

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Kids Fun TV, LLC)	
)	
Serial No.:	90/085,751)	
)	Law Office
Filing Date:	July 31, 2020)	124
)	
Mark:	KIDS FUN TV)	
)	
International Class:	025 and 028)	
)	
Examining Attorney:	Janet Lee)	

RESPONSE TO OFFICE ACTION

This correspondence responds to the office action, which was sent on November 20, 2020 (the “Office Action”) with regard to Kids Fun TV, LLC’s (“Applicant”) application to register its KIDS FUN TV trademark (“Applicant’s Mark”).

The Examining Attorney refused registration of Applicant’s Mark on the grounds that, with respect to Classes 25 and 28, Applicant’s Mark is confusingly similar to (a) the KID FUN mark in Reg. No. 2,276,703 for use with “small toys in the nature of carnival, gift or party favor items” in Class 28 (the “Kid Fun Mark”); (b) the KIDSFUN mark in Reg. No. 5,404,592 for use with “batting gloves; toy pistols; electronic action toys; toy building blocks; jigsaw puzzles; magic tricks; apparatus for electronic games other than those adapted for use with an external display screen or monitor; dolls; electronic action toys; inflatable swimming pools; radio-controlled toy vehicles; balls for sports; body-building apparatus; archery implements; board games” in Class 28 (the “KidsFun Mark”); and (c) the FUN TV mark in Reg. No. 4,732,922 for use with “clothing, namely, shoes; t-shirts, shorts, sweat shirts, sweat pants, sweat shorts; and headwear, namely, hats and caps” in Class 25 (the “Fun TV Mark” and, together with the Kid Fun Mark and the KidsFun Mark, the “Cited Marks”).

Applicant respectfully disagrees with the Examining Attorney’s contention that Applicant’s Mark is likely to cause confusion with the Cited Marks for the following reasons: (a)

the only terms that Applicant's Mark and the Cited Marks have in common are common weak terms, entitled to such a narrow scope of protection that any differences between the marks are sufficient to avoid consumer confusion, (b) consumers are accustomed to distinguishing between KID-, FUN-, and TV-formative marks based on small differences, and (c) consumers have come to associate Applicant's Mark with Applicant's wildly successful you tube channel and, therefore, are unlikely to be subject to confusion.

Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her objection to the registration of Applicant's Mark and advance it to publication.

Section 2(d) – Likelihood of Confusion Refusal

1. Legal Standard for 2(d) Determinations.

The determination of likelihood of confusion requires a two-part analysis. First, the similarity or dissimilarity of the marks is analyzed in terms of their “appearance, sound, connotation and commercial impression.” *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (C.C.P.A. 1973). Marks must be compared in their entireties. *See Ross Bicycles, Inc. v. Cycles USA, Inc.*, 765 F.2d 1502, 1507 (11th Cir. 1985) (“the marks ultimately must be considered as a whole”). The fact that two marks that share “identical, even dominant, words in common does not automatically mean that” such marks are confusingly similar. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987).

Second, the relatedness of the goods or services is analyzed for similarities or differences. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361. Similarity of marks and relatedness of goods and services vary in inverse proportion to one another for likelihood of confusion: the less closely related the goods and services, the more closely similar the marks need to be to support a finding of likelihood of confusion. *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350 (Fed. Cir. 2004) (*citing Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698 (Fed. Cir. 1992)). Thus, when the goods and services are completely unrelated, there may be no likelihood of confusion even from identical marks. *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 632, 63 USPQ2d 1659 (6th Cir. 2002).

Additional factors relevant to the likelihood of confusion include the sophistication of

customers and the strength of the mark. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361. With regard to the sophistication of customers, when goods are “purchased with a certain amount of care and thought, rather than...on impulse,” confusion is less likely to be found. *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1039 (TTAB 1988). “[T]he more sophisticated the consumer the less likely he will be confused” when encountering different goods or services with similar marks. *Moore Business Forms, Inc. v. Rite Aid Corp.*, 21 USPQ2d 2024, 2029 (WDNY 1991).

With regard to strength of the mark, a mark is “commercially weak if the mark lacks significance in the marketplace for identifying the origin of goods [or services].” *Oxford Indus., Inc. v. JBJ Fabrics, Inc.*, 6 USPQ2d 1756 (S.D.N.Y. 1988). “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.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992), quoting *Sure-Fit Prod. Co. v. Salzson Drapery Co.*, 254 F.2d 158, 160 (CCPA 1958). When making a determination as to the likelihood of confusion between two marks, the Examining Attorney must consider the relative strengths of the marks in question, judged by the inherent strength of the marks and the number of similar marks in use in connection with similar goods. *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1005-06 (2d Cir. 1983).

Finally, in assessing the likelihood of confusion, “it is the duty of the examiner . . . to find, upon consideration of all the evidence, whether or not confusion appears likely.” *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1362. The weight given to any one factor may vary in light of the circumstances, but the pivotal issue is always whether an appreciable number of ordinarily prudent purchasers of the associated goods or services are likely to be misled or confused as to the source of goods or services in question. *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 222 USPQ 373 (2d Cir. 1983). However, a mere possibility of confusion is not enough. *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1077, 26 USPQ2d 1583 (2d Cir. 1993). Likelihood means probability. When only a possibility, rather than a probability, of confusion exists, registration of Applicant’s Mark should be allowed. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2006).

