

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

TRADEMARK:	MYBLUPRINT	)	Jules Dean
		)	
SERIAL NO.:	88/001,183	)	Examining Attorney
		)	
FILING DATE:	June 14, 2018	)	Law Office 120
		)	
CLASS:	16	)	
		)	
APPLICANT:	SYMPOZ LLC	)	

**APPLICANT'S RESPONSE TO OFFICE ACTION**


Dear Examiner:

Applicant, SYMPOZ, LLC ("Applicant") hereby submits this response to the Office Action issued on October 12, 2018.

**REMARKS**

**1. Refusal Based on Trademark Act Section 2(d)**

The Examining Attorney has refused registration of Applicant's mark, MYBLUPRINT ("Applicant's Mark"), under Trademark Act Section 2(d), 15 U.S.C. §§ 1052(d), on the grounds that there is a likelihood of confusion with the following registered marks:

- Registration No. 5472485 for  for, *inter alia*, "Paper and cardboard; bookbinding material; photographs; stationery; pens; pencils; pen refills; binders; erasers; notebooks; postcards; greeting cards; adhesives for stationery or household purposes; artists' materials, namely, pastels, canvas panels, artists' brushes" in Class 16, claimed by The Institution of Occupational Safety & Health ("Cited Mark 1");
- Registration No. 4462308 for BLUEPRINT IT for, "Children's activity books; Children's books; Children's interactive educational books; Children's storybooks; Children's wall stickers and murals; Customizable journal books; Personalized coloring books for children; Personalized writing journals; Picture books" in Class 16, claimed by Little Blueprint LLC ("Cited Mark 2"); and
- Registration No. 5038865 for BLUEPRINT SERIES for, *inter alia*, "Stationery; artists' materials, namely, pencils, pens, canvas panels for painting, paint trays, paint rollers, drawing pads, easels, crayons, drawing instruments, water color pencils, sketching pencils, coloring pencils, oil pastels, soft pastels, printing blocks, paint brushes, drawing and sketching pads and

paper, painting pallets, artist printing blocks, drawing ink; pens; calendars; posters; postcards; notebooks; bookends; recipe books; bookmarks; none of the foregoing involving architectural blueprints” in Class 16, claimed by Moncada Brewery Ltd (“Cited Mark 3”).

For the reasons stated below, Applicant respectfully contends that Applicant’s Mark is not likely to cause confusion with and is registrable notwithstanding the above-referenced marks cited in the Office Action.

**A. The Marks Differ in Appearance and Commercial Impression**

Applicant’s Mark, which consists of a single word “MYBLUPRINT” differs in appearance and commercial impression from the cited marks. Cited Mark 1 consists of two words “(IOSH) BLUEPRINT” and design elements. The color blue is also claimed as a feature of Cited Mark 1. Cited Mark 2 consists of two words “BLUEPRINT IT” and Cited Mark 3 consists of two words “BLUEPRINT SERIES.” The cited marks all share the word “BLUEPRINT” and the Examiner views that Applicant’s Mark is substantially similar to these marks as it is a misspelling of “BLUEPRINT.” However, Applicant respectfully contends that Applicant’s Mark does not so resemble the cited marks such that confusion is likely.

It is well established that while more or less weight may be given to a particular feature of a mark, the ultimate determination that two marks are confusingly similar must rest upon a consideration of the marks in their entireties. *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 4 USPQ 1942 (6<sup>th</sup> Cir. 1987) (holding that LITTLE CAESARS and design and PIZZA CAESAR USA and design both for restaurant services were not confusingly similar). The use of the identical, even dominant, words in common does not necessarily mean that two marks are confusingly similar. *In re P. Ferrero & C.S.p.A.*, 178 USPQ 167 (CCPA 1973). In that case, the Court of Customs and Patent Appeals found that TIC TAC for candy and TIC TAC TOE for ice cream were sufficiently different in sight and meaning to preclude any likelihood of confusion, notwithstanding the fact that the goods might both emanate from a single source.

Here, Applicant’s Mark is distinguishable in appearance from the cited marks, at least as much as the cited marks are to be considered distinguishable from one another, as shown below.

