

ESTTA Tracking number: **ESTTA722256**

Filing date: **01/22/2016**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Emirimage Corp.		
Entity	Corporation	Citizenship	Florida
Address	5269 NW 161 Street Miami, FL 33014 UNITED STATES		

Correspondence information	Eduardo Perl President Emirimage Corp. 5269 NW 161 Street Miami, FL 33014 UNITED STATES sales@emirgroup.com Phone:786-287-1250
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Applicant Information

Application No	86578218	Publication date	12/29/2015
Opposition Filing Date	01/22/2016	Opposition Period Ends	01/28/2016
Applicant	SHANTOU DOUBLE HORSE TOYS INDUSTRY CO. LTD DONGHU INDUSTRIAL PARK SHANTOU, GUANG DONG, CHINA		

Goods/Services Affected by Opposition

Class 028. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Games and playthings, namely, toy pistols, toy model weapons and parts and accessories therefor; toy ammunition for these toy models; toy model weapons for virtual firing and parts therefor; toy model weapons for use with an electronic target and parts therefor; dolls; scale model vehicles; dolls' houses; dolls' rooms; toy furniture; mobiles for children; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; toy airplanes; remote control toys, namely, cars, race cars, airplanes and boats
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4083923	Application Date	06/07/2011
Registration Date	01/10/2012	Foreign Priority Date	NONE

Word Mark	DOUBLE HORSE
Design Mark	DOUBLE HORSE
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 2008/11/14 First Use In Commerce: 2008/11/14 Electronic toy vehicles; Electronicallyoperated toy motor vehicles; Radio controlled toy vehicles; Remote control toys, namely, helicopters and planes; Toy airplanes

Attachments	85340365#TMSN.png(bytes) OPP.pdf(737938 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Eduardo/Perl
Name	Eduardo Perl
Date	01/22/2016

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

In the Matter of the Serial No. 86578218
For the Mark: SM SHUANG MA

EMIRIMAGE CORP.,

Opposer,

Vs.

Cancellation No.

SHANTOU DOUBLE HORSE TOYS INDUSTRY CO. LTD.

Applicant.

PETITION FOR CANCELLATION

This Notice of Opposition is submitted in the matter of Application Serial No. 86578218 for Games and playthings, namely, toy pistols, toy model weapons and parts and accessories therefor; toy ammunition for these toy models; toy model weapons for virtual firing and parts therefor; toy model weapons for use with an electronic target and parts therefor; dolls; scale model vehicles; dolls' houses; dolls' rooms; toy furniture; mobiles for children; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; toy airplanes; remote control toys, namely, cars, race cars, airplanes and boats in International Class 28. Opposer, Emirimage Corporation, a Florida corporation with offices located at 5269 NW 161 Street, Miami, FL 33014, believes that it will be damaged by the registration of the mark shown in Serial No. 86578218 and therefore opposes the same.

The grounds for Opposition are as follows:

1. For many years and long prior to the acts of Applicant herein alleged, Emirimage Corp (Emirimage) has been engaged in the distribution and sale of Electronic toy vehicles;

electronically operated toy motor vehicles; Radio controlled toy vehicles; Remote control toys, namely, helicopters and planes; Toy airplanes. Such goods are distributed to consumers across the United States through retail stores in malls, online, and other retail stores.

2. Emirimage has, since as early as 2008 used the mark DOUBLE HORSE in connection with electronically operated toy motor vehicles; Radio controlled toy vehicles; Remote control toys, namely, helicopters and planes; Toy airplanes.
3. As a result of its consistent efforts to sell, distribute, and promote electronically operated toy motor vehicles; Radio controlled toy vehicles; Remote control toys, namely, helicopters and planes; Toy airplanes goods under and in connection with the DOUBLE HORSE mark, Emirimage has developed considerable and valuable consumer recognition and goodwill in the DOUBLE HORSE mark in word form. To protect its rights in this mark, Emirimage has obtained federal registration for the DOUBLE Horse mark for use with electronically operated toy motor vehicles; Radio controlled toy vehicles; Remote control toys, namely, helicopters and planes; Toy airplanes, in International Class 28. A copy of the United States Patent and Trademark Office record for Registration No. 4083923 is attached as Exhibit "A".
4. On April 17, 2012, approximately 4 years after Emirimage began its use of, and developed its rights in DOUBLE HOURSE, and after its DOUBLE HORSE Mark was registered with the United States Patent and Trademark Office, Applicant filed its first application for registration of the designation SHUANG MA. Exhibit "B". Applicant received an Office action thereafter Exhibit "C", and the application was later abandoned and denied by the United States Patent and Trademark Office, refusing protection.

