

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79156012
LAW OFFICE ASSIGNED	LAW OFFICE 105
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/79156012/large
LITERAL ELEMENT	GUMBIES
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1742654195-20160401232107317870 . Gumbies Response to FinalOA1.pdf
CONVERTED PDF FILE(S) (15 pages)	\\TICRS\EXPORT16\IMAGEOUT16\791\560\79156012\xml12\RFR0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Applicant's .pdf document of the Response to the Final Office Action; Request for Reconsideration
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Robert A. Iussa/

SIGNATORY'S NAME	Robert A. Iussa
SIGNATORY'S POSITION	Attorney of Record, Arizona Bar Member
SIGNATORY'S PHONE NUMBER	480.390.9835
DATE SIGNED	04/01/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Apr 01 23:32:52 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XX.XX.XXX-2 0160401233252253315-79156 012-5504ee137637040c4975a 2ae51a2605a685f76f64a7438 d7c8f69af721104f3c3b-N/A- N/A-20160401232107317870

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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79156012** GUMBIES(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/79156012/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of Applicant's .pdf document of the Response to the Final Office Action; Request for Reconsideration has been attached.

Original PDF file:

[evi_1742654195-20160401232107317870_..Gumbies_Response_to_FinalOA1.pdf](#)

Converted PDF file(s) (15 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

[Evidence-15](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Robert A. Iussa/ Date: 04/01/2016

Signatory's Name: Robert A. Iussa

Signatory's Position: Attorney of Record, Arizona Bar Member

Signatory's Phone Number: 480.390.9835

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79156012

Internet Transmission Date: Fri Apr 01 23:32:52 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XX.XXX-2016040123325225

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK

Applicant:	Michel Roger Maurer	Prev Docket No.:	22001-5001
Serial No.:	79/156,012	New Docket No.:	10400.0100
Filing Date:	October 7, 2014	Examiner:	Evelyn Bradley
Mark:	GUMBIES	Law Office:	105

RESPONSE TO OFFICE ACTION

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

In response to the Office Action dated October 1, 2015, Applicant submits the following response.

RESPONSE

In the Office Action of October 1, 2015 a single issue was raised. The application was refused based on a likelihood of confusion with other registered marks, namely, registration numbers 1399537 and 1573482 both for the mark "GUMBY".

Likelihood of Confusion

The Examining Attorney refuses to allow registration of Applicant's mark GUMBIES based upon a likelihood of confusion with the above reference registered marks for GUMBY. The Examining Attorney asserts that the relevant *du Pont* factors¹ in this case that weigh against the applicant are: the similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. Applicant respectfully disagrees and, while the above *du Pont* factors are given great weight, an analysis below of the relevant *du Pont*

¹ In re E. I. du Pont de Nemours & Co., the U.S. Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)

factors, when balanced and considered, even in a light most favorable to the Registrant, nonetheless equates to a de minimus likelihood of confusion between the marks. Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 1361-62, 177 USPQ at 567-68; see also *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered.”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). Furthermore, the significance of a particular factor may differ from case to case. See *du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533 (noting that “any one of the factors may control a particular case”).

1. The similarity of the marks.

The Examining Attorney notes that in a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); TMEP §1207.01. Moreover, the Examining Attorney notes that similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b). However, Applicant asserts in analyzing the sight, sound, meaning, etc., one must look to the overall impression created by the marks and not merely compare individual features. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987). The important concept in the determination is the overall commercial impression generated and whether such a commercial impression by the marks would be confusing to consumers. See, *Long John Distilleries, Ltd. v. Sazerac*, 426 F.2d 1406, 166 USPQ 30 (C.C.P.A. 1970) (LONG JOHN v. FRIAR JOHN; no confusion where marks have a common portion but convey different commercial impressions and are dissimilar in appearance, sound, connotation).

