

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINING DIVISION**

Applicant:	Amazon Technologies, Inc.)	
)	
Mark:	RING NET)	Amer Raja
)	Examining Attorney
Serial No.:	88357158)	Law Office 121

OFFICE ACTION RESPONSE

Amazon Technologies, Inc. (“Amazon”) has received and reviewed the Office Action dated June 7, 2019, regarding Application No. 88357158 (“Application”) to register the mark RING NET (“Amazon’s Mark”). In the Office Action, the Examining Attorney requests amendment of the Application’s identification of goods and services in Classes 9, 11, 12, 35, 38, 41, 42, and 45; partially refuses registration based on an alleged likelihood of confusion with two prior registered marks; and requests a disclaimer of the term NET with respect to all classes. In response, Amazon respectfully submits the following:

REMARKS

In response to the Examining Attorney’s request, Amazon has amended its identification of goods and services in Classes 9, 11, 12, 35, 38, 41, 42, and 45, and these amendments are set forth in the TEAS form submitted contemporaneously with this response.

The Examining Attorney initially has refused registration based on a perceived likelihood of confusion between Amazon’s Mark and two cited marks (“Cited Marks”): Reg. No. 5000274 for the mark RING (“BC’s Mark”), owned by Beta-Calco, Inc. (“BC”), and Reg. No. 4713654 for the mark RING (Stylized) (“Logbar’s Mark”), owned by Logbar, Inc. (“Logbar”). For the reasons set forth below, Amazon respectfully submits that no likelihood of confusion exists between Amazon’s Mark and either of the Cited Marks and asks that the Examining Attorney withdraw the Section 2(d) refusal.

Finally, the Examining Attorney has requested a disclaimer of the term “NET” with respect to all classes. Amazon requests the withdrawal of the disclaimer request and the approval of its Application for publication.

I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN AMAZON’S MARK AND EITHER OF THE CITED MARKS.

In determining a likelihood of confusion, the Examining Attorney must look at all of the relevant likelihood of confusion factors enumerated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). These factors include: the relatedness of the goods or services; the similarity or dissimilarity in the marks in terms of appearance, sound and overall commercial impression; the number and nature of similar marks in use on similar goods or services; the strength of the cited marks; and other established facts probative of the effect of use. *Id.*

In determining the similarity of the Cited Marks and Amazon’s Mark, the strength or weakness of the mark in the cited registration is a very important factor. *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 259 (5th Cir. 1980) (DOMINO’S PIZZA not confusingly similar to DOMINO sugar). Here, an evaluation of all relevant *Du Pont* factors—including the narrow scope of protection afforded to the Cited Marks and coexistence of the marks—instructs that no likelihood of confusion exists between Amazon’s Mark and either of the Cited Marks. Accordingly, Amazon respectfully requests withdrawal of the Section 2(d) refusal to register its mark.

A. BC’s Mark Is Entitled to an Exceedingly Narrow Scope of Protection Because It Is Registered on the Supplemental Register and Is Merely Descriptive.

BC’s Mark is registered on the Supplemental Register and is merely descriptive of the ring-shaped light fixtures offered under the mark. *See* Exh. No. 1 (printout of Registrant’s

website offering ring-shaped light fixtures under the BC's Mark). It is well-established that marks registered on the Supplemental Register, such as the BC's Mark, are "not [] 'trademark[s]'" at all" but instead are "only 'capable' of someday becoming 'mark[s]'" upon the acquisition of secondary meaning." J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:33 (5th ed.) ("MCCARTHY") (citing *Books On Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520, 5 U.S.P.Q.2d 1301 (Fed. Cir. 1987)).

Further, BC's Mark for RING is descriptive of BC's ring-shaped lighting goods. As BC's RING mark merely describes the specific shape of BC's ring lights, customers would naturally associate BC's Mark only with the ring shape of the goods and not as a mark unique to BC as the source of the goods. The name being associated with the product shape rather than product source is further demonstrated by BC's other lighting product names, which also describe the shape of the light. *See, e.g.*, Exh. No. 2 (BC's use of the mark SQUIGGLE in connection with a squiggle-shaped lighting fixture); Exh. No. 3 (BC's use of an unregistered "KURL" mark for curl-shaped fixtures).

