

**UNITED STATES DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE**

APPLICANT: Ghost L.L.C.



MARK:

GHOST (Stylized) & Design

SER. NO. 88/506,432

FILED: July 9, 2019

MAILING DATE: September 30, 2019

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**Response To Office Action  
Under 37 CFR 2.62**

In response to the Office Action in the above-captioned application (“Application”), Ghost L.L.C. (“Applicant”), by and through its attorneys, hereby responds as follows:

**RESPONSE TO LIKELIHOOD OF CONFUSION REFUSAL**

The Examining Attorney has refused the Application because of a likelihood of confusion with the marks in U.S. Registration No. 3835221 (“GHOST Stylized Mark” or “GHOST Stylized Registration”) and U.S. Registration No. 5527350 (“GHOST Cross Design Mark” or “GHOST Cross Design Registration”) (collectively, the “Cited Marks” or the “Cited Registrations”). For the reasons discussed below, Applicant respectfully requests that the refusal to register be withdrawn.

**1. Applicant Owns a Prior Registration for a Nearly Identical Mark**

Applicant has applied to register the mark GHOST (Stylized) & Design (“Applicant’s Mark”) in Class 025. Applicant owns, and has owned since 2016, a registration for the nearly identical mark GHOST LIFESTYLE (Stylized) & Design (Registration No. 5051066) covering many of the same Class 025 goods<sup>1</sup> (the “Prior GHOST Mark” or “Prior GHOST Registration”). Applicant hereby requests that the Prior GHOST Registration be made part of the Application record.


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<sup>1</sup> The Application covers “clothing, namely, sweatshirts, sweatpants, t-shirts, hats.”  
The Prior GHOST Registration covers “Clothing, namely, t-shirts, shorts and pants; Hats.”

Applicant's Mark and the Prior GHOST Mark are nearly identical. They differ only by the addition of the word LIFESTYLE in small font at the bottom of the Prior GHOST Mark. The word LIFESTYLE is descriptive and non-distinctive when used in connection with apparel. A search of applications and registrations in Class 025 reveals 289 live records that include the word LIFESTYLE. In many instances, the applicant or registrant was required to disclaim exclusive rights in the word "LIFESTYLE" on the grounds that it is descriptive of a type of apparel.

In contrast to the word "lifestyle," the GHOST (Stylized) & Design element of the mark—which appears in both the Application and the Prior GHOST Registration—is highly distinctive. Applicant's Mark and the Prior GHOST Mark are therefore essentially identical in overall commercial impression.

The timeline for the filing of the Prior GHOST Registration, the Cited Registrations, and the Application is as follows:

Mark	Dates	Section 2(d) Refusal (Class 025)
<b>Cited GHOST Stylized Registration</b> (Reg. No. 3,835,221)  	<b>Filed:</b> June 29, 2009  <b>Registered:</b> August 17, 2010	None
<b>Applicant's Prior GHOST Registration</b> (Reg. No. 5,051,066)  	<b>Filed:</b> August 6, 2015  <b>Registered:</b> September 27, 2016	None
<b>Cited GHOST Cross Design Registration</b> (Reg. No. 5,527,350)  	<b>Filed:</b> October 31, 2016  <b>Registered:</b> July 31, 2018	Preliminarily refused citing GHOST Stylized Registration
<b>Applicant's Application</b>  	<b>Filed:</b> July 9, 2019	Preliminarily refused citing GHOST Stylized Registration and GHOST Cross Design Registration

The prosecution history of Applicant's nearly identical Prior GHOST Mark is instructive for the present analysis of whether confusion is likely to arise between the Application and the Cited Registrations. Applicant's Prior GHOST Mark, filed more than four years ago, was quickly approved and registered. Neither of the Cited Registrations were cited against it. Of course, the GHOST Cross Design Registration could not have been cited against the Prior GHOST Mark because the GHOST Cross Design Registration was not filed until more than a year *after* Applicant filed its application for the Prior GHOST Mark. And yet, the GHOST Cross Design Registration now stands as a potential bar to Applicant's registration of a mark nearly identical to Applicant's existing registration—a registration that issued before the GHOST Cross Design Mark was even filed.

Importantly, nor was the GHOST Stylized Registration (which did exist in 2015) cited against the Prior GHOST Mark. While recognizing that the Examining Attorney is not bound by past Office actions, Applicant finds it puzzling that the GHOST Stylized Registration, which was not cited against the now-registered Prior GHOST Mark, is now—more than four years later—being cited as a basis to refuse a nearly-identical Application.

The prosecution history of the cited GHOST Cross Design Mark sheds further light on the lack of confusion or potential confusion between the marks at issue. The GHOST Cross Design Mark was filed more than a year *after* Applicant filed its application for the Prior GHOST Mark. The Prior GHOST Registration was not cited against the GHOST Cross Design Mark, but the GHOST Stylized Registration was. The applicant overcame this initial refusal by arguing that its use of the GHOST Cross Design Mark had coexisted with the Stylized GHOST Mark without consumer confusion and that differences in each party's actual use of their respective marks made confusion unlikely. The Examining Attorney accepted this argument and passed the GHOST Cross Design Mark to publication. The GHOST Cross Design mark was permitted to register despite the existence of both the GHOST Stylized Registration and the Prior GHOST Registration.

