

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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In re Application of)	
Applicant: American Bible Society)	Law Office: 120
Serial No.: 88207124)	
Class: 09)	Examining Attorney:
Date Filed: November 27, 2018)	Jacquelyn A. Jones
Mark: FIRST THING)	
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Response to Office Action

In response to Office Action dated, January 16, 2019, Applicant American Bible Society responds as follows.

1. Likelihood of Confusion.

The Examining Attorney has initially refused registration of Applicant’s mark **FIRST THING** on the ground of likelihood of confusion with the following mark: U.S. Registration No. 2701448 (“K U R T W A R N E R FIRST THINGS FIRST F O U N D A T I O N MATTHEW 6:33” & Design). Applicant respectfully submits that its mark is not confusingly similar to registrant’s mark for the reasons below, and should be permitted to register.

Applicant’s mark presents a substantially different commercial impression from the registered mark. The proper test to determine a consumer’s likelihood of confusion is whether the marks create the same overall commercial impression. Rather than consider the similarities between *component parts* of the marks, one must evaluate the impression that each mark *in its entirety* is likely to have on the purchaser exercising the attention usually given by purchasers of such products. *See e.g. Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). As the U.S. Supreme Court held, “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Bekwith, Inc. v. Comm. of Patents*, 252 U.S. 538, 546 (1920); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981).

In addition, although marks must be considered in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Dominant portions of a composite design and word mark are to be given greater weight. *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on, in-part, identical goods).

Applicant’s FIRST THING mark is distinguishable from the prior registered mark because it presents a substantially different commercial impression. In the cited mark, the design portion of

the mark is the largest element of the mark, comprised of a prominent, unique cross and blade design inside of an oval, and the large words “FIRST” and “FIRST” in a highly stylized format. Applicant’s mark happens to contain two words that are a part of the cited mark, but when consumers see the cited mark, they would not immediately see the words “FIRST THING”. Rather, visually they would focus on the large prominent design and the double use of the word “FIRST,” so it is highly unlikely they would be confused by Applicant’s mark FIRST THING.

Under the “overall impression” analysis, there is no rule that confusion is automatically likely if a junior user has a mark that is entirely incorporated in another’s mark. For instance, all of the following marks (one containing the whole of the other), were held not to be confusingly similar:

PEAK PERIOD held not confusingly similar to PEAK. *Colgate-Palmolive Co. v. Cater-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (C.C.P.A. 1970);

ALL CLEAR held not confusingly similar to ALL. *Lever Bros Co. v. Barcolene Co.*, 263 F.2d 1107, 174 USPQ 392 (C.C.P.A. 1972)

TIC TAC held not confusingly similar to TIC TAC TOE. *In re Ferrero*, 479 F.2d 1395, 178 USPQ 167 (C.C.P.A. 1975).

DULUTH NEWS-TRIBUNE held not confusingly similar to competitor’s SATURDAY DAILY NEWS & TRIBUNE. In *Duluth News-Tribune, Inc. v. Mesabi Pub. Co.*, 84 F.3d 1093, 38 U.S.P.Q. 2d 1937 (8th Cir. 1996).

As seen in the cases cited above, the fact that Applicant’s mark is contained in prior marks does not automatically mean that confusion is likely. These cases show that the presence of even just one extra term can obviate a likelihood of confusion. In this case, the cited mark does not contain merely one extra term, but four additional terms plus a distinctive design.

When consumers view the cited mark, they are confronted with a barrage of many various component words. Applicant’s mark only has two words, while the cited mark has seven (plus a large design):

KURT WARNER
FIRST
THINGS
FIRST
MATTHEW 6:33
FOUNDATION

The presence of so many disparate parts creates a very unique commercial impression that is not shared by Applicant’s simple mark.

The words in the cited mark begins with the name of a popular former NFL quarterback (“KURT WARNER”). Having this nationally recognized name as the first part of the mark immediately makes this mark distinguishable from Applicant’s mark.

The additional words “MATTHEW 6:33” and the term FOUNDATION further distinguish the cited mark from Applicant’s mark.

The term “THINGS” is written in a small font squeezed in between the large words “FIRST” and “FIRST” so that it is not very noticeable. Consumers would not likely think of the phrase “FIRST THINGS” when viewing the cited mark, but would more likely see the double words “FIRST FIRST”. Since Applicant’s mark lacks the second use of the word “FIRST”, even if consumers notice the word “THINGS” in the cited mark, they are unlikely to think the marks are related. So it is unlikely consumers would make any association between Applicant’s mark and the cited mark. Also, Applicant’s use of the term THING is singular, while the prior mark’s use of the term THINGS is plural. These factors further differentiate commercial impressions of the respective marks. The sight and sound of the two marks are utterly different.

The meaning of the two marks are also different. First, obviously the famous name KURT WARNER creates a substantially different meaning. The additional terms MATTHEW 6:33 and FOUNDATION further add more meaning that is absent from Applicant’s mark.

Even the words that the marks have in common also are different in meaning. They each represent common idioms that have different established meanings in the English language. Merriam-Webster’s dictionary states that “first things first” is an idiom used when “one should do the things that are more important before doing other things.”¹ In contrast, the phrase “first thing” (without the third word “first”) has an idiom meaning, “before anything else: right away: very early.”² “First things first” refers to the *importance* of things, whereas “first thing” indicates an absolute time, *i.e.*, right away or very early.

Thus the meanings and connotations of the small portion of the marks that are in common are quite distinguishable. Because these expressions are so common, the average consumer will understand their distinctions and are not likely to be confused by the marks. When the meaning of the respective phrases and the cited mark’s design are taken into consideration, it is clear that FIRST THING presents a distinct commercial impression as compared to registrant’s mark.

Given so many differences in sight, sound, and meaning, when the marks are compared in their entireties, Applicant’s FIRST THING mark is not likely to cause confusion with the cited mark K U R T W A R N E R F I R S T T H I N G S F I R S T F O U N D A T I O N M A T T H E W 6 : 3 3 & Design. Therefore, Applicant’s mark is not confusingly similar to the prior cited mark.

Applicant submits that its application is in condition for publication and requests such action be taken.

2. Identification of Goods.

Applicant accepts Examining Attorney’s suggested amendments to the identification of goods. The amended identification reads as follows:

Class 9: Electronic publications, namely, downloadable books, brochures, pamphlets, study guides, reports, newsletters, ~~video recordings, audio recordings,~~ and electronic newsletters delivered via email, all in the fields of the Bible, Christianity, religion, theology, and promoting and encouraging daily Bible engagement to military members and their families, multi-lingual

¹ <https://www.merriam-webster.com/dictionary/first%20things%20first>. Accessed July 9, 2019.

² <https://www.merriam-webster.com/dictionary/first%20thing>. Accessed July 9, 2019.

*communities, immigrants, prisoners, members of Christian denominations, and the general public; **Video and audio recordings featuring** the Bible, Christianity, religion, theology, and **promotion and encouragement of** daily Bible engagement to military members and their families, multi-lingual communities, immigrants, prisoners, members of Christian denominations, and the general public; downloadable software in the nature of a mobile application for accessing the Bible and information in the fields of the Bible, Christianity, religion, theology, and promoting and encouraging daily Bible engagement to military members and their families, multi-lingual communities, immigrants, prisoners, members of Christian denominations, and the general public.*