed by the two marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ 2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole). Even the use of identical dominant elements does not automatically mean that two marks are similar. For example, applying this same reasoning, the 10th Circuit in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ 2d 1865, 1874 (10th Cir. 1996), found the marks “FirstBank” and “First Bank Kansas” not to be confusingly similar. Additionally, in *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827, 833 (8th Cir. 1999), the mark “Lean Cuisine” was found not to be confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks included the term “lean” and were in the same class of goods, namely, low-fat frozen food.

A comparison of the marks at issue makes clear that Applicant’s Mark differs significantly from the Cited Marks. Applicant’s mark consists of the word CLOUD followed immediately by the number 9, with no space placed between the elements. In contrast, the first mark cited by the Examining Attorney consists of the composite term TREECLOUD followed by a space and the number 9. The Cited mark TREECLOUD 9 contains an entirely additional word not found in Applicant’s mark—“Tree” - which gives the mark an entirely different connotation and visual impression.

Moreover, the fact that both of the marks cited by the Examining Attorney, TREECLOUD 9 and CLOUD 9, already coexist with each other on the Principal Register is evidence that weighs against a likelihood of confusion here because it is pertinent “to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005); see also T.M.E.P. 1207.01(d)(iii); *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334 (Fed Cir. 2015).

When all of the various aspects of the respective marks are taken into account, Applicant’s Mark, CLOUD9, is not similar in impression or appearance to the Cited mark TREECLOUD 9.

### **III. CONCLUSION**

For all the foregoing reasons, Applicant requests that its application to register CLOUD9 be approved for publication on the Principal Register.