

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Genting International Management Limited



Mark: GENTING SKYWORLDS & Design

Serial No. 88/918,009

Examining
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Commissioner for Trademarks
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RESPONSE TO OFFICE ACTION OF AUGUST 17, 2020

The applicant, Genting International Management Limited ("Applicant"), by its attorneys, responds to the Office Action of August 17, 2020 as follows:

**I.
INTRODUCTION**

Applicant filed to register the mark GENTING SKYWORLDS & Design for the following services:

- Class 41: education; providing of training; entertainment, sporting and cultural activities; amusement park operations and services; theme park operations and services; providing amusement arcade services; booking of seats for shows; bookmobile services; providing casino facilities; (gambling); casino services; leasing of casino games; cinema presentations; movie theatre presentations; club services (entertainment or education); arranging and conducting of colloquiums, concerts, conferences, congresses, seminars, symposiums, workshops (training), beauty contests and exhibitions for cultural or educational purposes and fashion shows for entertainment purposes; cultural, educational or entertainment services provided by art galleries; disc jockey services; discotheque services; entertainment services; entertainment information; conducting fitness classes; gambling services; gaming services; game services provided on-line from a computer network; providing golf facilities; conducting guided tours; health club services (health and fitness training) ; holding camp services (entertainment); karaoke services; nightclub services (entertainment); organization of competitions (education or entertainment); organization of exhibitions for cultural or educational purposes; organization of lotteries; organization of balls; organization of entertainment events; party planning

(entertainment); presentation of variety shows; presentation of live performances; providing recreation facilities; sport camp services; ticket agency services (entertainment); provision of advice, information and consultation in relation to the afore-mentioned services; providing theme park facilities; theme park services; amusement park and theme park services; amusement arcade services; amusement center services; amusement centre services; amusement park services; providing amusement arcade services; providing amusement facilities; providing amusement park facilities; amusement park and funfair services; production of amusement park shows; entertainment in the nature of an amusement park ride; entertainment in the nature of an amusement park show; entertainment services provided by recreation and amusement parks; rental of amusement machines and apparatus; entertainment in the nature of a water park and amusement center; entertainment in the nature of a water park and amusement centre; entertainment services in the nature of an amusement park show; and

- Class 43: services for providing food and drink; temporary accommodation; bar services; boarding house services; café services; cafeteria services; rental of chairs, tables, table linen, glassware; rental of cooking apparatus; rental of water dispensers; food and drink catering; food sculpting; holiday camp services (lodging) ; hotel services; resort hotel services; hotel reservations; rental of meeting rooms; motel services; reception services for temporary accommodation (management of arrivals and departures); restaurant services; self-service restaurant services; snack-bar services; rental of temporary accommodation; temporary accommodation reservations; rental of tents; tourist home services; rental of transportable buildings; provision and rental of space for food and drink services; boarding of animals; reservation services; hotel reservation services; hotel reservation services provided via the internet; providing online information relating to hotel reservations; making hotel reservations for others; agency services for booking of hotel accommodation; provision of advice, information and consultation in relation to the afore-mentioned services

In the Office Action, the Trademark Office refused registration of Applicant's mark pursuant to 15 U.S.C. § 1052(d) on the grounds of a purported likelihood of confusion with the following registrations ("Cited Marks") in Class 41 only:

- **SKY WORLD** (Registration No. 2204573) incontestable registration owned by Ellie Dylan for on-going children's television programs; providing an electronic bulletin board for children's entertainment and education, featuring, topics designed to motivate and inspire children in organization, personal development, and the realization of their goals; educational and entertainment services, namely, on-line services for children's entertainment and education, featuring, stories, cartoons, games, music and related activities and exercises designed to motivate and inspire children in organization, personal development, and the realization of their goals in Class 41; and
- **SKYWORLD** (Registration No. 4832657) registration owned by Skyworld, LLC for amusement arcades; amusement centers; amusement park and theme park services; amusement parks; children's entertainment and amusement centers, namely, interactive play areas; entertainment in the nature of a water park and amusement center;

entertainment in the nature of a water park ride; entertainment in the nature of an amusement park ride; entertainment services in the nature of an amusement park attraction, namely, a themed area; entertainment services in the nature of an amusement park show; entertainment services, namely, arranging and conducting special events at an amusement park; entertainment services, namely, arranging for ticket reservations for amusement park attractions; entertainment services, namely, arranging for ticket reservations for water parks and amusement centers; providing amusement facilities; providing amusement parks; providing theme park services in Class 41.

