

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Office Action Response**

**In re Application of** : **Kyte, Daniel**  
**Serial No.** : **90079695**  
**Filed** : **July 29, 2020**  
**Mark** : **WISP CREATIONS**  
**Examining Attorney** : **Dinisha Nitkin**  
**Law Office** : **110**

**Introduction**

Applicant filed for registration of the trademark **WISP CREATIONS** under application serial No. **90079695** for Playhouses for children, with a basis of intent to use. The examining attorney refused registration under Section 2(d) citing Registration No. 0786726 for the mark WISPY WALKER for dolls, owned by UNEEDA DOLL CO., INC..

**Argument**

The entire argument in the office action that the marks are confusingly similar consists of the following:

Applicant's mark is WISP CREATIONS.

The cited registration is WISPY WALKER.

Both marks begin with the distinctive term WISP/WISPY. As can be seen by the attached dictionary definition from *Merriam-Webster*, WISPY is the adjective form of WISP, meaning frail, slight, or fleeting. Thus, the marks not only look similar with first terms differing only by one letter; they also impart similar commercial impressions.

See November 19, 2020 Office Action.

The office action included the following dictionary excerpt:



### **1. The Underlying Premise of the 2(d) Refusal is Erroneous**

Initially, applicant does not accept the underlying premise of the 2(d) refusal that “Both marks begin with the distinctive term WISP/WISPY.” WISP and WISPY are, in fact, two different terms, and neither mark begins with the “distinctive term WISP/WISPY.” Applicant’s mark is not WISP/WISPY CREATIONS, and the cited registration is not WISP/WISPY WALKER. The marks at issue do not share the same initial term. Thus, the premise underlying the entire 2(d) refusal is erroneous. This inaccurate characterization of the marks at issue permeates the refusal, wherein the marks are not analyzed in their entireties. Had the actual entire marks as they are used and would be encountered in the marketplace been properly considered, there would have been no reason to issue the instant 2(d) refusal.

### **2. WISPY in the Cited Registration and WISP in Applicant’s Mark Have Very Different Connotations**

Despite the assertions in the office action, WISPY meaning frail, slight, or fleeting is not the same in meaning as WISP. The term WISP in the applied-for trademark WISP CREATIONS does not have the connotation of slight, fleeting or frail as asserted by the Office. Wisp means a

small handful of hay or straw (definition 1); or a thin strip or fragment (definition 2a); a thready streak (definition 2b); or something frail, slight or fleeting (definition 2c), or WILL-O'-THE-WISP (definition 3) per the dictionary excerpt attached to the November 19, 2020 office action.

The word WISP in Applicant's WISP CREATIONS for children's playhouses would not be understood to mean something frail, slight or fleeting, because these terms are the antithesis of what a consumer would want or expect in a children's playhouse. It would make absolutely no sense for consumers to assign that particular definition to the word WISP when it is used in a trademark for children's playhouses. The term WISP in applicant's mark would rather be understood by consumers as connoting a fairy being (as associated with Will-O'-The-Wisp) or a twist of straw or a small handful of hay or straw, as in definition 1 of the term according to the dictionary excerpt attached to the office action. These meanings or connotations of "wisp," (a fairy being or a twist of straw or a small handful of hay or straw) are suggestive of the fantastical, rustic handcrafted nature of applicant's custom-made playhouses. Thus, contrary to the assertion in the office action, the fact that one of the marks begins with WISPY and the other with WISP does not equate to the two marks imparting the same commercial impressions, especially given that the entire marks as they appear in the marketplace are WISPY WALKER and WISP CREATIONS. It is indisputable that when the marks are considered in their entireties they have dissimilar meanings, and it is noteworthy that the 2(d) refusal does not assert that the two marks in their entireties have similar meanings.

