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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79130383
Applicant	Flair Leisure Products Plc
Applied for Mark	PLASTICINE IMAGINE THE FUN!
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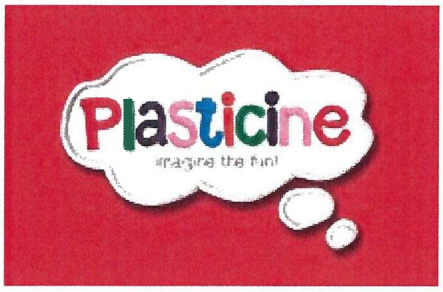
TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Flair Leisure Products Plc
Mark	:	
Serial No.	:	79130383
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Examining Attorney	:	Laura Golden
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BRIEF FOR APPLICANT

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INTRODUCTION

Pursuant to the Notice of Appeal filed with the Trademark Trial and Appeal Board on September 5, 2014. Applicant hereby appeals from the Examining Attorney's September 5, 2014 final refusal to register the captioned mark on the Principal Register, and respectfully requests the Trademark Trial and Appeal Board reverse the Examining Attorney's decision on the grounds that Applicant's mark does not create a likelihood of confusion with the mark cited by the Examining Attorney.

BACKGROUND

Applicant seeks to register on the Principal Register for:

> Hand tools and hand implements for use in modelling and in working modelling material, namely plastic and wooden modelling tools for cutting, trimming, shaping and forming modelling material in Class 8;
>
> Craft paper; craft paper articles and cardboard articles namely, pictures; printed matter, namely, magazines and leaflets relating to modeling and crafts; books in the field of modelling and crafts; paint brushes; modelling clay; printed instructional and teaching materials in the field of modelling and crafts in Class 16; and
>
> Toys, games and playthings, namely, hobby and modelling sets, comprised of toy modelling material, shape cutters, shaping tools, molds, play mats, plastic rollers, picture trays, and picture cards in Class 28.

The application was filed under Section 66(a) and received U.S. Trademark Application Serial No. 79130383 with a filing date of March 14, 2013. The Examining Attorney refused registration under Section 2(d) of the Lanham Act alleging that the mark is likely to be confused with the mark IMAGINE THE FUN, the subject of U.S. Reg. No. 4272346, for:

> Retail services through direct solicitation by salespersons directed to end-users featuring toys, balls and toy sports equipment in Class 35

because the phrase IMAGINE THE FUN is contained in Applicant's mark and the goods and services and their respective channels of trade are ostensibly related. The Examining Attorney reasoned that the tagline Imagine the fun! "stands independently as a tagline in applicant's mark

so that it will be separable from the remainder of applicant's mark and will stand alone in a consumer's minds (sic)." *See* Office Action mailing date July 8, 2013. The Examining Attorney went on to claim that the goods and services were related because in third party Internet research she found that retail stores sold items such as those associated with Applicant's mark and moreover claimed that this evidence showed that some entities manufacture such goods and market them under the same mark. In addition, the Examining Attorney cited case law for the proposition that specific products and stores selling those same products would give rise to a likelihood of confusion if the same mark was used. Finally, the Examining Attorney attached third party registrations which covered both retail services in Class 35 and toys in Class 28.

In Applicant's response to the initial refusal to register filed on January 8, 2014, Applicant argued that the marks are distinguishable based on the fact that they are entirely visually different given the several design features and colors, the dominant portion of Applicant's mark is Plasticine, and the marks create entirely different commercial impressions. Applicant addressed the prior registrations and the Internet evidence submitted by the Examining Attorney noting where these failed to support a contention that the marks were confusingly similar.

The Examining Attorney repeated her reasoning that the marks share a common phrase IMAGINE THE FUN and that the channels of trade are similar in her final Office Action issued March 5, 2014. The Examining Attorney dismissed the arguments previously propounded by Applicant arguing again that the marks are similar and the consumer would believe that the goods and services emanated from the same source and provided further Internet evidence for the proposition that the channels of trade overlap.