2. The Cited Marks are Weak

A factor that weighs in favor of registration of Applicant’s Mark is that the Cited Marks are diluted and weak and, therefore, entitled to a narrow scope of protection. *Sure-Fit Products Co. v. Salzson Drapery Co.*, 254 F.2d 158, 160 (CCPA 1958) (“[W]here a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owner of strong trademarks.”). Even among competitors, marks can be similar if, as in this case, the first user’s mark is weak. *Id.*

Here, the Cited Marks are diluted by extensive third-party registration and use of KIDS-, FUN-, and TV-formative marks in Classes 25 and 28. In fact, the USPTO database contains (a) 1,578 live trademark applications and registrations for use of KIDS-formative marks in Classes 25 and 28; (b) 990 live trademark applications and registrations for use of FUN-formative marks in Classes 25 and 28; and (c) 100 live trademark applications and registrations for use of TV-formative marks in Classes 25 and 28. See Exhibits A (printout of the following TESS search: “(kids)[BI] and (025 or 028)[IC] and (live)[LD]”), B (printout of the following TESS search: “(fun)[BI] and (025 or 028)[IC] and (live)[LD]”), and C (printout of the following TESS search: “(tv)[BI] and (025 or 028)[IC] and (live)[LD]”).

These marks include, without limitation, the following registrations for marks that are at least as similar as the Cited Marks are to Applicant’s Mark:

Class 25

Mark	Goods
ZZ ZZ KIDS TV Reg. No. 5709132	T-shirts
LIFEKIDS.TV Reg. No. 3871917	Shirts
FUN TV Reg. No. 4732922	Clothing, namely, shoes; t-shirts, shorts, sweat shirts, sweat pants, sweat shorts; and headwear, namely, hats and caps

Class 28

Mark	Goods
FUN KIDZ Reg. No. 5843494	Badminton game playing equipment; Building games; Chess games; Christmas tree decorations; Gaming machines, namely, electronic slot and bingo machines; Infant toys; Jigsaw puzzles; Rocking horses; Smart plush toys; Toy rockets; Waist protectors for athletic use
KIDSFUN Reg. No. 5404592	Batting gloves; Toy pistols; Electronic action toys; Toy building blocks; Jigsaw puzzles; Magic tricks; Apparatus for electronic games other than those adapted for use with an external display screen or monitor; Dolls; Electric action toys; Inflatable swimming pools; Radio-controlled toy vehicles; Balls for sports; Body-building apparatus; Archery implements; Board games
FUNKIDZ Reg. No. 3827480	Balls for games; Board games; Christmas tree ornaments; Jigsaw puzzles; Novelty items, namely, fake teeth; Theatrical masks; Toy and novelty face masks; Toy modeling dough; Transforming robotic toys
KID FUN Reg. No. 2276703	Small toys in the nature of carnival, gift or party favor items

See Exhibit D (TSDR printouts for the foregoing application and registrations).

The foregoing list of trademark registrations confirms the ability of KIDS-, FUN-, and TV-formative marks to coexist in the marketplace and on the trademark register with only slight differences between the marks, and that consumers are more than capable of distinguishing between these marks when used in connection with goods in Classes 25 and 28. As discussed in more detail below, the differences between Applicant’s Mark and the Cited Marks are at least as significant as the differences between these marks. Accordingly, Applicant’s Mark will coexist with the Cited Marks without causing any consumer confusion.

This is especially true in this case because Applicant’s Mark, as well as the associated goods, are directly linked in the minds of consumers to Applicant’s youtube channel, KIDS FUN TV, which has more than 5 million subscribers. *See Exhibit E (printout from*

<https://www.youtube.com/channel/UChsFz1DgXxa4MDlFp-28FxQ>).

3. The Appearance, Meaning, Sound and Commercial Impression of Applicant’s Mark and the Cited Mark are Distinct.

As shown above, KIDS-, FUN-, and TV-formative marks are entitled to a narrow scope of protection and the differences in appearance, meaning, and sound between Applicant’s Mark and the Cited Marks are sufficient to avoid consumer confusion.

a. The Marks Are Distinct in Appearance.

When all of the relevant factors are considered, the appearance of Applicant’s Mark is sufficiently different from the appearance of the Cited Marks to avoid any likelihood of consumer confusion.

Applicant’s Mark is comprised of the term “kids,” “fun,” and “tv.” In contrast, the (a) Kid Fun Mark is comprised of the terms “kid” and “fun,” (b) the KidsFun Mark is comprised of the terms “kids” and “fun,” and (c) the Fun TV Mark is comprised of the terms “fun” and “tv.” More specifically, (a) Applicant’s Mark includes a plural “kids” and “tv,” which are not present in the Kid Fun Mark, (b) Applicant’s Mark includes “tv,” which is not present in the KidsFun Mark, and (c) Applicant’s Mark includes “kids,” which is not present in the Fun TV Mark.