Exhibit “D”. In the application, Applicant submitted to the United States Patent and Trademark that the transliteration of the non-Latin characters in the mark is: SHUANG MA. The English translation of the foreign word(s) in the mark is: Double horse. Applicant filed the registration for substantially similar goods in International Class 28.

5. On March 25, 2015, approximately 7 years after Emirimage began its use of, and developed its rights in DOUBLE HOURSE, and after its DOUBLE HORSE Mark was registered with the United States Patent and Trademark Office, Applicant filed its first application for registration of the designation SHUANG MA. Exhibit “E”. The sole difference with this application was that Applicant added the letters SM in front of SHUANG MA, but in this application, after its denial of its first application in 2012, Applicant changed the transliteration of the meaning to The English translation of the wording "SHUANG MA" in the mark is "two horses". Applicant filed the registration for substantially similar goods in International Class 28.
6. Applicant’s mark is substantially similar to the DOUBLE HORSE mark, and is used in connection with virtually identical goods in the same International class that flow through identical channels of trade as Emirimage’s goods offered in connection with the DOUBLE HORSE mark.
7. As a result of the similarity of the parties marks, the similarity of the goods associated with the marks, the similarity in the channels of trade of such goods and the strength of the Emirimage DOUBLE HORSE mark, Applicant’s use and registration of the SM SHUAN MA mark is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers are likely to believe Applicant’s goods are Emirimage goods, or are in some way legitimately connected with, sponsored by, or approved by Emirimage, in

violation of 15 USC § 1052(d). Accordingly, Emirimage opposes registration of Applicant's mark.

Wherefore, Emirimage requests that the registration sought by Applicant be refused and that the Notice of Opposition be sustained.

Respectfully submitted,

Emirimage Corp
5269 NW 161 Street
Miami, FL 33014
Ph.:786-287-1250

/s/ Eduardo Perl
President, Emirimage Corp.

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service's and sent Via U. S First Class Mail pursuant to 37 C.F.R. § 1.10 in an envelope addressed to Registrant at the address NTHEA LEE, 10685B Hazelhurst Dr # 9123, Houston, TEXAS UNITED STATES 77043-3238, legal correspondence for Applicant, on this 22th day of January, 2016.

/s/ Eduardo perl
Eduardo Perl, President,
Emirimage Corp.

United States of America

United States Patent and Trademark Office

DOUBLE HORSE

Reg. No. 4,083,923

Registered Jan. 10, 2012

Int. Cl.: 28

TRADEMARK

PRINCIPAL REGISTER

EMIRIMAGE CORPORATION (FLORIDA CORPORATION)
5269 NW 161 STREET
5269 NW 161 STREET
HIALEAH, FL 33014

FOR: ELECTRONIC TOY VEHICLES; ELECTRONICALLY OPERATED TOY MOTOR VEHICLES; RADIO CONTROLLED TOY VEHICLES; REMOTE CONTROL TOYS, NAMELY, HELICOPTERS AND PLANES; TOY AIRPLANES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 11-14-2008; IN COMMERCE 11-14-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-340,365, FILED 6-7-2011.

ROBIN CHOSID, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

EXHIBIT "A"

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.



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Word Mark	SHUANG MA
Translations	The transliteration of the non-Latin characters in the mark is: SHUANG MA . The English translation of the foreign word(s) in the mark is: Double horse.
Goods and Services	(ABANDONED) IC 028. US 022 023 038 050. G & S: Toy pistols; dolls; scale model vehicles; dolls' rooms; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; model plane
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	79115114
Filing Date	April 17, 2012
Current Basis	66A
Original Filing Basis	66A
International Registration Number	1121967
Owner	(APPLICANT) SHANTOU DOUBLE HORSE; TOYS INDUSTRY CO., LTD. CORPORATION CHINA Donghu Industrial Area Fengxiang Street,; Chenghai District,; Shantou; 515800 Guangdong CHINA
Description of Mark	Color is not claimed as a feature of the mark.
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Abandonment Date	February 15, 2013

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

APPLICATION SERIAL NO. 79115114

MARK: SHUANG MA

79115114

CORRESPONDENT ADDRESS:

Beijing China Treas; Intellectual Proper
Room No.1010 Jixie Palaza,
Guang an men wai Road,
100055 Beijing
CHINA

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: SHANTOU DOUBLE
HORSE; TOYS INDUSTRY CO., ETC.

