

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Serial No.: 88/228,697

Mark: FAR AWAY

Classes: 009, 041

Applicant: Adventure Works, L.L.C.

TRADEMARK APPLICATION

Law Office: 113

Trademark Attorney: Dana Dickson

RESPONSE

Commissioner of Trademarks
PO Box 1451
Arlington, Virginia 22313-1451

Applicant responds to the Office Action mailed on March 16, 2019 in the above-identified Application. The Examining Attorney has refused registration of Applicant's mark FAR AWAY based on an alleged likelihood of confusion with United States Registration Nos. 4320778 and 3952533, for the marks FARAWAY and FARAWAY FRONTIERS & Design. The Office Action also requires clarification of the identification of services. In response to the Office Action, Applicant sets forth a revised identification of services in Section I of this Response, addresses and requests reconsideration of the refusal to register in Section II.

I. AMENDMENT OF GOODS AND SERVICES

Applicant modifies the goods and services in the identification as follows. Applicant has also made the modifications directly on the response form. They are included here for the Examining Attorney's reference.

Class 9 – Downloadable computer game software and entertainment software in the nature of computer games for use on mobile and cellular phones, mobile digital electronic devices, handheld computers, computers, video game consoles, both handheld and free standing, and other wireless POS (point of service) devices; Downloadable computer game software

Class 41 – Entertainment services, namely, providing on-line computer games; Providing

on-line non-downloadable} computer game software and entertainment software in the nature of computer games for use on mobile and cellular phones, mobile digital electronic devices, handheld computers, computers, video game consoles, both handheld and free standing, and other wireless POS (point of service) devices; Providing on-line non-downloadable computer game software

II. THERE IS NO LIKELIHOOD OF CONFUSION WITH THE PRIOR REGISTRATIONS FOR FARAWAY AND FARAWAY VENTURES & DESIGN

The Examining Attorney refuses to register the mark FAR AWAY alleging a likelihood of confusion with the marks FARAWAY and FARAWAY VENTURES. Applicant asserts that there is no likelihood of confusion between FAR AWAY and the cited marks. Although the marks share similar terms, the differences in the goods and services between Applicant's FAR AWAY and the prior cited FARWAY obviate confusion. Similarly, Applicant's FAR AWAY mark the prior cited FARAWAY FRONTIERS & Design are different in sound, appearance and meaning. The services are also sufficiently unrelated to warrant a finding that the marks are not confusingly similar.

Applicant reminds the Examining Attorney that likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the " du Pont factors"). Although, typically the most relevant *du Pont* factors are the similarity of the marks and the relatedness of the services. Here, the remaining *du Pont* factors, in particular the level of purchaser care and the marketing channels used serve to further distinguish Applicant's mark from the cited marks.

A. Applicant's Mark and the Cited Marks are Different in Meaning, Sound and Appearance

"Similarity of the marks is tested on three levels: sight, sound, and meaning." *Id.* The marks must be compared "in their entirety in determining whether there is likelihood of confusion." *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

The Marks Have Different Meanings. Applicant's mark FAR AWAY and the cited registration for FARAWAY and FARWAY VENTURES & Design may share common terms, but the meaning of the terms is different. The Examining Attorney claims the space in Applicant's mark is insufficient to distinguish the marks. Applicant respectfully disagrees. The space in Applicant's mark immediately signals to a consumer that the mark is intended to reflect distance whereas the "faraway" term in the cited marks primarily means mentally absent, dreamy. *Far away* is an adverb phrase that appears after the item that is being modified as two words. *Faraway* is an adjective, it appears before the noun it modifies. (See Exhibit A from grammarist.com).

Examples of this usage, also found in Exhibit A include: "*Medical robot in Saskatchewan is connecting doctors to faraway patients*" (emphasis added), versus "*NATO deepening cooperation with Ukraine, but membership far away*" (emphasis added). To the Examining Attorney this distinction may be minor, but it clearly conveys different meanings. Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). The fact that FAR AWAY and FARAWAY share similar terms in itself should not be a basis for refusal, when Applicant has demonstrated those terms have different meanings. Similarly, FAR AWAY and FARAWAY FRONTIERS & Design are entirely different in meaning. The term "frontiers" in the cited FARAWAY FRONTIERS & Design mark is suggestive of another dimension, planet or galaxy. Applicant's mark on the other hand leaves a consumer wondering what exactly may be far away. Thus, the marks have completely different meanings.

The Marks Sound Different. Although true that FAR AWAY and FARAWAY sound similar, to the observing ear there is still a pause when Applicant's mark is spoken aloud. FAR AWAY and FARAWAY FRONTIERS & Design, however, do not sound at all alike. The cited mark is an alliterative mark. Due to the repetition of the "F" sound in the mark, it results in a

different sound than merely saying “far away”.

