

In view of the refusal of the Examining Attorney to grant the registration of the applied-for mark, Applicant respectfully prays that the Examining Attorney withdraws the refusal and approve the Mark for publication in the Official Gazette.

I. THERE IS NO LIKELIHOOD OF CONFUSION

There is no mechanical test for determining a likelihood of confusion. The issue is not whether the actual goods are likely to be confused, but rather whether there is a likelihood of confusion as to the source of the goods. *Paula Payne Products Co. v. Johnson Pub. Co.*, 473 F.2d 901, 902 (C.C.P.A. 1973). Each case must be decided on its own facts. TMEP § 1207.01.

Pursuant to the DuPont test, the factors relevant to a determination of a likelihood of confusion in an ex parte examination are:

- 1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- 2) The relatedness or un-relatedness of the goods or services as described in an application or registration, or in connection with which a prior mark is in use;
- 3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- 4) The conditions under which, and buyers to whom, sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
- 5) The number and nature of similar marks in use on similar goods; and
- 6) The existence of a valid consent agreement between the parties.

In re E.I. du Pont de Nemours & Co, 476 F.2d 1357 (C.C.P.A. 1973).

The trier of facts will not give equal weight to each of the of the DuPont factors—in fact, some may not even be relevant—but any one of the factors may control or be more persuasive in a particular case. *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 850 (Fed. Cir. 1992). In this case the dissimilarity of the goods and services and the dissimilarity of the marks are relevant in the likelihood of confusion analysis and support a finding of no likelihood of confusion.

Applicant’s services are distinguishable from the services of the cited marks. As clearly stated in the TMEP, there is no per se rule that certain goods are related. TMEP 1207.01(a)(iv). In determining if goods and services are similar enough to cause a likelihood of confusion, the focus of the analysis is on the mind of the consumer and whether or not the consuming public will be confused as to the source of the goods; not whether the goods are in fact similar. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369–71 (Fed. Cir. 2012).

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same person in situations that would create the incorrect assumption that they originate from the same source, then confusion is not likely. *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156, 1158 (T.T.A.B. 1990); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 U.S.P.Q.2d 1668, 1669 (T.T.A.B. 1986); See TMEP § 1207.01(a)(i). This is true even if the marks are identical in appearance. *Local Trademarks, Inc.*, 16 U.S.P.Q.2d at 1156.

Applicant offers class 38 services while cited marks offer class 9 and 41 which is in a different class and or trade channel than what applicant seeks to register. Du pont factor 2 "The relatedness or un-relatedness of the goods or services as described in an application or registration, or in connection with which a prior mark is in use".

MARK IS NOT MERELY DESCRIPTIVE

In its refusal to grant the registration, the Examining Attorney pointed out that under Section 2(e)(1) of the Trademark Act, the applied-for mark merely describes the subject matter of applicant's services, as such not subject of a valid registration.

Applicant prays for the Examining Attorney to reconsider its refusal and respectfully points out that the applied-for mark is not descriptive rather partakes the nature of a suggestive mark.

To be deemed merely descriptive, a mark must directly provide the consumer with reasonably accurate knowledge of the characteristics of the product or service in connection with which it is used. If the information about the product or service is indirect or vague, then the mark is considered suggestive, not descriptive. See J. McCarthy, McCarthy on Trademarks and Unfair Competition §11.19, at 11-26 (4th ed. 1998).

Moreover, as in the case of the applied-for mark, a suggestive mark does not immediately convey to one encountering it the nature of Applicant's goods. Simply put hints at or suggests the nature of a product or service or one of its attributes without actually describing the product or service, as such imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services. In re Quik-Print Shops, Inc. 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980).

In this case, the applied-for mark "Rome.com" is merely suggestive of the goods and services it may offer. It may create an impression, ferments speculations and fosters imaginative thoughts in the mind of the consumers that the Television, cable television and radio broadcasting services it offered may involve topics or discussions having ROME as the subject matter but providing no specific details as to the contents of the Television, cable television and radio broadcast.

In view of the foregoing reason, the Applicant respectfully requests the Examining Attorney to reconsider its previous determination refusing the registration of the Applicant's Mark "Rome.com".