

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Examining Attorney: Evonne Marie Neptune  
Law Office: 127

Applicant: NAVER Corporation  
Serial No. 88/328,065  
Mark: CLICK CHOICE  
Filed: March 6, 2019

**Attorney Ref.: 31781-499850**

**RESPONSE TO OFFICE ACTION**

This is in response to the Office Action issued against the subject application on May 22, 2019. The Examiner has refused registration of the subject application under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), based upon the registration for the mark CLICKCHOICE (Reg. No. 5,494,877), owned by Blackhawk Engagement Solutions, Inc. (“Cited Registration”). The Examiner also refused registration of the subject application on the basis that the subject application appears to be an exact duplicate of Registration No. 4,284,650.

For the following reasons, Applicant respectfully requests that both refusals be reconsidered and withdrawn.

**I. No Likelihood of Confusion Exists Between Applicant’s Mark and the Cited Registration**

In order to maintain a rejection under Section 2(d), it is not sufficient if confusion is merely “possible.” A higher standard is required. *Shatel Corp. v. Mao Ta Lumber & Yacht Corp.*, 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) (“Likelihood of confusion requires that confusion be probable, not simply a possibility”); *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) (“[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient”).

**A. The Services Covered Under Applicant’s Mark and the Cited Registration are Different, Offered in Different and Unrelated Fields, and Target Different and Unrelated Consumers**

The Patent and Trademark Office, as well as the courts, have consistently declared that goods are only “related” if those goods are “marketed and consumed such that buyers are likely to believe that the goods, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company.” *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991); *Elec. Data Sys. Corp. v. EDSA Micro Chip*, 1992 T.T.A.B. LEXIS 4, \*11, 23, U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992); *Info. Res. Inc. v. X\*Press Info. Serv.*, 6 U.S.P.Q.2d 1034 (1988); *Reynolds & Reynolds Co. v. I.E. Sys., Inc.*, 5 U.S.P.Q.2d

1749, 1751 (T.T.A.B. 1987). In other words, it is necessary to assess whether the services offered under Applicant's mark and the Cited Registration are related to such a degree that they are likely to be linked in consumers' minds. *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 159 (9th Cir. 1963) cert. denied, 374 U.S. 380 (1963).

The services covered under Applicant's mark and the Cited Registration are different, offered in different and unrelated fields, and target different and unrelated groups of consumers. Applicant's mark covers advertising and internet advertising services, whereas the Cited Registration covers services relating to the production, promotion and administration of rebate programs. Not only are the services offered in different fields, services in each of these fields are purchased for specific and different purposes. These distinctions result in significantly different consumer groups, consumer priorities, channels of trade, price points, and marketing strategies for entities offering each type of service.

Overall, the services offered under Applicant's mark are not sufficiently related to the services offered under the Cited Registration and therefore confusion is unlikely.

#### **B. Registrant Agrees that Confusion is Unlikely**

Registrant has consented to the use and registration of Applicant's mark as shown in the attached Trademark Consent to Use and Registration Agreement, by which Registrant agrees that, due to the differences outlined above, consumers would not be confused as to the source of the parties' respective services. *See* Exhibit A. Applicant notes that although the Agreement does not reference the specific serial number for the subject application, Paragraph 8 of the Trademark Consent to Use and Registration Agreement makes the consent granted therein applicable to the subject application. Specifically, Registrant consents to the use and registration of the mark CLICK CHOICE for the services covered by this application.

Section 1207.01(d)(viii) of the Trademark Manual of Examining Procedure provides the following guidance with respect to consent agreements:

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973), 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.

Accordingly, the Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion. *See In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); *see also du Pont*, 476 F.2d at 1362-63, 177 USPQ

at 568; *cf. In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (affirming TTAB's holding that applicant's mark was barred by §2(d), because the provided consent to register was essentially a "naked" consent and all other relevant factors weighed in favor of a conclusion that confusion was likely).

Thus, Examiners should give substantial weight to a proper co-existence agreement such as the one submitted herewith, in which the Registrant acknowledged that there has not been any known confusion. When presented with a credible co-existence agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion, an Examiner should not interpose his or her own judgment that confusion is likely.

The combination of the provisions of the attached Trademark Consent to Use and Registration agreement, as well as the differences between the services, fields and target consumers, serves as compelling evidence that confusion between the marks or as to source is not likely. *See In re Fieldcrest Cannon Inc.*, 5 U.S.P.Q.2d 1142 (T.T.A.B 1987); *see also, In re SGS Tool Co.*, 24 U.S.P.Q.2d 1382 (T.T.A.B 1992); *see also, In re Donnay Int'l, Societe Anonyme*, 31 U.S.P.Q.2d 1953 (T.T.A.B 1994). Registrant has confirmed that its services are distinct from Applicant's services and that, despite years of concurrent use, Registrant was not aware of any instances of actual confusion. In this case, the surrounding circumstances and marketing conditions for the parties' respective services are such that they would not be encountered by the same people under circumstances that would give rise to the mistaken belief they have a common source --- a factor the Registrant has acknowledged.

