

Mark: BLUESTAR & Design
Serial No.: 87533795

The Examining Attorney has cited five active trademark registrations as potential barriers to the registration of Applicant's BLUESTAR & Design mark. For the reasons set forth below, Applicant respectfully disagrees that these marks are confusingly similar.

In determining whether a likelihood of confusion exists, the fundamental inquiry goes to "the cumulative effect of the differences in the essential characteristics of the goods and differences in the marks" at issue. Federated Foods, Inc. v. Fort Howard Paper Co., 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). It is quite possible for no likelihood of confusion to exist even between marks that may appear substantially similar in the abstract, where the respective services that the marks identify are such that prospective customers are not likely to assume that those services share a common source.

1. BLUE STAR CAREERS, Reg. Nos. 4816744

The cited registration for BLUE STAR CAREERS identifies the following Class 35 services: "career planning services; organizing business networking events in the field of all career fields for military spouses; providing employment counseling information on how to successfully transition jobs for military spouses."

Applicant's mark, in contrast, identifies the following Class 35 services: "talent recruitment services in the field of amateur sports; sports recruiting services for high school and college athletes; public relations services in the field of amateur sports; career development services for middle school, high school and college athletes; providing information and news in the field of amateur sports recruitment."

Both Applicant and the owner of the cited registration have provided very specific information revealing their intended customers – student athletes versus military spouses. The typical trade channels the parties would use to reach their distinct audiences would have little to no overlap. Accordingly, the parties' services, trade channels and intended customers are sufficiently distinct to make confusion highly unlikely.

Further lowering the possibility that the parties' services are related is the sophistication of Applicant's consumers. Student athletes can be assumed to be careful purchasers, given the substantial training and expertise needed to guide their athletic training and careers. These sophisticated consumers may be expected to exercise greater care in making purchasing decisions, and to notice differences between the respective services and their source. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 223 U.S.P.Q. 1281 (Fed. Cir. 1984) (“purchasers of casual, low-cost ordinary consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of goods”). This high degree of care exercised by the parties' consumers assures that consumers will not confuse the marks at issue here.

**2. BLUE STARS, Reg. No. 5503715
BLUE STARS ADMISSIONS CONSULTING, Reg. No. 5503716**

The cited registrations for BLUE STARS and BLUE STARS ADMISSIONS CONSULTING are both owned by Amy Morgenstern d/b/a Blue Stars Admissions Consulting. As shown in the Letter of Consent attached as Exhibit A, the parties do not believe that there is a likelihood of confusion between their marks.

First, the parties' marks have coexisted peacefully in the marketplace for several years. Second, the parties do not believe there is a likelihood of confusion between

their marks, given the differences in the nature of the services their respective marks identify, their different customers, and their different trade channels. Third, the parties are not aware of any instances of actual confusion arising from their use of their marks and have agreed that if they become aware of any instances of confusion, they will take all reasonable steps to correct the confusion.

**3. BLUE STAR SPORTS, Reg. No. 5365648
BLUE STAR SPORTS & Design, Reg. No. 5381336**

The cited registrations for BLUE STAR SPORTS and BLUE STAR SPORTS & Design are both owned by Jones Team Sports, Inc. Pursuant to a settlement agreement between Applicant and Jones Team Sports, dated and signed in December 2017, Jones Team Sports agreed to cease all use of the BLUE STAR SPORTS trademark. Due to confidentiality provisions, Applicant cannot attach a copy of that agreement to this office action response. Applicant has, however, contacted Jones Team Sports, Inc. regarding the need to voluntarily cancel its registrations for the BLUE STAR SPORTS and BLUE STAR SPORTS & Design marks and expects that process to be complete shortly. As those marks are no longer in use and as their registrations will be cancelled shortly, Applicant requests that the Examining Attorney withdraw the citation of these marks as an obstacle to the registration of Applicant's mark.

EXHIBIT A

CONSENT TO REGISTRATION

Amy Morgenstern dba Blue Stars Admissions Consulting owns U.S. trademark Reg. No. 5503715 for the mark BLUE STARS and U.S. trademark Reg. No. 5503716 for the mark BLUE STARS ADMISSIONS CONSULTING & Design, both for "Admission consulting services, namely, consulting in the field of college admissions, specifically, college selection, completing admissions applications, and preparation for college admission interviews; College consulting services, namely, assisting students in finding colleges and universities and completing the application process; Educational services, namely, providing mentoring, tutoring, classes, workshops, lectures, and non-downloadable videos in the fields of college and graduate school admissions and college and graduate school planning" (the "Morgenstern Marks").

Blue Star Productions, Inc. has used, and has filed Application Ser. No. 87533795 for the mark BLUE STAR & Design; Application Ser. No. 87478136 for the mark BLUE STAR and Application Ser. No. 87478122 for the mark BLUESTAR, for the following services (the "BSP Marks"):

Class 35: talent recruitment services in the field of amateur sports; sports recruiting services for high school and college athletes; public relations services in the field of amateur sports; career development services for middle school, high school and college athletes; providing information and news in the field of amateur sports recruitment.

Class 41: coordination, organization and management of amateur sports competitions, showcases and events; sports training services, namely, evaluation, training and development of middle school, high school and college athletes; operation of sports camps for middle school, high school and college athletes; sports instruction services; providing information, news and thought leadership development training in the field of amateur sports

Morgenstern and BSP believe that there is no likelihood of confusion arising from their continued use of the Morgenstern Marks and the BSP Marks. The parties acknowledge that their use of these marks for their respective services have coexisted peacefully in the marketplace for several years. Further, the parties do not believe there is a likelihood of confusion between their marks, given the differences in the nature of the services their respective marks identify, their different customers, and their different trade channels. Finally, the parties are not aware of any instances of actual confusion arising from their use of their marks and agree that if they become aware of any instances of confusion, they will take all reasonable steps to correct the confusion.

Accordingly, Morgenstern consents to BSP's registration with the U.S. Patent and Trademark Office of the BSP Marks.

Date: May 24, 2019

By: *Amy Morgenstern*
By: Amy Morgenstern (May 24, 2019)
Name: Amy Morgenstern
Title: Principal

Amy Morgenstern dba Blue Stars Admissions Consulting