Three years later, the argument that the GHOST Cross Design Mark, the GHOST Stylized Mark, and Applicant's GHOST (Stylized) & Design Mark are not likely to be confused rings even more true. It defies logic to argue that registration of the Application will engender confusion and “adverse commercial impacts” where none has existed to date. The Prior GHOST Registration issued in September 2016; it has coexisted with the Cited Registrations *on the register* (not to mention in the marketplace) for more than three years without evidence of consumer confusion or other harm. Applicant's nearly identical Mark should now be permitted to register as well.

The TTAB addressed a strikingly similar situation in 2012, ultimately reversing the Examining Attorney's refusal to register the mark ANYWEAR in Class 025 citing a registration for ANYWEAR BY JOSIE NATORI. *See In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012). The TTAB based its reversal on the applicant's ownership of a prior registration for the nearly identical mark ANYWEARS for nearly identical goods, finding that such evidence of coexistence makes confusion unlikely. *Id.*

Here, Applicant likewise owns a nearly identical registration that has coexisted with the Cited Registrations for more than three years without any evidence of consumer confusion. Applicant's

highly distinctive mark has proven very capable of distinguishing Applicant's goods from those of others, and the Application should be allowed to register.

## 2. The Application and the Cited Registrations Are Not Confusingly Similar

Applicant submits that the Application should be allowed to register on the basis of its similarity to Applicant's valid and subsisting Prior GHOST Registration. However, even if the Examining Attorney is not compelled by this argument, the refusal to register should nevertheless be withdrawn because the Application and the Cited Registrations are not likely to cause consumer confusion.

### a. Applicant's Mark is Highly Stylized and Distinct from the Cited Marks

Determining a likelihood of confusion requires, among other things, examining whether the marks create the same overall commercial impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ.2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (T.T.A.B. 1980). The comparison of the marks requires consideration of the marks' visual similarities or differences, their connotations, and their overall commercial impressions. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983). In this instance, Examining Attorney seems to have given short shrift to this bedrock trademark principal. Indeed, it takes no more than a cursory review of the Application and the Cited Registrations, in their entireties, to recognize that they are clearly distinct and distinguishable. While the Application and the Cited Registrations all include the term GHOST, any similarity created as a result of the use of this common word is greatly outweighed by the many dissimilarities between the marks when considered as a whole. All three marks are shown below:



GHOST Application

**GHOST**

GHOST Stylized Registration



GHOST Cross Design Registration

All three of the marks at issue include the word GHOST and all three are stylized. But this is where the similarities end. Applicant's mark features angled, graffiti-style, bold, rounded, outlined, and underlined lettering. It also includes a distinctive design element. Neither of the Cited Registrations incorporate similar designs or stylization. The GHOST Cross Design Registration is highly stylized, featuring shadowed, gothic style text, with moons and crosses incorporated into the letters themselves. Indeed, the word GHOST is almost difficult to make out in the GHOST Cross Design Registration, given the extent of its stylization. The GHOST Stylized Registration presents yet a further study in contrasts, appearing in a simple, understated, sans serif text style. Compared (and contrasted) side-by-side, the overall commercial impression of Applicant's mark is notably distinct from that of either—and both—of the Cited Registrations. These distinctions should prove determinative here.

Case law makes clear that marks must be considered in their entirety, the way consumers encounter them, and not merely as a function of their common component. *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 49 USPQ2d 1355, 1359 (6th Cir. 1999) (“the ‘anti-dissection’ rule . . . serves to remind courts not to focus only on the prominent features of the mark . . . but on the mark in its totality”). The commercial impression of a trademark is derived from the mark as a whole, not from elements separated and considered in detail. *See* Richard L. Kirkpatrick, *LIKELIHOOD OF CONFUSION IN TRADEMARK LAW*, § 4:7 (2008). Here, even a cursory inspection of the three marks at issue makes clear that any commonalities between them are more than outweighed by the substantial distinctions in stylization and design.

Applicant respectfully disagrees with the Examining Attorney's assertion that the word portion of each mark should be accorded greater weight in the analysis of the likelihood of confusion between the Application and the Cited Registrations. The Court of Appeals for the Federal Circuit has cautioned, that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Marks, therefore, must be considered on a case-by-case basis. *In re VITERRA INC.* 671 F.3d 1358, 1363 (Fed. Cir. 2012). In this case, the stylization and design components of Applicant's mark sufficiently distinguish it from the marks in the Cited Registrations. Moreover, those same elements arguably render the word portion of the mark of less importance here, particularly in light of the word's common use. As a result, consumers will be able to easily distinguish between such highly stylized marks just as they have done for several years now, eliminating any risk of confusion.

b. Applicant's Goods are Distinguishable from Those in the Cited Registrations

It is well-settled trademark law that the only proper setting to evaluate likelihood of confusion is not through the prism of theoretical possibilities, but in the actual marketplace in which the goods or services are offered. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360-1361 (C.C.P.A. 1973). As the TMEP properly instructs, the question of confusion concerns “not . . . the nature of the mark, but . . . its effect ‘when applied to the goods of the applicant’”. The only relevant

application is made in the marketplace. The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding the use of the mark.” *In re E.I. DuPont DeNemours & Co.*, *supra*, at 1360-1361. Consideration of this factor here leads inevitably to the conclusion that confusion is not likely.

