

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

James Brush)	Art Unit:
)	
MARK: EMPIRE)	Examining Attorney: John E. Michos
)	
)	Serial No.: 86/609,657
)	
Docket No.: MPH 14-18)	Filing Date: 04/24/2015

Commissioner for Trademarks
Box Responses Non-Fee
PO Box 1451
Alexandria, VA 22313-1451

RESPONSE

This communication is in response to the Office Action of February 26, 2016.

Responsive Remarks

Applicant takes issue with the final refusal to register applicant's EMPIRE mark. The registrant's stylistic PREMIUM IMPRINTS EMPIRE mark should not bar applicant's right to register the EMPIRE mark. It is unfortunate that the United States Patent and Trademark Office has no effective tribunal to register an applicant's notorious EMPIRE mark which is nationally recognized as a source of applicant's goods and services. Applicant's EMPIRE mark antedates by decades the newcomers Q & V Screen Printing Inc. registered stylistic mark which bears little if any semblance to applicant's EMPIRE mark as notoriously known and recognized by consumers. This is particularly troubling in view of the common law rights already vested in applicant's EMPIRE mark through decades of notorious nationwide use and recognition by consumers identifying the applicant being the source of the "EMPIRE" services.

The ordinary consumer of the defined services upon hearing the "EMPIRE" mark would readily recognize the applicant and not the registrant as being the source of the EMPIRE services and goods. Applicant's vast nationwide sales force including its corporate as well as regional vendors and representatives, its research and technology staffing, administrative and

manufacturing personnel as well as other staffing and resources are clearly indicative of large corporate entity within the printing trade having wide spread nationwide consumer recognition and ownership to the EMPIRE mark. This vast Empire network has involved more than sixty years of hard work. In contrast, the registrant is a small localized entity with few employees (15) without any extensive national market penetration. The registrant knows or should have known that it does not own the EMPIRE mark or that registrant is not recognized as a quality printing source of the EMPIRE mark.

If you Google and type in “Empire Screen” the prompter queries whether or not you mean “Empire Screen Printing” which in turn takes you directly to applicant’s website advertising its EMPIRE services. Such a query does not direct you to the registrant. This provides further evidence of the notorious nationwide recognition of the applicant as being the owner of the EMPIRE mark as it applies to printing services. Empire’s employment has grown to over 200 employees with a manufacturing space of more than 150,000 square feet. The applicant also has a nationwide network of at least 15 regions serviced by sales representatives representing all 50 U.S states. The applicant has research support which has brought nationwide recognition for its technological contributions to the printing industry. The registrant as evidenced by its website is totally devoid of those capabilities and national sales exposure which have propelled the applicant as being recognized as the nationwide source of the EMPIRE goods and services.

The Examining Attorney has lost sight of those factors which establish nationwide recognition of a mark as the source of goods and services. The registrant’s mark of record constitutes a stylistic mark with the word marking PREMIUM IMPRINTING EMPIRE. Unlike an Examining Attorney’s requirement to disclaim certain words apart from the mark, the average

consumer does not dissect and discard words from a composite or compounded word mark. The ordinary consumer perception of the registrant's mark is PREMIUM IMPRINT EMPIRE and not EMPIRE only. The average consumer when viewing a registrant's stylistic mark does not totally discard the mark in its entirety and seize only upon the word "EMPIRE" as constituting the sole marking of the registrant's mark. To the average consumer's perception, the proceeding words of "PREMIUM" and "IMPRINTING" are clearly legible and would create a more meaningful and pronounced perception to the consumer than the illegible and cryptic "EMPIRE" wording. Besides its stylistic form with its obscured EMPIRE wording, the registrant's mark wording consists of PREMIUM IMPRINTING EMPIRE. The average consumer would not upon seeing or hearing the registrant wording in its entirety selectively dissect and discard the words PREMIUM IMPRINT as being meaningless and perceive only the "EMPIRE" mark. The initial impression by the average consumer is the entire wording. The average consumer would not disregard the more prominent PREMIUM IMPRINT mark wording and perceive the wording EMPIRE as its sole word marking and source of the service. The rules for determining confusion rely upon whether or not the ordinary consumer within the trade would be confused. The legal technicalities alleged in the final refusal to register applicant's EMPIRE mark loses sight of those factors in the totality which are essential to resolve the confusion amongst consumer's criteria.

If the final refusal is not withdrawn, the factual circumstances would force the applicant into a different forum to verify those rights which are already vested in the market place to the applicant. Under the Lanham Act it is most unfortunate that a late-comer without any nationwide recognition can obtain a registration barring a meritorious mark upon a conglomerate wording which defies the ordinary consumer's perception and recognition of applicant's

EMPIRE mark. It is also unfortunate that inappropriate technicalities without substance form the basis for the refusal. Applicant stands upon the position taken in applicant's last response and the evidence made of record. Applicant specifically requests the Examining Attorney to withdraw the final refusal. Applicant does not hereby waive any of its vested rights to the EMPIRE mark.

Withdrawal of Refusal and Allowance

Applicant respectfully requests a withdrawal of the refusal to register applicant's mark. Applicant respectfully submits the application is in condition for allowance and publication. Should there exist any outstanding issues, applicant's attorney respectfully requests the Examining attorney to contact the undersigned so that any such outstanding issues may be expeditiously handled.

Dated this 25th day of August 2016.

Respectfully submitted,



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