<u>Applicant’s Mark</u>	<u>Cited Marks</u>
<b>MYBLUPRINT</b>	
	<b>BLUEPRINT IT</b>
	<b>BLUEPRINT SERIES</b>

Furthermore, Applicant’s Mark creates a sufficiently different commercial impression from the cited marks such that there is no likelihood of confusion. It is well established that, even between arguably identical marks used in connection with arguably overlapping goods in an identical class, there can be sufficiently distinct commercial impressions that would preclude a likelihood of confusion. For instance, the Board noted in Sears:

*The second additional factor to be considered is the different meanings which the involved marks project when they are applied to the differing goods of the applicant and registrant. We agree with applicant that its mark “CROSS-OVER”, when applied to brassieres, is suggestive of the construction of the brassieres. Registrant’s mark “CROSSOVER”, on the other hand, conveys no such meaning when applied to ladies’ sportswear, namely, tops, shorts, and pants. Rather, it appears to us that registrant’s mark is likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which “crosses over” the line between informal and more formal wear (i.e., is appropriate for either use), or the line between two seasons. As a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance.*

*In connection with the foregoing, we note that in other close cases of this nature...such factor has played an important role in this Board’s conclusion of no likelihood of confusion. See, for example: ...In re Sydel Lingerie Co., Inc., 197 USPQ 629 (TTAB 1977) (“BOTTOMS UP” for ladies’ and children’s underwear versus “BOTTOMS UP” for men’s suits, coats, and trousers – marks found to project different meanings as applied to the respective goods); and In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) (“PLAYERS” for men’s underwear versus “PLAYERS” for shoes – marks found to project different meanings as applied to the respective goods). ...*

In re Sears, Roebuck and Co., 2 U.S.P.Q. at 1314-15 (emphasis added). Similarly, as specifically stated by the Board in Sydel Lingerie:

Thus, if “BOTTOMS UP” can be deemed to have any suggestive connotation as applied to men’s suits, coats and trousers, it will be in association with the drinking phrase, “drink up!” ... This is hardly the connotation that “BOTTOMS UP” would generate as applied to ladies’ and children’s underwear.

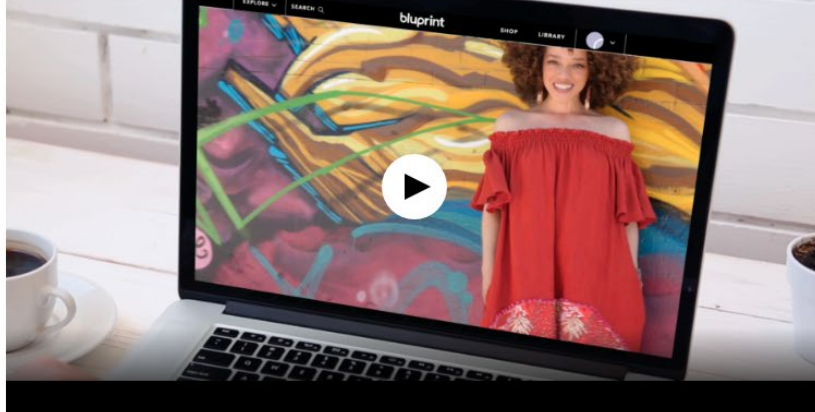
In re Sydel Lingerie Co., 197 U.S.P.Q. at 630 (TTAB 1977). Likewise, the Board opined in British Bulldog that:

[W]e agree with applicant’s argument, quoted below, to the effect that the mark “PLAYERS” has somewhat different connotations when applied to ... different goods [in the identical class], namely:

“PLAYERS” for shoes implies a fit, style, color, and durability adapted to outdoor activities. “PLAYERS” for men’s underwear implies something else, primarily indoors in nature.

In re British Bulldog, Ltd., 224 U.S.P.Q. at 856.

Here, as with Sears, Sydel, and British Bulldog, Applicant’s Mark and the cited marks create sufficiently different commercial impressions such that there is no likelihood of confusion. For instance, Applicant’s Mark will be presented in a manner that is tied to Applicant’s digital platform, which focuses on lifestyle learning. The below is an example of how the Applicant’s BLUPRINT house mark is used on its digital platform:




START FREE TRIAL

### Make with Confidence

Go from where-do-I-start to look-what-I-made with an online subscription to Bluprint.

See Exhibit A for more examples of Applicant’s activities.

