

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

APPLICANT: Ghost L.L.C.



MARK:

GHOST (Stylized) & Design

SER. NO. 88/506,442

FILED: July 9, 2019

MAILING DATE: September 30, 2019

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

In response to the Office Action issued 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 mark in U.S. Registration No. 4436472 (“Cited Registration”). For the reasons discussed below, Applicant respectfully requests that the refusal to register be withdrawn.

1. Applicant’s Mark is Distinct from The Cited Mark in Appearance and Meaning, Creating a Different Commercial Impression

While the Application and the Cited Registration both include the term GHOST, any similarity created by the use of this common word is greatly outweighed by the dissimilarities between the marks when considered as a whole.

Determining a likelihood of confusion requires 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).

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. Richard L. Kirkpatrick, *LIKELIHOOD OF CONFUSION IN TRADEMARK LAW*, § 4:7 (2008). Here, even a cursory comparison of Applicant’s Mark and the Cited Mark makes clear that any commonalities between them are outweighed by the substantial distinctions in stylization, design, and overall commercial impression in the marketplace.

The Cited Mark GHOST PIMP immediately calls to mind the image of a phantom pimp—and this is precisely the commercial impression Registrant appears to be attempting to convey, as evidenced by the specimen submitted in connection with the prosecution of the Cited Registration, attached hereto as Exhibit A, and as further evidenced by Registrant’s Twitter account located at <https://twitter.com/ghostpimp> (screenshot attached hereto as Exhibit B). It appears from Registrant’s Twitter account that “Ghost Pimp” is a film, which is summarized as follows: “A dead New York pimp must uncover who killed him and avenge his death, with an unlikely protégé.” See Exhibit B. Registrant is apparently selling (or claims to have sold) various beverage-related products under the mark GHOST PIMP. The term “Ghost” in this context describes a state of being—namely, that the pimp character in the film is dead—and by far the dominant term of the mark, therefore, is “Pimp.” The word “Ghost” is an adjective that merely modifies the noun “Pimp” and gives it context. The overall commercial impression upon viewing the GHOST PIMP specimen in Exhibit A is that the mark GHOST PIMP is intended to convey the idea of a phantom pimp, and that the various goods Registrant offers for sale under the mark are intended to promote the “Ghost Pimp” film.

By contrast, Applicant sells sports nutrition products and related accessories under the mark GHOST. A screenshot of the identified goods offered for sale on Applicant’s website is attached hereto as Exhibit C. The word “Ghost” in Applicant’s Mark is used as a noun; it does not modify any other terms. Applicant stylization further emphasizes the importance of the word “Ghost” and further distinguishes it from the Cited Mark.

Applicant respectfully disagrees with the Examining Attorney’s assertion that the word portion of each mark should be accorded greater weight. 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 Cited Mark, in large part by drawing the focus to a cartoonish ghost figure—standing in stark contrast to the image of a phantom pimp.

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 (9th 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 (9th 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.

Here, there is even less similarity between Applicant’s Mark and the Cited Mark than in either *Lindy Pen Co. Inc.* or *M2 Software, Inc.* As discussed above, the inclusion of the word PIMP in the Cited Mark creates a radically different consumer impression than that created by Applicant’s Mark—particularly in light of Applicant’s stylization. Under these circumstances, confusion is not likely to occur, and the Application should be allowed to proceed to registration.

Finally, Applicant further notes that the Cited Registration was due for a maintenance filing on November 19, 2019. Registrant did not file the required Section 8 Declaration within the regular time period to maintain the registration. The 6-month grace period ends on May 19, 2020. Unless the Examining Attorney is inclined to withdraw the refusal based on Applicant’s other arguments herein, Applicant respectfully requests the suspension of the examination of the instant application until the Registrant’s grace period has closed to determine if Registrant has abandoned its registration.

IDENTIFICATION OF GOODS AND SERVICES

The Examining Attorney has required clarification of the Class 021 goods identified in the application, specifically: “shaker bottles sold empty; beverage containers.” Accordingly, Applicant requests the adoption of the bolded amended description below to clarify the goods.

“Shaker bottles sold empty; beverage containers, **namely, containers for mixing and transporting beverages**”

INFORMATION ABOUT GOODS/SERVICES REQUIRED

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

1. **Does GHOST have any significance as applied to the goods and/or services other than trademark and/or service mark significance?**

No.

2. **Does GHOST have any significance in the relevant trade or industry other than trademark and/or service mark significance?**

No.

- 3. Does the applicant manufacture or offer any of the goods and/or services that appear in the registrant's identification of goods and/or services?**

No.

- 4. 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 registrant's 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.

Having responded to all issues, Applicant requests that its application be allowed to proceed to publication.