Applicant also wishes to emphasize that under *du Pont*, “...the ultimate question of likelihood of consumer confusion has been termed a question of fact. If labeled a mixed question or one of law, it is necessarily drawn from the probative facts in evidence. [E]ach case must be decided on its own facts. There is not litmus rule, which can provide a ready guide in all

cases...” Id. at 1361, 177 USPQ at 567 (Emphasis added) “Likelihood of confusion under section 2(d) is determined from the probative facts in evidence.” *In re Martin’s Famous Pastry Shoppe, Inc.*, 223 USPQ 1289, 1289 (Fed. Cir. 1984). Here, the evidence will show and Applicant will demonstrate that the facts before the USPTO in this matter sufficiently rebut the USPTO’s likelihood of confusion determination.

Sight, Sound and Connotation

The USPTO asserts that Applicant’s GUMBIES mark is merely a plural form of the Registrant’s GUMBY mark. Applicant disagrees, while technically and grammatically correct, the USPTO is not quite on point as it relates to these particular circumstances and unique fact situation. GUMBY is a vintage claymation character popularized by a children’s television show back in the ’50’s and ’60’s, and saw a resurgence in popularity in the ’80’s based upon a Saturday Night Live parody skit². GUMBY is a singular character and there is no such thing as multiple “GUMBIES”. Unlike other children’s characters that could comprise singular and plural elements, such as SMURF and SMURFS, or DWARF and DWARVES, etc., that is not the case here. It is reasonable to believe that the consuming public would investigate with great care regarding an odd mark of something such as what the USPTO references as multiple GUMBIES; just as much as they would if the consuming public came across Mickey Mice, Bugs Bunnies, Spider Men, etc., i.e., plural forms of well-known, singular character marks. Moreover, the GUMBY character is not even one of a family of GUMBY members, like the Flintstones, Jetsons, Simpsons, etc.; the family is not the Gumby family, it is the character’s proper name. For example, Gumby’s father’s name is Gumbo and his mother’s name is Gumba³. Gumby is a particular, singular character. Applicant asserts that there is significant difference in the appearance between Applicant’s GUMBIES mark and Registrant’s GUMBY marks. While both marks share the same “GUMB” root term, Applicant’s mark comprises an “IES at the end of the term, whereas the Registrant’s mark comprises a single letter “Y”. Thus, the terms are not even identical in sight and sound.

It is well settled that when the consuming public is led to investigate, scrutinize, or “...exercise a high degree of care in purchasing, there is a lesser likelihood of confusion.” See, *In re N.A.D. Inc.*, 224 USPQ 969, 971 (Fed. Cir. 1985). Moreover, the sophistication of the

² See generally, <https://en.wikipedia.org/wiki/Gumby>

³ <http://www.gumbyworld.com/gumby-characters/gumbo-gumba/>

purchaser is a relevant factor. If the goods or services are purchased by....consumers who are known to exhibit particular care in purchasing, there is less likelihood of confusion.” In re Ship, 4 USPQ 2d 1174, 1175 (TTAB 1987). Unlike toiletries, drug store sundries, or other everyday products where consumers may exercise random care in purchasing such everyday goods⁴, in this case, purchasers would be expected to seek out the well-known Gumby character with particularity and would obviously exercise great care and regard to secure particular products that encompass the Gumby character. Notwithstanding such heightened degree of care for purchasing particular Gumby character related goods, consumers would use even greater care above and beyond to ascertain, with regard to the sight and sound of Applicant’s GUMBIES mark, whether Applicant’s goods were related to the Gumby character; i.e., consumers would investigate the nature of an odd plural GUMBIES with question, certainly knowing that Gumby is a singular entity. Thus, in this unique situation here, there is a negligible likelihood of confusion between Registrant’s and Applicant’s mark and goods associated with them.

Applicant appreciates the USPTO’s contention in this singular/plural issue, but it should be noted that the USPTO has approved other marks under greater, more egregious circumstances. For example, the USPTO has found no likelihood of confusion between the marks; No Body’s Perfect vs. Nobody’s Perfect⁵, and Jumpin’ Jack vs. Jumpin Jack’s⁶. Applicant presents these cases, which from a sight and sound perspective are hardly discernable, and can be extended to the plurality issue here, i.e., to demonstrate that the particular facts surrounding each matter is what is relevant. Merely the fact that one mark is singular while the other mark is plural, is not automatically dispositive of the issue to make a determination that confusion by consumers between such singular and plural marks is likely.

