

Attorney Docket No.: 052999-100605
Mark: ELDEN RING
Application Serial No.: 88/473,317

ARGUMENTS

This is a Response to the Office Action issued September 13, 2019. Applicant, Kabushiki Kaisha BANDAI NAMCO Entertainment Inc. (“Applicant”), thanks the Examining Attorney for the thorough review of the application. In the Office Action, the Examining Attorney has raised a prior-filed application advisory. For the reasons set forth below, Applicant respectfully disagrees that the prior-filed application poses any risk to the registration of the subject mark. The Examining Attorney also requires further specification of the services in Class 41. The Applicant herein amends the services in Class 41 to address this requirement.

I. Prior-Filed Application Advisory

In the Office Action, the Examining Attorney has advised that the following pending application for the referenced mark precedes Applicant’s filing date for the subject application: U.S. Application Serial No. 88/251,451 for the mark ELDENTEC in the name of Meng Fu Chen directed to *Badminton rackets; Chest protectors for sports; Dumb-bells; Electronic learning toys; Fishing tackle; Infant toys; Padel rackets; Playing cards; Skis; Slingshots; Smart plush toys; Smart robot toys; Smart electronic toy vehicles; Throat protectors for athletic use; Toy cars; Toy for pets; Toy watches; Amusement game machines; Arcade game machines; Christmas tree ornaments and decorations; Climbers' harness; LCD game machines; Party favor hats; Party blowouts; Party favors in the nature of crackers and noisemakers; Party games; Talking toys; Tennis rackets; Toy whistles; Video game machines* in Class 28 (hereinafter the “Cited Mark”). The Examining Attorney further advises that if the Cited Mark registers, the subject application for the mark ELDEN RING (“Applicant’s Mark”) may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with such mark.

Applicant respectfully disagrees and submits that there is no likelihood of confusion between Applicant’s Mark and the Cited Mark. When taken as a whole, and considering the significant differences in appearance, sound, connotation, and commercial impression between these marks and the notable distinctions in the goods/services, there can be no likelihood of confusion between them.

The Du Pont Factors Weigh Decidedly in Applicant's Favor

The Trademark Office must consider the relevant *Du Pont* factors in determining the issue of likelihood of confusion. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ 563 (C.C.P.A. 1973). Further, the significance of each factor is case specific. *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 12 USPQ2d 1901 (Fed.Cir. 1989), *rev’g*, 9 USPQ2d 1061 (TTAB 1988); *In re E. I. du Pont De Nemours & Co.*, *supra*. In this instance, the most relevant *Du Pont* factors are:

- 1) The differences in look, sound, connotation, and commercial impression of each mark; and
- 2) The differences in the goods and services associated with the marks.

Dissimilarity of the Marks

Here, Applicant asserts that Applicant's Mark, ELDEN RING, and the Cited Mark, ELDENTEC, are sufficiently different in appearance, sound, connotation, and commercial impression such that there is no likelihood of confusion between the two marks. *See Du Pont*, 476 F.2d at 1361, 177 USPQ at 567 (noting that when conducting a likelihood of confusion analysis, marks must be compared for similarities in appearance, sound, meaning or connotation, and commercial impression). Importantly, "[s]imilarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related." *See* TMEP §1207.01(b)(i).

The fact that the marks both contain the term ELDEN does not necessarily support a finding of likelihood of confusion. It is well settled that there is no automatic determination of likelihood of confusion merely because two marks have one or two words in common. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159, 229 USPQ 818, 819 (Fed. Cir. 1986) (no likelihood of confusion between BED & BREAKFAST REGISTRY for "making lodging reservations for others in private homes" and BED & BREAKFAST INTERNATIONAL for "room booking agency services"); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1408-09 (TTAB 1998) (HARD ROCK CAFE and Design and COUNTRY ROCK CAFE and Design dissimilar in appearance; no likelihood of confusion); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1996) (BROADWAY CHICKEN and BROADWAY PIZZA dissimilar in appearance; no likelihood of confusion).

Moreover, both Applicant's Mark and the Cited Mark comprise distinct added elements which serve to distinguish the marks, including Applicant's addition of the wording RING and the Cited Mark's inclusion of the suffix TEC. Additions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive or diluted. TMEP 1207.01(b)(iii); *see, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that marks are distinct in look and sound); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in

connection with the respective goods and services). In this instance, the marks perceive entirely different commercial impressions, given the distinctive added elements to each mark.

