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Please place on Upper Right Corner
of Response to Office Action ONLY.
Examining Attorney: PHAM, LANA
Serial Number: 77/075123

VIA EMAIL & FACSIMILE
Commissioner of Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Trademark Application 77/075123
Applicant: Saratoga Harness Racing, Inc.
Mark: VAPOR
Filing Date: 2007-01-03

Dear Commissioner:

Please consider this letter a response to the Office Action dated April 25, 2007 (Examining Attorney Lana H. Pham), Law Office 115, where the Examining Attorney refused registration based upon the likelihood of confusion.

The Applicant, Saratoga Harness Racing, Inc. ("SHRI") is licensed by the NY State Division of Lottery for Video Lottery Gaming and by the NY State Racing and Wagering Board as a standard-bred race track. SHRI has been a world-class harness racing venue in Saratoga Springs, New York since 1941. SHRI was one of the first racetracks to have pari-mutuel wagering. In 2004, SHRI became the first video gaming facility in New York State. Currently, SHRI's facility houses over 1,700 video lottery terminals, a ½ mile harness track to host standard-bred racing, an enclosed clubhouse featuring a high-end restaurant ("Fortunes"), which is a 375 seat, tiered dining room and bar, pari-mutuel wagering and simulcast facilities for betting on harness and thoroughbred racing, training track, jogging track, horse stables for more than 900 horses, administrative buildings, a paddock barn, horseman's dormitories, a blacksmith's shop, maintenance building, 4,000 parking spaces, a hall of fame, polo fields and other maintenance and outbuildings. The video gaming encompasses more than 70,000 square feet, three food court dining options, with indoor and outdoor seating for 275, as well as a two-story nightclub "Vapor", which encompasses more than 15,000 square feet.

The examiner refused registration claiming that the mark "Magik Vapor" for entertainment services, naming live performances by musical rock band based in Glendale, California, so closely resembles the mark as to likely cause confusion.

As will be set forth in this response, both based upon differences in the physical appearances of the two marks, as well as the differences in consumers and channels of trade and advertising, a consumer in the market place could not mistakenly believe that a multi-use facility of the size, history, stature and character of Saratoga Harness Racing, Inc. is owned by a California rock band named Magik Vapor.

Saratoga Harness Racing, Inc. has filed two marks, the instant proposed mark "Vapor", International Class 041 for nightclub, lounge, music and live entertainment services as well as for Vapor nightclub, serial number 77/075183, a mark consisting of the words "Vapor Nightclub" in stylized format also for nightclub, lounge, music and live entertainment services. The examiner found "Vapor" confusingly similar to "Magik Vapor", a highly stylized mark for entertainment, namely live performances by a musical rock band from Glendale, California.

LIMITATION OF SERVICES

Applicant agrees to limit the description of goods and services to "Nightclub Services". This limitation will further serve to distinguished applicant's mark from "Magik Vapor".

ARGUMENT

THE EXAMINER ERRED IN REFUSING SHRI'S APPLICATION BASED UPON A SUPPOSED "LIKELIHOOD OF CONFUSION"

I. Standard for Reviewing a Trademark Application

Trademark Act Section 2(d), 15 U.S.C. §1052(d), provides, in pertinent part, that

> "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –
>
> "(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...."

See, also, Trademark Manual of Examining Procedure ("TMEP") §1207.01. The factors to determine whether a likelihood of confusion exists are set forth at length in the case of *In re E.I. DuPont de*

Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). In an *Ex Parte* application to the USPTO, a crucial *DuPont* factor is "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *See, Malletier v. Dooney & Burke, Inc.*, 454 F.3d 108, 117, 79 USPQ.2d 1481 (2d Cir. 2006). However, the other factors listed in *DuPont* must also be considered when relevant evidence is contained in the record. *See, In re Dixie Restaurants*, 105 F.3d 1405, 1406, 41 USPQ.2d 1531, 1533 (Fed. Cir. 1997). Ultimately, the issue is not whether the actual goods or services are likely to be confused with each other, but, rather, whether the public will be confused as to the source of the goods or services. (Emphasis Added). *See, In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ.2d 1687, 1690 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Industries, Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Each case must be decided on its own facts and the differences between marks are often subtle ones. TEMP §1207.01; *Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641 (C.C.P.A. 1982).

