

The consent of the parties is properly given “substantial weight” in the likelihood-of-confusion analysis. *Amalgamated Bank, Inc. v. Amalgamated Trust & Savs. Bank*, 842 F.2d 1270, 1273 (Fed. Cir. 1988). As the Court of Customs and Patent Appeals has explained:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

In re E. I. DuPont de Nemours & Co., 476 F.2d at 1363.

Where, as here, “applicant and registrant have entered into a credible consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely.” *Id.*; *accord In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1568 (Fed. Cir. 1993) (“The parties themselves have determined that confusion of the public by concurrent use of their marks is unlikely. . . . It is well settled that in the absence of contrary evidence that there is no likelihood of confusion.”); *Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1484 (Fed. Cir. 1987) (“[I]n trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace, . . . [the parties] are in a much better position to know the real life situation than bureaucrats or judges . . .”). For the foregoing reasons, Applicant requests that the refusal based on the Cited Marks be withdrawn.

Additionally, Applicant’s Mark is sufficiently distinguishable from the Cited Marks. It is apparent that no likelihood of confusion exists because: (1) the marks themselves are visually distinguishable. The unique design elements present in the respective marks make confusion unlikely.

II. Amendment to Goods in Class 34

In response to the Office Action's request, Applicant hereby amends the goods identified in Class 34 as follows:

Cigarettes; tobacco, raw and manufactured; tobacco products, namely, smoking tobacco, cut tobacco, leaf tobacco, chewing tobacco, snuff tobacco, pipe tobacco, and hand rolling tobacco; tobacco substitutes, not for medical purposes; lighters for smokers; matches; smokers' articles for the purpose of heating cigarettes and tobacco, namely, mouthpieces and drip tips for electronic cigarettes and e-pipes, cartridges for electronic cigarettes and e-pipes, and oral vaporizers for smokers; cigarette paper, cigarette tubes, cigarette filters; pocket apparatus for rolling cigarettes; hand held machines for injecting tobacco into paper tubes; electronic cigarettes; liquids for electronic cigarettes comprised of vegetable glycerin, chemical flavorings in liquid form used to refill electronic cigarette cartridges, etc.}; tobacco products for the purpose of being heated, namely, sticks of tobacco or sticks of tobacco substitutes that are designed to be heated but not burned; electronic devices and parts for devices for heating tobacco and tobacco substitutes for the purpose of inhalation, namely a handheld rechargeable device that user can insert rolled tobacco to smoke; none of the foregoing being cigars" in International Class 34.

III. CONCLUSION

Having addressed all of the issues raised in the Office Action, Applicant respectfully requests that its application be approved for publication in due course.

Respectfully submitted,

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