The sight and sound of the marks is different and in fact it is reasonable to find that the sight and sound between Registrant’s and Applicant’s mark would cause consumers to exercise a greater degree of care in purchasing; and even more care given the unique nature of Registrant’s well-known Gumby character.

With regard to the meaning or connotation of the marks, again, the USPTO asserts that Applicant’s GUMBIES mark is merely the plural of Registrant’s GUMBY mark. Again, while one may ascertain as grammatically correct, this is not on point. The meaning or connotation of

⁴ See generally, *Gillette Canada Inc. v. Rani Corp.*, 23 USPQ 2d 1768, 1773 (TTAB 1992)

⁵ *In re Nobody’s Perfect Inc.*, 44 USPQ 2d 1054 (TTAB 1997)

⁶ *In re Giovanni Food Co., Inc.*, 97 USPQ 2d 1990 (TTAB 2011)

Applicant's mark relates to the Gum Tree and its derivative "rubber" material extracted therefrom. This derivative drives the foundation for the rubber/burlap natural matrix that forms the foundation of the sole of Applicant's goods. GUMBY on the other hand is a well-known claymation character. Without reiterating the lengthy explanation above with respect to the uniqueness of the GUMBY character and the heightened degree to which purchasing consumers would exercise when encountering either mark, the meaning and connotation of the GUMBY character is rather well established. Again, there is little likelihood of confusion with regard to the GUMBY character mark and with the term GUMBIES, which would motivate the purchasing public to determine any nexus between the two, and which would of course result in a determination that the marks do not emanate from the same source.

2. The similarity of the goods and/or services.

The similarity of the goods and/or services is difficult to ascertain. While Registrant lists footwear as part of their TM Registration, Applicant could not find any instances of footwear actually offered to consumers. Applicant has performed an exhaustive search for GUMBY character footwear. None could be found. Registrant's own web-site offers a whole host of GUMBY character related goods from Apparel to Books, Apps, Electronics, Holiday, Toys, even Pet and Food items. It would seem that common clothing items such as footwear would be offered. For, example, one can apparently purchase shirts, hats, pajamas, costumes, baby clothes, dresses, sweatshirts, even pet dog coverings, however, there were no footwear offerings.⁷ Oddly, an Internet search⁸ of "Gumby Shoes" results not in as one would expect, i.e., GUMBY character footwear products. Rather it resulted in a plethora of a particular type of women's shoe/pump called a "Gumby" shoe, discussed in greater detail in Section 5 *Supra*.

Since there are no footwear goods offered by Registrant, there is no similarity to discern between, and thus, weighs in Applicant's favor.

⁷ See, <http://www.gumbyworld.com/gumby-store>

⁸ <https://www.bing.com/search?q=gumby+shoes&form=EDGNTC&qs=PF&cvid=98ef900d068d498ca07861c1956c33e0&pq=gumby%20shoes&PC=TBTS>

3. The similarity of trade channels of the goods and/or services.

According to TMEP § 1207.01(a)(i) if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). In the case at hand, the GUMBY terms are not even identical and they of course are marketed in such a way that they would not be encountered by persons such that an incorrect assumption could be made that they originate from the same source. GUMBY products are specialty items found in specialty stores, such as toy stores, or toy/iconic sections of larger, full purpose stores. In addition, they may found as nostalgic/vintage items in “trend setting” stores. Applicant’s GUMBIES brand flip-flops are what might be considered casual or sportswear related items, found in shoe sections, sporting goods stores, outdoor specialty stores and the like. Purchasers of Registrant’s goods would not look to the outlets where one would find Applicant’s goods, and vice versa. This clearly favors a low likelihood of confusion in favor of Applicant.

4. The conditions under which, and buyers to whom, sales are made, that is, “impulse” vs. careful sophisticated purchasing.

Here, we must again reiterate the arguments above that purchasers of GUMBY character products would use great care in particularly seeking out particular goods having the claymation character associated with it. It is clearly not an impulse purchase as one might expect with lip balm, tooth brushes, hand wipes, or other checkout counter items. The Gumby character is a unique item having vintage/nostalgic qualities. Those seeking to reminisce or obtain collectibles

would clearly use great care to purchase or acquire items. In fact, it is reasonable to assume that even greater care would be exercised to determine the authenticity/provenance of particular Gumby character items.