In order to find a likelihood of confusion, it must be shown that the goods and services of SHRI in connection with the Vapor Night Club and the goods and services provided by the rock bank "Magik Vapor" are "so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source." *See*, TMEP §1207.01(a)(i). Conversely, if the goods and services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create an incorrect assumption that they originated from the same source, then, even if the marks are identical, confusion is not likely. (Emphasis Added). TMEP §1207.01(a)(i); *See, e.g., Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for liquid drain cleaner not confusingly similar to LITTLE PLUMBER for advertising and literature related to the plumbing field).

II. The Examiner Erred in Finding the Marks Confusingly Similar

A. The Marks are Different in Appearance

The similarity or dissimilarity in appearance between marks is one relevant factor in determining whether there is a likelihood of confusion. *See*, TMEP §1201.01(b)(ii). When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ.2d 1894, 1897 (Fed. Cir. 2000). Here, an analysis of the dissimilarities between the marks "Vapor" and "Magik Vapor" necessitates a finding that no likelihood of confusion exists.

(i) The Marks Contain Different Words

The mark "Magik Vapor" clearly contains the word "Magik", which the mark "Vapor" does not contain. As set forth more fully in Section II. B., *infra*, the word "Magik" is a dominant term which eliminates any confusion which may exist. In sum, the only similarity between the two marks in terms of the words used is the common word "Vapor".

(ii) The Marks Contain Different Design Components

The registered mark "Magik Vapor" (registration no. 2,896,211) is stylized. The "Magik Vapor" mark consists of a capital letter "M" with a loop on the top left corner of the "M", a thin line forming the left portion of the "M" and a thicker line forming the remaining portion of the "M". The "A" and "G" are lower case letters in the same font as the "M", with a loop to the letter "G" extending below the line. The letters "I" and "K" are also lower case in the same font as the other letters, with a curve at the bottom portion of the "I" connecting to the "K". All the letters in the word "Magik" are attached to each other in a cursive style of writing, except that the letter "I" does not connect to the letter "G". The word "Vapor" in "Magik Vapor" consists of a capital letter "V" with a loop on the top left corner of the letter "V" similar to that on the letter "M" of "Magik". The left side line of the letter "V" is also thicker than the right side line. The right side of the "V" is rounded rather than straight. The letter "A" is lower case and similar to the "A" contained in the word "Magik". The letter "P" is also lower case, with the loop on the "P" not connecting at the bottom (resembling an upside-down "u") and the line on the "P" extending below the line. The letters "O" and "R" are both lower case in the same font as the other letters. All the letters in the word "Vapor" are also connected in a cursive style, except that the letter "V" is not connected to the letter "A". All in all, it is very purposefully distinguished and stylized.

The proposed mark "Vapor" is <u>not</u> stylized and is completely different in appearance than the stylized mark "Magik Vapor". Copies of both marks are attached for reference. To begin, the proposed mark "Vapor" appears in all capital letters in a uniform block style of font. All the letters in the mark "Vapor" are uniform in font size and appearance. No letters in the mark "Vapor" extend below the line. Each letter in the mark "Vapor" is separate from each other letter in a script style of font, rather than a cursive style as in the mark "Magik Vapor". Clearly, the mark "Vapor" does not share any of the same design components as the stylized mark "Magik Vapor" does.

Significantly, even if viewed in a uniform font and style, the words "Magik Vapor" and "Vapor" do not appear confusingly similar. When looking at these two marks, any person, without regard to their age or sophistication, would notice that the two marks start with totally different words. Not only are the words different, but there are also a different number of words in each mark: two words in "Magik

Vapor" and only one word in "Vapor".

B. The Marks are Distinguished by Use of the Dominant Term "Magik"

When determining whether there is a likelihood of confusion, the entirety of the mark must be examined as it is seen in the marketplace by consumers, not by dissection of the marks' component parts. *See, Reno Air Racing Ass'n, Inc. v. McCord*, 452 F.3d 1126, 1137, 79 USPQ.2d 1431 (9th Cir. 2006); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 744, 48 USPQ.2d 1503 (2d Cir. 1998); 2-5

Trademark Protection and Practice, §5.03(1)(a)(Matthew Bender & Co., Inc. 2007). The mere fact that marks are identical does not alone establish an infringing use. (Emphasis added). *See, What-A-Burger of Virginia, Inc. v. Whataburger, Inc.*, 357 F.3d 441, 449 n. 6, 69 USPQ.2d 1829 (4th Cir. 2004).