The Marks Are Visually Different. FAR AWAY is visually different than FARAWAY and FARAWAY FRONTIERS & Design. The missing “space” in the FARAWAY registrations completely changes the appearance of the marks. The Trademark Trial and Appeal Board has found that the difference of even one or two letters can be sufficient to distinguish marks from each other. *See, B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727 (Fed. Cir. 1988). Surely, if the difference in one letter can distinguish the marks, then so too can the omission of a space. Here, the missing space makes applicants mark visually distinct from FARAWAY and prevents any likelihood of confusion.

The addition of the word “frontiers” in “FARAWAY FRONTIERS & Design” makes the mark appear visually longer than “far away.” Similarly, the FARAWAY FRONTIERS & Design registration has an elaborate detailed design that divides the words “faraway” and “frontiers”



Further, Applicant respectfully disagrees with the Examining Attorney that Applicant’s mark is likely to appear to prospective purchasers as a shortened form of Registrant’s mark. Registrant’s mark is a detailed design mark and it is not foreseeable that Registrant would use FAR AWAY without a space. In fact, if Registrant were to submit a specimen of its mark for FAR AWAY with a space and without the design, the specimen would be refused for showing a mark that is materially different than the applied for mark. Here, the marks at issue are similar in only one element. It is not proper for the Examining Attorney to dissect Registrant’s mark. If one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). In this case, the design

and term “frontiers” is the more dominant feature. These visual distinctions obviate any potential for likelihood of confusion.

B. Applicant’s Services Are Sufficiently Different than Those Included In The Registrations For FARAWAY and FARAWAY FRONTIERS & Design Particularly when Considering the Marketing Channels

The courts and the T.T.A.B. routinely hold that, even in a situation where two marks are identical, there is no likelihood of confusion “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.” TMEP § 1207.01(a)(i) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related)).

The Services Offered Under the Marks FAR AWAY and FARAWAY VENTURES & Design are Sufficiently Unrelated. The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies’ sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant’s bras, whereas "CROSSOVER," as applied to registrant’s goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear or the line between two seasons").

Here, the services offered by Applicant under the mark FAR AWAY and the services offered by Registrant under the mark FARAWAY VENTURES & Design are sufficiently different to preclude a finding of likelihood confusion. First, the services offered under the respective marks are found in Class 41 for Applicant and Class 42 for Registrant. Although the services may still be considered “related” while in different classes, Applicant point out this fact, because Registrant is clearly offering services relating to the design and development of

computer game software. In other words, Registrant can be thought of as offering a mark in relation to consultation services for the design and development of computer game software.

Applicant believes that much like CROSS-OVER for bras and CROSSOVER for ladies sportswear is unlikely to result in confusion despite being related to clothing, that FAR AWAY, and FARAWAY FRONTIERS & Design offer services that are sufficiently unrelated despite covering “computer software”.

The Marketing Channels are Different. In the present case, the nature of the services are dissimilar, although the marks are used broadly in connection with “computer game software” they appear to be marketed differently. A closer look at the record indicates the registration for FARAWAY was attained using a specimen suggesting the mark is in use with older generation software. In fact, the specimen does not indicate how the mark is used in connection with software for video games. There is no login screen and no connection between the mark and the services as offered (See Exhibit B). The only connection between the specimen and the services is the fact the mark has “best score” at the bottom of the specimen.

Similarly, the specimen demonstrating use for the application to register FARAWAY FRONTIERS & Design is a screen capture of the Registrant’s “About” page and does not show the mark in use in connection with actual video game software (See Exhibit C).

This to say that Applicant intends to offer software that is proper for download and for use with computers, cellular phones and the other devices listed in the recitation of services. According to TMEP Section 1207.01 the similarity or dissimilarity of established, likely-to-continue trade channels must be considered if there is pertinent evidence in the record. Here, the record indicates the Registrant’s of both of the cited marks are not offering their marks in connection with the services in the recitation. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services.

Consumers downloading Computer Game Software are Likely to be Careful

Purchasers. Although it is tempting to classify consumers of video games to the standard typical buyer exercising ordinary caution, it is not correct. Consumers of services offered by Applicant have expertise and are otherwise sophisticated with respect to the purchase of Applicant's services. In sum, Applicant's target consumers will not be easily confused to the source of the services, particularly when Registrant's for the cited marks do not appear to be offering any services relating to computer software for video games, as evidenced by the specimens attached hereto.

III. CONCLUSION

On the foregoing bases, Applicant respectfully asserts that there is no likelihood of confusion between the marks. Accordingly, Applicant respectfully requests reconsideration of the Examining Attorney's refusal of registration.

Respectfully submitted,

Date: September 16, 2019

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