

Response to Office Action Issued 10/18/2018
 U.S. Application Serial No. 88/011,874 (LENSRENTALS)
 Date of Response: 04/15/2019



Likelihood of Confusion with Registration No. 4,334,341

The registrant of Registration No. 4,334,341 owns 89% of the outstanding voting securities of the Applicant. There is a unity of control over the use of the Applicant’s mark and the registrant’s mark. Therefore, the Applicant and the registrant, though separate legal entities, constitute a single source and there is no likelihood of confusion.¹

Likelihood of Confusion with Registration No. 4,312,086

Registration No. 4,312,086 (the “**Cited Mark**”) should not have been permitted to register on the Principal Register. The mark consists of the phrase “TopLensRental” in connection with “*Rental of cameras; Rental of photographic equipment; Rental of video cameras.*” As discussed in the Office Action, the words “lens” and “rental” merely describe the services associated with the mark. In addition, the word “top” is a laudatory term and merely descriptive². There is no design or stylistic element to the mark. Therefore, the entire mark is descriptive. And there is no evidence of the mark having established secondary meaning. If the Cited Mark can even function as a service mark, it is extremely weak and should be afforded very narrow protection.

The application should be allowed based on the prior “Lens Rentals” registrations of the Applicant’s owner. The Applicant’s owner already has or had the following registrations:

Mark	Services
 <p>Reg. No. 3,679,243³ Reg. Date: 9/8/2009</p>	<p><u>Class 35</u>: Retail store and on-line retail store services featuring digital single lens reflex camera equipment, camera lenses, video cameras and photographic lighting and supplies</p>
 <p>Reg. No. 4,334,341 Reg. Date: 5/14/2013</p>	<p><u>Class 41</u>: Rental of camcorders; Rental of cameras; Rental of photographic equipment; Rental of video cameras; Rental services for audio and video equipment</p>

¹ See TMEP § 1201.07



² See TMEP § 1209.03(k)

³ Active registration from 2009 to 2016

Clearly, the dominant component of each of these marks is the phrase “Lens Rentals.” One of these registrations (No. 3,679,243) predates registration of the Cited Mark and both of these registrations have co-existed for years on the Principal Register with the Cited Mark. In light of the foregoing, there is no reason why the Applicant’s mark for the same phrase, “Lens Rentals,” should not be permitted to register in spite of the Cited Mark.

Disclaimer

No disclaimer is required because the phrase “Lens Rentals” has become distinctive of the Applicant’s services. As discussed above, the Applicant’s owner has the following prior registrations:

Mark	Services
 <p>Reg. No. 3,679,243⁴ Reg. Date: 9/8/2009</p>	<p><u>Class 35:</u> Retail store and on-line retail store services featuring digital single lens reflex camera equipment, camera lenses, video cameras and photographic lighting and supplies</p>
 <p>Reg. No. 4,334,341 Reg. Date: 5/14/2013</p>	<p><u>Class 41:</u> Rental of camcorders; Rental of cameras; Rental of photographic equipment; Rental of video cameras; Rental services for audio and video equipment</p>

Clearly, the dominant component of each of the foregoing registered marks is the phrase “Lens Rentals.” This phrase presents a separate and distinct commercial impression apart from the other elements of these marks.

In addition, the phrase “Lens Rentals” has become distinctive of the Applicant’s services by reason of the Applicant’s and its affiliate’s substantially exclusive and continuous use of the phrase in commerce since at least 2006.

Substitute Specimen

The Applicant has submitted a substitute specimen that matches the applied-for mark.

Conclusion

The Applicant respectfully submits that the application is fit for publication.

⁴ Active registration from 2009 to 2016