The Examiner found that SHRI's mark "may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's marks." (citations omitted). However, this argument fails to take into account the plethora of cases finding to the contrary – that marks, although similar or even identical in appearance, are not necessarily confusingly similar. *See, e.g.*, 2-5 Trademark Protection and Practice, §5.22 (containing a court-by-court collection of cases in which similar or even identical word marks were held not confusingly similar); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ.2d 1842 (Fed. Cir. 2000) (LASER and LASERSWING); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ.2d 1793 (Fed. Cir. 1987) (SWEATS and ULTRA SWEATS); *Bell v. Streetwise Records, Ltd.*, 761 F.2d 67, 226 USPQ 745 (1st Cir. 1985) (NEW EDITION and NEW EDITION); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 48 USPQ.2d 1503 (2d Cir. 1998) (STREETWISE and STREETSMART); *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 204 USPQ 609 (2d Cir. 1979) (BIONIC and BIONIC BOOT); *M-F-G Corp. v. EMRA Corp.*, 817 F.2d 387, 24 USPQ.2d 1538 (7th Cir. 1987) (SUPERCUT and SUPERCUTS); *W.L. Gore & Assoc. v. Johnson & Johnson*, 882 F.Supp. 1454, 36 USPQ.2d 1552 (D. Del. 1995) (GLIDE and EASY GLIDE); *Motown Productions, Inc. v. Cacomm, Inc.*, 668 F.Supp. 285, 5 USPQ.2d 1859 (S.D.N.Y. 1987) (NIGHTLIFE and NIGHTLIFE); *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735 (T.T.A.B. 1984) (FANTASTIC and FANTASTIK); *In re Conti*, 220 USPQ 745 (T.T.A.B. 1983) (SHEAR and SHEAR PERFECTION). Ultimately, there is no "per se" rule that certain goods and services are related, such that there must be a likelihood of confusion, from the use of similar marks in relation thereto. *See*, TEMP §1207.01(a)(iv).

It is well-settled that, "in considering the question of likelihood of confusion, although the involved marks must be regarded in their entireties, it is proper to recognize that one feature of a mark is more significant than the other features and to give greater force and effect to that dominant feature." *Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875, 878, 203 USPQ 733 (C.C.P.A. 1979)(Court affirms decision of the USPTO Trial and Appeal Board that the words "BURGER" and "SANDWICH" were dominant terms in the marks "BURGER CHEF" and "SANDWICH CHEF" such

that a consumer would not likely be confused between the two marks.). *See, also, Martin v. Crown Zellerbach Corp.*, 422 F.2d 918, 920, 165 USPQ 171 (C.C.P.A. 1970), *cert denied*, 400 U.S. 911 (1970).

Here, the Examiner erred in finding the mark "Vapor" confusingly similar to the mark "Magik Vapor" by (i) dissecting the marks and comparing a single similar word – "Vapor", and (ii) ignoring the fact that the two renditions of the word "Vapor" in each mark are incredibly dissimilar. When looked at in their entirety, it cannot be disputed that the term "Vapor" would not be confused by consumers as seen in the marketplace with the term "Magik Vapor". The use of the word "Magik" to modify "Vapor" is incredibly strong and memorable. It dominates "Vapor" and it is clearly the more memorable term, not only for its association with the word "Magic", but also for the intentional misspelling which is designed to and does attract attention. Ultimately, the use of the word "Magik" eliminates the possibility that any confusion would occur.

Ultimately, it appears that the Examiner wrongfully applied a "per se" rule that the goods and services offered by SHRI and the goods and services offered by the rock band "Magik Vapor" were confusingly similar simply by the use of somewhat similar – but ultimately very different – marks in relation thereto.

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C. Reference to the NY State Lottery

(i)Further diminishment of any likelihood of confusion.