These differences are more than sufficient, given the weakness of the Cited Marks, to create a sufficiently different appearance, sound, and meaning from the Cited Marks. Indeed, as shown above, third parties already own the following marks in Classes 25 and 28, respectively, which are no more distinctive from one another than Applicant’s Mark is from the Cited Marks:

Class 25
ZZ ZZ KIDS TV
LIFEKIDS.TV
FUN TV

Class 28
FUN KIDZ
KIDSFUN
FUNKIDZ
KID FUN

See Exhibit D. For example, both the ZZ ZZ KIDS TV and LIFEKIDS.TV marks include the terms “kids” and “tv” for use with clothing. As another example, both the FUN KIDZ and FUNKIDZ marks include the terms “fun” and “kidz” for use with similar goods in Class 28. Finally, both the KIDSFUN and KID FUN marks include the terms “kid” or “kids” and “fun” for

use with similar goods in Class 28. These examples clearly show that consumers are accustomed to distinguishing between similar KIDS-, FUN-, and TV-formative marks based on slight differences between the marks. Accordingly, consumers are easily capable of distinguishing Applicant's Mark from the Cited Mark based on the different appearance of the marks.

In fact, tribunals have found no likelihood of confusion in similar cases. *See, e.g., Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 185 USPQ 321 (2d Cir. 1975) (KICK'ER not likely to be confused with KIK-IT, both for tabletop soccer games). Applicant respectfully submits that the differences between Applicant's Mark and the Cited Marks are at least as conspicuous as the differences between the marks found distinctive in the foregoing case and are sufficient to avoid any likelihood of confusion between Applicant's Mark and the Cited Mark.

b. The Marks are Distinct in Meaning.

When all of the relevant factors are considered, the meaning or connotation of the marks are also sufficiently different to avoid any likelihood of consumer confusion, another factor weighing in favor of registration.

In this case, the following terms create a different meaning and connotation from the Cited Marks: (a) a plural "kids" and "tv" in Applicant's Mark, which are not present in the Kid Fun Mark, (b) "tv" in Applicant's Mark, which is not present in the KidsFun Mark, and (c) "kids" in Applicant's Mark, which is not present in the Fun TV Mark.

More specifically, "kids" means multiple children or young people, "fun" means of or relating to fun or amusement, and "tv" means "television." *See* Exhibits F, G, H, and I (printouts from <https://www.dictionary.com/browse/tv?s=t>, <https://www.dictionary.com/browse/kid>, <https://www.dictionary.com/browse/kids?s=t>, and <https://www.dictionary.com/browse/fun?s=t>, respectively). Thus, Applicant's Mark connotes multiple children or young people having fun relating to tv. In contrast:

- The Kid Fun Mark connotes a single kid having fun;
- The KidsFun Mark connotes multiple kids having fun; and
- The Fun TV Mark is connotes fun relating to television.

Each of the Cited Marks has a different meaning from Applicant's Mark due to the absence of the word "tv," the use of a singular "kid," and/or the absence of the word "kid." These different words are all common words, which consumers can easily recognize and use to distinguish Applicant's Mark and the Cited Marks because consumers immediately know the difference between these terms and, as discussed above, consumers are accustomed to distinguishing between similar KIDS-, FUN-, and TV-formative marks based on slight differences between the marks.

Thus, these differences in meaning are sufficient to avoid a likelihood of consumer confusion.

c. The Marks Are Distinct in Sound.

Applicant's Mark and the Cited Marks are also distinct in sound. Applicant's Mark is comprised of four syllables, which are pronounced kidz-fuhn-tee-vee. *See* Exhibits F, G, H, and I. In contrast:

- The Kid Fun Mark has two syllables and is pronounced kid-fuhn;
- The KidsFun Mark has two syllables and is pronounced kidz-fuhn; and
- The Fun TV Mark has three syllables and is pronounced fuhn-tee-vee.

Id. Thus, as spoken, Applicant's Mark sounds different from the Cited Marks, which is sufficient to avoid a likelihood of consumer confusion, especially in view of the association in the minds of consumers between Applicant's Mark and Applicant's youtube channel, which has more than 5 million subscribers. *See* Exhibit E.

Indeed, even more similar sounding marks have been found to be distinctive. *See Lebow Bros., Inc. v. Lebole Euroconf S.p.A.*, 503 F. Supp. 209, 213, 212 USPQ 693 (E.D. Pa. 1980) (finding that LEBOLE and LEBOW CLOTHES were not confusingly similar); *Nat'l Distillers & Chem. Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 721, 184 USPQ 34 (C.C.P.A. 1974) (finding that DUVET and DUET were not confusingly similar). In addition, similarity of sound is less important when the goods are not ordered orally by name, as is the case here.

CONCLUSION

For the above reasons, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark based on the Cited Marks.

REMARKS

Applicant believes that this Response fully addresses the issues set forth in the Office Action. In the event the Examining Attorney does not agree with the sufficiency of this Response, Applicant respectfully requests that Applicant be given the opportunity to respond to any outstanding issues. Applicant invites the Examining Attorney to address any remaining issues in a telephone conference.