In response thereto on September 5, 2014, Applicant requested reconsideration of the Examining Attorney's final refusal arguing that the slogan is somewhat descriptive and weak as applied to craft and hobby kits and related creative tools and retail services through direct solicitation sales for toys. Applicant noted that the difference of opinion between Applicant and

the Examining Attorney was which portion of Applicant's mark was the dominant portion that would be remembered by consumers. Applicant argued that the cases cited by the Examining Attorney were not truly relevant in the instant case. Finally, Applicant argued that the mark should not be refused in all classes inasmuch as the cited registration was limited to retail sales through direct solicitation of toys and playthings.

On September 23, 2014, the Examining Attorney denied the request for reconsideration claiming that no new facts or reasons were presented that were significant and compelling with regard to the point at issue. She did however address the arguments raised by Applicant in the request for reconsideration and submitted additional evidence of third party sales of all of the items covered by Applicant's application.

On September 5, 2014, Applicant filed a Notice of Appeal.

THE MARKS MUST BE CONSIDERED IN THEIR ENTIRETIES AND MAY NOT BE DISSECTED

Applicant maintains that the Examining Attorney impermissibly dissected Applicant's composite mark

, rather than considering Applicant's mark and the cited mark in their entireties for purposes of determining a likelihood of confusion. The proper test is whether the entire mark of Applicant is likely to cause confusion with the entire mark of the cited prior registration. To leave out significant portions of the mark in considering a likelihood of confusion is contrary to trademark law.

Applicant does not dispute that in determining a likelihood of confusion, one must look to the principal factors listed in *In re E.I. DuPont de Nemours Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *DuPont* has long been held to be the precedent for determining issues of likelihood of confusion. In *DuPont*, the court emphatically held: "[T]he question of confusion is related not to the nature of the mark but to its effect when applied to the goods of the Applicant. The only relevant application is made in the marketplace. The words 'when applied' do not refer

to a mental exercise, but to all of the known circumstances surrounding use of the mark." *DuPont* at 567. It is clear that the Court held that all of the circumstances must be examined. The Court went on to hold "we find no warrant, in the statute or elsewhere, for discarding any evidence bearing on the question of likelihood of confusion.... In every case turning on likelihood of confusion, it is the duty of the Examining Attorney, the board and this court to find, upon consideration of all the evidence, whether or not confusion is likely." While one person will give greater weight to one factor than another person might, it is the Examining Attorney's duty to look at all of the evidence. Applicant believes that the Examining Attorney has impermissibly focused on one aspect of the mark.

Marks must be evaluated as they are perceived, in their entirety. *In re Hearst Corp.*, 982 F.2d 492, 25 U.S.P.Q.2d 1238,1239 (Fed. Cir. 1992) (stating that marks are perceived in their entireties and, therefore, all components thereof must be given appropriate weight). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the good or services offered under the respective marks is likely to result. *Miss Universe v. Community Marketing*, 82 USPQ2d 1562, 1570 (TTAB 2007). Additionally, when determining the degree of similarity, rather than dissecting a mark by minute comparison of its elements, courts look to the marks as a whole, including any disclaimed terms, to determine the level of similarity between them. *M2 Software Inc. v. M2 Communications Inc.*, 78 USPQ2d 1994, 1946 (Fed. Cir. 2006).

The Examining Attorney claims that the phrase IMAGINE THE FUN is the dominant portion of the marks and are the only words capable of distinguishing the goods and services in commerce. This reasoning is flawed. Imagine the fun! is only considered to be the dominant portion of Applicant's mark by the Examining Attorney because it is the whole of the Registrant's mark. This is a far too simplistic approach. Applicant contends that the design portion of the mark and the prominent and unrelated word PLASTICINE is the dominant and distinctive focal

point of Applicant's mark. The marks in their entireties are distinctly different. Consumers do not stop to dissect and analyze marks. They are impressed by a mark as they see or hear it. *Ex Parte Maya De Mexico*, 103 USPQ 158, 154 WL 5556 (Comm'r Pat. & Trademarks 1954); *Supply Mfg. Co. v. King Trimmings, Inc.,* 220 F. Supp. 947, 139 USPQ 163 (S.D. N.Y. 1963).