SHRI is licensed by NY State Division of Lottery for video lottery gaming. There are more than 1,700 video gaming machines on SHRI's premises. As a condition of licensure, SHRI is subject to NY State Lottery Rules, Regulations and directions. Those rules require that any written advertising contain the logo of the NY State Lottery with the words "must be 18 to play video gaming machines or wager on horses. Please play responsibly." This further distinguishes the mark.

D. The Goods and Services of SHRI are not so related to the Goods and Services of the band "Magik Vapor" as to cause a Likelihood of Confusion

(i) SHRI and "Magic Vapor" Offer Unrelated Goods and Services

In order to find likelihood of confusion, the goods and/or services of the parties must be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *See, e.g., On-line Careline Inc. v. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ.2d 1471 (Fed. Cir. 2000). Under this factor, the courts look to the similarity of the parties' goods or services and the degree to which they compete with each other. *See, Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 281 n.8, 60 USPQ.2d 1609 (3d Cir. 2001); *see, e.g., Bell v. Streetwise Records, Ltd.*, 761 F.2d 67, 75, 226 USPQ 745 (1st Cir. 1985) (live musical entertainment found unrelated to the phonorecord market.). Ultimately, the closer the parties' goods or services are related in the mind of the consumers, the more likely that confusion may occur. *See*, 2-5 Trademark Protection and Practice, §5.05(1); *Shen Mfg, Co v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ.2d 1350 (Fed. Cir. 2004).

Here, SHRI's proposed mark is for "Nightclub services," while the "Magik Vapor" mark is for "Entertainment namely, live performances by a musical rock band." It should be noted that for "Magik Vapor", they are a rock band performing live. With all of the types of music in the world, they specify rock and they perform live. SHRI's mark is for nightclub services. There is no doubt any music and live entertainment services are incidental to the primary function of the nightclub and lounge which is to sell alcoholic beverages, wine, spirits and beer to its patrons. To the extent there is anything else such as music or live entertainment (which could be comedians, singers, dancers, impersonators, ventriloquists, etc.), the entertainment is only incidental to the nightclub. Significantly, by law in New York State where Vapor nightclub is located they cannot sell alcoholic beverages to anyone under the age of 21 years of age. The sale of alcoholic beverages in the State of New York is licensed by the New York State Liquor Authority and the sale of alcohol to anyone under 21 years of age leads to loss of license. Accordingly, Vapor restricts its premises to patrons over the age of 21 years of age and does not market to anyone less than 21 years of age. "Magic Vapor" offers live, musical rock, but that is its main and only function. The rock music is not incidental and it offers only that service. It does not and cannot offer any nightclub, or bar services. It does not and cannot hold a liquor license and does not and cannot legally sell alcoholic beverages to consumers which is the primary purpose for Vapor.

Vapor is a two-story nightclub and lounge and spans over 15,000 square feet on two levels. It offers a variety of entertainment options such as disc jockey and live music of all types (crooners, folk, rock, polka), as well as other entertainment options such as dancing, comedians, viewing

football on large screens throughout the facility. There is seating area around a fireplace, an outside seating area, a large dance floor and a 16-foot video screen. It is located immediately adjacent to the gaming floor at Saratoga Gaming and Raceway, which is the name under which Saratoga Harness Racing, Inc. conducts business in New York State.

Arguably, the subject marks could be encountered by some of the same purchasers and found in some of the same channels of trade. For instance, a consumer seeking tickets to a performance by the rock band "Magik Vapor" on the Internet could possibly come across the website for the Vapor Night Club. However, they would immediately see that the source of the two marks is completely different – i.e. the "Magik Vapor" rock band verses the Saratoga Gaming and Raceway facility. Moreover, purchasing tickets for a "Magik Vapor" show would not be an impulse buy and any such purchaser would not be confused into thinking that "Magik Vapor" in fact owned the Vapor Night Club. Significantly, while "Magik Vapor" appears to perform rock music in parts of California and parts of Las Vegas, SHRI is not mobile and its more than 60 acre facility is in New York State. It targets its marketing to a 50 mile radius of Saratoga Harness Racing, Inc., which is where a vast majority of its customers originate.

