Response

This response answers the Office Action issued on April 18, 2019 for Application Serial No. 88/303,344 (the "Application") for the mark HAPPY EGGS (the "Mark") filed by RiGO Trading S.A. (the "Applicant"). Please see the following remarks:

Information Request

The Examiner requested additional information regarding the nature of Applicant's goods. Below are Applicant's answers to the Examiner's inquiries:

1. Applicant intends the goods to be in the form of colored eggs and fried eggs (see Exhibit A).
2. Applicant does not intend the goods for use in connection with eggs or egg shaped packages.
3. Applicant's goods will not include eggs as an ingredient.

Disclaimer Requirement

Applicant accepts the disclaimer for "EGGS" in the following standardized format:

No claim is made to the exclusive right to use "EGGS" apart from the mark as shown.

Remarks

The Examiner has initially refused registration under Section 2(d) of the Trademark Act on the grounds that it is likely to be confused with Registration No. 5500620. For the reasons below, Applicant respectfully submits there is no likelihood of confusion with the cited registration:

1. The Cited Registration is Entitled to a Narrow Scope of Protection

The co-existence of third party marks containing similar elements can indicate that a mark or a portion of a mark is so common that the public will look to other elements to

distinguish the source of goods or services. TMEP § 1207.01(d)(iii); *see also In re Hartz Hotel Services, Inc.*, 102 U.S.P.Q.2d 1150, 1154 (T.T.A.B. 2012) (reversing the Examiner's refusal to register the mark "GRAND HOTEL NYC" because other "GRAND HOTEL" marks for "hotel services" coexist on the register and "it is clear from the third-party registrations that the addition of a geographic location to the word 'GRAND HOTEL' has been sufficient for the Patent and Trademark Office to view these marks as being sufficiently different from the cited registrant's mark, and from each other, such as not to cause confusion"); *see also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015) (noting that third party registrations can indicate that the common element in the marks is a well-known descriptive or suggestive term and, therefore, such term is weak). Further, when a mark that consists of a certain term is used by many third parties, consumers will look to very nuanced points of differentiation between the marks. *See In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1564 (T.T.A.B. 1996) ("BROADWAY CHICKEN" for restaurant services not likely to be confused with "BROADWAY PIZZA" and "BROADWAY BAR & PIZZA" for restaurant services).

Here, a search of the Trademark Office records found 106 active registrations and applications that use "HAPPY" in relation to confectionary, candy, or chocolate products (see search results and representative sample of Registration Certificates attached as Exhibit B). This demonstrates that "HAPPY" is so common that it is a weak term in connection with these types of goods. Furthermore, the Registrant of the cited mark has disclaimed the word "EGG" and the Registrant's goods are egg-shaped. Thus, the term "EGG" in the cited mark is highly descriptive of the claimed products and is likewise a weak term. Therefore, the cited registration as a whole

is entitled to a very narrow scope of protection and Applicant's Mark can peacefully co-exist on the Principal Register without confusion.

2. Applicant's Goods are Distinguishable and Not Closely Related to those of the Cited Registration

One of the factors considered in determining a likelihood of confusion is the "similarity or dissimilarity and nature of the goods or services as described in an application or registration." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Differences between the specific goods at issue must be taken into consideration, as each case must be decided on its own facts. *Harry Fischer Corp. v. Kenneth Knits, Inc*., 207 U.S.P.Q. 1019, 1024-25 (T.T.A.B. 1980).

Furthermore, "there can be no rule that certain goods… are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto." *H.D. Lee Co. v. Maidenform Inc.*, 87 U.S.P.Q.2d 1715, 1723 (T.T.A.B. 2008) (finding "ONE FAB FIT" for intimate apparel and sleepwear not confusingly similar to "ONE TRUE FIT" for outerwear in part because "they are different types of clothing, having different purposes"); *see, also, Elec. Data Sys. Corp. v. ESDA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992) ("[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.").

As shown below, the goods of the cited registration are chocolate candies in an egg-shaped container with a toy inside:

Specimen for Reg. No. 5500620

While the scope of the cited mark is not bound by the specimen, the description of goods specifically limits the registration to goods "contained in an egg-shaped container and also including a toy." In contrast, Applicant's goods will not come in egg-shaped containers and they will not include a toy. Furthermore, Applicant's Mark covers "confectionary made of sugar in the form of sweet foam, licorice and chewing gum" and "gummy candies," which are made from gelatin. Therefore, Applicant's goods will have different ingredients, flavors, and consistencies than the goods of the cited registration. *See In re Mars, Inc.*, 222 U.S.P.Q. 938 (Fed. Cir. 1984) (finding no likelihood of confusion between CANYON for candy bars and CANYON for citrus fruits due the differences between the goods). As such, the goods are sufficiently distinct to avoid confusion.

However, if necessary, Applicant is willing to amend their description of goods to state that the goods are "not contained in an egg-shaped container and not including a toy."

Conclusion

Given the above, Applicant respectfully submits that there is no likelihood of confusion and that Application No. 88/303,344 is in condition for publication.