

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Applicant:	Element Brand Holding, LLC)	
Mark:	ELEMENT SMART APPLIANCE)	Examining Attorney: Katherine Ferrell
App. Ser. No.:	88/397,086)	Law Office: 126
Filing Date:	April 22, 2019)	

REQUEST FOR RECONSIDERATION

The only issue remaining in the Final Office Action that the Examining Attorney sent on December 19, 2019 is a Section 2(d) refusal based on an alleged likelihood of confusion between Applicant’s mark and cited U.S. Registration No. 4,924,874 (the “Cited Mark”). Applicant respectfully disagrees with the refusal and respectfully requests that it be withdrawn.

In support of this request, Applicant submits perhaps the most persuasive evidence that no likelihood of confusion exists here: a consent agreement with the registrant of the Cited Mark, Fiskars Denmark A/S, confirming the registrant’s belief that Applicant’s mark has not and will not create a likelihood of confusion with its Cited Mark. Applicant and the registrant of the Cited Mark have reviewed the facts and circumstances for each party’s use and registration of their respective trademarks, and each has agreed that consumer confusion is unlikely to occur. The parties have set out the substantiation for their agreements in a formal Consent Agreement, attached as **Exhibit 1**, which contains:

1. The registrant’s consent for Applicant to register Applicant’s mark;
2. The parties’ acknowledgement and agreement that their respective trademarks are distinguishable;
3. The parties’ acknowledgement and agreement that their respective products do not compete with one another;

4. The parties' acknowledgment and agreement that, following review of their respective relevant consumers and services, Applicant's use and registration of its mark is not likely to cause consumer confusion; and
5. The parties' agreement to take necessary steps to avoid consumer confusion (if any) in the future.

A registrant's consent to an applicant's registration of a mark is a strong factor to be considered in response to a Section 2(d) refusal. T.M.E.P. § 1207.01(d)(viii) ("examining attorneys should give substantial weight to a proper consent agreement"). As the Court of Customs and Patent Appeals has stated:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1363 (C.C.P.A 1973) (emphasis in original). "Accordingly, the Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion." T.M.E.P. § 1207.01(d)(viii) (citing *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996 (Fed. Cir. 1985)).

Accordingly, for the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw her refusal and advance the application to publication for registration on the Principal Register.

Respectfully submitted,

Date: May 4, 2019

By: /Ian Block/

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