Because of its weak and descriptive nature, BC's Mark has an exceedingly narrow scope of protection and cannot serve to block Amazon's distinctive mark, which also contains the term NET, which BC's Mark does not. *See In re Hunke & Jochheim*, 185 U.S.P.Q. 188, 189 (T.T.A.B. 1975) (Registration of DURABUL on the Supplemental Register for stationery articles did not bar registration of HIG-DURABLE on the Principal Register for stationery articles). Here, BC's Mark is readily distinguishable from RING NET considering that BC's Mark is not functioning as a "trademark at all."

B. Logbar’s Mark Is Entitled to an Exceedingly Narrow Scope of Protection Because It Is a Commonly Used, Merely Descriptive Term and Because the Mark Is No Longer in Use.


Even assuming that Logbar’s Mark is in use (which it does not appear to be), Logbar’s Mark is descriptive and would be entitled to only a narrow scope of protection. At the time of registration of its RING (Stylized) mark, Logbar used the mark on a ring designed to be worn on a finger, and the mark is therefore descriptive. While Logbar asserted in its Office Action Response dated May 5, 2014, that “‘RING’ appearing in the mark has *no significance* nor is it a term of art in the relevant trade or industry or as applied to the goods/services listed in the application,” (emphasis added) Logbar’s *actual use* of the mark was in relation to a tech-capable ring (commonly referred to as a “smart ring”). See Exh. No. 4 (Specimen submitted by Logbar on January 14, 2015 in regards to Trademark Registration No. 4713654); Exh. No. 5 Tim Stevens, *16Lab Smart Ring Concept Keeps All of Your Devices Within Reach*, CNET (October 7, 2014). In other words, Logbar’s actual use of its RING mark is obviously descriptive and does not indicate the source of Logbar’s goods.

In addition to the descriptiveness of the Logbar Mark, Applicant requests that the Examining Attorney withdraw the Section 2(d) refusal as to the Logbar Mark for an independent reason: Logbar’s mark is no longer in use. As early as October 2015, Logbar had rebranded its smart ring product under the brand OZON. See Exh. No. 6 (Tim Stevens, *Ozon Gesture Ring Concept From 16Lab Lets You Wrap All Your Devices Around Your Little Finger*, CNET (October 5, 2015)). Because this descriptive mark is no longer in use, it should not block registration of Amazon’s Mark.

C. There Is No Likelihood of Confusion Because Numerous RING Marks Owned by Applicant Have Registered Without Citation or Objection from BC or Logbar.

Amazon's Mark is not likely to cause confusion with the Cited Marks because the Cited Marks coexist with various RING marks owned by Applicant on the Principal Register.

Amazon's RING marks that coexist with Cited Marks in Classes 9 and 11 include the following:

- Trademark Registration No. 4724984 for **RING** for various electronic and software products in Class 9, which registered on 4/21/2015 and states a date of first use in commerce of 11/2016.
- Trademark Registration No. 5676741 for **RING** for "lighting controllers; lighting control apparatus; electric control devices for lighting fixtures" in Class 9, which registered on 2/12/2019 and states a date of first use of 6/13/2016.
- Trademark Registration No. 5776163 for  for "floodlights, spotlights, and wall lights" in Class 11 and for security lights and software for controlling lights in Class 9, which registered on 6/11/2019.
- Trademark Registration No. 5277105 for **RING+** for software for controlling lights in Class 9, which registered on 8/29/2017 and states a date of first use in commerce of 1/5/2016.
- Trademark Registration No. 5764224 for **RING** for "Floodlights, spotlights, wall lights" in Class 11 and software for controlling lights in Class 9, which registered on 5/28/2019 and states a date of first use in commerce of 6/13/2018.

Copies of the TSDR printouts of these records are attached as Exhibit 7. Given that the USPTO has allowed the above marks to register alongside the Cited Marks, and given that neither BC nor Logbar has opposed any of these registrations, Applicant respectfully submits that Amazon's RING NET mark can coexist with the Cited Marks without confusion.

