

TRADEMARK
513733-8009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Freeze 24/7 International, LLC
Application No. : 78/768,750
Filing Date : December 7, 2005
Mark : ICECREAM DOUBLE SCOOP
International Class : 3
Law Office : 113
Trademark Attorney : Kristin M. Dahling

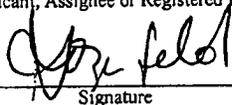
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Magali Rozenfeld

Name of Applicant, Assignee or Registered Representative



Signature

July 19, 2007

Date of Signature

RESPONSE

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



07-23-2007

U.S. Patent & TMO/TM Mail Rpt Dt. #34

Sir:

In response to the Office Action mailed January 19, 2007, Applicant respectfully requests the following remarks be considered and made of record:

REMARKS

Reconsideration and withdrawal of the objections to this trademark application are respectfully requested in view of these remarks.

It is noted that the Examining Attorney has maintained her refusal to register the mark **ICECREAM DOUBLE SCOOP** under Section 2(d) of the Trademark Act on the basis that Applicant's mark when used on or in connection with the identified goods it so resembles the **DOUBLE DIP ICED CREME** mark in U.S. Registration. 2,811,554 as to be likely to cause confusion, or to cause mistake or to deceive. The cited registration is for "sun tanning preparations" and is owned by Australian Gold of Indianapolis, Indiana.

It is respectfully submitted that the refusal to register under Section 2(d) is unwarranted and should be withdrawn.

In testing for likelihood of confusion, various factors are considered, including but not limited to, the similarity of the marks, the similarity of the goods, the similarity of established trade channels, and the conditions under which and by whom sales are made (impulse v. sophisticated purchasers). See In re E.I. du Pont de Nemours & Co., 177 USPQ 563 (CCPA 1973).

It is respectfully asserted that an analysis of the du Pont factors demonstrates that no confusion is likely between **ICECREAM DOUBLE SCOOP** and the cited registrations for **DOUBLE DIP ICED CREME**. Applicant maintains that the registrability of its mark is particularly supported by the differences in the marks themselves.

The degree of similarity between conflicting marks is properly determined by the "sight-sound-meaning" trilogy, *i.e.*, the degree of similarity between marks based on the overall impression created by the designations; pronunciation; translation of foreign words; and verbal

translation of pictures; suggestions, connotations or meanings of the designations. Restatement (Third) of Unfair Competition § 21(a) (1995); McCarthy on Trademarks and Unfair Competition, 4th Ed. § 23:21.

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks as a whole are sufficiently similar in terms of their commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980).

First, Applicant maintains that as far as appearance and sound are concerned, there are obvious differences between the mark **ICECREAM DOUBLE SCOOP** and the cited **DOUBLE DIP ICED CREME** mark. Indeed, Applicant's mark consists of three words and begins with the word "icecream". The cited registration consists of four words and begins with the word "double". Therefore, with respect to sight and sound alone, the only word the two marks have in common is the word "double". Additionally, Applicant respectfully submits that, the word "double" in the instant mark is not the prominent part of the mark, which further renders confusion with the cited mark unlikely. *See Presto Product, Inc. v. Nice Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988) (In holding that KID-WIPES is confusingly similar to KID STUFF, when used in connection with baby wipes, the board noted that "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."); *see also Von Dutch Originals, LLC v. Richard M. Betts*, 2006 WL 1087854 (Trademark Tr. & App. Bd.) (the board found no likelihood of confusion between VON DUTCH and UNCLE DUTCH and noted that first part of the mark is often the most prominent "both to the eye and the ear"); *see also Remerica Real Estate Corp. v. Steve Komomdorea*, 2007 WL 117517 (Trademark

Tr. & App. Bd.) (No confusion between REALAMERICA REALTY and REMERICA both for real estate services because the prominent sounds and appearances, i.e. the leading syllables of each mark are different).

Second, Applicant urges that the two marks also convey two entirely different meanings. Applicant's mark conveys two scoops of ice cream while the registered mark refers to crème that has been dipped twice.

The Examining Attorney argues that "ice cream" and "iced crème" are used interchangeably by consumers. To support such statement, she refers to what appears to be entries on a yahoo forum. Applicant respectfully maintains that ice cream and iced crème are not synonyms and that, on information and belief, the word "iced crème" was coined by registrant to bring to the mind of the consumer the notion of welcomed freshness its "crème" (i.e. sun tanning lotion) would bring to the user upon application. On the other hand, such concept is entirely absent from applicant instant mark.

Finally, the Examining Attorney also argues that "double dip" and "double scoop" have the same meaning. Applicant respectfully disagrees. As evidenced by the print-out from the wikipedia encyclopedia, attached as Exhibit A, "'double dipped' can also refer to ice cream dipped in a sauce, usually chocolate". Additionally, as shown in the print-out of the online Merriam Webster dictionary, the word "dip" has several meaning but "scoop" is not one of them. See attached Exhibit B.

In sum, the different amount of words (4 vs. 3), in the two marks, **DOUBLE DIP ICED CRÈME** and **ICECREAM DOUBLE SCOOP**, the different words in the marks (Double, Dipped, Iced, and Crème vs. Icecream, Double, and Scoop), the different placement in the mark

of the only similar word "double", and the difference in connotation causes the *sight, sound and meaning* of Applicant's mark to be clearly different from the cited mark.

As a result, the mere fact that the trademarks in question both contain the word double is not dispositive of the issue of similarity and is not likely to create confusion.