Applicant respectfully submits that Applicant's mark is not likely to be confused with the Cited Marks because (A) Applicant's mark differs from the Cited Marks in sight and sound; (B) Applicant owns numerous GENTING-formative marks such that consumers will recognize the GENTING house mark as a source indicator for Applicant's GENTING SKYWORLDS & Design mark; and (C) the services covered by covered by Applicant's mark differ from those covered by the Cited Mark (Registration No. 2204573).

II.
THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN
APPLICANT'S MARK AND THE CITED MARKS

A. Applicant's Mark And The Cited Marks Differ In Sight And Sound

Applicant's mark and the Cited Marks are not similar in sight or sound. Consumer confusion, therefore, is not likely. "The points of comparison for a word mark are appearance, sound, meaning and commercial impression. Similarity 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." TMEP § 1207.01(b)(i) (*citing Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1691 (Fed. Cir. 2005)); *see also First Savs. Bank, F.S.B. v. First Bank Sys., Inc.*, 101 F.3d 645, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (finding that the marks FIRSTBANK and FIRST BANK SYSTEM for banking services were not likely to be confused).

In *First Savs. Bank*, the United States Court of Appeals for the Tenth Circuit compared the marks FIRSTBANK and FIRST BANK SYSTEM and concluded that there were "minimal"

similarities between the two. See *First Savs. Bank*, 101 F.3d at 653. The court concluded that even though the marks contained some identical terms, the marks, when compared in their entireties with the additional term, were not confusingly similar. *Id.* While the dominant portion is given greater weight, each mark still must be considered as a whole. *Id.* (citing *Sun Banks of Florida, Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 317-18 (5th Cir. 1981) (similarity of appearance is determined “on the basis of the total effect of the designation, rather than on a comparison of individual features.” (quoting Restatement of Torts § 729, cmt. b (1938))).

Applicant’s GENTING SKYWORLDS & Design mark features an additional term that is different from the Cited Marks’ unitary marks SKY WORLD and SKYWORLD. The distinctive, dominant term GENTING in Applicant’s mark creates a unique impression and eliminates any likelihood of confusion with the Cited Marks. Moreover, the addition of the term GENTING in Applicant’s mark provides a different appearance than the Cited Marks. This addition of GENTING allows Applicant’s mark to begin in a different letter than the Cited Marks - a “G” as opposed to an “S.” Applicant’s mark also ends in a different letter than the Cited Marks - an “S” as opposed to a “D.” Moreover, Applicant’s mark comprises four syllables and fifteen letters in two distinct terms, while the Cited Marks include two syllables and eight letters in one or two terms.

Thus, there are significant visual and aural differences between Applicant’s mark and the Cited Marks such that confusion between Applicant’s mark and the Cited Marks is unlikely.

B. Applicant Owns Numerous GENTING-formative Marks Such That Consumers Will Understand Applicant’s GENTING SKYWORLDS & Design Mark Emanates From Applicant

It is well established that the addition of a strong house mark is sufficient to distinguish it from a third party mark. In *Juicy Couture, Inc. v. L’Oréal USA, Inc.*, the court found no likelihood of confusion between JUICY for clothing and JUICY WEAR for cosmetics where the accused mark always appeared near or in conjunction with the house mark LANCÔME. 2006 WL 1012939, at *22 (S.D.N.Y. 2006). Moreover, in *Knight Textile Corp. v. Jones Investment Co.*, the Trademark Trial and Appeal Board held that that the addition of applicant’s house mark to the highly

suggestive term ESSENTIALS was sufficient to avoid a likelihood of confusion. Serial No. 76070279 (T.T.A.B. June 21, 2005) [precedential].

Similar to the above cases, the distinctive part of the Applicant's mark is GENTING. Since at least as early as 1998, Applicant has used the GENTING house mark as its corporate name and in connection with a variety of goods and services. Indeed, Applicant owns the following U.S. registrations:

- **GENTING** (Registration No. 3683708) incontestable registration for note pads, notebooks, and stationery in Class 16; entertainment, namely, discotheques, cabarets, cinema theaters, movie theaters, motion picture theaters, dinner theaters, and presentation of live show performances; production of live show performances in Class 41; and bar services, cocktail lounges; restaurants in Class 43 (registered September 2009; first use in commerce December 12, 1998);
- **GENTING REWARDS** (Registration No. 4112726) incontestable registration for consumer loyalty services for commercial, promotional, and/or advertising purposes, for the purpose of promoting and rewarding loyalty for the use of entertainment services, namely, bar services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels in Class 35 (registered March 2012; first use in commerce October 28, 2011);



