




## RESPONSE TO OFFICE ACTION

In response to the Office Action issued on October 2, 2018, Applicant states that it has amended its identification of goods. Applicant further states that a co-existence agreement is in place as to the mark that is the subject of the cited registration, U.S. Reg. No. 4748472. Applicant respectfully requests that the Examining Attorney reconsider and withdraw the Section 2(d) refusal to register the subject mark.

### **I. APPLICANT'S MARK NOT LIKELY TO CAUSE CONFUSION WITH CITED MARK**

Registration was refused under Trademark Act §2(d) based on the following U.S. trademark registration: U.S. Reg. No. 4748472, , (the "Cited Mark") for "Tires for land vehicles." The current owner of the Cited Mark is E & P Investments ("E & P"). Applicant is affiliated with RBP Performance, Inc., the original owner of the Cited Mark.

As set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973), the likelihood of confusion analysis takes into account the market interface between the applicant and the owner of a prior mark, including a consent to register or use. A consent will be sufficient to overcome a likelihood of confusion rejection if it incorporates sufficient facts to evidence a full understanding of the matter, a period of concurrent use, and little or no actual confusion. *See In re Palm Beach, Inc.*, 225 U.S.P.Q. 785 (T.T.A.B. 1985).

An agreement that includes provisions which give a reasonable separation between use of the respective marks and which tends to ensure that confusion will not occur is sufficient to overcome a likelihood of confusion rejection based upon a previously registered mark. As the court in *DuPont* stated:

It can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in causing public confusion. ... Thus, when those most familiar with use in the marketplace and most interested in precluding confusion enter agreement designed to avoid it, the scales of evidence are clearly tilted. ... A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

*DuPont*, 476 F.2d at 1363. For example, in *In Re Four Seasons Hotels Limited*, the Federal Circuit found a consent agreement where the cited registrant, owner of a registration for THE BILTMORE LOS ANGELES covering hotel services, consented to the registration of applicant's FOUR SEASONS BILTMORE mark for resort inn keeping services, was sufficient to overcome a likelihood of confusion where the agreement acknowledged the parties' longstanding coexistence and set forth the parties' duty to cooperate with one another in the event of any potential future consumer confusion. *In Re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1569 (Fed. Cir. 1993). According to the court, the Board erred in not giving adequate weight to the consent agreement because the consent agreement demonstrated that the parties had "thought out their commercial interests with care" and found that there was no reason to ignore the parties' assessment of likelihood of confusion. *Id.*

Once a consent agreement is made of record in the application file it will be accorded “great weight,” and no likelihood of confusion should be the conclusion. *Bongrain International v. Delice de France*, 811 F.2d 1479 (Fed. Cir. 1987); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270 (Fed. Cir. 1988); *In re N.A.D. Inc.*, 754 F.2d 996 (Fed. Cir. 1985). In a number of decisions, the Trademark Trial and Appeal Board, relying upon these Federal Circuit decisions, has found that a letter of consent is determinative on the issue of likelihood of confusion. *See e.g., In re American Management Association*, 218 U.S.P.Q. 477 (T.T.A.B. 1983) (reversing Examining Attorney's refusal to register PERSONNEL for human resources publication based on prior registration for PERSONNEL JOURNAL for periodic magazine based on consent agreement between the parties setting forth restrictions on use and absence of confusion stemming from parties' coexistence for fifty years); *In re Leonard S.A.*, 2 U.S.P.Q.2d 1800 (T.T.A.B. 1987) (reversing Examining Attorney's refusal to register LEONARD SWISS for watches based on prior registration of LEONARD for flatware and jewelry based on a consent agreement between the parties which noted that applicant and cited registrant had used their respective marks for many years without confusion, that the parties believe there is no likelihood of confusion and that the parties will use their best efforts to mitigate any potential future confusion).

Further, T.M.E.P. § 1207.01(d)(viii) states that the examining attorney should accord substantial weight to a proper consent agreement and not interpose his or her own judgment concerning likelihood of confusion when an applicant and a registrant have entered into a credible consent agreement. Based on the foregoing, a reasonably comprehensive consent agreement should conclusively establish the lack of any likelihood of confusion and overcome a § 2(d) rejection.

Applicant has used the applied-for mark in commerce in connection with automotive parts and accessories since 2015, the year E & P purchased the Cited Mark. The Parties' respective marks have been used contemporaneously in the marketplace since 2015. On August 15, 2017, to avoid any potential customer confusion, the Parties entered into a Co-Existence Agreement under which E & P expressly consents to Applicant's registration of the applied-for mark. *See Exhibit A*. The Co-Existence Agreement provides that E & P may only use the Cited Mark only in connection with tires and that Applicant may only use the Rolling Big Power marks, such as the applied-for-mark, in connection with any goods and services other than tires. The Co-Existence Agreement acknowledges the Parties' coexistence and indicates that the Parties do not believe consumer confusion is likely under the terms of the Co-Existence Agreement. The Agreement also provides that “[t]he parties will use commercially reasonable efforts to avoid consumer confusion in the marketplace between their respective RBP Trademarks.”

The Parties' Co-Existence Agreement demonstrates that the Parties gave consideration to their commercial interests, have assessed the issue of likelihood of confusion with great care and determined that there is no likelihood of consumer confusion because the subject marks are used in a distinguishable manner and the Parties' goods and services are not in competition. The Parties' position on no likelihood of confusion is underscored by the lack of evidence of consumer confusion during the Parties' simultaneous use and coexistence in the marketplace over the last four years. As the Co-Existence Agreement between the parties satisfies the requirements of a comprehensive consent under binding Federal Circuit case law and the T.M.E.P., it should be dispositive on the issue of likelihood of confusion with respect to the pending Application.

In view of the Co-Existence Agreement between Applicant and the owner of the Cited Mark, it is clear that there is no likelihood of confusion between the applied-for mark and the mark in U.S. Registration No. 4748472. Accordingly, Applicant respectfully requests that the refusal of registration under Trademark Act § 2(d) based on U.S. Registration No. 4748472 be withdrawn.

## **II. CONCLUSION**

Having responded to the Examining Attorney's Office Action, Applicant respectfully submits that the Application is now in proper condition for publication, notification of which Applicant requests at the Examining Attorney's convenience. If it would advance the prosecution of this Application, Applicant invites the Examining Attorney to telephone the undersigned.