

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: :
: Trademark Attorney
App. Ser. No. 87/548851 : Teague Avent
: Law Office 125
Applicant: Advance Magazine Publishers Inc. :
: Mark: CLEVER :
-----X

AMENDMENT

In response to the Official Action mailed November 3, 2017, please amend the above-identified application as follows:

Amend the identification of services to: "Providing online publications in the nature of magazines, in the field of design, architecture and décor.

REMARKS

The Trademark Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on the conclusion that Applicant's mark CLEVER is likely to be confused with the mark shown in U.S. Registration No. 4890550, namely CLEVER LITTLE MADAME.

The principal factors to be considered in determining whether there is a likelihood of confusion include: similarity of the marks, similarity of the goods or services and the similarity of the trade channels. In re E.I. Dupont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

SIMILARITIES OF THE MARKS

The mere fact that two marks may share a word or words in common is not dispositive of likelihood of confusion. Clairol, Inc. v. Cosmair, Inc., 224 U.S.P.Q. 229, 232 (S.D.N.Y. 1984) (SUMMER BLOND and SUMMER SUN for directly competitive hair lighteners sold through the same channels of

distribution are different enough in terms of name, packaging and impression to avoid likelihood of confusion by average customer). Even where common words may appear to be “dominant”, courts have held that confusion is not likely, after considering marks in their entireties. In re Cooper Tire and Rubber Co., 22 U.S.P.Q. 2d 1079, 1080 (Fed. Cir. 1991) (THE INDY TUBE for rubber inner tubes is not likely to cause confusion with INDY 500 for tread rubber used on automobile tires. The court stated “even though we agree that in parsing the marks THE INDY TUBE and INDY 500, similarities can be found, we do not agree that the marks are, in their entireties, similar as to appearance, sound and commercial impression”).

Applicant has applied to register CLEVER. The Trademark Attorney has cited a mark that includes the word “Clever” and the additional words “Little Madame.” On their face the two marks are visually, audibly and contextually distinguishable.

The mere fact that cited Registrant’s mark contains the word “clever” cannot be a basis for refusing registration to all other marks that incorporate that word. Applicant argues that the registrant Deborah Seidner does not have a monopoly on the word “Clever”, even as it relates to class 35 and 41 services. Sections 807.03 and 1214.01 of the TMEP makes it clear that a single application or registration can protect only one mark, not a host of marks that could possible incorporate elements of the mark at issue. See, International Flavors, 51 USPQ2d at 1517-18. In addition, Applicant attaches a printout referencing over 60 Federal registrations which contain the word “clever” and which include services in Class 35 and/or 41. Thus, it is clear that the PTO

has determined that multiple parties may use and register “clever” on its own or with other words.

Applicant respectfully contends that the overall commercial impression, appearance and sound of the Applicant’s mark and the cited mark are very different.

DIFFERENCES IN THE GOODS AND SERVICES AND TRADE CHANNELS

Applicant’s online magazine content focuses on design, décor and architecture. Published by the editors of Architectural Digest, the CLEVER site reads like a special issue of Architectural Digest with its focus on smart and intuitive design and décor ideas. The source of the materials, namely Architectural Digest is clearly identified. In stark contrast, the operator of Clever Little Madame is an individual who posts information in topical and diary formats wherein she tracks daily life and adds thoughts, opinions and things learned. Her website reads like a daily journal and is intended for general interest readers. The full name “Clever Little Madame” is always displayed and the source, namely Deborah Seidner, is prominently displayed on the site to remind users of the source of the materials.

When considered in their entirety, and not in a vacuum, the nature, context, subject matter and trade channels of both sites are easily distinguishable.

SUMMARY

When the relevant factors are considered, namely the differences in the marks, services content and trade channels, it is evident that there is no likelihood of confusion between Applicant’s mark and the marks shown in the cited registration. Therefore, Applicant respectfully requests that the

Trademark Attorney withdraw the §2(d) refusal and pass the instant application to publication.

Respectfully submitted,

SABIN, BERMANT & GOULD LLP
One World Trade Center, 44th Flr
New York, New York 10007
(Attorneys for Applicant)

By: 
Eric E. Gisolfi

Dated: April 4, 2018
Telephone: (212) 381-7070

Search Strategy

Search Strategy

Your Reference 2018/04/04 [4]

Selected Databases 10

Trademark Databases (3);

International (IR) trademarks with protection in selected countries/regions ONLY;

North America (2); U.S. Federal; U.S. State;

Domain Name Databases (7);

.biz; .com; .info; .mobi; .net; .org; .us;

Criteria Options:Active Only: on, Plurals: on, Cross References: on

Q1: 2318 - Trademark Equals **clever** , Status Equals **registered**

Q2: 2046 - Trademark Equals **clever** , Status Equals **registered** , International Classes Equals **41 35**

Q3: 1987 - Trademark Equals **clever** , Status Equals **registered** , International Classes Equals **41**

