

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Trademark Application of Rolls-Royce Corporation

Serial No.: 88/077,927

Law Office: 114

Filed: August 14, 2018

Examining Attorney: Eugenia K. Martin

Mark: BANSHEE

AMENDMENT

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

Responsive to the Office Action mailed December 10, 2018, Applicant amends the application and provides the following remarks:

Identification of Goods

Please amend the Identification of Goods to read:

A CLASS OF UNMANNED WATERBORNE VESSELS in Class 12.

Refusal for Indefinite Identification of Goods

The Office refuses registration on the basis that the Identification of Goods “is indefinite and must be clarified.” Responsive to this refusal, Applicant has amended and clarified the Identification of Goods.

Refusal Under § 2(d) – Likelihood of Confusion

The Office refuses registration under § 2(d), finding the BANSHEE mark confusingly similar to the marks of U.S. Registration Nos. 1481532 and 5559023. The Office additionally notes U.S. Application No. 88041821 as potentially leading to a § 2(d) refusal if registered.

Applicant notes that U.S. Registration No. 1481532 was canceled April 12, 2019, obviating the refusal premised on this registration. However, even absent this cancellation the present application is allowable over the cited registrations.

In the cited registrations, the mark BANSHEE is previously registered for “Structural parts of all-terrain vehicles” (Reg. No. 1481532) and “Bicycle frames and parts thereof” (Reg. No. 5559023). The co-existence of these registrations show that each registration is entitled to a narrow penumbra of protection. The present application seeks to register the mark BANSHEE for “a class of unmanned waterborne vessels.” As parts of bicycles were sufficiently distinguished from parts of all-terrain vehicles so as not to cause a likelihood of confusion, so too are a class of unmanned surface vessels sufficiently distinguished from both parts of bicycles and parts of all-terrain vehicles so as not to cause a likelihood of confusion.

Similarly, with respect to Application No. 88041821 Applicant notes that the applied-for BANSHEE MAYHEM mark would potentially be registered for “Land vehicle structural parts for all terrain vehicles; Land vehicles and structural parts therefor;

all of the foregoing excluding bicycles.” As registrations previously were allowed without confusion in Registration Nos. 1481532 and 5559023, no confusion results from registration of the present application.

Applicant respectfully requests withdrawal of the refusal under § 2(d).

Conclusion

The present application is now in condition for registration.

Respectfully submitted,

/D. Joseph English/
D. Joseph English
Attorney for Applicant

DUANE MORRIS LLP
505 9th Street, N.W., Suite 1000
Washington, D.C. 20004
Telephone: (202) 776-7800
Facsimile: (202) 776-7801

Dated: June 7, 2019