The term WISP in applicant's mark has the connotation of a spirit or fairy being, thus a fantastical and magical connotation, and imparts these characteristics to applicant's mark and associated custom-made children's playhouses. WISP has the connotation of Will-o'-the-Wisp, the most common English designation for a family of fairy-beings characterized by their fiery

appearance and their tendency to lead nighttime wayfarers astray. The term wisp refers to a twist of straw, used as a torch. See Exhibit A, excerpt from web page at <https://www.pitt.edu/~dash/willowisp.html>, visited February 25, 2021. Will-o'-the wisp may also refer to “an atmospheric ghost light seen by travelers at night, especially over bogs, swamps or marshes. The phenomenon is known in English folk belief.” See Exhibit B, excerpt from web page at <https://en.wikipedia.org/wiki/Will-o%27-the-wisp>, visited February 25, 2021.

Will-o'-the-wisp appears in folk tales and traditional legends of numerous countries and cultures; notable will-o'-the-wisp include [St. Louis Light](#) in Saskatchewan, [The Spooklight](#) in Southwestern Missouri, [Marfa lights](#) of Texas, the [Naga fireballs](#) on the [Mekong](#) in Thailand, the [Paulding Light](#) in Upper Peninsula of Michigan and the [Hessdalen light](#) in Norway. While urban legends, folklore and superstition typically attribute will-o'-the-wisps to ghosts, fairies or elemental spirits, modern science explains them as natural phenomena such as bioluminescence or chemiluminescence, caused by the oxidation of phosphine (PH<sub>3</sub>), diphosphane (P<sub>2</sub>H<sub>4</sub>) and methane (CH<sub>4</sub>) produced by organic decay.

See Exhibit B, excerpt from web page at <https://en.wikipedia.org/wiki/Will-o%27-the-wisp>, visited February 25, 2021.

Will-O'-The-Wisp, in the sense of a fairy-like being, may also be shortened simply to Wisp. “The will o' the wisps, or simply the wisps, are characters in Brave.”

We made the wisps like actual little spirits. They're almost like Marley's ghost in a way, because Marley's ghost isn't an evil spirit—even though he's frightening, he's trying to warn Ebenezer to change his ways. That's what the wisps are doing. There's a duality to them, because they're either good or evil—they led Merida into more and more trouble, but in the end, they've led her exactly where she needs to go.”

See Exhibit C, web page describing Pixar's Will O' The Wisp characters, known as the wisps, appearing in the film Brave, at [https://pixar.fandom.com/wiki/Will\\_O%27\\_the\\_Wisps](https://pixar.fandom.com/wiki/Will_O%27_the_Wisps), visited March 4, 2021.

WISP can also be a verb, meaning “to roll into a wisp.” See the excerpt from Merriam-Webster dictionary appearing at page 7 of the November 19, 2020 office action. This is suggestive of Applicant’s WISP CREATIONS brand custom-made children’s playhouses, as Applicant takes its customers’ ideas for the playhouse and treats these ideas like strands which are then rolled together into a wisp, which process is allegorical to the fabrication of the playhouse made to the customer’s specifications.

Thus, as set forth above, the connotation of WISP in applicant’s mark is not “frail, slight, or fleeting,” as asserted by the Examining Attorney. Although this meaning may be appropriate for the term WISPY appearing in the cited WISPY WALKER mark for dolls, it is not the connotation that consumers would associate with the word WISP as it appears in the WISP CREATIONS trademark for applicant’s custom-made children’s playhouses. Applicant’s custom-made children’s playhouses are decidedly not frail, slight or fleeting. They are well constructed and solid, and the term WISP in the mark WISP CREATIONS refers to the mystical, fairy-like quality of the playhouses and the fact each individual custom-made playhouse is created by stranding together the ideas of the customer.

Accordingly, the connotation of the word WISPY appearing in the cited registration in connection with dolls is not at all similar to the connotation of the word WISP appearing in the instant application in connection with custom-made children’s playhouses.

