

U.S. Application Serial No. 88/053496

Mark: DUAL SOFT

Correspondent Docket No.: 16129-200108

### **RESPONSE TO OFFICE ACTION**

Applicant acknowledges receipt of an Office Action dated November 2, 2018 in this matter and notes the existence of a two issues (*i.e.*, likelihood of confusion and disclaimer) that form the bases for refusal of its application to federally register its trademark identified above. Applicant respectfully addresses the bases for refusal as follows and requests that its application be allowed and published for opposition.

#### **I. NO LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT'S DUAL SOFT MARK AND THE CITED REGISTRATIONS**

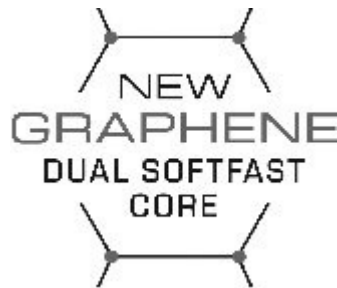
The Examining Attorney contends that Applicant's DUAL SOFT mark presents a likelihood of confusion with U.S. Registration No. 4,942,996 for NEW GRAPHENE DUAL SOFTFAST CORE and design ("the '996 Registration") and U.S. Registration No. 5,552,152 for DUAL SOFTFAST CORE ("the '152 Registration"). Applicant respectfully disagrees and believes that its DUAL SOFT application should not be refused based on either the '996 Registration or the '152 Registration.

##### **A. Marks as a Whole Have Different Appearances**

When Applicant's DUAL SOFT mark is considered in its entirety, it is clear that DUAL SOFT and NEW GRAPHENE DUAL SOFTFAST CORE and design and DUAL SOFTFAST CORE are different in appearance. The refusal under 2(d) focuses on the terms "dual" and "soft" but (1) ignores the fact that DUAL SOFT mark are two separate words, whereas the cite marks include at three or four additional words, and (2) ignores the fact that the cited marks do not use the word "Soft" as a standalone term and instead combines the word "soft" with the word "fast" to create the unitary "SOFTFAST" term. Respectfully, Applicant believes the marks should not be dissected into component parts. Importantly, as specifically stated in the first DuPont factor, marks must be considered in their entireties, which is the way consumers encounter the marks. *DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Additionally, the entire mark must be considered as a whole because "the commercial impression of a trademark is derived from it as a whole, not

from elements, separated and considered in detail.” *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 U.S. P.Q.2d 1471, 1473 (Fed. Cir. 1992). Further, marks are to be compared in their entireties and should not be dissected into component parts to reach a conclusion of confusing similarity as suggested by the Examining Attorney. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (stating “marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight”); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991).

Further, the '996 Registration is a design mark as shown below;



In addition to the design elements, the dominant portion of the mark is GRAPHENE. As shown, the mark looks different from Applicant's DUAL SOFT mark. Thus, this factor weighs against a finding of likelihood of confusion. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976)(similarities or dissimilarities between the marks is one of the two key inquires in a likelihood of confusion analysis).

**B. The Marks as a Whole Have Different Sounds and Commercial Impression**

Applicant's DUAL SOFT mark and the cited NEW GRAPHENE DUAL SOFTFAST CORE and design and DUAL SOFTFAST CORE have, as a whole, completely different sounds that create separate and distinct commercial impressions. Applicant's mark is pronounced as two words- "dual soft" which is different than the presumed pronunciation of "new graphene dual softfast core" and "dual softfast."

Further, as shown in the specimen(s) accompanying the statement(s) of use submitted in the '152 Registration (Exhibit A) and the '996 Registration (Exhibit B), the word "sofffast" is a unitary word. The unitary word "sofffast" is noticeably different sound than the word "soft" alone. Consequently, while portions of the marks are the same, the marks in their entireties have completely different pronunciations. Because the average consumer is not likely to be confused between the pronunciations of the marks, this factor further shows that there is no likelihood of confusion between the marks. Further, Applicant's mark creates a separate commercial impression from the cited marks. DUAL SOFT is different than the stylized NEW GRAPHENE DUAL SOFFFAST CORE mark and the DUAL SOFFFAST CORE mark. These dissimilarities weigh against a likelihood of confusion. See *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 USPQ.2d 1381, 1383 (TTAB 2005)(no likelihood of confusion between CARTAGIO and ONFOLIO and noting "the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion"); *Bridgestone Firestone North American Tire, LLC and Bridgestone Corporation v. Federal Corporation*, Opposition No. 91168556 (TTAB Feb. 24, 2010)(no likelihood of confusion between POTENZA and TURANZA).

