

February 12, 2013

Jane Client
123 Main Street
Rochester, NY 14624

VIA USPS

Re: Docket No.:
Trademark Search: "Goldfish Innovations"

Dear Mrs. Client:

It was a pleasure meeting you today. Below are the results of your trademark search.

SCOPE OF SEARCH

The goal of this search was to evaluate whether the term "**Goldfish Innovations**" was available as a brand for Federal Trademark Protection and registration with the United States Patent and Trademark Office (USPTO) for use with goods in the nature of eye gaze communication boards. The presumption is that the mark will be used in interstate commerce and therefore qualifies for federal trademark protection.

For goods, interstate commerce involves sending the goods across state lines with the mark displayed on the goods or the packaging for the goods. With services, interstate commerce involves offering a service to those in another state or rendering a service that affects interstate commerce (e.g. restaurants, gas stations, hotels, etc.). This might be phone or virtual consultations, webinars, or writing educational materials for national distribution.

It is my understanding that eye gaze communication boards are augmentative and alternative communication systems (AAC) that encompasses the communication methods used to supplement or replace speech or writing for those with impairments in the production or comprehension of spoken or written language. AAC systems are used by those with a wide range of speech and language impairments, including congenital impairments such as cerebral palsy, intellectual impairment and autism, and acquired conditions such as amyotrophic lateral sclerosis and Parkinson's disease.

The following International Classes were selected for searching based on their relation to the goods and services you plan to market. There are 45 broad classes and your goods could potentially fall into 3 different “goods” classes and 2 different “services” classes should you ever expand your brand into teaching and training services. Below are the potential classes:

International “Goods” Classes

009 – This class includes: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and **teaching apparatus and instruments**.

010 – This class includes: Surgical, **medical**, dental and veterinary **apparatus and instruments**, artificial limbs, eyes and teeth; orthopedic articles; suture materials. Class 10 includes mainly medical apparatus, instruments and articles.

016 – This class includes Paper, cardboard and goods made from these materials, not included in other classes; **printed matter**; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); **instructional and teaching material (except apparatus)**.

International “Service” Classes

038 – This class includes: Telecommunications. Class 38 includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which:

- (1) allow one person to talk to another,
- (2) transmit messages from one person to another, and
- (3) place a person in oral or visual communication with another (radio and television).

041 – This class includes education; **providing of training**; entertainment; sporting and cultural activities and covers mainly services rendered by persons or institutions in the development of the mental faculties or physical fitness of persons or animals, as well as services intended to entertain or to engage the attention.

Following are 3 current or previously registered marks for similar goods as yours. Although two of them have been canceled since registration, they were valid marks in each of their respective classes. These example demonstrate that your goods could potentially be registered in 3 different classes. You should carefully consider which classes of goods and services you choose to register your mark in.

Word Mark	EYEGAZE EDGE
Goods and Services	IC 009. US 021 023 026 036 038. G & S: Computer hardware and software for measuring eye movement. FIRST USE: 20080331. FIRST USE IN COMMERCE: 20080701

Word Mark	OPTICOMMUNICATOR
Goods and Services	(CANCELLED) IC 010. US 044. G & S: Communication aid for the handicapped consisting of a transparent panel having a central opening bordered by symbols. FIRST USE: 19841003. FIRST USE IN COMMERCE: 19841005

Word Mark	NU-VUE-CUE
Goods and Services	(CANCELLED) IC 016. US 038. G & S: Educational Materials-Namely, Teaching Manuals, Eye Gaze Charts, Floor Charts, and Desk Charts. FIRST USE: 19791200. FIRST USE IN COMMERCE: 19800100

It is my understanding that currently Goldfish Innovations, LLC does not provide communication or training services but may in the future if they expand their business to train people in using the eye gaze boards or provide support services such that a person facilitates the communication.

With your current and potential future business prospects in mind, a search for the literal elements was conducted of all US Federal and state, registered and applied for marks as of February 12, 2013. As a courtesy, and at no extra charge, we expanded the US search to include the Federal registrations of Canada, Mexico, and the World Intellectual Property Organization. The search was conducted of the literal elements of all US state registered marks within the most current database of state marks.

Additionally, a search was conducted of common law marks of the literal elements of your mark, including selected top level domain (TLD) name registrations (.com, .net, .org, .biz, .info, .mobi, .tel, .travel, .tv, .asia).

