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BKYZ500208US - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 79130383

**MARK:** PLASTICINE IMAGINE THE FUN!



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Flair Leisure Products Plc

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

BKYZ500208US

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTERNATIONAL REGISTRATION NO. 1160877**

Applicant has appealed the trademark examining attorney's final refusal to register the mark PLASTICINE IMAGINE THE FUN! & Design, under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d),

on the grounds that applicant's mark, when used on or in connection with applicant's goods, so resembles the mark in U.S. Registration No. 4272346, IMAGINE THE FUN as to cause confusion, mistake, or deceive consumers as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d).

## I. FACTS

On June 6, 2013, applicant, Flair Leisure Products Plc, filed an application to register the mark PLASTICINE IMAGINE THE FUN! & Design on the Principal Register for use with *Hand tools and hand implements; all for use in modelling and in working modelling material*, in Class 08; *Paper, paper articles and cardboard articles all included in this class; printed matter, books, stationery, artists' materials; paint brushes; modelling clay; instructional and teaching materials (other than apparatus)*, in Class 16; and *Toys, games and playthings; modelling sets, being toys*, in Class 28.

On July 8, 2013, the examining attorney refused registration of the proposed mark under Section 2(d) of the Trademark Act, on the grounds that applicant's mark, when used on or in connection with applicant's goods, so resembled the mark in U.S. Registration No. 4272346, IMAGINE THE FUN, for use with *Retail services through direct solicitation by salespersons directed to end-users featuring toys, balls and toy sports equipment*, in Class 35, as to be likely to cause confusion as to the source of the respective goods. Additionally, applicant was required to amend the identification of goods, provide a description of the mark, and submit a claim of prior registration.

On January 8, 2014, applicant responded to the Office action and provided arguments against the refusal pursuant to Section 2(d) of the Trademark Act. Additionally, applicant amended the identification of goods, provided a mark description, and submitted a claim of prior registration.

On March 5, 2014, the examining attorney issued a final refusal under Section 2(d) in regard to U.S. Registration No. 4272346, in which applicant's arguments were addressed and the arguments concerning the sound, appearance, connotation and commercial impressions of the respective marks being very similar and that the respective marks are used on related goods and services were reiterated. In addition, the examining attorney made final the requirements for an amended identification of goods and mark description.

On September 5, 2014, applicant simultaneously filed an appeal with the Trademark Trial and Appeal Board ("the Board") and a Request for Reconsideration asking the examining attorney to reconsider the Section 2(d) refusal and other outstanding issues. This Request addressed the issues regarding the identification of goods and mark description, but was denied by the examining attorney as to the Section 2(d) refusal on September 23, 2014.

Applicant filed repeated requests for extensions of time to file its brief, on the grounds that it was seeking a consent agreement with the cited registrant. On June 11, 2015, applicant filed its appeal brief with the Board.

On June 16, 2015 the case was forwarded to the examining attorney for a brief in accordance with Trademark Rule 2.42(b).

## II. ISSUE

The sole issue on appeal is whether there is a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), between applicant's mark PLASTICINE IMAGINE THE FUN! & Design for use with *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 08; *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; and registrant's prior-registered mark IMAGINE THE FUN for use with Retail services through direct solicitation by salespersons directed to end-users featuring toys, balls and toy sports equipment, in Class 35.*

### III. ARGUMENT

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

#### A. The Applied-for Mark is Very Similar to the Registered Mark

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

When comparing marks, the test is not whether the marks can be distinguished in 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 goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Furthermore, marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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.”)).

Finally, marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91

(TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

In the present case, applicant's mark is PLASTICINE IMAGINE THE FUN! & Design and registrant's mark is IMAGINE THE FUN. Applicant's mark is configured such that it gives the commercial impression of being applicant's brand name and a slogan used by the brand, whereas registrant's mark gives the impression of being a slogan. Consumers seeing related goods and services being offered under the same slogan, as IMAGINE THE FUN appears in these two marks, are likely to believe that the goods and services are being offered by the same, or related, entities.

Applicant focuses its arguments largely on the examining attorney's purported argument that IMAGINE THE FUN is the dominant element of applicant's mark. This misstates the examining attorney's position. Rather, the refusal rests on the use of this phrase as a separable element of applicant's mark, namely, a slogan associated with the brand name. As noted above, marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression.