Consumers will not pick the mark apart and believe that the associated goods emanate from the provider of direct solicitation retail services marked with the tagline IMAGINE THE FUN. They will see first and foremost the word PLASTICINE and the vibrant associated design. They will hear the first and dominant word, PLASTICINE, and will commit that portion of the mark to long term memory consistent with the well-known psychological phenomenon Primacy Effect.

While the Examining Attorney has stated that a similarity in any one element of sound, appearance or meaning may be recognized as more significant in creating a commercial impression, she has omitted the emphasis on the word *may* included by the Board when discussing this very issue in *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987). "It should be noted that 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. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor (sight, sound or meaning) alone '*may* be sufficient to support a holding that the marks are confusingly similar.' *Trak Inc. v. Traq Inc.*, 212 USPQ 846, 850 (TTAB 981) (emphasis added)." *In re Lamson Oil Co., Id.* at 1043.

The Examining Attorney cites *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645 (TTAB 2010)[1] for the proposition that "[n]ot all *DuPont* factors, however, are necessarily relevant or of equal weight and any one of the factors may control in as given case, depending

[1] Interestingly, in the case cited by the Examining Attorney, *Citigroup Inc.,* the Board found no likelihood of confusion between the mark Capital City Bank Group and the various Citibank marks even though the services associated with each mark were identical.

on the evidence of record." It is not a foregone conclusion that if there is one similarity then the marks are confusingly similar. In fact, TMEP §1207.01(b) states: "[w]hen considering the similarity of the marks, '[a]ll relevant facts pertaining to the appearance and connotation must be considered.' *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)." Applicant maintains that "the relevant facts pertaining to the appearance and connotation" of these two marks has been skewed in this case.

Applicant agrees that one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant term in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."). *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Where Applicant and the Examining Attorney diverge is considering what the dominant portion of the mark is and whether there is a rational reason to ignore the PLASTICINE and design portions of Applicant's mark.

The Court in *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005) reiterated the hard and fast rule that one must consider the appearance, sound, connotation and commercial impression of each mark in determining a likelihood of confusion. Applicant submits that the differences in the marks, taken as a whole, render confusion unlikely. Evaluating the marks in their entirety reveals obvious differences in the marks. The total impression created by Applicant's mark is different from that created by the cited mark. When viewed in their entireties, as they must be, the marks and IMAGINE THE FUN are entirely different.

THE MARKS AT ISSUE ARE DIFFERENT IN SOUND, APPEARANCE AND COMMERCIAL IMPRESSION

Again, "[w]hen considering the similarity of the marks, '[a]ll relevant facts pertaining to the appearance and connotation must be considered.' *Recot, Inc. v. M.C. Becton*, 214 F.3d at 1329, 54 USPQ2d at 1897" TMEP§1207.01(b). Applicant maintains that the Examining Attorney did not consider all of these factors in finding a likelihood of confusion.

The Marks are Different in Sound

The marks and IMAGINE THE FUN do not remotely sound alike. When one says the words of the marks out loud, one hears PLA STI SEEN IM A GIN THE FUN versus IM A GIN THE FUN. Contrary to the Examining Attorney's emphasis on the words "imagine the fun" as similar enough to find a likelihood of confusion, the emphasis should have been on the distinctly different word PLASTICINE. The spoken PLASTICINE is enough to add a new and relevant dimension to the sound of the mark. When "imagine the fun" is spoken after the word PLASTICINE it is almost like an afterthought. The marks, *in their entireties,* just do not sound alike.

