

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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In re Application of)	
Applicant: American Bible Society)	Law Office: 120
Serial No.: 88207198)	
Class: 36)	Examining Attorney:
Date Filed: November 27, 2018)	Jacquelyn A. Jones
Mark: FIRST THING)	
)	

Response to Office Action

In response to Office Action dated July 31, 2019, Applicant American Bible Society responds as follows.

The Examining Attorney continued the refusal to register Applicant’s mark on the ground of likelihood of confusion with the prior registered mark “K U R T W A R N E R FIRST THINGS FIRST F O U N D A T I O N MATTHEW 6:33” (plus design) (Reg. No. 2701448). The Examining Attorney stated that “where the 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 services.’”

Applicant believes the differences in the services of the two marks are already sufficiently different, such that the differences in the wording of the two marks preclude a likelihood of confusion. Nevertheless, Applicant hereby requests amendment of its identification of services to further distinguish the services from those of the prior registrant. Specifically, Applicant requests removal of the general identification services, “*charitable fundraising*,” which the Examining Attorney stated as “broad” and “encompasses all services...including registrant’s more narrow ‘*Charitable fundraising services that primarily promote Christian values in others.*’” Although Examining Attorney does not mention a conflict with Applicant’s remaining services, Applicant also removes “*the general public*” from the remaining identification to even further distinguish its services from the cited mark by narrowing the target audiences.

Applicant’s remaining identification is as follows: “*Charitable fundraising to support the promotion and encouragement of daily Bible engagement to military members and their families, multi-lingual communities, immigrants, prisoners, and members of Christian denominations.*” This amended identification of services is very narrow in purpose and is limited to highly specific target audiences, such that, if there was any overlap previously, there is no longer any overlap. Thus, the significant differences between the two marks are now clearly sufficient to preclude any likelihood of confusion.

As Applicant stated in its prior Office Action Response (all previous arguments and evidence of Applicant are incorporated by reference herein), Applicant’s mark is not confusingly similar because the mark presents a substantially different commercial impression from the registered

mark. While considering the similarities between the marks, it is appropriate to evaluate each mark in its entirety while according greater importance to the more distinctive elements. In the prior registered mark, the design portion is the largest element of the mark, while Applicant's mark has no design. Also, the terms that the marks share, "FIRST THING," are not very noticeable in the cited mark. Furthermore, the cited mark has many additional words that give the marks substantially differing commercial impressions. The terms in the cited mark, "KURT WARNER," "MATTHEW 6:33," and "FOUNDATION" all have distinct meanings differentiating it from Applicant's mark. Given the many differences in sight, sound, and meaning, when the marks are compared in their entireties, in light of the significantly narrowed identification of services, Applicant's mark is clearly distinct from the cited mark and does not present a likelihood of confusion.

Applicant respectfully submits that its application is in condition for publication and requests such action be taken.