

**2018 March 14 Response to Office Action mailed 9 14 2017**

**MARK: BLUESTAR (& Design), Serial No. 87/533,795 in Classes 35 AND 41 (FLY B03)**

Applicant thanks the Examiner for her thoughtful review of the application and offers these remarks and arguments in response to the Office Action mailed September 14, 2017.

- I. Applicant's Mark is Not Confusingly Similar to BLUE STAR CAREERS Reg 84 816 744 –
  - a. The Services Are Entirely Different and In Different Trade Channels

The Examiner has refused registration on the ground that Applicant's mark is confusingly similar to BLUE STAR CAREERS, Reg. 84/816,744, for "Career planning services; organizing business networking events in the field of all career fields for military spouses; providing employment counseling information on how to successfully transition jobs for military spouses." Applicant respectfully disagrees.

Registrant's services are directed entirely to military spouses – Registrant apparently provides solutions for the challenges military spouses face with transitioning jobs, presumably an issue of special concern to military spouses as service members are often moved around from base to base, forcing military families often to relocate, even to bases outside the country. Registrant's services are, on the face of the registration, limited to this narrow and important niche of clientele and services.

Applicant's services are directed entirely to middle school, high school and college athletes and their parents, on the one hand, and athletic talent recruiters (sports recruiters looking for elite amateur athletes for team sports) on the other hand. Applicant's services are marketed to young athletes working toward a career in team sports, i.e. elite young athletes, and their parents, as well as talent scouts and recruiters in the field of amateur team sports. Whereas Registrant no doubt markets its services in channels directed toward military families, Applicant markets its services in channels directed toward youth athletics and team sports.

Registrant's services relate to the field of job training, job transitioning, business networking events and employment counseling. Applicant's services have nothing at all to do with job training, job transitioning, business networking events or employment counseling. Applicant's services relate to the field of elite youth athletes in team sports. Registrant's services have nothing whatever to do with sports, team sports, youth athletics or elite athletes.

Because both Registrant and Applicant focus their services in their own particular, narrow niche to their own particular, narrow market, there is no likelihood of confusion between the marks. There is no overlap between military family employment services and services to develop elite youth athletes. Even if a consumer familiar with one mark happened to encounter the other, it is extremely unlikely the consumer would expect them to be connected given how completely different their services.

- b. Applicant Has Already Acquired Secondary Meaning in BLUE STAR By Virtue of Prior Registration

Moreover, Applicant is the owner of prior registration 1,677,944, BLUE STAR, registered March 3, 1992 for "Operating basketball camps" in class 41, with a date of first use dating back to 1981. Therefore, Applicant has already acquired secondary meaning in the term BLUE STAR in connection with sports-related services. In this context, it is even more likely Applicant's mark would be understood to be connected with Applicant's well-known basketball camps and not with Registrant's job training for military spouses.

In summary, there is no likelihood of confusion between Registrant's BLUE STAR CAREERS and Applicant's BLUESTAR (& Design).

## II. Specimen Rejection

The Examiner has refused registration on the ground that the specimen does not match the mark in the drawing because "the specimen pages cut off the top portion of the star design" and thus the drawing is not a substantially exact representation of the mark as used in connection with the services, as shown by the specimen.

Applicant respectfully suggests that the specimens submitted support the mark to be registered as shown in the drawing because users of the internet are accustomed to see website banners, such as Applicant's, in which the graphics extend slightly outside the borders of the screen. In Applicant's case, the website banner is so cropped to maximize useable space on the screen to display content and to minimize wasted white space at the top of the banner. If the mark were moved down in the banner so the top point showed, the banner would be wider, thus reducing available space for content on the page, while wasting space to empty white space to the right of the mark.

Applicant suggests that despite the fact that it is positioned "full bleed" so the top point is outside the display area at the top of the banner, viewers of Applicant's website mentally fill in the missing point of the star, as we are accustomed to do when viewing website banners. In other words, the perception and commercial impression of the mark displayed in the specimens is the complete star (matching the drawing) and not a cropped star. Said another way, the missing point is the result of the placement of the logo on the website banner – it is clearly not a design element in the logo and is not perceived as a design element. A viewer of the website would certainly recall the mark as "the wording BLUESTAR over the design of a five-pointed star." In support of this point, see the Blue Star Home specimen (the website home page), which displays the mark in the center of the screen as well as at in the banner. In the center of the page, where the mark is displayed next to the term "Class of 2016 College Recruiting Class Rankings," the full logo is displayed. See, as well, the additional specimen uploaded herein as evidence. Applicant urges the Examiner to find that, under the totality of the circumstances and in particular considering the specimens which show the complete star, the specimens adequately support the mark as shown in the drawing filed.

Applicant believes altering the drawing and description, removing the top point of the star, would lead to registration of a mark that does not well-match the strong commercial impression given by Applicant's mark, which is that of a complete star with the words BLUESTAR superimposed over it. That said, if the Examiner is unpersuaded after considering this Response, Applicant will reluctantly submit a revised drawing that matches the specimens with the top point outside the page borders.

## III. Identification of Services Is Clarified

The Examiner has determined the Identification of Services to be indefinite and requiring clarification.

### a. Career Planning Services vs. Career Development Services

In Class 35, the Examiner requires the clarification that the cited "career development services" be classified as "career planning services." Applicant respectfully suggests there is a difference between career planning and career development. Whereas career planning presumably consists of the passive activities of counseling to discuss a possible careers and planning the steps to achieve them, career development suggests a more active role in moving the subject's career forward toward the goal, such as contacting recruiters, trainers, public relations and the like. If "career development services" is

indefinite, Applicant invites the Examiner to call the undersigned to discuss wording that would be acceptable to adequately describe such active development services, which includes but goes beyond mere “career planning services.”

b. Partial Reclassification from Class 41 to Class 35

Examiner also requires an amendment to move “providing information, news ... in the field of .. amateur sports recruitment” from Class 41 to Class 35. Applicant accepts the Examiner’s suggestion and makes that amendment herein.

c. Thought Leadership

The Examiner has objected to the term “thought leadership” as vague. Oxford English Dictionary defines a thought leader as “One whose views on a subject are taken to be authoritative and influential.” Applicant intends this meaning of the term and is open to the Examiner’s suggestions of an adequate term instead of “thought leadership.” Applicant and its BLUESTAR marks are recognized authorities in the field of recruitment and talent spotting in elite young athletes for team sports. However, Applicant accepts the Examiner’s suggestion and makes the amendment herein.

d. Sports Training Services

In Class 41, in addition to replacing the vague term “thought leadership,” the Examiner requires “evaluation, training and development ...” services be grouped under the term “sports training services.” This amendment is acceptable and is made by Applicant herein.

IV. Color Claim and Description

Examiner requires an amendment to the color claim and mark description to incorporate use of all colors in the mark. Applicant accepts the Examiner’s suggestions and makes those amendments herein.

V. Conclusion

Applicant has now responded to all issues raised in the Office Action. The Examiner is invited to call the undersigned as needed to expedite allowance, negotiate resolution or provide clarification. Allowance and registration at an early date is respectfully requested.

Respectfully submitted,

Catherine A. Cavella, Esq.  
Attorney for Applicant  
215-348-1442