The Marks are Different in Appearance and Commercial Impression

Similarly, the marks and IMAGINE THE FUN do not look the same in the least. The only similarity between the marks is the phrase "Imagine the Fun". The cited mark is for the phrase simpliciter. Applicant's mark on the other hand, is a composite design mark dominated by its already registered product line mark, PLASTICINE, in multiple colors with thought bubbles on a red background. "It is well settled that marks must be considered in their entireties, not dissected or split into component parts and each part compared with the other parts." *Genesco Inc. v. Martz*, 66 USPQ2d 1260,1269 (TTAB 2003); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F. 2d 1005,1007, 212 USPQ 233 (C.C.P.A. 1981); *Sun-Fun Prods., Inc. v. Suntan Research &*

Dev. Inc., 656 F.2d 186, 213 USPQ 91 (5th Cir. 1981). Applicant does not contest that its mark contains the same phrase as the registered mark, but the visual appearance of the marks is undeniably different as evidenced by the following:

Registrant's Mark:	Applicant's Mark
IMAGINE THE FUN	

Applicant is not suggesting that a side-by-side comparison is determinative. Rather, Applicant asserts that a consumer, encountering both marks at different times would not recall one as associated with the other simply because the PLSTICINE and design features of Applicant's mark are the dominant and remembered portions of the mark.

The Examining Attorney contends that the word portion of a composite mark containing both words and a design is often considered the dominant feature of the mark and is accorded greater weight in the determination of likelihood of confusion. She propounds the notion that the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. However, in this case, Applicant's mark is dominated by its already registered product line mark, PLASTICINE. The "Imagine the fun!" phrase is a slogan coupled to Applicant's product line mark. It is highly unlikely that Applicant or any consumer will use the slogan independently.

Applicant again asserts that rather than examining the marks as a whole for visual similarities, the Examining Attorney improperly dissected the marks and focused solely on the words IMAGINE THE FUN stating that "IMAGINE THE FUN stands independently as a tagline in Applicant's mark, so that it is separable from the remainder of Applicant's mark and will stand alone in consumer's minds. This portion of the mark is identical to Applicant's full mark, and therefore creates the same commercial impression for the consuming public. Therefore, the marks are confusingly similar." Applicant maintains that this is precisely the sort of piecemeal comparison the courts reject. *See, China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1340

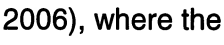
(Fed. Cir., 2007) ("The marks must be compared in their entirety, at least when the overall commercial impression is reasonably based on the entirety of the marks"). When comparing the visual similarity of the mark, an Examining Attorney must ask whether the overall appearance of the mark, when compared in its entirety, resembles that of the Registrant's mark.

Furthermore, as noted above, no element of a mark is ignored. It is the impression the mark as a whole creates on the ordinary prospective buyer and not the impression of the individual parts thereof. *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.* 834 F.2d 568 (6th Cir. 1987); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23.41, at 23-173(4th ed. 2006). Applicant's slogan and thought bubbles enhance the notion that when using the PLASTICINE craft and hobby kits products, a person can create anything that comes to his or her imagination. This mark is used on craft and hobby kits which by their very nature engage the user's imagination. By contrast, the cited mark lacks any development of the imagination or creativity theme. The overall commercial impression created by the marks is entirely different.

Applicant maintains that the tagline is not the dominant portion of the mark. The dominant portion of Applicant's mark is Plasticine. Also dominant is the overall design of the mark, including the red background and thought bubbles. This in fact is what the consumer will retain. The remainder of Applicant's mark is the laudatory, somewhat descriptive, and weak tagline "imagine the fun". What are the two things that are important in a good toy? First it must be fun and second, especially from a parent's perspective, it should stimulate imagination. This tagline is not the dominant portion of Applicant's mark. It is simply a tagline that enhances Applicant's already registered product line mark PLASTICINE. Clearly the cited mark is also a tagline used in conjunction with the Registrant's company name. It is not the name of the actual services. Again, it bolsters the Registrant's primary trademark, HEDSTROM.