Also, the marks have entirely different connotations and meanings in view of the added elements to both marks. Applicant's Mark ELDEN RING suggests the world in which Applicant's video game takes place; whereas, the Cited Mark ELDENTEC has no such known meaning or suggested connotation.

Furthermore, when pronounced, Applicant's Mark does not sound like the Cited Mark because the marks include different wording that do not sound alike. Applicant's Mark has the added wording RING and the Cited Mark has the added suffix TEC. In *Colgate-Palmolive*, the court noted there was no phonetic similarity between the marks "PEAK" and "PEAK PERIOD," stating that "[t]he difference in the appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike." *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 58 C.C.P.A. 735, 737, 432 F.2d 1400, 1402 (C.C.P.A. 1970). This reasoning is equally applicable in the instant case.

Thus, when considered in their entireties, the marks at issue create significantly different overall appearances, sounds, connotations, and commercial impressions. Because of these differences between the marks, Applicant submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

Dissimilarity of the Goods and Services

The Board has long recognized that even where marks are identical, this alone is not enough to find a likelihood of confusion where the goods and services are unrelated. In evaluating whether goods or services are "related," the mere fact that two marks somehow, however tangentially, relate to the same class of goods or services does not suffice to find them confusingly similar. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992); (products not related merely because both involve computer hardware); *Information Resources Inc. v. X*Press Info. Servs.*, 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988); *G. H. Mumm & Ciev. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 U.S.P.Q.2d 1635 (Fed. Cir. 1990) (RED STRIPE (and Design) for beer not confusingly similar to a design of a red stripe for wines and sparkling wines); *National Distillers and Chemical Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 U.S.P.Q. 34 (C.C.P.A. 1974) (no likelihood of confusion between DUET for alcoholic cocktails and DUVET for French brandy and liqueurs). Rather, to be considered "related," the goods or services must be identical or competitive in nature, or there must be some relationship between them, or the conditions of their marketing must be such that the same persons will encounter them who might, because of the similarity of the marks, mistakenly believe that they have a common origin or are associated with the same source. *Mine Safety Appliances Co. v. Management Science Am., Inc.*, 202 U.S.P.Q. 105, 108 (T.T.A.B. 1981).

U.S. Trademark law is concerned with "the practicalities of the commercial world, with which the trademark laws deal" rather than the "mere theoretical possibilities of confusion, deception, or mistake." *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992). Two parties' general engagement in a broad industry such as the entertainment

or education industries does not infer that the parties' goods and services are related. For example, in *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029, 1034 (S.D.N.Y. 1990), the Board found that while the parties "furnish products related to the broad field of finance, [they] are as completely unrelated as night and day."

Here, the goods and services are not so related to cause a likelihood of confusion. In fact, the relevant goods and services have very little in common and do not overlap. Applicant offers downloadable video and computer games and entertainment services relating to the provision of video games. The Cited Mark, however, is applied for and/or used or intended to be used in connection with various toys and playthings, not including downloadable computer video games. The nature of the goods and services by Applicant and by the owner of the Cited Mark are wholly different. Examples of Applicant's goods and services are shown in Exhibit A and examples of the goods associated with the Cited Mark are shown in Exhibit B hereto. It is clear by the goods and/or services reflected in Exhibits A and B that the Applicant's goods and services and the goods associated with the Cited Mark are completely distinct. As such, there can be no finding of likelihood of confusion between the marks.

Further, while the relevant goods and services may arguably have some level of commonality, as they relate very generally to games, such generalization does not support a finding of likelihood of confusion. *See, e.g., Bose v. QSC Audio*, 293 F. 3d 1367, 63 (Fed. Cir. 2002) ("a broad general market category [electronic sound products] is not a generally reliable test of relatedness of products"). In one instance, the court determined that sugar and pizza, while both foods, are not related stating that "about the only things they have in common are that they are edible." *Amstar Corp. V. Domino's Pizza, Inc.*, 615 F.2d 252, 261 (5th Cir. 1980). That case is analogous here, where the relevant goods and services are associated tangentially with games, but are not so related that consumers are likely to be confused as to the source or sponsorship of the goods and services.

Applicant has now responded to all issues raised by the Examining Attorney, and therefore respectfully requests the Application be approved for publication. Should the Examining Attorney have any questions, she is invited to contact Applicant's counsel at (202) 585-8000.