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**Subject:** U.S. Trademark Application Serial No. 88729282 - MARATHON (GOLD) - 057273-04593  
**Sent:** July 20, 2021 12:43:48 PM EDT  
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**Attachments**

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

**U.S. Application Serial No.** 88729282

**Mark:** MARATHON (GOLD)

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**Applicant:** Asghedom, Samiel G.

**Reference/Docket No.** 057273-04593

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**REQUEST FOR RECONSIDERATION  
AFTER FINAL ACTION  
DENIED**

**Issue date:** July 20, 2021

**Applicant's request for reconsideration is denied.** See 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Accordingly, the Section 2(d) Refusal is **maintained and continued**. See TMEP §§715.03(a)(ii)(B), 715.04(a).

**As applicant has already filed an appeal** with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

Further discussion about issues made final.

#### SUMMARY OF ISSUES MADE FINAL

- Section 2(d) Refusal - Likelihood of Confusion

#### SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The final refusal of registration of the applied-for mark because of a likelihood of confusion with the mark in U.S. Registration No. 0529753 is **maintained and continued**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the registration attached to the previous Office action.

The applied-for mark is MARATHON (GOLD) for "Jewelry made in whole or significant part of gold" in International Class 14.

The registered mark is MARATHON for "Jewelry for personal adornment, not including watches-, namely, lockets, bracelets, finger rings, neck-chains, bracelet-chains, pendants, chains and pendants, all of which are either made of or plated with precious metal" in International Class 14.

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 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. 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.

#### Comparison of the 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 applied-for mark is similar to the registered mark because the marks begin with the word MARATHON. As the marks begin with MARATHON, that term will make the first impression on consumers. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”). When looking for jewelry goods, consumers will believe both of these marks emanate from the same source because they use the word MARATHON at the beginning of the marks.

The term "marathon" is defined as "a cross-country footrace of 26 miles, 385 yards" and "an event or activity that requires prolonged effort, endurance, or attention." *See attached evidence*. In the context of jewelry goods, the term MARATHON does not have a direct descriptive meaning, but gives the marks a suggestive commercial impression of jewelry goods that endure over time. As the term MARATHON in both marks will give the marks the commercial impression of jewelry that endures, confusion is likely.

The applied-for mark includes the term GOLD, but applicant provided a disclaimer for that term as it describes the material composition of the jewelry goods. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). As the word GOLD in the applied-for mark is descriptive, it is less significant in terms of affecting the mark’s commercial impression, and renders the wording MARATHON the more dominant, source-indicating element of the mark.

Moreover, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See Coca-Cola Bottling Co. v. Jos. 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 Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); TMEP §1207.01(b)(iii). In this case, the addition

of the term (GOLD) does not obviate a likelihood of confusion because the use of the similar word MARATHON would confuse consumers. Consumers would see the word MARATHON at the beginning of both marks and believe that both jewelry goods emanated from the same source because they would think that MARATHON (GOLD) is merely the gold variation of the MARATHON jewelry goods. As a result, despite the addition of the term (GOLD), there is a likelihood of confusion between the marks because of the use of the identical wording MARATHON.

Applicant and registrant identify jewelry goods. Where the goods 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. *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). As both applicant and registrant identify jewelry made with precious metals, the degree of similarity between the marks required to support a finding that confusion is likely declines.

Applicant argues that the additional term (GOLD) in the parentheses in the applied-for mark set the applied-for mark apart from the registered mark. When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b). As discussed above, despite the elements in the applied-for mark that do not appear in the registered mark, the marks have a similar commercial impression of jewelry that endures because of the word MARATHON. The overall recollection of the average purchaser would be the dominant element MARATHON. The term GOLD merely describes the material composition of the jewelry goods and the parentheses would likely be interpreted by consumers as there to clarify how the jewelry is made of gold. As a result, despite the differences, a likelihood of confusion exists because of the use of the similar word MARATHON.

In the request for reconsideration, applicant has included improper evidence of third-party registrations, in the form of a list of the registrations. The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record. *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974); TBMP §1208.02. To make registrations of record, copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from the USPTO’s Trademark database) must be submitted. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994). Therefore, the examining attorney objects to the improper evidence of third-party registrations. *See* TMEP §710.03.

Notwithstanding the insufficiency of the evidence, and in the event that the Board overrules the objection and considers the evidence, applicant’s arguments related to the third-party registrations are unpersuasive. Applicant included its list of registrations to support the argument that the term MARATHON is weak, diluted, or so widely used that it should not be afforded a broad scope of

protection. However, the term MARATHON in the marks listed by applicant is predominantly used in a different manner than in the applied-for mark.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods. *See Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).

The marks listed by applicant are almost all marks for road races where the name of the race appears before MARATHON, such as BOSTON MARATHON. These marks present a different commercial impression that the applied-for mark as in those marks MARATHON is a descriptive term for the road race and operates as a descriptor while MARATHON in the applied-for mark is not descriptive and does not give the commercial impression of a road race and instead gives a commercial impression of products that will endure. As a result, there are few, if any, similar marks that use the term MARATHON for similar goods. Evidence comprising only a small number of third-party registrations for similar marks with similar goods, as in the present case, is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few registrations are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; *In re I-Coat Co.*, 126 USPQ2d 1730, 1735 (TTAB 2018). Thus, the few similar third-party registrations submitted by applicant are insufficient to establish that the wording MARATHON is weak or diluted.

Thus, when looking at the jewelry goods identified in the marks, a consumer would be confused as to the source of the goods because of the use of the word MARATHON. Therefore, the marks are confusingly similar.

### Comparison of the Goods

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Applicant identifies all jewelry goods which is wording broad enough to include the specific jewelry goods specified by registrant. Registrant specifies that its jewelry goods are made of or plated with precious metal, which is wording broad enough to include applicant's jewelry made in whole or significant part of gold. As applicant's goods encompass registrant's goods, or vice versa, the goods are related. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball*

*Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant’s and registrant’s goods are related.

Thus, when confronted by applicant's and registrant's goods, consumers would likely be confused as to the source of the goods because they identify closely related jewelry goods. Therefore the goods are closely related.

Since the marks are similar and the goods are related, there is a likelihood of confusion as to the source of applicant’s goods. Therefore, the final refusal pursuant to Section 2(d) of the Trademark Act is ***maintained and continued***.

#### 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.

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## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on July 20, 2021 for  
**U.S. Trademark Application Serial No. 88729282**

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

- (1) [Read the official letter](#).
- (2) **Direct questions** about the contents of the Office action to the assigned attorney below.

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Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

- (3) **Respond within 6 months** (or earlier, if required in the Office action) from July 20, 2021, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond.

### 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](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application.](#)

Private companies **not** associated with the USPTO often use public information provided in USPTO trademark applications to mail and email trademark-related offers and notices - most of which require fees. These companies often have names similar to the USPTO. All **official USPTO correspondence** will only be **emailed from the domain "@uspto.gov"**.