In the March 5, 2014 Final Action, the Examining Attorney stated: "[t]aken as a whole, the marks are confusingly similar, despite their differences. This is because consumers seeing

the [ ] trademark are likely to believe that its use is related to use of the IMAGINE THE FUN trademark." This is not the case. When viewing Applicant's mark, IMAGINE THE FUN is not what sticks in the consumer's mind. What sticks in the consumer's mind is PLASTICINE and then the colorful nature of the mark on a red background – the overall look of the mark. Moreover, consumers are highly unlikely to call for a product by the phrase IMAGINE THE FUN. They would call for the product by the visually and aurally dominant word PLASTICINE.

Applicant has identified both precedential and non-precedential opinions by the Board in which the whole of a registrant's mark was included in an applicant's mark and the addition of a design feature served to distinguish the marks to the satisfaction of the Board. Among these is *In re Panasonic Corporation of North America,* Serial No. 78445277 (Trademark Trial and Appeal Board 2006), where the marks at issue were  and HIFI.COM, one being used in association with car audio speakers and the other being used with retail store and mail order services featuring audio electronic components. The Board in *In re Panasonic* opined that the addition of the Greek letter Phi was sufficient to create a different commercial impression stating:

> A potential consumer viewing applicant's mark will be drawn first to the "phi" symbol, displayed in large size and bold presentation, prior to noticing the wording. Even consumers unfamiliar with the Greek alphabet and thus unaware of the meaning of the "phi" symbol would be drawn to what they would perceive as a prominent design element in the center of the mark. As such, the Greek "phi" symbol is the dominant portion of applicant's mark, and its presence therein renders applicant's mark notably dissimilar from that of registrant in appearance.

In re Panasonic, at p. 11.

In *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), the Board acknowledged that the goods covered by the marks at issue were identical and the marks contained some of the same words, but it ultimately held that the two marks were simply too visually distinct from one another for a likelihood of confusion to occur. In that case the marks were RACEGIRL and

(two stylized Rs one spelling Redneck and the other spelling Racegirl). Moreover, the Board noted that since the associated products were clothing sold at retail, not unlike Applicant's, the visual appearance of the mark would be more important to a consumer. *Id.,* at 1168. Just as in *Covalinski*, the words Imagine the fun! are difficult to notice in Applicant's mark and are the portion of the mark that is impressed on the consumer.

The Board also cited a list of cases where the design feature of a mark was considered to be dominant not unlike the instant case. *Ferro Corp. v. Ronco Labs., Inc.,* 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966) (confusion was unlikely between applicant's mark and several marks owned by opposer consisting of or containing FERRO, due to the dominance of the design elements of applicant's mark and the relatively small typeface in which FERRO appeared); accord *Parfums de Coeur Ltd. v. Lazarus,* 83 USPQ2d 1012 (TTAB 2007) (prominently displayed design considered to be dominant element of the mark because it catches the eye and engages the viewer before the viewer looks at the word Bodyman"); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987) (no likelihood of confusion between for restaurant services and STEVE'S for ice cream; "Even with the word 'STEVE'S' appearing above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form.").

The proper test in determining likelihood of confusion must be based on the similarity or dissimilarity of the general overall impressions engendered by the individual marks. *See, Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). This test involves the recollection of the average purchaser, who normally retains a general, rather than a specific impression of the

many trademarks encountered throughout the day. The overall commercial impression of the mark is created by the purchaser's cursory reaction to the mark in the marketplace, not a painstaking dissection to determine possible legal differences or similarities. *See*, 4 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23.41.