Additionally, the existence of design elements in the NEW GRAPHENE DUAL SOFFFAST CORE and design mark further militates against confusion, in part because Applicant's DUAL SOFT mark does not connote or suggest the same design elements as the cited mark. See *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 U.S.P.Q.2d 1404, 1988 WL 252364 (TTAB 1988)(no confusion between a highly stylized house design used for real estate property management and a mark featuring another highly stylized house for real estate brokerage services); *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (holding VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause confusion).

## **II. RESPONSE TO DISCLAIMER REQUIREMENT**

For purposes of proceeding with this Application, Applicant submits the following disclaimer:

**No claim is made to the exclusive right to use “SOFT” apart from the mark as shown.**

This disclaimer is not a concession or admission that the term “Soft” as used in connection with the ‘496 Application is descriptive or generic.

## **III. CONCLUSION**

In view of the arguments and remarks submitted above, Applicant respectfully requests reconsideration of the refusal to federally register its DUAL SOFT trademark. Further, Applicant believes the amendments submitted concurrently with this response address all of the Examining Attorney’s concerns. Thus, Applicant respectfully requests prompt allowance of Applicant’s application. The Examining Attorney is invited to contact the undersigned by telephone or email if any issues are thought to remain.

62390062.1

## Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86699976
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 117
<b>EXTENSION OF USE</b>	NO
<b>MARK SECTION</b>	
<b>MARK</b>	http://tmng-al.uspto.gov/resting2/api/img/86699976/large
<b>LITERAL ELEMENT</b>	DUAL SOFTFAST CORE
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>OWNER SECTION (current)</b>	
<b>NAME</b>	Callaway Golf Company
<b>STREET</b>	2180 Rutherford Road
<b>CITY</b>	Carlsbad
<b>STATE</b>	California
<b>ZIP/POSTAL CODE</b>	92008
<b>COUNTRY</b>	United States
<b>PHONE</b>	7609305203
<b>EMAIL</b>	sonia.lari@callawaygolf.com
<b>OWNER SECTION (proposed)</b>	
<b>NAME</b>	Callaway Golf Company
<b>STREET</b>	2180 Rutherford Road
<b>CITY</b>	Carlsbad
<b>STATE</b>	California
<b>ZIP/POSTAL CODE</b>	92008
<b>COUNTRY</b>	United States
<b>PHONE</b>	7609305203
<b>EMAIL</b>	MikeCa@callawaygolf.com
<b>AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	Yes
<b>GOODS AND/OR SERVICES SECTION</b>	

<b>INTERNATIONAL CLASS</b>	028
<b>CURRENT IDENTIFICATION</b>	Golf balls
<b>GOODS OR SERVICES</b>	KEEP ALL LISTED
<b>FIRST USE ANYWHERE DATE</b>	01/31/2016
<b>FIRST USE IN COMMERCE DATE</b>	01/31/2016
<b>SPECIMEN FILE NAME(S)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT 16\866\999\86699976\xml11\SOU0002.JPG</a>
<b>SPECIMEN DESCRIPTION</b>	packaging for golf balls bearing the mark
<b>REQUEST TO DIVIDE</b>	NO
<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES IN USE</b>	1
<b>SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]</b>	100
<b>TOTAL AMOUNT</b>	100
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	/Michael A. Catania/
<b>SIGNATORY'S NAME</b>	Michael A. Catania
<b>SIGNATORY'S POSITION</b>	Assistant General Counsel
<b>DATE SIGNED</b>	02/05/2016
<b>SIGNATORY'S PHONE NUMBER</b>	7609308493
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Fri Feb 05 19:04:01 EST 2016
<b>TEAS STAMP</b>	USPTO/SOU-XX.XXX.XX.X-201 60205190401366699-8669997 6-5503595229c9031ef358450 d0d094d8cc2572fa15387c652 5d7f855a59274871-DA-6042- 20160205190029469536

## Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

To the Commissioner for Trademarks:

**MARK:** DUAL SOFTFAST CORE(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86699976/large>)

**SERIAL NUMBER:** 86699976

The applicant, Callaway Golf Company, having an address of

2180 Rutherford Road  
Carlsbad, California 92008  
United States  
7609305203

MikeCa@callawaygolf.com (authorized)

is submitting the following allegation of use information:

For International Class 028:

Current identification: Golf balls

The mark is in use in commerce on or in connection with all of the goods/services, or to indicate membership in the collective organization listed in the application or Notice of Allowance or as subsequently modified for this specific class.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 01/31/2016, and first used in commerce at least as early as 01/31/2016, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) packaging for golf balls bearing the mark.

