

To: DD IP Holder LLC (wades@dicksteinshapiro.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85529535 - BAGEL BUNCHKIN
- D1383.1385
Sent: 5/17/2012 7:22:27 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85529535

MARK: BAGEL BUNCHKIN

85529535

CORRESPONDENT ADDRESS:

STEPHANIE K. WADE
DICKSTEIN SHAPIRO LLP
1825 EYE ST NW
WASHINGTON, DC 20006-5403

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APPLICANT: DD IP Holder LLC

CORRESPONDENT'S REFERENCE/DOCKET

NO:

D1383.1385

CORRESPONDENT E-MAIL ADDRESS:

wades@dicksteinshapiro.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 5/17/2012

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 ISSUE(S) that applicant must address:

- Section 2(d) Refusal

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. 2222941. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

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/or services, and similarity of the trade channels of the goods and/or services. *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 and/or services. *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 and/or services 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).

The applicant's mark is BAGEL BUNCHKIN for bite-sized bagel pieces.

The registrant's mark is THE BAGEL BUNCH for bagels.

Similarities of the marks:

In this case, the applicant's mark and the registrant's mark are highly similar and they convey a very

similar commercial impression. Here, both marks share the same terms or formatives of the same terms, BAGEL and BUNCH to identify closely related goods, namely, bagels and bite-sized bagel pieces.

Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Vittera Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

In this instance, the mere addition of the letters “KIN” to the registrant’s mark does not change the original commercial impression of the mark “THE BAGEL BUNCH.” Thus, the addition of the letters “KIN” to the registrant’s mark does not obviate the similarity between the marks.

Further, the deletion of “THE” from the registrant’s mark also will not obviate the similarity between the marks.

As such, both marks convey essentially the same meaning or commercial impression and are therefore confusingly similar.

Similarities of the goods:

Where the goods and/or services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Such is the case here. The food products of both parties are virtually identical. The applicant’s goods are bite-sized bagel pieces and the registrant’s goods are bagels.

The trademark examining attorney refers to the excerpted materials from the Yahoo search engine establishing the relatedness of the goods by showing that the applicant offers both bagels and bite sized bagel pieces. See attachments.

Material obtained from the Internet is generally accepted as competent evidence. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); *In re Joint-Stock Co. “Baik”*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Based on the evidence, it is clear that the goods of both parties are closely related. As such, the goods of both parties will travel and will be marketed in the same channels of trade to the same class of consumers. Thus, consumers are likely to encounter the goods of both parties and are likely to mistakenly believe that the goods emanate from the same source. Accordingly, confusion is likely.

Therefore, the proposed mark is refused registration pursuant to Section 2(d) of the Trademark Act.

RESPONSE:

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

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Trademark Examining Attorney
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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/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: May 17, 2012

75465722

TYPED DRAWING

Serial Number

75465722

Status

REGISTERED AND RENEWED

Word Mark

THE BAGEL BUNCH

Standard Character Mark

No

Registration Number

2222941

Date Registered

1999/02/09

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

FRED MEYER STORES, INC. CORPORATION OHIO 3800 S.E. 22ND AVE., P.O. BOX
42121 PORTLAND OREGON 97242

Goods/Services

Class Status -- ACTIVE. IC 030. US 046. G & S: bagels. First Use:
1996/06/00. First Use In Commerce: 1996/06/00.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BAGEL" APART FROM THE
MARK AS SHOWN.

Filing Date

1998/04/09

Examining Attorney

DELANEY, ZHALEH

Attorney of Record

Richard L. Kirkpatrick

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BEHIND THE BEANS

What's Brewin' at Dunkin' Donuts.



« [Something to Chew on: Freshly-Baked Bagel Buzz and Fun Facts](#)

[The Cold Hard Facts Around Iced Coffee in the Winter](#) »

From Round to Twisted to Bite-Sized: Dunkin' Donuts Celebrates 15 Years of Bagels on National Bagel Day

By Jessica Gioglio

Did you know that today is National Bagel Day? It's true...each and every February 9 is recognized as the country's official bagel bash and the perfect opportunity to appreciate this beloved bakery item.

