

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 88033795
Application of : Celebrity Cruises Inc.
Date Filed : July 11, 2018
Examining Attorney : Sung In
Law Office : 103
Docket : 11668-6 (342019)
Mark : CELEBRITY OPUS

RESPONSE TO OFFICE ACTION

This response is submitted to the Office Action dated November 6, 2018, which issued a 2(d) likelihood of confusion refusal. As set forth below, the likelihood of confusion rejection should be withdrawn and the application published for opposition because (i) the services are different, (ii) the relevant consumers' sophistication level will prevent confusion, (iii) Applicant's CELEBRITY house mark avoids confusion and (iv) the PTO already made a determination that the identical marks and services are not likely to cause confusion.

I. The Section 2(d) Likelihood Of Confusion Refusal Should Be Reversed

The refusal to register based on a purported likelihood of confusion with Registration No. 3914976 should be withdrawn. It is well settled that the test for determining whether a likelihood of confusion under Section 2(d) exists includes any combination of the factors set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). And, that test favors registration.

A. The Services Of The Cited Registration Are Different Than the Services Of The Applied-For Mark

Applicant's arranging of cruises; cruise ship services; transportation of passengers by cruise ship in Class 39, are narrowly tailored to Applicant's cruise ship industry. To the contrary, the cited mark, as confirmed by the specimen filed with the PTO, is used to "organize performance tours for choirs and orchestras around the world" by arranging for

travel visas, passports and travel documents for persons traveling abroad; Arranging travel tours; Coordinating travel arrangements for individuals and for groups; Escorting of travellers; Making travel and excursion arrangements for bands and orchestras; Organisation of travel; Organization of excursions, sightseeing tours, holidays, tours and travel; Organization of travel and boat trips; Provision of travel information; Reservation and booking of seats for travel; Travel agency services, namely, making reservations and bookings for transportation; Travel and tour information service; Travel and tour ticket reservation service; Travel booking agencies; Travel guide and travel information services; Travel guide services; Travel information; Travel information services, as excerpted from the specimen below.

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Our Promise: Unsurpassed Service

Opus Tours believes that performance music and international travel make perfect harmony.

That's one of the reasons why we organize performance tours for choirs and orchestras around the world. Whether it's Prague or Patagonia, Barcelona or Beijing, your Opus customized tour will feature unmatched musical experiences and vibrant cultural exchanges.

Opus Tours gives you personalized one-on-one

Such organization of performance tours for choirs and orchestras around the world, including the ancillary services thereto, are different than, and easily distinguishable from, cruise ship services.

B. The Sophistication Of Consumers Prevents A Likelihood Of Confusion

Applicant respectfully submits that the relevant consumers of both party's services are sophisticated such that a likelihood of confusion is prevented. Consumers, who perform

in choirs and orchestras and who purchase services to perform in choirs and orchestras on a tour, are sophisticated enough to know that such services are uniquely different than cruise ship services. Likewise, a purchaser of cruise ship services understands that (i) cruise ship services are not somehow related or ancillary to performance in choirs and orchestras on a tour and (ii) services for and related to performing in a choir or orchestra on a tour are different than cruise ship services.

C. Applicant's CELEBRITY House Mark Prevents Confusion

There is no likelihood of confusion under applicable law, and particularly, in view of TMEP § 1207.01(b)(iii) *Comparing Marks That Contain Additional Matter*. Although it is the general rule that that a likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services, exceptions to the rule exist. The analysis here for the applied-for CELEBRITY OPUS mark requires application of the exception.

Exceptions to the general rule regarding additions or deletions to marks may arise if:

- (1) the marks in their entireties convey significantly different commercial impressions; or
- (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

TMEP § 1207.01(b)(iii).

The applied-for mark qualifies under the first exception. The marks must be compared in their entireties, including applicant's house mark **CELEBRITY** in CELEBRITY OPUS. There is a long line of precedent that adding a house mark can convey an overall significantly different commercial impressions.

