

U.S. Trademark Application No. 88/851,162
Mark: CAMERA GO
Applicant: Google LLC
Applicant Ref. No. GT-1507-US-1

RESPONSE TO OFFICE ACTION

Applicant Google LLC (“Applicant”) hereby responds to the Office Action issued May 23, 2020, for the above-referenced application and submits that it is timely. In the Office Action, the Examining Attorney refused to register Applicant’s mark based on a likelihood of confusion with U.S. Reg. No. 4,845,995 for the mark CAMERINGO, and required Applicant to amend its recitation of services and to disclaim the wording “camera.” For the reasons discussed below, Applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal because the marks are not confusingly similar.

There is No Likelihood of Confusion Between the Parties’ Marks

Section 2(d) of the Trademark Act precludes registration of an applicant’s mark “which so resembles a mark registered in the Patent and Trademark Office...as to be likely, when used on or in connection with the goods [and/or services] of the applicant, to cause confusion.” 15 U.S.C. §1052(d). In determining whether a likelihood of confusion exists, “the fundamental inquiry...goes to the cumulative effect of the differences in the essential characteristics of the goods [and/or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24 (C.C.P.A. 1976).

When considering whether there is a likelihood of confusion, marks must be compared in their entireties. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442 (8th Cir. 1987) (“[A]

court must look at the overall impression created by the marks and not merely compare individual features”). In particular, a mark

should not be split into its component parts and each part then compared with the 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.

J. Thomas McCarthy, *Trademarks and Unfair Competition*, §23:41. See also *In re Nat’l Data Corp.*, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (“likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark”); *In re 1776, Inc.*, 223 U.S.P.Q. 186 (T.T.A.B. 1984) (it is improper to dissect a mark as “[i]t is axiomatic that marks must be considered in their entireties in resolving the issue of confusing similarity”).

Here, the Examining Attorney noted that the marks are confusingly similar because they begin with “camer” and end with “go.” The Examining Attorney dissected Applicant’s mark into component parts and each part was then compared with the corresponding parts of the cited mark to determine likelihood of confusion. However, this dissection is in contradiction of accepted principles in a likelihood of assessment because marks should be viewed in their entireties, not their parts. When the parties’ marks are viewed in their entireties, Applicant respectfully submits that they are not confusingly similar. Applicant’s mark is a two-word mark composed of the separate terms “camera” and “go.” The inclusion of the term “camera” in Applicant’s mark references its non-downloadable software for creating and capturing photos and images, among other things. In contrast, the cited mark is a single word mark – CAMERINGO. Presumably, the cited mark is a coined term and, as such, there is no direct reference in the mark to cameras or any other device to take photos or related to photography.

Therefore, the parties' marks look and sound different and have different meanings and commercial connotations.

If we are to accept the Examining Attorney's analysis that the marks are confusingly similar, it would be not important what wording is between "camer" and "go" because it would only matter that the words share the wording "camer" and "go." So, for example, marks such as CAMERBBGO, CAMERXXGO, CAMERLENGO, CAMERSOFTGO, and CAMERTELLGO would be considered confusingly similar because they all start with "camer" and end with "go," even though these marks are indeed distinguishable from the cited mark. However, even marks that have shared the same word or words have been found not to be similar. *See also, e.g., Fossil Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998) (FOSSIL for watches found not confusingly similar to THE FOSSIL GROUP for clocks); *Lever Bros. Co. v. American Bakeries Co.*, 216 U.S.P.Q. 177 (2d Cir. 1982) (AUTUMN for margarine found not confusingly similar to AUTUMN GRAIN for bread); *Beneficial Corp. v. Beneficial Capital Corp.*, 213 U.S.P.Q. 1091 (S.D.N.Y. 1982) (BENEFICIAL for consumer loans found not confusingly similar to BENEFICIAL CAPITAL for business loans); *Vitarroz Corp. v. Borden, Inc.*, 209 U.S.P.Q. 969 (2d Cir. 1981) (BRAVO'S for crackers found not confusingly similar to BRAVOS for tortilla chips); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 202 U.S.P.Q. 81 (2d Cir. 1979) (DRIZZLER for men's golf jackets not confusingly similar to DRIZZLE for women's overcoats and raincoats); *Dwinell-Wright Co. v. White House Milk Co.*, 56 U.S.P.Q. 120 (2d Cir. 1943) (WHITE HOUSE for tea and coffee found not confusingly similar to WHITE HOUSE for milk). Here, where the parties' marks do not share any word or words but, rather, only share a more limited prefix and suffix, Applicant respectfully submits that case law does not support a finding of confusing

similarity. As such, Applicant respectfully requests that the Examining Attorney reassess the marks and find that they are not confusingly similar. The marks, when viewed in their entirety, are distinguishable as they look different, sound different and convey different meanings. Therefore, there is indeed no likelihood of confusion between the parties' marks.

Recitation of Services

The Examining Attorney noted that Applicant's recitation of services is indefinite, requiring Applicant to clarify it. Applicant respectfully submits that it has amended the recitation of services and that the recitation is now definite, meeting all Office requirements.

Disclaimer

The Examining Attorney also required Applicant to disclaim the wording "camera" because she believes it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose or use of Applicant's services. Accordingly, Applicant has hereby entered a disclaimer for the wording "camera."

Conclusion

In conclusion, Applicant respectfully submits that its mark is not confusingly similar to the cited mark and requests that the Examining Attorney withdraw the likelihood of confusion refusal and approve the application for publication.

Please contact the undersigned attorney if you have any questions.