[Specimen File 1](#)

The applicant is not filing a Request to Divide with this Allegation of Use form.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for the allegation of use for 1 class.

### Declaration

STATEMENTS: The signatory believes that: if the applicant is filing the amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d), the applicant is the owner of the mark sought to be registered; the mark is in use in commerce; **for a trademark or service mark application**, the applicant is using the mark in commerce on or in connection with all the goods/services in the application or notice of allowance, or as subsequently modified; **for a collective trademark, collective service mark, collective membership mark application**, the applicant is exercising legitimate control over the use of the mark in commerce by members on or in connection with all the goods/services/collective membership organization in the application or notice of allowance, or as subsequently modified; **for a certification mark application**, the applicant is exercising legitimate control over the use of the mark in commerce by authorized users on or in connection with the all goods/services in the application or notice of allowance, or as subsequently modified, and the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant; that to the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive; and the specimen(s) shows the mark as used on or in connection with the goods/services/collective membership organization in commerce.

DECLARATION: The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Michael A. Catania/ Date Signed: 02/05/2016  
Signatory's Name: Michael A. Catania  
Signatory's Position: Assistant General Counsel  
Signatory's Phone: 7609308493

RAM Sale Number: 86699976  
RAM Accounting Date: 02/08/2016

Serial Number: 86699976  
Internet Transmission Date: Fri Feb 05 19:04:01 EST 2016  
TEAS Stamp: USPTO/SOU-XX.XXX.XX.X-201602051904013666  
99-86699976-5503595229c9031ef358450d0d09  
4d8cc2572fa15387c6525d7f855a59274871-DA-  
6042-20160205190029469536



**CHROME SOFT**

DUAL SOFTFAST™ CORE  
TOUR URETHANE COVER

**CHROME SOFT**

DUAL SOFTFAST™ CORE  
TOUR URETHANE COVER

Callaway  
✓

**FEE RECORD SHEET**

**Serial Number:** 86699976



**RAM Sale Number:** 86699976

**Total Fees:** \$100

**RAM Accounting Date:** 20160208

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Total Fee</u>
Statement of Use (SOU)	7003	20160205	\$100	1	\$100

**Transaction Date:** 20160205



## Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	87541947
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 105
<b>EXTENSION OF USE</b>	NO
<b>MARK SECTION</b>	
<b>MARK FILE NAME</b>	https://tmng-al.uspto.gov/resting2/api/img/87541947/large
<b>LITERAL ELEMENT</b>	NEW GRAPHENE DUAL SOFTFAST CORE
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>OWNER SECTION</b>	
<b>NAME</b>	Callaway Golf Company
<b>STREET</b>	2180 Rutherford Road
<b>CITY</b>	Carlsbad
<b>STATE</b>	California
<b>ZIP/POSTAL CODE</b>	92008
<b>COUNTRY</b>	United States
<b>PHONE</b>	760-930-5203
<b>FAX</b>	760-930-5019
<b>EMAIL</b>	Sonia.Lari@CallawayGolf.com
<b>AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	Yes
<b>GOODS AND/OR SERVICES SECTION</b>	
<b>INTERNATIONAL CLASS</b>	028
<b>CURRENT IDENTIFICATION</b>	Golf balls
<b>GOODS OR SERVICES</b>	KEEP ALL LISTED
<b>FIRST USE ANYWHERE DATE</b>	01/01/2018
<b>FIRST USE IN COMMERCE DATE</b>	01/01/2018
<b>SPECIMEN FILE NAME(S)</b>	<a href="#">\\TICRS\EXPORT17\IMAGEOUT 17\875\419\87541947\xml16\SOU0002.JPG</a>
<b>SPECIMEN DESCRIPTION</b>	Use of mark on golf ball packaging, with link to purchase on company website.
<b>REQUEST TO DIVIDE</b>	NO
<b>PAYMENT SECTION</b>	