(ii) Analogous Situations in Which Courts have Found no Likelihood of Confusion

Analogous to the situation at bar are the more common instances of similar food marks to restaurant marks. Courts have held that simply because restaurants serve food and beverages does not automatically mean that the food and beverages are related to restaurant services for determining whether a likelihood of confusion exists, even if the restaurant and food marks are identical. *See, e.g., Jacobs*, 668 F.2d at 1236, 212 USPQ 641. Similarly analogous is the situation where courts have found that live musical entertainment is not necessarily related to the phonorecord market. *See, Bell,* 761 F.2d at 75, 226 USPQ 745. Also analogous is the situation where the court has found that liquid drain cleaner was not confusingly similar with advertising and literature related to the plumbing field. *See, Local Trademarks, Inc.*, 16 USPQ.2d 1156.

Accordingly, in connection with SHRI's applications for "Vapor", just because the Vapor Night Club will offer some live entertainment in addition to its night club services does not automatically mean that night club services are related to rock bands for purposes of determining likelihood of confusion.

(iii) The Goods and Services Offered by SHRI and "Magic Vapor" are not Within Each Entity's "Logical Zone of Expansion"

The Examiner correctly claims that "any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods and services for purposes of analysis under Section 2(d)." *See, In re General Motors Corp.*, 196 USPQ 574 (T.T.A.B. 1977). As noted, the test is whether purchasers would believe the product or service is within the registrant's "logical zone of expansion." *See, CPG Products Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (T.T.A.B. 1983). However, despite the Examiner's position, it is wholly illogical that purchasing and owing a night club or bar would be within the normal field of expansion for a rock group solely engaging in live performances. A night club would be a business in an entirely different industry than rock music. Likewise, as noted above, it is highly unlikely that the rock band "Magik Vapor" would obtain a liquor license to sell alcoholic beverages to consumers.

E. The Examiner Failed to take into Account other Relevant *DuPont* Factors

As noted above, other relevant *DuPont* factors must also be taken into account when relevant evidence is contained on the record. *See, In re Dixie Restaurants*, 105 F.3d at 1406, 41 USPQ.2d at 1533. The following *DuPont* factors were not taken into account by the USPTO despite the presence of relevant evidence.

(i) Channels of Trade and Advertising

Generally, where the parties' channels of trade and advertising are different, there is less of an opportunity for consumer confusion. *See*, 2-5 Trademark Protection and Practice, §5.06(1); *M2 Software, Inc. v. Madacy Entertainment*, 421 F.3d 1073, 1083, 76 USPQ.2d 1161 (9th Cir. 2005). Further, where the parties advertise in (i) different media, (ii) the same media but with little geographic overlap or (iii) in media directed at different potential customers, the advertising factor will most likely weigh against finding a likelihood of confusion. *See*, 2-5 Trademark Protection and Practice, §5.06(3).

The channels of trade factor asks where, how and to whom a parties' goods or services are sold. *See, Frehling Enterprises, Inc. v. Int'l Select Group, Inc.*, 192 F.3d 1330, 1339, 52 USPQ.2d 1447 (11th Cir. 1999). When a party markets their product to a specific audience, rather than to the general public, there is less of a chance of a likelihood of confusion. *See, e.g., Big Dog Motorcycles, L.L.C. v. Big Dog Holdings, Inc.*, 402 F.Supp.2d 1312, 1330-1331, 79 USPQ.2d 1187 (D. Kan. 2005) (court finds no likelihood of confusion in two parties using the BIG DOG trademark where one party, a clothing company, marketed apparel in its mall-based stores, mail order catalogues and website, and the other party, a motorcycle manufacturer, marketed its motorcycles in its own showroom and dealerships only to

motorcycle enthusiasts.). Where the parties market their products in different outlets, Courts have found this to "lessen the possibility of confusion, mistake, or deception." *See, e.g., Moore Business Forms, Inc. v. Ryu*, 960 F.3d 964, 974-975, 64 USPQ.2d 1321 (10th Cir. 2002).