Search Date 2018/04/04 17:39 GMT

Hit Overview

Hit No.	Query	Citation	Source	Status	Class	Owner Name
US-1	Q2	CLEVER GIRLS KNOW	USPTO	Registered	41	CLEVER GIRL FINANCE LLC
US-2	Q2	CLEVER GIRL FINANCE	USPTO	Registered	41	CLEVER GIRL FINANCE, LLC
US-3	Q2	CLEVER IDIOTS INC	USPTO	Registered	9 14 16 18 20 21 25 28 35	CLEVER IDIOTS, INC.
US-4	Q2	CLEVER CRAZES HOUSE BAND	USPTO	Registered	9 35 38	BUILDING HEALTHY LIVES FOUNDATION
US-5	Q2	CLEVER FOX	USPTO	Registered	41	CLEVER FOX LLC
US-6	Q2	CLEVERTAP Cross References: CLEVER TAP	USPTO	Registered	35 42	WIZROCKET INC.
US-7	Q2	CLEVERCARE Cross References: CLEVER CARE	USPTO	Registered	35	CLEVER DEVICES LTD.
US-8	Q2	CLEVER CREATIONS	USPTO	Registered	35	BRIAN'S TOYS, INC.
US-9	Q2	CLEVER COACHMAN	USPTO	Registered	41	SEMILIAN, LAURA
US-10	Q2	CLEVERTECH Cross References: CLEVER TECH	USPTO	Registered	35	CLEVERTECH DEVELOPMENT INTERNATIONAL, LTD. (Bermuda)
US-11	Q2	CLEVERTECH Cross References: CLEVER TECH	USPTO	Registered	35	CLEVERTECH DEVELOPMENT INTERNATIONAL, LTD. (Bermuda)
US-12	Q2	CLEVER MEDIA	USPTO	Registered	35	CLEVER MEDIA LLC (Puerto Rico)
US-13	Q2	THE CLEVER STORE	USPTO	Registered	35	THE CLEVER STORE, LLC
US-14	Q2	CLEVER TALKS	USPTO	Registered	41	CLEVER TALKS
US-15	Q2	WHATEVER IS CLEVER	USPTO	Registered	35	COHEN, ERIC M
US-16	Q2	CLEVER CHEF	USPTO	Registered	35	BRIAN'S TOYS, INC.
US-17	Q2	THE CLEVER ROOT	USPTO	Registered	16 41	THE CLEVER ROOT, LLC
US-18	Q2	CLEVER LITTLE MADAM	USPTO	Registered	35 41	SEIDNER, DEBORAH A.

<u>US-19</u>	Q2	CLEVERMETHOD Cross References: CLEVER METHOD	USPTO	Registered	35	CLEVERMETHOD, INC.
<u>US-20</u>	Q2	BOX CLEVER	USPTO	Registered	9 35 42	BOX CLEVER INCORPORATED (Canada)
<u>US-21</u>	Q2	HEALTH CLEVER	USPTO	Registered	5 35	HARVEY, MARK (United Kingdom)
<u>US-22</u>	Q2	FIKSU Translation: CLEVER	USPTO	Registered	35 42	FIKSU, INC.
<u>US-23</u>	Q2	MYCLEVER Cross References: MY CLEVER	USPTO	Registered	9 35 36 41 42	MY CLEVER LIMITED (United Kingdom)
<u>US-24</u>	Q2	CLEVERREACH Cross References: CLEVER REACH	USPTO	Registered	35 38 42	CLEVERREACH GMBH & CO. KG (Germany)
<u>US-25</u>	Q2	CLEVER ENERGY	USPTO	Registered	35	ENTRUST ENERGY, INC.
<u>US-26</u>	Q2	G EN GURU CLEVER ENERGY Cross References: GEN GURU CLEVER ENERGY	USPTO	Registered	35	ENTRUST ENERGY, INC.
<u>US-27</u>	Q2	CLEVER BISCUIT	USPTO	Registered	9 35	IDAAAS (France)
<u>US-28</u>	Q2	CLEVER LUXE	USPTO	Registered	41	DELOACH, CHARLENE
<u>US-29</u>	Q2	CLEVER INVESTOR	USPTO	Registered	41	SPERBER, CODY
<u>US-30</u>	Q2	CLEVERFISH Cross References: CLEVER FISH	USPTO	Registered	35	CLEVERFISH PRODUCTS, LLC
<u>US-31</u>	Q2	CLEVER GIRLS	USPTO	Registered	35 41	CLEVER GIRLS COLLECTIVE, INC.
<u>US-32</u>	Q2	KLEVER V Cross References: CLEVER V , K LEVER V	USPTO	Registered	35 41 42	DANCING E, LLC
<u>US-33</u>	Q2	BOXING CLEVER	USPTO	Registered	35	4 ALARM STUDIO, INC.
<u>US-34</u>	Q2	CLEVER SPRING	USPTO	Registered	20 24 35	FRANC GARDINER SP. Z O.O. (Poland)
<u>US-35</u>	Q2	CLEVER EDGE MARKETING	USPTO	Registered	35	CONTE, DANIELLE
<u>US-36</u>	Q2	CLEVER RELEVANCE	USPTO	Registered	35	RICOCHET PARTNERS, INC.