According to Maria Balinska, author of "The Bagel: The Surprising History of a Modest Bread," the boiled then baked bread is a classic rags to riches immigrant's tale. "Bagels came to America as a snack almost exclusively enjoyed by the Jewish community, but by the 1970s 'the roll with the hole' was on its way to becoming an all-American favorite. Millions of bagels are consumed every day across the United States and sales are estimated to be worth over \$900 million annually. Now, the bagel is available and popular in such unlikely places as Korea, Japan and Argentina."

This year, National Bagel Day holds an extra special meaning for Dunkin' Donuts, and not just because we sell 252 million freshly baked [bagels](#) annually, making us the #1 server of bagels in the U.S., according to the fine folks at NPD Group/CREST. Believe it or not, 2011 actually marks the 15th anniversary of the introduction of freshly-baked bagels at Dunkin' Donuts.

Back in 1996, Dunkin' Donuts launched bagels with national advertising pairing the iconic "Fred the Baker" with a former New York City Mayor. We offered 12 varieties, with prices ranging from 55 to 60 cents. Some original varieties like Egg and Pumpernickel have since been replaced as we've added exciting new choices such as Sour Cream and Onion and our popular Multigrain Bagel (an excellent source of fiber, BTW).





Dunkin' Donuts Multigrain Bagel

Over the years, Dunkin' Donuts' culinary team has earned a place in bagel history for bagel inspiration and ingenuity. In 2010, Dunkin' Donuts unveiled the [Bagel Twist](#), featuring our famous bagels twisted into a more portable, easy-to-eat shape, perfect to keep you running on-the-go at work or play. They're available in a variety of flavors...if you're looking to satisfy your chocolate cravings this month, try the new Chocolate Chip Bagel Twist, which is drizzled in chocolate and filled with chocolate chips.



Dunkin' Donuts Chocolate Chip Bagel Twist

Bagels are becoming increasingly popular in Asia. So, in South Korea, one of Dunkin' Donuts' top-selling international bagel markets, we recently introduced a bite-sized "pop-able" snack for bagel lovers.





Dunkin' Donuts Bagel Bites, available in South Korea

If you want to join us in the celebration of National Bagel Day, on February 9 Dunkin' Donuts is offering brand followers of [@DunkinDonuts](#) on Twitter the opportunity to score a \$100 [Dunkin' Donuts Card](#). For a chance to win, all you need to do is offer a guess on how many poppy seeds cover a typical Dunkin' Donuts Poppy Seed Bagel, plus the hashtag [#BagelDDay](#). (Yes, we actually counted!) If you would like to offer a toast to your beloved bagel, please visit the Dunkin' Donuts [Facebook page](#) to answer our 'heated' debate: Do you enjoy your bagel toasted, or untoasted?

Whether you enjoy yours round, twisted or bite-sized, with cream cheese or without, here's a "toast" to bagels and bagel lovers everywhere. Happy National Bagel Day!

This entry was posted on Thu Feb 10 06:00:00 EST 2011 and filed under [Bagels](#) and [Social Media](#). You can follow any responses to this entry through the [Atom](#) feed. You can [leave a response](#), or [trackback](#) from your own site.

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It's easy to fuel up at Dunkin' Donuts so you can get on with your day. We bring you a range of delicious products no matter what you're craving.

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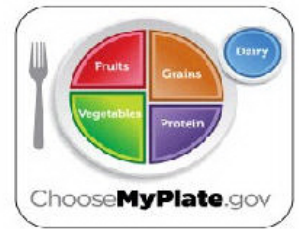
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To: DD IP Holder LLC (wades@dicksteinshapiro.com)
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Sent: 5/17/2012 7:22:30 PM
Sent As: ECOM105@USPTO.GOV
Attachments:

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

**USPTO OFFICE ACTION HAS ISSUED ON 5/17/2012 FOR
SERIAL NO. 85529535**

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from 5/17/2012 (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.