The question to be asked is would a consumer see the marks and IMAGINE THE FUN as indicating the same source. The answer has to be no. This is where the "rational reason" referenced in *In re National Data Corp.* comes into play. Would consumers, when encountering Applicant's mark, rationally believe that a product is called IMAGINE THE FUN and that tangentially related services are offered under the name IMAGINE THE FUN? No. The reasonable consumer would see both of these for what they are – taglines associated with another product line or service provider. As Justice McGivern so eloquently stated in *Pocket Books, Inc., et al. v. Dell Publishing Co., Inc.,* 149 USPQ 466 (N.Y. Sup. Ct. 1966), "there simply must be some limits to the claimed asininity of the buying public." The test is likelihood of confusion, not possibility of confusion.

THE GOODS AND SERVICES AND THEIR CHANNELS OF TRADE ARE NOT RELATED ENOUGH TO FIND A LIKELIHOOD OF CONFUSION

The goods and services at issue are plainly different. Applicant's goods are simply arts and crafts kits, hobby kits, and the various components of those kits. The services associated with the cited marks are retail services through direct solicitation by salespersons directed to end-users featuring toys, balls and toy sports equipment. It is important to note that these services are not defined simply as retail store services featuring toys, balls and toy sports equipment or on-line retail store services featuring toys, balls and toy sports equipment. These services are very narrowly defined as direct solicitation sales.

The Examining Attorney rests a significant portion of her argument on the contention that because there are prior registrations which contain both toys and retail services for toys the consumer is likely to believe that the products emanate from the same source because the marks are so similar. The registration supplied by the Examining Attorney failed to adequately prove that contention. The Board, in a precedential decision, has called into question the probative value of such evidence. In *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010) the Board stated, " While third-party registrations can play an important role in establishing that the types of goods at issue are related, examining attorneys must review the registrations carefully to ensure that each registration presented is probative and that the number of registrations is sufficient, along with other types of evidence, to establish that the types of goods at issue are related." *Id.,* at 1511. With over 1.7 million live registrations on the Principal Register one is bound to find a few, even several, registration that cover both Applicant's goods and the Registrant's services. Applicant noted that one of the registrations attached by the Examining Attorney covered 15 different classes of goods, two covered eight classes, two covered five classes and only one covered four classes. This hardly indicates that consumers would believe that the goods and services emanate from the same source.

The Examining Attorney also noted that case law has held that "the use of similar marks on or in connection with both products and retail store services ...[is] likely to cause confusion where the evidence showed that the retail store services featured the same kinds of products" and as evidence attached printouts of four websites. Three websites were for companies selling their own products and one website was for a toy store selling several brands. In a global retail community, three internet sites selling toys does not clearly indicate that the marks in this specific case would be likely to be confused.

In the final refusal issued March 5, 2014, the Examining Attorney claimed that "companies that sell their products via direct solicitation often sell their goods via other means" and proffered internet sites as evidence that entities sell their products both online and in brick

and mortar stores (although there was no discussion of direct solicitation sales). The Examining Attorney went on to note that even the Registrant had sales both on-line and in third party stores. What the Examining Attorney overlooked here was that the evidence she attached regarding the Registrant, did not contain the trademark at issue; some of the websites were from other countries; and some were for big box stores selling everything from potty chairs and cribs to sports equipment. Two attachments from www.latticeandivy.com and www.avon.com had no connection with the goods and services at issue in any way.

The Examining Attorney stated in her March 5, 2014 final refusal " the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use." She then asserted that because the word "toys" was used in the recitation of services in the cited registration "to describe the goods sold via its retail services ... this wording is presumed to encompass all goods and/or services of the type described in Applicant's narrow identification." Applicant believes that the Examining Attorney has made a leap in reasoning and, in fact, is comparing apples to oranges.