In an almost identical case, the nostalgic/vintage cartoon character Mighty Mouse was found NOT confusingly similar to My-T-Mouse (Audibly Identical), for respective computer related goods. The TTAB held that, “Opposer licenses its MIGHTY MOUSE marks, and its other merchandising marks, for a variety of products where the product is bought because of the mark. Thus, a consumer may purchase a tee shirt because it bears the name and picture of MIGHTY MOUSE...” “The merchandising....promotes the trademark and its visibility.”⁹ Gumby is a similarly nostalgic/vintage character. Clearly any purchases would not be impulse purchases, but rather the conditions are such that Gumby goods would be obtained with a heightened awareness as to the source of such goods, and in fact, any goods are significantly more apt to be purchased because of the GUMBY character, similar to the MIGHTY MOUSE goods, and not because of some perceived quality GUMBY brand footwear product. This is clearly different than a consumer seeking to obtain Applicant’s specific, quality brand of flip-flops.

Moreover, purchasers of Registrant’s Gumby goods are directed towards children or older adults for nostalgic and/or collectible vintage reasons. Applicant’s goods are directed towards those seeking casual or sportswear items. Applicant’s Gumbies Islander flip-flops would similarly not be an impulse purchase, and given the analysis above with respect to the sight and sound of Applicant’s mark, purchasers would use a heightened awareness as to the source of the goods and are more apt to purchase items because of the Gumby character.

5. The number and nature of similar marks in use on similar goods/third party use.

The TTAB has given weight to credible and probative evidence of widespread, significant, and unrestrained use by third parties of marks containing elements in common to demonstrate that confusion is not, in fact, likely.¹⁰ In this matter, it is highly relevant to present to the USPTO the widespread and apparent unrestrained use of the exact GUMBY term as it

⁹ Viacom International, Inc. v. Kermit Komm et al. Opposition No. 98,944 (TTAB 1993)

¹⁰ Miles Labs, Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ 2d 1445, 1462 (TTAB 1986)

relates to footwear. In particular, an Internet search¹¹ of “Gumby Shoes” results not in as one would expect, i.e., GUMBY character footwear products. Rather it resulted in a plethora of a particular type of women’s shoe/pump called a “Gumby” shoe. See merely two example below:

[BCBGeneration Gumby - shoebuy.com](#)

www.shoebuy.com/bcbgeneration-gumby/692834

- \$47.95
- IN STOCK

BCBGeneration Gumby with FREE Shipping & Exchanges. The **Gumby** is a classic mid-heel pump with a rounded toe and a covered heel.

[Images of gumby shoes](#)

bing.com/images



[See more images of gumby shoes](#)

Clearly, Registrant has acquiesced in the use of the GUMBY term apart from its GUMBY character, but more relevantly, how the GUMBY term has been allowed to be used with other footwear. Applicant could find no disclaimers, explanations, and the like, such that purchasers were put on notice that these types of shoes were not related to Registrant and his line of well-known GUMBY character products. Applicant can only assume that purchasers would similarly not be confused regarding his line of footwear, and even more so because Registrant’s and Applicant’s terms are not identical as they are in this instance. This evidence clearly weighs in favor of Applicant.

¹¹<https://www.bing.com/search?q=gumby+shoes&form=EDGNTC&qs=PF&cvid=98ef900d068d498ca07861c1956c33e0&pq=gumby%20shoes&PC=TBTS>

6. That nature and extent of any actual confusion.

Applicant's Gumbies Islander flip-flops is not a new endeavor for Applicant. Applicant has been selling his Gumbies goods for several years internationally and although offered on the Web, has purposefully begun to enter the US market more aggressively. Applicant has never had any instances of confusion with the Gumby character or goods; and has never had even any inquiries into the nature of his goods and/or how they may relate or be associated with Registrant's goods.

Only upon inquiry by counsel did Applicant state:

"I exhibited at Outdoor retailer Salt Lake city in January 2016 and also Surf Expo Florida in January 2016. And Platform Fashion trade show in Las Vegas in Feb 2016 There are several thousand customers that passed the booth, no joke. Not 1 person ever mentioned Gumby nor were they confused as to who we were or where we came from."

