Attorney Docket: 6182.10296

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marvel Characters, Inc.
Serial Number: 88219653
Filing Date: December 6, 2018
Mark: ULTIMATE ALLIANCE 3 THE BLACK ORDER

Examining Atty.: Tara J. Pate, Esq.
Law Office: 100

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

RESPONSE TO OFFICE ACTION

Marvel Characters, Inc. ("Applicant") submits the following amendment and remarks in response to the Office Action dated March 13, 2019.

AMENDMENT

Please replace the current recitation of services with the following (as amended, "Applicant's Amended Services"):

> Entertainment services, namely, providing online video games; providing information relating to online video games via global computer networks and electronic communication networks for use in connection with computers, mobile computers, media players, cellular phones, wireless devices, and portable and handheld digital electronic devices; providing an online entertainment information in the field of computer games, enhancements for computer games, online video games, and game applications via global computer networks and electronic communication networks for use in connection with computers, mobile computers, media players, cellular phones, wireless devices and portable and handheld digital electronic devices; providing temporary use of non-downloadable software for playing computer games; providing temporary use of non-downloadable game software to enable playing and otherwise providing computer games; providing interactive websites and applications featuring online video games and non-downloadable video games

SECTION 2(d) REFUSAL

The Examining Attorney has initially refused registration of Applicant's mark ULTIMATE ALLIANCE 3 THE BLACK ORDER under Section 2(d), 15 U.S.C. § 1052(d), on the ground of an alleged likelihood of confusion with U.S. Supplemental Register Registration No. 3963776 which is shown in the chart below (the "Cited ULTIMATE ALLIANCE DANCE COMPANY Mark").

Mark	Reg. No.	Services and Class	Owner
ULTIMATE ALLIANCE DANCE COMPANY	3963776	Dance club services; Dance events; Dance instruction; Dance instruction for children; Dance reservation services, namely, arranging for admission to dance events; Dance schools; Dance studios; Education services, namely, providing classes and instruction in the field of dance; Entertainment and education services in the nature of live dance and musical performances; Entertainment in the nature of dance performances; Entertainment in the nature of visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; Entertainment services, namely, dance events by a recording artist in Class 41	Derrick, Daniel M

As discussed below, Applicant submits that the differences between the marks and the narrower listing of services that Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark now covers makes confusion between Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark and the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark unlikely. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal to register.

A. The Marks Are Dissimilar in Overall Appearance, Sound, Connotation, and Commercial Impression

The Examining Attorney argues that Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark and the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark are similar because they share the wording ULTIMATE ALLIANCE. The Examining Attorney's analysis discounts the obvious differences between these marks in overall commercial impression, connotation, appearance, and sound that stem from the additional wording in Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark and use of the marks in the marketplace.

It is well settled that in a likelihood-of-confusion analysis, the marks must be considered in their entireties and it is improper to give weight only to particular shared terms in marks and to disregard all other wording. *See Nat'l Data Corp.*, 224 USPQ 749, 752 (Fed. Cir. 1985) ("[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark."); *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351, 1355–56 (Fed. Cir. 2000) (criticizing the TTAB for overemphasizing the fact that the marks shared the word "Packard" and failing to consider the marks in their entireties); *Franklin Mint Corp. v. Master Mfg. Co.*, 212 USPQ 233, 234–35 (CCPA 1981) ("It is axiomatic that a mark should not be considered piecemeal, rather it must be considered as a whole in determining likelihood of confusion.").

As the Supreme Court has noted, "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545–46 (1920). The rationale for this rule is that "[m]arks tend to be perceived in their entireties, and all components thereof must be

given appropriate weight." *In re Hearst Corp.*, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992); *see also Opryland USA Inc. v. Great Am. Music Show, Inc.*, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) ("Although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared.").

In *In re Hearst Corp.*, for example, the Federal Circuit found that the Trademark Trial and Appeal Board erred as a matter of law in finding the mark VARGAS was confusingly similar to the mark VARGA GIRL. 25 USPQ2d at 1239. The Federal Circuit held that the marks were *not* confusingly similar, and it criticized the Board for discounting GIRL from the mark. *Id.*

Similarly, the Board has time and again found that the mere fact that two marks share some, but not all, common terms is not dispositive on the issue of likelihood of confusion when the additional wording creates an entirely different commercial impression. *See Plus Products v. General Mills, Inc.*, 188 USPQ 520, 522 (TTAB 1975) (PROTEIN PLUS and PLUS not confusingly similar); *Standard Brands, Inc. v. Peters*, 191 USPQ 168, 172 (TTAB 1975) (CORN-ROYAL for butter not likely to cause confusion with ROYAL marks on other food products).

In this case, just as in *Hearst*, the Examining Attorney has improperly dissected Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark by focusing only on the two terms it shares with the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark—

namely, the wording "ULTIMATE ALLIANCE." When the marks are properly viewed as a whole, there are clear differences between them.

Applicant's distinctive, additional wording "3 THE BLACK ORDER" in Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark shares no similarities in appearance, sound, connotation, or commercial impression with the "DANCE COMPANY" portion of the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark. These words do not even appear in the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark.

