

To: Javier Gomez(docket@markavo.com)
Subject: U.S. Trademark Application Serial No. 97119847 - MIDNIGHT MUSE
Sent: August 24, 2022 07:34:04 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[79336077](#)
[5142797](#)
[screenshot-www-calvinklein-us-en-16613832883591](#)
[screenshot-www-calvinklein-us-en-16613833312621](#)
[Gucci Women All.jpg](#)
[Gucci Jewelry.png](#)
[screenshot-www2-hm-com-en_us-productpage-1113429001-html-16613838662091](#)
[screenshot-www2-hm-com-en_us-productpage-0723469001-html-16613837322821](#)

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 97119847

Mark: MIDNIGHT MUSE

Correspondence Address:

JAVIER GOMEZ
MARKAVO.COM
750 N SAINT PAUL ST STE 250 PMB 72065
DALLAS TX 75201-3206 UNITED STATES

Applicant: GINA GROUP LLC

Reference/Docket No. N/A

Correspondence Email Address: docket@markavo.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office

action.

Issue date: August 24, 2022

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

SUMMARY OF ISSUES:

- Pending Section 2(d) Refusal – Prior-Filed Application
- Section 2(d) Refusal – Likelihood of Confusion

PRIOR-FILED APPLICATION

The filing date of pending U.S. Application Serial No. 79336077 precedes applicant's filing date. *See* attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

While applicant is not required to respond to the issue of the pending application, ***applicant must respond to the following refusal within six months of the mailing date of this Office action to avoid abandonment.***

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 5142797. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* *See* the attached registration.

Standard of Analysis for Section 2(d) Refusal

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the 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) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Facts

Applicant has applied to register the mark MIDNIGHT MUSE for use on “Bras; Panties” in International Class 25.

Registrant’s mark is MIDNIGHTMUSE for “Jewelry.” in International Class 14.

Similarity of Marks

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 Fondee 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 Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

The compared marks are identical except for a slight difference in appearance between registrant’s mark, which appears as a compound word with no space separating the words, that is, MIDNIGHTMUSE; and applicant’s mark, which appears as multiple words with space separating the words, that is, MIDNIGHT MUSE. As such, the marks are identical in sound and virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion. See, e.g., *Seaguard Corp. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted].”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”); *Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”).

Relatedness of Goods

The compared goods need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] 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).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. See *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); TMEP §1207.01(a); see also *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

The attached Internet evidence, consisting of screenshots of third-party websites, establishes that the same entity commonly provides the relevant goods under the same mark, through the same trade channels, which are used by the same classes of consumers in the same fields of use. Thus, applicant's and registrant's goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

In conclusion, because the marks are virtually identical and the goods are related, there is a likelihood of confusion as to the source of applicant's goods. Therefore, registration is refused pursuant to Section 2(d) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

ASSISTANCE

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. [Click to file a response to this nonfinal Office action.](#)

/Salima Oestreicher/
Salima Oestreicher
Trademark Examining Attorney
Law Office 128
(571) 272-6786
salima.oestreicher@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

(4) STANDARD CHARACTER MARK

MIDNIGHT MUSE

Mark Punctuated
MIDNIGHT MUSE

Translation

Goods/Services

- IC 003. US 001 004 006 050 051 052.G & S: Perfumery products; non-medicated body lotions, milks and creams; deodorants for personal use; non-medicated soaps in liquid, solid or gel form for personal use; non-medicated bath gel; non-medicated shower gel; non-medicated skin care preparations

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Design Code

Serial Number
79336077

Filing Date
20211008

Current Filing Basis
66A

Original Filing Basis
66A

Publication for Opposition Date

Registration Number

Date Registered

Owner
(APPLICANT) Antonio Puig, S.A SOCIEDAD ANONIMA SPAIN Plaza Europa, 46-48, L'Hospitalet de Llobregat E-08902 Barcelona SPAIN

Priority Date
20210409

Disclaimer Statement

Description of Mark

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record

(4) STANDARD CHARACTER MARK

MidnightMuse

Mark Punctuated
MIDNIGHTMUSE

Translation

Goods/Services

- IC 014. US 002 027 028 050.G & S: Jewelry. FIRST USE: 20021118. FIRST USE IN COMMERCE: 20021118

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Design Code

Serial Number
86796583

Filing Date
20151022

Current Filing Basis
1A

Original Filing Basis
1B

Publication for Opposition Date
20160329

Registration Number
5142797

Date Registered
20170214

Owner
(REGISTRANT) Kerry Catherine Jewelry Inc. DBA Kerry & Charles CORPORATION NORTH CAROLINA
P.O. Box 18388 Asheville NORTH CAROLINA 28814

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

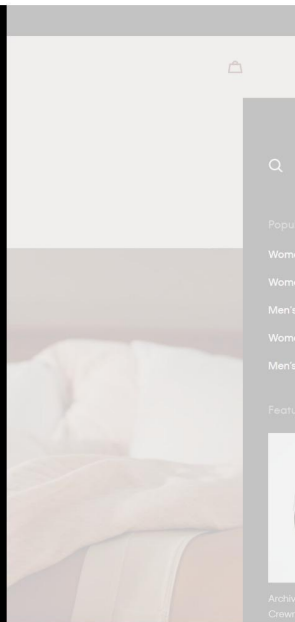
Steven M. Crosby

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Pants & Shorts

Blazers

Skirts

Denim

Activewear

Swimwear

Outerwear

Lingerie

SHOES

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Slides

Espadrilles

Slippers & Mules

Pumps

Moccasins & Loafers

Ballet Flats

Sneakers

Boots & Ankle Boots

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- Gucci Flora
- Interlocking G
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- Necklaces
- Bracelets
- Earrings