### **3. The Marks do Not Look Similar**

The office action asserts that “Both marks begin with the distinctive term WISP/WISPY” and “Thus, the marks . . . look similar with first terms differing only by one letter.” Again, applicant must disagree. As noted above the marks do not begin with the shared term

WISP/WISPY. Applicant's mark begins with WISP and the cited registration begins with WISPY. Furthermore, the two marks at issue are WISPY WALKER and WISP CREATIONS. These two marks, in their entireties, only look similar if you are blind to the last seven letters of the registered mark and the last nine letters of applicant's mark. Indeed, in both cases, the terms CREATIONS and WALKER make up the majority of the visual elements of their respective trademarks. As these terms are completely different from each other in appearance, the two trademarks in their entireties do not look similar.

Applicant is aware that USPTO examiners are not bound by prior decisions of other examiners, but it is interesting to note that the mark SEXY COUTURE, registration No. 4770293 (COUTURE disclaimed) for "Belts for clothing; Bottoms; Caps; Hats; Hosiery; Jackets; Jeans; Jeggings, namely, pants that are partially jeans and partially leggings; T-shirts; Tops" (filed Jul. 25, 2014, owned by SEXY COUTURE, INC.) was not cited in a 2(d) refusal against the application to register the mark SEX SKATEBOARDS, registration No. 5291481 (SKATEBOARDS disclaimed) for "Caps; headwear; jackets; pants; shirts; socks; sweat shirts; sweaters; T-shirts; underwear" (filed May 09, 2015, owned by SLUG ART LTD.). According to the logic of the instant 2(d) refusal the marks SEXY COUTURE and SEX SKATEBOARDS would both begin with the distinctive term SEX/SEXY and thus would "look similar with the first term differing by only one letter." Yet, even though the goods identified in these two registrations are legally identical (both identify caps and jackets as well as other closely related clothing items) and the terms SKATEBOARDS and COUTURE are disclaimed, no such refusal issued against SEX SKATEBOARDS. As in the instant case, the marks SEXY COUTURE and SEX SKATEBOARDS would only look similar if you were blind to all but the first three letters of each mark. The point being that trademarks that share no elements in common other than the same

initial three or four letters, where such letters make up only a minority of the material elements comprising the trademarks, do not, ipso facto, “look similar” and are not ipso facto likely to cause consumer confusion, even where the goods identified by the marks are identical and the remaining terms in the marks are descriptive and disclaimed. Applicant only mentions this to illustrate that the reasoning underlying the instant 2(d) refusal is seriously flawed and not in accord with prior USPTO practice.

The entire argument in the 2(d) refusal that the marks are confusingly similar was based on an unsupported assertion that the marks look similar because one begins with WISPY and the other begins with WISP, and that the two marks impart similar commercial impressions because one begins with WISPY and the other begins with WISP. Absolutely no weight was given in this analysis to the entire marks at issue, namely WISPY WALKER and WISP CREATIONS. The marks were analyzed as if the cited mark were WISPY and applicant’s mark were WISP. Yet in the marketplace consumers are confronted with two very different trademarks that are easily distinguishable: the alliterative WISPY WALKER and WISP CREATIONS. As demonstrated above, the initial terms WISPY and WISP as used in these two trademarks do not have similar connotations. Nor do the entire marks WISPY WALKER and WISP CREATIONS have similar appearances. The two marks WISPY WALKER and WISP CREATIONS are not similar sounding, nor do they have similar meanings. Accordingly, these two marks, WISPY WALKER and WISP CREATIONS, are not confusingly similar.

#### **4. The Goods are Not Related**

Moreover, the goods in connection with which the marks are used are not similar or related and travel in completely separate trade channels. By the amended identification of goods submitted herewith, the goods in the WISP CREATIONS application are the following:

Custom-made playhouses for children.

