

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Clearwater Marine Aquarium

Law Office: 110

Serial No. 87/223,584

Examining Attorney: Andrea Koyner Nadelman

MARK: HOPE
_____ /

APPLICANT'S RESPONSE TO OFFICE ACTION

On behalf of the Applicant, Clearwater Marine Aquarium, the undersigned counsel responds to the First Office Action dated February 3, 2016 as follows:

The Examining Attorney has cited Registration No. 4,229,402 for HOPE CUPS A CREATIVE DIFFERENCE and design in International Class 021 as a bar to registration on grounds of a likelihood of confusion. Today, Applicant has filed a Petition to Cancel the subject registration with the TTAB. (See attached filing reference).

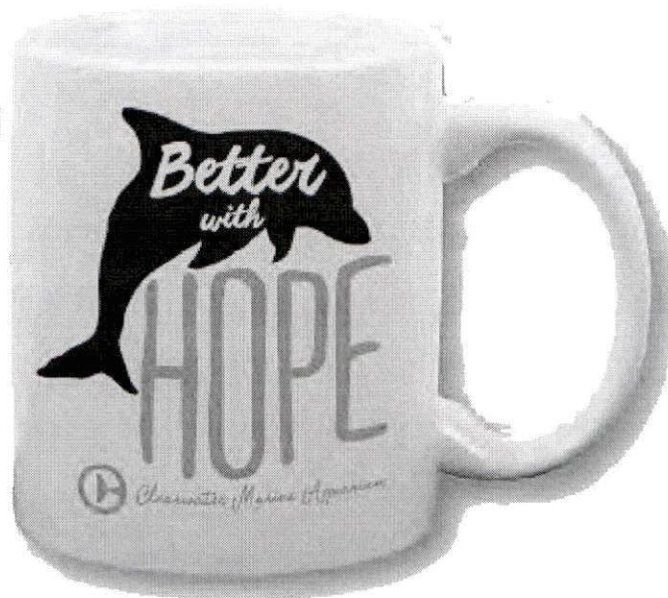
Accordingly, pursuant to TMEP 716.02(a), Applicant respectfully requests that the Examining Attorney suspend this application pending resolution of the subject Petition to Cancel the cited registration.

To the extent that the Examining Attorney believes that the specimen refusal should be addressed prior to suspension, the Applicant respectfully submits that the submitted specimens properly reflect a proper trademark usage of the mark HOPE in a separable, non-unitary depiction such that the relevant consuming public would recognize the mark HOPE as a distinct commercial impression.

“The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element

of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.” *In re ITT Industries, Inc.*, 2006 WL 2558019 *2 (T.T.A.B. 2006). The question of whether a mark is a mutilation “boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct ‘trademark’ in and of itself.” *Institut National des Appellations D’Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992).

As reflected in the latter two (of three) specimens, the mark HOPE is both dominant and prominent. While there exists a silhouette design of a dolphin with the integrated words “better with” above the depiction of the HOPE mark does not alter the fact that the word mark HOPE creates a separate and distinct commercial impression. Similarly, the inclusion of the Applicant’s house brand – which includes its business name – below does not transform the depiction into a unitary mark. *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950)(The omission of a trade name does not normally result in a mutilation of the mark.); *Textron Inc. v. Cardinal Engineering Corp.*, 164 USPQ 397, 399 (TTAB 1969) (“While the record does show that Textron’s principal or house mark ‘HOMELITE’ appears on its chain saws as well as in all of its advertising literature, there is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin”);



The, mere proximity of a design component “does not endow the whole with a single, integrated, and distinct commercial impression.” *Dena Corp. v. Belvedere International Inc.*, 960 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). In the mark shown below, “EUROPEAN FORMULA in large type appears to stand out and convey a meaning wholly unrelated to the circular design. Viewing the mark in its entirety, as it must, this court determines that Belvedere does not seek registration of a unitary mark.” *Id.*



“Therefore, the mere presence of other wording on a specimen in close association with the identified mark does not necessarily create a unitary impression.” *In re ITT Industries, Inc.*, at *5; accord *In re Tekelec-Airtronic*, 188 USPQ 694, 695 (TTAB 1975).

The HOPE word mark stands out on the specimens and creates a separate and distinct commercial impression. The refusal of the specimens should be withdrawn.

/Frank R. Jakes/

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Patti F. Todd

From: estta-server@uspto.gov
Sent: Tuesday, June 20, 2017 12:05 PM
To: Frank R. Jakes; Patti F. Todd
Subject: ESTTA. Petition for Cancellation confirmation receipt ID: ESTTA828150

Petition for Cancellation

Tracking No: ESTTA828150

ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

The Trademark Trial and Appeal Board (Board) has received a filing titled Petition for Cancellation submitted through the Electronic System for Trademark Trials and Appeals (ESTTA). This Notice verifies receipt of the filing and includes an ESTTA Tracking Number.

Unless the filing fails to meet all applicable minimum legal requirements for filing, the Board will not retract the filing or refund any fees paid.

The filing, and any Board proceeding, may be viewed on TTABVUE at <http://ttabvue.uspto.gov/ttabvue/>. Please allow up to two hours for the system to process this filing unless the filing is a new opposition or new petition to cancel that must be processed by a TTAB staff member. Please allow up to one week from the date of filing for manual processing.

If the filer received an error message or experienced a technical issue while using ESTTA, please email estta@uspto.gov and provide your ESTTA Tracking Number along with a Serial, Registration or Proceeding Number. For further status or information inquiries, please email ttabinfo@uspto.gov. The TTAB Assistance Center is open Monday through Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET) at 571-272-8500.

ESTTA server at <https://estta.uspto.gov>

ESTTA Tracking number: ESTTA828150
Filing date: 06/20/2017

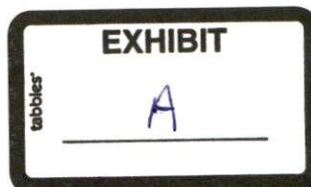
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name: Clearwater Marine Aquarium
Entity: Corporation
Citizenship: Florida
Address: 249 Windward Passage
Clearwater, FL 33767



UNITED STATES

Attorney information:

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Registration Subject to Cancellation

Registration No: 4229402
Registration Date: 10/23/2012
Registrant:
McCarty, Kevin P.
543 Lafayette Blvd
Brigantine, NJ 08203
UNITED STATES

Goods/Services Subject for Cancellation

Class 021. First Use: 20111130 First Use In Commerce: 20111215
All goods and services in the class are subject to cancellation, namely: Coffee cups; Coffee cups, tea cups and mugs; Cups and mugs; Paper cups

Grounds for Cancellation:

Abandonment
Trademark Act Section 14(3)

Fraud on the USPTO
Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Attachments:

HOPE CI 21-Petition for Cancellation.pdf

Frank R. Jakes
/Frank R. Jakes/
06/20/2017