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

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1121967

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION ABOVE, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS REFUSAL WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

The "Mailing Date" appearing on the WIPO cover letter may also be found through the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please enter the U.S. Application Serial Number for this application and select "Documents." The "Mailing Date" is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Applicant may respond directly to this provisional refusal Office action if applicant is not represented by an authorized attorney. See 37 C.F.R. §2.193(e)(2)(ii). Otherwise, applicant's authorized attorney must

EXHIBIT "C"

respond on applicant's behalf. *See* 37 C.F.R. §2.193(e)(2)(i). However, **the only attorneys who are authorized to sign responses and practice before the USPTO** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States.
- (2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(e), 2.62(b), 11.1, 11.5(b)(2), 11.14(a), (c); TMEP §§602, 712.03.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO. *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(b). That is, foreign attorneys may not file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal, among other things. *See* 37 C.F.R. §11.5(b)(2); TMEP §§602.03(c), 608.01. If applicant is represented by such a foreign attorney, applicant must respond directly to this provisional refusal Office action. *See* 37 C.F.R. §2.193(e)(2)(ii).

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom notices or process may be served. 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2); *see* TMEP §610. Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/index.jsp>.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS SPECIFIED BELOW.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

- 2(d) Refusal – Likelihood of Confusion Refusal
- Amendment of Particular Wording in the Identification of Goods in International Class 028
- Description of the Mark Required – Omitted

SEARCH OF OFFICE'S DATABASE OF MARKS

1. 2(d) Refusal – Likelihood of Confusion

Registration of the applied-for special character mark, **SHUANG MA** is refused because of a likelihood of confusion with the standard character mark, **DOUBLE HORSE** in U.S. Registration No. **4083923**, under Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* *See the enclosed registration – Exhibit 1*

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the 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); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods. *See 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); TMEP §1207.01; *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). 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 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).

Applicant's proposed mark, **SHUANG MA** is used with *toy pistols; dolls; scale model vehicles; dolls' rooms; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; model plane, in International Class 028.*

The cited mark, **DOUBLE HORSE**, in U.S. Registration No. 4083923 is used with *electronic toy vehicles; electronically operated toy motor vehicles; radio controlled toy vehicles; remote control toys, namely, helicopters and planes; toy airplanes, in International Class 028.*

a. Similarity in the Commercial Connotation of the Marks

Applicant's proposed mark, **SHUANG MA** represents the foreign legal equivalent in English of registrant's mark, **DOUBLE HORSE**, and creates the same commercial connotation. Applicant's mark is a Chinese term. Common, modern languages include Spanish, French, Italian, German, **Chinese**, Japanese, Russian, Polish, Hungarian, Serbian and Yiddish. *See, In re Oriental Daily News, Ltd.*, 230 USPQ 637 (TTAB 1986) (Chinese).

Under the doctrine of foreign equivalents, a mark in a foreign language, SHUANG MA in this case, and a mark that is its English equivalent, namely, registrant's, DOUBLE HORSE may be held to be confusingly similar. TMEP §1207.01(b)(vi); *see, e.g., In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983). Therefore, marks comprised of foreign words are translated into English to determine similarity in meaning and connotation with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Equivalence in meaning and connotation can be sufficient to find such marks confusingly similar. *See In re Thomas*, 79 USPQ2d at 1025.

The doctrine is applicable when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696; TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024 (citing J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2006), which states “[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”).

Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. *See In re Thomas*, 79 USPQ2d at 1021 (holding MARCHE NOIR for jewelry likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services where evidence showed that MARCHE NOIR is the exact French equivalent of the English idiom “Black Market,” and the addition of MINERALS did not serve to distinguish the marks); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding applicant's mark LUPO for men's and boys' underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPO is the Italian equivalent of the English word “wolf”); *In re Hub Distrib., Inc.*, 218 USPQ at 284 (holding the Spanish wording EL SOL for clothing likely to be confused with its English language equivalent SUN for footwear where it was determined that EL SOL was the “direct foreign language equivalent” of the term SUN).

Therefore confusion is likely among consumers if the marks of the parties are found in the marketplace for similar goods.

b. Relatedness of the Goods

Applicant's goods are *toy pistols; dolls; scale model vehicles; dolls' rooms; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; model plane*; and registrant's goods are *electronic toy vehicles; electronically operated toy motor vehicles; radio controlled toy vehicles; remote control toys, namely, helicopters and planes; toy airplanes*. Both parties provide toys which are related goods and may be found in the same channels of trade. Furthermore, applicant's goods, *toy vehicles* are identified broadly and may include registrant's more specific identification for toy vehicles.

In this case, applicant's proposed mark, **SHUANG MA** represents the foreign legal equivalent in English of registrant's mark, **DOUBLE HORSE**, and the goods of the parties are related and may be found in

the same channels of trade, such that if encountered by consumers, it may create the incorrect assumption that they originate from the same source, and thus likely to cause confusion.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, 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); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

For these reasons, registration is refused. Although the Trademark Examining Attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

Requirements

If the Applicant chooses to respond to the refusal to register, the Applicant must also respond to the following requirements:

3. Particular Wording Indefinite in the Identification of Goods in International Class 028

The wording “*plane*” in the identification of goods is indefinite and must be clarified because the common commercial name for the goods must be stated, e. g., airplanes. *See* TMEP §1402.01. The Applicant may adopt the suggested identification, if accurate.

