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**To:** Ripples Group Limited ([sorel@sergei-orel.com](mailto:sorel@sergei-orel.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77820105 - ULTRA CASE - FHKI 3117 (8)  
**Sent:** 1/21/2011 12:32:29 PM  
**Sent As:** ECOM101@USPTO.GOV  
**Attachments:**

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 77820105

MARK: ULTRA CASE

**CORRESPONDENT ADDRESS:**

SERGEI OREL  
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APPLICANT: Ripples Group Limited

  
**CLICK HERE TO RESPOND TO THIS LETTER:**  
<http://www.uspto.gov/teas/eTEASpageD.htm>

**CORRESPONDENT'S  
REFERENCE/DOCKET NO:**

FHKI 3117 (8)

**CORRESPONDENT E-MAIL ADDRESS:**

[sorel@sergei-orel.com](mailto:sorel@sergei-orel.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 1/21/2011**

**THIS IS A FINAL ACTION.**

This Office action is in response to applicant's Request for Reconsideration filed on December 30, 2010.

Applicant's request for reconsideration presented new evidence that is significantly different from the evidence previously submitted by applicant. Therefore, this subsequent Final action is being issued to the applicant.

For the reasons set forth below, the refusal under Trademark Act Section 2(d) continues to be made FINAL with respect to U.S. Registration No. 3199331. See 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a). In

addition, the following requirement continues to be made FINAL: Identification of Goods. See 37 C.F.R. §2.64(a).

### **Section 2(d) Refusal – Likelihood of Confusion – Goods – FINAL Continued**

Registration of the applied-for mark continues to be refused because of a likelihood of confusion with the mark in U.S. Registration No. 3199331. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the cited registration, previously sent to applicant.

In its request for reconsideration, applicant argues (with attached applicant webpage, registrant webpage, applicant product catalog and various advertisement evidence) that the applicant's mark and registrant's mark are used on very different goods. Applicant's goods are primarily cases, covers and skins for light small electronic devices, devices that are light and designed to be carried on one's person. Registrant's website shows registrant's goods are sturdy "transit" cases for carrying "field instruments" where the goods are big sturdy goods presumably used for shipping or transporting in transit bulky industrial size equipment. Therefore, the users of the respective goods are different.

The examining attorney has carefully considered this argument, but finds it unpersuasive. In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see TMEP §1207.01(a)(iii).

In this case, registrant's website may be showing only a portion of the goods that they are using the mark on. Despite the type of goods shown on the registrant's website, the registrant's identification of goods "carrying and transit cases for electronic and field instruments" is broadly worded. This identification can be interpreted to include cases for consumer electronic goods – the same cases for consumer electronic devices being sold by the applicant. Therefore, the users of the registrant's broad-worded goods could be the same users of the applicant's goods. Furthermore, the evidence from the Google Searchable Database (attached to the initial Final office action dated June 30, 2010) shows that carrying cases for electronic instruments and fitted plastic films known as skins and screen protectors for covering and protecting electronic devices are all accessories for electronic instruments that are sold in the same channels of trade and/or originate from the same source. This evidence supports the conclusion that applicant's goods and registrant's goods are related and the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source.

In its request for reconsideration, applicant argues that it is a Hong Kong company and offers its goods online, on its website. Since U.S. consumers can only purchase applicant's goods online, not in stores, and the website of the applicant looks different from the registrant's website, there cannot be likelihood of confusion. Reasonable consumers can tell the different between the two websites.

The examining attorney has carefully considered this argument, but finds it unpersuasive. The differences in appearance between applicant's website and registrant's website is immaterial because a likelihood of confusion analysis involves a comparison of the marks and the goods or services. Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); see also *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression.

TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi). The initial Final office action dated June 30, 2010 demonstrates, with supporting evidence, that the marks are confusingly similar in sound and commercial impression and that the goods are related and the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source.

In its request for reconsideration, applicant argues that the marks are visually different and the main element of applicant's mark is an encircled "U" with umlaut. This looks very different from block letters of ULTRACASE.

The examining attorney finds this argument unpersuasive. As previously stated, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). In this case, the registrant's mark is in standard characters and could be presented on the registrant's website in the exact same manner of display as applicant's mark. Also, as stated in the initial Final office action dated June 30, 2010, the word portion (not the design) of applicant's mark is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods. Therefore, despite the differences, the applicant's mark and registrant's mark are confusingly similar in sound and commercial impression (as each mark suggests goods or cases that are beyond normal or ordinary or of high quality).