E. Amazon Lacks Intent to Trade Off the Goodwill of the Registrant.

Relevant case law indicates that “courts regularly include intent as one of the factors to be assessed in evaluating likelihood of confusion.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 22 rptr. note to cmt. b, at 246 (1995). In this instance, Amazon had no intent to trade upon anyone’s reputation by applying to register Amazon’s Mark, including the reputations of BC and Logbar. This lack of intent can be inferred from Amazon’s longstanding use of RING marks in the marketplace without objection from BC or Logbar, and the coexistence of Amazon’s numerous RING-formative registrations. Further, on information and good faith belief, Amazon understands that the Logbar’s RING-branded product is no longer in use and did not achieve commercial success. *See* Exh. No. 6. Thus, this factor also supports registration of Amazon’s Mark. *Omaha Nat’l Bank v. Citibank (S.D.), N.A.*, 633 F. Supp. 231, 234, 229 U.S.P.Q. 51, 52 (D. Neb. 1986).

F. After Consideration of all Relevant Factors, Confusion Is Unlikely.

When determining whether Amazon’s Mark creates a likelihood of confusion with a mark covered by a cited registration or application, “[a] showing of mere possibility of confusion is not enough; a *substantial likelihood* that the public will be confused must be shown.” *Omaha Nat’l Bank*, 633 F. Supp. at 234, 229 U.S.P.Q. at 52 (emphasis added). Amazon submits that the factors set forth in *Du Pont* for which there is record evidence support registration of Amazon’s Mark and do not raise a substantial likelihood of confusion with either of the Cited Marks. A Section 2(d) refusal requires that there be a practical likelihood of confusion, not “mere theoretical possibilities of confusion.” *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405 (C.C.P.A. 1969). For the reasons discussed above, consumer confusion is not likely, and Amazon respectfully requests that the Section 2(d) refusal be withdrawn.

II. THE TERM “NET” IS NOT DESCRIPTIVE OF AMAZON’S GOODS AND SERVICES AND DOES NOT REQUIRE A DISCLAIMER.

Amazon respectfully requests that the Examining Attorney withdraw the disclaimer request for the term NET with respect to all classes because RING NET is incongruous and suggestive of the applied-for goods and services. Section 2(e)(1) of the Lanham Act does not prohibit registration of a word or mark unless the *immediate* significance of the words making up the mark is to describe the applicant’s goods or their qualities or characteristics. *See, e.g., In re Realistic Co.*, 440 F.2d 1393 (C.C.P.A. 1971) (CURV not merely descriptive of permanent wave curling solution); *Ex parte Great West Lubricants, Inc.*, 118 U.S.P.Q. 169 (Comm. Pats. 1958) (TUBE-O-LUBE used on a cartridge of lubricating grease not descriptive but suggestive).

A disclaimer of NET is not appropriate because RING NET, and the individual term NET, are suggestive rather than descriptive. Suggestive marks are protectable because they require consumers to “exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristic the term indicates.” *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978) (finding TENNIS IN THE ROUND suggestive of a service providing circular tennis facilities). Further, “[i]f two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.” TMEP § 1213.05(d); *see also* TMEP § 1209.01(a) (“[T]he concept of mere descriptiveness “should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and ‘mental pause.’”).

Moreover, where a word in a mark (or the mark itself) can have multiple meanings to the consuming public, it is suggestive rather than descriptive. *See Henry Siegel Co. v. M & R Int’l*

Mfg. Co., 4 U.S.P.Q.2d 1154, 1159 (T.T.A.B. 1987) (finding L.A. CHIC not merely descriptive of fashionable women’s jeans because ‘chic’ could also be interpreted to mean ‘chick’); *In re Diet Tabs, Inc.*, 231 U.S.P.Q. 587, 588 (T.T.A.B. 1986) (finding DIET TABS not merely descriptive of vitamin tablets because, *inter alia*, DIET could mean ‘diet’ or ‘dietary’).

As discussed below, a disclaimer of ‘NET’ in Amazon’s Mark is unnecessary because RING NET is incongruous and suggestive of Amazon’s goods and services, and because RING NET conveys a variety of ideas about the characteristics and qualities of the goods and services to consumers. As a result, consumers encountering Amazon’s RING NET mark must follow ‘a multi-stage reasoning process’ when determining the nature of Amazon’s goods and services offered under the mark.

A. NET Is Suggestive and Its Potential Disclaimer Must Be Evaluated in the Context of the Whole RING NET Mark.

RING NET is suggestive, and a disclaimer of NET should not be required. When considering a disclaimer, the proper inquiry is whether the mark RING NET *as a whole* has a recognized definition or meaning that immediately describes the qualities or characteristics of the applied-for goods and services. *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920).

