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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79144067

MARK: RING GO



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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: Vitakraft-Werke Wührmann & Sohn GmbH & C
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CORRESPONDENT'S REFERENCE/DOCKET NO:

VK5438US (#9)

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1195772

Applicant has appealed the trademark examining attorney's final refusal to register the trademark RING GO in standard character form. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that the applicant's mark, when used in

connection with the identified goods in International Class 18, “dog leashes; dog collars; harness for animals,” so resembles the mark shown in U.S. Registration No. 4585793, RINGO, for “pet toys” in International Class 28, as to likely to cause confusion, to cause mistake, or to deceive.

FACTS

On December 18, 2013, the applicant, Vitakraft-Werke Wührmann & Sohn, filed a Section 66(a) Request for Extension of Protection seeking registration of the mark RING GO in standard character form for “dog leashes; dog collars; harness for animals.”

On April 3, 2014, an initial Office Action was issued indicating a potential likelihood of confusion with a prior pending Application Serial No. 85223979, as well as a requirement to specify applicant’s entity and place of organization. Applicant submitted a Response to Office Action on September 29, 2014, arguing against the potential conflict with the prior pending application and satisfying the requirement to specify its entity and place of organization.

In a subsequent non-final Office Action dated October 29, 2014, the applied-for mark was refused registration under Section 2(d) of the Trademark Act regarding U.S. Registration. No. 4585793, which resulted from Application Serial No. 85223979. The application was reassigned to examining attorney Seth A. Rappaport on November 7, 2014. Applicant responded to the Office Action on March 16, 2015, arguing against the Section 2(d) refusal.

On March 18, 2015, a Final Office Action was issued pursuant to Section 2(d) of the Trademark Act. The applicant filed a Notice of Appeal on September 15, 2015, and filed a brief on July 5, 2016. The file was then reassigned to the undersigned examining attorney.

ISSUE

Whether the applied-for mark RING GO, when used in connection with the identified goods, so resembles the mark shown in U.S. Registration No. 4585793 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d). *See* 15 U.S.C. §1052(d).

ARGUMENT

THE MARK OF THE APPLICANT IS CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, MEANING AND OVERALL COMMERCIAL IMPRESSION TO REGISTRANT'S MARK AND THE GOODS OF BOTH MARKS ARE CLOSELY RELATED CREATING A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis using 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). In this case, the following *du Pont* factors are most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01 *et seq.* The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion between marks. It is not necessary to show actual

confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). In the present case, applicant's mark RING GO and registrant's mark RINGO are confusingly similar, and the goods are closely related and sold in the same channels of trade.

The Marks are Confusingly Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

Here, the marks RING GO and RINGO are similar in appearance and will sound identical when pronounced.

The marks are also similar in appearance in that the slight differences between the marks, a space between RING and GO and an additional letter "G," do not significantly distinguish the marks. Both marks begin with RING and end with GO. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto*

Prods., Inc. v. Nice-Pak Prods., Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Moreover, 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 *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); TMEP §1207.01(b)(ii)-(iii).

In addition, applicant’s mark and registrant’s mark may sound identical when pronounced. Though there is a space between the terms RING and GO in applicant’s mark, consumers could naturally pronounce RING GO in the same way as registrant’s mark, RINGO, with no spaces. The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Applicant argues that registrant’s mark is not simply a telescoped version of applicant’s own mark and, as such, conveys a different meaning. Applicant argues that RINGO conveys to consumers the name of Ringo Starr, the owner of the cited registration, and applicant’s mark RING GO does not convey this meaning because applicant’s mark is a combination of two different and distinct words with well-known meanings. In addition, applicant argues that in the context of applicant’s goods, a round extendable dog leash, (Response to Office Action, 9/29/2014, pp.24-32) the mark RING GO has a different meaning and commercial impression to consumers than the registrant’s mark RINGO that is a first name. In support of this, applicant points to registrant’s specimen of record (Response to Office Action, 9/29/2014, pp. 22-23) that indicates that certain toy items of registrant are in the image of Ringo Starr, and thus, in context of registrant’s goods, RINGO conveys to consumers the name of Ringo Starr.