The applicant then argues that the differences in the mark are sufficient to overcome any similarity. In response to the same, the examining attorney notes that this is not an impermissible dissection of the mark, but rather an appropriate consideration of the overall commercial impression of the mark. First, regarding the addition of the PLASTICINE wording, the addition of applicant's house mark only strengthens the impression that applicant's mark in its entirety is confusingly similar to the registered mark. Adding a house mark to an otherwise confusingly similar mark will not obviate a

likelihood of confusion under Section 2(d). See *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR and CACHET confusingly similar); TMEP §1207.01(b)(iii). It is likely that goods and/or services sold under these marks would be attributed to the same source. See *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007). In this case, applicant's mark incorporates the entirety of the registered mark. The only difference in the wording between registrant's IMAGINE THE FUN mark and applicant's PLASTICINE IMAGINE THE FUN! & Design mark is the addition of applicant's house mark. The addition of this house mark does distinguish the marks, but rather makes it more likely that consumers will believe there to be an association between the goods and services sold under the marks.

Regarding the design element in applicant's mark, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii). In addition, because registrant's mark is in standard characters, it is entitled to a broad scope of protection.

Finally, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element 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 Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument

concerning a difference in type style is not viable where one party asserts rights in no particular display”). For the foregoing reasons, applicant’s arguments regarding the distinct stylization in applicant’s mark are unpersuasive.

Accordingly, for the foregoing reasons, the additional elements in applicant’s mark are not sufficient to overcome the fact that the two marks are confusingly similar.

Applicant then argues, “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.” However, this argument ignores the trademark significance of slogans and taglines, which often stand independently as a source indicator. Indeed, this is exactly their purpose as trademarks, and exactly why registrant has registered this wording as a standalone phrase without its brand name. The IMAGINE THE FUN wording identifies registrant’s retail store services, just as the phrases JUST DO IT, THE HAPPIEST PLACE ON EARTH, LET YOUR FINGERS DO THE WALKING, BREAKFAST OF CHAMPIONS, and numerous others, identify the source of particular goods and services, even when used separately from the relevant brand names.

Although not precedential, the TTAB has recently found that marks are confusingly similar where a brand name is paired with a previously registered slogan, even where there are slight variances in the slogans. *See, e.g., Pita Jungle -- Tempe, Inc. v. Pita Pal Foods, LP*, 2014 TTAB LEXIS 307 (Trademark Trial & App. Bd. July 24, 2014) (finding PITA PAL THE ART OF HEALTHY EATING & Design confusingly similar to THE ART OF EATING HEALTHY, noting that “More importantly, Applicant’s slogan THE ART OF HEALTHY EATING is separable and distinct from PITA PAL and the star design, as it appears on a different line than PITA PAL and the star and is a unitary phrase.”); *In re Keystone Homes, Inc.*, 2009 TTAB LEXIS 38 (Trademark Trial & App. Bd. Jan. 21, 2009) (upholding a refusal to register the mark KEYSTONE DREAM. BUILD. LIVE. & Design based on a likelihood of confusion with the mark DREAM. BUILD. LIVE.); *In re*

*Westmed Med. Group, P.C.*, 2013 TTAB LEXIS 84 (Trademark Trial & App. Bd. Feb. 20, 2013) (affirming a refusal to register the mark THE FUTURE OF HEALTHCARE TODAY under Trademark Act Section 2(d) based on a prior registration for THE SMART MED CARD THE FUTURE OF HEALTHCARE TODAY! & Design).

Applicant then argues that registrant's IMAGINE THE FUN trademark is weak because it is laudatory and somewhat descriptive. However, this is an inaccurate assessment of the mark's strength from a trademark perspective. Indeed, this wording is not treated as descriptive as it does not describe the relevant goods and services, nor does it contain laudatory wording. Further, the registrant's mark is the only registered mark on the Register that includes this wording. For the foregoing reasons, IMAGINE THE FUN is not a weak trademark and is entitled to a full scope of protection.

Applicant concludes its arguments by noting that "The reasonable consumer would see both of these marks for what they are—taglines associated with another product line or service provider." The examining attorney notes that while there is additional wording in applicant's mark to indicate to its own source, there is no such wording in the registered mark. Because this wording stands alone, it is entitled to protection as an independent phrase, just as it is registered. Indeed, applicant's argument supports the examining attorney's contention that the way in which consumers are accustomed to seeing taglines and slogans as independent trademarks associated with brands supports the finding that the PLASTICINE IMAGINE THE FUN & Design and IMAGINE THE FUN marks would be perceived by consumers similarly.

