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To: USPTO

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From:

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Re: 88473396 - POUCH

This Response is made to the Sept 7th, 2019 Office and is made timely. The Examining Attorney has refused registration of Applicant's mark under:

- Section 2(e)1 Refusal – Merely Descriptive
- Section 2(d) Refusal – Likelihood of Confusion

Applicant now addresses these issues:

Section 2(e)1 Refusal – Merely Descriptive

The applicants mark POUCH is filed in International Class 031, Pet Food. The examining attorney has refused the mark as Merely Descriptive. In order for a mark to be considered merely descriptive, the term must describe goods or services with particularity. In re TMS Corp. of the Americas, 200 U.S.P.Q. 57, 59 (TTAB 1978) (THE MONEY STORE held registrable; “falls short of describing [a]pplicant’s services in any one degree of particularity”); Holiday Inns, Inc. v. Monolith Enterprises, 213 U.S.P.Q. 949, 952 (TTAB 1981) (THE AMERICAN CAFE held registrable; American fails to “immediately tell a diner what to expect his or her dinner to be”).

In this case the examining attorney has cited other pet food which packages its pet food in a pouch, but does not cite a reference where the pet food itself is POUCH. Here the application is for pet food, POUCH is not descriptive of pet food in anyway.

“if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496, 498 (TTAB 1978).

Here the consumer is buying pet food, and has to reason that pouch is named from the packaging, not the product. The applicants product could come in a box, but this is not a consideration as the applicant has applied for a pet food classification.

“It should be noted that looking to others in the industry to determine if they use such words in describing their products.” *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557 (T.T.A.B. 1975), *aff'd*, 189 U.S.P.Q. 348 (C.C.P.A. 1976).

The citations merely describe packaging, not the pet food itself.

Section 2(d) – Likelihood of Confusion

The registered marks are as follows:

1. U.S. Registration No. 4889990, THERE’S A PARTY IN EVERY POUCH

The marks in question are different and leave different commercial impressions. When comparing products a customer will not assume the applicants POUCH mark is associated with the cited mark THERE’S A PARTY IN EVERY POUCH, as the marks have a different commercial impression. In the cited registered mark the term POUCH is not the primary term, PARTY is the commercial impressionable primary word.

In the seminal case, *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236 (CCPA 1982), the CCPA held that “[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used...”

The case of *In re E.I. Dupont de Nemours & Company*, 177 U.S.C.Q. 563 (CCPA 1973) [hereinafter “*Dupont*”] sets forth the factors to be considered in determining whether a likelihood of confusion exists. There is no bright line test and each case must be decided on its own facts. TMEP § 1207.01. “The fundamental inquiry mandated by section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the mark.” *Interstate Brands v. Celestial Seasonings, Inc.*, 198 USPQ 151, 153 (CCPA 1978). Applicant asserts that the cumulative effect of the factors articulated in *Dupont* as they relate to Applicant’s mark and the goods that it

represents distinguish it sufficiently. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

Dupont Factors:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
 - a. The marks are significantly different in their entirety, appearance when printed, speech, and commercial impression.

2. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
 - a. The applicant agrees these products are similar.

3. The similarity or dissimilarity of established, likely-to-continue trade channels.
 - a. Similar trade channels.

4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
 - a. The likelihood of impulse buying versus sophisticated buying does not apply as the commercial impression of the length of mark THERE'S A PARTY IN EVERY POUCH at a glance is not similar to the simplicity of POUCH.

5. The fame of the prior mark.
 - a. Unknown

6. The number and nature of similar marks in use on similar goods.
 - a. NA

7. The nature and extent of any actual confusion.

- a. None has occurred.
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- 8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
 - a. NA

 - 9. The variety of goods on which a mark is or is not used.
 - a. NA

 - 10. The market interface between the applicant and the owner of a prior mark.
 - a. No interface.

 - 11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
 - a. NA

 - 12. The extent of potential confusion.
 - a. The names are different in length, meaning, and connotation and would not cause confusion.

 - 13. Any other established fact probative of the effect of use.
 - a. NA

Conclusion

As the applicant's mark and cited mark are distinctly different, The Dupont factors allow for these names to coexist.

Applicant respectfully submits that all outstanding issues have been resolved and the mark is now in sufficient condition for publication. The Examining Attorney is

invited to contact the undersigned by telephone at (612) 584 9726 or e-mail to resolve any outstanding issues.

/Ross Brandborg/ 10/01/2019
Attorney of Record