In the *Donnay* case, *supra*, the Board accepted a letter of consent that was, in fact, a consent to register. The Trademark Consent to Use and Registration agreement in the present case is more than a mere consent to register. The Trademark Consent to Use and Registration agreement explain why the Registrant believes that confusion is not likely, and sets forth steps, including an agreement to cooperate and consult with the Applicant, to assure that confusion does not occur.

The Board has held that in cases involving consent agreements, "a great deal of weight must be given to the parties' assessment as to whether or not confusion is likely to occur." *In re Fieldcrest Cannon Inc.*, 5 U.S.P.Q.2d at 1143-44. The very fact that the Registrant has entered into the Trademark Consent to Use and Registration agreement and given its consent to the registration of Applicant's mark -- at the very least -- negates the presumption that all doubts regarding likelihood of confusion are to be resolved in favor of the prior applicant. By giving its consent, Registrant has, in effect, removed the basis for applying this equitable consideration. *Donnay*, 31 U.S.P.Q.2d at 1957.

## **II. The Subject Application is Not a Duplicate of an Active Registration**

The Examiner has refused registration of the subject application on the basis that the subject application is duplicative of Registration No. 4,284,650. Applicant notes that Registration No. 4,284,650 has been cancelled and therefore requests that this refusal be withdrawn. *See* Exhibit B.

### **III. Conclusion**

Based on the foregoing, Applicant respectfully requests that the Examiner withdraw the likelihood of confusion refusal, as well as the refusal based on the since cancelled Registration No. 4,284,650, and approve the subject application for publication.

# **EXHIBIT A**

## **TRADEMARK CONSENT TO USE AND REGISTRATION**

This consent (the "Consent Agreement") is by and between NAVER CORPORATION, a corporation organized under the laws of the Republic of Korea (herein after referred to as "Naver"), located at Greenfactory, 6 Buljeong-Ro, Bundang-Gu, Seongnam-Si, Gyeonggi-Do, Republic Of Korea, and BLACKHAWK ENGAGEMENT SOLUTIONS, INC., a Delaware corporation located at Suite 200, 700 State Highway 121 Bypass, Lewisville TEXAS 75067 (hereinafter referred to as "Blackhawk").

WHEREAS Naver is the record owner of United States Trademark Registration No. 4,284,650 for the mark CLICK CHOICE in connection with the following services in International Class 35 (the "Naver Services):

Dissemination of advertising for others via the Internet; electronic billboard advertising; on-line advertising on computer communication networks; on-line advertising on computer networks; providing and rental of advertising space on the internet; providing television advertising for others; rental of advertising space on web sites; dissemination of advertising for others via mobile websites, applications, and devices; advertising and advertisement, promotion and marketing services for providing electronic media or information over the Internet or other communications network.

WHEREAS Blackhawk has filed the trademark Application Serial No. 86-934,203 for the mark CLICKCHOICE, in connection with the following services (the "Blackhawk Services") which claims a first use date of 2002:

Business marketing consulting services, namely, customer relationship management services for others; business marketing consulting services, namely, establishing multiple promotional items or services as options for consumers to select from as part of a promotional program; administrative processing of manufacturer's product rebates for others via a global computer network; administrative processing of manufacturer's product rebates for others; administrative processing of manufacturer's product rebates for others by allowing consumers to select a desired promotional item or service from among multiple promotion items or services as part of a promotional program; administrative processing of retailer's product rebates for others via a global computer network; administrative processing of retailer's product rebates for others; administrative processing of retailer's product rebates for others by allowing consumers to select a desired promotional item or service from among multiple promotion items or services as part of a

promotional program; order fulfillment services for others; administrative processing of consumer service rebates for others via a global computer network; administrative processing of consumer service rebates for others; administrative processing of consumer service rebates for others by allowing consumers to select a desired promotional item or service from among multiple promotion items or services as part of a promotional program; promoting the goods and services of others through promotions management, namely, establishing multiple promotional items or services as options for consumers to select from as part of a promotional program; computerized online retail store services in the field of general consumer merchandise, in International Class 35;

Providing manufacturer's product rebates for others via a global computer network; providing manufacturer's product rebates for others; providing manufacturer's product rebates for others by allowing consumers to select a desired promotional item or service from among multiple promotion items or services as part of a promotional program; providing retailer's product rebates for others via a global computer network; providing retailer's product rebates for others; providing retailer's product rebates for others by allowing consumers to select a desired promotional item or service from among multiple promotion items or services as part of a promotional program; providing consumer service rebates for others via a global computer network; providing consumer service rebates for others; providing consumer service rebates for others by allowing consumers to select a desired promotional item or service from among multiple promotion items or services as part of a promotional program; in International Class 36; and

Packing of documents for others for shipping; packing of products for others for shipping; shipping documents for others; shipping products for others; in International Class 39.