In sum, the additional elements in applicant's mark do not mitigate the fact that the marks, viewed independently, both create the impression of a toy company selling its goods under the IMAGINE THE FUN slogan. Therefore, the marks are confusingly similar.

**B. The Goods and Services with Which the Marks are Used are Highly Related**

Applicant has described its goods as “arts and crafts kits, hobby kits, and the various components of those kits.” Registrant offers retail services through direct solicitation by salespersons directed to end-users featuring toys, balls and toy sports equipment.

First, the examining attorney notes that, as cited in *In re Office Furniture Concierge, LLC*, 2013 TTAB LEXIS 39 at \*4 (TTAB Jan. 16, 2013), “it has often been recognized that likelihood of confusion may arise where confusingly similar marks are used on goods, on the one hand, and in connection with sales of such goods, on the other.” Citing *In re Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2006); J. Thomas McCarthy, *Trademarks and Unfair Competition* (4th ed.) § 24:25. In *In re Office Furniture Concierge, LLC*, the TTAB found that retail store services by direct solicitation by sales agent in the field of office furniture is related to furniture, noting, “‘trademarks for goods find their principal use in connection with selling the goods’ and accordingly marks for goods and marks for the service of selling such goods will have their impact on the purchasing public in the same marketplace.” *Id.* at \*4, citing *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

In light of the same, the examining attorney notes that the registrant offers sales services in the field of toys, which encompass applicant’s “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” and are related to the additional goods, which are the components of these kits, as set forth by applicant. Furthermore, as noted by applicant in its brief, the remaining goods in the application are the components of these kits, listed separately. Therefore, applicant’s goods are encompassed within the goods sold by registrant and the goods and services are therefore related.

Evidence in the record includes the following:

- Screenshots from the Melissa & Doug website showing that this company makes and sells a variety of toys, including hobby kits featuring clay, tools, and molds, and additional craft materials, all sold under the same mark;
- Screenshots from the Galt website showing that the company makes and sells modelling clay and other arts and crafts items, as well as active play toys under the same mark;
- Screenshots from the Alex Toys website showing that the company makes and sells modelling kits including clay, tools, and molds, and other arts and crafts items, as well as branded toys for active play, including balls, all under the same mark;
- Screenshots from The Entertainer toy shop's website, showing that they sell clay and clay kits, as well as various other types of toys, including balls and active toys;
- Screenshots from The Toy Village Shop website, offering modeling clay kits and a variety of other toys;
- Screenshots from the Fat Brain Toys website showing retail store services featuring toys, including balls and sporting goods, as well as clay, molding and sculpting kits, which include modelling clay, molds, and tools, among others;
- Screenshots from the Go Bananas toy store website, showing that the store offers arts and crafts items, including clay kits, as well as goods for active and outdoor play, including balls and sporting items; and
- Screenshots from the Ambassador Toys website showing the store offers arts and crafts items, including clay kits, as well as goods for active and outdoor play, including balls and sporting items.

This evidence establishes that the same entity commonly manufactures/produces/provides the relevant goods and services and markets them under the same mark, as well as that the relevant goods are sold via toy stores. Therefore, applicant's and registrant's goods and/or services are considered related for

likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at [http://www.ntia.doc.gov/files/ntia/publications/exploring\\_the\\_digital\\_nation\\_-\\_americas\\_emerging\\_online\\_experience.pdf](http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf)). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

Applicant argues that "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." However, the examining attorney attached evidence of various parties that sell their goods via both direct sale solicitations and traditional retail means. These included the applicant, Avon, Tupperware, and Lattice and Ivy. Furthermore, as noted previously, the TTAB has found that direct solicitation sales are the equivalent of traditional retail means

and a likelihood of confusion may exist in cases where one party offers goods and the other party offers direct solicitation sales of those goods.

For the foregoing reasons, applicant's arguments have been found unpersuasive and applicant's goods are related to registrant's services.

#### **IV. CONCLUSION**

For the foregoing reasons, consumers are likely to confuse the source of applicant's goods with the source of registrant's services, upon encountering them in the marketplace. Resultantly, the refusal to register applicant's mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), should be affirmed.

Respectfully submitted,

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