

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application for Trademark Registration of:	*	
Offspring Inc Sdn. Bhd.	*	Examining Attorney Robert N. Guliano
Mark: OFFSPRING (design)	*	
Serial No.: 88/477,597	*	
Atty. Docket No.: 93311-0001	*	

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

I. PRIOR PENDING APPLICATION

Examiner has identified prior filed U.S. Application Serial No. 88/426,659 (the “‘659 Application”) as a mark that may present likelihood of confusion issues if registered.¹ The ‘659 Application does not present a likelihood of consumer confusion because it differs significantly in its commercial impression and the ‘659 Application is entitled to a narrow scope of protection.

a. The Commercial Impression of the ‘659 Application Differs Significantly from the Instant Application

Consumers are not likely to confuse the source of goods sold under the instant application with those sold under the ‘659 Application because there is a significant difference in appearance, which overrides any potential similarity in goods.

¹ The ‘659 Application has since issued as U.S. Trademark Registration No. 5919824 on November 26, 2019.

i. Appearance

The stylized nature of the Applicant's mark, as compared to the '659 Application and its inclusion of the additional wording THE KING'S, sufficiently differentiate the marks such that consumers would not confuse the two marks as indicating the same source. Consumers are also likely to focus on applicant's prominent inclusion of whales versus KING'S as the dominant portion of the mark in the '659 Application.

The instant application claims a composite mark consisting of both a word element and a design element. The mark consists of the word OFFSPRING above a design of two whales consisting of a small whale located inside a larger-sized whale:



While the word portion of a composite mark is generally given greater weight, here, the whale portion of the mark is very significant and the contrasting whale-within-a-whale design is a major feature in the mark that draws the consumer's eye.

The mark claimed in the '659 Application, by contrast, is THE KING'S OFFSPRING, where "KING'S" is the dominant portion of the mark because of its possessive nature. *See, In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). The use of a possessive causes consumers to focus on that portion of the mark because it serves as a significant differentiator and creates a perception that the mark is associated with royalty, and by extension, luxury goods. Thus, when consumers encounter THE KING'S

OFFSPRING they are likely to associate it with goods that are not necessities, but rather luxury goods with which to pamper. For illustrative purposes, if the mark for the '659 Application was THE VAGABOND'S OFFSPRING, then the consumer's impression of the mark would be drastically different.

The only commonality between the marks in the instant application and '659 Application is OFFSPRING—the minor portion of the mark. More so, the minor portion is also weak, as discussed below. Where the “common element of two marks is ‘weak’ in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality.” TMEP § 1207.01(b)(vii).

Because the instant application uses OFFSPRING in a distinctive font accompanied by two prominent, eye-catching whales, and the dominant portion of mark from the '659 Application—KING'S—is not present, the commercial impression of the two marks is dissimilar and militates against a likelihood of confusion. *See, In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (holding VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause confusion).

ii. The '659 Application is Entitled to Limited Protection Because There is Widespread Use of KING and OFFSPRING in Third-Party Registrations.

A search of TESS reveals that there are 6,352 records for live applications or registrations that contain “KING” and 27 live applications include “OFFSPRING.” Accordingly, the '659 Application is entitled to a narrow scope of protection because there is extensive third-party use of the dominant portion and minor portions of THE KING'S OFFSPRING.

II. MARK DESCRIPTION

Applicant amends the description of the mark to the following:

- The mark consists of the word OFFSPRING above a design of two whales consisting of a small whale located inside a larger-sized whale.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney find that there is no likelihood of confusion between the instant application and the '659 Application and approve the application for publication. If the Examining Attorney has any questions, please feel free to call Applicant's attorney below.

Sincerely,

/s/Cameron C. Murphy
Attorney for Applicant
404-407-5217 (telephone)