- **GENTING REWARDS & Design** (Registration No. 4112727) incontestable registration for consumer loyalty services for commercial, promotional, and/or advertising purposes, for the purpose of promoting and rewarding loyalty for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels in Class 35 (registered March 2012; first use in commerce October 28, 20211);



- **GENTING REWARDS & Design** (Registration No. 4365100) incontestable registration for consumer loyalty services for commercial, promotional, and/or advertising purposes, for the purpose of promoting and rewarding loyalty for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels in Class 35 (registered July 2013; first use in commerce February 6, 2013);



- **GENTING REWARDS & Design** (Registration No. 5464874) registration for consumer loyalty services for commercial, promotional, and/or advertising purposes, namely, administration of a consumer loyalty program to promote and reward loyalty for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels in Class 35 (registered May 2018; first use in commerce December 2012);
- **GENTING DREAM** (Registration No. 5198070) registration for paper, cardboard, and goods made from these materials, namely, table napkins of paper, place mats of paper, handkerchiefs of paper, figurines and statuettes of papier mache, mats for beer glasses; printed matter, namely, writing pads, postcards, bookmarkers, almanacs; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials, namely, drawing instruments, drawing boards; paint brushes; typewriters and office requisites, namely, document files and stationery, book binders, steel pens, pencils, balls for ball-point pens; printed instructional, educational, and teaching materials in the field of computers, music, art, dance, sports, exercise, health, nutrition, fitness, wellness, personal development, entertainment, politics, travel, culture; plastic materials for packaging, namely, plastic film for use as wrapping and packaging material for general use; printers' type; printing blocks in Class 16; clothing, namely, tee-shirts, shirts, pants, coats, dresses, skirts, sweaters, sports jerseys, jackets, bath robes, beachwear; swim wear, bathing trunks, boxer shorts, scarves, knit tops, waterproof jackets and pants, baby tops, neckties, socks, belts; footwear; headgear, namely, hats, caps in Class 25; games and playthings, namely, toys, namely, children's multiple activity toys, toy models, toy boats, toy cars, toy animals, toy building blocks, dolls, drawing toys, teddy bears, plush toys, jigsaw puzzles, snow globes, kaleidoscopes, dice, cups for dice, playing cards, scratch cards for playing lottery games; gymnastic and sporting articles, namely, balls for games, playing balls, decorations for christmas trees in Class 28; transport of goods; travel arrangement, namely, coordinating travel arrangements for individuals and for groups; cruise ship services in Class 39; entertainment, namely, movie theaters, presentation of live shows performances, and organized games offered via on a cruise liner; sporting and cultural activities, namely, organizing community sporting and cultural events on a cruise liner in Class 41; services for providing food and drink; temporary accommodation in Class 43; medical services; hygienic and beauty care for human beings in Class 44 (registered May 2017); and



- **GENTING REWARDS ALLIANCE & Design** (Registration No. 6213999) registration for informational flyers featuring information on entertainment services, namely, gaming, bar services, theme park

services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; booklets in the field of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; place cards; paper banners; display banners made of cardboard in Class 16; vinyl banners; banners of textile; plastic banners; cloth banners; banners of textile or plastic in Class 24; slot machines in Class 28; loyalty, incentive and bonus program services, namely, administration of a consumer loyalty program for commercial, promotional, or advertising purposes, for the purpose of promoting and rewarding loyalty for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; administration of consumer loyalty programs to promote and reward loyalty for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; administration of loyalty rewards programs, namely, arranging and conducting incentive reward programs to promote and reward loyalty for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; sales promotion for others through customer loyalty programs; organization and management of customer loyalty programs to promote the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; administration of loyalty programs involving discounts or incentives to promote the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; organization of customer loyalty programs for commercial, promotional or advertising purposes; organization and operation of customer loyalty and incentive programs, namely, providing incentive award programs through issuance and processing of loyalty points for the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; loyalty, discount and promotional programs, namely, the issuance of loyalty rewards cards to promote the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; incentive, loyalty, discount and promotional card services, namely, a loyalty rewards card program for commercial, promotional, or advertising purposes; club membership subscription services, namely, providing discounts and rewards to members for commercial, promotional, or advertising purposes; promoting the goods and services of others by means of loyalty program, discount program, promotional program and an incentive awards program; administration of a consumer loyalty program, a discount program, a promotional program and an incentive awards program to promote the use of entertainment services, namely, gaming, bar services, theme park services, cocktail lounges, restaurants, hotels, resort hotels, condominium hotels; electronic billboard advertising services; advertising and marketing services provided by means of social media; providing business information in the field of social media; digital advertising services in Class 35 (registered December 2020).