However, there is no evidence on the record that the registrant's relevant goods of "pet toys" are or will be in the image of or show a specific association with Ringo Starr. Furthermore, the connotation and commercial impression of RING GO and RINGO remain similar because the marks are so similar, either mark could be mistaken for the mark of the other. Specifically, RING GO could be perceived as a reference to Mr. Starr and RINGO could be perceived as a reference to the shape of applicant's goods. Generally, when considering the potential confusion of purchasers, the proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). In the case, the commercial impression of the marks is very similar.

In the case, the commercial impression of the marks is very similar.

Applicant also argues that the marks are not confusingly similar because they may sound different when pronounced. The applicant states that RINGO is a single flowing word, and RING GO has a clear break or pause due to the space between the terms. However, there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); TMEP §1207.01(b)(iv). Here, the marks in question could clearly be pronounced the same; however, even if the applicant were correct, the difference between the marks pronunciation would be *de minimus* because of the hard "g" sound at the end of the word "ring" and at the beginning of the word "go."

Finally, applicant argues that a likelihood of confusion does not exist in this case because of the existence of several other RINGO marks on the Trademark Register coexisting with registrant's mark RINGO used in connection with wide variety of consumers products. However, the existence on the register of other seemingly similar marks does not provide a basis for registrability for

the applied-for mark. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). For example, the following marks were referenced by applicant, but these marks contain additional wording and design elements, and are for goods and services unrelated to applicant's and registrant's goods.

- RINGO UNIVERSAL MOUNTING SYSTEM, with a design element, U.S. Reg. No. 4027712, for Class 6 items including "Common metals and their alloys; metal building materials;" Class 9 including "Audio, video and data processing equipment;" and Class 20 including "Furniture for storing and placing and storing audio, video and data processing equipment."
- RINGO MAXX, U.S. Reg. No. 4260509, for Class 5 "Dietary and nutritional supplements."
- JOHNNY RINGO, U.S. Reg. No. 416662 for Class 25 "Footwear."
- RINGOCAP, with a design element, U.S. Reg. No. 3686369, for Class 20, "Synthetic cork caps for wine and champagne bottles."
- RINGO'S DONUTS, U.S. Reg. No. 3827248, for Class 30 "Donuts."
- RINGO HEAD, U.S. Reg. No. 3728047, for Class 9 including "Video camera supports and stabilizers."
- RINGO, U.S. Reg. No. 4748873, for Class 30 "Biscuits; cookies"
- RINGO, U.S. Reg. No. 3489710 for Class 28 "Lottery tickets."
- RINGO, U.S. Reg. No. 1889314 for Class 25 including "Men's, women's, and children's clothing."

In sum, given that the marks are very similar with respect to sound and appearance, as well as in commercial impression, RING GO and RINGO are confusingly similar and are likely to cause confusion under Section 2(d) of the Trademark Act.

The Goods Are Closely Related And Are Found In The Same Trade Channels

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”). The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

As noted above, applicant has applied for the following goods: “dog leashes; dog collars; harness for animals.” Registrant’s relevant goods are: “pet toys.”

In the final Office Action dated March 18, 2015, evidence was attached consisting of websites showing entities that provide applicant’s and registrant’s goods. This evidence demonstrates that the same entities commonly provide dog leashes, dog collars, animal harnesses and pet toys under the same mark, and further, that the relevant goods are commonly sold or provided through the same trade channels and used by the same classes of consumers. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009). This evidence includes the following examples:

- The evidence from Planet Dog.com shows various pet toys, as well as dog collars and dog leashes, being offered to the public under the same mark/sold together in the same market place. (Office Action, 4/1/2014, TSDR pp. 5-6)
- The evidence from Petsafe.net shows dog collars, animal harnesses, and pet toys being offered to the public under the same mark/sold together in the same market place. (Office Action, 4/1/2014, TSDR pp. 7-10)
- The evidence from Barneys.com shows dog collars, harnesses, and chew toys being offered to the public under the same mark. (Office Action, 4/1/2014, TSDR pp. 11-17)
- The evidence from Berganpet.com shows leashes, harnesses and cat toys being offered to the public under the same mark/sold together in the same market place. (Office Action, 4/1/2014, TSDR pp. 17-22)
- The evidence from Petsmart.com shows pet toys, collars, harnesses and leashes being offered to the public sold together in the same market place. (Final Office Action, 3/18/2015, TSDR pp. 78-84)
- The evidence from Thebarkerybistro.com shows leashes, harnesses, and pet toys being offered to the public under the same mark/sold together in the same market place. (Final Office Action, 3/18/2015, TSDR pp. 85-86)