SILVER JEWELRY

- For Women
- For Men
- Interlocking G
- Rings
- Necklaces
- Bracelets
- Earrings
- Cufflinks & Tie Bars

FASHION JEWELRY

- For Women
- For Men
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- Interlocking G
- Rings
- Necklaces
- Bracelets
- Earrings
- Hair Accessories
- Brooches & Pins
- Cufflinks

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- G-Timeless
- Gucci Dive
- Grip Watches
- Interchangeable Watch Straps

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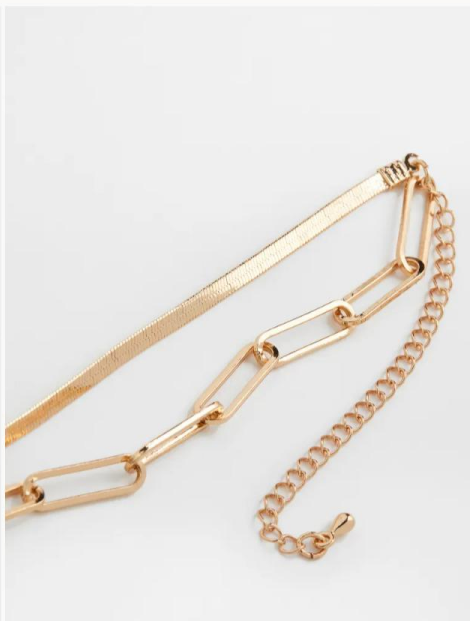
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Double-strand necklace with a link chain and a narrow snake chain. Adjustable length with trigger clasp.

Weight — 15 g

Composition — Steel 75%, Metal 25%

Art. No. — 1113429001

Gold-coloured



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New Arrival




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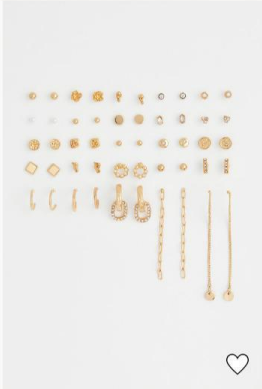
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Conscious choice

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Conscious choice

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Push-up bras in soft cotton jersey with lace. Molded, padded underwire cups to maximize bust and cleavage. Adjustable shoulder straps and narrow back section with fastener.

Pieces/Pairs — 2

Size — The model is 179cm/5'10" and wears a size 34B

Composition — Cotton 95%, Spandex 5%, Cup lining: Polyester 100%, Lace: Polyamide 89%, Spandex 11%

Art. No. — 0723469001

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True to Size

Runs Large



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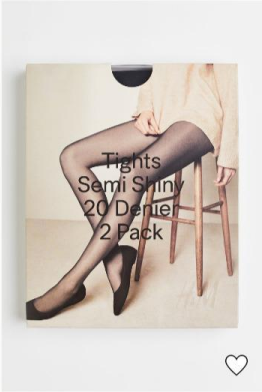
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United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 24, 2022 for
U.S. Trademark Application Serial No. 97119847

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

Note To The File

Serial Number: 97119847

Date: 08/24/2022 6:32 pm

Created by: Salima Oestreicher

MIDNIGHT MUSE

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4	2 and 3	607	0	0	0	0:02
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8	7 and 2	673	0	0	0	0:02
9	(6 8) and ("025")[cc]	171	0	171	171	0:03
10	*mu{"scz"1:2}*[bi,ti] and ("025")[cc] not dead[ld]	4246	0	0	0	0:01
11	*mu{"sz"1:2}e*[bi,ti] and ("025")[cc] not dead[ld]	754	0	0	0	0:01
12	*muse*[bi,ti] and ("025")[cc] not dead[ld]	720	0	0	0	0:00
13	*mu{"scz"1:2}*[bi,ti] and ("042" a b "200")[ic] not dead[ld]	740	0	0	0	0:02
14	*mu{"scz"1:2}*[bi,ti] and ("025" a b "200")[ic] not dead[ld]	1651	0	0	0	0:01
15	*mu{"scz"1:2}e*[bi,ti] and ("025" a b "200")[ic] not dead[ld]	304	0	0	0	0:01
16	*muse*[bi,ti] and ("025" a b "200")[ic] not dead[ld]	282	0	282	282	0:01
17	*muse*[bi,ti] and ("042" a b "200")[ic] not dead[ld]	119	0	119	119	0:01
18	*muse*[bi,ti] and ("035" a b "200")[ic] not dead[ld]	344	0	0	0	0:01
19	3 and (6 8)	10	0	10	10	0:03
20	"midnight muse"[bi,ti]	5	2	3	3	0:01
21	"midnight muses"[bi,ti]	1	0	1	1	0:00

Session started 08/24/2022 6:02 pm

Session ended 08/24/2022 6:16 pm

Total search duration 30.00

Session duration 13 minutes 34 seconds

Adjacency Level 1

Near Level 1