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Subject: U.S. TRADEMARK APPLICATION NO. 79156012 - GUMBIES - N/A - Request for Reconsideration Denied - Return to TTAB

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Files: Gumbies1-1.jpg, Gumbies1-2.jpg, Gumbies1-3.jpg, Gumbies1-4.jpg, 79156012.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79156012

MARK: GUMBIES



CORRESPONDENT ADDRESS:

ROBERT A. IUSSA

IUSSA LAW, PLLC

610 E. BELL RD.2-243

PHOENIX, AZ 85022

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Michel Roger Maurer

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

riussa@iussalaw.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/2/2016

INTERNATIONAL REGISTRATION NO. 1225379

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The likelihood of confusion refusal made final in the Office action dated October 1st, 2015 is maintained and continues to be final. See TMEP §§715.03(a)(ii)(B), 715.04(a). See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

Applicant argues that GUMBY is a singular television character while the applicant's mark relates to a gum tree. Applicant further argues that there is no plural for the term GUMBY and that there is a significant difference between the parties' marks. Nevertheless, the attached dictionary evidence shows that GUMBIES is the plural of GUMBY.

Applicant further argues that the sophistication of the relevant consumer is relevant in this case and that the applicant's goods are not for impulsive purchase. Nevertheless, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Applicant argues that other marks with similar characteristics co-exist on the register. Nevertheless, trademark examining attorneys are not bound by the actions of past examining attorneys in prior registrations, even if the registrations have some characteristics similar to the application at issue; each case is decided on its own merits. *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

Applicant further argues that the marks are dissimilar in sound, appearance and meaning. Nevertheless, 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). The marks in this case create the same overall commercial impression.

Applicant argues that it has found no evidence that the registrant sells footwear. In essence, applicant argues that the owner of the cited registration has abandoned its trademark in relation to footwear, due to nonuse. However, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant’s exclusive right to use the mark in commerce in connection with the specified goods and/or services. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv).

Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant’s nonuse of its mark, are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Applicant further argues that the registrant’s goods are directed towards children and older adults, while the applicant’s goods are casual and sportswear items. Nevertheless, in a likelihood of confusion analysis, the comparison of the parties’ goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

Applicant argues that the parties' have been using their marks for several years without any confusion in the marketplace. However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. 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). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Applicant's contention that the registrant has acquiesced in the use of the term GUMBY for footwear by other entities and that the registrant appears to be offering licensing rights to the applicant to use the term GUMBIES have no probative value with respect to the determination of likelihood of confusion in this case.

Therefore, the likelihood of confusion refusal is maintained.

/E.Bradley/

Evelyn Bradley

Trademark Examiner

Law Office 105

(571) 272-9292

plural **gumbies** also **gumbés**

:

a drum made by stretching a skin over a piece of a hollowed tree and used especially in the West Indies

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Variants of GUMBY

also **gumbé**

Origin of GUMBY

of Bantu origin; akin to Kongo *nkumbi* ceremonial drum, Tshiluba *nkumbi* drum

Seen and Heard

What made you want to look up *gumby*? Please tell us where you read or heard it (including the quote, if possible).

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