

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Treasure Studio, Inc.
Applicant's Mark : COCOMELON
U.S. Serial No. : 88/681,253
Law Office : 120
Examining Attorney : Shari Gadson

RESPONSE TO SUSPENSION NOTICE

This communication responds to the Suspension Notice dated February 11, 2020 in connection with Applicant's United States Trademark Application Serial No. 88/681,253 for COCOMELON. Specifically, it addresses the Examining Attorney's preliminary refusal to register Applicant's mark with respect to Class 25 based on a likelihood of confusion with three prior pending applications. As will be shown, there is no likelihood of confusion with any of these marks, and Applicant respectfully requests that its application be passed to publication, without waiting for the prior pending applications to resolve.

ARGUMENT AGAINST REFUSAL UNDER SECTION 2(d)

In the Office Action, the Examining Attorney suspended the examination of Applicant's Mark under Section 2(d) of the Trademark Act on ground that Applicant's Mark is confusingly similar with the following pending application:

- Serial No. 87608083 for the mark MELON for "Beach shoes; sneakers; running shoes; linen shoes; flip-flops; belts; gloves; bermuda shorts; surf shorts; swim shorts; bikinis; bathing suits; swimming trunks; hats; baseball caps; swimming caps; caps; woolen hats; cyclist jerseys; earmuffs; head sweatbands; wrist sweatbands; sport jerseys; polo shirts; T-shirts; cargo shorts; boxershorts; athletic socks; tracksuit bottoms; sweaters; tank tops; windcheaters; fleece pullovers; pullovers" (the "First Cited Application");
- Serial No. 87195439 for the mark MELON for "Clothing, namely, beanies, tops, sweaters, sweatshirts, t-shirts, long-sleeve shirts, tank tops" (the "Second Cited Application"); and

- Serial No. 87716316 for the mark MELON for “hats, tshirts, sweatshirts” (the “Third Cited Application”).

Applicant notes that the Third Cited Application is suspended based on the First and Second Cited Applications. The Second Cited Application was published for opposition, but has been opposed by the owner of the Third Cited Application. The First Cited Application is suspended, but not because of an issue with Class 25. Therefore, it seems that the First and Second Cited Applications were both allowed to proceed, but that neither of them will register in the foreseeable future.

All of the Cited Applications are for the mark MELON used in connection with clothing. Applicant respectfully disagrees with the Examiner’s finding that the existence of prior pending applications for MELON are barriers to the registration of Applicant’s mark, and requests that the Examining Attorney reconsider the suspension and allow registration of Applicant’s mark.

Likelihood of confusion between two marks at the USPTO is determined by a review of all of the relevant factors under the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, “there is no mechanical test for determining likelihood of confusion and ‘each case must be decided on its own facts.’” TMEP § 1207.01 (*citing du Pont*, 476 F.2d at 1361, 177 USPQ at 567). Each of the thirteen *du Pont* factors may be considered in weighing likelihood of confusion, if raised, and any one may be dispositive. *See* TMEP § 1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common industry, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the presence in the marketplace of a significant number of similar marks in use on similar goods/services, the existence of a valid consent agreement between the parties, or another established fact probative of the effect of use. *Id.*

1. Applicant’s Mark is Not Confusingly Similar with the Cited Applications

Applicant notes that there are a significant number of similar marks in use in connection with similar goods and services. The chart below illustrates a selection of MELON-formative marks used in connection with goods in Class 25:

Ser/Reg No.	Mark	Class(es)	Owner/Services
4734202	TOPMELON	25	Cao Rongcai Bikinis; Corsets; Dresses; Girdles; Gloves as clothing; Hats; Hosiery; Lingerie; Masquerade costumes; Scarfs; Shoes; Swimsuits; Underclothing No 2(d) refusal.
5489660	MELONHEAD	25	Rod Steele apparel, namely, shirts, sweat shirts, tank tops, pants, athletic pants, leggings, tights, shorts, swimwear, coats, jackets, vests, jerseys, sleepwear, underwear, sports bras, balaclavas, ear muffs, scarves, athletic sleeves being clothing, headbands, wristbands being clothing, bandannas, hats, caps being clothing, helmet liners being clothing, and footwear No 2(d) refusal.
5374380	FUNMELON	25	Huang, Libin Baby layettes for clothing; Dressing gowns; Hats; Pajamas; Scarves; Sleep masks; Slippers; Sports jerseys; T-shirts; Tops No 2(d) refusal.
88657432	MELONFEST	28	KBTD Touring Company, LLC Promotional clothing and headwear No 2(d) refusal.
88346502	MR. MELON	25	Candy Brands, LLC Hats; T-shirts No 2(d) refusal.
5117853	TRENDY MELON	25	Jun Meng Coats; Dresses; Pants; Shirts; T-shirts; Trousers; Vests; Under garments No 2(d) refusal.
4692182	MELON CAKES	25	SMB Group Clothing, namely, t-shirts No 2(d) refusal.

Copies of registration certificates printed from the United States Trademark Office online database and print-outs from the United States Trademark Office TESS database reflecting the pending applications are attached collectively as **Exhibit A**.

If the above-cited marks can co-exist with each other, and with the Cited Applications in Class 25, then Applicant submits that Applicant's Mark is capable of registration, especially given the significant differences between the Cited Applications and Applicant's Mark, COCOMELON. COCOMELON is no more similar to the Cited Applications than any of the other marks shown in Exhibit A.

In addition to the dilution of MELON-formative marks in connection with clothing, Applicant notes that Applicant's Mark and the Cited Applications differ in sight, sound and meaning. The Cited Applications is comprised of the word MELON, which is two syllables. COCOMELON, on the other hand, is a comprised of four syllables, includes the distinctive element COCO, and is an invented word with no meaning, other than to refer to Applicant and its goods and services. Moreover, Applicant's mark starts with the syllables CO-CO, which are completely different in sound and appearance than MELON.

When the cumulative effect of the significant differences between Applicant's COCOMELON mark and the cited MELON applications are given fair weight, along with the significant number of third party registration of similar, Applicant submits that confusion is not likely.

CONCLUSION

Applicant respectfully submits that the Examining Attorney has focused exclusively on the purported similarities between the Applicant's Mark and the Cited Registration and Cited Application, and has not adequately considered their differences, which are very significant. It is well-settled that, when determining likelihood of confusion, the Examiner should assess the mark as a whole and not focus on a single aspect of a mark. This is the "anti-dissection" rule. *See* 4 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition § 23:41 at 23-227 (4th ed. 2015) ("A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important"). Marks are compared in their

entireties for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1358, 1362 (C.C.P.A. 1973).

Applicant submits that its distinctive COCOMELON mark is significantly different from the Cited Registrations. Given the significant number of similar marks used in connection with similar goods, it is clear that consumers are capable of distinguishing between such marks.

For all of the foregoing reasons, Applicant requests that its application be allowed for publication and registration on the Principal Register.