Clearly, Applicant has had an opportunity in several concentrated settings to witness any actual confusion between his mark/goods and Registrant's mark/goods. As stated by Applicant, not only was there no witnessed confusion, but even more probative, there were no inquiries as to whether there was any association between Registrant and Applicant. Generally, mere declarations are not persuasive, because it is unknown as to what confusion may truly exist. But in this case, the fact that Applicant was in a concentrated setting with the opportunity by thousands to espouse any confusion they may have, and Applicant witnessing zero instances of confusion or inquiry, clearly is more dispositive. This favors Applicant.

7. The length of time during, and the conditions under which, there has been concurrent use without evidence of actual confusion.

As stated above, this is not a new endeavor for Applicant. Applicant has been selling GUMBIES brand flip-flop's internationally for several years and is now introducing his GUMBIES brand flip-flops here in the US. Similarly, GUMBY, according to Registrant, is

known, "...world-wide."¹² Registrant's and Applicant's mark have been concurrently used in other parts of the world contemporaneously for several years. It has been held that, "...where there has been coexistence over an extensive period of time, and applicant's mark is shown to be well-known or famous, the absence of any known incident of actual confusion in an extensive period of contemporaneous use of the marks is strong evidence that confusion is not likely to occur in the future."¹³ (Emphasis Added)

Applicant, having actual knowledge of his mark in use outside of the US, has never encountered or had any inquiries regarding any association between his mark and goods with respect to anything GUMBY character/goods related. This complete lack of any confusion between his mark and goods and Registrant's mark and goods weighs in favor of Applicant, and is strong evidence that confusion is not likely in the future.

8. The extent of potential confusion, that is, whether de minimus or substantial.

In this case, the potential for confusion is de minimus. The GUMBY character is a well-known children's/vintage fictional, claymation character. The reasonable purchaser of GUMBY character goods would use great discerning care when seeking to secure authentic, clearly visible GUMBY character related goods. The nature of the goods, the channels of trade, the well-known nature of the GUMBY character, the questions that would arise to a purchaser regarding a "plural" GUMBIES are all relevant to objectively conclude that the potential for confusion is de minimus. This factor weighs in favor of Applicant.

9. Any other established fact probative of the effect of use.

Finally, one of the most relevant pieces of evidence to rebut the likelihood of confusion comes directly from the Registrant themselves. Attached at "Exhibit A" is a "Deal Memo" addressed to and submitted to Applicant¹⁴ seeking to provide "licensing rights" to Applicant's own GUMBIES mark, which of course is a bit confusing. The "Deal Memo" seems to be a bit

¹² <http://www.gumbyworld.com/license-gumby/> See Registrant's "ICON" self-description on the breadth of recognizeability throughout the world.

¹³ *In re General Motors Corp.*, 23 USPQ 2d 1465, 1470 (TTAB 1992); see also *In re American Management Ass'ns*, 218 USPQ 477, 478 (TTAB 1983).

¹⁴ The "Deal Memo" was part of an e-mail attachment made to Applicant on or about February 22, 2016.

off point in that Registrant fails to own the rights to Applicant's mark, they have rights in the GUMBY name, but not GUMBIES. Rather it seems, they are providing an offer sheet that would "allow" Applicant to use his own GUMBIES term, and we can only speculate, either via some sort of Concurrent Use Proceeding, Consent Decree, or as some sort of covenant not to sue. In any case, Registrant by acquiescing to such offered use must clearly recognize that confusion is not likely between the marks, and Registrant is obviously seeking pecuniary gain in light of Applicant's current likelihood of confusion rejection before the USPTO.

The USPTO has recognized that, for example in a Concurrent Use Proceeding/Consent Decree, mere declaratory statements by the senior mark owner is not enough to overcome a likelihood of confusion rejection of the junior mark. The parties must also explain why there would be no likelihood of confusion. If such explanation satisfies the USPTO, then Courts have instructed the USPTO to give such decrees great weight to overcome the rejection. (Emphasis Added) The Courts have stated that the USPTO has inferior marketplace knowledge to the parties, thus the parties are in the best position to determine whether there is a likelihood of confusion. We must assume that if confusion were likely, Registrant would not jeopardize or diminish the value of their own GUMBY mark by making such an offer to Applicant. Clearly, Registrant is conceding that there is little likelihood of confusion, but perhaps only at the expense of Applicant.

