

To: Leticia Fernandez (ews@stieflerlaw.com)
Subject: TRADEMARK APPLICATION NO. 78645887 - MAMA GOT MILK! - N/A
Sent: 8/28/2006 3:52:10 PM
Sent As: ECOM102@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)

[\[Important Email Information\]](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/645887

APPLICANT: Leticia Fernandez

CORRESPONDENT ADDRESS:

Ellen W. Stiefler
Stiefler Law Group PC
3525 Del Mar Heights Rd, #111
San Diego CA 92130-2122

78645887

RETURN ADDRESS:

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

MARK: MAMA GOT MILK!

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

CORRESPONDENT EMAIL ADDRESS:

ews@stieflerlaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/645887

STATUS

This letter is in response to the applicant's communication filed on August 17, 2006. Therein, the applicant: 1) submitted arguments traversing the refusal for likelihood of confusion under Section 2(d) of the Trademark Act; 2) responded to the refusal under Section 2(a) for false suggestion of a connection; and 3) amended the identification of goods. Number 3 is acceptable.

Likelihood of Confusion

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration Nos. 1903870 and 2689741 as to be likely, when used on or in connection with the identified goods, to cause confusion, or to cause mistake, or to deceive.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(d) is maintained and made **FINAL**.

The mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (“GASPAR’S ALE and “JOSE GASPAR GOLD”); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (“THE LILLY” and “LILLI ANN”); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”); TMEP §1207.01(b)(iii).

Applicant argues that the commercial impression and meaning of the mark is changed merely because of the addition of the term “MAMA’S” to registrant’s mark. This argument is unpersuasive. Applicant’s use of its mark on diaper bags and whatever other baby products it has deleted from the application is no different than registrant’s use on a variety of promotional products including baby clothing. (See attached baby products for GOT MILK?). Applicant has merely added a single term to the registered mark. The difference in punctuation is minimal. And, not coincidentally, Applicant is using the exact same font and stylization as the registrant uses in its advertising and products. Providing further conflict between the marks.

Applicant also argues that the goods of the parties are so different that confusion is unlikely. However, registrant provides association services and promotes the sale of milk through a wide variety of promotional items that include baby products. (See attached). Additionally, the fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Consumers are likely to be confused that Applicant’s goods originate from Registrant.

Applicant’s argument that the channels of trade will be different between the good and services of the parties is without evidence and unpersuasive. The well-known “GOT MILK?” promotion is marketed through commercials and promotional items to all consumers. The promotion attempts to get everyone to understand the health benefits of milk, including pregnant women and mothers of babies and toddlers.

The fame of a registered mark is also a factor to be considered in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002) (Trademark Trial and Appeal Board erred in discounting the fame of opposer's marks ACOUSTIC WAVE and WAVE); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). The Court of Appeals for the Federal Circuit has stated:

[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Kenner Parker Toys, 963 F.2d at 353, 22 USPQ2d at 1456.

Registrant's mark is a highly famous mark that deserves a wide latitude of legal protection. The registered mark has been in use for over ten years and is highly recognizable. As evidence, the examining attorney has attached several web pages providing examples of the commercials and the many celebrities used in the GOT MILK? advertisements. (See attached web pages). According to their website, the campaign has over 90% awareness and the tag line has been licensed to dairy boards across the U.S. since 1995. "GOT MILK? is a powerful property and has been licensed on a range of consumer goods including Barbie dolls®, Hot Wheels®, baby and teen apparel and kitchen ware. (See attached wikipedia web page).

Because of the famousness of registrant's mark and the wide variety of goods with which it may be used, confusion as to the source of applicant and registrant's goods is highly likely.

False Suggestion of a Connection

For the reasons stated below, the refusal for false suggestion of a connection with the famous mark is herein made **FINAL**. Applicant's sole argument in response to this refusal is that it will be use only "on diaper bags so the farthest connotation connected with milk would be for bottles of formula or breast milk being given to babies." "Milk is not given to babies – only lactose formula, which is not milk, soy or other non-lactose formula, or breast milk is given to babies, so in fact MAMA GOT MILK as it will be used will be almost diametrically opposite to the uses of the Registrant's mark." (See Applicant's response). This argument is unpersuasive and without evidentiary support. The mark will be used on diaper bags much like "GOT MILK?" will be used on a variety of goods including baby items. Applicant's mark used on diaper bags may connote that the mother is providing the health benefits of whole milk by carrying regular cow's milk in the bottle compartment of the diaper bag. Babies and toddlers in diapers are not limited to breast milk or lactose formula. Toddlers in diapers can drink and do drink plenty of whole milk. Otherwise, registrant's use of the mark on baby gear would be a contradiction. Additionally, Applicant's mark in no way connotes breast milk or infant formula.

In this case, Applicant's use of an identical font appears to be intent to trade upon the goodwill that registrant has established. The fact that applicant did not intend to adopt the name of, or trade upon the goodwill of, the named person or institution does not obviate a false connection refusal. Trademark Act Section 2(a) does not require such intent. *See, e.g., Consolidated Natural Gas v. CNG Fuel Systems, Ltd.*, 228 USPQ 753 (TTAB 1985); *S&L Acquisition Co., v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987). However, evidence of such intent is highly probative that the public will make the intended false connection. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Final Response

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney. Thank you.

/Michael Webster/

Michael Webster
Examining Attorney
USPTO Law Office 102
571-272-9266

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

Note:

In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 3 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:

Email 1 includes the following 11 attachments

1. babygear1
2. babygear2
3. babygear3
4. babygear4
5. babygear5
6. babygear6
7. products
8. prouducts2
9. products3
10. products4
11. products6

Email 2 includes the following 10 attachments

1. products5
2. gotmilk-1
3. gotmilk-2
4. gotmilk2
5. famousness-1
6. famousness-2
7. famousness-3
8. famousness-4
9. famousness-5
10. famousness-6

Email 3 includes the following 1 attachment

1. gotmilk3

Please ensure that you receive all of the aforementioned attachments, and if you do not, please contact the assigned-examining attorney.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.