True and accurate copies of records of the above-listed registrations from the Trademark Status & Document Retrieval database of the Trademark Office are attached hereto as Exhibit A.

The dominance of GENTING distinguishes Applicant's mark from the Cited Marks such that consumers are not likely to be confused as to the source or origin of Applicant's services in its GENTING SKYWORLDS & Design mark. See *AutoZone, Inc. v. Tandy Corp.*, 373 F.3d 786 (6th Cir. 2004) (holding that "the use of the Radio Shack house mark in proximity to POWERZONE reduces the likelihood of confusion [between AUTOZONE and POWERZONE]."); *Juicy Couture, Inc.*, *supra*, 2006 WL 1012939, at *22 (S.D.N.Y. 2006).

Given that Applicant owns numerous GENTING-formative marks, consumers will understand that Applicant's GENTING SKYWORLDS & Design mark emanates from Applicant as well. Therefore, consumer confusion is unlikely.

**C. Applicant's Mark And The Cited Mark
(Registration No. 2204573) Cover Different Services**

The Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. TMEP § 1207.01(a)(vi). See, e.g., *In re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282, 1285 (T.T.A.B. 2009) (finding that the Trademark Office failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Moreover, the United States Court of Appeals for the Eleventh Circuit found no likelihood of confusion between the mark FREEDOM used in connection with realty services and the mark FREEDOM used in connection with savings and loan services, though a consumer in need of realty services is also generally in need of loan services. *Freedom Savs. Loan Ass'n v. Way*, 757 F.2d 1176 (11th Cir. 1985). If these goods and services are sufficiently unrelated, it is clear that Applicant's services are sufficiently unrelated to the services offered under the Cited Mark (Registration No. 2204573) to preclude a likelihood of confusion.

First, the Cited Mark (Registration No. 2204573) covers "on-going children's television programs; providing an electronic bulletin board for children's entertainment and education,

featuring, topics designed to motivate and inspire children in organization, personal development, and the realization of their goals; educational and entertainment services, namely, on-line services for children's entertainment and education, featuring, stories, cartoons, games, music and related activities and exercises designed to motivate and inspire children in organization, personal development, and the realization of their goals" in Class 41. The Cited Mark appears to provide children's educational services that aim to motivate children to reach their goals.

Meanwhile, Applicant's application covers "education; providing of training; entertainment, sporting and cultural activities; amusement park operations and services; theme park operations and services; providing amusement arcade services; booking of seats for shows; bookmobile services; providing casino facilities; (gambling); casino services; leasing of casino games; cinema presentations; movie theatre presentations; club services (entertainment or education); arranging and conducting of colloquiums, concerts, conferences, congresses, seminars, symposiums, workshops (training), beauty contests and exhibitions for cultural or educational purposes and fashion shows for entertainment purposes; cultural, educational or entertainment services provided by art galleries; disc jockey services; discotheque services; entertainment services; entertainment information; conducting fitness classes; gambling services; gaming services; game services provided on-line from a computer network; providing golf facilities; conducting guided tours; health club services (health and fitness training); holding camp services (entertainment); karaoke services; nightclub services (entertainment); organization of competitions (education or entertainment); organization of exhibitions for cultural or educational purposes; organization of lotteries; organization of balls; organization of entertainment events; party planning (entertainment); presentation of variety shows; presentation of live performances; providing recreation facilities; sport camp services; ticket agency services (entertainment); provision of advice, information and consultation in relation to the afore-mentioned services; providing theme park facilities; theme park services; amusement park and theme park services; amusement arcade services; amusement center services; amusement centre services; amusement park

services; providing amusement arcade services; providing amusement facilities; providing amusement park facilities; amusement park and funfair services; production of amusement park shows; entertainment in the nature of an amusement park ride; entertainment in the nature of an amusement park show; entertainment services provided by recreation and amusement parks; rental of amusement machines and apparatus; entertainment in the nature of a water park and amusement center; entertainment in the nature of a water park and amusement centre; entertainment services in the nature of an amusement park show” in Class 41.

Given these different services, it is unlikely that a consumer will mistake the Cited Mark’s educational services with Applicant’s services, or that anyone will believe that they emanate from the same source. Thus, Applicant’s services and the Cited Mark’s (Registration No. 2204573) services are not related and confusion is not likely.

For these reasons, there is no likelihood of confusion between Applicant’s mark and the Cited Marks. Accordingly, Applicant requests that its GENTING SKYWORLDS & Design mark be approved for publication.