

RESPONSE TO NON-FINAL OFFICE ACTION

EDDIE

Serial No. 88512965

Response.

In the Office Action dated September 30, 2019, the present application for Applicant's EDDIE mark was refused registration under the Trademark Act § 2(d), 15 U.S.C. § 1052(d), on the premise that Applicant's mark is likely to cause confusion with the following registrations and application (hereafter, collectively, the "Cited Marks"):

1.



Word Mark
Goods and Services

E EDDIES

IC 018. Bags for sports; Luggage; Sport bags; Sports bags; All purpose sport bags; All-purpose athletic bags; Athletic bags; Duffel bags; Duffel bags for travel; Duffle bags; General purpose sport trolley bags; Gym bags; Leather and imitation leather sport bags and general purpose trolley bags; Messenger bags; Shoulder bags; Traveling bags; Travelling bags; Wheeled duffel bags.

IC 025. Pants; Shirts; Shoe soles; Shoes; Sneakers; Sport coats; Sport shirts; Sports bra; Sports jackets; Sports jerseys; Sports pants; Sports shirts; Sports shirts with short sleeves; Athletic pants; Athletic shirts; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Basketball sneakers; Gym pants; Jogging pants; Leather shoes; Long-sleeved shirts; Polo shirts; Running shoes; Short-sleeve shirts; Short-sleeved or long-sleeved t-shirts; Soccer shoes; Sports shoes; Sweat pants; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Track pants; Wind shirts; Women's shoes.

Registration Number
Registration Date
Owner

5374022

January 9, 2018

XING DI SHI

2.



Word Mark E EDDIES
Goods and Services IC 025. Swim caps; Swim suits; Swim trunks; Swim wear; Swim wear for gentlemen and ladies; Swimming caps; Swimming trunks; Swimwear.
IC 028. Flippers for swimming; Swimming aids, namely, swimming paddles, arm floats for recreational use; Swimming boards; Swimming flippers; Swimming gloves; Swimming jackets; Swimming kick boards; Trolley bags specially adapted for sports equipment.
Registration Number 4691445
Registration Date February 24, 2015
Owner Xing Di Shi

3.



Word Mark EDDIE
Goods and Services IC 016. Educational materials for children, namely, coloring books and activity workbooks; pens and pencils, notebooks, and pen and pencil pouches.
IC 021. Lunch boxes for children.
IC 025. Clothing for children and adults, namely, shirts, and hats.
Registration Number 5237981
Registration Date July 4, 2017
Owner EDUSTEPS, LLC

4.

Word Mark EDDY BROS.
Goods and Services IC 025. HEADWEAR.
Registration Number 2367870
Registration Date July 18, 2000; Renewal filed July 23, 2019
Owner BOLLMAN HAT COMPANY

5.

Word Mark EDDIE
Goods and Services IC 025. Footwear
Serial Number 88367819

Filing Date April 2, 2019
Notice of Allowance September 10, 2019
Owner River Light V, L.P. CRB, LLC

Applicant respectfully submits that its application can be distinguished from these references based on the differences in the commercial impression of the marks, and the narrow scope of protection properly accorded the Cited Marks. Further, Applicant notes that none of the Cited Marks covers goods or services in Classes 9 or 41 or goods or services that would appear to be related to the goods and services covered in those classes by the present application. Accordingly, Applicant has focused this Response on Classes 25 and 16 and respectfully requests that the Examining Attorney reconsider its application in those classes based upon the comments contained herein below.

1. The Cited Marks are properly accorded only a narrow scope of protection due to their relative weakness as source identifiers.

The relative strength of a cited mark, or a portion thereof, should be considered when determining if confusion between marks is likely. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). As stated in *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

The personal name EDDIE is the subject of numerous registrations and applications listed in the US Patent and Trademark Office database. In particular, Applicant notes that the Cited Marks all co-exist with one another in International Class 25 for the same or closely related goods. In fact, none of the other Cited Marks (or any other third party registrations or applications) were cited against the pending application for EDDIE for “footwear” (US Serial No. 88367819). Applicant also notes the coexistence of registrations for the marks EDDIE & ME, EDDIE IZZARD, EDDIE BAUER, EDDIE’S FAVORITE, EDDIE WOULD GO, EDDIE VEDDER and EDDIE & EDWARD, along with several other EDDIE marks, in Int. Classes 16 and/or 25. Details of these registrations from the US Patent and Trademark Office database are

attached hereto as Exhibit A.

In assessing the strength of the cited marks, the Examining Attorney should consider "[t]he number and nature of similar marks in use on similar services when evaluating likelihood of confusion." *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563, 568 (CCPA 1973). The co-existence of the Cited Marks with each other and the third-party EDDIE registrations noted above indicates that the US Patent and Trademark Office has determined that such marks can co-exist on the register without any likelihood of consumer confusion. At a minimum, the US Patent and Trademark Office's apparent determination that the above-noted references can co-exist with one another evidences that customers can distinguish between marks that contain the term EDDIE in the industry based on relatively minor differences in the marks. *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 US.P.Q.2d 1477 (TTAB 1987) (the numerous third-party uses of STEVE'S demonstrate that the purchasing public has become so conditioned to recognize that many businesses in the restaurant and food store fields use the term and that the purchasing public is able to distinguish between these businesses based on small distinctions among the marks). Applicant submits that its EDDIE application is also readily distinguishable from the Cited Marks based on the differences in the marks and is therefore entitled to registration on the Principal Register.

2. The Cited Marks are distinguishable in appearance and commercial impression from Applicant's EDDIE mark.

The differences in the marks should be considered when evaluating likelihood of confusion. *DuPont*, 177 U.S.P.Q. at 568. (CCPA 1973). Similarity as to one aspect of the sight, sound, and meaning trilogy will not automatically result in a finding of likelihood of confusion, even when the goods or services are identical. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, n. 4 (TTAB 1988). In determining likelihood of confusion, one of the issues to be considered is whether the marks create the same overall impression to the average purchaser. *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 109 (TTAB 1975). Considering Applicant's EDDIE mark in its entirety, it is distinctly different in commercial impression from the Cited Marks. Specifically, Applicant's mark relates to Iron Maiden's well known "mascot" – Eddie (see Exhibit B). Thus, the subject mark has a direct association with Applicant/Iron Maiden that is completely lacking in the Cited Marks. This association, combined with the relative weakness of the Cited Marks, would allow consumers to readily distinguish Applicant's mark from the Cited Marks.

3. The totality of the evidence demonstrates the absence of any danger of consumer confusion in this matter.

When making a final determination as to likelihood of confusion, the Examining Attorney should consider all of the evidence. *DuPont*, 177 U.S.P.Q. at 568. Applicant submits that, in light of the relative weakness of the Cited Marks, and the differences in appearance and commercial impression of the marks, there is no danger of consumer confusion as to source under these circumstances. As such, Applicant submits that consumers are capable of differentiating Applicant's mark from the Cited Marks and that they should be withdrawn as conflicts with regard to Applicant's goods in Classes 16 and 25.

* * * * *

In view of the above comments in satisfaction of the issues raised by the Examining Attorney in the Office Action, Applicant respectfully requests that the Examining Attorney give favorable reconsideration to its application, that the refusal based on the Cited Marks be withdrawn and that Applicant's EDDIE application be allowed to proceed to publication. Such favorable action on the part of the Examining Attorney is respectfully solicited.