The search criteria included the following searches (terms are not case sensitive):

1. The term as a whole “Goldfish Innovations”
2. The term as a whole “Goldfish”
3. The terms “gold” and “fish” and “innovations” together in any order

The search also substituted similar words using phonetic substitutions to identify other terms incorporating dominant portions of the mark at issue.

EXECUTIVE SUMMARY OF SEARCH RESULTS

The term “Goldfish Innovations” may be registerable on the Federal Register. However, careful consideration must be made in selecting which classes or multiple classes you would like to obtain exclusive rights in commerce. It is recommended that you consider filing in multiple classes.

SEARCH RESULTS OF REGISTERED OR APPLIED FOR MARKS

As there were no results for the direct combined term “Goldfish Innovations”, the dominant term “Goldfish” was primarily searched and examined in consideration of the “confusingly similar” standard. A mark considered to be “confusingly similar” need only be based upon a dominant portion of a mark and not the mark in its entirety. As such the dominant, term “Goldfish” was examined separately in the International Classes 009, 010, 016, 038, and 041.

The specific results of the searches are below.

TERM	# of RESULTS
Goldfish Innovations	0
Goldfish in International Class 009	14
Goldfish in International Class 010	0
Goldfish in International Class 016	7
Goldfish in International Class 038	2
Goldfish in International Class 041	9

Goldfish in International Class 009

	Serial Number	Reg. Number	Word Mark	Live/Dead
1	85737312		DIGITAL GOLDFISH	LIVE
2	78643998		GOLDFISH	DEAD
3	77907721	4010061	GOLDFISH	LIVE
4	77215952		THE GREAT GOLDFISH GIVEAWAY	DEAD
5	75517170		GOLDFISH	DEAD
6	75124403	2108569	TRUSTY THE GOLDFISH	DEAD
7	76125158		GOLDFISH BOWL	DEAD
8	77907721	4010061	GOLDFISH and Design	LIVE
	And 6 Canadian marks			

Goldfish in International Class 010

None

Goldfish in International Class 016

	Serial Number	Reg. Number	Word Mark	Live/Dead
1	78643988		GOLDFISH	DEAD
2	75124403	2108569	TRUSTY THE GOLDFISH	DEAD
	And 5 Canadian Marks			

Goldfish in International Class 038

	Serial Number	Reg. Number	Word Mark	Live/Dead
1	75982504	2682194	SECRET GOLDFISH	DEAD
	State Registry	Minesotta	Goldfish Communications	

Goldfish in International Class 041

	Serial	Reg.	Word Mark	Live/Dead
1	78938638	3318156	GOLDFISH SWIM SCHOOL WHERE THE EXPERIENCE IS	LIVE
2	77803717		GOLDFISH KIDS	DEAD
3	77566979	3605933	GOLDFISH SWIM SCHOOL	LIVE
4	77231832	3408467	GOLDFISH CENTRAL	LIVE
5	77052987	3494546	GOLDFISH	LIVE
6	75982504	2682194	SECRET GOLDFISH	DEAD
7	74121880	1694938	THE OFFICIAL GOLD FISH RACING EVENT TOUR DE FISH	DEAD
	State Registry	California	Julian Goldfish Rodeo	Abandoned
	State Registry	Colorado	Runaway Goldfish	Abandoned

Each of the results were examined and it was determined that it is unlikely that they would be considered confusingly similar to your desired mark “Goldfish Innovations” when considering the mark in its entirety and the description of your goods and services is accounted for.

SEARCH RESULTS OF COMMON LAW MARK

	Terms	Results from Top Level Domain Search (.com, .net, .org, .biz, .info, .mobi, .tel, .travel, .tv, .asia)
1	goldfishinnovations	TLDs unavailable - .com – parked at godaddy.com
2	goldfish	TLDs unavailable <ul style="list-style-type: none"> - .com – ASCIO Technologies - .net – Suzhou Hitarget Goldfish Farm - .biz – Barclaycard of the UK - .mobi – Barclaycard of the UK - .tel – customer of Blacknight Internet Solutions - .asia – parked at godaddy.com - The rest are “unavailable” but may be available for purchase.

The results of the common law mark search of unregistered trade and business names revealed that there is an eBay “myworld” seller from the United Kingdom whose username is goldfishinnovations, but does not appear to have a “storefront” set up under that name.