It should be noted that Registrant offers licensing as a matter of course for almost any good or service. See Registrant's own web-site¹⁵. The difference in this case is that Registrant is not seeking to license the GUMBY term to Applicant, but rather license Applicant's own GUMBIES mark to himself. This is quite the enigmatic licensing structure and amounts to what could only be some sort of "license" in-gross, which are well-known as disfavored transfer structures under the law. Thus, we are only left with the fact that Registrant set forth the "Deal Memo" to Applicant knowing that there is no likelihood of confusion, and is merely seeking to benefit on Applicant's current challenges before the USPTO to register his GUMBIES mark. Therefore, this should clearly weigh in favor of Applicant.

As a matter of procedure and notice, Applicant respectfully puts the USPTO on notice that all contents of Applicant's and cited Registrant's file wrappers, as well as the file wrappers of any other marks noted herein, are materials constructively attached to this Response and may

¹⁵ <http://www.gumbyworld.com/license-gumby/>

be respectively considered. Moreover, any subsequent proceedings related to these parties and this matter in any forum are similarly put on notice. Actual attachment of the voluminous documents is impractical and inconvenient; the materials are readily attainable via the USPTO's trademark database. Thus, the reason for Applicant's constructive notice here.

Applicant further incorporates by reference into this response for consideration of all arguments set forth herein to the extent applicable the full contents of Registrant's website: www.gumbyworld.com , and Applicant's website www.gumbies.com, as well as any links at either's respective site to any third party sites, such as Facebook, LinkedIn, etc.

Finally, Applicant preserves the right to pursue cancellation of Registrant's mark, at least as it relates to the respective mark for footwear. Applicant reiterates from above. Applicant has performed an exhaustive search for GUMBY character footwear. None could be found. Registrant's own web-site offers a whole host of GUMBY character related goods from Apparel to Books, Apps, Electronics, Holiday, Toys, even Pet and Food items. It would seem that common clothing items such as footwear would be offered. For, example, one can apparently purchase shirts, hats, pajamas, costumes, baby clothes, dresses, sweatshirts, even pet dog coverings, however, there were no footwear offerings.¹⁶

¹⁶ See, <http://www.gumbyworld.com/gumby-store>

CONCLUSION

In view of the preceding comments, Applicant respectfully submits that the singular ground for refusal has been addressed. Applicant respectfully requests the USPTO to carefully reconsider Applicant's application in light of this response and the evidence presented. Please contact the undersigned attorney at the address and telephone number noted below with any questions or comments.

Respectfully submitted,

Date:

4/1/16



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Tel: 480.390.9835

EXHIBIT A



Prema Toy Company, Inc.
359 Los Osos Valley Rd.
Los Osos, CA 93402

DEAL MEMO Gumby[®] and Pokey[®]

Date: February 22, 2016

Property: Gumby and Pokey

LICENSEE
Company Name: GUMBIES LIMITED
Address: 10 Chancerygate Trade Center, Hollyrod Close
Poole, Dorset, BH17 7AE

Contact: Michel Maurer
Title: President
Office Phone: 44 (0) 1202 699509
Mobile Phone:
Fax:
Email:

Licensed Articles: The rights to use the "Gumbies" brand name to manufacture and sell footwear (flip flops)

Term: Three (3) years

Territory: North America

Advance and Guarantee: \$10,000 per year with the 1st payment due on signature of Deal Memo and subsequent yearly advance payments to be paid on the 1st of the calendar year.

Royalty Rate: 1% of wholesale price

Exclusivity: N/A

Comments: This is a legally binding document and may be followed by a longer form agreement..

Prema Toy Signature: _____ Date: _____

Agent Signature: _____ Date: _____

Licensee Signature: _____ Date: _____

PREMA TOY COMPANY, INC.
PREMAVISION, INC.
www.gumby.com
www.premavision.com

marketing@premavision.com
Phone: 805.528.8103
Fax: 805.528.7227