

In re Application of : Louis Poulsen A/S
Mark : ABOVE in Intl. Cl. 11, 35, 42
US Appl. No. : 79207669 (from Int. Reg. 1344876)
Atty. Docket No. : 3T10298

TM Examining Atty. : Toby E. Bulloff
Law Office : 119

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

Applicant's ABOVE mark makes a distinctly different commercial impression from the cited prior right, rendering confusion between the marks unlikely. Whereas Applicant's mark satisfies all substantive requirements for registration and, by way of the amendments made herein, claims goods and services with sufficient clarity, the application should be approved for publication and passed to the Publication Branch at the USPTO for pre-publication review.

In the Office Action reported to WIPO on June 5, 2017, and subsequently forwarded to Applicant, the trademark examining attorney: (1) refused registration of Applicant's ABOVE mark on grounds the mark is likely to cause confusion, pursuant to Trademark Act Sect. 2(d), with the prior-registered ABOVE ALL mark, and (2) objected to the goods and services in Int. Cl. 11 and 35, as originally claimed, as being indefinite. As the refusal to registration and formalities objection are believed to be overcome and/or moot, Applicant respectfully requests all encumbrances to registration now be withdrawn.

1. Applicant's ABOVE Mark is Sufficiently Distinguishable Over the Cited Prior Right.

Applicant's ABOVE mark creates a unique and different overall commercial impression from the cited ABOVE ALL registration, precluding a likelihood of confusion. This is in addition to the visual and phonetic differences between the marks. The refusal to registration pursuant to Trademark Act Sect. 2(d).

A significant tenet of USPTO trademark jurisprudence is the notion that marks must be compared in their entireties, and not dissected into their component parts, for purposes of a likelihood of confusion analysis. When Applicant's ABOVE and the cited ABOVE ALL mark are properly compared in their entireties, the difference in meaning is apparent and significant and precludes conflict and confusion. The cited ABOVE ALL mark sends a clear, laudatory message to viewers of the mark. The terms comprising the mark will be read together without viewers attempting to dissect the mark into "ABOVE" and "ALL" and then arrive at an understanding as to what message the mark intends to convey. In stark contrast, Applicant's ABOVE mark sends no such clear message to consumers and is far more arbitrary in its application. In view of these structural differences in the marks, consumers would not believe ABOVE is somehow related to or in the same family as ABOVE ALL.

In addition to these conceptual differences between the marks, the marks look different, one having 1 term and the other comprising 2 terms. The different number of terms in each mark also results in marks that include a different number of syllables and sound different.

The differences in overall appearance, pronunciation and commercial impression between the marks precludes conflict. The refusal to registration on likelihood of confusion grounds should be withdrawn.

2. Applicant's Amended Cl. 11 and Cl. 35 Goods and Services are Specific and All-Inclusive.

Applicant's amendments to its Cl. 11 goods and Cl. 35 services result in these goods/services being expressed with sufficient clarity and specificity. The formalities objection to the goods and services should be withdrawn as moot. Applicant understands from the Office Action that there is no objection to the Cl. 42 services as filed. Accordingly, no amendment is being made to these services.