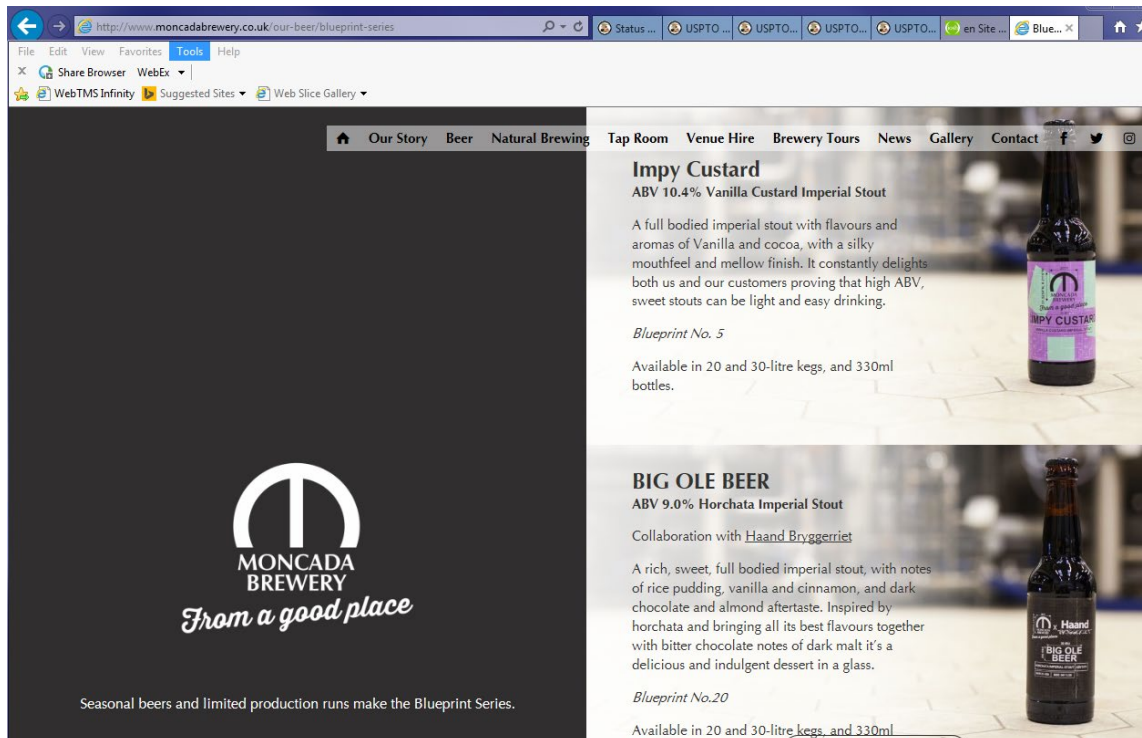
When the commercial impression created by Applicant’s Mark is compared against that created by Cited Mark 1, there can be no likelihood of confusion. While there is no specimen of record available for Cited Mark 1, the record indicates that most of the goods/services claimed for this registration are specified to be related to the field of occupational health and safety. Thus, this design mark (  ) creates a different commercial impression from Applicant’s Mark, especially given the differences between the respective parties’ fields. See Exhibit B for copy of registration certificate for Cited Mark 1 which shows the full description of registrant’s goods and services.

Cited Mark 2 consists of a phrase which also creates a different commercial impression from Applicant’s Mark, which is a single word. The specimen of record for Cited Mark 2 further demonstrates that this phrase (“Blueprint it!”) leaves a different commercial impression from Applicant’s Mark, as depicted below.



See Exhibit C for the specimen submitted by the registrant for Cited Mark 2 which shows how the phrase BLUEPRINT IT is used with the registrant's goods.

As for Cited Mark 3, while there is no specimen of record available, the registrant appears to be a beer brewery, and uses BLUEPRINT SERIES in connection with a series of beers, as shown on the registrant's website below. Thus, the overall commercial impressions are quite different and confusion is not likely with respect to Cited Mark 3.



## **B. The Goods/Services Offered, Trade Channels, and Consumers Targeted are Distinct**

Applicant respectfully notes that the goods offered in connection with Applicant's Mark are not only distinguishable from the goods offered in connection with the cited marks, but the trade channels and targeted consumers are also different.

Applicant is a division of a major entertainment company, and Applicant's "BLUPRINT" mark is currently used as a house brand for its digital platform which focuses on lifestyle learning and features various content on the topics of knitting, quilting, sewing, cooking, drawing, photography, and many more. Applicant also features content connected to its related entertainment companies and the consumers targeted by Applicant would overlap with those that engage with its content. Therefore, Applicant's Mark when used with the applied-for goods in this application, would tie back to Applicant's "BLUPRINT" digital platform in the minds of the consumers targeted.

Furthermore, the registrants of the cited marks are in different fields from Applicant. Thus, the trade channels and targeted consumers would be quite distinguishable. Consumers would take a very different commercial impression from Applicant's Mark and the cited marks as applied to the respective goods. For instance, when consumers encounter Applicant's Mark in connection with the applied-for goods in this application as they would be offered, they are likely to conjure up the related lifestyle learning content or other services with which Applicant uses the BLUPRINT mark on its digital platform.

However, when consumers encounter the cited marks, they would have a different commercial impression. For example, Cited Mark 1 contains its registrant's house mark ("IOSH") as the first element of the mark, which appears to be an acronym for the Institution of Occupational Safety and Health. Cited Mark 2, as noted above as well as in the specimen description of record, is a phrase ("BLUEPRINT IT"). Cited Mark 3 appears to be used in connection with its registrant's brewery business and its series of beer ("BLUEPRINT SERIES"). See Exhibit D for an overview of the cited registrants' activities.