International Class 028	Toy pistols; dolls; scale model vehicles; dolls' rooms; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; model airplanes
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An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

4. Description of the Mark Required – Description Omitted

The applied-for mark is not in standard characters and applicant did not provide a description of the mark with the initial application. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. *See* 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b).

Therefore, applicant must provide a description of the applied-for mark. The following is suggested:

The mark consists of the stylized unshaded Chinese wording, “SHUANG MA” in all caps on a shaded background.

If the Applicant has *questions* about its application or needs assistance in responding to this Office action, please telephone the assigned Trademark Examining Attorney directly at the number below, or e-mail.

/Odessa Bibbins/
Attorney Advisor
Law Office 105
Tel: 571-272-9425
Fax: 571-273-9425
Odessa.Bibbins@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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Print: Aug 8, 2012

85340365

DESIGN MARK

Serial Number

85340365

Status

REGISTERED

Word Mark

DOUBLE HORSE

Standard Character Mark

Yes

Registration Number

4083923

Date Registered

2012/01/10

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

EMIRIMAGE CORPORATION CORPORATION FLORIDA 5269 NW 161 Street 5269 NW
161 Street Hialeah FLORIDA 33014

Goods/Services

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S:
Electronic toy vehicles; Electronically operated toy motor vehicles;
Radio controlled toy vehicles; Remote control toys, namely,
helicopters and planes; Toy airplanes. First Use: 2008/11/14. First
Use In Commerce: 2008/11/14.

Filing Date

2011/06/07

Examining Attorney

CHOSID, ROBIN

DOUBLE HORSE

FINAL DISPOSITION ON EXTENSION OF PROTECTION

The table below presents the data as entered.

Input Field	Entered
IDENTIFICATION SECTION	
INTERNATIONAL REGISTRATION NUMBER	1121967
OFFICE REFERENCE	79115114
ORIGINAL LANGUAGE CODE	ENGLISH
FILE SECTION	
FILE SPECIFICATION OF THE DOCUMENT	The legal letter below is sent to IB
GOODS AND SERVICES SECTION	
ALL GOODS AND SERVICES INDICATOR	X
INSTRUCTIONS SECTION	
FREE TEXT PROCESSING INSTRUCTIONS	Abandonment of REP Application



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

**Notification of Confirmation of Total Provisional Refusal
by the United States Patent & Trademark Office
According to Rule 18ter(3) of the Common Regulations**

The United States Patent and Trademark Office hereby notifies the International Bureau of the TOTAL REFUSAL TO GRANT PROTECTION in the United States.

International Registration No.: 1121967
Holder: SHANTOU DOUBLE HORSE
Mark: SHUANG MA

Application Serial No. 79115114 was abandoned by the USPTO on March 11, 2013.

The refusal of protection applies to all goods and/or services requested.

EXHIBIT "D"

**United States Patent and Trademark Office**

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TSDR ASSIGN Status TTAB Status (Use the "Back" button of the Internet Browser to return to TESS)



Word Mark SM SHUANG MA

Translations The English translation of the wording "**SHUANG MA**" in the mark is "two horses".

Goods and Services IC 028. US 022 023 038 050. G & S: Games and playthings, namely, toy pistols, toy model weapons and parts and accessories therefor; toy ammunition for these toy models; toy model weapons for virtual firing and parts therefor; toy model weapons for use with an electronic target and parts therefor; dolls; scale model vehicles; dolls' houses; dolls' rooms; toy furniture; mobiles for children; toy vehicles; jigsaw puzzles; radio-controlled toy vehicles; toy airplanes; remote control toys, namely, cars, race cars, airplanes and boats

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 26.09.21 - Squares that are completely or partially shaded
26.11.21 - Rectangles that are completely or partially shaded

Serial Number 86578218

Filing Date March 26, 2015

Current Basis 1B

Original Filing Basis 1B

Published for Opposition December 29, 2015

Owner (APPLICANT) SHANTOU DOUBLE HORSE TOYS INDUSTRY CO. LTD LIMITED LIABILITY COMPANY
CHINA DONGHU INDUSTRIAL PARK CHENGHAI DISTRICT SHANTOU, GUANG DONG CHINA

Description of Mark Color is not claimed as a feature of the mark. The mark consists of stylized Latin wording "SM SHUANG MA" with the "SM" being enclosed in a box, and the "SHUANG MA" is enclosed in a box.

Type of Mark TRADEMARK

Register PRINCIPAL

EXHIBIT "E"

**Live/Dead
Indicator**

LIVE

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