IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
NOVIE, Ser. No. 88/307,138
Response to Office Action dated March 25, 2019

The Examining Attorney has refused registration of the applied-for mark "NOVIE", Ser. No. 88/307,138, owned by Spin Master Ltd. ("Applicant"), for goods in Class 28 on the following grounds: (1) Section 2(d) refusal with respect to U.S. Reg. No. 5,225,990 for NOVI A GAME OF VISUAL INTELLIGENCE in connection with board games (the "Cited Mark"); and (2) amendments were required to the identification of goods.

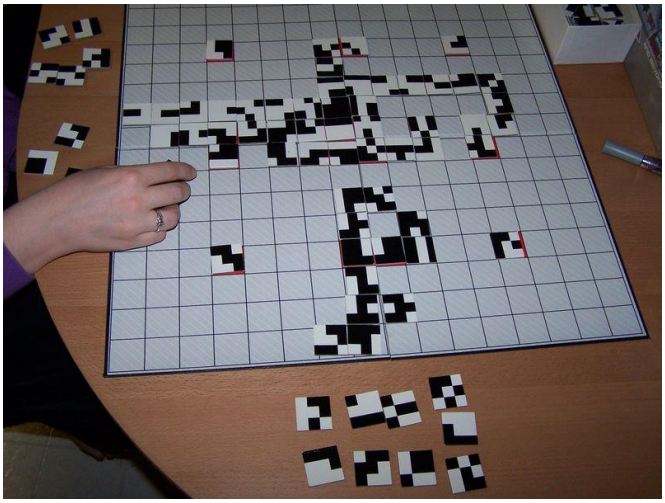
As an initial point, Applicant has amended the identification of goods to read: "Toys, namely, interactive electronic toy robots." In light of this amendment, Applicant respectfully submits that the identification of goods is now sufficiently definite.

Applicant further submits that there is no likelihood of confusion with NOVI A GAME OF VISUAL INTELLIGENCE for board games, as the marks differ in commercial impression, sound, connotation, and appearance, and are used on unrelated goods, especially in light of the amended identification. Thus, Applicant respectfully requests that the Examining Attorney allow this application to proceed.

I. Applicant's Mark NOVIE creates no likelihood of confusion with respect to the mark NOVI A GAME OF VISUAL INTELLIGENCE

The Examining Attorney refused registration on the basis of a likelihood of confusion with Reg. No. 5,225,990 for NOVI A GAME OF VISUAL INTELLIGENCE in connection with "board games." Applicant respectfully submits that its mark NOVIE for use in connection with "Toys, namely, interactive electronic toy robots" does not create a likelihood of confusion with the mark NOVI A GAME OF VISUAL INTELLIGENCE in connection with "board games."

The goods identified in connection with Applicant's mark and the Cited Mark are not, as the Examining Attorney asserts, "closely related," but are in fact vastly different and not related at all. Applicant produces interactive electronic toy robots, such as the one shown below left. The Cited Mark, in contrast, is used in connection with board games, specifically, the one below right.



These products are plainly unrelated.

The Examining Attorney provided a small number of registrations including "toy robots," "board games," and "toy animals" in some combination. The Examining Attorney did not, however, provide any registrations that include both Applicant's specific goods as amended and the goods of the Cited Mark, namely, "interactive electronic toy robots" and "board games." No such registrations exist.

The Examining Attorney also provided internet evidence purporting to show that the same entity "commonly" produces both board games and toy animals. Despite claiming that such overlap is common, the Examining Attorney provided only two examples. One of those two examples, Fat Brain Toys, is primarily a toy store rather than a toy maker, and the links provided by the Examining Attorney are to products from two different source toy makers, neither of which

is Fat Brain Toys. Further, with Applicant's amendment to the identification of goods, toy animals are no longer relevant to the alleged overlap in goods.

The Examining Attorney also states that the determination of likelihood of confusion is based on the "description of the goods" rather than use, and that "the goods of the parties have no restrictions as to nature…." Applicant respectfully submits that with the amendment to the identification of goods, the restriction as to the nature of Applicant's goods sufficiently differentiates the goods from those in the Cited Mark such that confusion is unlikely.

Further, the marks NOVIE and NOVI A GAME OF VISUAL INTELLIGENCE differ in appearance, sound, connotation, and commercial impression. In the Office Action, the Examining Attorney focused only on the first word of the NOVI A GAME OF VISUAL INTELLIGENCE mark. This was error, as the additional five words in the Cited Mark create a significantly different appearance, sound, connotation, and commercial impression to Applicant's NOVIE mark, which does not contain any additional verbiage. When analyzing marks for similarities in sight, sound and meaning, "a court must look to the overall impression created by the marks and not merely compare individual features" of the marks. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987). Courts have consistently found that the mere presence of an identical term within different marks does not automatically create a likelihood of confusion. *Id*. For example, the marks ROMAN and ROMANBURGER (both for food products) were held to be not confusingly similar even though the mark ROMANBURGER incorporates the entirety of the mark ROMAN. *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884 (Fed. Cir. 1986). In this case, the Examining Attorney states that the addition of five words "does not change the commercial impression significantly enough to overcome the shared similarities." But courts have also held that the addition, subtraction, or rearrangement of parts of a mark may create

distinctly different commercial impressions. *See In re Hearst Corp.*, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992). In fact, those additional five words completely alter the way the mark as a whole is verbalized, understood, and perceived by the consuming public. The cases cited as support by the Examining Attorney are all distinguishable from the current case, as in each of the cited cases, there were only minor differences between the two marks in question, ranging from three to five letters. In this case, however, the difference between Applicant's mark and the Cited Mark is five *words*—83% of the Cited Mark. The additional five words in the NOVI A GAME OF VISUAL INTELLIGENCE mark should not be discounted, and the result is a mark significantly different in appearance, sound, connotation, and commercial impression to Applicant's NOVIE mark.

In summary, when both marks are viewed in their entirety, Applicant's mark NOVIE is different in commercial impression, sound, connotation, and appearance from the Cited Mark, NOVI A GAME OF VISUAL INTELLIGENCE, and the goods "interactive electronic toy robots" are significantly different goods from "board games." Given the differences between the marks and the goods identified, there is no likelihood of confusion and Applicant respectfully requests the Examining Attorney's refusal be withdrawn.

II. Applicant Has Amended the Identification of Goods

The Examining Attorney noted that the wording used to describe Applicant's goods and services requires clarification. To resolve this issue, Applicant amends the identification of goods as follows (amendments in **bold**, deletions in ~~strikethrough~~):

Toys, **namely,** ~~games and playthings; toy animals, interactive electronic toy animal,~~ **interactive electronic** toy robots ~~and accessories for all the foregoing~~

III. Conclusion

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw all grounds for refusal and allow App. Ser. No. 88/307,138 to proceed to publication.