The TTAB has stated that, while it need not go beyond the four corners of the application, it is appropriate to look at the manner in which each mark is used when considering whether confusion is likely (*Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157 (TTAB 1992); *see, also, Vornado, Inc. v. Breuer Electric Mfg. Co.* 390 F.2d 724, 726 (1968) (finding, “. . . trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression”); *see, also, In re Nationwide Industries, Inc.*, 6 USPQ2d, 1882, 1883 (TTAB 1988) (“ . . . evidence of the context in which a mark is used on labels, packaging, advertising, etc. is probative of the significance which the mark is likely to project to purchasers”).

Looking first at the GHOST Stylized Registration, it is clear that although the goods of both parties are in Class 25, the respective channels of trade could not be more different. The GHOST Stylized Registration covers “ladies’ coats, jackets, blazers, cardigans, tops, blouses, shirts, dresses, skirts, trousers, shawls,” and the specimens of record show the understated use of that mark on adult women’s clothing. Applicant’s goods, which are sold in clear connection with Applicant’s Ghost branded sports nutrition and sports lifestyle products, are intended for an entirely different audience. And, the fact that Applicant’s Prior GHOST Registration and the GHOST Stylized Registration have long coexisted without any confusion is but further evidence of the clear differences here and of consumers’ ability to distinguish between them.

As to the GHOST Cross Design Registration, during prosecution of this registration, the owner stated that its apparel goods “are sold in clear connection with a music/entertainment act of the same name.” Indeed, this appears to be the case. An image of what Applicant believes to be the registrant’s website is shown in Exhibit A attached hereto. It is difficult to imagine a scenario where a consumer would confuse the apparel sold on the website shown in Exhibit A with the apparel sold by Applicant in connection with its sports nutrition products.

Similarly, in a case involving two identical marks—AUDITOR’S—both used in connection with pens, the Ninth Circuit held, “The two marks viewed in isolation are indeed identical, but their similarity must be considered in light of the way the marks are encountered in the marketplace and the circumstances surrounding the purchase of the [products].”). *Lindy Pen Co. Inc. v. Bic Pen Corp.*, 725 F.2d 1240, 1245 (9<sup>th</sup> Cir. 1984). Considering these marketplace factors, the court found that the two AUDITOR’S marks were readily distinguishable in the context in which they were encountered, despite the fact that they were identical marks used for the same category of goods. *Id.* Likewise, in *M2 Software, Inc. v. Madacy Entertainment*, 421 F.3d 1073 (9<sup>th</sup> Cir. 2005), *cert. denied*, 126 S.Ct. 1772 (US 2006), the court held there was no likelihood of confusion between the registered mark “M2” used for music databases and audio CDs and “M2 ENTERTAINMENT” by a junior user in connection with another genre of music CDs, largely because the marketing channels were distinct. Both of these cases are of direct relevance here.

Applicant maintains that the circumstances surrounding the sale of each product covered by the Cited Registrations through their respective marketing channels create another layer of distinction between the marks, further suggesting that confusion is not likely.

For the foregoing reasons, Applicant requests that the refusal to register the Application on the basis of the Cited Registrations be withdrawn.

### **INFORMATION ABOUT GOODS/SERVICES REQUIRED**

Applicant provides the following responses to the Examining Attorney's questions:

- 1. If available, the applicant will provide a website address at which the goods and/or services are offered and/or the mark is used. If no website is available, then the applicant will state this fact for the record.**

Applicant's goods are offered at <https://www.ghostlifestyle.com/>

- 2. Does the applicant manufacture or offer any of the goods and/or services that appear in the registrants' identification(s) of goods and/or services?**

Yes.

- 3. Other than any identical goods, is the applicant aware of any other company and/or person(s) that provides both the goods and/or services, in whole or in part, listed in both the applicant's identification and the registrants' identification(s)? If so, the applicant must provide the name of the company and/or person(s) and any available website address for the same. The applicant need not provide more than five references per each cited registration.**

Applicant does not possess this knowledge or information.

### **PRIOR FILED APPLICATIONS**

Applicant will address the likelihood of confusion issue with respect to the prior filed applications cited by the Examining Attorney at such time as the cited U.S. Application Serial Nos. 87459573, 87844370, and 88077249 mature to registration, if ever. Accordingly, Applicant requests the suspension of the instant application pending final disposition of the referenced, earlier-filed applications.