US-37	Q2	CLEVER CREATIVE	USPTO	Registered	35 42	CLEVER CREATIVE, INC.
US-38	Q2	C CLEVER CREATIVE	USPTO	Registered	35 42	CLEVER CREATIVE, INC.
US-39	Q2	CLEVER TRAINING	USPTO	Registered	35	CLEVER ATHLETICS CO., LLC
US-40	Q2	CLEVER TRAINING	USPTO	Registered	35	CLEVER ATHLETICS CO., LLC
US-41	Q2	KLEVERKLOUD Cross References: CLEVER CLOUD	USPTO	Registered	35	KLEVER MARKETING, INC.
US-42	Q2	KLEVERDASH Cross References: CLEVER DASH	USPTO	Registered	35	KLEVER MARKETING, INC.
US-43	Q2	SIQIN Translation: CLEVER	USPTO	Registered	25 35	BEIJING SUNSHINE TRAVELER APPAREL CORPORATION (China)
US-44	Q2	CLEVERTV Cross References: CLEVER TV	USPTO	Registered	38 41	DEFY MEDIA, LLC
US-45	Q2	CLEVER SAVER	USPTO	Registered	35	VON HUDMAN GROUP, LLC
US-46	Q2	CLEVERANT Cross References: CLEVER ANT	USPTO	Registered	9 35 42	DELOITTE IT INC. (Canada)
US-47	Q2	{FIKSU} Translation: CLEVER	USPTO	Registered	35	PSCP HOLDINGS LIMITED (VIRGIN ISLANDS, BRITISH)
US-48	Q2	FIKSU Translation: CLEVER	USPTO	Registered	35	PSCP HOLDINGS LIMITED (VIRGIN ISLANDS, BRITISH)
US-49	Q2	CLEVERCOUNT Cross References: CLEVER COUNT	USPTO	Registered	35	CLEVER DEVICES LTD.
US-50	Q2	CLOSETCLEVER Cross References: CLOSET CLEVER	USPTO	Registered	35	WENGER, KATHLEEN, C.
US-51	Q2	KLEVERSHOP Cross References: CLEVER SHOP	USPTO	Registered	35	KLEVER MARKETING, INC.
US-52	Q2	KLEVERBANK Cross References: CLEVER BANK	USPTO	Registered	35	KLEVER MARKETING, INC.

<u>US-53</u>	Q2	CLEVER CRAZES FOR KIDS	USPTO	Registered	41	BUILDING HEALTHY LIVES FOUNDATION
<u>US-54</u>	Q2	C-LEVER Cross References: C LEVER	USPTO	Registered	35	WHITMIRE, ALISON
<u>US-55</u>	Q2	CLEVER CRAZES FOR KIDS	USPTO	Registered	41	BUILDING HEALTHY LIVES FOUNDATION
<u>US-56</u>	Q2	CLEVERSCALE Cross References: CLEVER SCALE	USPTO	Registered	41	MOVE & PLAY (France)
<u>US-57</u>	Q2	THE CLEVER BRIDE CAYLA	USPTO	Registered	35	6963803 CANADA INC. (Canada)
<u>US-58</u>	Q2	CLEVER CRAZES FOR KIDS BUILDING HEALTHY LIVES	USPTO	Registered	41	BUILDING HEALTHY LIVES FOUNDATION
<u>US-59</u>	Q2	BRAIN IN ITALY ITALIAN CLEVER PRODUCTS	USPTO	Registered	18 35 42	MAGNABOSCO, SUSANNA BARIN, ANTONIO BARIN, MARGHERITA (Italy)
<u>US-60</u>	Q2	THAT'S CLEVER! Cross References: THAT IS CLEVER!	USPTO	Registered	41	SCRIPPS NETWORKS, LLC
<u>US-61</u>	Q2	CLEVER PARTIES	USPTO	Registered	9 35 41 45	CLEVER PARTIES, INCORPORATED
<u>US-62</u>	Q2	CLEVER DEVICES	USPTO	Registered	35	CLEVER DEVICES LTD.
<u>US-63</u>	Q2	CLEVERBRIDGE Cross References: CLEVER BRIDGE	USPTO	Registered	35	CLEVERBRIDGE AG (Germany)
<u>US-64</u>	Q2	CLEVER CRAZES FOR KIDS	USPTO	Registered	41	BUILDING HEALTHY LIVES FOUNDATION
<u>US-65</u>	Q2	CLEVER SPIDER	USPTO	Renewed	35 42	EXOCREATIONS, LLC
<u>US-66</u>	Q2	CLEVER COOKIE	USPTO	Renewed	30 35 45	JEWEL CONFECTIONS LLC
<u>US-67</u>	Q2	CLEVERPAY Cross References: CLEVER PAY	USPTO	Registered	35 36	RG/2 CLAIMS ADMINISTRATION LLC
<u>US-68</u>	Q2	CLEVER & UNIQUE CREATIONS	USPTO	Renewed	41	FOR YOUR EASE ONLY, INC.
<u>US-69</u>	Q2	CLEVER	USPTO	Renewed	35 41	TRILEGIANT

		CLUBHOUSE				CORPORATION
--	--	-----------	--	--	--	-------------