The Examining Attorney has improperly dissected the mark and stated that the term NET is descriptive because the term refers to ‘a network or connected group of computer or systems such as the internet.’ However, the Examining Attorney must consider NET in the context of the mark as a whole. *See P.D. Beckwith, Inc. v. Comm’r*, 252 U.S. 538, 545-46 (1920) (‘The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason [the mark] should be considered in its entirety....’) (reversing disclaimer requirement); *In re Hester Indust., Inc.*, 230 USPQ 797, 798

n.5 (T.T.A.B. 1986) (“the ultimate determination is made on the basis of the mark in its entirety”) (reversing disclaimer requirement). When considering Amazon’s Mark as a whole, RING NET has many possible meanings, all of which would require consumers to pause and follow “a multi-stage reasoning process” when determining the nature of Amazon’s goods.

However, even on its own, the term NET is not descriptive in the context of Amazon’s applied-for goods and services. Indeed, insisting on a disclaimer requirement for a single word across eight classes is nonsensical, as the term in question cannot possibly “describe” each item listed in the specification.

In any event, as the Examining Attorney illustrated, the term “NET” can be defined in various ways, including (i) “an open-meshed fabric twisted, knotted, or woven together at rectangular intervals;” (ii) “something made of a net”; (iii) “an entrapping device or situation”; (iv) “something resembling a net”; (v) “a group of communications station operating under unified control”; or (vi) “less commonly” meaning “internet”. *See* Exh. No. 8 (printout of <https://www.merriam-webster.com/dictionary/net>). In the context of the applied-for goods and services, the term NET does not immediately bring to mind one meaning of “NET” over another.

Under any of the definitions listed above, the term NET combined with the term RING creates even more possible meanings and requires even more of “a multi-stage reasoning process,” invoking even greater imaginative thought in the mind of consumers. For example, a consumer may associate RING NET with a literal net in the shape of a ring, i.e. a circle of rope nets or a ring-shaped net, such as the variety often used to catch flying insects.

While some of Amazon’s goods and services do involve internet-enabled features, there is no evidence (or legal basis to assume) that a consumer will parse out the term NET in the mark RING NET, *and then immediately* associate the term NET as describing Applicant’s goods and

services as “internet connected.” There is also no basis to go one step further and assume that the consumer would view “NET” as describing each and every one of the applied-for goods and services across eight International Classes.

Even if the term NET, if viewed isolated from the mark, were seen as potentially descriptive, its inclusion in the full mark RING NET results in an incongruous mark such that a disclaimer should not be required. RING is most commonly defined as a “circular object.” The Examining Attorney contends that NET “refers to a network or connected group of computer systems such as the internet.” Office Action, at 10. The term RING (meaning circle) used in connection with NETWORK (meaning interconnection between nodes) is incongruous because it is not immediately clear how such interconnection would function in a circular fashion. In any event Applicant’s goods and services do not feature a ring-shaped network.

B. RING NET Suggests So Many Possible Meanings that Consumers Must Pause and Reflect about the Meaning of the Mark.

As detailed above, Amazon’s Mark suggests many possible meanings, all which require consumers to pause and exercise some thought and imagination to determine what goods and services Amazon offers under its RING NET mark. For example, the Examining Attorney cited not one but multiple possible descriptive meanings for NET, pointing to distinct definitions in multiple dictionaries. Thus, the descriptive nature of NET is not *immediately* clear and requires pause. When combined with RING, any descriptive qualities of NET are further blurred. Given the need for “multi-stage reasoning,” Amazon’s mark is not merely descriptive. *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. at 498.

Consumers will be required to use thought and imagination in order to discern any relationship between the RING NET mark and the nature of Amazon’s products. Moreover, it does not matter which impressions may occur to an individual consumer; more than one possible

meaning is enough to make consumers pause and think. *See, e.g., In re Shutts*, 217 U.S.P.Q. 363, 364-65 (T.T.A.B. 1983). And that pause is all that it takes to demonstrate that Amazon's mark is not merely descriptive. *Id.* As such, Amazon respectfully requests that the disclaimer request be withdrawn.

III. CONCLUSION

In light of the foregoing arguments in favor of publication, Amazon respectfully requests that the objections raised in the Office Action be withdrawn and that the Application be approved for publication.

Respectfully submitted,
AMAZON TECHNOLOGIES, INC.

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