Vapor Night Club is located in the City of Saratoga Springs, New York. Much of its advertising is centralized to the upstate New York market and consists of billboards and local newspaper advertisements. Additionally, Vapor Night Club advertises on the Internet at its website: www.vapornightclub.com. In contrast, pursuant to the website www.magikvapor.com, the rock bank "Magik Vapor" is based in Los Angeles, California and appears to perform primarily in and around Los Angeles and in Las Vegas. Accordingly, other than by use of the Internet, the parties do not market their services using the same channels of trade. Moreover, the band "Magik Vapor" targets a specified audience of consumers interested in their style of rock music, whereas the Vapor Night Club targets a broader audience of consumers – namely, any adult over the age of 21 years who wishes to visit a bar/lounge on the property of the Saratoga Gaming and Raceway. In contrast, "Magik Vapor" might target rock music aficionados of any age. Vapor Night Club does not even allow anyone under the age of 21 on its premises and does not market to them.

With respect to the parties' Internet advertising, Courts have held that general use of the Internet for advertising is not the equivalent of overlapping channels of trade. *See, e.g., U.S. Conference of Catholic Bishops v. Media Research Center*, 432 F.Supp.2d 616 (E.D. Vir. 2006); *Current Comm. Group, LLC v. Current Media*, LLC, 76 USPQ.2d 1686 (S.D. Ohio 2005). Likewise, where the parties have different domain names and do not offer competing services, Courts have found that there is "little or no" overlap in marketing channels. *See, e.g., FW Omnimedia Cor. V. Toyota Motor Sales, U.S.A., Inc.*, 73 USPQ.2d 1667 (C.D. Cal. 2004); *Glow Indus., Inc. v. Lopez*, 273 F.Supp.2d 1095, 1126 (C.D. Cal. 2003). Accordingly, even though both SHRI and "Magik Vapor" advertise on the Internet, this does not necessarily mean that they advertise using the same channels of trade.

(ii) Impulse vs. Non-Impulse Buyers and the Sophistication of Prospective Purchasers

This factor focuses on whether the applicant's goods and/or services are aimed at ordinary purchasers or at discriminating or sophisticated purchasers. Generally, circumstances suggesting care in a purchase may tend to minimize likelihood of confusion. *See*, TEMP §1207.01(d)(vii).

Any consumer in the marketplace paying to attend a concert for the rock band "Magik Vapor" will know full well what they are paying to see prior to ordering tickets, making travel arrangements and/or attending the performance. Purchasing tickets to a "Magik Vapor" concert would not be an impulse purchase and would not confuse the purchaser into thinking they were purchasing tickets to enter the Vapor Night Club. By contrast, a consumer wanting to enjoy the services of the Vapor Night Club at

Saratoga Gaming and Raceway would have to travel to Saratoga Springs, New York, park on the grounds of the Saratoga Gaming and Raceway, enter a portion of the building known as the "Racino" and then locate the Vapor Night Club and lounge area. There is simply no likelihood that a consumer in the marketplace would see the mark "Vapor" and confuse it with the source of the mark "Magik Vapor" – i.e. that a consumer would see the mark "Vapor" and mistakenly believe that the rock band "Magik Vapor" owned the Vapor Night Club at the Saratoga Gaming and Raceway Facility, or vice versa.

Also of import is the fact that the Saratoga Gaming and Raceway has been in business for more than 65 years. Located within the historic district of the City of Saratoga Springs, the Saratoga Gaming and Raceway is a 160 acre facility consisting of a harness racing track, a racing simulcast facility and a gaming facility.

Saratoga Gaming and Raceway consists of a main building that houses a Video Lottery Terminal (VLT), device-only casino, which currently features 1,770 video lottery terminals, a grandstand with a ±252-seat (indoor and outdoor) food court, several bars, a gift shop, a large room utilized for simulcast wagering, and appropriate back-of-the-house space. Attached to the southern end of the grandstand is the clubhouse, which offers a ±450-seat tiered dining room, a bar, and appropriate back-of-the-house space. The other developed areas of the site include a primary racetrack, a training track, a jogging track, various stables, administrative buildings, a paddock barn, horseman's dormitories, blacksmith's shops, a harness shop, an equine pool, a diner, maintenance buildings, a carpenter's shop, a hall of fame, polo fields, and approximately 4,000 spaces of surface (paved and shaled) parking. At the southeastern corner of the subject site is The Lodge, a ±90-seat leased restaurant that is open only six weeks of the year and features an in-ground pool and pool house.