For instance, in *In re Shawnee Milling Co.*, the applicant appealed from a refusal to register GOLDEN CRUST for use in connection with flour under §2(d) in view of the previously registered mark ADOLPH'S GOLD'N CRUST (and design to the right) for use in connection with combination coating and seasoning for poultry, fish and certain vegetables. The Trademark Trial and Appeal Board (“TTAB”) noted that “in cases where there are some recognizable differences in the assertedly conflicting product marks or where the conflicting marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a housemark and/or other material to one of the marks has been held sufficient to render the marks as a whole distinguishable.” *In re Shawnee Milling Co.*, 225 USPQ at 748-749.



The TTAB also noted that the registrant disclaimed the words GOLD'N CRUST apart from the mark as a whole because of the is descriptiveness. Furthermore, the TTAB was persuaded by the fact that the applicant had overcome a refusal to register under §2(e)(1) where the Examining Attorney had asserted that “the mark merely describes an attribute of the floured baked goods when using applicant's goods -- items possessing a golden colored crust, based on the nature or consistency of the flour.” *Id.* The TTAB recognized that although the §2(e)(1) refusal was withdrawn,

it is clear that ‘GOLDEN CRUST’ or its phonetic equivalent ‘GOLD'N CRUST’ as applied to flour and/or to combination coating and seasoning is, at the very least, highly suggestive of a desired result of use of the goods.” *Id.* As such, the scope of protection for such a suggestive or nonarbitrary term is less than that of a distinctive or arbitrary mark and we believe that the addition of the house mark ‘ADOLPH'S’ to registrant's mark is sufficient to distinguish the marks as a whole and to avoid the prescription to the registration of applicant's mark under Section 2(d) of the Act.

Id. Thus, the TTAB reversed the refusal to register and the GOLD'N CRUST mark has been registered ever since.

As shown above, the cited OPUS mark is used in connection with “organizing performance tours for choirs and orchestras around the world.” One definition of “opus” is

“a musical composition or set of compositions usually numbered in the order of its issue.” <https://www.merriam-webster.com/dictionary/opus>. The cited mark, having a meaning associated with *musical compositions* and which is used in connection with organizing performance tours for *choirs and orchestras to play such musical compositions* should not be given such a wide scope of protection to prevent registration of narrowly tailored services in a different industry. In other words, because the cited mark’s overall commercial impression is uniquely correlated to musical compositions and organizing performance tours of choirs and orchestras therefor, the addition of Applicant’s house mark CELEBRITY should be sufficient to distinguish the marks as a whole and to avoid a likelihood of confusion.

Just as the house mark ALDOLPH’S was sufficient to distinguish between the two marks, Applicant respectfully submits that the CELEBRITY house mark obviates any likelihood of confusion with the applied-for mark.

D. As a Matter of Consistency of PTO Practice, the Applied-For Mark Should Not Be Rejected as the Identical Mark was Previously Approved for Publication Without Rejection

The PTO already examined an identical mark and services and found no likelihood of confusion. Applicant’s parent company, Royal Caribbean Cruises Ltd., filed Application No. 87960531 for CELEBRITY OPUS. That application for the identical mark and services was published for opposition without an office action ever being issued.

Applicant respectfully requests the Examining Attorney to apply an examination standard consistent with that which was applied to Application No. 87960531. Consistency, in and of itself, is a desirable goal, because the time and expense of complying with inconsistent examination standards burdens both the PTO and the public which depends on its services. *See* Trademark Consistency Initiative, published September 29, 2008, which became permanent. <https://www.uspto.gov/trademark/trademark-updates-and-announcements/consistency-initiative>. Just like the first application was approved without an office action, this application should also be approved for publication because there is no likelihood of confusion.

II. Conclusion

For at least the reasons set forth above, withdrawal of the likelihood of confusion rejection and approval for publication is requested. Applicant invites the Examiner to call the undersigned if clarification is needed on any aspect of this response.

Respectfully submitted,

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