It is, therefore, respectfully asserted that an analysis of the various relevant duPont factors in the instant application leads to a finding of no likelihood of confusion. Applicant respectfully requests that confusion is unlikely and that the refusal to register the **ICECREAM DOUBLE SCOOP** mark should be withdrawn.

Applicant submits that the instant application is now in condition for publication, the early notification of which is respectfully solicited.

Respectfully submitted,

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EXHIBIT A

Double dipping

From Wikipedia, the free encyclopedia

Double dipping or **Double dipped** has several meanings:

Contents

- 1 Travel
- 2 Softball/Slo-Pitch
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Travel

Some frequent guest programs permit guests to accumulate points with the primary program and simultaneously with other programs. For example, guests can earn Hilton and chosen airline points simultaneously.^[1]

Softball/Slo-Pitch

In Softball/Slo-Pitch, the term is used to refer to the team that loses twice in the finals to the same team; or referring to the winning team beating the undefeated team twice in the finals "SPC Ladies double dipped the Sudbury Storm in the NSA Canadian World Series"

Canadian politics

In Canadian politics, the term is used to refer to politicians or civil servants who draw one pension, or benefit, while working in another job within the government; or drawing two pensions at the same time. The issue became a centrepiece in a campaign by the National Citizens Coalition and a national issue in Canada, affecting many federal politicians, and forcing accountability and disclosure within the Canadian political process.

Food

Double-dipping can refer to an offense derived from the custom that it is considered rude (and unsanitary or a violation of etiquette) to place food back into (and thus contaminate) a communal bowl after it has touched a person's hands or mouth.

The term was popularized in an episode of the sitcom *Seinfeld* ("The Implant"), written by Peter Mehlman. George Costanza dips a tortilla chip again after taking a bite. His girlfriend's younger brother Timmy notices the offense and castigates George for being a double dipper. A fight ensues.

TIMMY: What are you doing?

GEORGE: What?

TIMMY: Did...did you just double-dip that chip?

GEORGE: Excuse me?

TIMMY: You double-dipped the chip!

GEORGE: "Double-dipped"? What are you talking about?

TIMMY: You dipped the chip. You took a bite. <points at the dip> And you dipped again.

GEORGE: So...?

TIMMY: That's like putting your whole mouth right in the dip! From now on, when you take a chip - just take one dip and end it!

Doubled dipped can also refer to ice cream dipped in a sauce, usually chocolate.[1] (<http://www.checkout.ie/MarketProfile.asp?ID=194>) This definition also occasionally extends to other foods, such as strawberries.[2] (<http://www.e-cookbooks.net/recipes/02118.htm>)

DVDs

This term is also used in referring to DVDs. In the case of double dipping, the movie has already been released on DVD and it gets re-released, typically adding new special features or as a "special edition." It refers to dipping your hand into your pocket to pull out your money for a second time.

Roller Coasters

On a roller coaster, a double dip is a hill that levels off for a bit about halfway down.

Drugs

Various drugs such as lsd are measured by their potency. Thus, a 'double dipped' dose of lsd would be twice as strong.

References

1. ^ WebFlyer Hilton Entry (http://www.webflyer.com/programs/ratings_and_reviews/program.php?key=HH01)

External links

- Cites this issue. (<http://www.ottawasun.com/Comment/Editorial/2006/01/29/1417409.html>)
- Provincial MLAs allowed to collect MLA pension and salary concurrently, citation of Conflict of Interest Commissioner H.A.D. Oliver's decision. (<http://www.straight.com/content.cfm?id=15202>)

Retrieved from "http://en.wikipedia.org/wiki/Double_dipping"

Categories: Articles lacking sources from November 2006 | All articles lacking sources | Slang | Seinfeld | Phrases

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EXHIBIT B



Merriam-Webster
Online

- Home
- Visit Our Sites
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- Spelling Bee Hive
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dip

8 entries found for **dip**.
To select an entry, click on it.

- dip[1,verb]
- dip[2,noun]
- dip[3,noun]
- dip[4,abbreviation]
- DIP
- dip net

Go

Main Entry: **1 dip**

Pronunciation: 'dip

Function: *verb*

Inflected Form(s): **dipped; dip-ping**

Etymology: Middle English *dippen*, from Old English *dyppan*; akin to Old High German *tupfen* to wash, Lithuanian *dubus* deep

transitive verb

1 a : to plunge or immerse momentarily or partially under the surface (as of a liquid) so as to moisten, cool, or coat <*dip* candles> **b** : to thrust in a way to suggest immersion **c** : to immerse (as a sheep or dog) in an antiseptic or parasitocidal solution

2 a : to lift a portion of by reaching below the surface with something shaped to hold liquid : LADLE **b** : to take a portion of (snuff)

3 a *archaic* : INVOLVE **b** : MORTGAGE

4 a : to lower and then raise again <*dip* a flag in salute> **b** *chiefly British* : DIM.2
intransitive verb

1 a : to plunge into a liquid and quickly emerge **b** : to immerse something into a processing liquid or finishing material

2 a : to suddenly drop down or out of sight **b** *of an airplane* : to drop suddenly before climbing **c** : to decline or decrease moderately and usually temporarily <prices *dipped*> **d** : to lower the body momentarily especially as part of an athletic or dancing motion

3 a : to withdraw a part of the contents of something by or as if by reaching down inside it -- used with *into* <*dipped* into his pocket for change> <*dipped* into the family's savings>

4 : to examine or read something casually or superficially -- used with *into* <*dip* into a book>

5 : to incline downward from the plane of the horizon
- **dip·pa·ble** /'di-p&-b&/' *adjective*

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Browse t
A B C D E
Z



THE WORD

K&N
- High
- Des
- Milli

I
D

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