Applicant's goods are individually crafted to the specifications of each customer. The goods are available only directly from applicant, not through any third-party websites or big box stores. As far as applicant is aware, consumers cannot order custom-made children's playhouses from a company that also sells dolls under the same mark. Applicant's goods are not assembly line prefabricated playhouses, which occupy a separate product niche, and sell for substantially less money. For example, the KidKraft Ocean Front Playhouse attached at page 11 of the November 19 office action sells for \$269.99 on Target.com, the LOL Surprise Winter Disco Cottage Playhouse attached at page 13 of the November 19 office action sells for \$164.99 at lol Surprise.com, and the Cape Cottage Playhouse—Blue attached at page 15 of the November 19 office action sells for \$132.99 at littletykes.com. By contrast, the custom-made children's playhouses offered under the WISP CREATIONS trademark sell for \$4,000 and up depending on the specifications of the custom design. They are only available by custom order directly from applicant through applicant's web site at wispreations.com. Customers will necessarily know the source of the product because they will need to interact with the applicant to provide the specifications for the playhouse they are ordering.

Custom-made children's playhouses are not goods that are typically sold under the same trademark as dolls, and none of the evidence presented with the office action purported to show that dolls and custom-made playhouses are the type of goods that are "commonly sold under the same mark via similar trade channels." Moreover, the office action did not prove that dolls and assembly line prefabricated children's playhouses are the type of goods that are "commonly sold under the same mark via similar trade channels." Although the office action demonstrated that assembly line prefabricated children's playhouses and dolls are both marketed under the



trademarks KidKraft and LOL Surprise, the office action did not show that any dolls are offered under the CAPE COTTAGE trademark. A showing that there are two brands of prefabricated assembly line playhouses sold under the same trademark as dolls does not suffice to show these types of goods are “commonly sold under the same mark via similar trade channels.” Two instances does not equate to “commonly,” which as used in the office action, means “occurring frequently.” Furthermore, the high price tag of applicant’s goods ensures that they are purchased only after careful consideration, not quickly or carelessly. Thus, the goods are not related.

#### **5. Analysis of the Du Pont Factors**

Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “du Pont factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although applicant is satisfied that the arguments set forth above sufficiently demonstrate why the application for WISP CREATIONS should not be refused on the basis of the prior WISPY WALKER registration, in the interests of thoroughness applicant includes an analysis of the similarities and differences of the two trademarks applying the Du Pont factors below.

**The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression**

The appearances of the marks are notably different. Applicant's mark is WISP CREATIONS, consisting of thirteen letters, while the cited registration is WISPY WALKER, consisting of eleven letters. Applicant's mark ends with the word CREATIONS while the cited registration ends with the word WALKER. The initial word in Applicant's mark, WISP, ends with the letter P while the initial word in the cited registration ends with the letter Y. The word that makes up the bulk of the appearance of applicant's mark, CREATIONS, is completely absent from the cited registration, and the word that makes up the bulk of the appearance of the cited registered mark, WALKER, is completely absent from applicant's mark. The two marks do not share a single complete word in common. Accordingly, in their entireties the appearances of the two marks WISP CREATIONS and WISPY WALKER are very different.

The sound of applicant's mark also bears no similarity to the sound of the cited registered mark. WISPY WALKER, because the cited registration includes the second syllable "Y" pronounced "EE," which sound is completely absent from Applicant's mark. Applicant's mark includes the three-syllable word CREATIONS, the sound of which is completely absent from the cited registration. At the same time the cited registration includes the two-syllable word WALKER, the sound of which is completely absent from applicant's mark. The cited registration consists of a total of four syllables, and applicant's mark consists of a total of four syllables, but of these four syllables only one, WISP, appears in both marks. Thus, seventy five percent of the sounds of the subject marks are completely different. Moreover, WISPY WALKER contains an alliteration while WISP CREATIONS does not. Thus, the overall sounds of the phrases WISPY WALKER and WISP CREATIONS are completely different. Accordingly, the sounds of the subject marks are not similar.