DISCUSSION

Common Law Trademarks

Common Law trademarks are trademarks that are used in consumer/business interactions that have not been registered either on a US State or Federal register. Common law trademarks are enforceable only where the mark has come to be identified with the user's goods or services, a territory often referred to as the "Zone of Actual Goodwill." Common law trademarks and the right to their exclusive use are classified among property rights; however, this right grows out of use and not mere adoption of the mark. (*Hanover Star Milling Co. v. Metcalf*) The general rule is that a common law mark is enforceable only in the limited area where it has come to be identified with the user's goods or services, in this case, eBay, and it is questionable if a username of a seller would be afforded trademark status.

Likelihood of Confusion

The controlling standard for determining likelihood of confusion is whether the purchasing public would mistakenly assume that your product or service in the nature of eye gaze communication boards, originates with, are sponsored by, or are in some way associated with the goods offered under another mark, or vice-versa. (*FBI v. Societe: "M. Bril & Co."*, 172 U.S.P.Q. 310 (TTAB 1971)).

All factors set forth in the *In re DuPont de Nemours & Co.* case must be considered when determining whether a likelihood of confusion exists. In this case, comparison of its mark and the other marks using the factors established in the *DuPont* case leads to a conclusion that there is no likelihood of confusion. When assessing the commercial impact of a mark, the standard of review is, what probable impact each mark will have on the ordinary purchaser in the marketplace. In other words, will the newcomer's mark likely confuse relevant purchasers and prospective purchasers?

The 13 *DuPont* factors are:

1. Appearance, sound, connotation, and commercial impression: The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.
2. The Goods: The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use.
3. Trade Channels: The similarity or dissimilarity of established, likely-to-continue trade channels.
4. Sales: The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
5. Fame: The fame of the prior mark

6. Similar Marks: The number and nature of similar marks in use on similar goods.
7. Actual Confusion: The nature and extent of any actual confusion.
8. Concurrent Use: The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
9. Variety of Goods: The variety of goods on which a mark is or is not used . . .
10. Market Interface: The market interface between the applicant and the owner of a prior mark
11. Right to Exclude: The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. Potential Confusion: The extent of potential confusion
13. Any Other Fact: Any other established fact probative of the effect of use.

These factors are taken together and considered as a whole. They are not given equal weight and any one factor may dominate. If a mark is found in one international class, the inquiry is whether each business' services are related or marketed in such a way that they would be encountered by the same person in a situation that would create the incorrect assumption that they originated from the same source. A careful examination of the conditions under which a consumer purchases and to whom sales are made must be made.

When assessing the commercial impact of a mark, the standard of review is, what probable impact each mark will have on the ordinary purchaser in the marketplace. In other words, will the newcomer's mark likely confuse relevant purchasers and prospective purchasers? The likelihood of confusion depends on a comparison of the overall impression of the marks. Marks cannot be dissected and no feature of a mark should be ignored. As such, the determination must be made on the mark as presented without dissecting it into separate elements.

ANALYSIS and OPINION

The results of the US State and Federal registers were reviewed in light of the "confusingly similar" standard and the DuPont factors and no registered marks have been identified as barriers to registration. The "**Goldfish Innovation**" elements are discernible for all active US Federal and State registered marks. The other marks all have different literal or graphic elements. Literal elements tend to be dominant in a consumer's memory, especially when the graphic elements are weak, common or generic in nature. The common sense precept is that the more forceful and distinctive aspects of the mark should be given more weight. In this case, the literal portions play a critical role in the overall commercial impression of the mark. Likelihood of confusion is avoided when the common portions or incorporated mark is combined with other features in such a way that its identity is lost or so merges with the other features that overall the marks are dissimilar in sound, appearance and meaning. That is the case here. A well informed court may find that that this non-common subject matter is

sufficient to avoid confusion. When taken together, it cannot be said that these literal elements would play no role in the consumer's perception of the mark as a whole.

The results of the common law search revealed that there is an eBay "myworld" seller from the United Kingdom whose username is goldfishinnovations, but does not appear to have a "storefront" set up under that name.

My advice and opinion is that the mark is registerable, however you may wish to protect your mark in the 3 different classes for goods, to obtain the exclusive use that you desire.

I hope this information is useful in your decision to proceed in registering the mark. Please call to discuss the search if you have additional questions or concerns.

Respectfully,

Attorney