<b>NUMBER OF CLASSES IN USE</b>	1
<b>SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]</b>	100
<b>TOTAL AMOUNT</b>	100
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	/Sonia Lari/
<b>SIGNATORY'S NAME</b>	Sonia Lari
<b>SIGNATORY'S POSITION</b>	Attorney of Record/CA Bar Member
<b>DATE SIGNED</b>	06/18/2018
<b>SIGNATORY'S PHONE NUMBER</b>	760-930-5203
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Mon Jun 18 15:35:58 EDT 2018
<b>TEAS STAMP</b>	USPTO/SOU-XX.XXX.XX.X-201 80618153558126838-8754194 7-6109e8e9aab53545ef13d98 36f458efb35e535b7cb5853ae c84596b98ad835d-DA-2075-2 0180618152118314944

---

## Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

To the Commissioner for Trademarks:

**MARK:** NEW GRAPHENE DUAL SOFTFAST CORE (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/87541947/large>)

**SERIAL NUMBER:** 87541947

The applicant, Callaway Golf Company, having an address of

2180 Rutherford Road  
Carlsbad, California 92008  
United States  
760-930-5203  
760-930-5019

Sonia.Lari@CallawayGolf.com (authorized)

is submitting the following allegation of use information:

For International Class 028:

Current identification: Golf balls

The mark is in use in commerce on or in connection with all of the goods/services, or to indicate membership in the collective organization listed in the application or Notice of Allowance or as subsequently modified for this specific class.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 01/01/2018, and first used in commerce at least as early as 01/01/2018, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Use of mark on golf ball packaging, with link to purchase on company website..

[Specimen File1](#)

The applicant is not filing a Request to Divide with this Allegation of Use form.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for the allegation of use for 1 class.

### Declaration

- The signatory believes that the applicant is the owner of the mark sought to be registered.  
**For a trademark or service mark application**, the mark is in use in commerce on or in connection with all the goods/services in the application or notice of allowance, or as subsequently modified.  
**For a collective trademark, collective service mark, collective membership mark application**, the applicant is exercising legitimate control over the use of the mark in commerce by members on or in connection with all the goods/services/collective membership organization in the application or notice of allowance, or as subsequently modified.  
**For a certification mark application**, the applicant is exercising legitimate control over the use of the mark in commerce by authorized users on or in connection with the all goods/services in the application or notice of allowance, or as subsequently modified, and the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.
- The specimen(s) shows the mark as used on or in connection with the goods/services/collective membership organization in commerce.
- To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.

- To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: /Sonia Lari/    Date Signed: 06/18/2018  
Signatory's Name: Sonia Lari  
Signatory's Position: Attorney of Record/CA Bar Member  
Signatory's Phone: 760-930-5203

RAM Sale Number: 87541947  
RAM Accounting Date: 06/19/2018

Serial Number: 87541947  
Internet Transmission Date: Mon Jun 18 15:35:58 EDT 2018  
TEAS Stamp: USPTO/SOU-XX.XXX.XX.X-201806181535581268  
38-87541947-6109e8e9aab53545ef13d9836f45  
8efb35e535b7cb5853aec84596b98ad835d-DA-2  
075-20180618152118314944





Quantity:

Personalize:

Ball <b>STANDARD</b>	Ball <b>PERSONALIZE</b>
-------------------------	----------------------------

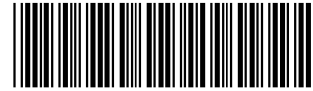
**\$44.99** Availability: In Stock

[Add To Cart](#) +

[http://www.callawaygolf.com/balls/chrome-soft/balls-2018-chrome-soft.html?\\_ga=2.139251827.1110534257.1527719670-625285481.1523549967](http://www.callawaygolf.com/balls/chrome-soft/balls-2018-chrome-soft.html?_ga=2.139251827.1110534257.1527719670-625285481.1523549967)

**FEE RECORD SHEET**

**Serial Number:** 87541947



**RAM Sale Number:** 87541947

**Total Fees:** \$100

**RAM Accounting Date:** 20180619

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Total Fee</u>
Statement of Use (SOU)	7003	20180618	\$100	1	\$100

**Transaction Date:** 20180618