The connotations of the two marks are completely different. WISPY WALKER has the connotation of a fragile, slight or frail walker, appropriate for a toy doll. Applicant's mark WISP CREATIONS has a very different connotation, namely, a fairy being (as associated with Will-O'-The-Wisp) or a twist of straw or a small handful of hay or straw, as in definition 1 of the term WISP according to the dictionary excerpt attached to the office action. Another connotation of the term WISP as such would be understood by consumers in relation to applicant's custom designed playhouses for children is "to roll into a wisp," which is suggestive of Applicant's WISP CREATIONS brand custom-made children's playhouses, because Applicant takes its customers' ideas for the playhouse and treats these ideas like strands which are then rolled together into a wisp, which process is allegorical to the fabrication of the playhouse made to the customer's specifications. These meanings or connotations of "wisp," (a fairy being or a twist of straw or a small handful of hay or straw, or in verb form "to roll into a wisp") are suggestive of the fantastical, rustic handcrafted nature of applicant's custom-made playhouses. Accordingly, the connotations of the marks are completely different.

Because the appearances, sounds and connotations of the two marks differ so greatly, the overall commercial impressions created by the marks are necessarily very different. WISPY WALKER has a totally different overall commercial impression from WISP CREATIONS.

**The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use**

As noted above, the office action did not provide proof to support the contention that the goods (dolls and custom-designed playhouses for children) are related. Although a child may play with a doll in a custom designed playhouse, a child may also read a book in a custom-designed playhouse, or listen to music, or eat a sandwich. The fact that the examining attorney was able to locate two companies that sell both dolls and prefabricated cheap children's

playhouses under the same trademark does not show that such goods are “commonly” provided by single source under a single trademark. Moreover, applicant’s goods are not equivalent to the low-quality prefabricated playhouses advertised in the web pages submitted as evidence with the office action. Applicant’s goods, by the amended identification submitted herewith are “Custom-made playhouses for children.” These are premium products, built to the individual specifications of each customer, costing four thousand dollars and up. Applicant’s custom-made playhouses can only be obtained by dealing with applicant directly and providing the requested specifications for the playhouse to applicant so that the item can be constructed. Thus, the goods are not related.

**The similarity or dissimilarity of established, likely- to-continue trade channels.**

Applicant’s goods are only available directly from applicant, because each custom-made playhouse must be built by applicant to the specifications of the customer. Thus, the trade channels of applicant’s custom- made playhouses will remain distinct from those in which the WISPY WALKER dolls travel.

**The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.**

Because applicant’s goods are custom-made playhouses for children that sell for prices starting at four thousand dollars, applicant’s customers will necessarily be careful and sophisticated. They will have to exercise care in their purchase because they will need to provide their input and specifications for the custom-made playhouse they are ordering. They cannot be impulse buyers and they would have to know that the source of the custom designed playhouse is applicant, since they will need to purchase the product directly from applicant. Because applicant’s customers would be careful and would be required to think about the custom

designed playhouse they want to have built for them, this factor reduces any possibility of confusion with the cited registered mark WISPY WALKER for dolls.

**The extent of potential confusion, i.e., whether de minimis or substantial**

Because the goods identified in the cited registration are toy dolls and applicant's goods are custom-made playhouses for children costing at least four thousand dollars, and because applicant's customers will need to deal directly with applicant in order to provide their desired specifications for their custom-made playhouse, as well as the fact that the playhouses will only be available directly from applicant, the extent of any potential confusion is truly de minimis.

**Cited Prior Pending Application**

Regarding the cited prior pending application, Serial No. 88499832 for HOLD MY HAND AND I WILL WALK WITH YOU WISPY WALKER, there is no likelihood of confusion with this prior pending application for all of the reasons set forth above as to why there is no likelihood of confusion with the cited registration for WISPY WALKER, only in the case of the mark HOLD MY HAND AND I WILL WALK WITH YOU WISPY WALKER, the differences between the marks are even greater, and the goods are not related.

Accordingly, based on the foregoing arguments and evidence, and in light of applicant's amended identification of goods, applicant respectfully requests that the 2(d) refusal be withdrawn, the potential 2(d) refusal be withdrawn, and the application be approved for publication.