In its request for reconsideration, applicant argues that the examiner did not demonstrate any prima facie evidence of actual confusion. Applicant's evidence suggests that there is no confusion among the public, and both parties are using the marks in the U.S. in the marketplace and there is no confusion. The examining attorney finds this argument unpersuasive. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

In its request for reconsideration, applicant presented new evidence, including copies of Trademark Certificates of Registration from foreign countries, copies of authorized resellers agreements in the U.S. market, copies of invoices made to clients in the U.S., Paypal payment records by re-sellers and customers, Google ad-words campaign records, magazine advertisements, applicant's product catalog

and applicant's homepage of its website, in the effort to distinguish its mark and prove that there is no likelihood of confusion in this case.

The examining attorney has carefully considered this evidence but finds it unpersuasive. The copies of Trademark Certificates of Registration from the foreign countries is not proof that there is no likelihood of confusion in the present case between applicant's mark and the cited registered mark – these foreign registrations do not change the fact that the marks and goods at issue in the present case are confusingly similar, for the reasons stated above and in the previous Office actions. Also, the resellers agreements, invoices, Paypal payment records, Google ad-words campaign records and various forms of advertising presented by applicant are immaterial to the likelihood of confusion analysis in this case, where the focus of the analysis is on the applicant's mark and registrant's mark (compared for similarities in their appearance, sound, connotation and commercial impression) and the applicant's goods and registrant's goods (compared to determine whether they are similar or commercially related or travel in the same trade channels).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

This refusal continues to be FINAL.

#### **Identification of Goods – FINAL Continued**

In its request for reconsideration, the applicant's proposed wording "OGG players, namely, digital players ... 3GP players, namely, digital players" in the identification of goods is indefinite and must be clarified because the wording "digital players" is overly broad and ambiguous. *See* TMEP §1402.01. Applicant must amend this wording to specify the common commercial name of the goods. If there is no common commercial name, applicant must describe the product and its intended uses. *See id.*

If accurate, applicant may use the substitute language "digital audio players" for clarification.

Also, the proposed language "that is used for files whose content uses the OGG free fully open and standardized multimedia bitstream container format" and "which is a multimedia container format defined by the Third Generation Partnership Project (3GPP) for 3G UMTS multimedia services" is extraneous and does not need to be included in the explanation of the "OGG players" and "3GP players." Therefore, this language should be deleted.

Applicant may adopt the following identification of goods, if accurate:

"Cases and bags specially adapted for protecting, holding and carrying electronic devices, namely, mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, namely, analog voice recorders, digital sound recorders, digital voice recorders, video recorders, audio players, namely, personal hand-held music players, digital voice players, MP3 players, MP4 players, OGG players, namely, digital audio players designed for playing files with .ogg filename extension, WMA players, 3GP players, namely, digital audio players designed for playing files in 3GPP file format, CD players and MD players, audio recorders, movie players, namely, digital video players, video file players, VCD players, DVD players, movie recorders, namely, digital video recorders, digital cameras

with movie recording functions; screen protectors and fitted plastic films known as skins for covering and providing a scratch proof barrier for protection for mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, namely, analog voice recorders, digital sound recorders, digital voice recorders, video recorders, audio players, namely, personal hand-held music players, digital voice players, MP3 players, MP4 players, OGG players, namely, digital players designed for playing files with .ogg filename extension, WMA players, 3GP players, namely, digital players designed for playing files in 3GPP file format, CD players and MD players, audio recorders, movie players, namely, digital video players, video file players, VCD players, DVD players, movie recorders, namely, digital video recorders, digital cameras with movie recording functions; devices and accessories for mobile phones, cell phones, media players, media recorders, namely, hands-free devices for mobile phones, keyboards, batteries, battery chargers, in **International Class 009.**”

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. See TMEP §1402.04.

Although identifications of goods and/or services may be amended to clarify or limit the goods and/or services, adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

This requirement continues to be FINAL.

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**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at

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**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 1/21/2011 FOR  
SERIAL NO. 77820105**

Please follow the instructions below to continue the prosecution of your application:

**TO READ OFFICE ACTION:** Click on this **link** or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to **access** the Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

**RESPONSE IS REQUIRED:** You should carefully review the Office action to determine (1) how to respond; and (2) the applicable **response time period**. Your response deadline will be calculated from **1/21/2011** (or sooner if specified in the office action).

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

**Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.**