First, we are instructed to compare the identification of goods and services in the application and cited registration as they are written. For simplicity sake, Applicant's goods are arts and crafts and hobby kits. The services in the cited registration are **retail services through direct solicitation by salespersons** directed to end-users featuring toys, balls and toy sports equipment. Direct solicitations are very specific types of sales and are in fact regulated by state laws. They are solicitations of consumer transactions that are initiated by the seller at the residence or place of employment of a consumer. There is no evidence proffered that entities which engage in direct sales solicitations also have retail stores and on-line retail sites or that a consumer would expect to find direct solicitation sellers with on-line or bricks and mortar stores. Direct solicitation sales are very different from traditional retail. In fact, most states have regulated this type of commerce. To suggest that because the Registrant engages in both

online sales and sales through third party retailers – with no evidence of the use of the mark in this way is extrinsic evidence that the Examining Attorney says Applicant may not use. It has nothing to do with the reality of the respective identifications of goods and services in the application and registration at issue. There comes a point when conjecture departs from the reality of the situation being assessed.

In the July 8, 2013 office action, the Examining Attorney cited three cases for the proposition that the use of similar goods on or in connection with both products and retail store services have been held likely to cause confusion where the evidence showed that the retail-store services featured the same type of products. As stated above, by the Board, and by the Examining Attorney, likelihood of confusion determinations are made on a case-by-case basis. The cases cited by the Examining Attorney simply prove that just because the issue was a particular way in one case does not mean that the decision is appropriate in this case. In *In re Thomas,* 79 USPQ2d 1021 (TTAB 2006), the marks were BLACK MARKET MINERALS and MARCHE NOIR. Marche Noir translates to Black Market. The difference was a descriptive word. In *In re Peebles, Inc.,* 23 USPQ2d 1795(TTAB1992), the marks were MOUNTAIN HIGH and MOUNTAINHIGH. In *In re U.S. Shoe Corp.* 8 USPQ2d 1938 (TTAB 1988) the marks were the name J. Chisholm in different fonts. In these last two cases, the marks weren't "nearly identical" as the Examining Attorney describes them. They were identical and they were the entire mark.

In the instant case the marks are

and IMAGINE THE FUN. The marks are different – not by a translation of the identical words in different languages or the addition of one descriptive word at the end of the mark but rather by the already registered, very distinctive word PLASTICINE and the very obvious design features.

Finally, in the September 23, 2014 denial of Applicant's request for reconsideration, the Examining attorney made the statement:

> However, the entirety of registrant's mark is incorporated into Applicant's mark in a way that it is a separable element of Applicant's mark and stands alone, despite the

> additional wording and the design element. It is common for companies to use a slogan with a brand name, as well as the same slogan independently without their brand name. Because slogans are able to stand alone as a trademark, consumers could assume that the parties using the same slogan for related goods or services are related to one another.

The Examining Attorney went on to cite three non-precedential cases for the proposition that slogans can be separated from the mark and are what are remembered by the consumer. Again, the decision of a likelihood of confusion in these cases cannot be made based on a hard and fast rule that slogans can be separated from the mark and used alone therefore there is a likelihood of confusion. The determination of a likelihood of confusion when composite marks are involved must be made on a case by case basis, weighing all of the relevant factors.

CONCLUSION

The only remaining issue preventing registration of Applicant's mark relates to the alleged likelihood of confusion with the prior registration for IMAGINE THE FUN. When considered in its entirety, the mark conveys a different overall impression from the IMAGINE THE FUN mark. The two marks are entirely different in sound, appearance and meaning and present an entirely different commercial impression. Moreover, Applicant's PLASTICINE branded products and their channels of trade are not sufficiently related to the retail services through direct solicitation by salespersons for which the cited mark is registered.

Thus, Applicant submits that there is no likelihood of confusion between the marks.

Applicant respectfully request that the Board reverse the Examining Attorney's refusal under Section 2(d) and permit registration of the mark on the Principal Register.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing *Brief for Applicant* has been filed electronically on June 11, 2015.

Colleen Flynn Goss

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CERTIFICATE OF RESUBMISSION

I hereby certify that the foregoing *Brief for Applicant* has been resubmitted electronically on July 29, 2015.

Colleen Flynn Goss

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