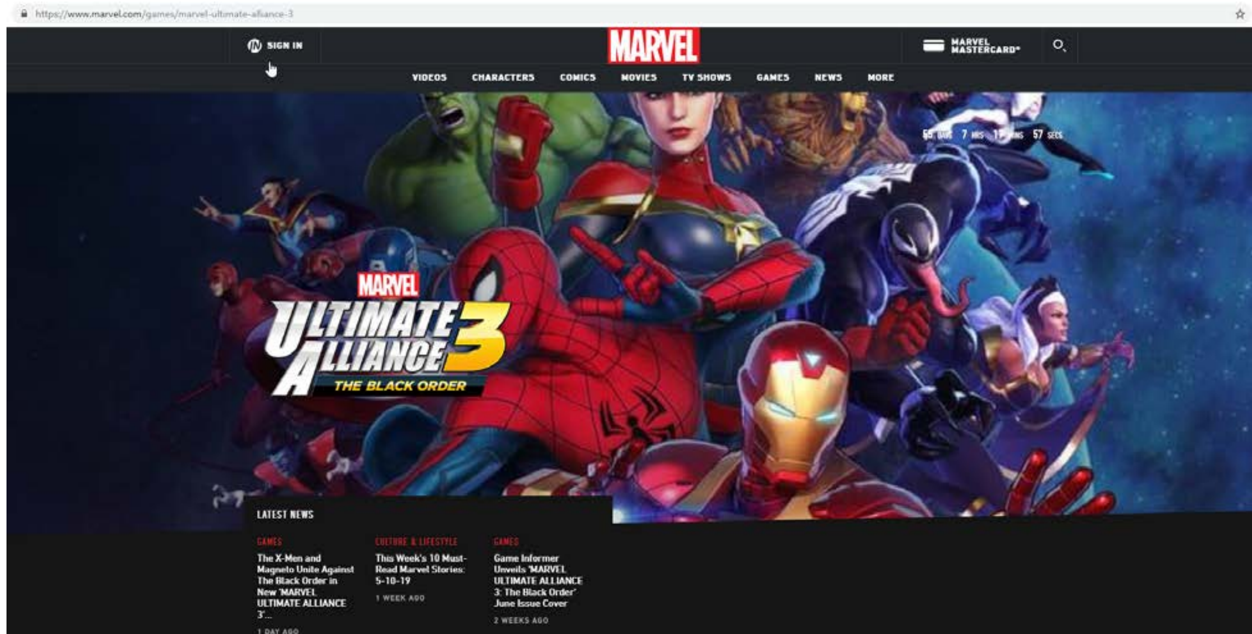
Further, the additional wording "DANCE COMPANY" in the cited mark conveys a different sound, appearance, and meaning from Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark. This additional working immediately conveys to consumers that the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark and services relate to dance. Indeed, the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark issued on the Supplemental Register because of this immediate dance connotation, which is completely different from Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark. Attached as Exhibit A is the specimen from the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark registration clearly identifying and showing dance services.

Further, unlike the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark, consumers will immediately recognize that Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark identifies and refers to Applicant and its well-known series of games featuring Marvel's famous characters. As shown below, Applicant first offered games in connection with its ULTIMATE ALLIANCE mark as early as 2006. In fact, Applicant owned prior Reg. No. 3250366 (subsequently cancelled on January 14, 2017)

for the mark ULTIMATE ALLIANCE for computer games for many years before registration of the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark. In 2009, as shown below, Applicant offered a second installment of games under its ULTIMATE ALLIANCE 2 mark.

Applicant now intends to release the third installment of action online video games, among other things, under Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark in the summer of 2019. Applicant's online games and online entertainment will again feature a team of characters, including those from Marvel's famous AVENGERS, THE GUARDIANS OF THE GALAXY, and X-MEN franchises. Attached as Exhibit B is a website printout regarding Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark and services. In this case, consumers will immediately recognize Applicant's ULTIMATE ALLIANCE 3 THE BLACK ORDER Mark and identify

Applicant as the source of the online games and other identified services, and not the cited registrant (a dance company).



In sum, when the marks are considered in their entireties and in the marketplace, the differences between the marks in overall appearance, sound, connotation, and commercial impression will no doubt avoid a likelihood of confusion.

B. Applicant's Amended Services Are Unrelated to the Services in the Cited Registration

The Examining Attorney argues that Applicant's services are identical to or encompass the services identified in the Cited Mark because Applicant's "education and entertainment services" encompass the dance education and entertainment services in the Cited Mark.

As shown above, Applicant's Amended Services clarify that it does not offer any dance services like those identified under the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark. In fact, as shown above, Applicant's Amended Services now feature

a narrower set of services that are related to online video games and online entertainment that is clearly distinct from the dance company, dance education and dance entertainment services offered under the Cited ULTIMATE ALLIANCE DANCE COMPANY Mark.

Accordingly, the relatedness of the goods and services factor also weighs against a likelihood of confusion.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the 2(d) refusal be withdrawn, and that the application be approved for publication.