The word "blueprint" as used in each of the cited marks would therefore create a different commercial impression from Applicant's Mark, MYBLUPRINT, when used in the context of Applicant's business. Given the evidence of record, it is respectfully submitted that there could be no likelihood of confusion resulting from Applicant's Mark and the cited marks.

In addition to the marks at issue in Sears, Sydel, and British Bulldog, Applicant further respectfully notes that the U.S. Patent and Trademark Office routinely accepts marks for registration that may be alleged to be identical for arguably overlapping goods and services. Furthermore, the USPTO has accepted the cited marks for registration though they all share the identical "BLUEPRINT" element at issue for arguably overlapping goods. Although third-party registrations do not necessarily bind the USPTO or its reviewing Board, these illustrate the common practice of the USPTO to find such marks registrable. Thus, if the cited marks are not deemed to create a likelihood of confusion with one another, Applicant respectfully notes that Applicant's Mark also would not create a likelihood of confusion with any of the cited marks.

Refusal to register under Section 2(d) requires that consumer confusion be likely, not just possible. See Estee Lauder, Inc. v. The Gap, Inc., 108 F.3d 1503, 1510 (2d Cir. 1997) ("likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible'"). Moreover, such confusion must be likely for a substantial share of reasonable consumers, rather than just a "negligible portion of the relevant market." T.A.B. Sys. v. Pactel Teletrac, 77 F.3d 1372, 1377 (Fed. Cir. 1996). To determine if these criteria are met, courts consider several factors. See In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973) (outlining likelihood-of-confusion factors); see

also T.M.E.P. § 1207.01 (same). The weight of each factor may vary depending on the facts of each case. See DuPont, 476 F.2d at 1361-62. The Examining Attorney need not consider all factors, but may consider those “most relevant and important” to the case at hand. In re Dixie Restaurants, Inc., 105 F.3d 1405, 1407 (Fed. Cir. 1997). Here, as noted above, the relevant DuPont factors weigh heavily against a likelihood of confusion, and therefore in favor of registration.

Moreover, it is well settled that where, at the examining stage, any doubts exists regarding whether or not a mark presents a likelihood of confusion, those doubts must be resolved in favour of the applicant and the mark should be permitted to proceed to publication. See, e.g., In re On Tech. Corp., 41 U.S.P.Q.2d 1475 (T.T.A.B. 1996); In re Morton-Norwich Prods., Inc., 209 U.S.P.Q. 791, 791 (T.T.A.B. 1981) (noting that the Board’s practice is “to resolve doubts in applicant’s favour and publish marks for opposition”). Accordingly, Applicant respectfully requests that the Examining Attorney reconsider and withdraw its objection based upon Trademark Act Section 2(d).

## AMENDMENT

### 1. Amendment to Identification of Goods

Applicant respectfully submits the following amendment for the goods in International Class 16:

“Paper, cardboard; children's storybooks; comic books; poster books; address books; graphic novels; magazines featuring stories, games and activities for children; bookmarks; bookbinding material; photograph albums; scrapbook albums; sketchbook albums; sticker albums; notebooks; diaries; blank writing journals; stationery; envelopes; writing paper; printed invitations; postcards; greeting cards; collectible trading cards; memo pads; folders; binders; adhesives for stationery or household purposes; artists' materials, namely, easels, pastels; paint brushes; arts and crafts paint kits; modeling materials and compounds for use by children; activity kits consisting of stickers and stamps; school supplies, namely, mechanical pencils, highlighter pens, protractors for drawing, chalk; school supply kits containing various combinations of selected school supplies, namely, writing instruments, pens, pencils, mechanical pencils, erasers, markers, crayons, highlighter pens, folders, notebooks, paper, paper clips, pencil sharpeners, writing grips, glue for stationery purpose, drawing rulers, drawing compasses, protractors for drawing, and bookmarks; writing instruments; pens; pencils; writing grips; pen and pencil cases; erasers; pencil sharpeners; decorative pencil top ornaments; markers; crayons; paper clips; staples; paper staplers; staple removers; drawing rulers; drawing compasses; glue for stationery or household purposes; writing slates; rubber stamps; stamp pads; stencils; stickers; decals and heat applied transfer **decals**; heat applied appliques made of paper; printed photographs; posters; calendars; coasters made of paper; paper pennants; gift bags; gift boxes; paper party supplies, namely, ~~paper party favors~~, paper napkins, paper placemats, paper gift wrap, paper gift wrapping ribbons, paper table cloths, paper party bags, paper cake decorations, and paper party decorations; paper gift cards”

## CONCLUSION

In view of the above, consumer confusion between Applicant's Mark and the cited marks is unlikely. Applicant believes that it has met all the requirements as outlined in the outstanding Office Action and respectfully requests that the Examining Attorney pass the Application to Registration.

Respectfully submitted,

*/Anna Kim/*

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