

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Marine Stewardship Council	Examining Attorney: Justin Ronald Moscati
Serial No.: 88266969	Law Office 127
Filing Date: January 18, 2019	
Mark: MSC	

RESPONSE TO OFFICE ACTION
DATED APRIL 10, 2019

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1450

I. INTRODUCTION

Marine Stewardship Council (“Applicant”) filed an application to register the mark MSC (the “Mark” or “Applicant’s Mark”) in connection with the following goods:

“Dietetic food and substances adapted for medical or veterinary use; food for babies; dietary supplements for humans and animals; fish oil for medical purposes; oils (medicinal -); oil (cod liver -); edible fish oils for medical and/or dietary purposes” in International Class 5;

“Fish; seafood; food products made with or from fish; salted fish; fish fillets; preserved fish; tinned fish, fishmeal for human consumption; fish extracts; fish spreads; prepared meals, cooked meals and/or chilled meals, containing fish; pickled fish, frozen fish, fish products being fresh, preserved or frozen, canned fish, farmed fish products, prepared meals containing fish; edible oils and fats; snack foods; frozen foods; shrimps; prawns; shellfish; crustaceans; edible seaweed; dried edible seaweed; processed edible seaweed; seaweed extracts for food” in International Class 29; and

“Live fish; live shrimp; live prawns; shellfish; crustaceans; fish food; fresh seaweed; unprocessed edible seaweed” in International Class 31

(collectively “Applicant’s Goods”).

In a non-final Office Action dated April 10, 2019, the Examining Attorney raised two issues with the application: (1) citing a prior pending U.S. Application Serial No. 88125154 for

the mark MSC MALE SPERMACEIVE (“Cited Application”) filed by Global Medics USA (“GMU”) as a potential bar to the registration of Applicant’s Mark based on an alleged likelihood of confusion; (2) requesting that Applicant clarify certain terms in the identification of Applicant’s Goods.

In response, Applicant specifies and amends the identification of Applicant’s Goods as shown below in this response.

Further, Applicant states that on September 18, 2019, Applicant and the owner of the Cited Application, GMU, signed a Consent To Use and Register Agreement (“Consent Agreement”) attached as Exhibit A. This Consent Agreement reflects the real parties in interest, Applicant and GMU, (collectively “Parties”) position that confusion between Applicant’s Mark and the Cited Application is not likely. In the Consent Agreement, the Parties expressly state this belief. The Parties’ joint conclusion is supported by various facts, including: (1) the differences in the Parties’ respective goods, namely, the fact that Applicant’s Goods are targeted to individuals who are concerned with sustainable aquaculture and farming practices, whereas GMU’s are not, but are in the field of fertility supplements and are targeted specifically towards males who are looking to improve sperm health; (2) the fact that the Parties’ respective customers are so sophisticated that they are not likely to be confused into thinking that the Parties’ respective marks are related to, sponsored by, or affiliated with the other entity; and (3) the different appearance of the Parties’ goods that the consuming public will not be confused as to source. See Exhibit A.

Accordingly, under these circumstances, there is no likelihood of confusion between Applicant’s Mark and the Cited Application, and Applicant requests that the Examining Attorney approve this application for publication in the *Official Gazette*. Applicant’s arguments are more fully set forth below.

II. RESPONSE

A. Applicant’s Amendment to the Description of Applicant’s Goods.

In response to the Examining Attorney’s request, Applicant hereby amends of Applicant’s Goods as follows:

“Dietetic foods and ~~substances~~ beverages adapted for medical or veterinary use; food for babies; dietary supplements for humans and animals; fish oil for medical purposes; medicinal oils; cod liver oil; edible fish oils for medical and dietary purposes” in International Class 5;

“ Fish, not live; seafood, not live; food products made with or from fish, namely, fish fillets, smoked fish, fish steak, and fish cakes; salted fish; fish fillets; preserved fish; tinned fish; fishmeal for human consumption; fish extracts; fish spreads; prepared meals, cooked meals and frozen meals, consisting primarily of fish; pickled fish; frozen fish; preserved fish; canned fish; fish, namely, farmed, not live; prepared meals consisting primarily of fish; edible oils and fats; snack foods, consisting primarily of fish; frozen

foods consisting primarily of fish; shrimps, not live; prawns, not live; shellfish, not live; crustaceans, not live; dried edible seaweed; processed edible seaweed” in International Class 29; and

“ Live fish; live shrimp; live prawns; live shellfish; live crustaceans; fish food; fresh unprocessed seaweed; unprocessed edible seaweed, for human or animal consumption” in International Class 31.

The above amendments have been discussed by Applicant’s Attorney with the Examining Attorney who preliminary approved them.

B. There Is No Likelihood Of Confusion Between Applicant’s Mark And The Cited Application.

i. The Parties’ Consent Agreement Should Be Given Great Weight.

As the Court of Appeals for the Federal Circuit has held, consent agreements should be given great weight, and an examining attorney should not substitute his judgement concerning likelihood of confusion for the judgment of the parties especially, when the other factors do not dictate a finding of likelihood of confusion. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996 (Fed. Cir. 1985); TMEP § 1207.01(d)(viii). In the controlling decision on this issue, the Federal Circuit’s predecessor court – the Court of Customs and Patent Appeals - stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

In re E. I. du Pont de Nemours & Co., 476 F.2d at 1363 (C.C.P.A. 1973). *See also* TMEP § 1207.01(d)(viii).

Here, as in *In Re Four Seasons*, the Parties believe that confusion between the Parties and the uses of their marks is not likely. Indeed, the Parties have memorialized their belief in the Consent Agreement that both details particular reasons confusion is not likely and establishes steps the Parties will take to halt and prevent any likelihood of confusion, should it arise. *See, e.g., In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A. 1973) (noting that “[i]n considering agreements, a naked ‘consent’ may carry little weight,” but “[t]he weight to be given more detailed agreements . . . should be substantial”); *In re Donnay Int’l, S.A.*, 31 USPQ2d 1953, 1956 (TTAB 1994) (“the more information that is in the consent agreement as to why the parties believe confusion to be unlikely, and the more evidentiary support for such conclusions in the facts of record or in the way of undertakings by the parties, the more we can assume that the consent is based on a reasoned assessment of the marketplace, and consequently the more weight the consent will be accorded.”)

Therefore, Applicant requests that the Examining Attorney give substantial weight to the Parties' properly executed and credible Consent Agreement and withdraw his refusal to register Applicant's Mark.

III. CONCLUSION

As supported by the Parties' Consent Agreement, there is no likelihood of confusion between Applicant's Mark and the Cited Application. In addition, Applicant specified and amended certain terms in the identification of Applicant's Goods. Thus, Applicant respectfully requests that its' application be passed to publication in the *Official Gazette*.

Respectfully Submitted,

LOEB & LOEB LLP

Dated: September 24, 2019

By: /Tatyana V. Gilles/
Douglas N. Masters
Tatyana V. Gilles
321 N. Clark Street, Suite 2300
Chicago, Illinois 60654
Tel: (312) 464-3100
Fax: (312) 464-3111

Attorneys for Applicant