WHEREAS, Blackhawk's application for CLICKCHOICE has been refused registration based upon an asserted likelihood of confusion with Naver's CLICK CHOICE mark;

WHEREAS, the parties believe that their respective marks can continue to coexist;

NOW, THEREFORE, in consideration of the mutual covenants contained herein, and intending to be legally bound hereby, the parties agree as follows:

1. The parties agree that the services identified by their respective marks set forth above are sufficiently unrelated to make confusion unlikely.
2. Specifically, Blackhawk's Services are primarily for production, promotion, and administration of rebate programs, while Naver's Services are primarily for advertising and internet advertising services.
3. NAVER confirms it is not aware of any public confusion as to the source, sponsorship or affiliation arising from the use of the CLICKCHOICE mark by Blackhawk for the Blackhawk Services, despite concurrent use of the parties' marks.

4. As a result, Naver does not believe there will be a likelihood of confusion between its **CLICK CHOICE** mark as used in connection with the Naver Services and Blackhawk's **CLICKCHOICE** mark as used in connection with the Blackhawk Services.
5. Naver thus consents to the registration and use of **CLICKCHOICE** by Blackhawk for the Blackhawk Services.
6. Blackhawk also confirms it is not aware of any public confusion as to the source, sponsorship or affiliation arising from the concurrent use of its **CLICKCHOICE** mark and Naver's **CLICK CHOICE** mark when used in connection with the parties' respective services, despite concurrent use of the parties' marks for over five years.
7. As a result, Blackhawk does not believe there will be a likelihood of confusion between its **CLICKCHOICE** mark as used in connection with the Blackhawk Services and Naver's **CLICK CHOICE** mark as used in connection with the Naver Services.
8. Blackhawk thus consents to the use and registration of the **CLICK CHOICE** mark by Naver in connection with the Naver Services.
9. As further evidence that the parties' marks can coexist without any likelihood of confusion, Naver's registration for **CLICK CHOICE** coexisted from 2013 to 2016 with U.S. Reg. No. 2,972,683 for **CLICKCHOICE**, owned by Blackhawk and covering services identical to those in Blackhawk's application for **CLICKCHOICE**, until the registration was inadvertently allowed to expire.
10. The parties further agree that the manner of promotion and use of their respective marks make confusion unlikely. However, in the unlikely event that either party learns of any instances of actual confusion arising from the concurrent use of their respective marks, such party shall notify the other party, and the parties agree to cooperate to take appropriate actions to avoid such confusion in the future.
11. The parties agree to execute any further agreements, consents or other documents which may be necessary to carry out the spirit and intent of this Agreement.
12. This Agreement shall be binding upon and inure to the benefit of the parties hereto and their subsidiaries, related companies, and respective successors and assigns, and may be freely assigned along with the rights to its respective marks and registrations.
13. This Consent Agreement may be filed by either party with the United States Patent and Trademark Office pursuant to § 1207.01(d)(viii) of the Trademark Manual of Examining Procedure to support the registration of marks consistent with the terms and conditions of this Agreement.



14. This Agreement may be executed in multiple counterparts with each constituting an original, and be effective on the date it is executed by the Parties. Each party represents that the individual signing this Agreement on its behalf has the authority to bind the party.


**NAVER CORPORATION**

By: 

Title: Manager

Date: 2018 2 20

**BLACKHAWK ENGAGEMENT SOLUTIONS, INC.**

By: 

Title: General Counsel and Secretary

Date: 2/20/18

# **EXHIBIT B**



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**Word Mark** CLICK CHOICE

**Goods and Services** (CANCELLED) IC 035. US 100 101 102. G & S: Dissemination of advertising for others via the Internet; electronic billboard advertising; on-line advertising on computer communication networks; on-line advertising on computer networks; providing and rental of advertising space on the internet; providing television advertising for others; rental of advertising space on web sites; dissemination of advertising for others via mobile websites, applications, and devices; advertising and advertisement, promotion and marketing services for providing electronic media or information over the Internet or other communications network

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 85348863

**Filing Date** June 17, 2011

**Current Basis** 44E

**Original Filing Basis** 1B;44D

**Published for Opposition** October 9, 2012

**Registration Number** 4284650

**Registration Date** February 5, 2013

**Owner** (REGISTRANT) NHN Business Platform Corp. CORPORATION REPUBLIC OF KOREA 9F First Tower, 55, Bundangro, Bundanggu Seongnamsi, Gyeonggi-do REPUBLIC OF KOREA

(LAST LISTED OWNER) NAVER CORPORATION CORPORATION REPUBLIC OF KOREA GREENFACTORY, 6 BULJEONG-RO, BUNDANG-GU, SEONGNAM-SI GYEONGGI-DO REPUBLIC OF KOREA

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Hae-Chan Park

**Priority Date** February 25, 2011

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** DEAD

**Cancellation Date** September 6, 2019

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