This evidence and the remaining evidence of record makes it clear that applicant's and registrant's goods should be considered related for likelihood of confusion purposes. Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods 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). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

In addition, the March 18, 2015 final action included evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection pet toys, dog leashes, dog collars, and animal harnesses, thus showing that these goods are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii). The following are examples of this evidence:

- YOUR PETS, OUR PASSION (U.S. Registration No. 2905311) for “**pet collars, pet leashes, pet harnesses** and pet clothing” and “**pet toys.**” (Final Office Action, 3/18/2015, TSDR pp. 5-7)
- MARTHA STEWART PETS (U.S. Registration No. 4190977) for “**collars for pets; collars for pets bearing medical information; electronic pet collars; pet harnesses; pet leashes; pet leads**” and “**Pet toys; pet toys containing catnip; pet toys made of rope.**” (Final Office Action, 3/18/2015, TSDR pp. 14-18)
- PLANET PETCO (U.S. Registration No. 4258029) for “pet accessories, namely, **collars, leashes, harnesses** and carriers” and “**pet toys.**” (Final Office Action, 3/18/2015, TSDR pp. 19-21)
- WAG & BONE (U.S. Registration No.3765416) for “**collars for pets; garments for pets; pet clothing; leashes for pets; harnesses for pets**” and “**pet toys.**” (Final Office Action, 3/18/2015, TSDR pp. 22-24)

- PREMIER (U.S. Registration No. 3004506) for “**pet collars, pet leashes, pet harnesses**, and pet clothing” and “**pet toys.**” (Final Office Action, 3/18/2015, TSDR pp. 25-27)
- ZOOM ROOM (U.S. Registration No. 3889846) for “**Collars for pets**; Dog apparel; Dog clothing; **Dog collars; Dog collars and leads; Dog leashes**; Garments for pets; Pet accessories, namely, canvas, vinyl and leather pouches for holding disposable bags to place pet waste in; Pet collar accessories, namely, bells, silencers, safety lights and blinkers, pendants and charms; **Pet products, namely, pet restraining devices consisting of leashes, collars, harnesses, restraining straps, and leashes with locking devices**; Pet tags specially adapted for attaching to pet leashes or collars” and “**Dog toys**; Exercise balls; Exercise equipment, namely, inflatable balls; Paper party hats; Pet toys; Pet toys made of rope; **Toys for domestic pets.**” (Final Office Action, 3/18/2015, TSDR pp. 28-31)

Regarding the relatedness of the goods, the applicant argues that the goods it is providing has no connection to Ringo Starr. The applicant states that the goods of the applicant and registrant would not be encountered by the same people in the marketplace because the cited registration “would likely be sold to, marketed to, and purchased by fans and enthusiasts of Ringo Starr and/or The Beatles,” and that applicant’s goods will be sold and marketed to general pet owners. As noted above, likelihood of confusion is determined based on the identification of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Absent restrictions in an application and/or registration, the identified goods are presumed to encompass all goods of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Registrant has not limited the channels of trade in any manner, and there is nothing in the registration

that would restrict the use of the mark or promote an association with any particular individual, Ringo Starr or otherwise. Therefore, since the identification of the application and registration have no restrictions as to nature, type, channels of trade, or classes of purchasers, it is presumed that these goods encompass all types of goods described and that these goods travel in all normal trade channels available to the same classes of consumers. Applicant's assumption about the purchasers of the registrant's goods is not supported by anything in registrant's registration or any evidence of record.

Moreover, applicant provides no evidence indicating that the goods of applicant and registrant are not related and do not travel in the same trade channels.

Thus, because of the similarity of the marks, when consumers encounter applicant's mark RING GO used in connection with "dog leashes; dog collars; harness for animals," and registrant's mark RINGO used in connection with "pet toys," they are likely to be confused and mistakenly believe that these closely related goods originate from a common source. In addition, 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). As such, registration should be refused under Section 2(d) of the Trademark Act.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), should be affirmed.

Respectfully submitted,

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