Saratoga Gaming and Raceway's video gaming is housed in a Victorian themed building and the gaming floor prior to a recent expansion was 55,000 square feet, including 1,300 video gaming machines, three food court dining options, various bars and a gift shop. This is in addition to a recent 45,000 square foot addition which includes the Vapor Night Club, an additional 400 video gaming machines and a 300 seat buffet restaurant.

A consumer in the marketplace simply could not mistakenly believe that a facility of this size, history and stature was owned by a rock band named "Magik Vapor"! As noted above, purchasing tickets to a "Magik Vapor" performance requires a certain amount of care and is not likely to be an impulse buy. A consumer would have to locate a performance date, venue and time which suits their schedule and then make arrangements to attend the performance. The only way in which this could be considered an impulse buy would be if a casual fan of rock music walked by a venue on the night of a "Magik Vapor" performance and decided to attend if tickets were available, and in such a case, there would be no confusion because the consumer would know it was seeing a "Magik Vapor" performance. It is simply not logical to believe that a potential consumer happening upon an advertisement for a "Magik Vapor" performance on the west coast would purchase tickets on a mistaken belief that this advertisement was

somehow related to the services offered by Vapor Night Club in Saratoga Springs, New York. Likewise, it is highly unlikely that a potential consumer viewing a Vapor Night Club advertisement in New York would visit the Vapor Night Club on a whim believing that said night club was owned by the rock band "Magik Vapor" or that said band was having a performance at the Saratoga Gaming and Raceway.

(iii) Many Other Marks Using the Term "Vapor" Have Been approved by the USPTO

Also of import is the fact that the USPTO has approved numerous other trademarks containing the word "vapor". A recent search of the word "vapor" in the USPTO registry revealed at least 442 related records. Since there are so many pre-existing uses of the word "vapor" which co-exist on the trademark register, the proposed mark "Vapor" should be able to co-exist as well without confusion. Moreover, given the extensive third-party usage of the word "vapor", the USPTO must have determined that consumers can easily distinguish between variations in the respective marks.

CONCLUSION

Based upon the foregoing, it is respectfully submitted that the Examiner erred in denying SHRI's applications to register the trademark "Vapor" as it is not confusingly similar to the registered mark "Magik Vapor". It is respectfully requested that the USPTO register the mark. Thank you.

Respectfully submitted,

NOLAN & HELLER, LLP

Richard L. Burstein

53021

Magik Vapor

MAGIK VAPOR (Stylized) F-9

Status: REGISTERED **Date:** October 19, 2004

Goods/Services:
Int'l. Class: 41 **(U.S. Class:** 100, 101, 107)
ENTERTAINMENT NAMELY, LIVE PERFORMANCES BY A MUSICAL ROCK BAND
First Use: February 22, 2002 **In Commerce:** June 21, 2003

Most Recent Owner: HOLLAND, GLENN SODERLING (UNITED STATES CITIZEN)

Registration No.: 2,896,211 **Registered:** October 19, 2004
Serial No.: 76-460473 **Filed:** October 21, 2002
Published: June 10, 2003

Additional Info: FILED AS INTENT TO USE - ACTUAL USE CLAIMED

Owner Information

Registrant/ Applicant: HOLLAND, GLENN SODERLING (UNITED STATES CITIZEN)
27645 SUSAN BETH WAY #E
SANTA CLARITA, CA 91350

Owner At Publication: HOLLAND, GLENN SODERLING (UNITED STATES CITIZEN)
27645 SUSAN BETH WAY #E
SANTA CLARITA, CA 91350

Correspondent: GLENN SODERLING HOLLAND
27645 SUSAN BETH WAY#E
SANTA CLARITA CA 91350

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This page was generated by the TARR system on 2007-06-26 15:56:37 ET

Serial Number: 77075123 Assignment Information

Registration Number: (NOT AVAILABLE)

Mark

VAPOR

(words only): VAPOR

Standard Character claim: Yes

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2007-04-25

Filing Date: 2007-01-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 115

Attorney Assigned:
PHAM LANA H Employee Location

Current Location: M6X -TMO Law Office 115 - Examining Attorney Assigned

Date In Location: 2007-04-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. Saratoga Harness Racing, Inc.

Address:

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 09/30/2008)

Mark (USPTO-generated image for standard characters):

VAPOR

Back